Summary Report

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2026 – Study Question

Divisional applications and double patenting

Introduction

Divisional patent applications are a key mechanism for applicants seeking to secure protection for multiple inventions disclosed in a single parent application. They allow applicants to pursue distinct subject matter while retaining the filing date of the original filing. However, the procedural and substantive requirements for filing divisional applications vary widely across jurisdictions. A central issue associated with divisional applications is double patenting. Double patenting, as its name suggests, refers to the granting of two or more independent patent rights for the same invention. Double patenting may arise, e.g., when overlapping claims in the parent and the divisional patent(s) lead to concerns about claim distinctiveness. The criteria used to assess double patenting also vary significantly across jurisdictions. While some jurisdictions provide mechanisms such as terminal disclaimers to address potential overlaps, others apply stricter requirements that may limit the applicants´ ability to obtain appropriate protection for inventions related to one another. This Study Question examines whether additional harmonisation in the area of double patenting and divisional application practice is desired.

The Reporter General has received Reports from the following Groups and Independent Members in alphabetical order: Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, Chile, China, Chinese Taipei (Independent Members), Colombia, Denmark, Ecuador, Egypt, Finland, France, Germany, Hungary, India, Indonesia, Israel, Italy, Japan, Korea, Malaysia, Mexico, Netherlands, Norway, Paraguay, Peru, Philippines, Poland, Portugal, Russia, Singapore, Spain, Sweden, Switzerland, Thailand, Turkey, UAE, United Kingdom, United States, Vietnam.

44 Reports were received in total. The Reporter General Team thanks the Groups and Independent Members for their helpful and informative Reports. All Reports may be accessed in AIPPI's library at www.aippi.org.

The Reports provide a comprehensive overview of national and regional laws, practices, and policies relating to divisional applications and double patenting set out in three parts:

- Part I – Current law and practice
- Part II – Policy considerations and proposals for improvements of your Group's current law
- Part III – Proposals for harmonisation

This Summary Report does not summarise Part I of the Reports received. Part I of any Report is the definitive source for an accurate description of the current state of the law in the jurisdiction in question.

This Summary Report has been prepared on the basis of a detailed review of all Reports (including Part I) but focuses on Parts II and III, given AIPPI's objective of proposing improvements to, and promoting the harmonisation of existing laws. As it is a summary, if any question arises as to the exact position of a particular Group

in relation to Parts II or III, please refer to the relevant Report directly.

In this Summary Report:

- references to Reports of or responses by one or more "Groups" may include references to Independent Members;
- where percentages of responses are given, they are rounded to the nearest 5%; and
- in Part IV below, some conclusions have been drawn in order to provide guidance to the Study Committee for this Study Question.

I. Current law and practice

For the replies to Questions 1) to 17) set out in the Study Guidelines for this Study Question, reference is made to the full Reports. The Study Guidelines may be accessed in AIPPI's library at www.aippi.org.

II. Policy considerations and proposals for improvements of your Group's current law

18) According to the opinion of your Group, is your current law regarding double patenting adequate and/or sufficient? Please answer YES or NO and please explain your chosen view briefly.

27 of the responding Groups stated YES (60%), while 17 Groups (40%) stated NO.

Thus, a slight majority of the Groups considered that the current law regarding double patenting is adequate and/or sufficient in their jurisdiction. However, a significant minority also found development needs.

19) According to the opinion of your Group, what is or should be the policy rationale for regulations addressing double patenting?

The Groups identified several policy rationales for regulations addressing double

patenting. The most frequently cited rationale was the prevention of unjustified extension of patent exclusivity beyond the intended statutory term. Many Groups, including the German, Swedish, Japanese, and Australian Groups, emphasized that double patenting regulations serve to protect legal certainty for third parties by ensuring that competitors can rely on the expiry of a single patent term. Several Groups also noted that such regulations prevent the imposition of duplicative enforcement burdens on third parties, who would otherwise face the prospect of challenging multiple patents covering the same subject matter. A number of Groups further identified the maintenance of the integrity and coherence of the patent system as a key rationale, noting that permitting multiple patents for the same invention would undermine public confidence in the system. Some Groups, such as the US Group and the Singaporean Group, additionally noted that double patenting regulations serve to ensure that the public receives the benefit of the patent bargain — namely, that upon expiry of the patent term, the invention enters the public domain without residual exclusivity.

20) According to the opinion of your Group, is your current law regarding divisional applications adequate and/or sufficient? Please answer YES or NO and please explain your chosen view briefly.

27 of the responding Groups stated YES (65%), while 16 Groups (35%) stated NO. One (1) Group refrained from a YES/NO answer.

Thus, a slight majority of the Groups considered that the current law regarding divisional applications is adequate and/or sufficient in their jurisdiction. However, a significant minority also found development needs.

21) According to the opinion of your Group, what is or should be the policy rationale for regulations addressing divisional?

The Groups identified several policy rationales for regulations addressing divisional applications. The most commonly cited rationale was the preservation of the applicant's right to obtain protection for all inventions disclosed in a single parent application, particularly where a lack of unity objection prevents their pursuit in a single proceeding. Many Groups emphasized that divisional applications serve as a necessary procedural mechanism to ensure that applicants are not penalized for the breadth of their original disclosure. Several Groups also noted that divisional application regulations serve to balance the applicant's interests against the need for legal certainty for third parties, by establishing clear procedural boundaries within which divisional filings are permissible. A number of Groups further identified the prevention of abuse as a key rationale, noting that without appropriate safeguards, the divisional application system could be exploited to artificially prolong pendency or create legal uncertainty for competitors.

22) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

Several Groups identified additional policy considerations and proposals for improvement. Among the most frequently raised issues were: the need for clearer rules on the interaction between divisional applications and double patenting, particularly regarding the permissible degree of claim overlap within a patent family; the desirability of procedural mechanisms to accelerate the examination of divisional applications; and the importance of transparency measures, such as requiring patent offices to maintain and publish clear links between all members of a patent family. Some Groups also raised concerns about the cost implications of divisional filings for both applicants and third parties and proposed that fee structures could be used as a regulatory tool to discourage excessive or strategic filings without imposing rigid numerical limits.

III. Proposals for harmonisation double patenting

23) Do you consider that there is a need to have harmonisation regarding issues involving double patenting? Please answer YES or NO and add a brief explanation.

38 of the responding Groups (85%) stated YES, while 6 Groups (15%) stated NO.

An overwhelming majority of the Groups supported harmonisation on double patenting. The most commonly cited justification was the need to reduce legal uncertainty arising from divergent national standards. The US Group noted that "the current level of divergence among national approaches is counter-productive, and unnecessarily complex, confusing, and expensive". The Swedish Group emphasised that "divergences exist among jurisdictions regarding double patenting, including the legal basis, substantive assessment criteria, exceptions, and procedural arrangements", and that "a consistent approach would provide applicants with greater legal certainty in securing rights across jurisdictions". The Bulgarian Group stated that "harmonisation is needed to avoid duplication across jurisdictions and ensure legal certainty". The UAE Group similarly noted that "divergent standards as to what constitutes the 'same invention' or 'substantially the same claim scope' create uncertainty for applicants seeking protection in multiple jurisdictions". The Netherlands Group noted the overall importance of harmonisation by stating that "harmonisation as such may be beneficial for patent holders and for every party being confronted or working with the patent system". The UK Group observed that "harmonisation is a good idea as it reduces the scope for misunderstanding and mistakes in the acquisition and maintenance of patent portfolios covering a number of jurisdictions". The Singapore Group also stated that harmonisation "can be useful and provide more certainty when applicants pursue patent protection in multiple countries".

The minority of Groups opposing harmonisation generally considered their existing framework adequate or expressed concern that harmonisation could dilute existing safeguards. For example, the Ecuadorian Group opposed harmonisation on the basis that it could "facilitate the unjustified extension of exclusive rights, especially in sensitive sectors such as pharmaceuticals".

24) Should it be categorically prohibited to have more than one patent right for one invention for the same geographical area with the same or substantially the same claim scope (double patenting)? a. YES, it should be categorically prohibited (i.e., only one patent right per invention per territory). b. NO, it should not be categorically prohibited as exceptions should apply. Please provide a brief explanation.

22 of the responding Groups stated YES (55%), while 21 Groups (45%) stated NO. One (1) Group refrained from a YES/NO answer. Thus, the Groups were evenly divided on this question.

The Groups that answered YES generally considered that granting more than one patent right for the same invention within the same territory would unjustifiably extend exclusivity, create legal uncertainty for third parties, and undermine the integrity of the patent system. For example, the Australian Group stated that "there should only be one patent right per invention within a territory" as this "ensures transparent scope of protection and reduces uncertainty and the administrative burden created by overlapping exclusive rights". The Chinese Group argued that granting multiple patent rights for the same invention would lead to "repeated examination work by the patent examination authority", result in "the patentee obtaining extended patent protection for an invention-creation that exceeds the statutory term", and "force others to obtain licenses for multiple patents and even pay separate royalties when implementing the patents". The Korean Group stated

that "more than one patent right for the same or substantially identical invention in the same geographical area should be prohibited, as it may create unjustified barriers to technology development and legal uncertainty". The Swiss Group considered that "a categorical prohibition would ensure clarity and maintains a fair balance between rewarding innovation and protection". The Turkish Group stated that "only one patent right should be granted per invention within a given territory, since patent protection is limited to 20 years; otherwise, there is a risk of effectively extending the term of protection". The Vietnamese Group stated that "double patenting should be categorically prohibited to avoid abuses of the patent monopoly system and protect fair competition and innovation". The Singaporean Group answered YES "in light of the policy considerations" relating to prevention of unjustified extension of patent term, public interest, and avoidance of unjustified rewards and conflicting rights.

The Groups that answered NO generally considered that a categorical prohibition would be excessively rigid and could negatively affect legitimate filing strategies, particularly where different granting authorities operate under independent legal frameworks, or where different types of rights serve distinct purposes. For example, the Danish Group referred to its existing framework as adequate and sufficient, noting that exceptions are necessary due to the particular territorial situation of Greenland and the Faroe Islands. The German Group considered that "a categorical prohibition of double patenting should therefore be rejected", noting that the coexistence of a patent and a utility model is justified given that they serve different purposes, and that coordination between different authorities would be difficult and burdensome. The Swedish Group considered that "double patenting should not be categorically prohibited" and that "limited and clearly defined exceptions should remain possible", such as where different granting authorities apply independent

prosecution procedures. The UK Group stated that "there should be limitations on the same applicant obtaining multiple patent rights having the same priority date for the same geographical area with the same or substantially the same claim scope", but that a categorical prohibition was not appropriate as exceptions should apply. The French Group considered that exceptions should apply, in particular where different courts have jurisdiction over the respective rights. The Hungarian Group stated that "a granted patent should be per se enforceable, without any respect to any other granted patent, so it seems to be rather difficult to conclude any fair, justified and effective restriction in the patent law in the enforcement of redundant/overlapping patents". The Belgian Group noted that "having more than one patent right for the same invention can be beneficial when, e.g. one of those patents is under a pledge", and that "having should, however, be distinguished from enforcing", with limits on enforcing the same right twice being the more appropriate approach. The Brazilian Group considered that "a categorical prohibition may be appropriate where two rights protect the same inventive subject matter in substance", but that "regulatory frameworks should carefully distinguish between impermissible duplicate protection and technically unavoidable overlap".

25) Irrespective of your answer to question 24)) above, if it were possible to have more than one patent right for the same or substantially the same claim scope, should it be possible to have patent rights covering the same geographical area granted by different national or regional bodies for the same or substantially the same claim scope? [YES/NO] Please add a brief explanation.

