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STUDY ON SUBSTANTIVE AND PROCEDURAL REQUIREMENTS REGARDING VOLUNTARY DIVISION OF PATENT APPLICATIONS

Document prepared by the Secretariat

INTRODUCTION

1. At its thirty-sixth session, held in Geneva from October 14 to 18, 2024, the Standing Committee on the Law of Patents (SCP) decided that a study on substantive and procedural requirements regarding voluntary division of patent applications would be prepared by the Secretariat, based on the information provided by Member States and regional patent offices, and be submitted to the thirty-seventh session of the SCP. The Committee agreed that in addition to the requirements regarding the voluntary division of patent applications by applicants, the inputs may include issues relating to the prohibition of double patenting and any other relevant information.

2. Pursuant to the above decision, Member States and regional patent offices were invited through Note C.9260, dated January 31, 2025, to submit information to the International Bureau on the above elements under the applicable law. In total, 21 Member States and 1 regional patent office provided their applicable laws and practices in relation to the requirement regarding voluntary division of patent applications.[1] Taking into account the submitted information, the Secretariat prepared a study on substantive and procedural requirements regarding voluntary division of patent applications, which is contained in this document.[2]

[Annex follows]

[1] The information received from Member Staes and regional patent offices is available on the website of the SCP electronic forum at https://www.wipo.int/en/web/scp/electronic-forum/meetings/session_37/comments_received.

[2] The information received included national and regional legislation, court decisions, patent examination manuals and guidelines. They were generally referred to as “appliable law” where the precision of the type of the legal source was not necessary. As regards to the patent examination manuals and guidelines, while they are used intensively through the document, they do not constitute substantive rulemaking and hence do not have the force and effect of law. In general, such manuals and guidelines are simply designed to assist Office personnel in analyzing claimed subject matter for compliance with substantive law.

Study on Voluntary Division of Patent Applications

Contents

I. VOLUNTARY DIVISION OF PATENT APPLICATIONS: GENERAL CONCEPTS AND PRINCIPLES

A. INTRODUCTION TO DIVISIONAL APPLICATIONS

1. In patent law, a divisional application refers to a patent application that originates from an earlier, pending application, known as the parent application. A primary characteristic of a divisional application is that it is normally based entirely on the disclosure originally presented in the parent application and does not introduce any new subject matter. By filing a divisional application, an applicant effectively divides the original application into two or more separate applications, each designed to protect distinct inventions disclosed initially. The divisional application inherits the filing date of the parent application and, where applicable, any priority date claimed by the parent application. This continuity of dates ensures that the divisional application is assessed against the prior art as of the parent application's effective date, protecting it from intervening disclosures and patent applications.

2. In general, divisional applications (hereinafter: "**divisionals**") are considered independently from the parent application once filed; they undergo their own distinct prosecution processes, including separate examination, issuance, or rejection, and thus result in independently enforceable patent rights. Notably, divisional applications within the same patent family - those originating from a common parent - do not constitute prior art against one another, maintaining a principle often referred to as "family immunity". This principle underscores the rationale that divisional applications serve as extensions of the original filing, not as independent disclosures creating competing prior art. With respect to patent term, typically a granted divisional's term is measured from the earliest effective filing date in the family, so divisionals normally expire on the same date as the parent.

3. Patent systems may allow multiple generations of divisional filings, whereby a divisional application itself can potentially serve as the parent for subsequent divisional applications. For clarity of terminology used herein, "cascading divisionals" refers to chains of successive divisionals filed serially (maintaining pendency), and in some jurisdictions the equivalent term is "sequences of divisional applications"; both expressions are conceptually aligned with multi-generational divisional filing. However, the availability and conditions governing such multi-generational filings vary significantly between jurisdictions. Typically, in jurisdictions that allow such practices, each successive divisional application must maintain an unbroken chain of pendency; this generally means that subsequent divisionals must be filed while their immediate parent applications are still pending, and before any final disposition such as grant, refusal, abandonment, or lapse. Where allowed, subsequent divisional applications usually inherit the earliest possible filing date of the original parent application, thus extending the strategic and practical advantages initially established. Nonetheless, certain patent systems impose restrictions or additional conditions to discourage or limit strategic abuse or undue prolongation of patent rights through extensive use of divisional applications. Consequently, the ability to file multiple generations of divisional applications, as well as the exact conditions and procedural requirements for doing so, differ considerably across jurisdictions.

4. In most jurisdictions, a divisional application may not extend beyond the content of the earlier application as filed; it may claim different inventions than disclosed in the parent but cannot introduce new technical information. Where new subject matter is needed, a new application with a later filing date is generally required. By contrast, a "patent of addition" (where recognized) is intended for improvements or modifications to a main invention; it may include new technical features relative to the main filing, is legally dependent on that main patent/application, and its term typically cannot extend beyond the main patent's term. Divisionals and patents of addition thus serve distinct purposes: divisionals split out supported subject matter already disclosed, whereas patents of addition capture later-developed improvements tied to the same underlying invention. In some jurisdictions, related application

types often termed “continuations”, and “continuations-in-part” are recognized. Broadly, a continuation pursues additional claims to subject matter already disclosed in an earlier application without adding new technical information, whereas a continuation-in-part permits inclusion of new technical information; in such systems, the added subject matter generally receives a later effective filing or priority date than the earlier disclosure. Terminology and legal effects vary, and in some jurisdictions divisionals are grouped with these “continuing” applications.

B. HISTORY OF DIVISIONAL APPLICATIONS

5. The practice of filing divisional patent applications has its roots in the principle of “one invention per patent”, a concept that crystallized in the late 19th and early 20th centuries as patent systems became more formalized. This single invention formula was written straight into statute in some jurisdictions providing that a patent shall be granted “for one invention only”. As patent offices began examining applications, they increasingly required that each application claim a single inventive concept. This need to handle applications disclosing multiple inventions led to the notion of dividing an application.[3]

6. At the international level, the Paris Convention for the Protection of Industrial Property eventually codified divisional filings. In the Paris Convention for the Protection of Industrial Property, as revised at The Hague in 1925, Article 4 of the Paris Convention was revised to oblige countries to allow division of multi-invention applications. In this revision the treaty provided that if examination reveals that an application is complex, the patent office must permit the applicant to divide the application under conditions laid down by national law with each divisional retaining the filing date of the original application and the benefit of any claimed priority.[4] Some time later, the Paris Convention was amended further to explicitly recognize voluntary divisional filings. The Paris Convention for the Protection of Industrial Property, as revised at Lisbon in 1958, explicitly confirmed that an applicant may on their own initiative divide a patent application, again retaining the parent’s filing date and priority for the divisional application. In other words, even absent a unity objection from an examiner, applicants gained the right to voluntarily file a divisional.[5]

C. VOLUNTARY V MANDATORY DIVISION

7. Patent systems typically differentiate between **voluntary** and **mandatory (involuntary)** divisional applications based upon the conditions or circumstances under which the division is initiated. This distinction reflects the differing roles and procedural contexts in which each type of divisional application arises.

8. A **mandatory divisional application** is generally required by the patent examining authority following a determination that the parent application fails to meet the requirement of unity of invention. Unity of invention is a fundamental principle in patent law mandating that a single patent application should relate to only one invention or to a group of closely related inventions forming a single inventive concept. When the patent office concludes that the application encompasses multiple distinct inventions lacking the necessary unity, the applicant is typically compelled to choose one invention to pursue within the original application.[6]

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3 UK: *Patents, Designs and Trade Marks Act 1883*, s.33; Theodore A. Seegrist, Delay in Claiming, 21 J. PAT. OFF. SOC'y 741 (October 1939).

4 Paris Convention for the Protection of Industrial Property, as revised at The Hague Act (6 Nov. 1925), art. 4(f).

5 Paris Convention for the Protection of Industrial Property, Lisbon Act (31 Oct. 1958), art. 4 (G)(2).

6 World Intellectual Property Organization (WIPO), Standing Committee on the Law of Patents, *Study on Unity of Invention*, SCP/36/4.

9. Subsequently, the applicant must file one or more divisional applications to separately pursue patent protection for the remaining inventions identified by the examining authority. In this scenario, the requirement to divide the application is involuntary, as the applicant is responding to an official objection or finding from the patent office. The mandatory nature of this division underscores that it is triggered by a substantive examination of the patent claims, rather than strategic considerations by the applicant.

10. The procedural specifics associated with mandatory divisionals, including the applicable timelines, fees, and documentation requirements, can vary significantly between patent jurisdictions. In some jurisdictions, failure to comply with a mandatory division order within a specified timeframe may result in the non-elected (i.e. additional) inventions disclosed in the initial application being deemed withdrawn/abandoned, with examination continuing on the elected (often first-mentioned) invention. Consequently, mandatory divisional applications represent an obligatory procedural step to maintain patent coverage for distinct inventions originally disclosed but found to lack unity of invention.

11. In contrast, **voluntary divisional applications** are initiated solely at the discretion of the patent applicant, independently of any official requirement or finding of lack of unity. Rather, applicants proactively file these divisionals to manage their inventions and claims strategically. Such filings are entirely elective and reflect the applicant's choice to separate different aspects, embodiments, or scopes of an invention into distinct patent applications. This allows for enhanced flexibility and the possibility of obtaining multiple, independently enforceable patents stemming from the same original disclosure.

12. While mandatory divisionals respond primarily to official findings and procedural obligations, voluntary divisionals provide applicants with proactive opportunities for strategic patent portfolio management. However, the specific procedural frameworks, timing restrictions, and limitations for filing voluntary divisional applications differ considerably across jurisdictions. Some jurisdictions offer broad latitude for voluntary divisionals, permitting their filing at nearly any stage of the examination process, including during the appeals period in cases of refusal of the parent application, while others impose strict time limits, procedural conditions, or other statutory restrictions aimed at discouraging strategic abuses or unwarranted prolongation of examination and the period of uncertainty regarding patentability.

13. In most jurisdictions, once a divisional has been filed, a later refusal or withdrawal of the parent does not affect the divisional's content or pendency; it continues independently. Additionally, many patent systems condition the filing of a divisional on the parent being pending at the time of filing. Where a patent has lapsed or become abandoned, many offices provide remedial mechanisms that if granted, may retroactively cure the loss of rights so that the parent is deemed to have been pending throughout. In these systems a divisional filed "in the gap" may be validated once the loss is remedied. By contrast, other frameworks may treat codependency strictly: a divisional cannot properly claim benefit if the parent was abandoned at the time the divisional was filed.[7]

[7] EPO, *Guidelines for Examination*, A-IV, 1.1.1 "Pendency of the earlier application; U.S. Patent & Trademark Office, *Manual of Patent Examining Procedure* § 211.01(b), I ("Copendency") (Rev. 01.2024).

D. RATIONALE AND STRATEGIC CONSIDERATIONS FOR VOLUNTARY DIVISION

14. Voluntary divisional applications allow patent applicants significant strategic flexibility, enabling them to optimize the management of their intellectual property portfolios. Unlike mandatory divisional filings, which respond to official determinations of lack of unity, voluntary divisional applications are proactively initiated by applicants, allowing them to align patent prosecution processes closely with business objectives, legal strategies, and commercial considerations. The key rationales and strategic purposes underlying voluntary divisional filings are described below.

Addressing Unity of Invention Proactively

15. Applicants may use voluntary divisional applications to proactively address unity of invention requirements before receiving an objection from patent authorities. Rather than waiting for mandatory divisional requirements imposed by examiners, applicants can pre-emptively structure their applications into clearly unified claim sets.[8]

Preservation of Rights through Continued Pendency

16. Filing voluntary divisional applications can maintain pendency of patent applications, allowing applicants additional flexibility to respond to market developments, evolving technology landscapes, or competitor strategies. Through careful timing and strategic filing, divisional applications maintain a continuous and adaptable patent presence, which may be useful in dynamic and competitive technological fields.[9]

Accelerating Patent Protection for Certain Inventions or Claim Sets

17. By filing a voluntary divisional application, an applicant may separate out clearly defined inventions or claims that are more likely to progress quickly through the examination process. Narrower or simpler inventions may thus be protected sooner, providing immediate enforceable rights and potentially commercial and competitive advantages. This allows for simultaneous, yet separate, prosecution of broader or more complex claims without delaying the overall protection of key, commercially significant elements.[10]

Enhanced Management of Patent Prosecution Timelines and Procedures

18. Patent prosecution can often become procedurally complex or protracted, especially for claims facing substantial objections or requiring extensive argumentation. Voluntary division offers a procedural strategy to isolate problematic or heavily contested claims into separate divisional applications. This can effectively restart examination in a fresh case, affording additional opportunities for amendment, evidence submission, and negotiation with patent examiners.[11]

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8 See comments received from the Czech Republic in response to C.9260.; M. *Sakthivel* and N. *Sharma*, "Interpretational Dilemma on Divisional Patent Applications in India," NTUT Journal of Intellectual Property Law and Management, vol. 11, no. 2, pp. 1–11, 2022; K. *Foss-Solbrekk*, "The Divisional Game: Using Procedural Rights to Impede Generic/Biosimilar Market Entry," IIC – International Review of Intellectual Property and Competition Law, vol. 53, pp. 1007–1037, 2022.

9 K. *Rizzuto*, "Fixing Continuing Application Practice at the USPTO," Marquette Intellectual Property Law Review, vol. 13, no. 2, p. 411, 2009.

10 See comments received from Germany in response to C.9260; E. *Arezzo*, "Divisional Applications and Patent Portfolios in Europe: Will Patenting Strategies Change after the Introduction of the Unitary Patent and the UPC?" GRUR International, vol. 74, no. 3, pp. 205–216, 2025.

11 See comments received from Brazil in response to C.9260.

Risk Mitigation and Strengthened Enforceability

19. Voluntary divisional applications are sometimes used to distribute related claim sets across multiple patents. Doing so can preserve protection if one patent is narrowed, opposed, or held invalid, thereby maintaining commercial leverage and reducing reliance on a single grant. Such practices are, however, prone to creating patent thickets and raising costs for competitors, and they may also increase applicants' own filing, prosecution, and portfolio-management costs. Many jurisdictions seek to temper these effects through unity-of-invention and double-patenting rules and through fee structures.[12]

Strategic Flexibility in Licensing and Commercial Exploitation

20. When unity is not present, voluntary division facilitates tailored commercial strategies by creating multiple patents covering related but distinct inventions. This segmentation is particularly beneficial where inventions involve separate market applications, product categories, or technical embodiments. Having multiple patents allows the applicant to structure targeted licensing arrangements, field of use licensing, selectively enforce specific patent claims, and align their IP portfolio according to diverse market needs, international standards, potential licensees, or geographic regions.[13]

Responding to Legal or Case-Law Shifts

21. Evolving judicial interpretations and examination guidelines can swiftly redefine the criteria applied to patent claims, disclosure sufficiency, and inventive step analysis. Voluntary divisional filing offers applicants an agile mechanism to realign claim scope and supporting arguments with the most current legal expectations while leaving the parent application undisturbed. By commencing a fresh prosecution track, applicants can tailor amendments, introduce updated evidence, and engage examiners under the newly clarified standards.[14]

E. PROHIBITION OF DOUBLE PATENTING

22. A fundamental principle recognized across patent systems is the prohibition against **double patenting**, a scenario in which the same applicant obtains two or more patents covering identical or substantially identical inventions. The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. Double patenting can be broadly categorized into two types: **exact double patenting** and **obviousness-type double patenting**.[15]

23. **Exact double patenting** occurs when claims in two separate patents are identical, granting redundant protection to precisely the same invention.[16]

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12 See comments received from Germany and Brazil in response to C.9260.; C. Righi and T. Simcoe, "Patenting inventions or inventing patents? Continuation practice at the USPTO," *RAND J. Econ.*, vol. 54, no. 3, pp. 416-442, Fall 2023.

