

# A Micro-Comparison of Patent Law - Admissibility of Divisional Patent Applications Before the State Intellectual Property Office and the European Patent Office

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In this article, recent limitations of a patent applicant's freedom to file divisional patent applications under the European Patent Convention<sup>2</sup> are compared with corresponding regulations of the Patent Law of the People's Republic of China<sup>3</sup>.

## 1. Background

Where patent protection for a technical invention is sought, an application for a patent must be filed with the competent authority of the relevant jurisdiction in which protection is desired. In Europe, such patent applications can be filed with the national authorities, usually national patent offices. Alternatively, an applicant may file a patent application with the European Patent Office (EPO), which grants patents under the European Patent Convention (EPC). A patent that is granted under the EPC has the same effect as a national patent in all contracting states of the EPC as stipulated in Article 2 paragraph 1 EPC. The EPC established the European Patent Organisation and entered into force on 7 October 1977, at that time effecting seven founding member states. A revised version of the European Patent Convention entered into force on 13 December 2007<sup>4</sup>, and today the European Patent Organisation has 38 member states. The number of

applications filed with the EPO has constantly been rising. In 2010, 232,000 applications were filed with the EPO, the number rising by 10% compared to 2009<sup>5</sup>. Of the filings in 2010, 5% came from China.

In China itself, patent applications are to be filed with the State Intellectual Property Office (SIPO). Patents are granted under the Patent Law of the People's Republic of China (PR China), which first entered into force on 1 April 1985 (Article 76 Patent Law of the PR China as in force). Since then, China's patent law underwent three revisions, and the law that is currently in force was promulgated on 1 October 2009. Three different applications for a patent are possible under this law, namely for an invention patent, a utility model patent and a design patent. Of these, the invention patent is directed at technical inventions and is examined for patentability requirements by the SIPO upon request by the applicant (Article 35 Patent Law of the PR China). Such invention patents are comparable to patents granted by the EPO which are also issued after a substantive examination procedure. The number of filings<sup>6</sup> for Chinese invention patents in 2010 was approximately 391,000<sup>7</sup>, which is an increase of almost 25% compared to 2009 (approximately 315,000<sup>8</sup>). Of the applications filed in 2010, the majority originated in China itself, whilst still 98,000 applications were submitted by foreign applicants.

It is noteworthy that these days, the number of applications for invention patents filed in China outreaches the number of patent filings at the EPO.

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<sup>2</sup> Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973 as revised by the Act revising Article 63 EPC of 17 December 1991 and the Act revising the EPC of 29 November 2000; an English version is available at <<http://www.epo.org/patents/law/legal-texts/html/epc/2000/e/ma1.html>> (visited on 25 June 2011).

<sup>3</sup> Adopted at the 4th Meeting of the Standing Committee of the Sixth National People's Congress on 12 March 1984, amended for the first time in accordance with the Decision of the Standing Committee of the Seventh National People's Congress on Amending the Patent Law of the People's Republic of China at its 27th Meeting on 4 September 1992, amended for the second time in accordance with the Decision of the Standing Committee of the Ninth National People's Congress on Amending the Patent Law of the People's Republic of China adopted at its 17th Meeting on 25 August 2000, and amended for the third time in accordance with the Decision of the Standing Committee of the Eleventh National People's Congress on Amending the Patent Law of the People's Republic of China at its 6th Meeting on 27 December 2008 (hereinafter: Patent Law of the PR China); an English translation is available at <[http://english.sipo.gov.cn/laws/lawsregulations/201101/t20110119\\_566244.html](http://english.sipo.gov.cn/laws/lawsregulations/201101/t20110119_566244.html)> (visited on 25 June 2011).

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<sup>4</sup> For a synoptic presentation of the former EPC (so-called EPC 1973) and the current EPC (so-called EPC 2000), see Special edition No. 5 OJ EPO, 2007.

<sup>5</sup> News release from the EPO dated 26 January 2011, found at <<http://www.epo.org/topics/news/2011/20110126.html>> (visited on 25 June 2011).

<sup>6</sup> Detailed filing statistics can be found on SIPO's homepage, in English at <<http://english.sipo.gov.cn/statistics/>> (visited on 25 June 2011).

<sup>7</sup> Found at <[http://english.sipo.gov.cn/statistics/gnwsznb/2010/201101/t20110125\\_570592.html](http://english.sipo.gov.cn/statistics/gnwsznb/2010/201101/t20110125_570592.html)> (visited on 25 June 2011).

<sup>8</sup> Found at <[http://english.sipo.gov.cn/statistics/gnwsznb/2009/201001/t20100127\\_488773.html](http://english.sipo.gov.cn/statistics/gnwsznb/2009/201001/t20100127_488773.html)> (visited on 25 June 2011).

Foreign applications including those from Europe constitute a significant share of the filings in China, whereas the number of applications for European patents from Chinese applicants is on the rise. A comparison of the treatment of these applications by two competent offices, the SIPO and the EPO, shall be made with regard to one aspect of the complex patent application procedures, particularly the question under which circumstances the filing of a divisional application stemming from a parent application is considered admissible.

## 2. Divisional patent applications

In principle, an application for a patent claims and describes what the applicant believes to be an inventive contribution to the already existing state of the art. Provided the formal and substantive requirements for granting the patent are fulfilled, the competent examination authority issues one patent for the inventive contribution. There are, however, two occasions when an applicant may want to divide the original application, i.e. may want to file a divisional patent application on the basis of the original application.

The first occasion is that upon examination of the application, the examination authority identifies a so-called lack of unity of invention. This means that the examiner in charge of the application believes that the application contains not only one single inventive concept, but actually claims at least two different inventions which follow unequal inventive concepts. Typically, an applicant is not allowed to have more than one invention protected by a single patent. Where an examiner raises a lack of unity objection, the applicant can either limit the application to one invention whilst not further pursuing the other invention or the applicant can make the further invention the subject-matter of a divisional application.