15 of the responding Groups stated YES (40%), while 25 Groups (60%) stated NO. Four (4) Groups refrained from a decisive answer.

Thus, a majority of the Groups considered that it should not be possible to have patent rights covering the same geographical area granted by different national

or regional bodies for the same or substantially the same claim scope.

The Groups that answered YES generally acknowledged that parallel protection from different granting authorities may arise as a structural feature of coexisting national and regional patent systems, and that such coexistence can serve legitimate purposes. For example, the Russian Group noted that "parallel patent rights in such cases do not arise from an attempt to improperly extend the scope or duration of protection, but from the legitimate use of independent legal frameworks". The Swedish Group pointed out that "different granting authorities apply independent prosecution procedures" and that requiring applicants to coordinate across parallel prosecution tracks would impose a disproportionate administrative burden. The French Group and the Italian Group similarly noted that such coexistence should be permitted where different courts have jurisdiction over the respective rights, subject to safeguards against double enforcement. The Danish Group highlighted a specific territorial concern, noting that a European patent cannot apply to Greenland and the Faroe Islands, so that a ban on national double patenting in relation to European patents would limit patenting possibilities in those territories.

The Groups that answered NO generally considered that allowing multiple patent rights from different authorities for the same geographical area and the same claim scope would create significant legal uncertainty, risk conflicting rights, and undermine the coherence of the patent system. For example, the Australian Group stated that "having multiple patent rights for the same invention issued by different national/regional bodies would create significant legal uncertainty and potentially duplicate and/or conflicting enforcement". The UAE Group noted that "allowing such parallel protection would undermine legal certainty and effectively result in

double exclusivity for the same invention within the same territory". The Bulgarian Group stated that "it should be categorically prohibited" and that "abuse may include serial filings or strategic fragmentation". The Paraguayan Group similarly considered that "it should be prohibited to avoid the abuse of rights". Several Groups, including the Chinese Group and the Korean Group, emphasized that the risk of duplicative protection and increased costs for third parties (e.g., having to file multiple invalidity requests against multiple patents with identical scope) weighed against permitting such parallel rights.

26) Should it be possible to have protection for the same or substantially the same claim scope through different "patent rights" (e.g., utility model, design patent)? [YES/NO] Please provide a brief explanation.

20 of the responding Groups stated YES (45%), while 23 Groups (55%) stated NO. One (1) Group refrained from a YES/NO answer.

Thus, the Groups were almost evenly divided on this question.

The Groups that answered NO generally considered that allowing protection for the same or substantially the same claim scope through different types of rights would result in unjustified duplication of exclusive rights, legal uncertainty, and potential extension of market exclusivity beyond the intended term. For example, the Vietnamese Group stated that "it should generally not be possible to obtain multiple overlapping IP rights for the same or substantially the same claim scope", as this "would lead to duplication of exclusive rights, legal uncertainty, and potential extension of market exclusivity beyond the intended term". The Turkish Group noted that "permitting parallel technical protection for the identical claim scope across different right categories creates severe double patenting conflicts, risking overlapping enforcement, double recovery of damages, and significant legal

uncertainty for third parties". The Chinese Group argued that allowing such parallel protection would "increase the examination burden of the patent examination authority" and undermine patent quality.

The Groups that answered YES generally reasoned that different types of patent rights serve distinct legal purposes and protect different aspects of an invention, so that parallel protection is justified where the rights do not truly overlap in substance. Several Groups drew a distinction between technical rights (patents and utility models) and design rights, noting that the latter protect aesthetic appearance rather than technical function and therefore cannot, by definition, cover the same subject matter as a patent. For example, the Australian Group stated that "a patent protects the claimed function or inventive features and a design right protects how the product looks", and that parallel protection between a patent and a design right "would not have the same claim scope". The German Group similarly argued that "patents, design patents and utility models are subject to different grant criteria" and that "not allowing parallel protection would undermine the decision of the legislator to provide different types of intellectual property rights which not per se exclude each other". The Finnish Group noted that "different types of rights serve different functions and may have different requirements, durations, and enforcement mechanisms", and that a general prohibition on cumulative protection would not be justified. The Danish Group similarly supported the permissibility of parallel protection through different types of rights, consistent with its view that coexisting national and regional systems may legitimately give rise to overlapping protection.

27) Irrespective of your answer to question 26)) above, if such parallel protection was available, should it be possible to have, for the same or substantially the same claim scope

a) a patent right and a utility model right? [YES/NO]

20 of the responding Groups stated YES, while 19 Groups stated NO. Five (5) Groups refrained from a YES/NO answer. Thus, the Groups were almost evenly divided on this question.

The Groups that answered YES generally noted that patents and utility models, while both protecting technical inventions, serve different purposes and are subject to different requirements and durations, so that parallel protection may be justified in certain circumstances. For example, the German Group noted that "utility models offer complementary protection, providing security during the unprotected period between patent application and grant". The Finnish Group pointed out that "different types of rights serve different functions and may have different requirements, durations, and enforcement mechanisms", and that a general prohibition on cumulative protection would not be justified. The Italian Group similarly noted that utility models may serve as a useful complement to patents, particularly in jurisdictions where they provide faster and less costly protection for incremental innovations.

The Groups that answered NO generally considered that, since both rights protect the same technical subject matter, parallel protection would amount to double patenting and should not be permitted. For example, the Turkish Group noted that "permitting parallel technical protection for the identical claim scope across different right categories creates severe double patenting conflicts, risking overlapping enforcement, double recovery of damages, and significant legal uncertainty for third parties". The Vietnamese Group stated that allowing such parallel protection "would lead to duplication of exclusive rights, legal uncertainty, and potential extension of market exclusivity beyond the intended term". The

Chinese Group argued that allowing such parallel protection would "increase the examination burden of the patent examination authority" and undermine patent quality.

b) a patent right and a design patent right? [YES/NO]

32 of the responding Groups stated YES (80%), while 7 Groups stated NO (20%). Five (5) Groups refrained from a YES/NO answer. Thus, a majority of the Groups considered that parallel protection between a patent right and a design patent right should be possible.

The Groups that answered YES generally reasoned that patents protect technical function while design rights protect aesthetic appearance, so that the two types of rights protect fundamentally different aspects of a product and can legitimately coexist. For example, the Australian Group stated that "a patent protects the claimed function or inventive features and a design right protects how the product looks", and that parallel protection between a patent and a design right "would not have the same claim scope". The Swedish Group stated that "patents and design patent rights protect different aspects of an innovation (technical function versus aesthetic appearance), and the same product may be deserving of both forms of protection". The German Group similarly argued that "patents, design patents and utility models are subject to different grant criteria" and that "not allowing parallel protection would undermine the decision of the legislator to provide different types of intellectual property rights which not per se exclude each other".

The Groups that answered NO generally considered that, even where the types of rights are formally distinct, allowing protection for the same or substantially the same claim scope would result in unjustified duplication of exclusive rights and legal uncertainty. Several Groups noted that if the claim scopes are genuinely the

same or substantially the same, the distinction between technical and aesthetic protection becomes immaterial, and parallel protection should not be permitted regardless of the formal category of the right.

c) a utility model right and a design patent right? [YES/NO]

30 of the responding Groups stated YES (80%), while 9 Groups stated NO (20%). Five (5) Groups refrained from a YES/NO answer. Thus, a majority of the Groups considered that parallel protection between a utility model right and a design patent right should be possible.

The Groups that answered YES relied on substantially the same reasoning as for subquestion (b), noting that utility models protect technical function while design rights protect aesthetic appearance, and that the two types of rights therefore protect fundamentally different aspects of a product. Several Groups emphasized that the same product may legitimately warrant both forms of protection where the technical and aesthetic contributions are each independently protectable. For example, the Swedish Group noted that the rationale for permitting parallel protection between a patent and a design right applies equally to the combination of a utility model and a design right.

The Groups that answered NO applied the same reasoning as for subquestion (b), considering that where the claim scopes are the same or substantially the same, parallel protection should not be permitted regardless of the formal category of the rights involved.

d) a utility model right and a utility model right? [YES/NO]

11 of the responding Groups stated YES (30%), while 28 Groups stated NO (70%). Five (5) Groups refrained from a YES/NO answer. Thus, a large majority of the Groups considered that parallel protection between two utility model rights should not be

possible.

The Groups that answered NO generally considered that two rights of the same nature covering the same or substantially the same claim scope would constitute impermissible double patenting, regardless of whether they are granted by the same or different authorities. For example, the Swedish Group stated that "two utility model rights with the same or substantially the same claim scope should be prohibited on the same basis as duplicate patents". The German Group similarly noted that the acquisition of two utility model rights for the same claim scope should not be permissible. The Turkish Group emphasized that "permitting duplicate utility model rights for identical claim scope would create severe enforcement conflicts and undermine the coherence of the IP system".

e) a patent right and a patent right? [YES/NO]

11 of the responding Groups stated YES (30%), while 28 Groups stated NO (70%). Five (5) Groups refrained from a YES/NO answer. Thus, a large majority of the Groups considered that parallel protection between two patent rights should not be possible.

The Groups that answered NO generally considered that granting two patent rights for the same or substantially the same claim scope represents the paradigmatic case of impermissible double patenting. For example, the Australian Group stated that "having multiple patent rights for the same invention would create significant legal uncertainty and potentially duplicate and/or conflicting enforcement". The UAE Group noted that "allowing such parallel protection would undermine legal certainty and effectively result in double exclusivity for the same invention within the same territory". Several Groups emphasized that the prohibition on double patenting exists precisely to prevent this situation, and that no exception should be

made regardless of whether the patents originate from the same or different applications.

The small number of Groups that answered YES generally relied on the same reasoning as for subquestion (d), noting that parallel patent rights may arise from different granting authorities and that such structural coexistence should not be categorically prohibited. The Russian Group, for example, noted that "parallel patent rights in such cases do not arise from an attempt to improperly extend the scope or duration of protection, but from the legitimate use of independent legal frameworks".

28) Irrespective of your answer to question 26)) and 27)) above, for two patent rights to be considered to constitute double patenting, the scope of protection should be

a) identical? [YES/NO]

14 of the responding Groups stated YES (35%), while 26 Groups (65%) stated NO. Four (4) Groups refrained from a YES/NO answer. Thus, a minority of the Groups considered that the threshold for double patenting should be limited to identical claim scope.

The Groups that answered NO generally considered that a standard limited to strict identity would be too narrow, as it would allow applicants to circumvent the prohibition through trivial or inconsequential amendments to claim wording without any meaningful technical distinction. Several Groups noted that minor reformulations of claims could effectively defeat the prohibition on double patenting if only literal identity were required.

The Groups that answered YES generally considered that the prohibition on double patenting should be limited to cases of strict identity of claim scope, in order to

preserve legal certainty and avoid over-broad restrictions on legitimate claim differentiation. For example, the German Group stated that "identical" should be understood as "technically identical, i.e. conferring the same scope of protection even if not expressed in exactly the same wording", and that a "substantially identical" test "is inherently vague, would reduce predictability, and risks inconsistent outcomes and increased disputes". The Swiss Group similarly noted that the prohibition should apply "where the same applicant seeks protection for the same subject-matter", understood as requiring identity of the claimed subject-matter rather than a broader standard.

The Groups that answered NO generally considered that a standard limited to strict identity would be too narrow, as it would allow applicants to circumvent the prohibition through trivial or inconsequential amendments to claim wording without any meaningful technical distinction. Several Groups noted that minor reformulations of claims could effectively defeat the prohibition on double patenting if only literal identity were required.

b) identical or substantially identical? [YES/NO]

21 of the responding Groups stated YES (55%), while 19 Groups (45%) stated NO. Four (4) Groups refrained from a YES/NO answer. Thus, a majority of the Groups favoured the standard of "identical or substantially identical" as the threshold for double patenting.