13 See comments received from Germany and Brazil in response to C.9260.; C. Righi and T. Simcoe, "Patenting inventions or inventing patents? Continuation practice at the USPTO," *RAND J. Econ.*, vol. 54, no. 3, pp. 416-442, Fall 2023.

14 U.S. PTO Office of the Chief Economist, *Adjusting to Alice: USPTO Patent Examination Outcomes after Alice Corp. v. CLS Bank International*, Apr. 2020.; E. Arezzo, "Divisional Applications and Patent Portfolios in Europe: Will Patenting Strategies Change after the Introduction of the Unitary Patent and the UPC?," *GRUR International*, vol. 74, no. 3, pp. 205-216, Mar. 2025.

15 United States (USPTO) – *Manual of Patent Examining Procedure (MPEP) § 804, "Definition of Double Patenting"* (R-07.2022; rev. Feb. 2023); European Patent Office, *Guidelines for Examination in the EPO*, Part G-IV, 5.4 "Double patenting" (1 March 2024); See comments received from the EPO in response to C.9260.

16 United States (USPTO) – *Manual of Patent Examining Procedure (MPEP) § 804, "Definition of Double Patenting"* (R-07.2022; rev. Feb. 2023).

24. **Obviousness-type double patenting** arises when the claims, though not strictly identical, differ only in trivial or obvious ways such that they fail to represent patentably distinct inventions.[17]

25. Both forms of double patenting raise significant policy and practical concerns within patent systems. First and foremost, in cases where the filing dates differ, double patenting undermines the foundational patent principle of limited exclusivity, by effectively extending the duration of protection beyond the statutory period. Such extension unjustly restricts market competition and delays the entry of technology into the public domain. Furthermore, it creates legal uncertainty for competitors and other market participants, complicating risk assessments and investment decisions due to overlapping and ambiguous patent rights. Additionally, double patenting unnecessarily burdens administrative and judicial resources by multiplying enforcement, opposition, and invalidity proceedings involving essentially identical inventions.

26. The policy rationale underpinning the prohibition against double patenting thus emphasizes fairness, clarity, and predictability within the patent system. Ensuring that each patent application and the resulting patent grant cover only patentably distinct inventions fosters legal certainty, simplifies patent landscaping, and facilitates the equitable functioning of competitive markets.

Double Patenting and Divisional Applications

27. The prohibition of double patenting is particularly pertinent in the context of divisional applications, given that divisional filings inherently originate from a shared disclosure contained within a single parent application. However, the manner in which double patenting intersects with divisional applications varies depending on whether the division is mandatory or voluntary.

Mandatory Divisional Applications and Double Patenting

28. Mandatory divisional applications typically arise in response to a formal determination by a patent examining authority that a single patent application includes more than one distinct invention and therefore does not meet the unity of invention requirement. In such cases, the applicant is obliged to separate the multiple inventions into distinct divisional applications, each subject to its own independent examination process.[18]

29. Due to their very nature, mandatory divisional applications significantly mitigate the risk of double patenting, as the examining authority explicitly identifies and delineates the separate inventions that must be pursued independently. Patent offices, through their communications and formal objections, clarify the boundaries between the separate inventions, instructing applicants precisely on how to divide and amend their claims. This ensures each divisional application claims a patentably distinct invention, thereby minimizing the potential for exact or obviousness-type double patenting.[19]

30. Nevertheless, even in the context of mandatory divisional applications, careful drafting remains essential. Patent offices generally require that the claims of each divisional application be clearly distinguished from those of the parent application and other divisional filings arising from it. If claims are not adequately differentiated, patent examiners typically issue formal objections or rejections based on double patenting concerns. Applicants may then be required to amend claims, withdraw overlapping subject matter, or, in some jurisdictions, adopt other remedial measures such as disclaimers. Thus, even mandatory divisional applications require

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17 United States (USPTO) – *Manual of Patent Examining Procedure (MPEP) § 804, "Definition of Double Patenting"* (R-07.2022; rev. Feb. 2023).

18 See comments received from Brazil in response to C.9260.

19 Canadian Intellectual Property Office, Manual of Patent Office Practice (MOPOP), ch. 18: Novelty, Obviousness and Double-Patenting, § 18.06.04 "Division at the Direction of the Office".

applicants' diligence in clearly articulating patentably distinct inventions to avoid potential conflicts and preserve the enforceability and validity of resulting patents.

Voluntary Divisional Applications and Double Patenting

31. **Voluntary divisional applications** are initiated independently by the applicant, without any directive or official determination from the patent office regarding a lack of unity of invention. These filings typically reflect strategic decisions aimed at optimizing patent protection, portfolio management, and commercial flexibility. However, precisely because voluntary divisionals are filed at the applicant's discretion, rather than in response to explicit office instructions, they carry a heightened risk of creating inadvertent double patenting issues.

32. In the absence of an official directive to separate distinct inventions, the applicant bears sole responsibility for drafting clearly differentiated claims between parent and divisional applications. Without careful delineation, claims may unintentionally (or sometimes deliberately) overlap, triggering concerns about either exact or obviousness-type double patenting.

33. When examining voluntary divisional applications, patent offices carefully scrutinize claim scopes in relation to those of parent and other related divisional applications. If overlapping or substantially similar claims are identified, examiners typically issue formal objections, requiring applicants to amend or clarify their claims to remove duplication or ambiguity. These interventions are essential to preserving the integrity of the patent system by ensuring each patent covers a distinct invention or inventive concept, thereby preventing undue extension of exclusivity periods.

34. In some jurisdictions, applicants have the option to resolve certain double patenting objections through the filing of a **terminal disclaimer**. A terminal disclaimer is a formal legal declaration disclaiming any patent term extending beyond the expiration of a related earlier patent, effectively synchronizing their expiration dates. This mechanism allows overlapping or closely related claims to coexist, provided the applicant accepts the concurrent expiration of the patents involved, thereby mitigating the risk of an unjustified extension of monopoly. In practice, such disclaimers are most pertinent where the later expiring patent would otherwise have a longer term, whereas if the patents would already expire together, a terminal disclaimer is often unnecessary.

35. Some stakeholders have raised concerns that frequent reliance on terminal disclaimers to address double patenting can allow multiple patents with closely related claims to persist around a single inventive concept, potentially increasing the number of overlapping rights and contributing to portfolio complexity and higher clearance, licensing, and dispute-resolution costs. It has also been observed that, while a terminal disclaimer aligns expiry dates and may be accompanied by conditions that tie related rights it does not necessarily reduce the number of patents within a family, so the practical burdens associated with multiple, closely related rights may remain. Additional issues noted in some jurisdictions include how terminal disclaimers interact with administrative or regulatory adjustments or extensions to patent term, and how the management of linked families over time can affect enforceability and portfolio strategy.[20]

36. Additionally, terminal disclaimers and similar instruments are not available universally. Many patent systems instead require that applicants proactively amend their claims or explicitly withdraw overlapping subject matter prior to patent grant. Consequently, applicants utilizing voluntary divisional applications must meticulously manage claim drafting and prosecution strategies, clearly distinguishing the scope of each divisional from related patent family members to ensure compliance with jurisdiction-specific prohibitions against double patenting.

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[20] Mark A. Lemley & Lisa Larrimore Ouellette, Fixing Double Patenting, 74 Am. U. L. Rev. 1013 (2025).

37. In some jurisdictions, multiple co-pending applications may proceed even if they share the same description, provided their claims are directed to different subject matter. Where co-pending applications by the same applicant share the same effective date and claim the same invention, authorities typically require an election with any unremedied duplicate commonly refused at grant. By contrast, partial overlap of claim scope alone is often tolerated and may not trigger a double patenting objection. In some jurisdictions, if two applications with the same effective date are filed by different applicants, each can proceed independently.[21]

F. PROBLEMS COMMONLY ASSOCIATED WITH VOLUNTARY DIVISIONAL APPLICATIONS

38. Voluntary divisional applications offer patent applicants strategic flexibility and important procedural options in managing their intellectual property rights. However, their use has raised concerns among some stakeholders regarding possible implications for competition, market predictability, and the overall balance within patent systems. At the same time, it must be acknowledged that perspectives vary considerably, and there is no unanimous agreement among stakeholders as to whether the identified issues genuinely constitute misuse or instead represent acceptable strategic practices within existing legal frameworks. While certain jurisdictions have recognized and sought to address potential concerns, approaches remain diverse, and no unified consensus has emerged regarding the precise nature of these issues or appropriate solutions. As a result, voluntary divisional applications continue to represent an area characterized by differing views, reflecting the inherent complexity and nuance of balancing patent applicants' legitimate interests, broader policy objectives, and public interest considerations. Some of the potential concerns that have been raised are described below.

Strategic Delay and Market Uncertainty

39. Voluntary divisional applications give applicants a practical means to keep at least one member of a patent family pending while earlier members move through examination or appeal. By filing a fresh application derived from the same original disclosure, an applicant restarts the examination timetable and gains renewed opportunities to amend claims, submit data, or adjust the invention’s framing in light of commercial developments.

40. Supporters of the practice point out that legitimate divisional filings can accommodate after-arising test results or divergent commercial embodiments that could not be anticipated when the parent was drafted.

41. Critics, however, observe that a sequence of voluntary divisionals can extend the period during which rivals lack certainty about what the eventual scope of protection will be. This uncertainty may prompt cautious product development strategies, higher due diligence costs, or delayed entry, especially in sectors where research cycles and regulatory approval already stretch for many years. Regulators typically allow divisionals so long as no fresh matter is introduced, yet the absence of a firm outer limit on the timing or frequency of such filings means the period of pendency can, in some technology areas, outlast the commercial life of the underlying product. Whether this amounts to an abuse of the system remains contested: some commentators view extended pendency as a predictable outcome of complex R&D pipelines, while others regard it as a tactical lever that shifts risk and information costs onto later innovators.

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[21] European Patent Office, *Guidelines for Examination in the EPO*, Part G-IV, 5.4 “Double patenting” (1 March 2024); See comments received from Brazil in response to C.9260.

42. Somewhat mitigating this concern, some courts have developed discretionary declaratory relief to reduce the uncertainty caused by extended divisional prosecution. For example, in the United Kingdom, an Arrow declaration allows a court to declare that a specified product or process used by an entrant was old or obvious at the relevant priority date, thereby giving the would-be entrant a pre-emptive Gillette defense (i.e., if the allegedly infringing activity was old or obvious at the priority date then the patent is either invalid or not infringed) against later-granted divisionals. Comparable, Arrow type relief has also been accepted by Dutch courts.[22]

Patent Thickets and Portfolio Complexity

43. When multiple voluntary divisionals are pursued from a single parent application they can accumulate into dense clusters sometimes labeled “patent thickets.” In these situations, each individual patent may satisfy formal requirements, yet the portfolio as a whole can create an intricate web of rights through which competitors must navigate. Freedom to operate exercises become more time-consuming, because counsel must compare each claim in each family member against prospective product features, licensing terms, or design alternatives. Larger enterprises with specialized in-house expertise may absorb this complexity as a routine business cost and even benefit from cross-licensing opportunities. Smaller entities, however, may find the aggregate legal exposure so opaque that they decide either to abandon certain research avenues or to devote disproportionate resources to clearance opinions. The debate is not one-sided: proponents emphasize that a finely granulated portfolio can delineate inventive contributions with precision and enable tailored licensing strategies that match distinct value propositions. Detractors counter that the same granularity can function as a deterrent, raising barriers to entry in ways unrelated to genuine technological merit. Because the thicket phenomenon arises from cumulative behavior rather than a single patent, policy responses to this phenomenon have been elusive. At the same time, IP-intensive markets often self-organize around these costs, using cross-licensing networks, patent pools, and standards-based licensing to cut through potential thickets as market participants have strong incentives and capacities to devise transactional solutions that mitigate anti-commons effects.[23]

Evasion of Judicial Scrutiny and "Evergreening"

44. Voluntary divisionals also interact with litigation dynamics in subtle ways. A patentee facing an imminent invalidity challenge on specific claims can, within permissible procedural windows, cancel those claims in the parent while pursuing revised or broadened variants in a newly filed divisional. The “splintered” application begins its examination afresh, often before a different examiner panel, and the contested subject matter reenters the administrative pipeline insulated from the immediate judicial record. Observers who criticize the practice describe it as a form of “evergreening,” noting that the sequential reshaping of claims can prolong exclusivity without changing the underlying inventive contribution. Those more sympathetic emphasize that scientific progress is incremental and that emerging data such as new clinical results, improved manufacturing methods, or evolving safety profiles may warrant a genuine

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22 See comments received from Colombia, Brazil and Germany, in response to C.9260.; K. *Rizzuto*, “Fixing Continuing Application Practice at the USPTO,” Marquette Intellectual Property Law Review, vol. 13, no. 2, p. 411, 2009; Y. *Hou*, I. P. L. *Png*, and X. *Xiong*, “When stronger patent law reduces patenting: Empirical evidence,” Strategic Management Journal, vol. 44, no. 4, pp. 977–1012, 2023; K. Foss-Solbrekk, “The divisional game: Using procedural rights to impede generic/biosimilar market entry,” *IIC – Int. Rev. IP & Competition L.*, vol. 53, pp. 1007–1037, 2022; C. Righi, D. Cannito, and Theodor Vladasel, “Continuing patent applications at the USPTO,” *Research Policy*, vol. 52, no. 4; *Arrow Generics Ltd. v Merck & Co Inc [2007] EWHC 1900 (Pat); Fujifilm Kyowa Kirin Biologics Company Ltd v Abbvie Biotechnology Ltd [2017] EWHC 395 (Pat);* District Court of The Hague held it had jurisdiction to hear Arrow-type claims (e.g., *Pfizer v Roche*, 8 May 2019).

