

World Intellectual Property Organization
SCP Secretariat
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Inputs of the Estonia in response to the WIPO Circular C.9260

Dear Madam, Sir,

Pursuant to the request in C.9260 (ii) for the inputs for the preparation of the document SCP/37/4 “**Study on substantive and procedural requirements regarding the voluntary division of patent applications by applicants, including the prohibition of double patenting**” the following provisions from the Estonian regulation regarding patent law are provided below.

The Regulation of Estonia provides a procedure for carrying out the action for the division of patent application. An invention could be separated from a patent application in the two following cases:

- 1) the patent applicant wishes to file an independent divisional patent application **on his own initiative** for the invention contained in the description of the invention or in the patent claims of the initial patent application;
- 2) the Patent Office requests the separation of an invention contained in the patent claims that violates the unity of the invention.

The general procedures and requirements are the same for both cases.

Establishment of filing date for divisional patent application

The filing date of the divisional application is considered to be the filing date of the initial patent application (*Patents Act*, § 21 (3)).

Filing of divisional application

Divisional patent applications may be filed for up to six months after termination of the processing of the initial patent application (*Patents Act*, § 9 (2)).

Priority claim

Priority for a patent application which is separated from an earlier patent application shall be established, if priority is claimed, on the basis of the date of priority of the earlier patent application (*Patents Act*, § 11 (4)).

State fee for year of validity

In case a divisional patent application is filed, the applicant shall, within two months from the actual filing date of the divisional application with the Patent Office, pay state fees for all preceding years of validity, taking into account that the filing date of the initial

patent application shall be the basis for the calculation of years of validity of a divisional patent application (*Patents Act, § 42 (10)*).

Contestation of patent

The revocation of a patent may be requested within nine months from the publication date of the notice of grant of the patent if the invention protected by the patent, including an invention separated from an initial patent application does not correspond to the subject matter of the invention as disclosed in the initial patent application (*Patents Act, § 50 (2)*).

Prohibition of double patenting

The patent applicant shall remove the parts of description and claims from initial application that are not necessary to characterize the surviving invention (*Requirements concerning the content and format of patent applications and the procedure for filing the same, § 66 (2), Regulation of the Minister of Justice*).