The Groups that answered YES generally considered that a standard limited to strict identity would be too narrow, as it would allow applicants to circumvent the prohibition through trivial or inconsequential amendments to claim wording without any meaningful technical distinction. For example, the Swedish Group noted that "a standard limited to strict identity of claim scope would be too narrow,

as it would permit applicants to circumvent the prohibition through trivial or inconsequential amendments to claim wording without any meaningful technical distinction", and that the Swedish approach requires a "reasonable technical difference" between the inventions claimed. The UK Group stated that "the restrictions on double patenting should be narrow: they should prevent an applicant obtaining multiple co-extensive monopolies for exactly the same invention", and that "limiting double patenting to identical or substantively identical scope provides legal certainty and avoids overreach". The Chilean Group noted that "whether there is a double patenting issue is clearly in our opinion a matter of identical claim sets (or drawings)". The Chinese Taipei Independent Members stated that "a harmonised approach should focus on whether the claims are identical or substantially identical in scope" and cautioned that "extending the doctrine to non-obviously distinct inventions may introduce uncertainty and overlap with inventive step analysis". The Japanese Group noted that "not only the acquisition of identical patent rights, but also the acquisition of substantially identical patent rights need to be prohibited" in order to avoid the disadvantages of double patenting.

The Groups that answered NO were divided between those preferring a stricter standard (identical only) and those preferring a broader standard (including non-obviously distinct). The Groups preferring a stricter standard considered that "substantially identical" is inherently vague and would reduce predictability. The Groups preferring a broader standard considered that the "identical or substantially identical" threshold would still allow applicants to obtain multiple patents for claims that are obvious variations of one another.

c) identical or substantially identical or non-obviously distinct? [YES/NO]

4 of the responding Groups stated YES (10%), while 36 Groups (90%) stated NO. Four (4) Groups refrained from a YES/NO answer. Thus, a large majority of the Groups rejected the extension of the double patenting threshold to claims that are "non-obviously distinct".

The Groups that answered YES generally considered that the prohibition should extend to claims that are not patentably distinct from one another, even if they are not strictly identical or substantially identical. For example, the US Group stated that "double patenting should be defined to protect against a patentee receiving multiple independent patents covering subject matter that is identical, substantially identical and obvious variations to the subject matter of the patentee's prior patent(s)". The Singaporean Group noted that "non-obviously distinct" means that the two patents are not patentably distinct, and that in such a case "there is a good chance both patents would still be considered as relating to the same invention".

d) other? [YES/NO]

A small number of Groups considered that alternative thresholds should apply. For example, some suggested that the threshold should be assessed on a case-by-case basis taking into account the specific circumstances of the patent family, while others proposed that the standard should focus on whether the claims confer the same scope of protection in practice, regardless of their literal wording.

29) When determining whether a patent application would constitute double patenting, should there be restrictions on the legal status of the "other patent" to which the double patenting is compared to? [YES/NO] Please provide a brief explanation.

27 of the responding Groups stated YES (60%), while 16 Groups (40%) stated NO. One (1) Group refrained from a YES/NO answer. Thus, a large majority of the Groups

considered that there should be restrictions on the legal status of the "other patent" to which the double patenting is compared.

The Groups that answered YES generally considered that the double patenting assessment should only be made against rights that have reached a certain legal status, in order to ensure legal certainty and avoid premature or speculative objections. Several Groups noted that comparing a pending application against another pending application whose claims may still change during prosecution would create undue uncertainty. For example, the Swedish Group noted that "the assessment of double patenting should take into account the legal status of the reference right and a patent application should not be refused on the basis of double patenting relative to an earlier right that has lapsed or been invalidated". The Japanese Group stated that "the 'other patent' needs to be a valid patent. When it is a valid patent, the scope of its rights can be identified, making it possible to compare and determine whether a patent would be identical or substantially identical to the other". The UK Group similarly considered that "double patenting should only be assessed by reference to a legally effective right from the same applicant having the same priority date — whether a pending application or a granted patent".

The Groups that answered NO generally considered that the prohibition on double patenting should apply regardless of the legal status of the other right, as the policy rationale for preventing duplicative protection applies equally whether the conflicting right is granted, pending, or lapsed. Several Groups noted that restricting the assessment to granted rights only would allow applicants to circumvent the prohibition by maintaining overlapping applications in a pending state.

30) Irrespective of your answer to question 29) above, if such assessment was to be made:

a) Should double patenting be assessed against granted rights? [YES/NO]

43 of the responding Groups stated YES (95%), while 1 Group (5%) stated NO. Thus, a large majority of the Groups considered that double patenting should be assessed against granted rights.

The Groups that answered YES generally considered that granted rights represent the clearest and most appropriate benchmark for the double patenting assessment, as their claim scope is definitively established. For example, the German Group noted that double patenting should be assessed "against granted rights", "using the granted scope as the stable reference at the relevant time of examination/decision". Several Groups emphasized that assessing double patenting against granted rights is the most straightforward and least controversial application of the prohibition.

The Groups that answered NO generally considered that limiting the assessment to granted rights alone would be insufficient, as it would not address situations where overlapping applications are simultaneously pending.

b) Should double patenting be assessed against published applications? [YES/NO]

29 of the responding Groups stated YES (65%), while 15 Groups (35%) stated NO. Thus, the majority of the Groups considered that double patenting should be assessed against published applications.

The Groups that answered YES generally considered that published applications, while not yet granted, disclose a claim scope that is sufficiently defined to permit a meaningful double patenting assessment. Several Groups noted that failing to

assess double patenting against published applications would allow applicants to maintain overlapping claims across multiple pending applications without consequence until grant.

The Groups that answered NO generally considered that published applications do not provide a sufficiently stable basis for the double patenting assessment, as their claims may still be amended during prosecution. For example, the German Group noted that "published applications should not be used as a reference, because their claims and scope are not final and may change substantially during prosecution, making any comparison unreliable". Several Groups emphasized that assessing double patenting against published applications would create procedural complications and could unduly restrict applicants' ability to pursue legitimate claim strategies during prosecution.

c) Should double patenting be assessed only against rights that are in force (not lapsed or invalidated)? [YES/NO]

25 of the responding Groups stated YES (60%), while 19 Groups (40%) stated NO. Thus, a majority of the Groups considered that double patenting should be assessed only against rights that are in force.

The Groups that answered YES generally considered that once a right has lapsed or been invalidated, it no longer confers any exclusive protection and therefore cannot give rise to the concerns underlying the prohibition on double patenting. For example, the Swedish Group noted that "a lapsed or invalidated right no longer confers exclusionary effect and should therefore not constitute an obstacle to the grant of a new right". Several Groups emphasized that requiring the other right to be in force ensures that the double patenting assessment remains focused on actual, rather than theoretical, overlaps in protection.

The Groups that answered NO generally considered that the double patenting prohibition should apply regardless of whether the other right is currently in force, as the prohibition serves broader systemic purposes beyond preventing concurrent enforcement. Several Groups noted that allowing an applicant to obtain a second patent for the same invention after the first has lapsed would effectively permit an extension of the patent term, which is precisely one of the harms that the prohibition on double patenting is designed to prevent.

d) Should double patenting be assessed only between the same type of rights (e.g., patent application to patents, utility model application to utility models, etc.)? [YES/NO]

18 of the responding Groups stated YES (40%), while 26 Groups (60%) stated NO. Thus, a large majority of the Groups considered that double patenting should not be assessed only between the same type of rights.

The Groups that answered YES generally considered that different types of rights protect different subject matter and are subject to different requirements, so that a meaningful comparison of claim scope can only be made between rights of the same nature. For example, several Groups noted that comparing a patent claim (which protects technical function) with a design patent claim (which protects aesthetic appearance) would be conceptually inappropriate, as the two types of claims are directed to fundamentally different aspects of a product.

The Groups that answered NO generally considered that the double patenting assessment should be capable of being applied across different types of rights, particularly where those rights effectively confer the same scope of protection. Several Groups noted that limiting the assessment to rights of the same type would create a loophole allowing applicants to obtain duplicative protection by filing for

different categories of rights covering the same subject matter.

e) Should other criteria apply? [YES/NO] Please provide a brief explanation.

As to question 30(e), 12 of the responding Groups stated YES (30%), while 32 Groups (70%) stated NO. Thus, a large majority of the Groups did not consider that other criteria should apply. The small number of Groups that answered YES proposed various additional criteria, including that the assessment should take into account the relationship between the applicants (e.g., whether they are the same entity or related entities) and the prosecution history of the respective applications.

The Groups that answered NO generally considered that the different nature and requirements of patents, utility models, and design patents justify differentiated criteria for assessing double patenting. Several Groups noted that design patents protect aesthetic appearance rather than technical function, and that the criteria for assessing whether two design patents cover the "same" subject matter are necessarily different from those applicable to patents and utility models.

31) Should the criteria for assessing double patenting be the same for patents, utility models, and design patents?

27 of the responding Groups stated YES (65%), while 15 Groups (35%) stated NO. Two (2) Groups refrained from a definitive YES/NO answer. Thus, a large majority of the Groups considered that the criteria for assessing double patenting should be the same for patents, utility models, and design patents.

The Groups that answered YES generally considered that the policy rationale underlying the prohibition on double patenting applies equally regardless of the type of right, and that applying different criteria would create unnecessary complexity and potential for circumvention. For example, the Swedish Group stated that "the same substantive criteria should apply when assessing double patenting

across all types of patent rights. While the formal requirements and protective scope of patents, utility models, and design patents may differ, the underlying policy concern is the same". The Japanese Group noted that "both of a patent right and a utility model right protect technology. Since the same product can be identified by identical claims in patent and utility model applications, the criteria for assessing double patenting should also be the same".

The Groups that answered NO generally considered that the different nature and requirements of patents, utility models, and design patents justify differentiated criteria for assessing double patenting. Several Groups noted that design patents protect aesthetic appearance rather than technical function, and that the criteria for assessing whether two design patents cover the "same" subject matter are necessarily different from those applicable to patents and utility models.

32) If a patent application is deemed to constitute double patenting, what measures should be available to resolve the issue?

a) Amend the claims of the patent application? [YES/NO]

All of Groups considered that amending the claims of the patent application should be available as a measure to resolve double patenting.

The Groups generally considered that claim amendment is the most natural and least disruptive remedy for double patenting, as it allows the applicant to differentiate the claim scope while retaining protection for the disclosed invention. For example, the German Group noted that "if by an amendment of the claims of the patent application a true distinction is possible, this can be a way to resolve the issue". Several Groups emphasized that this remedy preserves the applicant's substantive rights while addressing the policy concerns underlying the prohibition on double patenting.

b) Abandon the earlier patent right? [YES/NO]

35 of the responding Groups stated YES (80%), while 9 Groups (20%) stated NO. Thus, a majority of the Groups considered that abandoning the earlier patent right should be available as a measure to resolve double patenting.

The Groups that answered YES generally considered that the applicant should have the option to abandon the earlier right if it prefers to maintain the later application, as this provides flexibility in managing the patent portfolio while eliminating the overlap. Several Groups noted that this remedy may be particularly appropriate where the later application contains broader or more commercially relevant claims.

The Groups that answered NO generally considered that requiring or permitting abandonment of an earlier granted right would be disproportionate and could prejudice the applicant's legitimate interests, particularly where the earlier right has already been relied upon by third parties or has been the subject of licensing arrangements. Several Groups noted that claim amendment or terminal disclaimer would be less disruptive alternatives.

c) Terminal disclaimer? [YES/NO]

14 of the responding Groups stated YES (30%), while 30 Groups (70%) stated NO. Thus, a large majority of the Groups considered that a terminal disclaimer should not be available as a measure to resolve double patenting.

