

Czech Republic

Inputs for the preparation of a study on substantive and procedural requirements regarding voluntary division of patent applications by applicants

According to Section 13 Paragraph 1 of Decree No. 550/1990 Coll., on the Procedure in Matters of Inventions and Industrial Designs, if the Industrial Property Office (the Office) determines that a patent application does not comply with the requirements of Section 26 (1) (unity of invention) of Act No. 527/1990 Coll., on Inventions and Rationalisation Proposals, as amended (the Patent Act), it will invite the applicant to remedy this defect within a specified time limit. Divisional patent applications retain the priority right of the original application if the applicant files them within three months of remedying the defect from the original application (i.e., from the moment the applicant submits the amended application documents containing a single subject matter). Additionally, the applicant may divide the application for an invention up to the date of grant of patent, on his/her own initiative.

Pursuant to Paragraph 2 of this Section, if the original application is divided after the start of the full examination in accordance with Section 33 of the Patent Act, the divisional application is considered an application for which a request for full examination has been filed.

Paragraph 3 of Section 13 stipulates that, in the case of a divisional application, the applicant is required to pay administrative fees corresponding to the procedural status of the original application due at the time of the division.

It remains the case that the content of divisional applications must not extend beyond the original application as filed.

If the original patent application has already been published, then the divisional applications will not be published again.

If the Office finds a lack of unity in the invention, it must precisely define (by listing the claims) and must justify which subject matters do not meet the condition of unity. If there are objections to the patentability of any subject matter causing the lack of unity, these objections shall be communicated to the applicant at the same time.

The applicant may, at any time during the proceedings (up to the granting of the patent), divide the invention application at their own discretion. Provided that the content of the divisional application does not extend beyond the original application as filed and there is a valid reason for dividing the original application (i.e. the application does not meet the conditions of unity), the divisional application enjoys the priority right of the original application.

The same applies in the case of utility model applications pursuant to Article 11(6) of Act No. 478/1992 Coll., on Utility Models, as amended.

Section 35 of the Patent Act addresses the prevention of double patenting for the same invention. According to this Section, if more than one invention application relating to the same subject matter is filed, only one patent can be granted.

If multiple patent applications for the same subject matter are filed independently in the Czech Republic before the first is published, the Office will grant a patent to the application with the earliest priority date. The Office will then reject the other applications.

Multiple applications for the same subject matter may also arise when one or more divisional applications are submitted. Therefore, it is essential to ensure that the patent claims of the divisional applications each do not have the same scope and content as the original application, i.e., they must not mutually protect the same subject matter. The claims of the original application and divisional applications (or multiple divisional applications) must be substantially amended to avoid overlap.

In practice, however, a very rare situation could arise where two applications for the same subject matter of an invention, independently created by two inventors, are filed with the Office on the same day. In such a case, both applications would have the same right of priority, i.e., the same priority date. If two applications with the same effective date are received from two different applicants, each must be allowed to proceed as if the other did not exist. In practice, this represents a rare scenario where double patenting cannot be prevented.