Divisional, Continuation and Continuation-in-Part Applications (Q 193)

REPORT OF SWISS GROUP *


I. General Remarks

The following analysis is focused on Swiss national patent applications. We will not deal with European patent applications although patent protection in Switzerland is nowadays mainly obtained through this way.

Swiss national patent applications are examined by the Swiss Patent Office on absolute requirements. Relative requirements, like novelty, inventiveness, are taken into account only during litigation (nullity/infringement action) by a court. Amendments substantially modifying the scope of protection during examination are quite rare, hence an incentive of voluntarily filing a Swiss divisional patent application does almost never exist.

Switzerland has ratified the EPC 2000 on June 12, 2006. However, the Swiss Patent Act is still under revision in order to further harmonize the Act with the EPC.

II. Analysis of the Current Law

1. Are divisional, continuation or continuation-in-part applications, respectively, available under your national or regional law?

Divisional applications are allowable according to art. 57 of the Swiss Patent Act. Continuation or continuation-in-part applications are not provided in the Swiss patent system. However, art. 17 of the Swiss Patent Act allows internal priority. In such a case, a Swiss patent application filed within 12 months following the first Swiss patent application can be compared to a continuation or a continuation-in-part application as defined under Item 1) of the Introduction of the Working Guidelines to Question Q193.

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

Most frequently, a divisional application is filed in order to overcome a non-unity objection (art. 52 of the Swiss Patent Act) raised during the examination of the parent application. However, the applicant is generally free to voluntarily divide his application without the need of giving any justification. The usual reasons for filing divisional applications are those indicated under Items 2) to 4) of the Introduction of the Working Guidelines to Question Q193. A typical reason for voluntarily filing a divisional application is to adapt the claimed invention more precisely to the activity of a potential infringer.
Applications claiming internal priority are typically filed for completing and/or correcting the corresponding priority application or to “extend” up to 12 months the duration of the patent protection.

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?

The conditions and circumstances for filing a divisional application are set forth in art. 57.1.a-c of the Swiss Patent Act, which reads: “A patent application resulting from the division of an earlier application shall have the same filing date as the earlier application: a. if, at the time of its filing, it is expressly identified as being a divisional application; b. if, at the time of filing of the divisional application, the earlier application was still pending; and c. in so far as its subject matter does not go beyond the content of the original version of the earlier application”.

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 applications are allowed as confirmed by the case law (SMI 1960, 156) and the Guidelines for Examination (of the Swiss Federal Institute of Intellectual Property), chapter 12.4.

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

The filing of a divisional application is possible at any time as long as the parent application is pending, i.e., until the grant of the parent application is registered in the Patent Register or until the date of the withdrawal or the date of the rejection of the application (art.57.1.b and 60.1 of the Swiss Patent Act). See also case law (BGE 100 Ib 126, 99 Ib 122; SMI 1970, 222).

6. Is it a requirement for filing an application that is a divisional, continuation or continuation-in-part of an original application (or of another divisional, continuation or continuation-in-part thereof) that the original application (or the direct parent application, or both) is still pending at the time of filing of the divisional, continuation or continuation-in-part application?

Yes, see 5) above.

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, see 5) above.

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

The restrictions as to what may be included in a divisional application are set forth in art. 57.1.c. of the Swiss Patent Act. The same criteria as for amending a patent application apply (art. 58 of the Swiss Patent Act).

In particular, the subject matter of a divisional application must not extend beyond the content of the parent application if the applicant wants the filing date of the parent application to be maintained. However, the description and/or claims may contain or claim matter that was not contained or claimed in the original application or other application from which the divisional application derives, with the consequences set forth in art. 57.2 of the Swiss Patent Act, which will discussed at point 9) below.

The restrictions connected with the problem of double patenting are dealt with at point 11) below.

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?

Yes, this is possible under the circumstances set forth in art. 57.2 of the Swiss Patent Act, which states that in case the subject matter of the divisional application goes beyond the content of the par-
ent application but not beyond that of a later version, the divisional application can still be prosecuted and it shall be given the date on which said later version was filed as its filing date. If no version of the parent application exists which completely covers the divisional application, the divisional application obtains the date of its own submission as the filing date (see Guidelines for Examination, chapter 12.4). With respect to the meaning of the expression «later version» it is noted that if a Swiss patent application as amended extends beyond the scope of the originally filed specification, the patent application is assigned the filing date of the amendment, and the original filing date looses any effect. In other terms, the filing date is shifted to the date when the amendment is filed. Accordingly, this is not comparable to a continuation-in-part application where the original filing date is still valid for a part of the application.

This provision is not contained in the European Patent Convention and will be cancelled in the new Swiss Patent Act currently under revision.

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?

