

## Summary Report

### Question Q193

#### **Divisional, Continuation and Continuation in Part Patent Applications**

The intention with Q193 is to study the extent to which divisional, continuation and continuation in part patent applications are available in various countries, and to explore the possibilities for harmonisation in this field.

In the Working Guidelines, the following definitions are used: *continuation application*: a second application for the same invention claimed in a prior application and filed before the first application becomes abandoned or patented; *divisional application*: a later application for a distinct or independent invention disclosing and claiming (only a portion of and) only subject matter disclosed in the earlier or parent application, and *continuation-in-part application*: an application filed during the lifetime of an earlier application, repeating some substantial portion or all of the earlier application and adding matter not disclosed in the earlier application. According to the Working Guidelines, Question Q193 is not concerned with patents of addition which may be defined as patents filed during the lifetime of an earlier application and which relate to an improvement or modification of the invention of the earlier application not having been disclosed in the earlier application.

It emanates from the Group Reports that there is a great variety in the extent to which divisional, continuation and continuation in part patent applications are available and in the rules and conditions governing such applications.

Many of the Reports have not only responded to the specific questions about the current law but have also provided useful discussion of matters of principle or policy.

The Reporter General has received 38 Reports from the following countries (in alphabetical order): Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, Chile, China, Colombia, Denmark, Egypt, Estonia, Finland, Georgia, Germany, Greece, Hungary, Indonesia, Israel, Italy, Japan, Korea, Latvia, Malaysia, the Netherlands, Paraguay, Poland, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom, the United States and Venezuela. In addition to these 38 Reports, the French, Luxembourg, New Zealand and Peruvian Group Reports unfortunately arrived too late to be taken into consideration for this Summary.

#### **1) Analysis of the current law**

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

In Argentina, Belgium, Brazil, Bulgaria, Chile, China, Colombia, Denmark, Estonia, Finland, Georgia, Germany, Greece, Hungary, Indonesia, Israel, Italy, Japan, Korea, Latvia, Malaysia, the Netherlands, Paraguay, Poland, Russia, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom and Venezuela, only divisional applications are available in the respective national systems. The German, Hungarian and Japanese Groups report that divisionals may be used as continuation applications within the meaning of the Working Guidelines.

The European Patent System only provides for divisional applications, but in practice divisionals may also be granted for the same invention as claimed in the parent application, i.e. divisionals may in reality take the form of continuation applications.

In Australia, divisional applications may include new matter and can serve a similar function to continuation and continuation-in-part application in other jurisdictions. It is also possible to combine two parent applications into as single divisional application.

In Austria, not only divisionals but also continuation applications, “applications for new matter,” and applications claiming priority of an earlier Austrain application (“continuation-in-part applications”) are available.

In the United States, divisional, continuation and continuation-in-part applications are all available.

Also, in Canada, divisional, continuation and continuation-in-part applications are available.

In Egypt, the national IP law does not mention any wording regarding filing divisional, continuation and continuation-in-part applications.

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

Many Groups have understood this to mean what the conditions are for allowing the filing of divisional, continuation or continuation-in-part applications. Rather, the intention was to explore what justification has been given by the local legislature for having rules allowing the filing of divisional, continuation or continuation-in-part applications.

In this respect, the Austrian Group reports that the justification is that a maximum of flexibility should be allowed for the applicant in the prosecution of his patent application. The Japanese, South African, United Kingdom and Chinese Groups observe that the patent system should avoid damage to the applicant’s rights as a consequence of the unity of invention principle, because the applicant has made his contribution by disclosing the whole content of the parent application; furthermore, the Chinese Group observes as a justification for allowing divisions that separate assignment and licensing of different aspects of an invention should be facilitated. The German, Italian and Polish Groups also observe that where division is compulsory because of the unity of invention requirement, which is of a formal character, based on technical, fiscal and administrative considerations, it would be unfair if this should cause the applicant to lose benefit of the original filing date for all patentable matter included in the parent application. The German Group also observes that the introduction of Article 4 G(1) Paris Convention which expressly allows contracting states to make the use of voluntary divisionals available to applicants was in fact inspired by AIPPI’s 1932 London Resolution (R 32/7) and 1938 Prague Resolution (R 38/2). The London Resolution R 32/7 asserted that voluntary division should be available in order to enable the applicant to accelerate grant of undisputed parts of the application. The Prague Resolution asserted that voluntary division was justified also in order to enable the applicant to simplify independent exploitation of several different aspects of the invention contained in the parent application.