The Groups that answered NO generally considered that terminal disclaimers are an unfamiliar or inappropriate mechanism in their jurisdiction, or that they do not adequately address the underlying concern of duplicative protection. Several Groups noted that a terminal disclaimer only addresses the issue of patent term extension but does not resolve the problem of overlapping enforcement during the

period of concurrent validity.

The Groups that answered YES generally considered that a terminal disclaimer provides a pragmatic solution by ensuring that the later patent does not extend protection beyond the term of the earlier patent, thereby addressing the concern about unjustified extension of exclusivity while allowing the applicant to maintain both rights. Several Groups emphasized that this mechanism strikes an appropriate balance between the interests of the applicant and the public.

d) Other?

A small number of Groups proposed various additional measures, including: requiring the applicant to elect between the overlapping rights; imposing a declaration that the rights will not be independently enforced against the same alleged infringement; and permitting the patent office to refuse the later application ex officio where the overlap is identified during examination.

33) Should Resolution Q193 be considered sufficient for addressing harmonisation on divisional applications?

21 of the responding Groups stated YES (45%), while 23 Groups (55%) stated NO.

The Groups that responded with YES highlighted the importance of the principles set out in Resolution Q193 as a common ground. For example, the Italian Group pointed out that "resolution Q193 already provides comprehensive and balanced principles on divisional applications, including entitlement, timing and the relationship between parent and divisional filings". The Vietnamese Group stated that "resolution Q193 may be considered sufficient for addressing harmonisation regarding divisional applications. The Resolution sets out common principles and identifies key issues, so it may help to align national practices and reduce major divergences...". The Thai Group similarly answered in the affirmative, noting that the

existing resolution provides an adequate framework. The Argentine Group and the Austrian Group also considered Resolution Q193 sufficient, while the Chilean Group affirmed that the resolution addresses the key issues.

It should be noted that some Groups, while answering YES and acknowledging the usefulness of Resolution Q193, indicated that further improvements may be possible. Issues such as the definition of pendency, double-patenting and anti-abuse measures were mentioned by some Groups. More specifically, the Singaporean Group pointed out that "it is agreed that 'pendency' can be better defined to achieve greater harmonisation", while the Colombian Group pointed out that "further harmonisation is needed on the legal definition of pendency, and interaction between divisionals and double patenting". As another example, the Belgian Group pointed out that "it could be good to investigate whether possible instruments can be put in place at the patent offices avoiding clear abusive delays of the granting and opposition/appeal procedure…Such instruments should be investigated for both their positive and negative effects on the procedure before being implemented". The Norwegian Group, while answering YES, noted that "as regards how situations involving abuse should be handled, there are somewhat differing views within the group. While the majority of the group consider that such situations are best assessed under competition law, since it is usually necessary to view a pattern of conduct over time in context, one member believes that one possible measure could be to empower the patent authorities to issue decisions in application or opposition proceedings even where an application or patent is withdrawn by the rights holder".

The Groups that responded with NO to this question provided more details as to the aspects requiring further improvements.

One of the most frequently cited issues was the lack of a clear, universal definition of the "pendency" of a parent application. Numerous Groups stressed that the current ambiguity created legal uncertainty regarding the window during which a divisional can be filed, especially after actions like grant, refusal, or withdrawal. For example, the US Group pointed out that additional harmonisation should address "precise pendency definition including treatment of post-grant proceedings and grace periods". The Finnish Group stated that "there should be a clear and harmonised framework defining when the filing of further divisional applications is permitted, in particular with respect to the meaning of the term 'pendency'". The Chinese Taipei Independent Members similarly noted that Resolution Q193 "does not sufficiently address several important procedural aspects particularly regarding the permissibility of filing divisional applications during pendency such as the definition of pendency, the permissibility of cascading divisional applications". The Hungarian Group similarly emphasized the need for a clear definition, noting that there is a large number of jurisdictions without opposition proceedings, which could be seen as further complicating the interpretation of pendency across different legal systems.

The insufficiency of rules regarding double patenting was also frequently mentioned. For example, the Swiss Group stated that "it is fundamentally insufficient because it fails to address the critical substantive issue of double patenting. The resolution asserts that it should be possible to claim subject matter in a divisional that was disclosed in the parent application. However, it remains entirely silent on how patent offices should handle claim overlap or whether identical (or substantially identical) claims should be permitted across parent and divisional applications". The Mexican Group pointed out that "the resolution should be complemented to account for issues such as: the relationship between

divisional applications and double patenting, including how overlapping subject matter within the same family is assessed". The Egyptian Group emphasized the particularity of certain field by pointing out that "Q193 does not fully address the modern interplay between divisional applications and double patenting in digital and biotech sectors".

Rules regarding cascading divisionals were also called for. For example, the Spanish Group pointed out that "it remains to be seen until which point a divisional can be filed from a divisional, when the parent patent is already granted". The Egyptian Group pointed out that "while Resolution Q193 established fundamental principles for divisional applications, it is no longer sufficient due to emerging complex practices like 'cascading' divisional (divisional of divisional) and the strategic use of divisional to create legal uncertainty (submarine patents)".

Another commonly noticed problem was the lack of rules regarding abuse of divisionals. For example, the US Group stated that "Q193 did not address time limits on filings to prevent 'abuse', nor define what is considered 'abuse' in obtaining multiple overlapping divisional applications". The Indian Group stated that Q193 "leaves several operational and anti-abuse questions open". The Netherlands Group stated that "Q193 is not considered to be sufficient, as an anti-abuse measure is lacking in Resolution Q193" and proposed that "an anti-abuse measure should be subject of additional harmonisation, but the anti-abuse measure should not be in the form of a time limit. A competence should be assigned to the examiner, opposition division and/or Board of Appeal to refuse patent applications or patents in cases of abuse". The Paraguayan Group also considered Resolution Q193 insufficient, noting the need for additional provisions to address potential abuse of the divisional application system.

Apart from the above issues, the Mexican Group stated that the resolution should be complemented to account for "the different procedural contexts in which divisionals arise (e.g., voluntary vs. examiner-required) and their implications", and that "patent term considerations require greater flexibility than reflected in Q193. In particular, the term of a divisional application should not necessarily be rigidly tied to that of the original parent, and may require independent adjustment depending on the circumstances".

To be brief, while the Groups considered Resolution Q193 a helpful reference for harmonizing the mechanism of divisional applications, some potential supplements were proposed such as the definitions of pendency, special attention to double patenting in the examination of divisionals, and rules to prevent procedural abuse.

34) If your answer to question 33) above was NO, what kind of issues/aspects should in general be subject to additional harmonisation? Even if your Group would not prefer further harmonisation, please continue answering the questions below.

Analysis of the responses revealed a consensus among several participating Groups on the need for further international harmonisation concerning certain issues.

One of the most frequently cited issues was the lack of a clear, universal definition of the "pendency" of a parent application. Numerous Groups stressed that the current ambiguity created legal uncertainty regarding the window during which a divisional can be filed, especially after actions like grant, refusal, or withdrawal. For example, the US Group pointed out that additional harmonisation should address “precise pendency definition including treatment of post-grant proceedings and grace periods”. The Finnish Group stated that "there should be a clear and

harmonised framework defining when the filing of further divisional applications is permitted, in particular with respect to the meaning of the term 'pendency'". The Hungarian Group similarly emphasized the need for a clear definition, noting that there is a large number of jurisdictions without opposition proceedings, which could be seen as further complicating the interpretation of pendency across different legal systems.

Another prominent theme was the regulation of cascading divisionals and establishing safeguards against the abusive use of the divisional system. Several Groups were concerned about "submarine patents" and the indefinite extension of legal uncertainty for third parties. For example, the Turkish Group stated that "appropriate mechanisms should also be established to ensure legal certainty and to prevent the abuse of divisional applications through the creation of continuously pending patent applications". The Mexican Group pointed out that "harmonisation should include safeguards against potential abuses of the divisional system, while maintaining a balanced approach that preserves the applicant's ability to obtain appropriate protection for disclosed inventions. This includes providing clear rules for cascade divisionals and ensuring that the system supports legitimate protection strategies without enabling undue extension or fragmentation of rights". The Egyptian Group emphasized "regulating the practice of 'divisional of divisional' to ensure they do not indefinitely extend the period of legal uncertainty for third parties". Some Groups proposed limits on the allowable number of divisional applications. For example, the Korean Group called for regulations on "the timing for filing divisional applications, the allowable number of divisional applications, and appropriate measures to prevent abuse of the patent system through excessive divisional filings". On the other hand, the French Group called for more flexibility for a divisional of a divisional: "the filing of a divisional application should

be permitted at any stage of the procedure relating to the parent application from which the divisional application is to derive, independently of the status of any other application".

Furthermore, many Groups identified the need to harmonize the substantive standard for double patenting, particularly what constitutes "same subject matter" and how a double patenting issue can be overcome. For example, the Colombian Group was concerned about "treatment of parent–divisional overlap, ensuring distinct claim scopes and the possibility to remedy any double patenting issues". The Swiss Group stated that "harmonisation should aim to establish a narrow and objective prohibition on double patenting" and specifically proposed that "clear, harmonised rules are needed to confirm that partially overlapping claims (where one claim is broader than or encompassed by another) between a parent and a divisional are entirely permissible and do not constitute double patenting". The Mexican Group noted that "the relationship between divisional applications and double patenting should be clarified, including how overlapping subject matter within the same family is assessed and which corrective mechanisms (e.g., amendment, abandonment, terminal disclaimer) are available".

Regulations on the side of the patent-granting authorities also received attention. Several Groups highlighted the need for examination coordination within the same patent families. For example, the Spanish Group mentioned "synchronization and/or joint examination of the different divisionals". The Brazilian Group pointed out that further harmonisation should address "examination coordination within families". The US Group noted that additional harmonisation should address "examiner coordination and consistency". Some Groups were concerned about the pace of examination of divisional applications. For example, the French Group

called for rules specifying “how patent-granting authorities should accelerate publication, examination, and decisions on divisional applications”. The US Group noted that “delayed examination availability” should be addressed.

Moreover, some Groups raised points that were less common but nonetheless reflected noteworthy concerns. For example, the US Group additionally mentioned the issue of whether prosecution history estoppel should have binding effect in divisionals. The Mexican Group called for differentiation between different types of divisionals: “it should differentiate between types of divisional filings, particularly voluntary divisionals versus those filed in response to unity objections, including the applicable time limits and procedural requirements".

To sum up, the responding Groups expressed interest in further international harmonisation on issues like the clear definition of "pendency," safeguards against abusive cascading divisionals, and consistent standards for double patenting. Additionally, the responses highlighted the necessity for coordinated examination procedures among patent-granting authorities, while opinions remained divided on balancing stricter limits with procedural flexibility.

35) With reference to Resolution Q193, item 3, according to which "The filing of divisional applications should be permitted at any time during the pendency of a parent application", how should "pendency" be legally defined to guide filing timelines? One may select multiple answers

a) Should pendency include time preceding the grant of the original parent application?

b) Should pendency include time preceding first instance opposition decision of the original parent application?

c) Should pendency include time preceding decision on opposition appeal of the original parent application?

d) Other?

As to option a), i.e., whether pendency should include the time preceding the grant of the original parent application, 43 of the responding Groups stated YES (95%), while 1 Groups (5%) stated NO. Thus, a near-unanimous majority of the Groups considered that pendency should include the time preceding the grant of the original parent application.