According to the Swiss Patent Act, the patent term is calculated from the date of filing which is inherited from the very first parent application. In the exceptional case where the divisional application has been given the filing date of a later version (see point 9 above), then the patent term of the divisional application may extend beyond that of the parent application. However, because the filing date is shifted, the priority claim may become invalid and questions such as what is prior art with respect to the shifted filing date, and who has the right to the patent in case of several independent applicants, are to be decided.

In case of patent applications claiming internal priority, the patent term of these applications is extended up to a maximum of 12 months with respect to the term of the parent (priority) application.

11. Is double-patenting permitted or must the matter claimed in divisional, continuation or continuation-in-part applications be deleted from the claims of the original application, or other application from which the divisional, continuation or continuation-in-part application derives?

The Swiss Patent Act has no provision against double patenting in connection with divisional applications, and no provision is foreseen for the case that double patenting occurs. However, double patenting is not permitted according to the practice of the Swiss Patent Office. Moreover, according to a statement of the Swiss Federal Council, the prohibition of double patenting is a matter of common law.

According to the Guidelines for Examination of the Swiss Patent Office, the following principles shall apply: the content of a divisional application should only extend to a portion of the parent application; there must be a clear distinction between the subject matter claimed in the divisional application and that claimed in the parent application (Guidelines for Examination, chapter 12.4).

With respect to patent applications claiming internal priority, the Swiss Patent Act provides that the corresponding parent (priority) application shall cease to be enforceable (art. 20a of the Swiss Patent Act) as far as the patents overlap.

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?

It makes no difference.

III. 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 filing of one or more divisional application(s) allows the applicant to comply with the requirement of unity of invention. Moreover, the applicant can take advantage of filing a divisional application in
order to achieve strategic goals such as improving his protection against a potential infringer, improving his flexibility with respect to licensing, patent prosecution, patent maintenance and/or patent enforcement. The existence of divisional applications may also result to be advantageous to the applicant in case of an opposition or a nullity action against the parent application.

The filing of a continuation application allows the applicant to have the invention re-evaluated for patentability (extension of examination). Moreover, if internal priority is claimed, the duration of protection can be extended up to 12 months.

The filing of a continuation-in-part application allows the applicant to integrate new developments of the invention.

No advantages can be seen from the point of view of third parties.

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?

The costs can be seen as the major disadvantage for the applicant with respect to divisional, continuation or continuation-in-part applications, while for third parties it is the legal uncertainty.

In countries without publication of the application before grant of a patent, divisional, continuation or continuation-in-part applications may result in “submarine” patents to the detriment of third parties’ rights.

It is also noted that during the examination of a continuation-in-part application, there is the risk that the parent and the new application are generally not correctly held apart and the filing date of the parent application is inappropriately attributed to the continuation-in-part application as a whole. Indeed, it is difficult, burdensome and bears significant uncertainty to determine the correct filing dates of the different subject-matters claimed in a patent issued from a (multiple) continuation-in-part application.

3. In the opinion of your National or Regional Group, should the filing of divisional, continuation or continuation-in-part patent applications, respectively, be permissible?

Yes, because of the advantages set forth at point 1) above.

In particular, the Swiss national group would plead for the possibility of filing divisional and continuation applications, while, apart from the exception of the possibility of claiming internal priority, it is against the institute of continuation-in-part applications because the disadvantages on the side of third parties do not justify the advantages this institute has for the applicant.

By “continuation application” the Swiss Group intends to refer to a new application with identical or possibly restricted description and scope with respect to the parent application, the parent application being rejected or withdrawn.

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?

The filing of a divisional or continuation application shall be permitted only as long as the parent application is pending.

Regarding divisional and continuation applications, the description shall not contain anything not disclosed by the original description. Amendments to correct clerical errors shall be allowed. In principle, amendments shall be allowed to the extent they are allowable if applied to any of the parent patent applications.

Cascades of divisional or continuation applications should also be possible.

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 new matter should be allowable in a divisional or continuation application.

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?

A new examination should always be allowed. This also entails the special situation of the second part of question 6. The Swiss Group believes that the interests of third parties in legal certainty are not inequitably impaired by the new examination as long as divisional or continuation applications are published as early as the parent application.

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?

The patent term of a divisional or a continuation application shall be identical to the term of the parent application, i.e., calculated from the same point in time, with the exception of the possibility of claiming internal priority.

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?

Limiting the backlog of patent offices is not deemed a valuable reason for restricting the access to divisional or continuation applications.

Provisions might be introduced to penalize abuse.

9. In the opinion of your Group, would it be desirable, in the interest of legal certainty of third parties, if databases of patent granting authorities ensured that a clear link was always indicated between original patent applications and all divisional, continuation or continuation-in-part applications derived therefrom?

Yes. This is very important and, furthermore, it should be made clear that pending applications should be made available to the public after a unified period of time (18 months from the priority or the filing date; immediately for divisional or continuation applications if the parent application is already published) in all countries so as to avoid the legal uncertainty derived from “submarine” patents.

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