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

In Chile, Hungary, Israel, and Thailand, divisional applications may be filed only in response to unity restriction requirements by the patent office.

In Argentina, Australia, Austria, Brazil, Bulgaria, Canada, China, Colombia, Denmark, Estonia, Finland, Georgia, Germany, Greece, Indonesia, Latvia, Malaysia, the Netherlands, Poland, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, the United Kingdom, Japan, Korea, Venezuela and the European Patent System, divisional applications may be filed in response to unity restriction requirements by the patent office, or voluntarily.

Reference is made to paragraphs 1.4-1.12 below, concerning some of the main circumstances and conditions that apply to the filing of such applications.

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

In Argentina, Australia, Austria, Belgium, Brazil, China, Colombia, Denmark, Finland, Georgia, Germany, Greece, Hungary (only for divisionals), Israel, Italy, Japan, Malaysia, the Netherlands, Paraguay, Poland, Russia, South Africa (law is unclear as to retention of original filing date), Spain, Sweden, Switzerland, Thailand, the United Kingdom, and the United States, and in the European Patent System, the filing of "cascades" is allowed.

Apparently, there is no restriction in most countries as to the number of cascade applications that may be filed.

In Bulgaria and Latvia, the filing of "cascades" is not allowed.

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

In Argentina, Australia, Brazil, Bulgaria, Chile, Colombia, Denmark, Finland, Georgia, Germany, Greece, Hungary, Indonesia, Israel, Italy, Latvia, the Netherlands, Poland, Russia, Singapore, South Africa, Sweden, Switzerland and the United States, filing must take place while the (immediate) parent is pending (i.e. as long as there is no final decision to grant or refuse the (immediate) parent).

In Hungary, the time limit for filing continuation-like and continuation-in-part-like applications is 12 months after the filing date of the parent.

In Austria, filing must be made within 2 months after the patent office's decision to refuse grant, within 6 months after its decision grant a patent, or within 2 months after the timely filing of an opposition.

In Belgium, filing must be made before grant of the parent, or before notification of search report, where such report is requested. Where the search report established a lack of unity, a divisional must be filed within 4 months from notification of the result of the search.

In Canada, a continuation or continuation-in-part application must be filed within twelve months of the filing date of its earliest filed parent application, while a divisional application can be filed before the date of issuance to patent of its parent application.

In Estonia, filing must be made within 6 months after final decision as to grant or refusal of parent.

In Indonesia, a divisional can be filed in response to an objection as to the lack of unity, and it can be filed voluntarily only before the substantive examination.

In Japan, a divisional can be filed any time prior to the first official action, within a period provided for responding to an official action, within a certain period after filing of an appeal against a decision of rejection. For applications filed after April 2007, a divisional can also be filed within a certain period after the decision of grant or rejection.

In Malaysia, filing must be made within the prescribed time such as three months from the mailing date of the Examiner's report.

In Paraguay, divisional can be filed before the publication.

In the United Kingdom, filing must be made within 3 months after the end of the time period for putting the parent application in order, provided that it has not been refused or withdrawn, or granted. If parent is already in compliance with the Patents Act and Rules, filing must be made within 2 months from the date of the Patent Office's report to that effect.

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

This is the case in Argentina, Australia, Brazil, Bulgaria, Chile, China (only direct parent), Colombia, Denmark, Finland (only direct parent), Georgia, Germany, Greece, Hungary (only direct parent), Indonesia, Israel, Italy, Japan (only direct parent), Korea, Latvia, the Netherlands (only direct parent), Poland (only direct parent), Russia, South Africa (at least direct parent), Spain (only direct parent), Sweden, Switzerland, Thailand, the United Kingdom (only direct parent), the United States (only direct parent) and Venezuela (only direct parent), and also in the European Patent System (only direct parent).

It is not the case in Austria, Estonia (divisional may be filed within 6 months from withdrawal of basic application), Malaysia and Paraguay. In Paraguay, the divisional of a granted patent is also allowed.

- 7) *Is it a requirement that the original application (or the direct parent application, or both) is still pending throughout the prosecution of a divisional, continuation or continuation-in-part application derived therefrom?*

This is the case in Georgia, Latvia and Venezuela.