The Groups that answered YES generally considered that until the original parent application is granted, the applicant does not have certainty about the granted subject matter and must retain the ability to file divisional applications to pursue additional subject matter. For example, the German Group explained that "until the original parent application is granted the applicant does not have certainty about the granted subject matter. Only based on the granted subject matter, the applicant can decide whether an additional patent application is required to cover the subject matter of the full disclosure of the application". The Mexican Group explained that "'pendency' should primarily be defined as the period …… up to, but not including, its grant, as this is the stage during which the applicant retains procedural control to pursue additional subject matter through divisional filings. In addition, pendency should include any post-allowance but pre-grant phase, such as the period for completing grant formalities (e.g., payment of fees), during which the grant has not yet taken legal effect and the applicant may still need to adjust the scope of protection".

However, there seemed to be different interpretations of the wording "the original parent application". Some Groups understood it as referring to the very first, original

application, while others understood it as the one from which the divisional application is directly derived. For example, the Spanish Group gave different answers under different interpretations: "NO. The parent (original) patent should not be referred to. YES. Pendency must include the time preceding the resolution (grant/refusal) of the mother patent on which the divisional is based". The French Group answered "YES, considering that the expression 'original parent application' concerns the parent application from which the divisional application directly derives". The Mexican Group explained that "'pendency' should primarily be defined as the period from filing of the previous application (the one immediately preceding, not the original parent application)".

As to options b) and c), i.e., whether pendency should include the time preceding a first instance opposition decision and/or the time preceding a decision on an opposition appeal of the original parent application, the responses to both sub-questions were closely split: To option b, i.e., whether pendency should include time preceding first instance opposition decision of the original parent application, 21 of the responding Groups (45%) stated YES, while 23 of the responding Groups (55%) stated NO. Whereas to option c, i.e., whether pendency should include time preceding decision on opposition appeal of the original parent application, 20 of the responding Groups (45%) stated YES, while 24 stated NO (55%). Thus, a majority of the Groups considered that pendency should include neither the time preceding a first instance opposition decision nor the time preceding a decision on an opposition appeal of the original parent application.

First of all, some Groups proposed that, as opposition proceedings are not available in all jurisdictions, a definition of this term should first be established. The Hungarian Group mentioned "there is a large number of jurisdictions without opposition

proceedings". The Indian Group seemed to understand "opposition" as referring to a pre-grant proceeding, and answered YES to option b) with a comment "only if this is a pre-grant opposition" and NO to option c). The Brazilian Group, while answering YES to both options b) and c), also seemed to understand "opposition" as a pre-grant proceeding. This Group explained "pendency should extend at least until publication of the decision granting the patent or confirming the rejection after exhaustion of administrative appeals. Only once no further administrative appeal is available should the application cease to be considered pending".

The Groups that answered NO generally considered that extending pendency into opposition or appeal proceedings would create loopholes for applicants to indefinitely delay the finalization of their patent scope, thereby undermining legal certainty for competitors and the public. For example, the German Group explained that "after the grant, the legitimate interest of the patent owner in receiving protection for subject matter of the full disclosure of the patent application has to be weighed against the legitimate interest of the public to have legal certainty. The patent owner knows the prosecution history, potentially from several parallel proceedings, and hence can decide based on this information whether to file divisional applications during the pendency of the parent application. Extending the right to file divisional applications to the time preceding the first instance opposition decision would allow to extend legal uncertainty without justification". The Turkish Group stated that "allowing divisional filings post-grant such as during opposition proceedings severely undermines legal certainty for third parties. Once the parent patent is granted and published, competitors and the public must be able to rely on the finality of the prosecution phase regarding that specific disclosure. Reopening the protective scope through divisionals during an opposition phase would create an unpredictable and unbalanced patent

landscape". The Swedish Group pointed out that "allowing the filing of continuations during opposition proceedings would severely affect a third party's ability to invalidate a patent that should not have been granted, and would therefore render opposition proceedings more or less useless". The Australian Group pointed out a specific example of uncertainty: "for example, an applicant may have a related party commence an appeal purely in order to deter competitors by creating a situation where it is possible that a divisional could be filed, without having to actually file a divisional application". The Singaporean Group noted that "the advantage of not allowing divisionals to be filed during those periods could prevent the patentee filing 'precautionary' divisionals or misusing the system, but yet we should not penalize legitimate users of the divisional system". The Polish Group suggested additional procedural provisions to achieve a better balance: "allowing divisional application during contradictory phase of the proceedings complicates the process unproportionally to the advantages to the flexibility of seeking justified protection allowed by this institution. Procedural provisions should be introduced/maintained, which allow for maintaining the broadest possible scope of protection to the patentee by waiving normally applicable formal requirements (such as waiving the unity of the patent requirement in case of limitations resulting in such lack of unity during opposition, etc.)".

The Groups that answered YES generally attached great importance to ensuring the applicant's right to pursue subject matter disclosed and to make necessary adjustments. For example, the Korean Group stated that "pendency should be defined as extending until the final status of the application is definitively determined, including opposition and appeal proceedings, in order to allow applicants sufficient opportunity to adjust the scope of protection".

As to option d), 8 of the responding Groups stated YES (20%), while 36 Groups (80%) stated NO. Two (2) Groups refrained from a YES/NO answer. The Groups that selected this option provided additional proposals. For example, the Indian Group suggested that the pendency should last until "six months from the issuance of the first office action". The French Group was concerned about the timing of filing cascading divisional applications: "in the case of cascading divisional applications, the time period for filing a new divisional application should depend only on the period during which a previous divisional application, from which the new divisional is to derive, is pending, independently of the legal status of other applications, in particular a parent application of the previous divisional application". The Mexican Group, while generally holding the opinion that pendency should not extend into opposition proceedings or appeals, seemed to believe that exceptions can be made: "limited flexibility may be justified in specific circumstances, particularly where opposition proceedings reveal the need to pursue distinct subject matter. Even in such cases, any extension of pendency should be narrow and carefully controlled, and in some views only allowed if expressly ordered by the competent authority". The Italian Group, the UAE Group, the Spanish Group and the Egyptian Group were concerned about the scenario where the parent application is rejected. For example, the UAE Group stated "pendency should also include the time preceding a final rejection decision of the examination procedure. If the parent application is rejected, the applicant should be able to file a divisional up until the final administrative decision is issued". The Italian Group noted "in case of refusal patent application, the application is considered to be pending until the expiration of the time limit to file the appeal". The Spanish Group proposed to include "appeals wherein the Appeals Unit/Division refers back the application to the Examination Division for re-examination".

The Japanese Group, although it had not selected option d), also commented in detail on the scenario of rejection: "when an appeal is filed against a decision to reject the application, it often takes long time to conclude it; and if filing a divisional application were allowed in response to the outcome of the appeal, the period during which a divisional application could be filed would become unduly long in view of legal certainty for third parties. Therefore, division of the application should not be allowed after conclusion of the appeal against a decision of rejection".

To sum up, most Groups agreed that pendency should include the time before the original parent application is granted, though interpretations of "original parent application" varied. However, opinions were divided on whether pendency should extend through opposition or appeal proceedings, with significant concerns raised about legal certainty for third parties versus the applicant's right to pursue disclosed subject matter.

36) Should there be a limit on the number of divisional applications? You may add a brief explanation.

Almost all Groups (95%) agreed that there should not be a limit on the number of divisional applications.

The primary justifications for rejecting a numerical limit included accommodating the complexity of modern inventions, preserving applicants' substantive rights to protect all originally disclosed inventions, and relying on objective legal safeguards rather than arbitrary administrative quotas. For example, the US Group outlined that "modern complex inventions may legitimately require numerous divisionals" and "appropriate universal numerical limit is impractical". Based on a similar rationale, the French Group commented that protection should be obtainable "for all inventions described in the parent application, whatever their number". The Swiss

Group further indicated that a rigid cap would force an applicant to "forfeit their legitimate intellectual property rights simply because the number of distinct inventions exceeds an arbitrary administrative quota". The Peruvian Group similarly opposed a numerical limit, noting that such a restriction would create additional difficulty for applicants seeking to protect complex inventions with multiple disclosed embodiments.

In addition, the majority of the Groups believed that statutory or procedural controls are more pragmatic tools instead of numerical caps. Specifically, the Brazilian Group argued that control should be exercised through "objective legal criteria, such as pendency, compliance with the original disclosure and unity of invention". In addition, the Korean Group indicated the alternative measures such as "differentiated fee structures for successive divisional filings". A similar position was suggested by the Chinese Group, which highlighted the possibility of implementing a "progressive fee system".

While responding "Maybe YES," the Vietnamese Group took the view that a limit "may prevent abuse of the patent system".

37) Should it be possible to file a divisional application:

a) Only based on another divisional application;

b) Only based on the parent application;

c) Based on divisional application or parent application.

You may add a brief explanation.

41 of the responding Groups selected option (c) (95%), i.e., that it should be possible to file a divisional application based on a divisional application or a parent application. 2 Groups (5%) selected option (b), i.e., that a divisional application

should only be filed based on the parent application. No Group selected option (a). Two (2) Groups refrained from answering. Thus, a near-unanimous majority of the Groups considered that it should be possible to file a divisional application based on either a divisional application or a parent application.

The primary justifications for permitting cascading divisional applications included providing applicants with procedural flexibility and accommodating the practical realities of examination timing and subsequent lack of unity objections. The Argentine Group similarly supported this flexibility, considering that applicants should retain the ability to file divisional applications based on either a parent application or a prior divisional application.

Among those advocating for this flexibility, the Korean Group underscored that option c) allows "flexibility in managing and developing a patent portfolio". Regarding the examination realities, the US Group outlined that "if an examiner issues a unity objection in a divisional or a continuation, the applicant must be able to file a further divisional". Complementing such rationale, the Swiss Group emphasized that by the time such "nested unity objections" arise, "the original parent application has often already granted and closed", meaning applicants would "risk unfairly losing protection for valid inventions simply due to examination timing" if restricted solely to the original parent.

When evaluating the drawbacks of the option b) approach, the German Group highlighted that restricting filings to only the parent application might "decrease legal certainty for third parties" due to the increasing number of pending divisional applications, and "'disfavor' small/medium-sized enterprise applicants". The Finnish Group further indicated that restricting the permissible basis to only one option "would undermine the principles established in Resolution Q193".

On the other hand, the Chinese Group leaned toward option b) as a general principle, and argued that cascading divisional applications "generally cannot be filed" to prevent the "divisional chain" from being "lengthened artificially and indefinitely". Meanwhile, this Group carved out an exception for those divisional applications that "specifically identified as having unity issue while the parent application is closed".

38) Should a divisional application be filed based on another divisional application when the parent application has already been allowed? You may add a brief explanation.

A majority of Groups (85%) agreed that it should be possible to file a divisional application based on another divisional application even when the original parent application has already been allowed, provided that the new divisional application itself independently satisfies the relevant statutory requirements.

In addition to emphasizing the need for procedural flexibility and the handling of late-stage unity objections as suggested for Question 37, the prevailing view was that the right to file further divisional applications should depend solely on the status of the immediate parent application.

In this regard, the Finnish Group indicated that the relevant criterion "should be the pendency of the immediate parent divisional, not the ultimate parent application". Supporting this view, the UAE Group explained that this approach created a "chain of pendency", where each divisional becomes independent upon filing, with its status "determined by its immediate parent application rather than the original application". Adding another practical perspective, the Mexican Group noted that the prosecution of subsequent divisional applications may "reveal distinct subject matter that was not fully addressed at the stage when the original parent

application was allowed", a situation that the German Group attributed to the fact that such distinct inventions "may not be known at the time of filing the divisional application as no search has been performed".

While agreeing in principle, some Groups introduced specific conditional safeguards to prevent abuse. For instance, the Vietnamese Group suggested imposing conditions such as "reduced examination time, limited number of divisionals." Similarly, the Russian Group underscored the need for "certain exceptions", and required that "all the prosecution history should be transparent and the information on all the divisional applications should be available and immediately published and all the applications should be linked with each other".