23 See comments received from Colombia, Brazil and Germany in response to C.9260; View of The Long CON: An Empirical Analysis of Pharmaceutical Patent Thickets,” 2024; Jonathan M. Barnett, *The Anti-Commons Revisited*, 29 Harv. J.L. & Tech. 127, (2015).

realignment of claim scope to facilitate product lifecycle management. Whether a given divisional represents abusive gamesmanship or responsible portfolio management thus depends on context: the timing of the filing, the extent of claim overlap, and the transparency with which applicants disclose their intentions to both examiners and rival market actors. As a note of caution, the very notion of "evergreening" is contested and definitions vary amongst stakeholders. Against that backdrop, some stakeholders advocate compulsory terminal disclaimers or enhanced estoppel rules to curb perceived abuse, whereas others caution that rigid constraints could stifle beneficial follow-on research and diminish the flexibility needed in fast-moving technical fields.[24]

Double Patenting Concerns and Ambiguous Claim Boundaries

45. Because voluntary divisionals share the same initial disclosure as their parents, they can raise issues of double patenting when claim language in separate family members captures substantially the same inventive concept. Most patent systems recognize a boundary between legitimate differentiation such as claiming a method in one patent and a composition in another and the granting of multiple patents for indistinguishable subject matter. Defining that boundary, however, is notoriously difficult. Applicants may argue that even modest linguistic adjustments reflect meaningful inventive distinctions, while opponents may view the same adjustments as cosmetic. Examiners and courts apply statutory or common law doctrines intended to prevent unjustified extension of monopoly rights, yet those doctrines differ in wording, scope, and procedural treatment. In the judicial context, these doctrines operate as claim interpretation rules (e.g., the doctrine of equivalents, prosecution-history/file-wrapper estoppel, purposive construction, and the pith-and-marrow approach) and are applied to delineate the scope of the claims before assessing overlap or patentable distinctness. As a result, because both the substantive double patenting standards and the claim interpretation tools vary across jurisdictions, two patents that would be deemed overlapping in one jurisdiction might be separately enforceable in another, contributing to a patchwork of legal outcomes. In practice, the potential for double patenting is entwined with claim drafting strategies: broad claims in one family member paired with narrower, fallback claims in another can leave competitors uncertain about which boundaries truly define the exclusionary zone. Some commentators propose heightened disclosure duties or harmonized examination guidelines to clarify where legitimate divisional practice ends, and impermissible redundancy begins. Others caution that a one-size-fits-all rule could inadvertently penalize applicants whose inventions legitimately span multiple distinct aspects of a given technology.[25]

Increased Litigation and Enforcement Costs

46. A portfolio comprising numerous divisionals can amplify the scope, duration, and cost of patent disputes. Each additional patent represents a separate legal right that can be asserted, opposed, or licensed, thereby multiplying the number of potential pleadings, claim construction hearings, expert reports, and settlement pathways. From the patentee's perspective, a suite of related patents provides strategic depth: if one claim set falters under validity scrutiny, another may still stand, sustaining leverage in negotiations. From the perspective of alleged infringers, the same multiplicity can create cumulative defense expenses, necessitating broader searches for prior art, larger technical teams, and more complex validity or non-infringement arguments. These costs are not necessarily wasteful; a diversified portfolio might reflect genuine technological breadth and justify layered enforcement. Nonetheless, observers worry that litigation initiated on several divisionals at staggered intervals can function as a war of attrition,

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24 See comments received from Brazil in response to C.9260.; K. *Rizzuto*, "Fixing Continuing Application Practice at the USPTO," Marquette Intellectual Property Law Review, vol. 13, no. 2, p. 411, 2009; Erika Lietzan, *The "Evergreening" Metaphor in Intellectual Property Scholarship*, 53 Akron L. Rev. 805 (2019).

25 See comments received from Colombia, the Czech Republic, Brazil, Germany, Singapore and the EPO in response to C.9260.

pressuring smaller rivals to settle on terms unrelated to the underlying merits. Alternative dispute resolution mechanisms, fee shifting rules, or consolidated case management procedures are sometimes suggested as ways to temper the escalation of costs without unduly limiting a patentee's right to protect each facet of its innovation. Whether such reforms are necessary remains a point of active debate among jurists, scholars, and industry practitioners, illustrating the delicate balance between robust enforcement and the preservation of open, competitive markets.[26]

G. COMPETITION LAW AND VOLUNTARY DIVISIONAL APPLICATIONS

47. In recent years, competition authorities and courts have examined how the strategic use of voluntary divisional patent applications can impact market competition. The intersection of divisional patent practice with competition law has been highlighted especially in the pharmaceutical industry, where patent portfolios are used to delay generic entry. Government studies and enforcement actions show an emerging concern that the accumulation of multiple patents including divisionals around a single invention can contribute to the foreclosing of competition.

48. In 2009, a seminal examination of these issues appeared in the European Commission's Pharmaceutical Sector Inquiry, a government-commissioned study into originator (brand-name) drug companies' patenting and litigation strategies. The Inquiry's Final Report documented that originator companies were increasingly filing large numbers of patents per product, including a high proportion of voluntary divisional applications, in what the Commission termed "patent clusters". Importantly, the report distinguished between divisional applications filed because an examiner required it and those filed voluntarily. It found that the vast majority of divisional filings were voluntary: by 2007 about 80% of divisionals in the EU pharmaceutical sector were applicant-initiated, not examiner-mandated. The Commission noted a sharp rise in such filings in the 2000–2007 period, identifying it as a trend in industry patenting behavior.[27]

49. The European Commission stopped short of condemning divisional applications as a general matter. However, it raised concerns about their use under certain conditions. The Inquiry reported that some originator firms pursued multiple generations of divisionals and assembled dense patent clusters around blockbuster drugs. According to the Commission's analysis, these practices "seemingly serve to prevent or delay generic entry". The intended effects of patent clusters and divisionals were found to be similar: creating a web of IP rights that a generic competitor must navigate or litigate before launching. In the Commission's words, "the denser the web created by the patent clusters and/or the divisionals is, the more difficult it will be for a generic company to bring its generic version to market". Even if each patent is valid, the sheer number can produce legal uncertainty for competitors. This lack of certainty can deter generic firms from entering "at risk" (e.g., before all patents expire or are invalidated) due to fear of infringement suits on one of the many patents. As a non-enforcement study, the Sector Inquiry did not declare such practices unlawful, but it recommended closer competition-law scrutiny. In its conclusions, the European Commission suggested that competition law enforcement could be intensified if patenting tactics like multiple divisionals or strategic litigation were used to abusively prolong market dominance.[28]

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[26] See comments received from Brazil and Germany in response to C.9260; K. Foss-Solbrekk, "The Divisional Game: Using Procedural Rights to Impede Generic/Biosimilar Market Entry," *IIC – International Review of Intellectual Property and Competition Law*, vol. 53, pp. 1007-1037, Aug. 2022; A. Galasso and M. Schankerman, "Patent Thickets and the Market for Innovation: Evidence from Settlement of Patent Disputes," CEP Discussion Paper 889, London School of Economics, Aug. 2008.

[27] European Commission, Directorate-General for Competition. (2009, July 8). *Pharmaceutical sector inquiry: Final report*.

[28] European Commission, Directorate-General for Competition. **(**2009, July 8). *Pharmaceutical sector inquiry: Final report.*

50. Shortly after this inquiry was released, the European Patent Office implemented a two-year filing window. From April 2010, a divisional could, in most cases, be filed only within 24 months of the first examination report on the parent. One of the reasons for this change was to limit the number of cascading divisionals that kept subject-matter pending indefinitely. However, this change was later reversed with effect from April 2014 after complaints that legitimate protection was being lost. Instead, surcharge fees were introduced that escalate with each subsequent generation which act to disincentivize cascading divisionals. Although emanating from the patent office rather than a competition authority, the 2014 rule change can be considered a structural measure located within the patent system that reflects the competition concerns articulated in the Sector Inquiry.[29]

51. A post-inquiry judgement directly testing the intersection of divisionals and competition law comes in Pfizer/Xalatan, where the Italian Competition Authority in 2012 fined Pfizer EUR 10.6 million for filing a second generation divisional and obtaining a late supplementary protection certificate (SPC) based on it, steps the authority found had "artificially" extended patent protection for latanoprost and discouraged generic entry through warning letters. The decision characterized the voluntary divisional as part of a single exclusionary strategy that converted an otherwise lawful filing right into an instrument of dominance, marking the first European infringement decision to single out a voluntary divisional application itself as an abuse.[30]

52. Lengthy follow-on litigation in Italy culminated on January 2, 2024, when the Italian Supreme Court upheld both liability and damages in the above matter. Rejecting Pfizer's arguments that the divisional and SPC were valid under patent law, the Court treated legality under the European Patent Convention as "irrelevant" once the purpose of the divisional was shown to be anticompetitive. It therefore ordered Pfizer to pay EUR 13.36 million to reimburse the National Health Service for excess expenditure during the exclusionary period. The judgment confirms that a divisional centered antitrust abuse can trigger civil compensation in addition to public fines, widening the financial exposure for originators who employ cascading divisionals to fence off competition.[31]

53. Most recently, on October 31, 2024, the European Commission fined Teva EUR 462.6 million in Teva/Copaxone for Teva's misuse of divisional patents through the staggered filing of overlapping divisionals on process and dosage claims for glatiramer acetate, combined with the strategic withdrawal of patents just before likely revocation so that generics had to restart clearance actions again and again. The Commission held that "patent validity challenges are an important expression of competition between originator and generic companies" and that "Teva's conduct obstructed their effectiveness, artificially prolonged the legal uncertainty concerning the validity of its remaining patents". Teva/Copaxone is the first Commission decision to declare the misuse of voluntary divisional applications itself an abuse of dominance and shows that escalating fee surcharges at the EPO were not sufficient to neutralize anticompetitive filing strategies.[32]

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29 CA/D 2/09 of 25 March 2009 amending Rules 36, 38 and 135 EPC, *OJ EPO* 2009, 296; CA/D 14/13 of 13 December 2013 amending Article 2 of the Rules relating to Fees, *OJ EPO* 2014, A5 – introduced the escalating "additional fee" for second- and subsequent-generation divisionals from 1 April 2014.

30 Autorità Garante della Concorrenza e del Mercato (Italian Competition Authority), Decision No. 23194, Case A431 – Ratiopharm/Pfizer (Xalatan), 11 January 2012, published in *Bollettino* 2/2012.

31 Corte Suprema di Cassazione (Italy), Sezione I Civile, Ordinanza n. 9, 2 January 2024, *Pfizer Italia S.r.l. v Ministero della Salute & Ministero dell'Economia e delle Finanze*.

32 European Commission, Decision C(2024) 7448 final of 31 October 2024, Case AT.40588 – Teva Copaxone, summary published in *OJ* 2025/C 1680, 19 March 2025.

54. In the United States, the competition law framework has evolved somewhat differently. The Seventh Circuit's Humira judgment sits at the center of the U.S. debate over the intersection of continuation applications and competition law. In this case, the drug manufacturer stitched more than 130 continuation and divisional patents into a defensive lattice that extended nominal exclusivity years beyond the molecule's (adalimumab) base patent. Purchaser plaintiffs framed that web of related patents as a blocking tactic designed to frighten biosimilar sponsors out of at-risk launches and then cemented, according to the complaint, by synchronized European and U.S. settlement deals that allowed earlier EU entry in exchange for a U.S. standstill until 2023. Against a policy background that now casts such layering with growing suspicion at the USPTO and FTC, the case was widely expected to test whether U.S. courts would follow Europe in treating multiplicative filings as potentially abusive in themselves. Instead, the decision highlighted that under current federal doctrine, quantity alone cannot transmute the legitimate pursuit of patent rights into an antitrust offense. The decision rests on two pillars. First, the court declared that "the patent laws do not set a cap on the number of patents any one person can hold—in general, or pertaining to a single subject," invoking examples from Thomas Edison to modern technology firms to illustrate that prolific inventing is neither suspect nor unusual. Second, it held that petitions to the USPTO remain protected unless they are "objectively baseless" or procured by fraud. Because the payor plaintiffs disclaimed fraud, and they could not allege any invalid or sham patents and attacked only the aggregate size and settlement pattern of the portfolio, their claims collapsed. The Seventh Circuit therefore affirmed the dismissal in full, reinforcing the message that building a wall of continuations and divisionals generally remains lawful under U.S. antitrust law, unless the patent was obtained by fraud, even if parallel regulators increasingly view the same tactic as anticompetitive.[33]

55. These different approaches taken by competition authorities and courts mean that strategies built around serial divisionals or continuations must now be evaluated not only for patent law validity but also for their legality from a competition law perspective in each key market.

II. LEGAL FRAMEWORKS FOR THE VOLUNTARY DIVISION OF PATENT APPLICATIONS

A. THE INTERNATIONAL LEGAL FRAMEWORK

56. At the international level, the principles underpinning the voluntary division of patent applications are reflected across a range of multilateral treaties. These international instruments provide broad harmonization and establish universal standards applicable to divisional filings, creating a foundational legal framework that guides national and regional patent systems. While the detailed implementation and procedural nuances remain within national jurisdictions, several key international treaties set essential obligations and minimum standards for divisional practice, directly or indirectly influencing the concept and availability of voluntary divisionals worldwide.

[33] The published citation is Mayor & City Council of Baltimore v. AbbVie Inc., 42 F.4th 709 (7th Cir. 2022) (No. 20-2402, decided Aug. 1, 2022).

The Paris Convention for the Protection of Industrial Property

57. The right of applicants to avail themselves of divisional applications is explicitly recognized by Article 4G of the Paris Convention which provides:

> (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.
>
> (2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized

58. Article 4G(1) grants applicants the flexibility to address unity objections by dividing the application into multiple divisional applications if, during examination, there is a finding of non-unity. Each divisional application retains the priority date of the original application, ensuring that the applicant does not lose the right of priority based on the filing date of the initial application. It should also be noted that in the French text of the Paris Convention (which prevails over translations) Article 4G(1) uses the term “complexe” in place of the English wording of “contains more than one invention”. It thus may happen that, according to the legislation of the country of examination, a patent application is considered “complex” for reasons other than lack of unity of invention for example, because it contains a forbidden combination of claims for manufacture and use of the same invention.[34]

59. Additionally, Article 4G(2) of the Paris Convention supports the concept of voluntary divisional applications. Applicants can proactively divide their patent applications at any stage and claim the priority date of the initial application.

60. It is important to note that each member country of the Paris Convention has the authority to determine the specific conditions and requirements for filing divisional applications. This means that the rules governing divisional applications can vary significantly between different jurisdictions. Some countries might have more stringent requirements, while others may offer more flexibility, impacting how applicants approach the filing of divisional applications.

The Patent Cooperation Treaty

61. The Patent Cooperation Treaty (PCT) does not explicitly regulate divisional applications as such; however, it significantly influences the practice of divisionals indirectly through its provisions on unity of invention and subsequent national phase processing.

62. Under Article 3(4)(iii) of the PCT, an international patent application must comply with the requirement of unity of invention. Rule 13 of the PCT Regulations elaborates this principle, detailing the conditions under which an international application fulfills the unity of invention criterion. Specifically, Rule 13.1 states:

> “The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”

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[34] Article 29(1)(c) of the Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979); G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* pages 55–57 (WIPO, WIPO Pub. No. 611, 1968).

63. If during the International Search or International Preliminary Examination, a lack of unity is identified, the applicant may be invited to pay additional fees and obtain a search report for all identified inventions or alternatively amend the claims to address unity objections by restricting the claims to a single identified invention. If neither action is taken, only the first invention is searched, leaving unsearched subject matter that may later be pursued in a national-phase divisional. However, crucially, the PCT itself does not permit the filing of divisional applications at the international stage; instead, divisional applications may be filed in the national or regional office in accordance with that office's own deadlines.

64. Thus, the primary influence of the PCT concerning divisional applications occurs when the international application transitions into national or regional phases. Upon entry into these phases, each designated or elected office is entitled, according to its national law, to allow applicants to file divisional applications derived from the international application. Such national-phase divisional applications typically retain the international filing date and the priority date of the original PCT application.

