



## Question Q193

**National Group:** Sweden Suède Schweden

**Title:** **Divisional, Continuation and Continuation in Part Applications**

**Contributors:** Ivan HJERTMAN, Marianne BRATSBERG, Birgitta LARSSON, Mikael NYBERG

**Date:** 20070321

### Introduction

Like patent laws in other countries the Swedish patent law is based on international agreements, such as e.g. the Paris Convention for the Protection of Industrial Property (Paris Convention), the Patent Cooperation Treaty (PCT), the European Patent Convention (EPC) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Some countries have regulations in their constitution or apply general principles of law according to which international agreements may become part of their national law without requiring further measures. Other countries as e.g. Sweden, other Nordic countries and common law countries apply a different order according to which a specific national regulation is required for a self executing effect of treaties which the country in question has adhered to.

In view of the above, international agreements for patents ratified by Sweden are incorporated into the Swedish Patents Act and its ancillary regulations. It follows that Swedish courts and other national authorities apply the Swedish Patents Act and its ancillary regulations, i.e. international agreements for patents can not be referred to as such by applicants or litigating parties.

The EPC and the development within the European Patent Office have been given particular weight by the Swedish Supreme Administrative Court and the Swedish Supreme Court.

Sweden is a Member State of the European Union (EU). Thus the EU legislation applies for Sweden as defined in the Swedish Act (SFS 1994:1500) in the same manner as for other EU member states: EU Directives are to be implemented into Swedish law, whereas EU Regulations are directly applicable.

For the sake of clarity, the Swedish Group notes that applications termed “continuation or continuation–in–part applications” in the Working Guidelines and in the actual questions have no counterpart in the practice under the Swedish Patents Act or in the practice under the EPC. The answers in the present Report are limited to applications termed “divisional applications”. Therefore, the terms “continuation applications” and “continuation-in-part applications” have been put in brackets in the titles of the questions.

### Analysis of the current law

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

Under Swedish law it is possible to file divisional applications. There is also a possibility to file what may be termed “separated applications”, which means that if,

as a result of an addition to the description or claims, or in another way, a patent application has been caused to disclose an invention not disclosed in the basic documents, a new application relating to this invention may be considered to have been filed on the date of the addition of the new subject matter. (Section 11 of the Patents Act and Sections 22-24 of the Patents Decree)

It is our understanding that the EPC provides the same possibilities, except that there is no “separated applications” available within the framework of the EPC. (Art 76 EPC)

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

In Sweden the unity requirement for a patent application is primarily based on administrative considerations. According to the preparatory documents for the Patents Act, if several technically independent inventions were allowed in a single application it would complicate the examination and the classification. Likewise, the public’s possibility to orientate among the issued patents would be diminished due to a decreased clearness.

The unity requirement is also based on fiscal considerations. An applicant should not be allowed to pay a single fee and receive examination and protection for several inventions. In addition, an interpretation of the patent claims in the granted patent would be more uncertain if several different inventions were linked together in a single application.

An application will be refused unless the claims are subsequently limited to one invention. (Sections 10, 15 and 16 of the Patents Act.)

- 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?*

If several inventions are disclosed in a patent application, the applicant may file one or more divisional applications. The parent application must not have been finally decided upon at the date of filing of the divisional application. It must be evident from the application when filed that it is a divisional application. Divisional applications can be filed as a result of a restriction requirement made by the patent examiner or the filing can be voluntary.

It is our understanding that the EPC provides the same possibilities. (Art 76 EPC, Rules 25, 26 and 37 EPC)

- 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–par]t application?*

Yes, it is possible to file a divisional application on the basis of another divisional application.

It is our understanding that the EPC presently provides the same possibilities. (Art 76 EPC, Rules 25, 26 and 37 EPC). However, note the questions pending before the Enlarged Board of Appeal in case G1/06, see the response to question I:8.

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

A divisional application may be filed at any time during the prosecution of the parent application as long as the parent application has not been finally decided upon. This means that a divisional application must be filed prior to the grant of a patent for the parent application or, for instance in the case of a refusal of the parent application, before the time limit for filing a notice of appeal has expired. If an appeal is filed it will have a suspensive effect and it is still possible to file a divisional application as long as the parent application has not been finally decided upon. In case the parent application is a divisional application emanating from an earlier grandparent application, the grandparent application may have been finally decided upon without affecting the possibility of filing a divisional from the parent application.

It is our understanding that the EPC provides similar possibilities. (Art 76 EPC, Art 106(1) EPC, Rules 25, 26 and 37 EPC).

- 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?*

Yes, cf. the response to I:5.

- 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?*

No.

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

A divisional application may only relate to subject-matter which does not extend beyond the content of the parent application as filed. This follows from section 11 in the Patents Act. The Swedish Group is not aware of case law which interprets the meaning of the term "parent application".

It is our understanding that the EPC provides the same constraints. (Art 76 EPC, Rules 25, 26 and 37 EPC).

However, the following questions are pending before the EPO Enlarged Board of Appeal:

G1/05 (T39/03)

- (1) Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?
- (2) If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?
- (3) If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed by Articles 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?

G1/06 (T1409/05)

- (1) In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, is it a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1) EPC, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?
- (2) If the above condition is not sufficient, does said sentence impose the additional requirement
- (a) that the subject-matter of the claims of said divisional be nested within the subject-matter of the claims of its divisional predecessors?
- or
- (b) that all the divisional predecessors of said divisional comply with Article 76(1) EPC?

G3/06 (T1040/04)

Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76 (1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100 (c) EPC and thereby fulfil said requirements ?

