

Report Q193

in the name of the United States Group
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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?*

Yes. Divisional applications are available pursuant to 35 U.S.C. §§ 120–21 of the U.S. patent statute. Continuation and continuation-in-part applications are available pursuant to 35 U.S.C. § 120¹.

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

Under certain circumstances, a later-filed application for a patent is entitled to the benefit of the filing date of a prior-filed application that has at least one common inventor. For example, when one patent application claims two independent and distinct inventions, the U.S. Patent and Trademark Office may require the application to be restricted to one of the inventions. The other invention can become the subject of a divisional application that is entitled to the benefit of the filing date of the original application. 35 U.S.C. § 121. Further, an applicant is permitted to file a continuation application, any time before a prior-filed parent application is patented or abandoned, to pursue claims that vary in scope from the claims in the parent application, to introduce a new set of claims into the application, and to establish a right to further examination by the U.S. Patent and Trademark Office. *Manual of Patent Examining Procedure*, § 201.07 (2006). Moreover, when an applicant that has already filed a patent application on an invention conceives of an improvement or other variation of the invention, the applicant is permitted to file a continuation-in-part application to disclose and protect the additional subject matter. *In re Klein*, 1930 DC.D. 2, 393 O.G. 519 (Comm'r Pat. 1930); *Manual of Patent Examining Procedure*, § 201.08 (2006).

- 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?*

A later-filed application may be entitled to the benefit of the filing date of an earlier-filed application in the United States when certain requirements regarding disclosure, timing, inventorship, and reference to prior applications are met. In sum, a divisional, continuation,

¹ The answers to questions 1-12 of this section have been prepared in view of the current state of the pertinent rules and statutes governing continuing application practice in the United States. Currently, however, the U.S. Patent and Trademark Office is considering whether to adopt a new set of rules that would significantly alter continuing application practice in the U.S. Should these new rules be adopted, the answers to questions 1-12 may need to be amended to properly reflect the changes implemented by the new rules.

or continuation-in-part application may be filed by an inventor or inventors named in a previously-filed parent application at any time before the parent application is either patented or abandoned. Further, the divisional, continuation, or continuation-in-part application must specifically reference the earlier-filed application. Moreover, a divisional or continuation application can disclose and claim only subject matter disclosed in the earlier or parent application. A continuation-in-part application, however, may include matter that was not previously disclosed in the parent application, but must repeat "some substantial portion or all" of the parent application. The conditions under which a divisional, continuation, or continuation-in-part application may be filed are specified in 35 U.S.C. § 120 and 37 C.F.R. 1.78(a). (Another circumstance where an applicant may file for a continuation is a request for continued examination (RCE) of a patent application after prosecution of the application has been closed and before the applicant has abandoned the application. The conditions under which a RCE may be filed are specified in 35 U.S.C. § 132(b) and 37 C.F.R. 1.114.)

- 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?*

Yes. There is no limit to the number of continuing applications an applicant is permitted to file, so long as certain statutory and regulatory requirements are satisfied. *In re Henriksen*, 158 U.S.P.Q. 224 (C.C.P.A. 1968). For example, if there is a continuous chain of copending parent applications, each copending application must disclose the claimed invention of a later-filed continuation or divisional application in the manner provided by the first paragraph of 35 U.S.C. § 112, in order for the later-filed application to be entitled to the benefit of the earliest filing date. See *Manual of Patent Examining Procedure*, § 201.11 (2006).

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

Under the current rules, a divisional, continuation, or continuation-in-part application may be filed at any time before the parent application is either patented or abandoned. 35 U.S.C. § 120.

- 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?*

To properly file a divisional, continuation, or continuation-in-part application, the direct parent application must be pending at the time the divisional, continuation, or continuation-in-part application is filed. It is not necessary, however, that an original application, on which the parent application depends, remains pending. 35 U.S.C. § 120.

- 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. As long as the direct parent was pending at the time the divisional, continuation, or continuation-in-part application was filed, there are no other requirements that the direct parent (or any original application on which the parent depends) remains pending during prosecution of the divisional, continuation, or continuation-in-part application.

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

A divisional application can disclose and claim only subject matter disclosed in the earlier or parent application. No new matter can be added to the divisional application, although any disclosure from the earlier or parent application that is not “germane” to the invention can be omitted from the divisional application. *Manual of Patent Examining Procedure*, § 201.06 (2006). Like a divisional application, no new matter can be added to a continuation application. Further, and in contrast to a divisional application, the disclosure presented in a continuation application must be the same as the parent application. *Id.* at § 201.07. A continuation-in-part application may include matter that was not previously disclosed in the parent application. Still, however, the continuation-in-part application must repeat “some substantial portion or all” of the parent application. *Id.* at § 201.08.

