

## Report Q193

in the name of the Chinese Group  
by Juan DU

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

#### Questions

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

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

Divisional applications are available under Chinese patent laws, but continuation or continuation-in-part applications are not.

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

Basically speaking, allowing the filing of divisional applications is a compensation for the applicant's right when enforcing the unity of invention rules. In order to facilitate the search, examination and management of the patent applications by the Patent Office, to ensure accurate definition of the protection scope and effective utilization of the patent documents by the public, and to ensure the fulfillment of obligations by the applicant/patentee, Chinese patent laws apply the unity of invention rules. If the application claims two or more inventions which do not belong to a single general inventive concept, then one or more of the claimed inventions shall be deleted. In this case, if the applicant is not given an opportunity to pursue the deleted invention(s), his or her rights will be damaged unfairly, since the applicant has made contributions to the prior art by disclosing the invention(s) but is deprived of the rights for getting patent protection therefor. Thus, the divisional application system allows the applicant to file a divisional application to pursue those inventions deleted in response to lack of unity objection, in return for the contribution the applicant has made to the prior art.

Another justification for allowing the filing of divisional applications is to facilitate the assignment or licensing of different inventions contained in the application, so as to enable the applicant to manage and gain benefit from his or her patent assets effectively and flexibly.

A further justification is that Chinese patent laws impose strict requirements on the amendments to a patent application. The applicant has only two opportunities to make voluntary amendments to the application during the examination procedure, and after the examiner has issued a Notification of Granting Patent Right, the applicant can no longer make any amendments. The divisional application system gives the applicant a further opportunity to make amendments to the patent documents.

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

Regarding the circumstances and conditions for filing a divisional application(s), Part I, Chapter 1, Section 5.1.1 of the Guidelines for Examination generally provides that, “[w]here a patent application includes two or more inventions, the applicant may file a divisional application(s) on his own initiative or according to the comments of the examiner. The divisional application(s) shall be filed on basis of the original application (the application which was filed for the first time)”.

Part I, Chapter 1, Section 5.1.1 of the Guidelines for Examination further provides that a divisional application shall fulfill the following conditions:

- i) The divisional application shall indicate the filing number and filing date of the original application. If the divisional application is derived from another divisional application, then the filing number of said another divisional application shall also be indicated.
- ii) The divisional application shall be filed within the specified time limit, which is to be discussed in detail in paragraph 5) below.
- iii) The kind of the divisional application shall be in conformity with that of the original application. For example, if the original application is an application for invention, then the divisional application shall also be an application for invention and shall not be an application for utility model.
- iv) The applicant of the divisional application shall be the same as that of the original application. The inventor(s) of the divisional application shall be the same as, or some of the inventor(s) of the original application.
- v) When a divisional application is filed, a copy of the original application and a copy of other relevant documents (e.g. priority documents) shall also be filed.

In light of the above-mentioned circumstances and conditions, divisional applications are often filed as a result of restriction requirement issued by the examiner to enforce unity of invention rules.

Also, the applicant may voluntarily file a divisional application(s) for various reasons. Chinese patent laws do not prescribe in detail these various reasons, and in practice, the circumstances under which a voluntary division may occur include but are not limited to:

- i) The applicant may voluntarily divide the original application into several applications, so as to facilitate the assignment/licensing of different inventions contained in the application to different assignee/licensee.
- ii) The applicant may voluntarily file a divisional application to pursue those disputed part(s) of the original application, while expediting the granting proceedings for those undisputed part(s) of the original application.
- iii) Under Chinese patent laws, the applicant has only two opportunities to make voluntary amendments to the application:
  - a) at the time of requesting substantive examination; and
  - b) within three months from receiving the Notification of Entering the Substantive Examination Stage. If the applicant has missed these two opportunities, he or she generally can only amend the application as required by the examiner in the Office Action. Moreover, if the examiner has issued the Notification of Granting Patent Right, the applicant can no longer make any amendments to the patent documents, including even amendments to the apparent errors in the description or the claims.

In this case, the applicant may voluntarily file a divisional application to incorporate his or her desired amendments, e.g., to claim the subject matter which was contained by not claimed in the original application, or to improve the claims which were not perfectly drafted in the original application, or to correct the apparent errors in the original application, etc.

- iv) The applicant may file a divisional application just before the original application is finally rejected, so as to have the claims examined again and get a second chance to make the claims granted.

As can be seen, when a divisional application is filed, it is not necessary that "the patent application includes two or more inventions", which is assumed to underlie the divisional application system.

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

Pursuant to Chinese patent laws, it is possible for the applicant to file a divisional application on basis of another divisional application. This, however, includes the following two different situations.

If the applicant files such a divisional application on his own initiative (voluntary division), then the time limit for filing shall be determined on basis of the original application rather than said another divisional application. In this case, the "cascades" of divisional applications actually are not formed.