- 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?*

The divisional application must not contain subject-matter that was not disclosed in the parent application. The divisional application may claim matter that was disclosed in the description including any drawings, or in the claims of the parent application.

It is our understanding that the EPC provides the same constraints. (Art 76 EPC, Rules 25, 26 and 37 EPC). However, cf. the response to question I:8.

- 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?*

No.

- 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?*

The term “*double-patenting*” is, in the opinion of the Swedish Group, an ambiguous term. In Swedish practice the claims in a divisional application must be technically distinguished from the claims in the parent application.

It is our understanding that the EPC provides the same constraints. (Art 76 EPC, Rules 25, 26 and 37 EPC).

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?*

No.

## 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?*

From the applicant's view it should be possible to receive an early patent for claims that have been accepted by the examiner, while dividing out non-accepted claims or parts of claims for further examination. Likewise, if it turns out that an application claims more than one commercial product and/or method it should be possible to make a voluntary division to receive separate patents for those products and/or methods. The possibility of filing a divisional application to receive an early patent may be crucial if competitors are infringing an aspect of what is sought to be patented in the application. Likewise, the possibility of filing a divisional may be crucial when different aspects of what is sought to be patented in an application are to be licensed to different licensees.

From the view of third parties unlimited possibilities of filing divisional applications may result in unacceptable uncertainties as to the final scope of the granted rights. For example, a cascade of divisional applications may result in a divisional application filed 16 years after the filing date of the original application and being granted 19 years after said filing date and giving rights from said filing date.

However, there are balancing factors to keep in mind. For example, the time for retroactively obtaining damages is often limited. In Sweden, for example, an action for compensation for patent infringement may only cover damage during the last five years before the action was brought (Section 58 of the Patents Act). In addition, the possibilities to make amendments in divisional applications are very limited, at least under the Swedish Patent Act and under the EPC. Furthermore, there are already similar uncertainties for third parties caused by other aspects in the present grant procedure, e.g. prolonged time for examination. This may be further complicated by EPC 2000 e.g. with the new possibility for central limitation of claims after grant.

From the patent office's view no disadvantage with the present system for filing divisional applications has been reported by the Swedish Patent and Registration Office. The Swedish Patent and Registration Office has not seen any extensive use or misuse of the present system and practice for divisional applications.

In the opinion of the Swedish group the fiscal considerations of patent offices are basically sound: one application/examination fee should only give right to one examination; examination quality is improved if the requirement for unity of invention is upheld. However, there may be a risk for fiscal misuse by a patent office if the requirements for unity of invention are driven too far, forcing the applicant to file an unreasonable high number of divisional applications at high cost for covering his needs.

General considerations:

- are there empirical evidence of problems affecting the present system for filing divisional applications under the Swedish Patents Act and the EPC?
- to what extent are cascades of divisional applications filed as a strategy to keep applications pending during the major part of the patent term?
- are there anecdotal cases? If so, do these anecdotal cases provide sufficient basis for motivating changes in the present system and practice?

- 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?*

C.f. the response to question II:1.

- 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?*

Yes.

- 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?*

As noted in the response to question II:1, the Swedish Patent and Registration Office has not experienced any problems with its current practice with respect to divisional applications.

In the opinion of the Swedish Group, it remains to be further studied whether the EPC and the practice under the EPC for filing divisional applications have such consequences for the EPO, the applicants, third parties or the society as a whole that a change of the current system is motivated.

Moreover, as the Swedish Group sees it, the differences between what is applicable under the EPC for filing divisional applications and what is applicable under the US patent legislation for filing continuation or continuation-in-part applications seem to be such that it is unrealistic to foresee a separate international harmonisation of the circumstances and conditions under which divisional applications can be filed.

- 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?*

No. However, the use of new material such as new examples etc must be permitted in responses and/or as evidence etc.

- 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?*

As a basis for the below response the Swedish Group has assumed that a divisional application cannot be filed from an application that has been *finally rejected*.

As explained in the response to question I:2, under current practice at the Swedish Patent and Registration Office a divisional application having claims that are identical

to claims in a parent application will not be accepted for substantive handling, whether or not the claims in the parent applications have been finally rejected.

In the opinion of the Swedish Group, it should not normally be permitted to obtain a new examination in a divisional application of claims that are identical or essentially identical to claims which have been refused in an office action for a parent application.

However, in a situation with upcoming potential change of practice, e.g. from a decision to come at a future date in a pending case in the EPO Enlarged Board of Appeals, it is important for the applicant that his potential rights are preserved. In such case, it is entirely in order, in the opinion of the Swedish Group, that the applicant has a possibility to get a new examination of such claims, even if those claims are identical or essentially identical to claims that have been refused in an office action for a parent application under earlier applicable practice.

The handling of applications with claims that are potentially affected by an upcoming decision should normally be postponed by the EPO until the issuance of the Enlarged Board's decision. However the applicant may for various reasons need to receive an early patent on allowable claims in his parent application. The applicant should therefore in such case be permitted to delete the affected claims from the parent application and file a corresponding divisional application with identical or essentially identical claims. The EPO should then postpone the examination of such a divisional application until the Enlarged Board's decision is available.

- 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?*

No.

- 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?*

No, c.f. the general considerations in the response to question II:1.

- 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?*

Yes, very desirable.

### Summary

In regard to international harmonisation, the differences between what is applicable under the EPC for filing divisional applications and what is applicable under the US patent legislation for filing continuation or continuation-in-part applications seem to be such that it is unrealistic to foresee a separate international harmonisation of the circumstances and conditions under which divisional applications can be filed.

-----