65. The role of the PCT, therefore, is mainly procedural and supportive rather than substantive regarding divisionals. It sets a unified standard for examining unity at the international level, indirectly prompting applicants to anticipate or address non-unity issues proactively. By establishing the unity of invention as an internationally recognized standard, the PCT facilitates procedural harmonization, creating greater predictability for applicants as they prepare divisional applications in multiple jurisdictions at the national or regional phases.

66. While the PCT currently contains no provision permitting the filing of divisional applications during the international phase, earlier drafting work contemplated such a mechanism. The 1968 drafts of the Treaty and Regulations would have allowed an applicant, in the case of lack of unity, at their option, to "(i) restrict the claims, or (ii) to pay additional fees, or divide the application, or both" but those provisions were deleted in the 1969 draft and did not appear in the final text adopted in 1970. Subsequent PCT reform discussions revisited whether to enable "divisional international applications" or an "internal division" procedure; these proposals illustrate possible models but have not been adopted.[35]

67. In summary, while the PCT itself does not allow divisional applications at the international stage, its emphasis on unity of invention and its harmonization of procedural frameworks significantly shape applicants' divisional filing strategies in subsequent national or regional phases.

<u>The Patent Law Treaty</u>

68. The Patent Law Treaty explicitly addresses divisional applications, ensuring they are encompassed within its scope. Article 3(1) provides:

> (a) The provisions of this Treaty and Regulations shall apply to national and regional applications for patents for invention and for patents of addition, which are filed within or for the Office of a Contracting Party, and which are:
>
> (i) types of applications permitted to be filed as international applications under the Patent Cooperation Treaty;
>
> (ii) divisional applications of the types of applications referred to in item (i), for patents for invention or for patents of addition, as referred to in Article 4G(1) or (2) of the Paris Convention.

[35] WIPO, *Divisional Applications under the PCT*, PCT/R/WG/5/6 (Aug. 21, 2003), paras. 8–10 (1968 draft allowing restriction or division; deletion in 1969 draft) and Annex IV (excerpts of 1968 draft Arts. 17, 34; draft Rules 37, 62); see also paras. 13–19 and Annexes I–III.

69. This article ensures that divisional applications, as recognized under the Paris Convention, specifically Article 4G, are brought within the administrative and procedural framework of the PLT. The provision clarifies that divisional applications, whether created due to unity objections or voluntarily initiated by the applicant, fall under the treaty's standardized formality rules.

70. Further, Article 5(8) of the PLT explicitly preserves applicants' rights regarding divisional applications under the Paris Convention, stating:

> Nothing in this Article shall limit:
>
> (i) the right of an applicant under Article 4G(1) or (2) of the Paris Convention to preserve, as the date of a divisional application referred to in that Article, the date of the initial application referred to in that Article and the benefit of the right of priority, if any
>
> (ii) the freedom of a Contracting Party to apply any requirements necessary to accord the benefit of the filing date of an earlier application to an application of any type prescribed in the Regulations.

71. This provision acts as a safeguard, explicitly affirming the applicant's existing right to retain the initial filing date and the benefit of priority for divisional applications, as established under the Paris Convention. It ensures the PLT does not impose any restrictions or procedural conditions that would conflict with these fundamental rights.

72. Moreover, under the PLT Regulations, Rule 2(6) specifically identifies divisional applications as one of the types of applications referenced in Article 5(8)(ii):

> The types of applications referred to in Article 5(8)(ii) shall be:
>
> (i) divisional applications;

73. This regulatory clarification explicitly categorizes divisional applications, underscoring their procedural recognition and the necessity for Contracting Parties to allow applicants to preserve original filing dates.

74. Additionally, Rule 3(1)(a) of the PLT Regulations allows Contracting Parties to specify certain procedural formalities regarding divisional applications, stating:

> A contracting Party may require that an applicant who wishes an application to be treated as a divisional application under Rule 2(6)(i) indicate:
>
> (i) that he wishes the application to be so treated;
> (ii) the number and filing date of the application from which the application is divided.

75. This regulation grants Contracting Parties discretion to establish clear procedural requirements, such as explicit indications from applicants about the divisional nature of their applications and necessary identifying details of the original parent application. This procedural clarity is essential to effectively administer divisional applications and ensure that applicants fully benefit from their rights under the treaty framework.

76. Thus, while the PLT does not impose substantive patentability standards, it provides comprehensive administrative provisions and clear procedural safeguards relating to divisional applications, harmonizing procedural formalities and preserving fundamental applicant rights established under the Paris Convention.

Agreement on Trade-Related Aspects of Intellectual Property Rights

77. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) does not explicitly mention divisional applications, nor does it impose mandatory or voluntary conditions directly related to their filing, processing, or substantive examination. However, Article 2(1) of TRIPS incorporates by reference certain provisions of the Paris Convention, specifically Articles 1 through 12 and Article 19. This incorporation indirectly obliges TRIPS member countries to adhere to Article 4G of the Paris Convention, which expressly recognizes an applicant's right to file divisional applications, either voluntarily or in response to a finding of lack of unity.

78. The practical effect of this indirect obligation is limited to ensuring that member countries respect the priority date preservation rule set forth in Paris Convention Article 4G. Beyond this fundamental requirement, TRIPS does not further regulate divisional application practices. Consequently, the substantive and procedural details governing divisionals including conditions for filing, permissible timelines, examination processes, fee structures, and double patenting issues are entirely within the discretion of national or regional patent systems.

79. Thus, while TRIPS indirectly safeguards the fundamental priority rights associated with divisional applications via the Paris Convention, it leaves member countries significant flexibility in determining the specific procedural frameworks and substantive criteria applicable to divisional patent filings.

B. NATIONAL AND REGIONAL LAWS AND PRACTICES

Australia

Legal Framework

80. In Australia, the division of patent applications is governed by Section 79B of the Patents Act 1990 (Cth). This provision allows applicants to divide a standard patent application ("the parent") into two or more applications, while maintaining the parent application's priority rights.

Section 79B states:

> (1) If:
> (a) a complete application (the first application) for a patent is made; and
> (b) the first application is not a divisional application for an innovation patent provided for in section 79C;
> the applicant may make a further complete application for a patent for an invention disclosed in the specification filed in relation to the first application.
>
> (2) The further complete application:
> (a) must be made in accordance with the regulations made for the purposes of this subsection; and
> (b) must include the prescribed particulars.
>
> (3) The further complete application can only be made during the period:
> (a) starting on the day the first application is made; and
> (b) ending when any of the following happens:
> (i) the first application lapses;
> (ii) the first application is refused;
> (iii) the first application is withdrawn;
> (iv) a period prescribed by the regulations for the purposes of this subparagraph ends.

81. Section 64(2) of the Patents Act prevents double patenting by prohibiting grant upon a standard application where the application claims an invention that is the same as an invention that is the subject of another patent and made by the same inventor with the same priority date. Section 64(2) states:

> Where:
>
> > (a) an application for a standard patent claims an invention that is the same as an invention that is the subject of a patent and is made by the same inventor; and
> >
> > (b) the relevant claim or claims in each of the complete specifications have the same priority date or dates;
>
> a standard patent cannot be granted on the application.

Interpretive Guidance and Procedural Approach

82. To make a divisional application, the parent application must satisfy several conditions. Specifically, it can be either a standard patent or an innovation patent application, and it may itself already be a divisional application. Additionally, it can originate from a PCT application but cannot be a provisional application. Importantly, the parent application must still be active and not have lapsed, been refused, or withdrawn at the time the divisional application is filed.[36]

83. The divisional application itself must fulfill distinct criteria. It must contain at least one claim clearly and sufficiently disclosed in the parent application, enabling a person skilled in the art to perform the invention. Moreover, the divisional application must have the same applicant(s) as the parent but can list different inventors. It is permissible for the divisional application to derive from two or more separate parent applications. Finally, the divisional application must be submitted no later than three months from the date the parent application's acceptance is advertised, depending on the parent's current status.[37]

84. There is no provision for filing a divisional application where the parent is already a granted patent. Before or during examination, an applicant may amend a patent request under Section 104 of the Patents Act to convert an existing application into a divisional application. However, certain restrictions apply. Specifically, the amendment to convert an application is not allowable if the parent application was filed after the application intended for conversion, if the application to be converted has already been accepted, or if the timeframe during which the divisional application could originally have been filed has passed. Additionally, the patent request must clearly indicate that the application is divisional under Section 79B and must state the number of the parent application.[38]

85. Section 64(2) of the Patents Act prohibits double patenting by disallowing the grant of a standard patent on an application claiming an invention identical to another invention covered by a patent already granted to the same inventor with the same priority date. This prohibition applies equally to divisional applications and their respective parent applications, as well as to unrelated applications. Similarly, objections to innovation patents under Section 101B extend to both divisional and unrelated applications.[39]

86. Furthermore, a Patent Cooperation Treaty (PCT) application designating Australia may serve as a parent for a divisional application, irrespective of whether it has entered the national phase in Australia, provided that the PCT application is still pending when the divisional is filed

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36 See comments received from Australia in response to C.9260.
37 *Ibid*.
38 *Ibid*.
39 *Ibid*.

– that is, it has not lapsed or been withdrawn; and, if it has already entered the national phase, it has not been refused.[40]

87. In Australia, the best method requirement is assessed on the basis of the applicant's knowledge at the time of filing the complete specification. If the applicant later identifies a better method, they do not need to amend the specification. A recent Australian court decision has clarified that with respect to divisional applications, the relevant date for assessing the best mode "knowledge element" was the filing date of the earliest complete specification in the family rather than the divisional filing date itself.[41]

Belarus

Legal Framework

88. In Belarus, division of patent applications and issues relating to double patenting are regulated by paragraph 8 of Article 16 of the Law of the Republic of Belarus dated December 16, 2002, No. 160-Z "On Patents for Inventions, Utility Models, Industrial Designs", which provides:

> "If applications for identical inventions and/or utility models or applications for identical industrial designs have been filed by the same applicant and have the same priority date, a patent may be granted only on the basis of one application selected by the applicant."

89. Further guidance is provided in Chapter 451 of the Resolution of the Council of Ministers of the Republic of Belarus dated February 2, 2011, No. 119, "On Approval of the Regulations on the Procedure for Compiling an Application for the Grant of a Patent for an Invention, Examination thereof and Adoption of a Decision on the Results of the Examination which provides:

> 5341. If the compliance of the claimed invention with all the conditions of patentability is established, but there is another application for an identical invention (and the other application is not withdrawn, and if a decision was taken to refuse to issue a patent in accordance with Article 19(5) or Article 21(3) of the Law, the time limit missed by the applicant is restored) having the same priority date, the Patent Office shall notify the applicants of such applications that, in accordance with Article 16(8) of the Law, a patent may be granted for only one application as determined by the agreement of the applicants.
>
> 5342. In case the priority dates of identical invention and utility model applications of the same applicant coincide, a patent has already been granted for the utility model application and it is in force, the applicant shall be notified that a decision on granting a patent for the identical invention application may be taken only if the utility model patent holder submits to the Patent Office, within three months from the date of the notification, a request for termination of its validity.
>
> 5343. The identity of inventions shall be established on the basis of the claims in respect of which the conclusion has been reached regarding the compliance of the invention with the conditions of patentability, and the identity of an invention and utility model shall be established on the basis of the claims in respect of which the conclusion has been reached regarding the compliance of the invention with the conditions of patentability and the claims of the utility model with which the patent has been granted.

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40 *Ibid*.

41 IP Australia, *Patent Manual of Practice and Procedure*, '5.6.7.5 Best method' ; T*he NOCO Company v Brown and Watson International Pty Ltd* [2025] FCA 887.

Interpretive Guidance and Procedural Approach

90. In Belarus, when applications for identical inventions, utility models, or industrial designs have been filed by the same applicant and share the same priority date, the Patent Office issues a notification to inform the applicant that a patent may be granted for only one of the submitted applications.[42]

91. Following this notification, the applicant must indicate within three months which specific application should proceed to patent grant. Once a decision is made to grant a patent based on the selected application, all authors (i.e., inventors) listed in the multiple applications are indicated as co-inventors. If the applicant fails to respond within the three-month deadline, the Patent Office issues a decision to refuse the grant of a patent for the applications concerned.[43]

92. The Patent Office identifies a double patenting issue in inventions or utility models if the contents of the independent claims are identical. In the case where the independent claims (or one of them) contains features characterized by alternative concepts, the inventions or utility models are recognized as identical if there is a coincidence of the totality of features comprising at least one of such concepts.[44]

Brazil

Legal Framework

93. In Brazil, the division of patent applications is regulated by Articles 26, 27 and 28 of the Brazilian Industrial Property Law No. 9,279, of May 14, 1996 which provide:

> Article 26 - A patent application may, until the end of examination, be divided, ex officio or on request of the applicant, into two or more applications, provided that the divisional application:
>
> > I - makes specific reference to the original application; and
> > II - does not exceed the matter disclosed in the original application.
>
> Sole Paragraph - A request for division not in accordance with the provisions of this article will be shelved.
>
> Article 27 - Divisional applications will have the filing date of the original application and the benefit of the priority of the latter, if any.
>
> Article 28 - Each divisional application will be subject to payment of the corresponding fees.

94. In September 2024, INPI republished two regulations that, among other issues, deal with the administrative processing of divisional applications in order to change the interpretation given to the term "end of the examination", as referred to in Article 26 of IP Law:

> - INPI/DIRPA Ordinance No. 16, of 2024 - Guidelines for Examination of Patent Applications (Block I), in particular, item 3.133, as per transcription:
>
> > *3.133 For the purposes of article 26 of the IP Law, the first application filed is considered an "original application". The application may be divided upon request of the applicant until the end of the examination in the first instance. This time limit*

42 See comments received from Belarus in response to C.9260.
43 *Ibid*.
44 *Ibid*.

does not apply to the division of an application proposed by INPI (ex officio). Divisions of already divided applications will not be accepted.

- INPI/DIRPA Ordinance No. 14, of August 29, 2024 - General procedural rules to explain and comply with the provisions of the IP Law, as regards to specifications concerning the form and content of patent applications and certificates of addition. In special, Articles 50 and 63 defines the term "end of examination", as follows:

> Art. 50. The patent application may be divided only up to the date of the end of the examination of the original application in the first instance, which consists of the date of publication of the decision of granting, denying or definitive shelving.
>
> § 1 - The first application filed is considered the "original application".
> § 2 - Untimely division requests as per the caput will be shelved.
> § 3 - The request for division of an application that has already been divided will be shelved.
> § 4 - The term of the caput does not apply to an ex officio division of a patent application.
>
> Art. 63. For the purposes of articles 26 and 31 of the IP Law, the date of publication in the RPI of the decision to grant, reject or definitively shelve will be considered as the end of the examination in the first instance.
>
> Sole paragraph - The term set out in the caput does not apply to the division of an ex officio patent application."

95. Brazilian IP law does not have a specific article directed to the prohibition of double patenting though double patenting rejection may be raised based on Article 6 of the IP law. Article 6 reads:

> The author of an invention or of a utility model will be assured the right to obtain a patent that guarantees to him the property, under the terms established by this law.