The second occasion is that an applicant may prefer to prosecute specific subject-matter in a divisional application without any unity objection being raised by the examination authority. There are various strategic reasons for the filing of such a voluntary divisional application. For example, a specific technical solution shall be patented quickly in order to obtain protection for the applicant's actual business, e.g. protection for a specific use of a new class of chemical compounds. The related technical teaching, i.e. the new chemical compounds themselves, is prosecuted in a second application, e.g. because it is expected to require a more time consuming application procedure. Although unity between the specific use of the new compounds and the compounds themselves is not questioned by the examination authority, it could be beneficial

for the applicant in such a case, to make the latter the subject-matter of a divisional application.

In view of these possibilities that the filing of a divisional patent application becomes either required or desired, it is to be asked which legislation governs such filings.

On the international level, the Paris Convention, established in 1883, is a valuable source<sup>9</sup>. China has been a member of the Paris Convention since 19 March 1985. The European Patent Organisation is not a member of the Paris Convention, but according to its preamble, the EPC constitutes a special agreement within the meaning of Article 19 of the Paris Convention<sup>10</sup> so that the EPC must not contravene the provisions of the Paris Convention<sup>11</sup>. Given that China and the European Patent Organisation thus both have to comply with the regulations laid down in the Paris Convention, it is worthwhile examining this convention for regulations relating to divisional patent applications. Article 4 G of the Paris Convention stipulates in this respect:

“(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.”

Article 4 G paragraph 1 Paris Convention, addresses the first of the two occasions described above, on which a divisional patent application may be filed. This regulation is straightforward: where the examination of a patent application leads

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<sup>9</sup> Paris Convention for the Protection of Industrial Property of 20 March 1883, last revised on 14 July 1967 at Stockholm and amended on 28 September 1979; an English version is available at <[http://www.wipo.int/treaties/en/ip/paris/trtdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html)> (visited on 25 June 2011).

<sup>10</sup> The EPC's preamble reads: “The Contracting States, DESIRING to strengthen co-operation between the States of Europe in respect of the protection of inventions, DESIRING that such protection may be obtained in those States by a single procedure for the grant of patents and by the establishment of certain standard rules governing patents so granted, DESIRING, for this purpose, to conclude a Convention which establishes a European Patent Organisation and which constitutes a special agreement within the meaning of Article 19 of the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883 and last revised on 14 July 1967, and a regional patent treaty within the meaning of Article 45, paragraph 1, of the Patent Cooperation Treaty of 19 June 1970”.

<sup>11</sup> OJ EPO 2001, 413; Decision G 2/98 of the Enlarged Board of Appeal of the EPO; see especially no. 3 of the reasons.

to the result that there is more than one invention contained therein, i.e. where a lack of unity objection is raised, the applicant is entitled to file divisional applications for all further identified inventions. Article 4 G paragraph 1 poses no further barriers to such filings. It follows that, neither according to the Patent Law of the PR China nor according to the EPC, any substantial limitations should be imposed which would deter an applicant from handing in a divisional patent application upon facing an objection as to multiple inventions in one application. An analysis of the conformity of the Patent Law of the PR China and the EPC with the Paris Convention in this regard is made in section 3 below.

Further, in Article 4 G paragraph 2 Paris Convention, the right to file a divisional patent application on the applicant's own motion is addressed. The first sentence of this prescription cannot be misunderstood: the applicant is free to file a divisional application should he desire to do so. The Paris Convention itself contains nothing further which would limit this right. However, there is a reference to the national jurisdiction in the second sentence of Article 4 G paragraph 2 Paris Convention, which empowers the member states of the convention to impose limitations on the applicant's possibility to file a divisional application on his own initiative. Before turning to an analysis whether such limitations apply under the Patent Law of the PR China or the EPC, further international treaties should be examined, which could contain additional regulations for the filing of divisional patent applications.

An international treaty that may be relevant is the Patent Cooperation Treaty (PCT)<sup>12</sup>. Currently, this treaty establishes the possibility to file one patent application which would take effect in 141 contracting states, in addition to giving effect to regional patent treaties as stipulated in Article 45 paragraph 1 PCT. China has been a contracting state of the PCT since 1 January 1994. Further, according to its preamble<sup>13</sup>, the EPC is a regional patent treaty according to Article 45 paragraph 1 PCT<sup>14</sup>. Accordingly, any regulations in the PCT as to divisional patent applications would be of interest. However, such regulations are neither found in

the PCT itself nor in its regulations<sup>15</sup>. This is at first astonishing as it might indicate that the PCT does not allow divisional patent applications and would therefore be in conflict with the Paris Convention, although according to Article 1 paragraph 2 PCT, no rights under the Paris Convention shall be diminished by the PCT.

It is, however, to be understood that the PCT is not a treaty under which patents are granted. Rather, the PCT is a system for the central filing of a patent application with effect for its contracting states and regional patent treaties. Such a PCT application is examined for formal requirements, a search for prior art is made which is summarized in an international search report and a non-binding opinion on substantive patentability criteria is provided. In order to have a patent granted on the basis of the PCT application, this application must proceed further through national and regional phases, respectively, for those countries and regions in which protection is sought. During such national and regional application phases, divisional applications may be filed in line with the prerequisites of the Paris Convention and the national/regional laws. The PCT itself is not a source for regulations which might have an impact on a patent applicant's right to file a divisional application, be it because of more than one invention being identified or because of the applicant's own initiative<sup>16</sup>.

Another possibly relevant international treaty is the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)<sup>17</sup>. However, neither the European Patent Organisation nor its organ, the EPO, is a party to the TRIPS Agreement. The fact that the European Union is party to the TRIPS Agreement (since 1 January 1995) also does not create a material nexus of the European Patent Organisation with that agreement. The European Patent Organisation is an independent organisation of its own; the governing law, the EPC, is independent. Accordingly, there is no direct legal link between the European Union and the European Patent Organisation which would have

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<sup>12</sup> Patent Cooperation Treaty, done at Washington on 19 June 1970, amended on 28 September 1979, modified on 3 February 1984 and on 3 October 2001; an English version is available at <<http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct.pdf>> (visited on 25 June 2011).