On the other hand, if the applicant files such a divisional application to meet the examiner's lack of unity objection to said another divisional application (mandatory division), then the time limit for filing can be determined on basis of said another divisional application. In this case, "cascades" of divisional applications can be formed. That is to say, only when the lack of unity objection is raised, can "cascades of divisional applications" be allowed.

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

Part I, Chapter 1, Section 5.1.1 of the Guidelines for Examination provides for the time for filing divisional applications:

- i) The applicant may file a divisional application before the expiration of two month from receiving the Notification of Granting Patent Right for the original application.
- ii) If the original application is rejected, the applicant may file a divisional application within three months from receiving the Decision of Rejection (i.e., the time limit for filing a request for reexamination of the original application), no matter whether a request for reexamination is filed or not.
- iii) If the applicant files a request for reexamination within the three-month time limit mentioned in paragraph ii) above, then the applicant may file a divisional application during the reexamination procedure, and may also file a divisional application during the litigation procedure in the case where the applicant is not satisfied with the Reexamination Decision and appeals to the Court.
- iv) If the original application is withdrawn, or if the original application is deemed withdrawn and the right has not been restored, then the applicant cannot file a divisional application.

In brief, the applicant may file a divisional application at any time before the original application is finally rejected or granted.

In light of the discussions in paragraph 4) above, if the applicant files a divisional application on basis of another divisional application on his own initiative, then time limits in the above-mentioned requirements i) – iv) shall be determined with respect to the original application.

On the other hand, if the applicant files a divisional application on basis of another divisional application to address the lack of unity objection to the latter, then the time limits in the above-mentioned requirements i) – iv) shall be determined with respect to said another divisional application. That is to say, the divisional application can be filed before said another divisional application is finally rejected or granted. In this case, when filing the divisional application, the applicant shall provide a copy of the Office Action or a copy of the Notification for Filing Divisional Application the examiner issued in connection with said another divisional application, in which the lack of unity objection is raised.

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

As can be seen from the discussions in paragraphs 4) and 5) above, it is generally required that the original application is still pending at the time of filing a divisional application. The only exception is the case where the applicant files a divisional application on basis of another divisional application (the “direct parent application”) to address the lack of unity objection to the latter, and in this case, the time limit for filing is determined based on the “direct parent application” and is irrelevant of whether the original application is still pending or not. That is to say, in the exception case, it is required that the “direct parent application” is still pending at the time of filing a divisional application derived therefrom, but it is not required that the original application is still pending.

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

Chinese patent laws do not require that the original application (or the direct parent application) is still pending throughout the prosecution of a divisional application derived therefrom.

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

Chinese patent laws require that a divisional application shall not go beyond the scope of disclosure of the original application. The “scope of disclosure of the original application” shall be construed as including the contents of the text of the description and claims of the original application, and the contents which can be directly and undoubtedly determined from the text of the description and claims and the drawings of the original application.

The claims of the original application (after a divisional application is filed) and the divisional application shall claim different inventions, but the descriptions of the original application and the divisional application may have different situations. For example, suppose that the original application (before the divisional application is filed) contains two inventions A and B. After a divisional application is filed, if the original application claims invention A, then the description thereof can still contain inventions A and B, and can also maintain invention A only. If the divisional application claims invention B, then the description thereof can still contain inventions A and B, and can also contain invention B only.

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

In light of the requirements discussed in paragraph 8) above, the description and claims of a divisional application may not contain contents not contained in the original application or other application from which the divisional application derives. However, the divisional application may claim subject matter which was not claimed in the original application or other application from which the divisional application derives.

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

Pursuant to Chinese patent laws, a divisional application, whether it derives directly from the original application or derives from another divisional application, has the same filing date and priority date as the original application, and its patent term is calculated from the filing date. Therefore, it is impossible to extend the patent term of the original application by filing divisional applications.

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

Chinese patent laws do not permit double-patenting, and the divisional application and the original application should claim different subject matter. During the examination, if the examiner finds that double-patenting problem exists between the divisional application and the original application, the examiner will request the applicant to make a choice between these two cases.

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

It does not matter in this respect whether the divisional application was filed in response to restriction requirement issued by the examiner.

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

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

For the applicant, the advantages of allowing the filing of divisional applications include:

- i) In the case where the examiner raises lack of unity objection to the two or more inventions claimed in the application, the applicant is entitled to get patent protection for these inventions respectively, without having to abandon one or more of them. This provides flexibility for the applicant to manage his or her patent portfolio. For example, the applicant may incorporate two or more inventions in one application, having only to pay relevant fees and monitor the status for the one application. If the examiner raises unity objection during the prosecution procedure, the applicant may then choose to abandon one or more of the inventions, or to pursue all the inventions by filing a divisional application(s), depending upon factors such as the commercial importance and prospects for being granted of the different inventions.