Interpretive Guidance and Procedural Approach

96. For the purposes of Article 26 of the IP Law, the first filed application is considered an "original application" and can only be divided in two or more applications until the end of the examination procedure (First Instance Procedure).[45]

97. In Brazil, a divisional application may be filed voluntarily or in order to overcome an objection of lack of unity of invention raised during the substantive examination. A divisional application may be requested until the date of publication of the decision to grant, reject or definitively shelve the original application. Here the "date of publication" of the decision is the date of publication in the Industrial Property Bulletin. This deadline does not apply to divisional applications proposed by INPI during the substantive examination of the original application. Also, a division request for a divisional application is not allowed. A divisional application is considered an independent application from the original application, despite the fact that both have the same filing date or priority date. During substantive examination, the Patent Examiner will verify whether the subject matter contained in the divisional application exceeds or not the subject matter revealed in the original patent application (Item II of Article 26 of the IP Law). The divisional application cannot exceed the subject matter disclosed in the original application.

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45 See comments received from Brazil in response to C.9260.

Once this criterion is met, the substantive examination will proceed. Otherwise, the divisional patent application will be shelved.[46]

98. Also, if the request for a divisional application is made after the date of the request for examination of the original application, the Patent Examiner shall verify if the divisional application complies with the provisions of Art. 32 of IP Law, related to voluntary amendments, as ruled by the "INPI Guidelines on the Applicability of the Provisions of Article 32 of IP Law in the Examination of Patent Applications" (INPI/DIRPA Resolution No. 93, of 2013), particularly Items 2.6, 2.7, and 3.3. The claimed subject matter in a divisional application cannot exceed the claimed subject matter in the original application. Issues relating to patentability requirements and double protection of divisional applications are examined in the substantive examination procedure based on INPI Guidelines for Examination of Patent Applications, Blocks I and II.[47]

99. When filing for a divisional patent application, the applicant must remove the part of the claimed subject matter that appears in the original application to avoid double patenting. The simple replication of part of the subject matter claimed in the original application to compose a divisional application actually constitutes a "multiplication of the patent application" and not a division, in the sense of Article 26 of IP Law. The question of whether the divisional application claims the same subject matter (partially or in full) contained in the original application is not verified until the examination procedure has started. The examination of double protection in a divisional application is carried out by comparing its claims set with the claims of the original patent application and also with the claims of the other divisional applications, if any. Once a double protection is recognized by the Examiner, the divisional application request is rejected as it does not meet the provisions of Article 6 of the IP Law.[48]

100. In the event that a divisional application claims a more specific subject matter than that claimed on the original application, it will be rejected as it does not comply with the provisions of Article 6 of the IP Law (double protection), considering that the broader subject matter claimed in the original application already covers the specific subject matter claimed in the divisional application. On the other hand, an alternative implementation of the invention may be removed from the set of claims of the original application to be claimed in a divisional application, even if this alternative implementation shares the same inventive concept as the subject matter claimed in the original patent application. If the divisional application contains only subject matter already examined and rejected in the substantive examination of the original patent application, it will be rejected for the same legal reasons presented for the original patent application.[49]

101. In recent years, the Brazilian National Institute of Industrial Property (INPI) has observed a significant increase in the voluntary filing of divisional patent applications, particularly in strategic technological fields. In the view of INPI, many of these divisional applications do not represent genuine divisions of the original application's subject matter but rather replicate portions or the entirety of the original applications. This trend has created unnecessary duplication of work for the patent office, exacerbating the backlog of pending applications. INPI's data indicates that divisional applications have predominantly arisen in sectors such as pharmaceuticals, biopharmaceuticals, biotechnology, electronics, agrochemicals, and telecommunications. Following a steady increase from 2018 to a peak in 2020, there has been a gradual decline in recent years; however, the overall volume remains substantial. Investigations into the reasons behind this proliferation have revealed several strategic objectives pursued by applicants through divisional filings. These strategies include leveraging divisional applications to prolong discussions on controversial examination issues, facilitating exclusive licensing arrangements with multiple licensees for the same invention, and attempting to influence patent examination outcomes by involving multiple examiners. Other problematic practices identified include

46 *Ibid*.
47 *Ibid*.
48 *Ibid*.
49 *Ibid*.

artificially expanding patent portfolios to enhance royalty negotiations within patent pools, initiating multiple infringement suits through separate assignees, and previously, extending patent terms through prolonged examination processes.[50]

102. In the view of INPI, the indiscriminate filing of divisional applications poses serious concerns regarding competition, as pending divisional applications introduce legal uncertainty that can unfairly restrict market entry. In the pharmaceutical industry, this tactic has proven especially problematic, delaying generic drug availability and impeding public access to healthcare. This situation is not unique to Brazil, as similar issues have emerged in various patent jurisdictions globally. In response, INPI has enhanced administrative transparency and efficiency concerning divisional applications. New measures include publicly announcing divisional requests in the INPI Official Bulletin, mandating detailed tracking of claim amendments between original and divisional applications, and adjusting original application claims to eliminate overlaps with divisional filings. Additionally, efforts are made to assign divisional and original applications to the same examiner and to synchronize their examination timelines, aiming for concurrent or near-concurrent decisions. These administrative enhancements seek to mitigate strategic misuse, streamline the examination process, and promote fair competition within Brazil's patent system.[51]

China

Legal Framework

103. Regarding the timing and requirements for divisional application, Rule 48 of the Implementing Regulations of the Patent Law of the People's Republic of China stipulates:

> If a patent application includes two or more inventions, utility models, or designs, the applicant may, before the expiration of the period specified in Rule 60, paragraph 1 of these implementing regulations, submit a request for division to the Patent Administration Department of the State council; however, if the patent application has already been rejected, withdrawn, or deemed to have been withdrawn, no request for division may be submitted.

104. Furthermore, Rule 49 provides that:

> A divisional application filed in accordance with Rule 48 of these implementing regulations shall entitled to the filing date and, if priority is claimed, the priority date of the initial application, provided that the divisional application does not go beyond the scope of disclosure contained in the initial application.

105. Part I, Chapter 5, Section 5.1.1 of the *Patent Examination Guidelines 2023* further defines the substantive and procedural requirements for voluntary division of patent applications by applicants.

Interpretive Guidance and Procedural Approach

106. In China, where an application for patent has been rejected, withdrawn or is deemed to have been withdrawn, no divisional application may be filed. A divisional application shall be entitled to the filing date and if, priority is claimed, the priority date of the initial application, provided that the divisional application does not go beyond the scope of disclosure contained in the initial application. The divisional application shall go through all the procedures in accordance with the provisions of the Patent Law and the Implementing Regulations. The filing

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50 *Ibid*.
51 *Ibid*.

number and the date of filing of the initial application shall be indicated in the request for a divisional application.[52]

Colombia

Legal Framework

107. Divisional applications are provided for under Article 36 of Decision No. 486 of the Commission of the Andean Community Establishing Common Provisions on Industrial Property (September 14, 2000) which states:

> The applicant may, at any stage in the processing, divide his application into two or more divisional applications, but none of them may involve any broadening of the protection accorded to the disclosure contained in the original application.
>
> The competent national office may, at any stage in the proceedings, require the applicant to divide the application if it does not fulfill the condition of unity of invention.
>
> Every divisional application shall have the same filing date and, where applicable, the same priority date as the original application.
>
> Where multiple or partial priorities have been claimed, the applicant or the competent national office shall specify the priority date or dates corresponding to the subject matter that should be covered by each of the divisional applications.
>
> For the purposes of the division of an application, the applicant shall file documents as may be necessary to make the corresponding divisional applications complete.

108. Divisional applications for a pending patent must not involve any broadening of the protection that would have been accorded to the disclosure contained in the initial application, as set forth in Article 34 of the Decision.

Interpretive Guidance and Procedural Approach

109. The division of a pending patent application may be requested as long as the application is pending. In Colombia, a patent application is considered to be pending until a decision on it becomes final, whether granting, refusal, or any other decision that concludes the procedure or makes continuation impossible. If an application for division is filed after a decision becomes final, the divisional application shall be considered to be a request to divide a patent. The division of an application results in one application being split from the other, with the new application processed separately from the initial application. Consequently, there are two distinct applications, each with different subject matter and separate procedures. The division of a patent application must not involve any broadening of the subject matter disclosed in the initial application; divisional applications that fail to meet this requirement are not accepted for processing.[53]

110. Divisional applications must comply with formal procedural requirements, including filing the application itself, payment of appropriate fees, and submission of the necessary accompanying documents, in accordance with national regulations established by the competent office. If a divisional application does not satisfy these requirements, the competent national office requests that the applicant undertake the necessary corrections. If the applicant fails to correct these deficiencies, the divisional application is considered withdrawn, and the request for division is closed. The filing of a divisional application does not affect the processing

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52 See comments received from China in response to C.9260.

53 See comments received from Colombia in response to C.9260.

of the initial (parent) application. Guidelines exist for handling divisional applications, considering the procedural stage of the corresponding parent application at the time of filing the divisional application.[54]

111. With the aim of preventing double patenting, the invention claimed in divisional applications may not cover the same subject matter as that claimed in the parent application. Where several divisional applications arise from the same initial application, the subject matter of each divisional application must differ. Furthermore, the initial and divisional applications must contain the same description/specification.[55]

112. The experience of the Colombian office indicates that there is a risk of improper use of divisional applications by applicants whose intentions may not align with applicable regulations. Such cases necessitate legal and administrative measures. Difficulties arise when applicants file divisional applications despite being aware that these applications contain multiple groups of inventions that lack unity. The competent office must then issue new requests, once again indicating a lack of unity in these divisional applications. This situation can lead to repeated division of divisional applications, resulting in unnecessarily prolonged procedures, an additional administrative burden for the patent office, and artificial expansion of patent portfolios.[56]

Czech Republic

Legal Framework

113. In the Czech Republic, division of patent applications is governed by Section 13 of Decree No. 550/1990 Coll., on the Procedure in Matters of Inventions and Industrial Designs, in conjunction with Section 26(1) of Act No. 527/1990 Coll., on Inventions and Rationalisation Proposals (the Patent Act).

114. According to paragraph 1 of this framework, if the Industrial Property Office determines that a patent application does not comply with the unity of invention requirement, the applicant is invited to remedy the defect within a specified time limit. Divisional patent applications retain the priority right of the original application if filed within three months of the date when the applicant remedies this defect by submitting amended application documents containing a single subject matter. Additionally, applicants may divide their application voluntarily, on their own initiative, at any time up to the date of patent grant.

115. Pursuant to paragraph 2, when the original application is divided after full examination has commenced, the divisional application is automatically considered as an application for which a request for full examination has been filed.

116. Paragraph 3 stipulates that administrative fees for divisional applications are determined according to the procedural status of the original application at the time of division.

117. 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.

54 *Ibid*.
55 *Ibid*.
56 *Ibid*.

Interpretive Guidance and Procedural Approach

118. In the Czech Republic, applicants may voluntarily divide their patent application at their discretion at any point during the examination proceedings up until the date of patent grant. For divisional applications to retain the priority of the original application, the division must be based on a valid reason, such as a lack of unity of invention. In such cases, applicants must ensure that the divisional application does not extend beyond the content disclosed in the original application as filed. When the Industrial Property Office identifies a lack of unity in the invention, it must clearly define the defect by specifically listing the affected claims and provide justification explaining why the subject matter does not meet unity requirements. If any objections regarding patentability contribute to or cause the lack of unity, the Office communicates these objections to the applicant simultaneously.[57]

119. 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. If the original patent application has already been published, divisional applications stemming from it are not republished. Furthermore, applicants are required to pay administrative fees for divisional applications corresponding to the procedural status of the original application at the time of division. 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.[58]

Dominican Republic

Legal Framework

120. In the Dominican Republic, voluntary division of patent applications is governed by Article 18 – Division of the Application of the Industrial Property Act, which states:

> (1) The applicant may divide an application into two or more divisional applications, but no divisional application may expand on the disclosure contained in the initial application.
>
> (2) Each divisional application shall be attributed the filing date of the initial application.
>
> (3) The applicable fee for filing a patent application shall be due for each divisional application, whereby the fee amount paid for the initial application shall be calculated as a credit.

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57 See comments received from the Czech Republic in response to C.9260.

58 *Ibid*.

Interpretive Guidance and Procedural Approach

121. In the Dominican Republic, applicants may voluntarily file divisional patent applications, provided such applications do not extend beyond the subject matter initially disclosed in the parent application. Each divisional application maintains the original filing date of the initial application. Applicants are required to pay standard patent application fees for each divisional application, though the fees previously paid for the original application are credited accordingly. In other words, when a divisional application is filed, resulting in two separate applications, only one additional set of fees must be paid, since the fees for the original application have already been paid.[59]

122. Voluntary divisional applications undergo the same substantive examination procedure as initial applications. Additionally, the examiner may require the applicant to divide the patent application if it is determined that the application lacks unity of invention. In such cases, the examiner explicitly identifies the absence of unity and requests the applicant to address the issue through the submission of one or more divisional applications.[60]

El Salvador

Legal Framework

123. In El Salvador, voluntary division of patent applications is regulated by Articles 214 and 260 of the Intellectual Property Act.

124. Article 214 relates to unity of invention and the origin of the division. Under article 214:

> A patent application must relate to a single invention or to a group of related inventions forming a single inventive concept. When an application contains multiple inventions that lack an essential technical relationship with one another, the applicant may divide it into two or more divisional applications.

125. Article 260 outlines specific requirements and limits for divisional applications, stipulating that:

- A divisional application must contain complete descriptions, claims and drawings for each separate invention.
- There is no need to resubmit documents concerning the priority right, the assignment of rights or powers of attorney if they are already included in the original application.
- No additional subject matter may be included in the divisional application, nor may the scope of the initial invention be broadened.
- The invention claimed in the divisional application must be different from that contained in the original application or in other divisional applications.
- With a view to preventing the excessive and abusive fragmentation of the patent granting process, further dividing other divisional applications is not permitted.
- If the divisional application does not comply with the aforementioned requirements, the original filing date is not acknowledged. Rather, the date on which it was received is deemed the filing date, and the priority right thus does not apply.

59 See comments received from the Dominican Republic in response to C.9260.
60 *Ibid*.

Interpretive Guidance and Procedural Approach

126. Applicants in El Salvador may voluntarily divide their patent applications whenever it is determined that multiple distinct inventions exist within a single application, thereby violating the unity of invention principle. Such division can be initiated either proactively by the applicant or at the request of the competent intellectual property authority. Divisional applications must strictly adhere to the original disclosure without introducing new subject matter or broadening the scope of protection initially sought. Each divisional application must be complete, containing its own description, claims, and necessary drawings, clearly differentiated from the subject matter of the original application or any other divisional application derived from it.[61]

127. In the view of the Salvadoran Institute of Intellectual Property, the requirement that divisional applications not broaden the initial disclosure serves to ensure transparency and prevents "evergreening", whereby applicants attempt to extend the life of a patent through strategic divisions.[62]

Estonia

Legal Framework

128. In Estonia, the division of patent applications is governed primarily by the Patents Act, specifically under sections 9(2), 11(4), 21(3), 42(10), and 50(2), and supplemented by the Regulation of the Minister of Justice, section 66(2), concerning the content and format of patent applications.

129. According to section 9(2) of the Patents Act, divisional patent applications may be filed for up to six months after termination of the processing of the initial patent application.