<sup>13</sup> See footnote 10.

<sup>14</sup> Other regional patent treaties according to Article 45 paragraph 1 PCT are the African Regional Intellectual Property Organization (ARIPO), the Eurasian Patent Organization (EAPO) and the African Intellectual Property Organization (OAPI).

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<sup>15</sup> Regulations under the Patent Cooperation Treaty as in force from 1 July 2010; an English version is available at <[http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct\\_regs.pdf](http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct_regs.pdf)> (visited on 25 June 2011).

<sup>16</sup> There had been proposals in the past to establish the possibility of dividing a PCT application during its international phase, but these proposals have not been transposed into actual PCT provisions to date. Related documents from the Working Group on Reform of the Patent Cooperation Treaty addressing the question of divisional applications under the PCT can e.g. be found here <[http://www.wipo.int/edocs/mdocs/pct/en/pct\\_r\\_wg\\_4/pct\\_r\\_wg\\_4\\_9.pdf](http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_4/pct_r_wg_4_9.pdf)> (visited on 25 June 2011) and here <[http://www.wipo.int/edocs/mdocs/pct/en/pct\\_r\\_wg\\_5/pct\\_r\\_wg\\_5\\_6.pdf](http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_5/pct_r_wg_5_6.pdf)> (visited on 25 June 2011).

<sup>17</sup> The TRIPS Agreement is Annex 1C of the Marrakesh Agreement establishing the World Trade Organization; an English version is available at <[http://www.wto.org/english/docs\\_e/legal\\_e/27-trips.pdf](http://www.wto.org/english/docs_e/legal_e/27-trips.pdf)> (visited on 25 June 2011).

resulted in the TRIPS Agreement impinging upon the European Patent Organisation, its organs or its law. It was therefore decided not to apply any TRIPS regulations within the framework of the codified legal system of the EPC<sup>18</sup>.

In China, the situation is different. China joined the TRIPS Agreement as a contracting party on 11 December 2001, so the agreement has direct application for procedures under the Patent Law of the PR China. The question arises as to which regulations of the TRIPS Agreement might be relevant for the admissibility of divisional patent applications under Chinese law. In Part IV of the TRIPS Agreement, the acquisition and maintenance of intellectual property rights is addressed. In respect of Part IV, Article 2 paragraph 1, TRIPS orders the contracting parties of the TRIPS agreement to comply with Articles 1 through 12 and 19 of the Paris Convention. However, the Paris Convention, and in the present context especially Article 4 G thereof, is to be observed by China anyway, as outlined above.

It is further stated in Article 62 paragraph 4 TRIPS Agreement, that a member's law concerning procedures of acquiring intellectual property rights, including patents<sup>19</sup>, shall be governed by the general principles set out in Article 41 paragraph 2 and 3 TRIPS Agreement. Article 41 paragraph 2 TRIPS Agreement basically stipulates that procedures shall be fair and equitable, but neither unnecessary complicated, costly or unreasonably lengthy. Article 41 paragraph 3 TRIPS Agreement further outlines some requirements for decisions on the merits. Both prescriptions in the TRIPS Agreement contain, however, no further details with respect to the admissibility of divisional patent applications.

It is thus to be clarified how the Patent Law of the PR China and the EPC, respectively, transpose the Paris Convention's basic regulations for the two possibilities for filing divisional patent applications, i.e. for the filing of a divisional patent application because more than one invention is identified and for the filing of a divisional patent application based on the applicant's own initiative.

### 3. Divisional patent application because of more than one invention

#### 3.1 The Patent Law of the PR China

According to Article 31 paragraph 1 Patent Law of the PR China, an application for a patent of invention shall in principle be restricted to one single invention. Only where two or more inventions are following a common general inventive concept, is it permissible to apply for a patent for all of them with one single application. Apart from these instructions to applicants, no regulations for the filing of divisional patent applications are found in the Patent Law of the PR China itself, also not for the case that one application contains two inventions which do not follow a common inventive concept.

Nevertheless, for the case of an application for a patent of invention containing two inventions with differing concepts, the Paris Convention requires China, as a member, to provide for possibilities to divide that application. For this reason, the Implementing Regulations of the Patent Law of the People's Republic of China<sup>20</sup> allow such dividing of an application, as laid down in Rule 42 paragraph 1 Implementing Regulations. This also applies to international applications, i.e. applications filed under the PCT system, after such an international application has entered the national Chinese phase (Rule 115 Implementing Regulations).

Actually, with more than one invention, the unity requirement of Article 31 paragraph 1 Patent Law of the PR China is not met. If an examiner detects such a defect, the applicant shall be invited to remedy this deficiency within a time limit to be set by the examiner (Rule 42 paragraph 2 Implementing Regulations). This can be done by limiting the application to a single invention. A divisional application may be filed in respect of the invention that is afterwards not included anymore. When doing so, some formal requirements must be observed. The to-be-divided application must be pending in the sense that it has neither been rejected nor withdrawn nor shall it be deemed to have been withdrawn (Rule 42 paragraph 1 Implementing Regulations). Further, the divisional

<sup>18</sup> OJ EPO 2004, 483; Decisions G 2/02 and G 3/02 of the Enlarged Board of Appeal of the EPO; see especially no. 8.9 of the reasons (G 2/02 and G 3/02 are identical).

<sup>19</sup> The term "intellectual property rights" is defined in the TRIPS Agreement in an autonomous manner. Article 1 paragraph 2 TRIPS Agreement points in this context to all categories of rights referred to in Part II of the TRIPS Agreement, which include patents (Article 27 through 34 TRIPS Agreement).