- ii) Where an application contains two or more inventions, the applicant may voluntarily divide it into several applications. This enables the applicant to assign/license different inventions contained in the application to different assignees/licensees, so that the applicant can manage his or her patent assets effectively and flexibly.
- iii) In the case where the applicant has missed the opportunities to amend the original application/patent, the applicant can take advantage of the divisional application system to improve the quality of the patent documents.
- iv) The applicant may take advantage of the divisional application system to expedite the granting proceedings for the undisputed part(s) of the original application.
- v) Before the application is finally rejected, the applicant may take advantage of the divisional application system to have the claims examined again so as to get a second chance for the claims being granted.

For the applicant, the advantages of allowing the filing of divisional applications include:

Where an application contains two or more inventions, allowing the applicant to voluntarily divide it into several applications enables the third parties, who are the assignees/licensees, to maintain and enforce their rights more flexibly and easily.

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

For the third parties, the disadvantages of allowing the filing of divisional applications include:

- i) In the case where the applicant uses the divisional application system to have the rejected claims examined again so as to get a second chance for the claims being granted, legal uncertainty arises for the third parties, since they cannot rely on the final rejection of the original application to use the rejected invention freely.
- ii) In the case where the applicant uses the divisional application system to have the rejected claims examined again, the resource of the Patent Office is wasted and the backlog is aggravated, with the objective effect that the examination of the genuinely new applications of the third parties is delayed.
- iii) Since the applicant can claim in the divisional application the invention(s) contained but not claimed in the original application, legal uncertainty may arise for the third parties. They cannot rely on the final rejection of the original application or the granted claims of the original application to use the unclaimed parts of the original application freely. The allowing of cascades of divisional applications may even add to this uncertainty. Accordingly, the burden of the third parties is made heavier for supervising the patent portfolio of the applicant so as to get an overview of potential rights that may impede their freedom to use.

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

The filing of divisional applications and continuation applications should be allowed. The filing of continuation-in-part applications, which may introduce new matter which was not contained in the original application, should not be allowed.

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

i) The reasons for filing

The reasons for filing may include enforcing unity of invention rules, amending the patent document, facilitating the enforcement of the patent right, getting the rejected claims examined again, and expediting the granting proceeding for the undisputed parts of the application, etc., and shall not be limited to the enforcement of unity of invention rules.

ii) Inventor and applicant

The inventor(s) and applicant(s) should be the same as, or part of that/those of the original application.

iii) Time limit

When a divisional or continuation application is filed, the original application should be pending. Cascades of applications should be restricted, so as to avoid an unlimited string of filings from the original application.

iv) Introduction of new matter

Introduction of new matter that was not contained in the original application should not be allowed, but claiming the subject matter which was contained but not claimed should be allowed.

v) Double patenting

The double patenting between the original application and the divisional or continuation application should not be allowed.

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

As stated in item iv) of paragraph 4) above, a harmonized system should not permit the addition of subject matter that was not contained in the original application as filed.

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

It should be permitted to use a divisional or continuation application to obtain new examination and decision for claims that are identical or essentially identical with claims rejected during the prosecution of the original application, so as to compensate for the adverse effect on the applicant caused by the variances in the application of the patent laws among different examiners.

Where case-law on the substantive conditions for patent grant has changed since the original application was rejected, it should be permitted to use a divisional or continuation application to obtain new examination and decision.

The above possibilities should take into account the interests of third parties by, for example, imposing limitations on the time for filing such applications.

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

It should not be possible to extend the patent term in respect of matter contained in the original application by filing divisional applications.

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

It would not be justified to limit the access to filing divisional applications primarily with the object of limiting the backlog of patent granting authorities.

The filing of divisional applications is not the main reason for the backlog of patent granting authorities. Therefore, to limit the access to filing divisional applications plays only a limited role in solving the backlog problem, but damage the interests of the applicants.

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

It would be definitely desirable if the database of the patent granting authorities can ensure that a clear link is always indicated between the original application and all the divisional, continuation or continuation-in-part applications derived therefrom in the interest of the third parties. The third parties could thereby get an overview of what would have impact on their freedom to use.

National and Regional Groups are invited to make any additional comment concerning divisional, continuation and continuation in part applications which they find relevant.

### **Summary**

Applicants should be allowed to file divisional applications and continuation applications either as a result of enforcing the unity rules, or for other reasons. The access to filing divisional or continuation applications should not be limited merely for limiting backlog of the patent granting authorities. Meanwhile, for the interests of third parties, cascades of applications should be restricted, introduction of new matter that was not contained in the original application should not be allowed, double patenting between the original application and the divisional or continuation application should not be allowed, and it should not be possible to extend the patent term in respect of matter contained in the original application by filing divisional or continuation applications. It would be desirable if the database of the patent granting authorities can ensure that a clear link is indicated between the original application and all the divisional or continuation applications derived therefrom.