Conversely, a minority of Groups (15%) rejected this possibility to prioritize legal certainty and public expectations. Advocating for this restriction, the Egyptian Group argued that a new divisional chain "cannot be initiated if the original parent has already been granted", as prohibiting this practice prevents the "unjustified extension of the examination process" and protects "the interests of third parties regarding the final scope of protection". The Malaysian Group similarly opposed this possibility, maintaining that "no further divisional should be permitted once the parent has been granted". Consistent with their stance in the previous question, the Chinese Group generally believed that such filings should not be permitted upon the grant of the parent, maintaining their exception solely for cases where the pending divisional application "has been identified as lacking unity by the examiner".

39) When a lack of unity objection is issued by the examiner of a patent application:

a) Should the applicant be required to file all the divisional applications of interest at that moment: YES/NO
b) Should it be possible to file a single divisional containing more than one invention: YES/NO

For question a), 8 of the responding Groups stated YES (20%), while 33 Groups (80%) stated NO. One (1) Group refrained from a YES/NO answer. Thus, a large majority of the Groups considered that the applicant should not be required to file all the divisional applications of interest at the moment a lack of unity objection is issued.

The Groups that answered NO generally considered that divisional applications should be allowed at any time while the parent application is pending, not just at a single moment. They believed that applicants need flexibility to adapt to prosecution developments, commercial strategies, and prior art. For instance, the Australian Group stated "claim scope can shift during prosecution in light of commercial considerations and prior art searching". The Chinese Group deemed "the option a is too demanding for the applicant. It may harm the applicant's legitimate interests if requiring the applicant to file all proposed divisional applications at once, given the uncertainty of the office actions, and the fact that the applicant may have legitimate filing strategies and financial circumstances of their own". The Portuguese Group also pointed out that the decision of what are the divisional applications to be filed "should take into consideration market inputs, which may not be available to the applicant at this point. Moreover, in order to assess whether an invention is of interest, receiving information from the search report for said invention is relevant". The Japanese Group stated "to file all the relevant divisional applications in response to the rejection notice could increase costs".

Among the Groups that answered YES, the Indian Group explained that "this depends on the objection of the controller" and "the answer is not black and white". This is because the applicant may be able to justify that the claim groups identified by the examiner have the same inventive concept, and/or new unity issue may be identified during examination.

For question b), 36 of the responding Groups stated YES (85%), while 6 Groups (15%) stated NO. Two (2) Groups refrained from a YES/NO answer. Thus, a large majority of the Groups considered that it should be possible to file a single divisional containing more than one invention.

Among the Groups answering YES, the German Group explained "it is often uncertain whether the divisional application includes more than one invention at the time of its filing". In addition, a few Groups emphasized the importance of procedural flexibility for applicants. For instance, the Japanese Group stated "this allows applicants to file cascading divisional applications and obtain rights flexibly depending on the status of the application being examined", and the Mexican Group deemed "this approach balances procedural flexibility for applicants with legal certainty for third parties". A few Groups also proposed that, even if a single divisional application contains more than one invention, the patent office still have the chance to issue a new lack of unity objection later and require further division. For example, the French Group stated "the claimed invention should satisfy the unity-of-invention criterion and, if that criterion is not met on the filing date, the applicant should be able to amend the application to resolve the issue and, if it so wishes, file new divisional applications".

Among the Groups that answered NO, most of them concentrated on the primary purpose of the requirement for unity of invention. For example, the Vietnamese

Group stated "filing a single divisional containing more than one invention would defeat the purpose of the requirement for unity of invention", and the Egyptian Group also mentioned that "a divisional application should not contain more than one invention, as this would contradict the primary purpose of filing a divisional to resolve a lack of unity objection".

40) Should the examiners be permitted to issue lack of unity objections in divisional applications, thus, allowing the applicant to further divide a divisional application with a lack of unity issue when the main (parent) application has issued? You may add a brief explanation.

43 of the responding Groups stated YES (95%), while 1 Group (5%) stated NO.

Many of the Groups answering YES considered that every application should independently comply with the requirement of unity of invention, and divisional applications should be no exception. For instance, the French Group stated "each application should comply with the unity-of-invention criterion". The Swedish Group stated "the system should work the same regardless of what generation of application the application to be examined is". The Philippine Group also mentioned "allowing such objections preserves the integrity of the unity of invention requirement and ensures that each application is examined in accordance with standards of examination practices".

The Portuguese Group and the Mexican Group specifically mentioned that the original unity may change during the prosecution because of further search or claim limitations. As stated by the Mexican Group, "the system should allow further division at this stage to ensure that applicants can still pursue protection for all disclosed inventions, notwithstanding the status of the original parent application".

Only the Malaysian Group deemed that "no further divisional should be permitted once the parent has been granted", and hence answered NO. Although the Egyptian Group answered YES to the question, it also mentioned "the applicant should not be permitted to further divide that divisional application once the parent application has been allowed", as the allowance of the parent application indicates the termination of its pendency.

41) Should applicants be required to justify the legitimate need for division at the time of filing?

A large majority of the responding Groups stated NO (90%), with only 3 Groups (10%) stating YES.

Among the Groups that answered NO to this question, most stated that the requirement of justifying the legitimate need for filing a divisional application will pose an additional burden on applicants, or "create additional difficulty", as said by the Peruvian Group. Some Groups were concerned that such a requirement may introduce uncertainty. As stated by the Brazilian Group, "requiring a 'legitimate need' justification risks uncertainty and discretionary barriers; objective criteria (pendency, support, unity, fees) are preferable". Furthermore, some Groups mentioned that it is detrimental to the applicant's patent portfolio, especially considering that patents or divisional applications are, in fact, tools allowed by the law for protecting inventions. The Swedish Group also considered the confidentiality, mentioning that "a requirement would potentially also risk of the applicant needing to disclose business intelligence on coming actions or strategy".

Among the Groups that answered YES, the Philippine Group stated that "providing such justification would promote transparency, discourage strategic or abusive

use of divisional, and help ensure that the divisional system serves its intended procedural purpose rather than creating unnecessary uncertainty for third parties".

42) Should a family of parent and divisional applications be examined by the same examiner?

33 of the responding Groups stated YES (75%), while 11 Groups (25%) stated NO.

Among the Groups that answered YES, the responses were primarily based on two aspects: efficiency and consistency. First, some mentioned that it may reduce the evaluation time and ensure efficiency, such as the French Group, which said that "this generally makes it possible to accelerate the procedure for publication and grant of the patent resulting from the divisional application", as the UAE Group mentioned that "the examiner is already familiar with the subject matter and prosecution history". The Australian Group further noted that "in principle this is efficient, so long as this does not cause more of a backlog within the examining body". The Norwegian Group similarly supported this approach, noting that having the same examiner ensures consistency and reduces the risk of double patenting within the same patent family. In terms of consistency, most Groups that answered YES believed that this approach may ensure consistency in claim construction and prevent conflicting decisions within the patent family.

Among the Groups that answered NO to this question, the Turkish Group noted that "assigning the same examiner could introduce bias or limit the diversity of technical perspectives". It should be noted that, according to these Groups' specific comments, some of them actually did not deny that having the applications examined by the same examiner or handled via coordination delivered positive effects to some extent. Their concern was that this approach should not be mandatory.

To sum up, a large majority of the Groups believed that this approach was ideally correct as it enhances efficiency, enables better examination coordination, and reflects the inseparable nature of parent and divisional applications.

43) When filing a divisional application, should the applicant be required to explain the relationship between the claimed technical solution in the divisional claims and the parent claims?

A large majority of the responding Groups (36) stated NO (80%), while 8 Groups (20%) stated YES.

Most Groups held that it is unnecessary to provide additional restrictions or constraints regarding the filing of divisional applications. Specifically, some Groups mentioned that the requirement would create difficulties, for example, as the German Group stated that "providing an explanation would not serve a purpose that would outweigh the practical difficulties", while the Swedish Group even pointed out that "a mandatory explanatory statement would add formality without clear benefit". Several Groups emphasized that the relationship should be assessed by the examiner during examination, as the Spanish Group said that "the examiner may request further information to identify the relationship between the technical solution claimed in the divisional and the parent claims, but the burden should not fall on the applicant". The US Group also noted that "claims may be amended during prosecution and the relationship thereafter change", which implied that the determination of the relationships should be conducted dynamically.

For those Groups that answered YES, the Japanese Group mentioned that such an explanation is helpful for the examiner, and its jurisdiction already imposes a similar requirement. The Polish Group held that "requiring the applicant to explain the relationship between the technical solution claimed in the divisional application

and the claims of the parent application would increase transparency and legal certainty for third parties and for the Office". As can be seen, those Groups mainly believed that such a requirement could make the relationship clearer, thus increasing the transparency and examination efficiency.

44) Should prosecution history estoppel from parent applications be binding on divisional applications?

27 of the responding Groups stated NO (60%), while 17 Groups (40%) stated YES. Thus, a majority of the Groups did not support prosecution history estoppel from parent applications being binding on divisional applications. Among the Groups that selected YES, such as the Chilean Group, it was considered prosecution history estoppel from parent applications should be binding on divisional applications as it would ensures consistency and prevent applicants from recapturing subject matter surrendered during prosecution of the parent.

Among the Groups that selected NO, the Colombian Group explained that "since the embodiments are already different, and the main focus of the applications is not the same, the history estoppel from the parent application should not be considered for prosecution of the divisional".

45) Should the prosecution period of divisional applications be limited?

10 of the responding Groups stated YES (20%), supporting the introduction of limitation on the prosecution period of divisional applications. In comparison, 34 Groups (80%) stated NO, opposing such a limitation.

The Groups that answered YES offered various justifications for limiting the prosecution period of divisional applications. Their reasoning generally centered on three key concerns: ensuring legal certainty for third parties, preventing strategic delay, and promoting procedural efficiency. For example, the UAE Group

acknowledged the need for balance, noting that "limiting the prosecution period of divisional applications helps prevent undue delays, reduces legal uncertainty, and avoids potential abuse through prolonged pendency, thereby supporting a more efficient and balanced patent system." Similarly, the Portuguese Group emphasized the need to safeguard legal certainty and prevent undue extension of procedural pendency, and pointed out that "an unrestricted ability to pursue divisional applications over prolonged periods may create persistent uncertainty for third parties and enable strategic behavior aimed at delaying final resolution of the scope of protection." The Philippine Group stated that "clear temporal limits promote procedural discipline, examination efficiency, and predictability in the patent landscape." The Polish Group proposed that "a genuine fast-track procedure, including accelerated examination for all pending members of a patent family once a divisional application has been filed, would reduce opportunities for strategic delay while still preserving the legitimate use of divisional applications in appropriate cases."

The Groups that answered NO generally held that divisional applications should be treated as ordinary, independent patent applications and not be subject to special time limitations beyond those already applicable to regular applications. For example, the US Group noted that "the term of the patent is generally limited to twenty years from the earliest claimed priority application, which can act as a natural limit on the prosecution period." The French Group cautioned against introducing time limits and argued that "this would probably have the effect of multiplying the number of precautionary divisional applications filed. Indeed, an applicant could be led to file a second precautionary divisional application before the end of that period where examination of the first divisional application does not result in the grant of a patent that the applicant considers satisfactory." The

Swedish Group pointed out that "there should be no special fixed prosecution time limit applicable only to divisional applications. Delay concerns are better addressed through existing procedural mechanisms and general case-management tools rather than through rigid special deadlines that may prejudice legitimate applicants". It also raised practical concerns for industries with long R&D cycles and delayed market entry due to regulatory requirements, noting that "for many industries, especially those with long R&D cycles and market entry that is significantly delayed by regulatory requirements, a fixed time limit for divisional applications would create a substantial practical burden. It could force applicants to make strategic decisions prematurely, before the commercial or regulatory landscape is sufficiently clear."