<sup>20</sup> Promulgated by Decree No. 306 of the State Council of the People's Republic of China on 15 June 2001, amended for the first time in accordance with the Decision of the State Council on Amending the Implementing Regulation of the Patent Law of the People's Republic of China on 28 December 2002, amended for the second time in accordance with the Decision of the State Council on Amending the Implementing Regulation of the Patent Law of the People's Republic of China on 9 January 2010, and effective as of 1 February 2010, abbreviated "Implementing Regulations" hereinafter; an English version is downloadable from the website of the EU-China Project on the Protection of Intellectual Property Rights (IPR2) at <<http://www.ipr2.org/ipsearch/file.php?id=434#>> (visited on 25 June 2011).

patent application must not change the kind of protection (Rule 42 paragraph 3 Implementing Regulations). This means that where a patent of invention is divided, the divisional application shall not be one for a utility model or a design, but shall also be one for a patent of invention<sup>21</sup>.

Whilst the divisional application does not need to be filed within the time limit set by the examiner to overcome the objection as to lack of unity<sup>22</sup>, another formal aspect is that the divisional patent application can only be filed within the time limit set in Rule 54 paragraph 1 Implementing Regulations. The set time limit requires that an applicant, after having been notified that a patent shall be granted, must comply with all formalities of registration within two months from the date of receipt of the notification. For the scenario of an intended divisional patent application, this brings about the requirement to file such a divisional application within two months after having received the grant notification for the parent application<sup>23</sup>.

Reverting back to Article 4 G paragraph 1 Paris Convention, a patent application shall be dividable where more than one invention is contained in the original patent application. As this refers to an application, the application should be active, i.e. neither rejected nor withdrawn nor deemed to be withdrawn, in accordance with Rule 42 paragraph 1 Implementing Regulations. Naturally, where a patent application is divided, the divisional as well as its parent are both a patent application, as requested by Rule 42 paragraph 3 Implementing Regulations. The Paris Convention is further silent on divisional applications arising from granted patents, so that an application for a patent shall apparently be pending in the sense of the applicable legislation at the time of the filing of the divisional application. At a certain point in time when a patent is granted for an application, there will be a caesura, and thereafter an application will not be considered pending any more. It follows from Rule 54 paragraph 1 Implementing Regulations that this

change in status occurs two months after the applicant has received the grant notification for the parent application. All formal requirements of the Chinese regulations thus find sufficient basis in Article 4 G paragraph 1 Paris Convention.

As a result, when filing a divisional patent application on the grounds of more than one invention, the Patent Law of the PR China, including its Implementing Regulations, concurs with the basic requirements set out in this respect in the Paris Convention.

### 3.2 The European Patent Convention (EPC)

Reference to divisional patent applications is made in the EPC itself, namely in Article 76 thereof. Such a divisional application must be filed directly with the European Patent Office only<sup>24</sup> and, provided its subject-matter does not extend that of its parent application, enjoys the same filing date and priority date, respectively, of the earlier application<sup>25</sup>. For the divisional application, the same contracting states are deemed to be designated which at the time of the filing of the divisional application are validly designated in the parent application<sup>26</sup>. These regulations apply to European patent applications and also to PCT applications which have entered the regional European phase because such PCT applications are equivalent to regular European applications<sup>27</sup> and are treated as European patent applications<sup>28</sup>. However, the further circumstances under which a divisional application is admissible are not addressed in Article 76 EPC, which simply makes a general reference to the Implementing Regulations of the EPC<sup>29</sup>.

For the aspects of divisional patent applications addressed herein, Rule 36 EPC<sup>30</sup> is of particular importance. Since its implementation in 2007<sup>31</sup>,

<sup>21</sup> This becomes evident from the listing of possible kinds of protection in Rule 39 no. 6 Implementing Regulations which clarifies that "kind of protection" shall refer to a patent for invention, utility model or design, respectively.

<sup>22</sup> See Part II, Chapter 6, Section 3.1, page 229, last paragraph of the English version of the Guidelines for Patent Examination 2010, State Intellectual Property Office of the People's Republic of China, Ordinance of the State Intellectual Property Office No. 55, hereafter referred to as "SIPO Guidelines"; an English version is available at <<http://www.ipr2.org/storage/2010%20Guidelines%20for%20Patent%20Examination.pdf>> (visited on 25 June 2011).

<sup>23</sup> In case of a rejection of the application, there are two possibilities: the applicant may file a divisional application within three months after having received the decision of rejection without requesting a reexamination, or the applicant may request reexamination and file a divisional application at the reexamination stage (see SIPO Guidelines, Part I, Chapter 1, Section 5.1.1, page 20, item (3), second paragraph).

<sup>24</sup> In contrast to a standard European Patent Application which in addition to the EPO may also be filed with the central industrial property office or any other competent authority of a contracting state the national law of which permits to do so (see Article 75 paragraph 1 (b) EPC).

<sup>25</sup> Article 76 paragraph 1 EPC.

<sup>26</sup> Article 76 paragraph 2 EPC.

<sup>27</sup> Article 153 paragraph 2 EPC.

<sup>28</sup> Article 153 paragraph 5 EPC.

<sup>29</sup> Implementing Regulations to the Convention on the Grant of European Patents of 5 October 1973 as adopted by decision of the Administrative Council of the European Patent Organisation of 7 December 2006; an English version is available at <<http://www.epo.org/law-practice/legal-texts/html/epc/2000/e/ma2.html>> (visited on 25 June 2011).

<sup>30</sup> Rules of the Implementing Regulations of the EPC are usually cited without reference to the "Implementing Regulations", see e.g. recommended abbreviations in the Guidelines for Examination in the European Patent Office, April 2010, General Part, Section 2.2; an English version thereof is available at <[http://documents.epo.org/projects/babylon/eponet.nsf/0/7ffc755ad943703dc12576f00054cacc/\\$FILE/guidelines\\_2010\\_complete\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/7ffc755ad943703dc12576f00054cacc/$FILE/guidelines_2010_complete_en.pdf)> (visited on 25 June 2011); this approach is followed herein in order to avoid confusions with the Implementing Regulations of the Patent Law of the People's Republic of China.