It is not the case in Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Chile, China, Colombia, Denmark, Estonia, Finland, Germany, Greece, Hungary, Israel, Italy, Japan, Korea, Malaysia, the Netherlands, Paraguay, Poland, Russia, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom and in the United States, and also not in the European Patent System.

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

In almost all countries, there are restrictions (see below, 1.9) as to what may be included or claimed.

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

In Argentina, Austria, Belgium, Brazil, Canada, Chile, China, Colombia, Denmark, Estonia, Georgia, Germany, Hungary, Israel, Italy, Japan, Korea, Latvia, Malaysia, the Netherlands, Paraguay, Poland, Russia, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom, the United States and Venezuela, and in the European Patent System, the content of a *divisional* application cannot go beyond the content of the parent as originally filed. In Canada, there is an exception for the addition of matter that describes the prior art with respect to the application.

In the United States, the same applies for continuation applications, but not for *continuation-in-part* applications which must, however, reiterate a substantial proportion of the parent application. In Hungary, the limitation to the scope of the content of the parent as filed also applies for "*continuation-like*" applications, but not for "*continuation-in-part-like*" applications which by definition do include new matter.

In the European Patent System, three appeal cases were pending at the time of filing of the Group Reports, concerning the issue whether the addition of new matter in a divisional application is an unrecoverable defect or whether any such matter may be subsequently removed so that the validity of the application is saved, and the issue whether cascades of divisionals are permissible (consolidated cases G1/05, G1/06 and G3/06). One of the

three cases has been withdrawn, and the remaining two cases, G1/05 and G1/06, were decided on 28 June 2007. It was held that the inclusion of new subject matter is not an irrecoverable defect; such subject matter may be removed subsequent to the filing. It was also held that cascading divisional applications are permissible, provided that the subject matter of each divisional is disclosed in each of its preceding applications.

In the Netherlands and in the European Patent System, a divisional may not reach back over the immediate parent, i.e. may not contain matter that was not included in the immediate parent, even if that matter was disclosed in the original application as filed.

In China, Colombia, Finland, Germany, Japan, the Netherlands and the United States, a divisional application cannot comprise the same set of claims as the parent. In Japan, the disclosure must furthermore be within the scope of the parent as it existed immediately prior to its division, where division is made after examiner's decision to grant or refuse the patent.

In Denmark, a divisional may not claim matter that could not have been introduced into the claims of the parent at the time of filing of the divisional application.

In Bulgaria, it is not possible to claim matter not previously *claimed*.

In Australia, new matter may be added to the description and/or claims in a divisional if filed before acceptance of parent or within 3 months after publication of acceptance; however, at least one claim must be fairly based on matter disclosed in the parent as originally filed. If a divisional is filed later, new matter may not be claimed, but it may be present in the description. Under the Australian practice, each claim has its own priority date.

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

This is not possible in Argentina, Australia, Belgium, Brazil, Bulgaria, Chile, China, Colombia, Denmark, Estonia, Finland, Georgia, Germany, Greece, Hungary, Israel, Italy, Japan, Latvia, Malaysia, the Netherlands, Paraguay, Poland, Russia, South Africa, Spain, Sweden, Thailand, the United Kingdom, the United States and Venezuela, and in the European Patent System, because the divisional benefits from the same filing date as the parent application.

In Canada, a continuation or continuation-in-part application which must be filed within 12 months of the earliest filed parent as discussed above receive its own filing date so that it is possible to extend the patent term by up to 12 months for the matter disclosed in the earliest parent. This system apparently corresponds to internal or domestic priority systems or provisional application practice found in many other countries.

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

As pointed out by the Group Reports of Sweden and the United Kingdom, the Working Guidelines might have been more specific on this point. Some countries may allow an overlap of protection provided there is some clear distinction between what is claimed in the parent and the divisional application, respectively. Whether this is characterised as double-patenting or not may be a question of definition. In a strict sense, the concept of double patenting does not include overlaps, if the scope of the applications is not identical.

Double-patenting is not permitted in Argentina (matter claimed in parent and divisional should be clearly distinct), Australia, Brazil, Bulgaria, Chile, China, Colombia, Estonia, Finland,

Germany (matter claimed in parent and divisional should be clearly distinct), Hungary, Israel, Italy, Japan, Latvia, Malaysia, the Netherlands, Poland, Russia, South Africa, Spain, Sweden (matter claimed in parent and divisional should be clearly distinct), Switzerland (matter claimed in parent and divisional should be clearly distinct), Thailand, the United Kingdom and the United States, and in the European Patent System (matter claimed in parent and divisional should be clearly distinct).

