Divisional, Continuation and Continuation-in-Part Patent Applications

Questions

1) Analysis of the current law

1) Are divisional, continuation or continuation-in-part applications, respectively, available under your national or regional law?

Divisional applications are available, but continuation-in-part applications are not available.

2) What is the justification behind allowing the filing of divisional, continuation and continuation-in-part applications in your law?

The justification behind allowing the filing of a divisional is the lack of unity of the invention during prosecution in the first application.

3) Under what circumstances and conditions may divisional, continuation and continuation-in-part applications (or combinations thereof) be filed in your national or regional patent system?

Because of lack of unity of the invention, during prosecution, it must be supported on the original specification.

4) Are cascades of divisional, continuation and continuation-in-part applications allowed, i.e. is it possible to file a divisional, continuation or continuation-in-part application on the basis of another divisional, continuation or continuation-in-part application?

Divisionals may be filed only from the parent application and only while the parent application is pending.

5) At what time during the prosecution of the parent application may divisional, continuation or continuation-in-part applications be filed?

At any time during prosecution of the parent application.

6) Is it a requirement for filing an application that is a divisional, continuation or continuation-in-part of an original application (or of another divisional, continuation or continuation-in-part thereof) that the original application (or the direct parent application, or both) is still pending at the time of filing of the divisional, continuation or continuation-in-part application?

Yes, it is a requirement.

7) Is it a requirement that the original application (or the direct parent application, or both) is still pending throughout the prosecution of a divisional, continuation or continuation-in-part application derived therefrom?
No, the parent application may be granted or denied throughout the prosecution of the divisional application. Prosecution of each are independent.

8) Are there any restrictions as to what may be included in a divisional, continuation or continuation–in–part application?

It must be supported on the original specification and it may not imply an extension of the invention.

9) In particular, may the description and/or claims contain or claim matter that was not contained or claimed in the original application, or other application from which the divisional, continuation or continuation–in–part application derives?

The description must be exactly the same as the one from the parent application. No additional subject matter may be added.

10) Is it possible to extend the patent term in respect of matter contained in the original application by filing divisional, continuation or continuation–in–part applications, including divisional, continuation or continuation–in–part applications containing added matter, to the extent the addition of new matter is allowed?

No, the divisional application will have the same filing date as the parent application and if granted, it will be for a period of 20 years from the filing date. That is the parent application and divisional application will have the same term of protection.

11) Is double-patenting permitted or must the matter claimed in divisional, continuation or continuation–in–part applications be deleted from the claims of the original application, or other application from which the divisional, continuation or continuation–in–part application derives?

No double-patenting is permitted, the subject matter sought in the divisional application must be deleted from the parent application.

12) Does it matter in this respect whether the divisional, continuation or continuation–in–part application was filed in response to a restriction requirement issued by the patent granting authority?

Applicant may file divisionals by choice or as a response or restriction requirement of the Patent Office.

II) Proposals for adoption of uniform rules

1) In the opinion of your National or Regional Group, what are the advantages, for applicants and third parties, of allowing the filing of divisional, continuation or continuation–in–part patent applications?

Divisionals are only useful when different subject matter are found within one single application.

2) In the opinion of your National or Regional Group, what are the disadvantages, for applicants and third parties, of allowing the filing of divisional, continuation or continuation–in–part patent applications?

No known opinion of any disadvantage.

3) In the opinion of your National or Regional Group, should the filing of divisional, continuation or continuation–in–part patent applications, respectively, be permissible?

Divisionals should be allowed only when lack of unity of invention arises.
4) If international harmonisation were to be achieved in respect of the rules governing divisional or continuation patent applications, what should be the common rules in respect of the circumstances and conditions in which divisional, continuation or continuation–in–part applications may be filed?

Divisionals should be filed when different subject matters are found.

5) In particular, should a harmonised system permit the addition in a divisional, continuation or continuation–in–part application of matter that was not contained in the original application as filed?

No.

6) Should it be permitted to use a divisional, continuation or continuation–in–part patent application to obtain new examination and decision of an application that contains claims that are identical or essentially identical with claims finally rejected in the course of the prosecution of the parent application? Should there be an exception where case–law on the substantive conditions for patent grant of the patent granting authority has changed since the parent application was rejected? Would this possibility adequately take into account the interests of third parties in legal certainty?

No.

7) Should it be possible to extend the patent term in respect of matter contained in the original application by filing divisional, continuation or continuation–in–part applications, including divisional, continuation or continuation–in–part applications containing added matter?

No.

8) In the opinion of your Group, would it be justified to limit the access to filing divisional, continuation or continuation–in–part applications primarily with the object of limiting the backlog of patent granting authorities?

No.

9) In the opinion of your Group, would it be desirable, in the interest of legal certainty of third parties, if databases of patent granting authorities ensured that a clear link was always indicated between original patent applications and all divisional, continuation or continuation–in–part applications derived therefrom?

Yes.

National and Regional Groups are invited to make any additional comment concerning divisional, continuation and continuation in part applications which they find relevant.