Thus, the vast majority opposed imposing special limitations on the prosecution period of divisional applications, arguing that divisional applications should be treated as independent applications subject to the same rules as ordinary patent applications, and that any delay concerns are better addressed through procedural efficiency measures (such as expedited examination) rather than applying time limits. A minority supports such limitations, primarily out of concern for legal certainty and the prevention of strategic delay, emphasizing the need to protect third parties from prolonged legal uncertainty and to prevent the abuse of procedural tools to keep applications pending for strategic reasons.

46) Should delayed examination be allowed for divisional applications?

22 of the responding Groups stated YES (50%), supporting the allowance of delayed examination for divisional applications, while 22 Groups (50%) stated NO, opposing such a mechanism.

The Groups that answered YES generally viewed delayed examination as a legitimate tool of procedural flexibility that allows applicants to better manage their patents and align prosecution strategies with commercial needs. Some Groups believed that allowing delayed examination of divisional applications benefits applicants by enabling them to comprehensively reference the entire prosecution history of the parent application, thereby optimizing their patent portfolio strategies. For example, the Japanese Group provided a practical scenario: "If a divisional application is filed in conjunction with an appeal against a decision to reject the application, it will be preferable to examine it based on the results of the appeal or reconsideration by examiners before appeal proceedings of the original application. In this case, applicants will be able to develop a more efficient and effective filing strategy if they know the results of the appeal." The Korean Group pointed out that "divisional applications may serve as fallback positions, and it is beneficial to consider the outcome of the parent application during their prosecution." The Canadian Group supported delayed examination for divisional applications in order to "enable optimization of patent strategy and claim scope."

Some Groups also suggested that the use of delayed examination should be prudent. For example, the Portuguese Group noted that "such a mechanism should be subject to clear temporal limits and procedural safeguards in order to prevent strategic delays that could prolong legal uncertainty for third parties." The US Group pointed out that "applicants may have legitimate business or financial reasons to delay examination", and added that "safeguards may be imposed by courts against the enforcement of patents obtained through illegitimate, abusive delays."

The Groups that answered NO generally considered that delayed examination for divisional applications could facilitate strategic abuse, prolong legal uncertainty, and undermine the efficiency of the patent system. For example, the French Group noted that "examination should, on the contrary, be rapid, for the legal certainty of third parties. Rapid examination limits the risk that the applicant artificially keeps divisional applications pending by filing successive divisional applications." The Russian Group characterized delayed examination as "an abusive tactic that can be used to control the access of other companies after they have already entered the market." The UAE Group also emphasized the interests of third parties, noting that "investors and competitors need to know as soon as possible where they stand in terms of freedom to operate."

In summary, the Groups supporting delayed examination generally viewed it as a legitimate procedural flexibility tool. Many of these groups, however, also acknowledged the need for safeguards to prevent strategic abuse. The Groups opposing delayed examination generally emphasized concerns about legal certainty, potential abuse, and the risk of prolonging the period of uncertainty for third parties.

47) Should amendments to the claims of divisional applications be restricted?

29 of the responding Groups stated NO (65%), while 15 Groups (35%) stated YES for this question.

Among the Groups that selected NO, the Turkish Group outlined that "amendments to claims in divisional applications should not be subject to special restrictions beyond the ordinary rules on amendment".

Among the Groups that selected YES, most reasoned that the amended claims of the divisional application should not exceed the scope recorded in the original application.

The variation in responses can be attributed to how the Groups understood the question. In fact, despite differences in the options they selected, most Groups agreed that amendments to the claims of divisional applications should be subject to the general requirements applicable to any patent application, such as the prohibition on new matter and compliance with the original disclosure, but should not be subject to any additional restrictions.

48) Should the same criteria of assessing double patenting in the case of divisional applications apply than for other patents?

a) NO.

b) YES, for mandatory and voluntary divisionals.

a) c)YES, for mandatory divisionals only.

c) YES, for voluntary divisionals only.

d) Other.

No Group selected option (a). Two (2) Groups refrained from answering.

38 of the responding Groups selected option (b) (90%), i.e., that the same criteria of assessing double patenting should apply for both mandatory and voluntary divisionals. 4 Groups (10%) selected option (d), i.e., that the same criteria should apply for voluntary divisionals only. No Group selected option (c). Two (2) Groups refrained from answering. Thus, a near-unanimous majority of the Groups considered that the same criteria for assessing double patenting should apply to divisional applications regardless of whether the divisional is filed to address a lack-of-unity objection or at the applicant's discretion. It is noteworthy that,

although 3 Groups selected option (e), their explanations showed that they actually held the same view as those who chose option (b). Therefore, they were combined into option (b) in the statistics.

The 4 Groups (10%) that favoured option (d) considered that the same criteria should apply only for voluntary divisionals. The US Group explained that "mandatory divisionals are filed where an Examiner has already made a determination that the parent application includes claims directed to different inventions via a unity of invention rejection or restriction requirement".

49) Should the filing of divisional applications be considered categorically exempt from being considered an abuse of the IP system? [YES/NO] You may add a brief explanation.

30 of the responding Groups stated NO (70%), while 13 Groups (30%) stated YES. One group refrained from a definitive YES/NO answer.

For the Groups that favored the view that the filing of divisional applications should not be considered categorically exempt from being considered an abuse of the IP system, many of them commonly believed that even though divisional filings were presumably legitimate, they might constitute abuse in exceptional or extreme cases.

Regarding the specific circumstances, some Groups asserted that the divisional filing system could potentially be used for strategic unfair competition. For example, the Turkish Group stated that "in exceptional cases—such as the filing of multiple divisionals that create legal uncertainty or delay competitors' market entry—it should remain possible to evaluate whether such filings constitute an abuse of the patent system". The Chinese Taipei Independent Members noted that "the filing of divisional applications should not be categorically exempt from being

considered an abuse of the IP system" and that abuse may arise where divisional filings are used strategically to prolong uncertainty. The Bulgarian Group similarly stated that "abuse may include serial filings or strategic fragmentation" and that "evidence includes filing patterns and claim overlap". The Paraguayan Group considered that divisional filings should not be exempt from abuse scrutiny, noting the need to prevent the misuse of procedural rights. Some other Groups, more specifically, believed that someone might take advantage of cascading or serial filing of the divisional applications to keep patent families pending indefinitely and thus artificially prolong pendency or patent term. Accordingly, the German Group cited the "Teva case" in their explanation, where staggered filings with overlapping content, strategic withdrawals, and prolonged shielding from validity review (approximately 9 years) constituted abuse. There were also some Groups, such as the Mexican Group, who indicated that the filing of divisional applications may be considered as abusive practice if they are used to re-pursue already examined and rejected subject matter.

As for the Groups that supported such categorical exemption, they primarily relied on the following reasoning: First, filing divisional applications is a statutory procedural right that is formally recognized in the patent law of most jurisdictions, "when used within the legal framework and examination guidelines, divisionals serve legitimate purposes such as addressing unity of invention objections and ensuring full and fair protection of disclosed subject matter", according to the explanation of the UAE Group. Second, the divisional filing system is a legitimate protection tool, and the applicants are entitled to use it to protect all inventive concepts disclosed in the original application. When the formal requirements are met, the divisional filing itself cannot be abusive, "otherwise, it may unduly limit

applicants' ability to pursue appropriate patent protection", according to the Korean Group's opinion.

However, among those Groups who supported such categorical exemption, although some of the Groups advocated the legitimate use of the divisional application system and presumably exempted such system from being considered an abuse, they still also mentioned the possibility of abuse and proposed particular approaches to avoid such potential abuse. For instance, although the Canadian Group stated that "the mere filing of a divisional application, if permitted to technically file by law, should not be the basis of an abuse of the patent system", the group also noted that "the Canadian Patent Act has a separate 'abuse' section for patents, with various requirements". The Belgian Group also believed that filing divisional applications cannot be automatically abusive under patent law, competition (antitrust) law may still assess abusive conduct in light of the overall context and circumstances.

50) In what kind of situations, if any, should the enforcement of divisional applications be considered as abusive (outside of the scope of the legitimate use of the patent right)? If/when identifying such situation(s), please also mention the evidence which would be required to support such a finding.

Many Groups provided responses on this Question. Most jurisdictions recognized divisional applications per se as a legitimate procedural tool, and reached general agreement that enforcement of divisional applications may be deemed abusive in exceptional circumstances. Several Groups emphasized that the assessments of abuse should primarily be made under competition law, antitrust law, or general civil law doctrines (such as the principles of abuse of rights and good faith), rather than under specific provisions of patent law.

The responding Groups have identified several categories of conduct that may render divisional enforcement abusive:

1. Serial divisional filings in the prosecution procedure

Multiple Groups identified the strategic filing of successive divisional applications with overlapping or identical claims as a primary abuse scenario, so that the applicant can keep at least one application pending indefinitely to preserve procedural leverage or delay competitor market entry. For instance, the Turkish Group mentioned that "excessive cascading divisional applications relating to the same subject matter that was previously objected to as non-patentable during the prosecution of the parent patent may be considered abusive". The Thai Group noted that "enforcement of divisional patents may be regarded as abusive where divisional filings are used to replicate the scope of earlier patents or to assert a series of closely overlapping rights in a manner intended to harass competitors or prolong legal uncertainty". Some Groups called such preservation of procedural leverage as "submarine/zombie patent strategy", where the filing of divisional applications is used to delay grant and later assert rights unexpectedly against the competitors.

2. Enforcement of multiple patents covering the same or substantially identical subject matter

A significant number of jurisdictions highlighted the abusive nature of enforcing multiple patents (parent and divisional, or multiple divisional applications) covering the same or substantially identical subject matter against the same infringer in the enforcement action. The Singaporean Group emphasized that "if there is a double patenting between a parent and a divisional and the patentee

attempts to enforce both patents against an infringer, this would be considered as abusive".

3. Strategic withdrawal to avoid adverse precedents

Several jurisdictions, particularly in Europe, cited the "Teva case" as the paradigmatic example of abuse. The Swiss Group provided detailed considerations when the dominant market player utilizes the procedural rules of a patent office to artificially prolong legal exclusivity and trap competitors in endless litigation loops, and such "divisional game" constitutes abuse of the patent system: (i) filing staggered, overlapping divisional applications with shared legal weaknesses; (ii) aggressively enforcing rights via preliminary injunctions during the pendency; and (iii) strategically withdrawing applications just before appellate revocation to prevent negative precedent.

4. Excessive filings beyond technical justification

The Chinese Group proposed to take the reasonable number of the divisional filings into consideration, more specifically, "strategically submitting a number of divisional applications, but the number significantly exceeds the reasonable number that is necessary for claim all technical solutions disclosed in the specification", but also emphasized that such determination of abuse must be very cautious and meet strict conditions, such as the filing of dozens or even hundreds of divisional applications, and the specification clearly does not support such a large number of technical solutions.

Regarding the required evidence to support such finding of abuse, the Groups basically identified some common categories of evidence:

1. Typical behaviors during the prosecution: Filing of repetitive applications; timing and sequence of divisional filings; lack of substantive prosecution activity; late-stage filings near parent refusal/opposition.

2. Overlapping claim scope: Degree of overlap between parent and divisional claims; insubstantial differences between cascading divisional filings; shifting or expanding claim scope across divisional filings.

3. Coincidence of the filing time and strategic withdrawals: Filings coinciding with competitor market entry; enforcement actions shortly after grant; systematic withdrawals immediately before appellate oral proceedings or revocation decisions.