- 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?*

As stated above, no new matter can be added to divisional applications. Generally, a divisional application uses the same or narrower disclosure as utilized in the parent application and presents new claims to a different invention that is disclosed, but not claimed, in the parent application as prosecuted. *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 555 (Fed. Cir. 1994) (“A divisional application... is one carved out of an earlier application which disclosed and claimed more than one independent invention, the result being that the divisional application claims only one or more, but not all, of the independent inventions of the earlier application.”) Similarly, no new matter can be added to a continuation application. See *Applied Materials Inc. v. Advanced Semiconductor Materials America, Inc.*, 98 F.3d 1568, 1579, (Fed. Cir. 1996). In contrast, a continuation-in-part application can include new matter, or additional material that was not present in the parent application from which it claims priority. See 37 C.F.R. § 1.53(b)(2). Again, as stated above, the continuation-in-part application, however, must reiterate a substantial portion of the parent application.

- 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, it is not possible to extend the patent term with respect to matter contained in the original application by filing divisional, continuation or continuation-in-part applications. Currently in the U.S., the 20 year patent term runs from the date of the filing of the **first** application in a series of continuation, continuation-in-part, or divisional applications that comply with 35 U.S.C. § 120.

- 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?*

Double patenting is not permitted. See *Manual of Patent Examining Procedure*, § 804 (2006). There are generally two types of double patenting rejections:

- 1) statutory rejections based on 35 U.S.C. § 101, which in essence states that an inventor may obtain a singular patent on an invention; and
- 2) nonstatutory-type double patenting rejection based on a judicially created doctrine intended to prevent the prolongation of a patent term by barring claims in a second patent that are not patentably distinct from the claims in a first patent. *Id.* A statutory double patenting rejection can be avoided by amending or cancelling the conflicting claims. A nonstatutory double patenting rejection can be avoided by filing a terminal disclaimer.

- 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?*

The Patent Act provides that when the U.S. Patent and Trademark Office issues a restriction requirement, the parent application and the divisional application filed as a result of the restriction requirement cannot be used as references against each other, if the divisional application is filed before the issuance of a patent from the parent application. See 35 U.S.C. § 121. Divisional applications that are voluntarily filed by the applicant without being subject to a restriction requirement by an Examiner, however, may not claim the benefit of § 121, and thus are susceptible to double patenting rejections. There are additional situations where this prohibition against double patenting rejections under 35 U.S.C. § 121 does not apply. See *Manual of Patent Examining Procedure*, § 804.01 (2006). For instance, if an applicant changes the scope of the claims in a divisional application, so that they are no longer consonant in scope to the original claims subject to restriction by the Examiner, the applicant may be susceptible to double patenting rejections. *Id.* Also, if the restriction requirement was only made in an international application by the International Searching Authority or the International Preliminary Examining Authority; the restriction requirement was withdrawn by the Examiner before the patent issues; or if the restriction requirement was made subject to the nonallowance of certain generic or other linking claims and those claims are subsequently allowed, then the exclusion of double patenting rejections under § 121 does not apply. *Id.*

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?*

There are many advantages for applicants in allowing the filing of divisional, continuation, or continuation-in-part patent applications. In general, the opportunity to file such an application can be used strategically in allowing the applicant to modify its patents to changing circumstances, while retaining the priority date associated with the parent application. For instance, by filing a continuing application, an applicant can enjoy the effective filing date of the parent application and overcome recent prior art or other statutory bars. In addition, an applicant can use a continuation application to ensure that the disclosure of the original application is always pending. Moreover, when dealing with competitors, if a competing product has designed around the original patent, the claims of the pending continuation application may be modified so as to ensure infringement if a patent should issue. Also, when an applicant has a particular product with immediate commercial potential, he or she may choose to delete the broad claims during prosecution to obtain a patent on the narrow claims covering the specific product. Subsequently, the applicant can file the broader claims in a separate continuation application, with the commercial product being protected during that time.

- 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?*

A disadvantage, for the applicant, in filing divisional, continuation, or continuation-in-part applications, is that the subsequently issued patent may not enjoy as long of a patent term as a new application, since the life of a patent is calculated from the filing date, and the continuing application will have an effective filing date equivalent to the filing date of the original parent application. The practice of allowing divisional, continuation, or continuation-in-part applications may also cause legal uncertainty for third parties in determining what is and is not protected by the patent laws.

- 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 and continuation applications should be permissible. Looking forward, however, the filing of continuation-in-part applications should not be permitted.