130. Pursuant to section 21(3) of the Patents Act, the filing date of the divisional application is considered to be the filing date of the initial patent application.

131. Under section 11(4) of the Patents Act, priority for a patent application separated from an earlier patent application is established, if priority is claimed, based on the date of priority of the earlier patent application.

132. Section 42(10) of the Patents Act stipulates that when a divisional patent application is filed, the applicant must, 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.

133. In accordance with section 50(2) of the Patents Act, 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.

134. Furthermore, double patenting is explicitly prohibited under section 66(2) of the Regulation of the Minister of Justice, requiring applicants to remove any portions of descriptions and claims from the initial application that are no longer necessary to characterize the surviving invention.

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61 See comments received from El Salvador in response to C.9260.

62 *Ibid*.

Interpretive Guidance and Procedural Approach

135. In Estonia, a divisional patent application may be initiated either voluntarily by the applicant or upon request by the Patent Office when a lack of unity of invention is identified. In both scenarios, the general procedures and requirements remain consistent. A divisional patent application inherits the filing date and, if claimed, the priority date of the initial patent application. Applicants must ensure timely payment of applicable state fees corresponding to all preceding years of validity, calculated based on the initial application's filing date. To comply with the prohibition against double patenting, applicants must amend the initial application by removing parts of the description and claims that relate exclusively to the subject matter claimed in the divisional application. Clear separation of claims between the initial and divisional applications is required.[63]

France

Legal Framework

136. In France, voluntary division of patent applications is governed primarily by Articles L612-4, R612-34 and R612-35 of the Intellectual Property Code (IPC).

137. Article L612-4 provides the principle of unity of invention:

> "The patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.
>
> An application which does not comply with the provisions of the foregoing paragraph shall be divided into divisional applications within the prescribed time limit; the date of filing and, as the case may be, the priority date of divisional applications shall be the date or dates of the initial application."

138. Article R612-34 introduces the voluntary division of a patent application:

> "Until payment of the issuance and printing fee for the patent specification, the applicant may, on their own initiative, file divisional applications from their initial patent application."

139. Article R612-35 specifies the requirements for filing divisional applications, including formal conditions (Articles R612-3 to R612-5) which govern the general requirements for patent applications (content of the application, compliance with public policy, morality, and payment of fees).

Interpretive Guidance and Procedural Approach

140. Under the provisions of the IPC and INPI guidelines, divisional applications enjoy the filing date and priority date of the parent application. The parent application can be either a patent application or a utility model application, but divisional applications must remain in the same category as the parent application. Each divisional application, including the initial application itself, may be subdivided further, provided the subject matter does not extend beyond the parent application. If paragraphs from the description or elements from the drawings were not included in the parent application, the applicant is invited to remove them from the divisional application under penalty of said application being rejected. In particular, adding or modifying paragraphs to incorporate the new claims as text in the description is not allowed. If the description of the first divisional application is limited, the entire description of the parent application will be

63 See comments received from Estonia in response to C.9260.

published, with the limited description being published only when the first divisional application is granted.[64]

141. Regarding claims, two scenarios exist. Firstly, if a divisional application is filed during the period when applicants may, on their own initiative, modify the claims in the parent application, claims in divisional applications do not need to match the claims of the parent application. They may include previously unclaimed elements, provided they do not go beyond the initial disclosure. Secondly, if division occurs after the period in which applicants can voluntarily modify claims, the claims in the divisional application must be extracted from the claims filed in the parent application. In such cases, applicants may remove claims or limit them but cannot introduce new claims.[65]

142. Between 2011 and prior to the Kubota ruling discussed below, French practice required all divisional applications, including second-generation and subsequent divisional applications, to be filed before payment of the issuance and printing fee of the initial (root) parent application. However, this practice changed following the Court of Cassation decision of August 30, 2023 (Kubota ruling), which clarified that second-generation divisional applications could be filed up until the payment of the issuance and printing fee for the immediate parent divisional application, aligning French practice more closely with European practice and earlier French practice before 2011.[66]

143. The French Intellectual Property Code does not explicitly prohibit double patenting arising from divisional applications. No article prevents the applicant from filing two divisional applications on the same subject matter. Double patenting is therefore possible, even between parents and subsequent applications. However, in this latter case, even though these are not grounds for rejecting the divisional application, the provisions of R612-35 (2) may apply: "*Faculty is open to the applicant: either to repeat in each divisional application the contents of the original application, except for limiting the claims to the sole subject-matter of the divisional application*." However, these provisions only apply between the parent application and the divisional application and not between two divisional applications that have the same parent application). Finally, the Court of Cassation ruled on the broader subject of double patenting on January 19, 1988. The judges considered that in cases where two applications were filed on the same day (or two applications that share the same priority date) by the same person, the patents resulting from said applications can coexist.[67]

Germany

Legal Framework

144. In Germany, division of patent applications is regulated under Section 39 of the German Patent Act (PatG) which provides:

(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

64 See comments received from France in response to C.9260.
65 *Ibid*.
66 *Ibid*.
67 *Ibid*.

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.

Interpretive Guidance and Procedural Approach

145. A specific requirement for division is the pendency of a parent application. According to Section 39 PatG, the voluntary division by the applicant can take place "at any time", i.e., at any stage, of the grant procedure until a decision on the parent application becomes final, 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 section 43 PagG, during the examination procedure, after a rejection or grant decision of the DPMA until expiry of the appeal period, in appeal proceedings before the Federal Patent Court (BPatG) until expiry of the legal appeal period, in the legal appeal proceedings before the Federal Court of Justice (BGH).[68]

146. The acts required by the applicant to bring about the division are specified in Section 39 PatG: declaration of division in written form, payment of fees, filing of application documents for the divisional application. The three requirements do not have to be fulfilled simultaneously. The requirement to pay fees and submit documents arises only 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.[69]

147. 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 recognizable 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 and immediately establishes a new patent application independent of the parent application. This declaration cannot be contested, as it is a purely procedural act. The validity of the declaration and thus the existence of the divisional application are subject to fulfilling the further requirements of Section 39 (paragraphs 2 and 3). If these requirements are not met within three months, the declaration of division is retroactively deemed not submitted, and the divisional application does not come into existence.[70]

148. The obligation to pay fees arises from the fact that the divisional application's subject matter was involved in the original grant procedure until division. The divisional application therefore inherits the history of the parent application. Fees due in the divisional application are exactly those which were paid or should have been paid in the parent application, including: application fees (including additional claims fees, if applicable), annual fees (including surcharges, if applicable), and fees for the examination/search request. If the application is divided in appeal proceedings before the BPatG, no appeal fee is payable in the divisional

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68 See comments received from Germany in response to C.9260.
69 *Ibid*.
70 *Ibid*.

application, because the divisional application is pending in the same appeal proceedings as the parent application.[71]

149. The required documents to be submitted within three months of the declaration of division correspond to the documents that must be submitted for a patent application: a request for grant of a patent, claims, description, drawings, abstract, and a German translation, if applicable. 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 document whether the declaration of division was made voluntarily or whether the declaration of division was preceded by a complaint due to lack of unity.[72]

150. Upon fulfilling the requirements of Section 39 para. 3 PatG, the divisional application becomes a finally effective, independent application, capable of expiring independently, for example through declaration or non-payment of fees. The divisional application retains the filing date and priority date claimed in the parent application without the need for a further declaration of priority. Applicants may derive multiple divisional applications from a parent application, each receiving a separate file number from the DPMA. If the declaration of division is deemed not to have been filed due to failure to meet the time limit, an already assigned file number will be cancelled and fees already paid will be refunded.[73]

151. The divisional application has available the entire original disclosure of the parent application. Content exceeding this disclosure is considered an inadmissible extension, and no rights can derive from it pursuant to Section 38 sentence 2 PatG, resulting in rejection. If the parent application is pending before the BPatG, divisional applications declared at this stage are also pending before the BPatG in the same appeal proceedings, although separate decisions are issued for each application. The BPatG can separate these appeals if necessary and may reject, grant, or refer divisional applications back to the DPMA for further examination.[74]

152. 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 considered 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.[75]

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71 *Ibid*.
72 *Ibid*.
73 *Ibid*.
74 *Ibid*.
75 *Ibid*.

Hungary

Legal Framework

153. In Hungary, division of patent applications is governed by Article 73 of the Hungarian Patent Act, which provides:

> If the applicant has claimed patent protection for more than one invention in one application, he may divide the application, retaining the date of filing and any earlier priority, until the day on which the decision on the grant of the patent is delivered.

Interpretive Guidance and Procedural Approach

154. According to the Hungarian Patent Act, any person who claimed patent protection for several inventions in a single application may divide his application before the day when the decision relating to the patent is adopted, keeping the date of application and the earlier priority, if any. Although there is no explicit mention on voluntarily filed divisional applications in the Patent Act, the current practice of the Hungarian Intellectual Property Office is to allow them believing that it is deductible from the legal context that filing divisional applications is bound to the compliance with the unity requirement.[76]

155. Double patenting is not explicitly prohibited by the Hungarian Patent Act. This means that it is possible to grant more than one patent to the same applicant even if the applications claim the same subject-matter and if the applications do not form part of the state of the art. This applies especially to the following typical situations: two applications filed on the same day, or an application and its priority application made by the same applicant. However, if one of the applications form part of the state of the art, lack of novelty can be a ground for refusal.[77]

Japan

Legal Framework

156. Article 39 of the Patent Act contains provisions pertinent to prior applications and reads:

> (1) Where two or more patent applications claiming identical inventions have been filed on different dates, only the applicant who filed the patent application on the earliest date shall be entitled to obtain a patent for the invention claimed.
>
> (2) Where two or more patent applications claiming identical inventions have been filed on the same date, only one applicant, who has been selected by consultations between the applicants who filed said applications, shall be entitled to obtain a patent for the invention claimed. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a patent for the invention claimed.
>
> (3) Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on different dates, the applicant for a patent may obtain a patent for the invention claimed therein, only if the application for a patent is filed prior to the application for a utility model registration.

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76 See comments received from Hungary in response to C.9260.

77 *Ibid*.

(4) Where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46-2(1) (including a patent application that is deemed to have been filed at the time of filing of said patent application under Article 44(2) (including its mutatis mutandis application under Article 46(6)) and a device relating to said utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.

(5) Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of paragraph (2) or (4) is applicable to said patent application.

(6) The Commissioner of the Patent Office shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result thereof, while designating an adequate time limit.

(7) Where no report under the preceding paragraph is submitted within the time limit designated under said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) or (4) has been reached.

157. Article 44 of the Patent Act contains provisions related to the division of patent applications and reads:

(1) An applicant for a patent may extract one or more new patent applications out of a patent application containing two or more inventions only within the following time limits:

(i) at such time when or within such time period in which amendments of the description, scope of claims or drawings attached to the request are allowed;

(ii) within 30 days from the date of service of a certified copy of the examiner's decision to the effect that a patent is to be granted (excluding the examiner's decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis under Article 163(3) and the examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160(1)); and

(iii) within three months from the date of service of a certified copy of the examiner's initial decision to the effect that the application is to be refused.

(2) In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original patent application; provided, however, that this shall not apply for the purposes of application of these provisions and the provision of Article 30(3) in the case where the new patent application constitutes another patent application as prescribed in Article 29bis or a patent application as prescribed in Article 3bis of the Utility Model Act.

(3) For the purpose of application of Article 43(2) (including the cases where it is applied mutatis mutandis in Article 43bis(2) (including the case where it is applied mutatis mutandis in paragraph 3 of the preceding Article) and in paragraph 3 of the preceding Article) in the case where a new patent application is filed under paragraph 1, "within one year and four months from the earliest of the following dates" in Article 43(2) shall be deemed to be replaced with "within one year and four months from the earliest of the following dates or three months from the date of filing of the new patent application, whichever is later."

(4) Where a new patent application is filed under paragraph 1, any statements or documents which have been submitted in relation to the original patent application (in the case of a submission under Article 43(2) (including the cases where it is applied mutatis mutandis pursuant to Article 43bis(2) (including the case where it is applied mutatis mutandis pursuant to paragraph (3) of the preceding Article; hereinafter the same shall apply in this paragraph) and paragraph (3) of the preceding Article), including statements or documents provided by electronic or magnetic means) and are required to be submitted in relation to the new patent application under Article 30(3), 41(4), or 43(1) and 43(2) (including the cases where these provisions are applied mutatis mutandis in Article 43bis(2) and in paragraph 3 of the preceding Article) shall be deemed to have been submitted to the Commissioner of the Patent Office simultaneously with such new patent application.

(5) If the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the 30-day period as provided in paragraph (1)(ii) shall be deemed to have been extended only for that period as extended.

(6) If the period as provided in Article 121(1) is extended under Article 4, the three-month period as provided in paragraph (1)(iii) shall be deemed to have been extended only for that period as extended.

(7) If the applicant of a new patent application as provided in paragraph 1 cannot file such new application within the time period provided in item (ii) or (iii) of the same paragraph due to a reason not attributable to the applicant, then, notwithstanding these provisions, the applicant may file such new application within 14 days (or two months, if the applicant is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiry of the time period provided in these provisions.

Interpretive Guidance and Procedural Approach

158. Under Japanese patent law, Article 44 of the Patent Act provides the framework for the division of patent applications. This article stipulates that the applicant may make part of a patent application containing two or more inventions a new patent application. In addition, this article stipulates that, if a patent application is lawfully divided, the new application is deemed to have been filed at the same time as the original application. The applicant entitled to divide a patent application must be the same as the original applicant at the time of division.[78]

159. Divisional applications can only be filed within specific periods, namely: (i) during the time period in which amendments to the description, claims, or drawings are allowed, (ii) within 30 days from transmittal of a certified copy of a decision to grant a patent, and (iii) within three months from transmittal of a certified copy of a non-final decision of refusal. Time periods

78 See comments received from Japan in response to C.9260.

mentioned under points (ii) and (iii) may be extended under certain conditions as provided for in the Patent Act.[79]

160. The substantive requirements for dividing a patent application include: (1) all of the inventions stated in the description, etc., as they stand immediately prior to the division of the original application do not together constitute the invention claimed in the divisional application, (2) the matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stood at the time of filing thereof, and (3): The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stand immediately prior to the division thereof. However, if a patent application is divided during the time period in which amendments to the description of the original application are allowed, the Requirement 3 shall be deemed to be satisfied so long as Requirement 2 is met.[80]

161. Under Article 50bis, if the examiner is to give notice of reasons for refusal of a patent application and such reasons are the same as those for refusal of the original application, then the examiner must include a statement to that effect. The objective of this is to encourage the applicant to fully scrutinize the reasons for refusal notified in the examination of the original application and refrain from dividing the application for the invention for which such reasons were already notified, without resolving such reasons. Amendments submitted after receiving this notification must comply with specific requirements; otherwise, they will be dismissed.[81]

162. In Japan, the applicant may file a divisional application ("child application") from an original application ("parent application") and further file a divisional application ("grandchild application") from a child application. Regarding the relationship between divisional applications and the prohibition of double patenting, if a divisional application is identical to the original application, it will be treated as having been filed on the same date. If the original application is withdrawn, the divisional application will remain valid. Additionally, if an application is abandoned, withdrawn, dismissed, or refused, it will lose its status as a prior application. Therefore, if the original application is withdrawn or received a decision of refusal, the divisional application will not receive a decision of refusal based on the identity of the two applications.[82]

Philippines

Legal Framework

163. According to the Philippine IP Code (R.A. 8293):

> 38.1. The application shall relate to one invention only or to a group of inventions forming a single general inventive concept.
>
> 38.2. If several independent inventions which do not form a single general inventive concept are claimed in one application, the Director may require that the application be restricted to a single invention. A later application filed for an invention divided out shall be considered as having been filed on the same day as the first application: Provided, That the later application is filed within four (4) months after the requirement to divide becomes final, or within such additional time, not exceeding four (4) months, as may be granted: Provided further, That each divisional application shall not go beyond the disclosure in the initial application.