4. Utilizing overlapping patents for malicious litigation: Prior failed infringement actions on overlapping patents; simultaneous pursuit of interim injunctions before strategic withdrawal; repetitive enforcement targeting the same technology.

5. Internal documentation proving bad faith: Company communications demonstrating explicit strategy to prolong uncertainty or hinder market entry.

6. The negative market effects resulting from abusive divisional filings: Evidence of legal uncertainty imposed on competitors; blocking effect on subsequent filers where published (but rejected) divisional disclosures become prior art.

50) (continued) Irrespective your answer to the above, are there any other practices that should be considered to be outside the scope of a legitimate use of the patent system (i.e., abusive) regarding divisional applications? [YES/NO] You may add a brief explanation.

23 of the responding Groups stated NO (55%), while 19 Groups (45%) stated YES.

The Groups that answered NO basically treated divisional filings as an inherent procedural right that should not be presumptively restricted, and applicants should enjoy broad freedom to file divisional patent applications provided that all formal requirements are satisfied. Most argued that any abuse concerns are better addressed through antitrust, competition law, general civil doctrines or some inherent patent law mechanism, rather than through special patent-law prohibitions. Beyond the exceptional circumstances already identified, there is no need for additional divisional-specific abuse categories. Some Groups, such as the Swedish Group, showed additional concern that broad or vague abuse standards could undermine legal certainty and the value of patents when applied to patents derived from continuations or divisional applications.

The Groups that answered YES cited largely the same abusive scenarios as those mentioned earlier in the first half of this Question, including: continuous cascading filing without reasonable grounds, repetitive divisional filings with same or overlapping claim scope, and strategically filing an excessive number of applications and artificial prolongation of pendency, etc.

51) If any, what kind of remedies should be available if the enforcement of divisional applications is considered as abusive? Please comment on any additional issues concerning any aspect of divisional applications or double patenting that you consider relevant to this Study Question.

Vast majority of Groups provided responses on this Question. They proposed the remedial framework from different perspectives, including structural safeguards in patent mechanism, administrative and procedural measures in application and prosecution, competition law sanctions and judicial remedies in enforcement action.

Some Groups believed that some structural safeguards should be provided. For instance, the Polish Group advocated that "greater clarity regarding the relationship between divisional applications and double patenting could contribute to increased legal certainty. In particular, clearer guidance on the extent to which overlapping claim scope between parent and divisional patents should be permissible could help reduce the risk of strategic use of divisional filings in enforcement contexts".

Some Groups discussed the available measures in the filing and prosecution procedure to prevent abuse of divisional filings. Firstly, refusing or revoking the divisional application or even the parent application thereof, where such filing is proven to obstruct competitors rather than protect a distinct invention. Secondly, accelerating the prosecution proceedings upon the request of third parties in certain circumstances to avoid unnecessary prolongation of pendency. Thirdly, adopting progressively higher filing fees for successive divisional filings to deter strategic multiplication. Additionally, the Philippine Group also provided some other procedural safeguards, such as requiring applicants to submit a written justification setting out the legal and technical grounds for divisional applications.

Some other Groups insisted that since the proper utilization of divisional application system itself should not be deemed abusive, the competition law sanctions could be used when the abuse arises in certain circumstances. For instance, the Turkish Group stated that "where such conduct leads to anti-competitive effects, remedies may also be sought under competition law by filing a complaint before the relevant competition authority". The Israeli Group similarly noted that "abuse of the patent system should preferably be developed as part of competition law rather than

patent law", emphasizing that competition law provides the more appropriate framework for addressing abusive conduct in the context of divisional applications.

Some Groups also focused on the judicial remedies, including the invalidation of divisional patent and unenforceability in the infringement action, or even damages for such abusive enforcement. For instance, the Ecuadorian Group had incorporated the aforementioned judicial remedies in its explanation that "appropriate remedies may include: invalidation or nullity actions against the divisional patent, particularly where it is demonstrated that the claims lack novelty, inventive step, or are not patentably distinct from prior rights; limitation or amendment of claims, ensuring that the scope of protection is restricted to subject matter that is clearly distinct and legitimately protectable; denial or restriction of enforcement measures, including injunctive relief, where the exercise of the right is found to be contrary to principles of good faith or constitutes an abuse of rights; compulsory licensing mechanisms, where applicable, to ensure access to the protected technology, especially in cases involving public interest considerations; damages or compensation in cases where abusive enforcement has caused demonstrable harm to competitors or third parties".

In summary, even though the responding Groups provided different remedy proposals, there was broad consensus that the aforementioned remedies should not be limited to a single approach, but rather be applied in combination, to resolve the potential abuse of divisional application system.

52) Please indicate which industry sector views provided by in-house counsels are included in your Group's answers to Part III.

The following industry sectors were specifically identified in the Group responses: pharmaceutical and life sciences; biotechnology; semiconductors; information

technology, ICT and telecommunications; electronics; chemicals; biomedicine; internet and communications; materials; medical informatics and medtech; automotive; mechanical engineering; semiconductor manufacturing equipment; micro- and nanofabrication technologies; surface analysis, metrology and microscopy; advanced processing and additive electronics; equipment software, services and refurbishment; steel manufacturing; elevator technology; mining technology; chemical engineering; flooring technologies; furniture assembly; and the agricultural sector.

IV. Conclusions / Guidance for the Study Committee

From the Reports, the conclusion can be drawn that a slight majority of the responding Groups (55%) consider that their current law regarding double patenting is adequate and/or sufficient. Similarly, a slight majority (65%) consider that their current law regarding divisional applications is adequate and/or sufficient. However, a significant minority in both cases identified development needs.

From the more detailed responses it can be drawn that a need for harmonisation regarding issues involving double patenting is supported by the Groups. Further, it can be drawn that:

- The Groups were evenly divided on whether double patenting should be categorically prohibited, with half supporting a categorical prohibition and half supporting exceptions
- However, a majority of the Groups considered that it should not be possible to have patent rights covering the same geographical area granted by different national or regional bodies for the same or substantially the same claim scope.

Protection through different types of patent rights:

- As to whether it should be possible to have protection for the same or substantially the same claim scope through different types of patent rights, the Groups were almost evenly divided.
- However, with respect to specific combinations, the majority of the Groups (although not each of the points below is necessarily supported by the "same" majority) finds that:
    - The Groups were almost evenly divided on whether parallel protection between a patent right and a utility model right should be possible.
    - A majority of the Groups considered that parallel protection between a patent right and a design patent right should be possible, on the basis that patents protect technical function while design rights protect aesthetic appearance
    - A majority of the Groups considered that parallel protection between a utility model right and a design patent right should be possible, applying the same reasoning
    - A large majority of the Groups considered that parallel protection between two utility model rights should not be possible
    - A large majority of the Groups considered that parallel protection between two patent rights should not be possible

Threshold for double patenting:

- As to the scope of protection required for two patent rights to constitute double patenting, a majority of the Groups favoured the standard of "identical or substantially identical" as the appropriate threshold.

- A large majority of the Groups rejected the extension of the double patenting threshold to claims that are "non-obviously distinct", cautioning that such a broad standard would import an obviousness analysis and risk unduly restricting applicants' ability to pursue differentiated but related claim sets.

Restrictions on legal status of the comparator right:

- A large majority of the Groups considered that there should be restrictions on the legal status of the "other patent" to which the double patenting is compared.
- More specifically, the majority of the Groups (although not each of the points below is necessarily supported by the "same" majority) finds that:
    - Double patenting should be assessed against granted rights
    - Double patenting should be assessed only against rights that are in force, not lapsed or invalidated
    - Double patenting should not be assessed only between the same type of rights, but should be capable of being applied across different types of rights
    - The criteria for assessing double patenting should be the same for patents, utility models, and design patents, on the basis that the underlying policy concern — preventing duplicative protection for the same subject matter — applies equally regardless of the type of right.
- The Groups were evenly divided on whether double patenting should be assessed against published applications.

Measures to resolve double patenting:

- As to the measures that should be available if a patent application is deemed to constitute double patenting, the majority of the Groups

(although not each of the points below is necessarily supported by the "same" majority) finds that:

- Amending the claims of the patent application should be available as a measure to resolve double patenting (90% YES)
- Abandoning the earlier patent right should be available as a measure to resolve double patenting (65% YES)
- A terminal disclaimer should not be available as a measure to resolve double patenting (70% NO), although a significant minority considered terminal disclaimers unfamiliar or inappropriate in their jurisdiction, or insufficient to address the underlying concern of duplicative protection

Group responses indicated that while some Groups considered Resolution Q193 a helpful reference providing balanced principles for divisional applications, a relative majority of the Groups (55%) found it insufficient. Their concerns centered on the absence of a clear definition for "pendency", the lack of provisions addressing the particular features of double patenting specific to divisional applications, and insufficient measures to prevent abusive use of the divisional application regime. These Groups maintained that further harmonisation was desired, at minimum, with respect to the foregoing points.

Definition of "pendency":

- Nearly all responding Groups agreed that "pendency" should encompass the period preceding the grant of the parent application.
- An overwhelming majority of Groups (85%) endorsed the permissibility of filing divisionals from divisionals, even after the very first filing had been allowed, taking the position that pendency should depend on the immediate parent application.

- A majority of the Groups (60%) opposed extending the pendency period through opposition and subsequent appeal proceedings, in the interest of maintaining legal certainty for third parties, while several other Groups supported such extension as a means of safeguarding applicants' rights.

Lack of unity objections and divisional filings:

- An overwhelming majority of the Groups (85%) affirmed that, when a lack of unity objection is issued, applicants should not be required to file all divisional applications at once, and a divisional filed in response to that objection may contain multiple inventions.
- Almost all the Groups (95%) supported permitting examiners to issue further lack of unity objections in divisional applications.

Measures to prevent abuse of divisional applications:

- Almost all the Groups (95%) agreed that there should not be a limit on the number of divisional applications.
- An overwhelming majority of the Groups (90%) opposed requiring applicants to justify the legitimate need for filing a divisional application.
- A majority of the Groups (75%) favored having the same examiner examine the parent and divisional applications within the same patent family, although a small number of Groups cautioned against mandating this practice.
- A majority of the Groups (80%) opposed requiring applicants to explain the relationship between the claims of a divisional application and those of the parent application.
- A relative majority of the Groups (60%) advocated that the examination of divisional applications should not be bound by the prosecution history estoppel of the parent applications.

- A majority (75%) of the Groups opposed imposing restrictions on the prosecution period of divisional applications. However, the Groups were divided on whether to allow delayed examination for divisional applications: a relative majority (55%) viewed delayed examination as a legitimate procedural flexibility tool, while the minority warned of its risks in prolonging legal uncertainty and enabling strategic abuse.

- A majority of the Groups (80%) agreed that there should be no special restrictions on amendments to divisional claims.

- Double patenting criteria for divisional applications:

- A near-unanimous majority of the Groups considered that uniform double patenting criteria should apply to divisional applications. More specifically, a solid majority (90%) supported identical standards for both mandatory and voluntary divisionals.

- Abuse of divisional applications:

- Most of the Groups rejected a categorical exemption for divisional filings from abuse scrutiny, while recognizing that divisional applications are generally legitimate when used within the legal framework. However, they acknowledged that divisional applications may be abused in some circumstances, such as serial cascading filings to artificially prolong pendency, enforcement of overlapping patents against the same infringer, strategic withdrawals to avoid adverse precedents, and excessive filings lacking technical justification.

- To regulate such potential abuse, several Groups proposed specific measures, including enhanced administrative procedural regulations (e.g., refusal/revocation, accelerated examination, progressive fee structures), competition law sanctions, and judicial remedies (e.g., unenforceability of abused divisionals).