In Austria, double-patenting is permitted. In Belgium, the issue is undecided.

In Denmark, there is no express prohibition against double-patenting. In cases of lack of unity, partial deletion from the parent application is required.

In Georgia and Paraguay, double-patenting is permitted.

In Greece, there is no provision in the law concerning this issue, and the provisions and rules of the EPC should apply.

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

The most Groups report that there is no distinction.

In the United States, however, the parent application and the divisional application filed as a result of the restriction requirement by an examiner cannot be used as references against each other. Divisional applications that are voluntarily filed by the application without being subject to a restriction requirement, on the other hand, are susceptible to double patenting rejections. Canada seems to adapt a similar approach.

## **II) Proposals for adoption of uniform rules**

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

A large number of Groups observe that it is an advantage for applicants that they may obtain adequate protection by being allowed to overcome unity problems by filing divisionals while retaining the original filing date of the parent (Argentina, Australia, Belgium, Brazil, Bulgaria, Canada, Chile, China, Colombia, Denmark, Finland, Greece, Hungary, Japan, Malaysia, the Netherlands, Poland, Russia, South Africa, Spain, Switzerland and the United Kingdom).

The other side of that coin is that the access to filing divisionals makes it possible and reasonable to require restriction where a parent application contains more than one inventive concept; that the unity requirement is adhered to is in the interest of third parties' legal certainty, partly because it enhances their possibilities of making effective searches in patent registers as the scope of applications are thus better defined (Argentina, Italy, Japan, South Africa and the United Kingdom).

Also, the possibility of filing divisionals restricts the power of examiners to demand amendments which unreasonably restrict the claim scope (Russia).

Furthermore, some Groups observe that the possibility to file divisional applications provide a way for applicants to save initial costs by including more than one invention in a single application and only dividing it into several applications at a later stage (Argentina, China, Germany, the Netherlands, Poland and Spain).

The Argentinean Group observes that the possibility of filing divisional applications encourages applicants to make full disclosure because the retention of the original filing date eliminates applicants' risk of forfeiting protection of later claimed inventions as a consequence of the earlier disclosure in the parent application.

Moreover, a number of Groups point to the advantage of being able to independently pursue non-controversial claims more expediently while continuing to debate more controversial parts of the application with the patent authority (Argentina, Brazil, China, Georgia, Germany, Hungary, Poland, Spain and Sweden).

Similarly, several Groups observe that divisionals offer applicants maximum flexibility in claiming every aspect of the invention in a manner which the applicant deems most appropriate according to changing circumstances (Austria, Belgium, Greece, the Netherlands, Russia, South Africa, Switzerland and the United States).

Some Groups observe that divisionals can be used to delay decisions about the scope of an application (e.g. to design claims towards particular infringements or in anticipation of a change in the case-law of the patent-granting authority) (the Netherlands and the United Kingdom).

The existence of a divisional is also an advantage to the applicant in the case of opposition proceedings (Switzerland).

The use of divisionals may serve to maintain a threat against competitors beyond the refusal of the parent application (the Netherlands and Spain).

It is also suggested that the filing of divisionals enable applicants to improve the quality of patent documents where deadlines for amendment have been missed (China).

The Australian Group suggests that the filing of a divisional may be used for delaying a final rejection by the patent office.

As a related advantage for applicants, some observe that the filing of a divisional may enable applicants to obtain a second examination of the same claims where final rejection is otherwise faced; in this, the lessons learned during the parent's prosecution may be applied (China, Germany and the Netherlands).

In respect of licensing and assignment, it is an advantage that transactions, maintenance and enforcement is more flexible and easier where an application originally containing two or more inventions or aspects of an invention is divided (China, Denmark, Georgia, Spain and Sweden).

For third parties, divisionals may make opposition and invalidation procedures easier (Poland).

Continuation and continuation-in-part applications also enable applicants to prolong patent protection (Brazil and Switzerland).

Continuations enable applicants to continue prosecution of the same invention after grant or refusal of the parent, and to add claims of different claim categories not claimed in the original application (Finland, Germany and Hungary).

Finally, continuations furthermore enable applicants to pursue a narrow scope first and then subsequently prosecute a broader claim scope (Malaysia, Poland and the United States).

Moreover, continuations may be used for modifying claims in light of third parties' design-around solutions (the United States).

