

WIPO Circular C.9260

**Contribution of Germany to a Study on Substantive and Procedural Requirements
Regarding Voluntary Division of Patent Applications by Applicants**

I. General; meaning and purpose of the provision

The division of patent applications is regulated in Section 39 German Patent Act (PatG)¹:

§ 39 [Division of the application]

- (1) The applicant may divide the application at any time. The division is to be declared in writing. If the division is declared after the request for examination has been filed (section 44), the separated part is deemed to be an application for which a request for examination has been made. The date of the original application and any priority claimed for it remains applicable to each divisional application.
- (2) The same fees are payable for the separated application for the period up until the division is made as were payable for the original application. This does not apply in respect of the fee paid in accordance with the Patent Costs Act for the search in accordance with section 43 if the division was declared before the request for examination was filed (section 44), unless a request in accordance with section 43 is also filed for the separated application.
- (3) If the application documents required in accordance with sections 34, 35, 35a and 36 for the separated application are not submitted within three months after receipt of the declaration of division or if the fees for the separated application are not paid within this period, the declaration of division is deemed not to have been made.

Pursuant to Section 39 PatG, every applicant is entitled to ‘voluntary’ (or ‘free’) division at any time during the grant procedure. In practice, this gives the applicant extensive formative

¹ Translation according to https://www.gesetze-im-internet.de/englisch_patg/englisch_patg.html#p0091, an online service by the German Federal Ministry of Justice. Please note that the translations of German statutes into languages other than German are intended solely as a convenience to the non-German-reading public and that any discrepancies or differences that may arise in translations of the official German versions of these materials are not binding and have no legal effect for compliance or enforcement purposes (https://www.gesetze-im-internet.de/Teilliste_translations.html). The original German wording of the provision is: „(1) Der Anmelder kann die Anmeldung jederzeit teilen. Die Teilung ist schriftlich zu erklären. Wird die Teilung nach Stellung des Prüfungsantrags (§ 44) erklärt, so gilt der abgetrennte Teil als Anmeldung, für die ein Prüfungsantrag gestellt worden ist. Für jede Teilanmeldung bleiben der Zeitpunkt der ursprünglichen Anmeldung und eine dafür in Anspruch genommene Priorität erhalten.“

(2) Für die abgetrennte Anmeldung sind für die Zeit bis zur Teilung die gleichen Gebühren zu entrichten, die für die ursprüngliche Anmeldung zu entrichten waren. Dies gilt nicht für die Gebühr nach dem Patentkostengesetz für die Recherche nach § 43, wenn die Teilung vor der Stellung des Prüfungsantrags (§ 44) erklärt worden ist, es sei denn, daß auch für die abgetrennte Anmeldung ein Antrag nach § 43 gestellt wird.

(3) Werden für die abgetrennte Anmeldung die nach den §§ 34, 35, 35a und 36 erforderlichen Anmeldungsunterlagen nicht innerhalb von drei Monaten nach Eingang der Teilungserklärung eingereicht oder werden die Gebühren für die abgetrennte Anmeldung nicht innerhalb dieser Frist entrichtet, so gilt die Teilungserklärung als nicht abgegeben.“

freedom to fully utilise the disclosed content of his application and thus his rights to the invention.

The motives for a voluntary division of a patent application can be manifold, e.g.:

- Accelerating the grant of the “parent application” by removing problematic parts;
- Desire to exploit, e.g. licence, certain parts of an invention complex in separate patents;
- Obtaining patents with a scope of protection that corresponds to specific forms of infringement and thus facilitates prosecution.

The motivation for a division may also arise for the applicant from the legal obligation to maintain the unity of the application (Section 34 (5) PatG).² The applicant is precluded from pursuing more than one invention in one application. If the application contains more than one invention, he will be requested by the examining section to abandon the parts of the application that lack unity, or, to declare division (so-called “separation”). He is free to do the latter, and may thus pursue further inventions from his application in separate (divisional) applications. The boundaries between free division and a required separation by means of division are fluid.^{3,4}

II. Formal Requirements

1. Time Requirements

The specific requirement for division is the pendency of a parent application. According to Section 39 PatG, the voluntary division by the applicant can then take place ‘at any time’, i.e. at any stage, of the grant procedure until a decision on the parent application becomes final,⁵ i.e.:

- immediately upon filing the parent application (even before filing the request for examination);
- during the examination with respect to obvious deficiencies;
- during the course of an isolated search procedure pursuant to § 43 PatG;
- during the examination procedure;
- after a rejection or grant decision of the DPMA until expiry of the appeal period;
- in appeal proceedings before the BPatG until expiry of the legal appeal period;
- in the legal appeal proceedings before the Federal Court of Justice (BGH).

