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?

DECISION 486 of the ANDEAN COMMUNITY rules the Intellectual Property matters in Venezuela, it only has provisions for a divisional application (it is more a fractioning of the application), but no provisions for a continuation or continuation–in–part applications.

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

Article 34 of DECISION 486 of the ANDEAN COMMUNITY, states that “The applicant for a patent may, at time during the processing, request the modification of the application, but that modification may not involve extending the scope of protection beyond the use indicated in the initial application”; additionally Article 36 of same Decision 486, states that “Applicants may, at any time during the processing, divide (it is more a fractioning of the application) their applications into two or more divisional applications, but none of these may have the effect of extending the scope of protection beyond the use indicated in the initial application”. Also the competent patent office may, at any time during the process, ask the applicant to divide the application if it fails to comply with the requirement for the unity of the invention. Each divisional application shall be entitled to keep the original filing date or, where priority is claimed, the initial date of application. Where multiple or partial priorities are claimed, the applicant or the competent national office shall state what priority date or dates shall be applicable to the subject matters that each of these divisional applications shall cover.

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?

See Answer to question 2).

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?

Cascades of divisional, continuation and continuation–in–part applications are not allowed, nor is it possible to file a divisional, continuation or continuation–in–part application on the basis of another divisional, different from the parent application, continuation or continuation–in–part application.
5) At what time during the prosecution of the parent application may divisional, continuation or continuation-in-part applications be filed?

At time during the processing.

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?

It is possible only when the direct parent application is still pending at the time of filing of the divisional.

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?

Yes.

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

Only that none of the divisions may have the effect of extending the scope of protection beyond the use indicated in the initial application. See Answer 2).

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?

See Answer 8) and 2).

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, see Answer 8) 9) and 2).

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?

Yes.

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

No.

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?

The advantage will be the possibility to separate the matters if it fails to comply with the requirement for the unity of the invention.
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?

None.

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?

We think all should be permissible.

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?

No new Matter.

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

No.

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?

No.

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

No.

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

No.

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 agree to it.

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