Continuations-in-part enable applicants to revise the contents of the application and add new subject matter, including further embodiments and thereby obtaining a more multi-faceted, exhaustive and precise scope, while maintaining the priority date in respect of originally disclosed matter, and in particular this may be advantageous where it is unclear whether the added matter is "new" (Brazil, Canada, Finland, Hungary, Japan (also advantage for third parties), Malaysia, Spain, Switzerland, Thailand and the United Kingdom).

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

Continued delay, legal uncertainty and added complexity are disadvantages for third parties (Argentina, Australia, Austria, Belgium, Brazil, China, Egypt, Finland, Germany, Hungary (continuation or continuation-in-part applications), Israel, Latvia, the Netherlands, Poland, South Africa, Spain, Sweden, Switzerland, the United Kingdom and the United States).

Added costs for third parties and expense of prosecution resources of patent-granting authorities are also disadvantages (Bulgaria, China, Denmark, Egypt, Greece and Japan).

To the extent the patent term may be extended by way of divisional, continuation or continuation-in-part applications, this is a disadvantage to third parties (Australia).

In particular, continuation and continuation-in-part applications adjusting or broadening the claim scope and introducing new matter increase third parties' legal uncertainty (Finland, Italy, Japan, Malaysia, Spain, Switzerland and Thailand).

The complexity arising from continuation and continuation-in-part applications including original, new and "mixed" subject-matter, is a disadvantage to applicants as well as third parties (Spain).

For the applicant, the obvious disadvantage of relying on divisional, continuation or continuation-in-part applications is that the patents granting on such applications have shorter life because the patent term is calculated from the filing date, and the divisional, continuation or continuation-in-part application will have an effective filing date identical to the filing date of the original application (United States).

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

Most Groups support that the possibility of filing divisional applications should exist (Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, Chile, China, Denmark, Egypt, Estonia, Finland, Georgia, Germany, Greece, Hungary, Israel, Italy, Japan, Korea, Latvia, Malaysia, the Netherlands, Poland, Russia, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom, the United States and Venezuela).

A number of Groups specifically observe that the filing of continuation applications should also be permitted (Australia, Austria, Belgium, Brazil, Canada, Chile, China, Colombia, Egypt, Finland, Italy (only in first-to-invent jurisdictions), Japan, Korea (but only restrictively), Malaysia (if controlled), Poland (to a limited extent), Switzerland, Thailand, the United Kingdom, the United States and Venezuela).

Some Groups also expressly support the permissibility of continuation-in-part applications (Australia, Austria, Brazil, Canada, Chile, Colombia, Egypt, Italy (only in first-to-invent jurisdictions), Korea (but only restrictively), Poland (to a limited extent), South Africa and Venezuela). It should be noted that Australia and Austria have continuation-like or continuation-in-part like practice, and in Canada continuation and continuation-in-part applications can only be filed within 12 months from the filing date of the earliest parent.

Some Groups expressly do not support the permissibility of continuation-in-part applications (Bulgaria, China, Denmark, Finland, Germany, Japan, Malaysia, the Netherlands, Spain, Switzerland, Thailand, the United Kingdom and the United States). It should be noted that the US Group, which has real experience in continuation-in-part practice, expressed an opinion against it.

Some Groups also expressly do not accept the permissibility of continuation applications (Bulgaria, Denmark, Germany, Hungary, the Netherlands, South Africa, Spain).



The Hungarian Group believes the issue of permissibility of continuation-in-part applications goes beyond the scope of Q193 because it is related to the question of allowability of addition of new matter.

- 4) *If international harmonisation were to be achieved in respect of the rules governing divisional or continuation patent applications, what should be the common rules in respect of the circumstances and conditions in which divisional, continuation or continuation-in-part applications may be filed?*

The filing of divisional applications should be allowed at any time during prosecution of the (immediate) parent application, either in response to a restriction requirement by the patent-granting authority or at the applicant's own volition: Argentina, Australia, Brazil, China, Denmark, Finland, Georgia, Germany, Italy, Japan, Russia, South Africa, Spain (not during appeal proceedings following refusal to grant parent, and no later than at the date of filing an appeal against a decision to refuse grant of the parent), Switzerland, Thailand and the United Kingdom.

Common rules should apply in respect of the time limit within which voluntary applications may be filed: Austria, Canada, the Netherlands (close of prosecution of parent) and Thailand (but it may extend beyond final rejection of parent application).