Rule 36 EPC has already undergone three revisions<sup>32</sup>. Because of this instability and due to its direct impact on the established system and on the everyday life of practitioners, it has caught quite some attention and has even given rise to criticism<sup>33</sup>. Nevertheless, Rule 36 EPC as in force today must be observed and is therefore to be analyzed for the requirements for filing divisional patent applications set forth therein.

As a general principle, Rule 36 EPC requires the parent application to be pending at the filing date of the divisional application for the latter to be admissible. Quite like the Chinese regulations referred to above, a pending application is one which has neither been refused nor withdrawn, nor is it one which is deemed to be withdrawn<sup>34</sup>. Further, a European patent application is pending up to - but not including - the date that the European Patent Bulletin mentions the grant of the patent<sup>35</sup>. That is, the regulations of the EPC are similar to those in the Chinese law and define a point in time after which an application is not pending anymore.

Besides, since the EPC deals with patents alone, but not with utility models or with designs, no prerequisites as to an identity between the kind of the parent application and the kind of the divisional application are found within this convention. A divisional application to a European patent application is necessarily a further patent application itself, so that identity of the type of the requested intellectual property rights is provided.

Up to this point, the EPC's provisions for filing a divisional application because of more than one invention, like the corresponding Chinese provisions, transpose the requirements set out in this respect in the Paris Convention.

Rule 36 EPC has, however, something additional up its sleeve. According to Rule 36 paragraph 1 (b) EPC, a divisional application because of more than one invention must be filed within a time limit of twenty-four months; such time limit is triggered by the first unity objection raised by the examining

division in any communication from that division. The compliance of this limitation with the Paris Convention may be questionable. This is because contrary to the wording of Article 4 G paragraph 2 Paris Convention, which allows restrictions to be imposed on the applicant's freedom to file divisional applications on his own initiative, no such empowerment is found in Article 4 G paragraph 1 Paris Convention. Evidently, some formal requirements will have to be observed for divisional applications falling into the definition of Article 4 G paragraph 1 Paris Convention, although the Paris Convention does not mention such formal requirements in this context. It nevertheless remains doubtful whether it is allowable to restrict such divisional applications because of more than one invention in the same application by setting a deadline, and conformity of Rule 36 paragraph 1 (b) EPC with the Paris Convention has indeed been contested<sup>36</sup>.

Irrespective of such concerns, according to Rule paragraph 1 (b) EPC as in force, once the EPO examiner has identified a lack of unity and has raised a respective objection, the clock starts running for the applicant, and within twenty-four months the decision whether or not to file a divisional application for the non-unitary subject-matter has to be made. There is thus a clear temporal restriction imposed by Rule 36 EPC on the filing of divisional patent applications that deal with a unity objection raised by the examiner.

In contrast, such a temporal restriction of the applicant's right to file a divisional application where this becomes necessary in order to prosecute all inventions contained in the original application, so as to obtain the deserved patent protection for each of them, is not outlined in the current Chinese patent law regulations. Even though a lack of unity objection has been raised at a certain point of the application procedure by the Chinese patent examiner, the applicant may later still be entitled to file a divisional application, be that twenty-four or even further months after the objection was raised for the first time.

It is seen that the filing of a divisional patent application because of more than one invention before the SIPO and the EPO, respectively, is subject to basically the same requirements. Before the EPO, there is an additional restriction of the appli-

<sup>31</sup> The original version of Rule 36 of the so-called EPC2000 entered into force on 13 December 2007.

<sup>32</sup> See OJ EPO 2008, 513; OJ EPO 2009, 296; and OJ EPO 2010, 568; the current version of this Rule 36 entered into force on 26 October 2010.

<sup>33</sup> To give some examples: *S. Frischknecht, H. Frey*, epi Information 3/2009, 93; *S. Frischknecht, H. Frey*, epi Information 1/2010, 10; *H. Wegener, R. Teschemacher*, epi Information 2/2010, 53; *A. Vögele, H. Nemeč*, epi Information 3/2010, 97 (the "epi Information" is the quarterly periodical of the Institute of Professional Representatives before the European Patent Office; an online archive is available at <<http://www.patentepi.com/patentepi/en/Information/epi-information.php>> (visited on 25 June 2011)).

<sup>34</sup> Guidelines for Examination in the European Patent Office, April 2010, Part A, Chapter IV, section 1.1.1.1.

<sup>35</sup> OJ EPO 2/2002, 112.

<sup>36</sup> *S. Frischknecht and H. Frey*, epi Information 1/2010, identify a clear violation of Article 19 Paris Convention by Rule 36 paragraph 1 (b) as in force. The EPC is a special agreement in the sense of Article 19 Paris Convention (see footnote 10), so that it must not contravene the provisions of the Paris Convention. There is, however, no legal institution or a competent court into which an action could be brought to apply for a review of the conformity of the EPC Rules with the Paris Convention and, ultimately, for the nullification of a non-conform EPC Rule.

cant's right to file such a divisional patent application, i.e. once an objection as to lack of unity has been raised, a time limit of twenty-four months for doing so must be observed.

#### 4. Divisional patent application based on the applicant's own initiative

##### 4.1 The Patent Law of the PR China

Similar to the situation addressed in section 3.1 above, the only relevant regulation found in the Patent Law of the PR China is actually Article 31 paragraph 1 thereof. The order is clear: one single application for a patent of invention shall contain only one single invention. Nothing is stated, however, in the Patent Law of the PR China about the consequences or remedies as a result of non-compliance with this regulation.

Again, Rule 42 paragraph 1 Implementing Regulations is of some help and provides guidance for such a situation. The applicant may file a divisional application with the SIPO, unless the parent application has been rejected, withdrawn or is deemed to have been withdrawn. Formal requirements are the same as listed in section 3.1, i.e. according to Rule 42 paragraph 3 Implementing Regulations the divisional patent application shall not change the kind of protection, and the time limit according to Rule 54 paragraph 1 Implementing Regulations has to be observed. It could thus be said that the requirements for an admissible divisional patent application based on the applicant's own initiative are the same as in the case of a divisional patent application because of more than one invention. However, this assessment falls short of providing a full analysis.