- 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?*

A common set of rules to promote international harmonization of continuing application practice may include an amalgamation of rules already in place or proposed in various jurisdictions of the world. For example, as in Japan, continuation-in-part ("CIP") applications may be made unavailable. Additionally, as required by the rules governing divisional applications in China, divisional applications would not be permitted unless a unity of invention issue was identified in an immediate parent of the divisional applications. Thus, no cascading divisionals would be allowed. Similarly, as in the new rules proposed by the U.S., there would be no ability to file cascading continuation applications. In contrast to the proposed U.S. rule, however, multiple continuation applications based on a single, original application should be allowed.

CIP applications should not be permitted because the potential benefits derived from CIP applications do not outweigh the uncertainty and added costs they generate. For example, under current U.S. practice, claims of a CIP application that include new matter are entitled only to the filing date of the CIP application. The presence of new matter in these claims makes them ineligible to receive an effective filing date equivalent to the filing date of the parent application. Manual of Patent Examining Procedure, §§ 201.11, 706.02, 2133.01 (2006). Thus, during examination, an examiner must closely study each claim to determine whether every claim element is fully supported by the parent application. If even one element of a particular claim finds insufficient support in the parent application, then that claim is entitled only to the filing date of the CIP application, and not to the parent. *Id.*

Analyzing each claim to determine its effective filing date can be costly to both the examining authority and members of the public wishing to analyze the validity of a patent issued from a CIP application. For example, the effort associated with assigning an effective date to each claim of a CIP application adds to the costs associated with examining CIP applications and reviewing patents issuing from CIP applications. Further, because some claims may be entitled to the date of the parent application and other claims may be entitled only to the filing date of the CIP application, the task of applying prior art against the claims of the CIP application (or to a patent issued from a CIP application) is made more difficult. It is feasible that some references may constitute prior art with respect to only a subset of claims in an application.

Moreover, legal uncertainties may exist regarding the validity of a patent issuing from a CIP application, as the effective date determination for each claim may be disputed. The effective filing date that an examiner assigns to a particular claim of a CIP application may remain unknown. For example, in cases where the applied or cited references all have prior art dates earlier than the effective filing date of the parent application, it would be unnecessary for an examiner to assign an effective filing date to each claim of a CIP application (i.e., the available references would qualify as prior art with respect to all of the claims). Uncertainty may exist regarding the validity of claims issued from a CIP application, however, especially where additional references are discovered that have prior art dates falling between the filing dates of the parent application and the CIP application. Those references may affect the validity of some of the claims. Likely, however, the patentee will maintain that all of the claims in the CIP application find support in the parent application and, therefore, all of the claims are valid with respect to the newly available references. On the other hand, an accused

infringer, or other member of the public, may take the opposite position and challenge the validity of the patent claims based on the new prior art. Ultimately, legal uncertainties may result, as it may be difficult to predict whether a fact finder would uphold the validity of the claims in view of the newly identified prior art.

The benefits of a CIP may not justify the added costs and uncertainty associated with CIP applications. One potential benefit of a CIP application may be realized in situations where an applicant wishes to file "continuation-type" claims in the CIP application that are fully supported by the parent application. For example, an patent applicant may opt to abandon the parent application in view of a newly filed CIP application that includes all the claims of the parent along with claims directed to newly added subject matter. Under certain circumstances, this approach could reduce prosecution costs by requiring prosecution of only one application (the CIP application) rather than the parent application and a new application. The potential reduction of costs in the short term, however, may be overshadowed in the future by the difficulty and costs associated with reviewing the claims issuing from the CIP application.

In most cases, the effects of a CIP application can be accomplished more simply and, therefore, CIP applications may be unnecessary. Particularly, the effects of a CIP application can be achieved by filing a new application, including claims directed to new subject matter, and one or more continuation applications. As a benefit of this approach, any patent issuing from the new application would have a patent term of twenty years from the filing date of that application, rather than as measured from the filing date of the parent application, as in the case of a CIP application. Additionally, and as long as the parent application remains pending, a continuation application could be filed (instead of a CIP application) where an applicant wishes to pursue claims that are supported by the parent disclosure and that have claims of different scope compared to the parent application.

To promote international harmony with respect to divisional applications, a divisional application could be reserved for the limited situation where the examining authority identifies a unity of invention issue in a pending application. To respond to the unity of invention issue, an applicant may be allowed to file one or more divisional applications for the sole purpose of pursuing non-elected inventions from the parent application. In order to promote legal certainty, however, cascading divisionals should not be allowed. Rather, a rule could be adopted requiring all divisionals to non-elected inventions to be filed while the parent application, in which the unity of invention issue was identified, remains pending.