If continuation applications are permitted, their number should be limited to one for each parent application: South Africa.

Harmonisation should follow the rules of the European Patent System: Belgium, Greece and Spain.

No double-patenting should be allowed: Brazil, China and Germany (overlap should be acceptable, provided the inventions are distinct).

Cascades of applications should be permissible: Brazil, Canada, Denmark, Finland, Italy, Japan and Switzerland.

There should be a limit on the number of divisional, continuation or continuation-in-part applications that can be filed from a parent: Australia.

Cascades of applications should not be permissible: China (rules should be restrictive so as to avoid unlimited strings of filings) and the United States.

It should only be possible to file divisional applications if the parent application lacks unity: Israel, Latvia and the United States.

The applicant should be required to file an explanation stating how the invention claimed in the divisional application is related to the invention contained in the parent application, and this should be published together with the divisional application: Japan.

It is unrealistic to harmonise US and EPC approaches: Sweden.

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

Most Groups agree that this should not be permissible (Argentina, Belgium, Brazil (in divisional applications), Bulgaria, Canada (in divisional or continuation applications), Chile, China, Colombia (in divisional applications), Denmark, Estonia, Finland, Georgia, Germany, Greece, Hungary, Japan, Latvia, Malaysia, the Netherlands, Poland (in divisional or continuation applications), Russia, South Africa (in divisional or continuation applications), Spain, Sweden (except for addition of new examples etc.), Switzerland, Thailand, the United Kingdom (content of immediate predecessor, or (great)grandparent if still pending), the United States (in divisional or continuation applications) and Venezuela.

However, some Groups believe addition of new matter should be permissible, provided that any claim relying on such new matter cannot claim priority from the original filing date (Australia and Austria)

The Korean Group believes addition of new matter should generally be permissible.

Some Groups observe that addition of new matter should be permissible in continuation or continuation-in-part applications (Brazil, Canada, Colombia, Italy (only continuation-in-part applications and only in first-to-invent jurisdictions), Poland (only continuation-in-part applications and under restrictive conditions), South Africa (only continuation-in-part applications) and the United States (only continuation-in-part applications)).

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

A number of Groups believe this should not be permitted (Argentina, Australia (provided all appeal processes are concluded), Austria, Bulgaria, Chile, Colombia, Denmark, Finland (provided the applicant has been given an opportunity to respond to the reasons for rejection), Germany, Hungary, Israel, Korea, the Netherlands, Poland, South Africa, Spain, Sweden, Thailand and Venezuela).

Other Groups believe this should be possible (Brazil (with reservations), Canada, China, Italy (but interests of third parties must be taken into account), Japan (critical), Latvia, Russia (in case of essentially identical claims), Switzerland and the United Kingdom).

Some Groups observe that it should only be permissible where case-law or substantive conditions have changed (Greece, Korea, Sweden and the United States (possibly also where new factual evidence is filed)).

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

Most Groups believe this should not be possible (Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Chile, China, Colombia, Denmark, Egypt, Estonia, Finland, Georgia, Germany, Greece, Hungary, Israel, Italy (except where permitted for continuation-in-part applications), Japan, Latvia, Malaysia (with reservations), the Netherlands, Poland, Russia, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom, the United States and Venezuela, and in the European Patent System).

However, the Canadian and Korean Groups believe this should be possible in certain circumstances.

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

Most Groups believe this is not in itself a valid reason for limiting the access to filing such applications (Argentina, Australia, Austria, Brazil, Bulgaria, Canada, Chile, China, Colombia, Denmark, Egypt, Estonia, Finland, Georgia, Germany, Hungary, Israel, Italy, Japan, Korea, Latvia, Malaysia, Poland, Russia, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom, the United States and Venezuela).

The Greek Group believes such a limitation would be justified.

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

All Groups expressing themselves on this point would support such a measure towards increased transparency (Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, Chile, China, Colombia, Denmark, Egypt, Estonia, Finland, Georgia, Germany, Greece, Hungary, Israel, Italy, Japan, Korea, Latvia, Malaysia, the Netherlands, Poland, Russia, South Africa, Spain, Sweden, Switzerland, Thailand, the United Kingdom, the United States and Venezuela).

The Spanish Group suggests that there should be a maximum period within which the patent-granting authority should publish this information, and that in general office databases should be updated as quickly as possible; parent applications and all divisionals stemming therefrom, including cascade applications divided from divisionals of the parent, should be clearly identifiable as members of the same patent family.