² Section 34 (5) reads: “The application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”

³ The applicant may also be obliged under substantive law to make use of the right granted by Sec. 39 (1); for example, the applicant may be obliged to separate a part of the application and to assign it in accordance with Sec. 8 PatG if he has unlawfully taken this part from another person without their consent and this part forms a separable part of the application.

⁴ A utility model can also be split off from a pending patent application. The right to split off may be exercised until the expiry of two months after the end of the month in which the patent application is finalised or any opposition proceedings are concluded, but at the latest until the end of the tenth year after the filing date of the patent application (Section 5 GebrMG).

⁵ In the past, voluntary division was also possible during the course of opposition proceedings. The corresponding Section 60 PatG was repealed with effect from July 1, 2006.

2. Required Actions

The acts required by the applicant to bring about the division are specified in Section 39 PatG:

- Declaration of division in written form (Para. 1, sentences 1 und 2);
- Payment of fees (Para. 2);
- Filing of application documents for the divisional application (Para. 3).

The three requirements do not have to be fulfilled at the same time. The requirement to pay fees and to submit documents only arises upon receipt of the declaration of division.

The result is a divisional application which comprises the part that is divided from the original application. It initiates a new, independent grant procedure that adopts the procedural stage in which the parent application stood at the time of the division.

The required actions and their effects in detail are

i. Declaration of division

The voluntary division of a patent application is effected by a unilateral declaration of intent by the applicant to the German Patent and Trademark office (DPMA) or to the Federal Patent Court (BPatG). Compliance with the written form is mandatory (Section 39 para. 1 PatG). There are no special requirements for its content. However, it must be recognisable that an application is subject to division and which application it is. It is therefore sufficient to declare the division of the application without specifying a subject matter for the divisional application or a subject matter to be separated from the parent application.

The declaration of division becomes effective upon receipt by the pertinent body. It immediately establishes a new patent application independent of the parent application. A declaration of division cannot be contested because it is a purely procedural act.

However, the validity of the declaration of voluntary division and thus the existence of the divisional application are subject to the fulfilment of the further requirements of section 39 (para. 2 and 3). If these requirements are not met within the prescribed period of three months, the declaration of division is deemed to have not been submitted with retroactive effect and the divisional application is deemed not to have come into existence (section 39 PatG para. 3).

ii. Fees

The obligation to pay fees pursuant to Sec. 39 (2) arises on the grounds that the subject matter of the divisional application was part of the original application until the division and that it was involved in the various stages and conditions of the original grant procedure until then. The divisional application 'inherits' the entire history of the parent application (see above).

The fees due in the divisional application are therefore exactly those which were paid, or, should have been paid in the parent application. These include:

- Application fees (including additional claims fees, if applicable, at least in the same amount as paid in the parent application, or correspondingly higher if the number of claims is higher (pursuant to Sec. 3 para. 1 PatKostG));
- Annual fees (including any surcharges due in the parent application);
- Fees for the examination request/search request.

If the application is divided in appeal proceedings before the BPatG, no appeal fee is payable in the divisional application, because the divisional application is pending in the same appeal proceedings as the parent application.

iii. *Application documents for the divisional application*

The documents to be submitted within three months of receipt of the declaration of division pursuant to section 39 para. 3 PatG are specified in sections 34, 35, 35a and 36 PatG. They correspond to the documents that must be submitted for a patent application:

- Request for the grant of a patent;
- Claims;
- Description;
- Drawings;
- Summary;
- German translation, if applicable, in the case of a foreign-language application.

In the case of a required division by separation, the time limit for filing documents of the divisional application does not apply, so that missing documents can be filed subsequently upon a notification by the DPMA or BPatG. It is therefore essential for the curability of late filing of documents whether the declaration of division was made voluntarily or whether the declaration of division was preceded by a complaint due to lack of unity.

iv. *Effect*

Upon fulfilment of the requirements of Section 39 para. 3 PatG, the pending divisional application becomes a finally effective, independent application. Like any other application, it can therefore expire with effect 'ex nunc', e.g. by declaration or non-payment of fees.