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79 *Ibid*.
80 *Ibid*.
81 *Ibid*.
82 *Ibid*.

Interpretive Guidance and Procedural Approach

164. The Director of Patents may require patent applications having multiple inventions not conforming with the Unity of Invention requirement to be restricted to a single invention. Any subsequent inventions filed as a result of the said restriction shall be afforded with the same filing date as the earlier application.[83]

Republic of Korea

Legal Framework

165. Article 52 of the Korean Patent Act which relates to divisional applications states:

> (1) An applicant who has filed a single patent application for two or more inventions may divide the application into two or more applications within the scope of the features described in the specification or drawings accompanying the initial patent application, within either of the following periods: Provided that if such patent application has been filed in a foreign language, it may be divided only where the patent application has been accompanied by the Korean translation required under Article 42-3 (2)
>
> 1. A period during which amendments can be made under Article 47 (1);
>
> 2. A period not exceeding three months from the date a certified copy of the ruling to reject the claim of a patent is served (referring to an extension, if the period specified in Article 132-17 has been extended under Article 15 (1));
>
> 3. A period of not more than three months from the date when the certified copy of a decision to grant a patent under Article 66 or the certified copy of a trial decision to revoke the decision to reject a patent application under Article 176 (1) (limited to a trial decision made to register a patent but including a trial decision on retrial) is served: Provided, That the period shall end on the day when it is intended to have the grant of a patent registered under Article 79, if the period up to such day is less than three months.
>
> (2) A patent application divided under paragraph (1) (hereinafter referred to as "divisional application") shall be deemed filed at the time the initial patent application was filed: Provided that a divisional application shall be deemed filed at the time the divisional application is filed in any of the following cases:
>
> 1. Where the divisional application constitutes a separate patent application referred to in Article 29 (3) of this Act or a patent application referred to in Article 4 (4) of the Utility Model Act, and Article 29 (3) of this Act or Article 4 (4) of the Utility Model Act shall apply to the divisional application;
>
> 2. Where Article 30 (2) applies to the converted application;
>
> 3. Where Article 54 (3) applies to the converted application;
>
> 4. Where Article 55 (2) applies to the converted application.
>
> (3) A person who intends to file a divisional application under paragraph (1) shall state his or her intention and indicate the patent application to be divided in the divisional patent applications.

[83] See comments received from Philippines in response to C.9260.

(4) If a patent application to be divided is a patent application claiming priority under Article 54 or 55, the priority shall be also claimed with regard to the divisional application at the time the divisional application is filed under paragraph (1); and if any document or written statement submitted under Article 54 (4) with respect to the patent application to be divided exists, the relevant document or written statement shall be deemed to have been submitted.

(5) As for a divisional application deemed to claim priority under paragraph (4), all or part of the priority claim may be withdrawn within 30 days from the filing date of the divisional application, even after expiration of the period specified in Article 54 (7) or 55 (7).

(6) A person who claims priority under Article 54 for a divisional application may submit the documents specified in paragraph (4) of the same Article to the Commissioner of the Korean Intellectual Property Office within three months from the filing date of the divisional application, even after expiration of the period specified in paragraph (5) of the same Article.

(7) If a divisional application is filed in a foreign language, the patent applicant can submit the application translated in Korean under Article 42-3 (2) or another Korean translation under the main clause of Article 42-3 (3) not later than 30 days from the filing date of the divisional application, even after expiration of the period specified in paragraph (2) of the same Article: Provided, That another Korean translation is not allowed in cases falling under any subparagraph of Article 42-3 (3).

(8) With respect to divisional applications filed without stating the claims in the specification accompanying the initial patent application, the patent applicant may make an amendment stating the claims in the specification not later than 30 days from the filing date of the divisional application, even after expiration of the period specified in Article 42-2 (2).

Interpretive Guidance and Procedural Approach

166. In the Republic of Korea, the person entitled to file a divisional application is the applicant who had filed the parent application or their successor in title. For jointly filed applications, the applicants of the divisional application should be identical to those who have filed the parent application. The divisional application must be based entirely on subject matter originally disclosed in the parent application's specification or drawings. Every invention claimed in the divisional application must be fully disclosed in the original documents of the parent application. If even a single invention in the divisional application extends beyond the scope of the parent application, the divisional application is deemed to be invalid or have grounds for rejection.[84]

167. A divisional application can be filed: Before the certified copy of a decision to grant a patent is served; however, if a non-final office action is issued, the divisional application must be filed within the period indicated in (2) or simultaneously with (3); (2) When a non-final office action has been issued, within the prescribed period for submission of a written argument; (3) When filing a request for reexamination; (4) Within three months from the date of a certified copy of a final action being served, or within the extended period if the time to appeal the rejection has been extended under Article 15 of the Korean Patent Act; (5) Within 3 months after a certified copy of the grant of a patent is served, provided that this occurs before the patent is officially registered. Additionally, the parent application must be pending at the time the divisional application is filed. If the parent application is invalidated, withdrawn, abandoned,

84 See comments received from the Republic of Korea in response to C.9260.

or the decision to reject the parent application has become final and binding, filing a divisional application is not permitted.[85]

168. The divisional application is filed using Form (XIV), as provided by Article 29 of the Enforcement Rules of the Korean Patent Act. It must explicitly state the intention to divide and clearly indicate the parent application. Failure to indicate the parent application at the time of filing makes the divisional application invalid, and such omission cannot be subsequently corrected, except for obvious errors.

169. Normally, along with submission of a divisional application, the applicant should submit the amendment of the parent application to differentiate the invention described in the claims of the parent application from the claims of the divisional application. However, the parent application need not be amended if inventions described in the claims of a divisional application are disclosed only in the description of the invention or drawing(s) in the parent application.

170. If an applicant claims a grace period for the divisional application, the applicant should state this intention and submit supporting documents within thirty days from the divisional application's filing date. Even if no grace period was claimed for the parent application, provided the parent application was filed within 12 months of its public disclosure, the grace period may still be claimed validly for the divisional application.

171. Domestic or treaty priority may be claimed for divisional applications if such priority was claimed in the parent application. Priority details including the priority country and date must be explicitly stated when filing the divisional application. For treaty priority claims, necessary documents must be submitted within three months from the divisional application's filing date or within one year and four months from the earliest priority date, whichever applies. After April 20, 2022, priority documents submitted for the parent application are automatically considered submitted for the divisional application, and priority claims may be withdrawn partially or fully within 30 days after filing the divisional application. Applicants can refer to documents already submitted with the parent application, clearly stating this intent in the divisional application. If the applicant fails to explicitly refer to the evidential documents previously submitted, the examiner may request amendments.[86]

172. Divisional applications typically retain the filing date of the original parent application. However, certain circumstances warrant exceptions, resulting in the divisional application adopting the actual filing date of the divisional submission.[87]

Republic of Moldova

Legal Framework

173. In the Republic of Moldova, division of patent applications is governed by Article 35 of the Law on the Protection of Inventions No. 50-XVI (adopted on March 7, 2008, applicable from October 4, 2008). Article 35 provides:

> (1) A patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.
>
> (2) If the patent application as filed does not meet the requirement referred to in paragraph (1) above, the applicant may divide it, on his own initiative or at the request of the AGEPI, by filing a divisional application, prior to a decision on the patent application.

85 *Ibid*.
86 *Ibid*.
87 *Ibid*.

(3) The divisional application may be filed only for the elements which do not go beyond the disclosure of the initial application as filed.

(4) The divisional applications complying with the requirements of paragraph (3) shall be deemed filed on the filing date of the initial application and shall benefit from its priority rights.

(5) The procedure of application of the provisions of paragraph (2), the special requirements to be fulfilled by the divisional application and the term of payment of the fees are provided for in the Regulations.

174. Further detailed rules on division and unity of invention are provided in Section 10 of the Regulation on the Procedure of Filing and Examination of the Patent Application and Grant of Patent (approved by Government Decision No. 528 of September 1, 2009, rules 235–245).

Interpretive Guidance and Procedural Approach

175. In the Republic of Moldova, divisional applications may be filed voluntarily by the applicant or in response to a request from the State Agency on Intellectual Property (AGEPI) if the original application lacks unity of invention. Divisional applications retain the filing date and any priority rights of the original application, provided they do not extend beyond the disclosure of the initial application as filed. If AGEPI identifies a lack of unity, the applicant is notified and must, within three months, either indicate which invention or unitary group of inventions should be examined, along with amendments and payment of applicable fees, or divide the application accordingly. Failure by the applicant to respond within this period results in examination of the first invention or first unitary group of inventions claimed. Where, prior to the issuance of a decision on the first filing, the applicant fails to file divisional application, the inventions which do not comply with the requirement of unity of invention shall remain in the description, provided that they do not form the subject-matter of the claims. Filing of divisional applications after the refusal, withdrawal, or deemed withdrawal of the initial application is not permitted. Importantly, lack of unity of invention does not constitute grounds for refusal of a patent application, nor can it be raised in actions seeking revocation or cancellation of an already granted patent.[88]

Russian Federation

Legal Framework

176. Articles 1384(4) and 1386(6) of the Civil Code allow divisional filings when an application was filed in violation of the unity of invention requirement.

177. Under Article 1363(1) of the Civil Code, the exclusive right to a patentable subject matter, including an invention, and the patent certifying this right, issued on the basis of a divisional application, is valid from the date of filing the initial application if the requirements established by the Civil Code are met.

178. Article 1381(4) establishes the conditions for claiming priority based on a divisional application. The priority of a patentable subject matter in a divisional application is determined by the filing date of the original application filed by the same applicant with Rospatent and disclosing that patentable subject matter. If there is a right to claim an earlier priority for the original application, the priority date of the divisional application shall correspond to that earlier priority date. A key condition for establishing priority is that, as of the filing date of the divisional application, the original application for the patentable subject matter (including the invention)

88 See comments received from the Republic of Moldova in response to C.9260.

must not have been withdrawn or rejected. Additionally, the divisional application must be filed before either: the exhaustion of the opportunity provided by the Civil Code to file an objection to a refusal on the original application, or the registration date of the patentable subject matter (including the invention), if a decision to grant a patent has been issued for the original application.

Interpretive Guidance and Procedural Approach

179. During the patent examination process, if the examination reveals that the application was filed in violation of the unity of invention requirement, the applicant is invited to indicate which of the claimed inventions should be considered and, if necessary, to make changes to the application within a three-month period from the date of the relevant notification. In this case, divisional applications may be filed for other inventions claimed in the application, of which the applicant is also informed. The Civil Code does not prohibit division of an application at the initiative of the applicant. At the same time, the legislation of the Russian Federation does not contain any special procedural requirements regarding the voluntary division of patent applications by the applicants.[89]

180. Under Paragraph 52 of the Rules for Drafting, Filing, and Examining Documents Substantiating Legally Significant Actions for the State Registration of Inventions (Rules), approved by Order No. 107 "On the State Registration of Inventions" of the Ministry of Economic Development of the Russian Federation dated February 21, 2023, when claiming priority based on a divisional application, Rospatent examines whether the claimed invention is disclosed in the original application. If the divisional application is derived from a convention application and priority is claimed based on its priority date, it must also be verified whether the claimed invention is disclosed in the first (convention) application. Moreover, paragraph 15 of Section 4 of Part 2 of the Guidelines for the Administrative Procedures and Actions in the Provision of the Public Services for the State Registration of Inventions, and the Issuance of Patents for Inventions, and Their Duplicates (approved by Order No. 236 of Rospatent dated December 27, 2018) contains a reservation that a divisional application may not be identical to the original application.[90]

Singapore

Legal Framework

181. In relation to divisional applications: pursuant to section 26(11) of the Singapore Patent Act:

> (11) Where, after an application for a patent has been filed, but before the applicant satisfies the condition under section 30(c), or the application is refused, withdrawn, treated as or taken to be withdrawn, or treated as abandoned or as having been abandoned —
>
> > (a) a new application is filed by the original applicant or the original applicant's successor in title in accordance with the rules in respect of any part of the matter contained in the earlier application; and
> >
> > (b) the conditions in subsection (1)(a), (b) and (c)(i) or (ii) are satisfied in relation to the new application (without the new application contravening section 84),
>
> the new application is treated as having, as its date of filing, the date of filing of the earlier application.

89 See comments received from the Russian Federation in response to C.9260.
90 *Ibid*.

182. Furthermore, under section 27(1) of the Singapore Patent Rules:

> (1) Subject to paragraphs (2) and (3), a new application for a patent which includes a request that it be treated as having its date of filing the date of filing of an earlier application may be filed in accordance with section 26(11) –
>
> (a) of the applicant's own volition; or
>
> (b) to comply with the requirements of section 25(5)(d)

Interpretive Guidance and Procedural Approach

183. Singapore allows an applicant to file a divisional application in respect of any part of the matter contained in an earlier application. A divisional application will be treated as having, as its date of filing, the date of filing of the parent application. Hence, the divisional application's patent term is the same as the parent application's patent term. The divisional application generally inherits priority claims by a declaration of priority under section 17(2) of the SPA. In Singapore, a divisional application may serve as the parent application for a further divisional application. However, the first divisional application must be pending at the time that the second divisional application is filed. The parent application of the first divisional application need not be pending for the second divisional application to be derived from the first divisional application.[91]

184. The following documents must be submitted when filing a divisional application: (i) a request for the grant of a patent, (ii) a specification containing a description of the invention, a claim or claims, and any drawing referred to in the description or any claim, (iii) an abstract, and (iv) a sequence listing, if applicable. A statement of inventorship should also be submitted when filing a divisional application, if the divisional application was filed later than 16 months from (i) the date of filing of the parent application, where there is no declared priority date, (ii) the declared priority date of the parent application, where there is one.[92]

185. Where possible, the description and drawings of the earlier application and the new application shall respectively relate only to the matter for which protection is sought by that application. Where it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a reference by number to that other application. A divisional application must not disclose any additional matter extending beyond that disclosed in the parent application.[93]

186. The claims in a divisional application must define a different invention from the claims in the parent application, even if they are based on the same disclosure. This is to prevent "double patenting" of the same invention. "Double patenting" is a ground for objection in relation to patent applications and a ground for revocation in relation to granted patents.[94]

187. Double patenting will apply if the patent applications or granted patents are for the same invention, i.e., claims are identical in scope. In most cases, this will occur if the claims are coterminous or if the claims use different terminology but are otherwise identical in substance. Double patenting may also apply where two claims differ in that one contains a specific feature while the other defines a more generic group for the corresponding feature without any indication in the specification of practicing across the generic group. For example, claim 1 in

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91 See comments received from Singapore in response to C.9260.