Moreover, to promote international harmony with respect to continuation applications, rules similar to those proposed for divisional applications could be adopted. Particularly, an applicant may be allowed to file multiple continuation applications, but it could be required that all continuation applications are filed while the original, parent application remains pending. This approach would adequately address the balance of interests between applicants and the public. For example, this approach would provide the applicant with an opportunity after the filing of the original application to seek claims that are fully supported by the parent application but that provide the full breadth of claim scope to which the applicant may be entitled. At the same time, this approach would avoid subjecting the public to the uncertainty associated with a continuous stream of serially-filed continuations that potentially allow for an applicant to redraft claims in an attempt to capture new technological developments that may fall within the broad disclosure of an original, parent application.

- 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?*

The answer to this question depends on the meaning of "original application." If this question asks whether subject matter can be included in a divisional, continuation, or continuation-in-part application that was not included in the parent application (i.e., the original application),

then the answer is “no” with respect to divisional and continuation applications and “yes” with respect to continuation-in-part applications. CIP applications, by definition, may include new matter.

On the other hand, if this question asks whether new matter may be introduced into a divisional, continuation, or continuation-in-part application after any of these applications is filed, then the answer is “no”. New matter should not be allowed in any of a divisional, continuation, or continuation-in-part application after such an application is filed.

An ability to insert new matter into any type of patent application would cause potential problems. A patent application discloses and claims the invention the applicant had in its possession at the time the application was filed. Allowing new matter into patent applications could enable an applicant to supplement details of an invention with information that was either unknown or unavailable at the time the application was filed. As a result, the scope and clarity of the invention could be obscured, as the applicant shifts the disclosure and claims away from the original application and toward a more desirable description of the invention. Ultimately, the addition of new matter could dramatically impact the scope of the claims in an application and add to legal uncertainties surrounding the application. Were new matter additions allowed, both examiners and members of the public would be less able to accurately assess the potential scope of patent claims. Moreover, examination of applications could become an iterative process where an examiner is forced to repeatedly examine an application in view of potentially recurring additions of new matter.

- 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 general rule, it should not be permitted to obtain a new examination in a divisional, continuation, or continuation-in-part application of claims that are identical or essentially identical to claims that were finally rejected in the parent application. Such a practice could, in general, contribute to an inefficient expenditure of examining resources and an increase in the backlog of applications at the examining authority.

A potential exception to this general rule, however, may be appropriate where the claims filed in the divisional, continuation, or continuation-in-part application are accompanied by new evidence that was unavailable or could not otherwise have been presented in the parent application and that supports the allowance of those claims. Such new evidence could conceivably take the form of case law that is established after the final rejection of the claims in the parent application but that supports allowance of those claims in the continuing application.

The potential for reevaluating, in a continuing application, claims finally rejected in a parent application would not significantly affect legal certainty in third parties. First, situations where new evidence (e.g., newly established case law) becomes available and undermines an earlier, final claim rejection would likely be uncommon. Therefore, the number of cases that would even qualify for this type of exception would be low and not significantly affect legal certainty. Second, any newly available evidence presented in a continuing application would likely receive a detailed explanation on the record in that application, further alleviating legal uncertainties.

- 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. In our view, the benefit of filing a divisional, continuation, or continuation-in-part application should be limited to entitlement to the filing date of a prior-filed application for matter disclosed in the prior-filed application. For the reasons described above, new matter should not be permitted in divisional or continuation applications. An inventor can always elect to file a new patent application, rather than a divisional, continuation, or continuation-in-part, if patent term is a primary concern.

- 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. We support the general objective of improving the efficiency of patent granting authorities. We do not believe, however, that it would be justified to limit access to filing divisional, continuation or continuation-in-part applications primarily with the objective of reducing the backlog of such authorities absent a strong showing that limiting access to such applications would contribute significantly to the reduction of the backlog.

- 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?*

We support the general objective of improving the legal certainty of third-parties. Toward that end, we are in favor of databases of patent-granting authorities indicating a clear link between original patent applications and all divisional, continuation, or continuation-in-part applications provided that the costs of doing so do not exceed the benefits. Even a link to such as database, however, may be insufficient to resolve the legal uncertainties associated with CIP applications. For example, electronic databases would likely be ineffective in helping an entity determine the earliest effective filing date to which each claim of a CIP application is entitled. Thus, legal uncertainties would likely persist with respect to CIP applications even if these types of electronic databases were implemented.

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

Summary

In the United States of America, as long as certain statutory requirements are met, a continuation, continuation-in-part, or divisional (national or international) application may claim the benefit of a previously filed application if the later-filed application is co-pending with the earlier-filed application and has at least one inventor in common with the prior application. In 2006, the United States Patent and Trademark Office proposed changes to the rules regarding continuing application practice. The proposed rules, which were met with a great deal of critical public comment, would limit the number of continuation applications, continuation-in-part applications, divisional applications, or requests for continued examination which could be filed by a patent applicant. Finalized rules have not yet been issued and it is not clear when such rules may become effective.