The filing date of the parent application is retained for a divisional application (Sec. 39 para. 1 sentence 4). In the same way, the divisional application has the same priority as claimed in the parent application without the need for a further declaration of priority.

The applicant can also derive several divisional applications from the parent application. For each divisional application, the priority of the parent application, i.e. the filing date or priority date claimed, is retained. The DPMA assigns a separate file number to each divisional application. If the declaration of division is deemed not to have been filed due to failure to meet the time limit (see above), an already assigned file number will be cancelled and fees already paid will be refunded.

III. Substantive requirements, procedural aspects

The entire original disclosure of the parent application is available to the divisional application. If the content of the divisional application goes beyond the originally disclosed content of the parent application, the excess part constitutes an inadmissible extension. No rights can be derived from such an extension pursuant to Section 38 sentence 2 PatG, including by way of division. A corresponding divisional application must be rejected.

Recourse to items contained in the parent application is still possible at a later date if the documents of the parent application or the documents submitted for the divisional application contained this item at the time of the division, provided that these items were not omitted in the parent application prior to the declaration of division or in the divisional application itself. The substantive examination of the divisional application is carried out in the same way as that of the parent application.

If the parent application is pending before the BPatG and the division is therefore declared before the BPatG, the divisional application will also be pending before the BPatG. The divisional application is dealt with before the BPatG in the same appeal proceedings as the parent application. However, separate decisions are issued for the parent application and the divisional application. If necessary, the BPatG can also order a separation of the appeal in the parent application from the appeal in the divisional application. As part of the appeal proceedings, the BPatG may reject the divisional application, grant the divisional application or refer it back to the DPMA for further examination by virtue of Section 79 para. 3 PatG.

IV. Effects in practice and evaluation of free division; double patenting

Free division enables the applicant to pursue different scope of protection for the same invention in several applications with different subject matters. Property rights for the same invention, but with different scopes of protection, give the patent proprietor room for flexibility when granting licences. Also, in practice, it is often necessary to successfully and quickly conclude the examination procedure with a limited scope of protection by excluding disputed parts of the invention in order to obtain a first enforceable IP right. A divisional application hereby provides the means to obtain an additional IP right for the same invention, possibly with a more suitable scope of protection and without time pressure.

The parent application and all divisional applications based on the same parent application have the same priority date and are therefore not prior art in relation to each other. Since each divisional application can refer back to the entire disclosure of the parent application, a further divisional application can also be separated from a divisional application which claims a subject-matter that was only contained in the original disclosure of the first application of a chain of applications, provided that this subject-matter has not been abandoned in the meantime.

In principle, there is an interest in legal protection for the multiple exercise of the right to division. In very exceptional cases, this may not be the case if the right to partition is abused, e.g. if there is no recognisable interest worthy of protection by division or if the proceedings are evidently delayed.

For the DPMA, a divisional application is a new procedure that has a positive impact in terms of statistics and fees. It also has positive procedural aspects if the divisional application reduces the technical complexity of the original application and enables an improved allocation to the respective responsibilities of the examining sections.

A procedural complication arises from the fact that the divisional application and the parent application may have to be dealt with in parallel. This is because the desired patent protection pursued with the various applications must be examined separately in the form of the patent claims for the respective applications, but as with all applications of the same applicant and with the same priority, the prohibition of double patenting must be obeyed.

Furthermore, the pursuit of the same subject-matter in the parent application and the divisional application does not allow for the granting of a patent in either application on subject-matter for which a negative decision has already been issued in the other application. Relevant in both procedures is only the wording of the claims at the time of grant. In the divisional application procedure and in the parent application procedure, the status of the other procedure must therefore be taken into account and, depending on which procedure is completed first, taken into consideration. However, if double patenting has (nevertheless) occurred, this does not constitute grounds for opposition or invalidity.

V. References

Literature:

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Case Law:

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- BGH GRUR 1993, 890 – Teilungsgebühren;
- BGH GRUR 1996, 747 – Lichtbogen-Plasma-Beschichtungssystem
- BGH GRUR 1998, 458 – Textdatenwiedergabe;
- BGH GRUR 1998, 148 – Informationsträger;
- BGH GRUR 1999, 574 – Mehrfachsteuersystem;
- BGH GRUR 1999, 41 – Rutschkupplung;
- BGH GRUR 2000, 688 – Graustufenbild;
- BGH GRUR 2003, 47 – Sammelhefter;
- BGH GRUR 2019, 766 – Abstandsberechnungsverfahren;
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