92 See comments received from Singapore in response to C.9260; Section 25(3) of the SPA; Section 19A(1) of the SPR; Section 28(f) of the SPR.

93 See comments received from Singapore in response to C.9260; Section 84(1) of the SPA.

94 See comments received from Singapore in response to C.9260; Rule 46(1)(f) of the SPR, read with section 29(7) of the SPA; Section 80(1)(g) of the SPA.

application “A” and claim 1 of application “B” define identical features, except that claim 1 in application “A” further defines a specific feature and claim 1 in application “B” further defines a more generic group of the specific feature. An objection of double patenting may arise between applications “A” and “B” in such situations if the specific feature is the only one disclosed in the specification of application “B” and there is no basis for reading the specification as constituting a more generic group. However, if application “B” discloses that there is more than one means of performing a particular step or the specific feature as selected from a generic group, then no objection should be taken. When dealing with co-pending patent applications for the same invention, an Examiner will flag any potential double patenting issues to the applicant while continuing with the examination of both applications. It will be up to the applicant how they wish to proceed with the applications in order to avoid double patenting. It is possible for the applicant to respond to the Examiner’s double patenting objection in the application in suit by stating his preference to address the double patenting issue in the co-pending applications that has not yet been granted. If such a statement is present, the Examiner may allow the application in suit to proceed to grant, and the double patenting issue may then be dealt with in the examination of the co-pending application.[95]

Spain

Legal Framework

188. In Spain, voluntary divisional applications are governed by Law 24/2015 of July 24 on Patents (Ley Española de Patentes, LEP) and Royal Decree 316/2017, which provides the detailed regulation for the implementation of this Law.

189. Under Article 26 of the LEP, the unity of invention is required, stating that:

> 1. The patent application may not include more than one invention or group of interrelated inventions, but must constitute a single, general inventive concept.
>
> 2. Applications which do not comply with the provisions of the previous paragraph must be divided in accordance to regulatory provisions.
>
> 3. The resulting divisional applications shall have the same filing date as the initial application from which they originated, to the extent that their object was contained in the previous application.

190. Article 36 LEP further specifies procedures regarding the prior art report and handling lack of unity issues. It states in part that:

> 4. If there is a lack of unity of invention and the applicant fails to divide its application or to pay additional fees as requested by the Spanish Patents and Trademarks Office, the procedure shall continue for the first invention or group of inventions claimed which satisfy the conditions of Article 26, and the remaining inventions shall be deemed withdrawn.

191. The Regulation (Royal Decree 316/2017) provides details of the specific procedures and requirements for the application for division. In particular, Article 44 states:

> 2. The applicant for a patent may, on their own initiative, apply for the division of their application at any time before completion of the substantive examination. The applicant for a utility model may, on their own initiative,

95 See comments received from Singapore in response to C.9260.

apply for the division of their application at any time before the resolution referred to in Article 62 (3) and (4) of this Regulation.

3. When filing the divisional application, the applicant must justify to what extent the subject-matter of the divisional application is a part and not essentially the same as that of the parent application.

192. Further procedural details in Article 45 include:

1. When applying for the division of the patent or utility model application, the applicant must formalize their divisional application, which must meet the requirements given in Chapter I of Title I of this Regulation.

2. To maintain the filing date assigned to the parent application, the Spanish Patents and Trademarks Office will verify whether the subject-matter of the divisional application is included in the parent application.

3. If an application for the division of a patent application is filed, the application fee and the fee for the prior art report must be paid within one month from the filing of the divisional application. If, in relation to the parent application, additional fees referred to in Article 29 of this Regulation had been paid, the applicant will not have to pay, for the divisional application, the fee for the prior art report insofar as the search on the subject-matter of the divisional application has already been performed. In this case, a written opinion will be issued on the subject-matter of the divisional application, which will be communicated to the applicant and made available to the public. A notice of the publication of the prior art report conducted regarding the parent application will also be published in the Official Gazette of Industrial Property. From the publication in the Official Gazette of Industrial Property, the period specified in Article 39.2 of the Law for requesting substantive examination will begin.

4. If the fee for the prior art report has not been paid or has not been paid in full or if, despite the payment of the additional fees referred to in Article 29 of this Regulation, it appears that the search has not been conducted on the subject-matter or part of the subject-matter of the divisional application, the applicant shall be notified of the need to pay the fee or complete the payment within a period of one month from publication of the defect in the Official Gazette of Industrial Property, with the indication that if the requirement is not met, the divisional application shall be considered withdrawn. The notice of withdrawal will be sent to the applicant and published in the Official Gazette of Industrial Property.

5. The description and drawings, both in the parent application for the patent or utility model and in any divisional application, must only refer, in principle, to the subject-matter that is to be protected in the application. However, when it is necessary to describe in an application the subject-matter for which protection has been filed for in another application, reference must be made to said other application.

Interpretive Guidance and Procedural Approach

193. The unity of invention requirement under Spanish law mandates that a patent application must not include more than one invention or group of interrelated inventions and must constitute a single general inventive concept. Where applications do not comply with this unity

requirement, division becomes mandatory. If the applicant does not proactively divide the application upon being notified by the Spanish Patent and Trademark Office (OEPM), the procedure continues exclusively for the first invention or group of inventions fulfilling this requirement, and the remaining inventions are deemed withdrawn.[96]

194. A central principle is the prevention of double patenting. While the divisional mechanism is available, applicants cannot leverage it to obtain multiple patents for the same invention. The subject matter protected by divisional applications must only be a part and cannot be essentially the same as that of the parent application. Furthermore, divisional applications are strictly confined to content originally disclosed in the parent application.[97]

195. In terms of procedural requirements, divisional applications can be voluntarily initiated by the applicant before the conclusion of the substantive examination for patents. It is permissible to file multiple divisional applications arising from a single parent application, as long as the parent or previous divisional application remains pending. Similarly, a divisional application may give rise to subsequent divisional applications. The divisional application must clearly indicate its divisional nature and specify the parent application. It also requires a separate explanatory document detailing how the divisional application's subject matter constitutes a part of and is distinct from the parent application. In situations involving multiple claimed priorities, divisional applications may claim some or all of the priorities cited in the parent application.[98]

196. Once the divisional application has been submitted, the OEPM must verify the following: (i) parent application number; (ii) that the filing date and priority date, where applicable, match the parent application and the divisional application; (iii) applicant and inventor details, which must match those given in the parent application; (iv) that the description, drawings, and sequences refer exclusively to the subject-matter to be protected, are part of the parent application and are not essentially the same (i.e., they do not have the same content). If this requirement is not met, the application will not be accepted as a divisional application and, therefore, will not retain the filing date of the parent application; (v) That the main application is being processed and was submitted on time; (vi) Whether or not the payment of fees is necessary and, if so, that they have been paid.[99]

197. Applicants must pay the application fee and the prior art report fee (IET) either at filing or within one month from OEPM’s notification. If additional fees have been previously paid regarding the parent application, the prior art report fee may not be required if the search for the divisional application's subject matter was previously conducted. In such cases, the OEPM issues a Written Opinion, communicating it to the applicant and making it publicly accessible. A notice regarding the prior art report’s publication related to the parent application will appear in the Official Gazette of Industrial Property, initiating a three-month period to request substantive examination. If fee requirements for the prior art report remain unmet or if it emerges that no prior search was performed for the divisional application's subject matter despite previous fee payments, the OEPM issues a notification of deficiency. The applicant then has one month from the publication of this notification in the Official Gazette to fulfill these requirements; otherwise, the divisional application will be considered withdrawn.[100]

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96 See comments received from Spain in response to C.9260.
97 *Ibid*.
98 *Ibid*.
99 *Ibid*.
100 *Ibid*.

Syrian Arab Republic

Legal Framework

198. As per Article (7) of the Patents Law No. 18 of 2012:

> A patent application may not include more than one invention. A set of related inventions that together represent an integrated creative idea is deemed a single invention.

Interpretive Guidance and Procedural Approach

199. Under Syrian patent law, the principle of unity of invention is fundamental and requires that a patent application includes only one invention, or a set of interconnected inventions that are related to each other and represent one general innovative concept. This principle is primarily designed to ensure a fair, effective, and balanced patent system, benefiting both applicants and the patent office. Applicants are permitted to divide an original patent application into two or more partial applications, each addressing a different invention, provided that each divisional application retains the priority date of the original application. This approach facilitates comprehensive patent protection across multiple inventions disclosed within a single initial application.[101]

United Kingdom

Legal Framework

200. In relation to divisional applications, section 15(9) of the Patents Act 1977 provides:

> Where, after an application for a patent has been filed and before the patent is granted –
>
> — (a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and
>
> — (b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below), the new application shall be treated as having, as its date of filing, the date of filing the earlier application.

201. In relation to double patenting, section 18(5) of the Patents Act 1977 provides:

> Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

Interpretive Guidance and Procedural Approach

202. In the United Kingdom, an application must be in order for grant by a certain date called the compliance date. The normal compliance date is 4 and half years from the earliest date of the patent. Divisional applications can be filed at the UK IPO any time up to 3 months from the compliance date of the parent, as long as the parent is not granted/terminated/withdrawn. The divisional application must be filed by the applicant of the parent or their successor in title. There is no need for the claims of the divisional application to be of the same scope as claims

101 See comments received from Syria in response to C.9260.

which were directed to the same subject-matter in the parent application; nor need there have been equivalent claims in the parent application. If a claim in divisional application is broader in scope than an equivalent claim originally present in the parent application, this does not necessarily mean that the divisional application contains additional disclosure.[102]

203. In contrast, with regard to added matter in the description, a divisional cannot proceed unless any subject matter beyond the earlier application is removed. Additionally, publication cannot occur until any added matter has been deleted from the application. Each divisional requires its own search report, even if similar searching was carried out on the parent.[103]

European Patent Office

Legal Framework

204. Article 76 of the European Patent Convention relates to divisional applications and states:

1) A European divisional application shall be filed directly with the European Patent Office in accordance with the Implementing Regulations. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this requirement is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy any right of priority.

2) All the Contracting States designated in the earlier application at the time of filing of a European divisional application shall be deemed to be designated in the divisional application.

205. Additionally, Rule 36 further states that:

1) The applicant may file a divisional application relating to any pending earlier European patent application.

2) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin.

3) The filing fee and search fee shall be paid within one month of filing the divisional application. If the filing fee or search fee is not paid in due time, the application shall be deemed to be withdrawn.

4) The designation fee shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the divisional application. Rule 39, paragraphs 2 and 3, shall apply.

5) Rule 39, paragraph 2a, shall apply.

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102 See comments received from the United Kingdom in response to C.9260; UK Manual of Patent Practice sections 15.17-15.49; UK IPO Manual of Patent Practice, s.15.

103 UK IPO Manual of Patent Practice, s.15.

Interpretive Guidance and Procedural Approach

206. At the European Patent Office (EPO), divisional applications may be filed to respond to an objection due to a lack of unity of invention and they may also be filed of the applicant's own volition. The substantive and procedural requirements under the EPC legal framework apply to both voluntary and mandatory divisional applications. Article 76(1) EPC provides that divisional applications shall be filed directly with the EPO and sets out the key substantive requirement for filing a divisional application, namely that it may be filed only in respect of subject-matter which does not extend beyond the content of the parent application as filed. Provided this requirement is met, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy any right of priority. A divisional application can also itself be the parent application for future divisional applications. All contracting states designated in the earlier application at the time of filing a divisional application are deemed designated in the divisional application.[104]

207. In accordance with Rule 36(1) EPC, a divisional application may be filed in relation to any pending earlier European patent application. An application is pending up to, but not on, the date that the European Patent Bulletin mentions the grant of the patent. If an application has been refused, the application is still pending within the meaning of Rule 36(1) EPC until expiry of the time limit for filing the notice of appeal. Divisional applications shall be filed in the language of the proceedings of the earlier application. If the latter was not in an official language of the EPO, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of filing the divisional application.[105]

208. The filing and search fees shall be paid within one month of filing the divisional application. If these fees are not paid in due time, the application shall be deemed withdrawn. An additional generation-specific fee is due in the case of a divisional application filed in respect of any earlier application which is itself a divisional application (Rule 38(4) EPC; Article 2 1b. of the Rules Relating to Fees). The renewal fees already due in respect of the earlier application at the date on which the divisional application is filed shall also be paid for the divisional application and shall be due on its filing. These fees, and any renewal fee due within four months of filing the divisional application may be paid within that period without an additional fee. If these fees are not paid within that period, they still may be paid within six months of the said date, provided that an additional fee is also paid within that period (Rules 51(2) and (3) EPC). If the renewal fees already due on the earlier application and additional fees are not paid in due time, the divisional application shall be deemed to be withdrawn (Article 86(1) EPC). The substantive examination of a divisional application should in principle be carried out in the same way as for any other application. The claims of a divisional application need not be limited to subject-matter already claimed in the parent application's claims.[106]

209. In examination of a divisional application, the examining division may exceptionally issue a summons to oral proceedings as the first action if: (i) the parent application was refused or withdrawn and there is no prospect of a grant for the divisional application, even taking into account the applicant's reply to the search opinion; and (ii) the content of the claims on file is substantially the same as or broader than the subject-matter of claims that were examined for the refused or withdrawn parent application or that served as a basis for the search of the divisional application; and (iii) one or more of the objections that are crucial to the outcome of the examination procedure and that were raised in either the search opinion established for the divisional application, the parent's refusal or a communication issued for the withdrawn parent still apply. The annex to the summons issued as the first action in examination must deal with all

104 See comments received from the European Patent Office in response to C.9260.
105 *Ibid*.
106 *Ibid*.

the applicant's requests and be as detailed as a communication under Article 94(3) EPC. The summons should be issued with at least six months' notice. Oral proceedings may be cancelled or postponed if the applicant's submissions contain a genuine effort to overcome the examining division's objections.[107]

210. As acknowledged by the Enlarged Board of Appeal, the prohibition on double patenting applies to divisional applications under Article 125 EPC (G 4/19). It is a principle of procedural law generally recognized in the majority of contracting states that two patents cannot be granted to the same applicant with claims directed to the same subject-matter. In line with that, a European patent application can be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent that has been granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC. This would especially be the case in the following typical situations: two applications filed on the same day, parent and divisional applications, or an application and its priority application. An applicant can be allowed to proceed with an application that has the same description as a patent already granted to them as long as it does not claim the same subject-matter. Where two or more European applications from the same applicant designate the same Contracting States and their claims have the same filing or priority date and relate to the same invention, the applicant must amend one or more of the applications so that the subject-matter of their claims is no longer the same, withdraw overlapping designations or choose which one of those applications is to proceed to grant. Otherwise, once one of the applications has been granted, the others will be refused under Article 97(2) EPC in conjunction with Article 125 EPC. If the claims of those applications only partially overlap, no objection should be raised. However, when, for example, the subject-matter of an independent claim in an application is the same as that of a dependent claim in a granted patent held by the same applicant, an objection of double patenting will be raised.

211. If two applications with the same effective date are received from two different applicants, each must be allowed to proceed as though the other did not exist.[108]

[End of Annex and of document]

107 *Ibid*.
108 *Ibid*.