It may happen that an applicant is interested in keeping a patent application active, despite one invention defined therein being patentable or despite a possible rejection of the application. The original application is granted or rejected. Within the applicable time limit of two or three months<sup>37</sup>, a divisional patent application of a first generation is filed. When this first generation divisional application is allowed or rejected itself, a divisional patent application of a second generation is filed on the basis of this first divisional application, and so forth. In other words, a cascade of divisional applications would be possible, so that one application would always be pending until the maximum term of an application is reached<sup>38</sup>. For the applicant,

such an unlimited possibility to file a divisional patent application constitutes a high degree of freedom in prosecuting the entire disclosure of the originally filed application. For third parties, on the other hand, a pending application always brings about a certain degree of uncertainty, as the application might or might not develop into a patent of yet unknown scope.

In view of the naturally conflictive interests of applicants and third parties, respectively, the Chinese patent law opts for a limitation of the applicant's freedom. In the above-illustrated case, the admissibility of the first generation divisional application with regard to its time limit is linked to the procedure of the original application. That is, such a first generation divisional application is only admissible until the end of the applicable term of either two or three months following the grant or the rejection of its parent application, which is the originally filed application. In contrast, the temporal admissibility of a second generation divisional application is not tied to the procedure of its parent, i.e. not to the procedure of the first generation divisional application. Instead, the final deadline for filing a second generation divisional application is again calculated on the basis of the original application, as laid down in the SIPO Guidelines<sup>39</sup>.

It is questionable whether guidelines issued by an administrative body are actually qualified to impose limitations to the applicant's right to file a divisional application on his own motion within the context of Article 4 G paragraph 2 Paris Convention. In one of the EPC member states, namely Germany, such an approach was dismissed<sup>40</sup>. For China, however, it is not apparent that there is any case law or patent practice which would call into question the validity of the regulations set out in the SIPO Guidelines for divisional patent applications of the second and any further generation<sup>41</sup>.

Consequently, a time limit must be observed when filing divisional applications as a result of the applicant's own initiative; such time limit is triggered by either the notification to grant the patent right for the original application or by the rejection of the original application.

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<sup>39</sup> The decisive part of the English version reads: "Where an applicant files another divisional application based on an already filed divisional application, the submission date of another divisional application shall be examined according to the initial application." (SIPO Guidelines, Part I, Chapter I, Section 5.1.1, page 20, last sentence).

<sup>40</sup> German Federal Patent Court, GRUR Int. 1968, 132 - Elektronenröhre (Electron tube).

<sup>41</sup> In fact, the three-months term for a divisional application, which is subsequent to the rejection of the original application and applies in case that no reexamination is requested, is also only stipulated in the SIPO Guidelines.

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<sup>37</sup> Two months in the case of a notification to grant (Rule 42 in connection with Rule 54 Implementing Regulations), three months in the case of a rejection (see footnote 23).

<sup>38</sup> 20 years, which is the maximum term for an invention patent right according to Article 42 Patent Law of the PR China.

In the latter case of rejection, another factor comes into play. According to Article 41 Patent Law of the PR China, the applicant may contest the rejection by filing a request for review with the Patent Review Board within a time period of three months from the date of receipt of the rejection. Should the applicant not execute his right to request a review, a divisional application may be filed within the same period of three months. In case the request for review is actually made, the application can still be validly divided during the reexamination phase<sup>42</sup>. In such an event, the three-months term no longer applies. Following Rule 62 Implementing Regulations, the Patent Review Board receiving a formally admissible request for reexamination will remit the application to the same examination department which issued the rejection. This examination department may set aside its former decision<sup>43</sup> or may retain its negative assessment. In either case, an interlocutory examination opinion has to be established by the examination department, which should be completed within one month<sup>44</sup>.

Should the former decision be set aside by the examination department, the Patent Review Board will make a respective reexamination decision. The office file is then returned to the competent examination department for a continuation of the examination process, wherein the decision to overturn the rejection is binding<sup>45</sup>. The competent examiner should then notify the applicant of the intention to grant a patent<sup>46</sup>. Such notification triggers the term of two months for filing a divisional application, as in the case of an acceptance of the patent application by the examiner without going through the reexamination phase.

In contrast, where the examination department maintains its original decision to reject the application, the Patent Review Board invites the applicant to file additional observations within a specified time limit, as required by Rule 63 paragraph 1 Implementing Regulations. The specified time limit will typically be one month<sup>47</sup>. After having reviewed the applicant's further observations, the

Patent Review Board may issue a decision to uphold the rejection, which terminates the reexamination procedure, but there is a further legal remedy against such a negative decision available. That is, the applicant may initiate legal action before the People's Court within three months after having been notified of the negative decision<sup>48</sup>. During such administrative litigation against the reexamination decision, the filing of a divisional patent application remains admissible<sup>49</sup>.

In summary, the applicant may file a divisional patent application on his own motion under the Chinese patent law, as requested by Article 4 G paragraph 2 Paris Convention. This general right is limited in that specific time constraints for filing such a divisional application must be observed. As long as the original parent application is pending, a divisional application is admissible. Once the applicant is notified that the original parent application shall be granted, only two months for filing a divisional application remain. In the event that the original parent application is rejected, there are three months for such a filing, unless a reexamination procedure is started during which the filing of a divisional application is also permissible. This is equally applicable for the duration of a possible civil action against the Patent Review Board's decision before the People's Court. Once all these time periods referring to the original patent application have passed, no further divisional patent applications may be filed.

As mentioned previously, Article 4 G paragraph 2 Paris Convention allows the member states to impose certain restrictions to voluntary filings of divisional patent applications, without further specifying such restrictions. The Chinese regulations in this respect are in line with the Paris Convention.