The Swiss Group generally suggests that pending applications should always be made available to the public after a harmonised period of time (18 months from the priority or filing date; immediately in case of divisional or continuation application if the parent is already published) in order to avoid legal uncertainty deriving from "submarine" patents.

*Additional comments:*

The Belgian and United Kingdom Groups highlight the need to introduce a harmonised time limit for filing divisional applications. The United Kingdom Group suggests a term of 3 years from the first examination report on the original patent application. This is perceived as a fair balancing of the interests of applicants and third parties.

The Japanese Group proposes to require applicants to provide a written explanation stating how the invention claimed in a divisional application is related to the original patent application. Furthermore, applicants should indicate the parts of the divisional application that have been changed in comparison with the original application (or immediate parent).

The Australian Group suggests, as an alternative to restricting access to filing divisional, continuation or continuation-in-part applications, that such applications should, as a matter of policy, receive a high degree of priority in examination by patent granting authorities. This could lead to minimizing uncertainty and delay for all parties.

### **III) Conclusions**

Based on the Group Reports, it would seem that there may be a potential for consensus in the Working Committee about the following main points:

- 1) The filing of **divisional patent applications**, in response to unity objections or of the applicant's own volition, should generally be possible.
- 2) The main advantages of permitting the filing of divisional applications are that it allows applicants to obtain adequate protection by being able to overcome unity objections while retaining the original priority date for the whole of the inventive content of the parent application; it also makes it possible for applicants to save initial filing costs; it allows applicants maximum flexibility, in particular in relation to obtain fast grant of non-controversial claims while continuing to debate more controversial parts of the application; it is also an advantage in relation to licensing and assignment that particular aspects of an invention may be divided into separate patent applications.
- 3) However, the possibility of filing divisional patent applications also has disadvantages, in particular on the part of third parties; it continues delay, it adds complexity and

increases legal uncertainty to third parties trying to establish a clear overview of potential patent rights that are relevant to their contemplated business activities; it also adds to the costs of third parties in connection with competitor watch services and freedom to operate analyses; moreover, it draws on the resources of patent granting authorities and increases backlogs, to the detriment of the processing of new applications.

- 4) It should be possible to file a divisional of a divisional application.
- 5) The filing of divisional applications should be permitted at any time during the prosecution of the immediate parent application.
- 6) In a divisional application, it should be possible to claim subject matter that was unclaimed in the parent but present in its description.
- 7) It should not be possible to add matter in a divisional application that was not contained in the original application as filed.
- 8) It should, as a main rule, not be possible to use a divisional application to obtain a new appraisal of patent claims that are identical or essentially identical with claims finally rejected by the patent granting authority.
- 9) A divisional application should not extend the patent term in respect of matter contained in the original application.
- 10) It would not be justified to limit the access to filing divisional applications primarily with the object of seeking to limit the backlog of patent granting authorities.
- 11) It would be desirable, in the interest of legal certainty of third parties, to ensure that the publicly accessible databases of patent granting authorities indicate a clear link between an original patent application and all divisional, continuation or continuation-in-part applications derived therefrom.

*On some further points, the Groups were more divided:*

- 12) A majority of the Groups would also support the possibility of filing **continuation applications**, but even among the Groups supporting this possibility, some observe that this should be possible only under restrictive conditions.
- 13) To the extent continuation applications are permitted, it should be permissible to add new matter in such applications.
- 14) There is no consensus to support the permissibility of **continuation-in-part applications**. For example, the U.S. group, which represents one of a few countries that already have experience with this type of applications, poses questions against them. The continuation-ip-part practice may run against the first-to-file principle.
- 15) The main disadvantage held out by the Groups in this respect is the added legal uncertainty for third parties caused by the adjustment and broadening of the claim scope and the introduction of new matter (leading sometimes to "mixed" subject-matter) that is possible in continuation-in-part applications.

*Some points that should merit further discussions:*

- 16) Procedural harmonization among national systems in the respect of when a divisional can be filed is much desired as a large diversity among national system is found. Perhaps, divisional application should be allowed any time as long as the immediate parent application is validly pending or up to a certain period after the decision of grant.
- 17) Cascades of divisional or continuation applications should be allowed so as to give the applicant more flexibility as to what he or she can claim in a patent. For the formation of such cascade, any temporary restriction may be desirable due to possible uncertainty against third parties.