



ExCo Singapore 2007
FINAL version
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Resolution

Question Q193

Divisional, Continuation and Continuation in Part Patent Applications

AIPPI

Noting:

- a) that for purposes of this resolution, the following definitions apply:
 - i. a divisional application is a later application for a distinct or independent invention disclosing and claiming only subject matter disclosed in an earlier filed application (parent application) and entitled to the same filing date as the parent application and the same priority date, if applicable,
 - ii. a continuation application is a later application for the same invention claimed in an earlier filed application (parent application) and disclosing only subject matter disclosed in the parent application and entitled to the same filing date as the parent application and the same priority date, if applicable,
 - iii. a continuation-in-part application is an application filed during the pendency of an earlier application (parent application) repeating some substantial portion or all of the parent application and adding matter not disclosed in the parent application and entitled to the same filing date as the parent application and the same priority date, if applicable, only as to subject matter common to the parent application;
- b) that in some countries the meaning of the term “divisional application” encompasses the above definition of continuation application and vice versa;
- c) that the meaning of the term “continuation-in-part application” does not encompass applications containing added matter filed within 12 months and claiming priority from an earlier application;
- d) that permitting the filing of divisional applications allows applicants to obtain adequate protection by being able to overcome unity objections while retaining the original priority date for the whole of the content of the parent application;
- e) that the availability of divisional and continuation applications allows applicants maximum flexibility, in particular in relation to obtaining faster grant of non-controversial claims while continuing to debate over more controversial parts of the application;
- f) that the availability of divisional and continuation applications may provide an advantage in relation to licensing and assignment allowing particular aspects of subject matter to be divided into separate patent applications;

Recognizing:

- g) that the filing of divisional and continuation patent applications may contribute to delay, add complexity and increase legal uncertainty for third parties trying to establish a clear overview of potential patent rights that are relevant to their contemplated business activities;
- h) that divisional and continuation applications may draw on the resources of patent granting authorities and increase backlogs, to the detriment of the processing of new applications;
- i) that continuation-in-part applications create additional legal uncertainty as to the filing date and priority date, if applicable, of each claim in the application;

Resolves that:

- 1) The filing of **divisional applications**, on the applicant's own volition or in response to unity objections, should be possible.
- 2) It should be possible to file a divisional of a divisional application.
- 3) The filing of divisional applications should be permitted at any time during the pendency of a parent application.
- 4) In a divisional application, it should be possible to claim subject matter that was unclaimed, but was disclosed in the parent application.
- 5) If matter not disclosed in the parent application as filed is included in a divisional application, the divisional application should not be invalid provided that the added matter is deleted prior to grant.
- 6) The patent term of a divisional application should not exceed the patent term of the parent application.
- 7) The filing of **continuation applications** also should be allowed under the conditions as defined in paragraphs 2) – 6).
- 8) In order to reduce the delaying effects of cascading divisional and continuation applications resulting in legal uncertainty, patent granting authorities should expedite the publication of, examination of and decision on divisional and continuation applications.
- 9) In relation to continuation applications, conditions, such as restrictions on the timing of the filing, may be appropriate in order to prevent abuse.
- 10) In view of the additional legal uncertainty for third parties and patent granting authorities created by **continuation-in-part** applications, such applications are not considered desirable.
- 11) In the interest of legal certainty for third parties, it is essential to ensure that the publicly accessible databases of patent granting authorities as soon as possible indicate clear links between an original patent application and all divisional, continuation or continuation-in-part applications derived therefrom.