## 4.2 The European Patent Convention (EPC)

The legal prerequisites for filing a divisional application under the EPC on the applicant's own initiative are essentially the same as for a divisional application because a lack of unity arises, as addressed in section 3.2 above. That is, Article 76 EPC is pertinent, but apart from the provisions that were previously referred to<sup>50</sup>, this Article does not

<sup>42</sup> See footnote 23; the English translation of the Patent Law of the PR China uses the term "review", which is often also referred to as "reexamination", e.g. in the English translations of the Implementing Regulations and the SIPO Guidelines, respectively. The "Patent Review Board" is likewise often named "Reexamination Board".

<sup>43</sup> Because the reasons for the requested reexamination as submitted by the applicant under Rule 60 paragraph 1 Implementing Regulations convince the examination department or because amendments made to the application under Rule 61 paragraph 1 Implementing Regulations overcome the grounds for the rejection.

<sup>44</sup> Rule 62 Implementing Regulations together with SIPO Guidelines, Part IV, Chapter 2, Section 3.1, page 439, first full sentence.

<sup>45</sup> SIPO Guidelines, Part IV, Chapter 2, Section 7, page 444.

<sup>46</sup> The SIPO examiner might however come up with new objections based on new grounds.

<sup>47</sup> SIPO Guidelines, Part IV, Chapter 2, Section 4.3, page 443, in the middle of the page.

<sup>48</sup> See Article 41 paragraph 2 Patent Law of the PR China.

<sup>49</sup> SIPO Guidelines, Part I, Chapter 1, Section 5.1.1, page 20, item (3), second paragraph.

<sup>50</sup> See section 3.2: Divisional application has to be filed directly with the EPO; filing date and priority date are preserved; only those contracting states can be designated which are covered by the parent application; also applies to applications entering the EP phase via the PCT route.



impose any further particular filing requirements on the applicant.

Therefore, one has to consult the Implementing Regulations of the EPC to ascertain more about possible limitations of the applicant's freedom to voluntarily divide a European patent application. As mentioned above, Rule 36 paragraph 1 EPC requires that the parent application is still pending, whilst otherwise no divisional application can be validly filed. In addition, Rule 36 paragraph 1 (a) EPC contains some rather complicated provisions that apply to the situation whereby an applicant intends to divide the original patent application on his own initiative. Basically, the applicant is granted twenty-four months from the first substantial examination report in the original application within which to file a divisional application<sup>51</sup>.

One practically important aspect is to identify the "first" communication mentioned in Rule 36 paragraph 1 (a) EPC in order to be able to calculate and observe the time limit of twenty-four months which is triggered by this communication. In the past, advice from the EPO regarding this matter was frequently sought by its users<sup>52</sup> and supplementing explanations were included in the EPO's Guidelines for Examination<sup>53</sup>. The identification of the first communication and consequently of the date starting the term of twenty-four months may however become easier because since 1 April 2011, the EPO has started entering into the European Patent Register<sup>54</sup> the date of despatch<sup>55</sup> of the examining division's first communication within the meaning of Rule 36 paragraph 1 (a) EPC<sup>56</sup>. Further, from 18 April 2011 on, communications from the EPO shall indicate that the communication marks the start of the twenty-four months time

limit<sup>57</sup> where applicable. Irrespective of these practical considerations, it is important to note that the applicant is given twenty-four months from the first substantive office action for voluntarily dividing the original application.

Another aspect of Rule 36 paragraph 1 (a) EPC which comes into play at this point is the reference to the "earliest application". This means that the time limit of twenty-four months has to be calculated based on the first communication in the original application. If a divisional application is filed during this period, a divisional of a first generation is created. As long as this divisional application is pending, a further divisional of a second generation may be divided from it. Such a divisional application of the second generation must, however, in any event be filed within the twenty-four months time limit which started due to a communication from the office in the application procedure of the first, original application.

In other words, within a cascade of divisional applications, it is always the start of the first twenty-four months term that counts. A later communication issued for the divisional application of the first (or any subsequent) generation does not trigger a fresh twenty-four months term. Thus, once the first twenty-four months period is over, the applicant is precluded from filing a divisional application on his own initiative.

Another question that arises is whether the fate of the original application is of relevance for the temporal limitation of the right to file a voluntary divisional application. In case the original application is granted, it is pending until its grant is mentioned in the European Patent Bulletin<sup>58</sup>. Further, in case the original application is rejected by the EPO, an appeal against such a decision may be filed pursuant to Article 106 EPC, and during the appeal phase, the application remains pending because in such an appeal the same provisions as in the first instance examination phase apply, as it is laid down in Rule 100 paragraph 1 EPC. Even if no appeal is filed, the application remains pending in the sense of Rule 36 paragraph 1 EPC until the expiry of the time limit for filing a notice of appeal<sup>59</sup>, which is actually two months of notification of the negative decision<sup>60</sup>. However, the

<sup>51</sup> Rule 36 paragraph 1 (a) EPC actually reads: "The applicant may file a divisional application relating to any pending earlier European patent application, provided that: (a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication under Article 94, paragraph 3, and Rule 71, paragraph 1 and 2, or Rule 71, paragraph 3, in respect of the earliest application for which a communication has been issued, ...".

<sup>52</sup> See e.g. OJ EPO 2010, 406 - Notice from the European Patent Office dated 29 June 2010 concerning communications under amended Rule 161 EPC.

<sup>53</sup> Guidelines for Examination in the European Patent Office, April 2010, Part A, Chapter IV, section 1.1.1.2.

<sup>54</sup> Article 127 EPC.

<sup>55</sup> For which the 10 days mailing fiction according to Rule 126 paragraph 2 EPC applies (confer Guidelines for Examination in the European Patent Office, April 2010, Part A, Chapter IV, section 1.1.1.2).

<sup>56</sup> OJ EPO 2011, 110 - Decision of the President of the European Patent Office dated 9 December 2010 concerning the information given in the European Patent Register; whilst according to Article 125 EPC the EPO has to take the principles of procedural law generally recognized in the Contracting States into account, which includes the principle of good faith, there is no case law yet for the situation that an applicant files a divisional application after the twenty-two months term due to a wrong entry in the European Patent Register. It is recommendable to verify any entry in the Register before using it as a basis for calculating the term for filing a voluntary divisional patent application.

<sup>57</sup> OJ EPO 2011, 273 - Notice from the European Patent Office dated 11 March 2011 concerning identification of the examining division's first communication in respect of the earliest application for which a communication has been issued and the entry of this communication's date of despatch in the European Patent Register.

<sup>58</sup> See footnote 35.

<sup>59</sup> OJ EPO 2011, 336; Decision G 1/09 of the Enlarged Board of Appeal of the EPO.

<sup>60</sup> Article 108 EPC.

twenty-four months period is not extended in any of these scenarios, which are only relevant for the question whether the parent application is still pending. Actually, the period of twenty-four months may end at any point in time during the examination phase or during a possible appeal phase, so that the outcome of the examination procedure of the original application is of no relevance in this context.

It can thus be stated that for a divisional patent application on the applicant's own motion, the EPC contains a restriction in that such a divisional application may only be filed within twenty-four months from the first substantive official communication from the EPO concerning the original application<sup>61</sup>. Like the Chinese regulations, the imposed limitations do not constitute a violation of Article 4 G paragraph 2 Paris Convention, because this Article empowers the member states to provide for limitations, and it does not rule out particular types of limitations, or temporal limitations.

However, under the EPC, the clock for divisional applications starts running at the beginning of the examination procedure, typically at the beginning of the examination procedure of the original application. This is quite different to the Chinese approach, where the clock starts at the end of the examination procedure of the original application, as discussed in section 4.1.

## 5. Discussion and Conclusion

An application for a patent for invention filed with the SIPO and the EPO, respectively, may be divided when more than one inventive concept is identified or on the applicant's own motion, as required by Article 4 G paragraph 1 and 2 Paris Convention.

In the case of more than one invention, the regulations of the Chinese patent law and the regulations under the EPC are largely identical, but the EPC provides for an additional time limit of twenty-four months. This time limit is triggered by the official communication identifying the presence of more than one invention in the same application, whilst such a time limit is unknown from the Patent Law of the PR China, its Implementing Regulations or the SIPO Guidelines. One basic rationale of Article 4 G paragraph 1 Paris Convention is to enable

an applicant, who is forced to divide a patent application because of multiple inventions being defined therein, to hand in one or more divisional applications as desired to make full use of the original disclosure. Given that the economic value of a certain invention may become apparent only several years after it was actually made<sup>62</sup>, it seems to be hardly justifiable to impose a temporal restraint on the applicant's right to file a divisional application in this context. There is also no justification for such a limitation in Article 4 G paragraph 1 Paris Convention itself. It seems fair to call into question whether the temporal restriction under the EPC of the applicant's right to file a divisional application because of more than one invention still complies with the gist of the Paris Convention.

It is thus concluded that the regulations under the EPC for filing a divisional patent application because of more than one invention have recently become quite restrictive, whereas the regulations of the Chinese patent law in this respect remain more generous and actually reflect the intention of Article 4 G paragraph 1 Paris Convention.

In the case of a voluntary filing of a divisional patent application on the applicant's own initiative, contracting parties of the Paris Convention may restrict such voluntary filings according to Article 4 G paragraph 2 Paris Convention. Both, the Patent Law of the PR China and the EPC, contain such restrictions and particularly define a limit of the time period for dividing the original application and any subsequent divisional applications. Both systems thus obviate an infinite cascade of divisional applications.

However, there is a clear contrast: the Chinese regulations urge an applicant to decide on the filing of a divisional application on his own motion within a specified time limit at the end of the application procedure of the original application. The regulations of the EPC, on the other hand, force an applicant to decide on one or more voluntary divisional applications already at the beginning of the substantial examination procedure of the original application. By virtue of these recent limitations, the EPC has changed from a system allowing an unrestricted filing of divisional applications on the applicant's own initiative<sup>63</sup> to a system requiring an applicant to make a sometimes quite complicated decision as to whether one or more divisional appli-

<sup>61</sup> One can think of a situation in which no substantive communication is issued for the original application, but only in the examination procedure of a divisional application stemming from this original application, or where the first communication in the original application procedure is issued later than the first communication for the divisional application. Under such circumstances, the twenty-four months are to be calculated on the basis of the communication issued for the divisional application (see Guidelines for Examination in the European Patent Office, April 2010, Part A, Chapter IV, section 1.1.1.4).

<sup>62</sup> For example, due to the necessity to file a patent application before making anything thereof public on the one hand and the usually very time consuming clinical studies and marketing approval application procedures on the other hand, there are typically many years between the filing of a patent application for an invented new chemical entity for medicinal purposes and this invention becoming economically successful - if at all.

cations should be filed at the early stages of an application procedure. The Patent Law of the PR China also forces the applicant to make such a decision, but only at a later stage of the original application procedure, i.e. at a point in time where the economic relevance of specific subject-matter contained in the original application can usually be better assessed. The regulations of the Chinese law are hence considered more balanced.

In summary, it can be said that the provisions for filing divisional patent applications of the Patent Law of the PR China and the EPC, respectively, basically follow the prerequisites already set out in the Paris Convention. It is, however, seen that the Chinese regulations for filing divisional patent applications are partly more generous and more balanced. In view of this result, which might be somewhat surprising, the author would like to quote a sentence which was often used by his former English teacher<sup>64</sup>: "It's a question of the details."

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<sup>63</sup> No such time limits as those of current Rule 36 EPC were found in the former version of the EPC (the EPC 1973), under which the applicant was entitled to divide an application as long as it was pending. This remained the case even with Rule 36 of the revised EPC (EPC 2000) which entered into force first on 13 December 2007 (see footnote 4). The twenty-four months time limits for filing divisional applications of Rule 36 paragraph 1 (a) and (b) EPC, respectively, were for the first time introduced with amended Rule 36 EPC which entered into force on 1 April 2010.

<sup>64</sup> Who is not at all responsible for the quality of the language used herein; Mr Andrew Southan, R.I.P.