

Report Q193

in the name of the Hungarian Group
by Marcell KERESZTY, Judit KERÉNY, Imre MOLNÁR, Tivadar PALÁGYI,
István POLGÁR, Éva SOMFAI, Zsolt SZENTPÉTERI and Ferenc TÖRÖK

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?*

Divisional applications are available according to Act No. XXXIII of 1995 on the protection of inventions by patents (hereinafter: HPA, Hungarian Patent Act) [HPA Art.73(1): *"If the applicant has claimed patent protection for more inventions in one application, he may divide the application, retaining the date of filing and any earlier priority, until the decision on the grant of patent becomes final."*].

As to continuation and continuation-in-part applications, no such applications are explicitly referred to in the HPA. However, similarly to other countries (e.g.: Germany, Austria), to the PCT (Art. 8) and to the EPC (Art. 87, Guidelines A-III 6.2), it is possible to claim "internal priority" of an earlier and pending domestic patent application, the filing date of which is not earlier than twelve months, in connection of which no priority has been claimed and which relates to the same subject matter. If internal priority is claimed, the previous patent application shall be considered withdrawn [HPA Art. 61(1)(c) and (3)].

Applications claiming internal priority can relate to the same subject matter without any new matter (in the following: "continuation like application") or can relate to the same subject matter with some new matter not disclosed in the earlier application (in the following "continuation-in-part like application").

It can be seen that an application claiming internal priority is to be filed at such an early stage of the previous application that the examination of the latter has in most cases not started yet. So, our continuation like and continuation-in-part like applications are dissimilar to U.S. type continuation and continuation-in-part applications but they fit into the definition as given in the Working Guidelines.

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

Divisional applications: if the applicant has claimed patent protection for a group of inventions in one application which do not satisfy the requirement of unity of the application [HPA Art. 59: *"In any patent application patent protection may be sought only ... for a group of inventions so linked as to form a single general inventive concept."*], the division of the application can be requested ex officio but the applicant is also free to perform the division of the application until the final decision on the grant of the patent.

Continuation like and continuation-in-part like applications: to provide the same opportunities for the applicants of domestic first applications in Hungary as for the applicants of foreign first applications, i.e. practically:

- continuation like applications: to shift the patent term with one year;
- continuation-in-part like applications: to provide the opportunity for the applicant to file a domestic patent application as early as possible after an invention has been made. If the applicant subsequently makes improvements or alterations to the original invention, the applicant may file a later domestic application by adding new matter and claim the priority of the first filed application, at the same time abandoning the same. This allows the applicant to maintain the original filing date as internal priority for the subject matter disclosed in the first filed application and to receive a later filing date for the whole application.

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?*

Divisional applications:

- if patent protection has been claimed for more than one invention in one application; and
- the divisional(s) is/are filed until the decision on the grant of the patent on the parent application becomes final [HPA Art. 73(1) cited above].

Continuation like and continuation-in-part like applications:

- applicant(s) is(are) the same person(s)/entity(ies);
- an earlier domestic patent application is pending,
- the filing date of which is not earlier than twelve months,
- in which no priority has been claimed, and
- which relates to the same subject matter.

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?*

Divisional applications:

yes.

Continuation like and continuation-in-part like applications:

no.

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

Divisional applications:

until the decision on the grant of a patent for the parent application becomes final.

Continuation like and continuation-in-part like applications:

within twelve months as from the filing date of the parent application.

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?*

Divisional applications, continuation and continuation-in-part like applications:

the parent application (original or direct) has to be pending.

- 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?*

Divisional applications:

no.

Continuation like and continuation-in-part like applications:

no, on the contrary, the original application lapses upon claiming the internal priority.

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

Divisional applications:

no new matter can be added.

Continuation like applications:

no new matter is added per definitionem;

and

Continuation-in-part like applications:

new matter is added per definitionem.

- 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?*

Divisional applications:

- description: no new matter can be added;
- claims: new claims can be submitted if they are supported by the original description and/or drawings.

Continuation like applications:

no (see point 8 above).

Continuation-in-part like applications:

yes (see point 8 above).

- 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?*

Divisional applications:

no.

Continuation like and continuation-in-part like applications:

no.

- 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?*

Divisional applications:

double-patenting is not permitted.

Continuation like and continuation-in-part like applications:

as the parent application lapses by claiming internal priority, no double-patenting is possible.

- 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?*

Divisional applications:

no.

Continuation like and continuation-in-part like applications:

not applicable.

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?*

Advantages of divisional applications for applicants:

- to obtain protection for more inventions originally claimed in one common application;
- to voluntarily divide the originally claimed scope of protection to obtain separate patent rights e.g. for strategic reasons;
- to accelerate patent granting proceedings for undisputed claims.

Advantages of divisional applications for third parties:

none.

Advantages of continuation applications for applicants:

In general (particularly in the US system): it is possible to introduce into the application a new set of claims and to establish a right for further examination by the primary examiner. Hungarian continuation like applications: see point 2 above.

Advantages of continuation applications for third parties:

none.

Advantages of continuation-in-part applications for applicants:

In general (particularly in the US system): to be able to add matter not disclosed in the earlier application. Hungarian continuation-in-part like applications: see point 2 above.

Advantages of continuation-in-part applications for third parties:

none.

- 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?*

Disadvantages of divisional applications for applicants:

none.

Disadvantages of divisional applications for third parties:

nothing when compared to basically filing more than one application.

Disadvantages of continuation applications for applicants:

none.

Disadvantages of continuation applications for third parties:

lengthy proceedings, backlog of patent granting authorities, timely extended legal uncertainty.

Disadvantages of continuation-in-part applications for applicants:

none.

Disadvantages of continuation-in-part applications for third parties:

lengthy proceedings, backlog of patent granting authorities, higher level of legal uncertainty.

- 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?*

Divisional applications:

yes.

Continuation applications:

no.

Continuation-in-part applications:

as this point involves the problem of adding new matter after filing, it is believed that this particular question needs further analysis and goes beyond the scope of Q193.

- 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?*

Divisional applications:

Art. 76 of the EPC seems to be an appropriate basis to elaborate such common rules.

Continuation and continuation-in-part applications:

internal priority provides a timely restricted system not leading to legal uncertainty for third parties.

- 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?*

No, it would lead to a high level of legal uncertainty.

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?

Such circumstances are rare and very hard to prove. The possibility to file pipeline patent applications for pharmaceutical products is an example how such problems have been treated in the past in an ad hoc way. No general exception is advisable.

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. (This does not relate to the shifting of the patent term of applications 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?*

Divisional application:

no.

Continuation and continuation-in-part applications:

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?*

Yes.

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

Summary

Divisional applications are available in Hungary and the system of "internal priority" renders possible the filing of continuation like applications and continuation-in-part like applications. Cascades of divisional applications are allowed, but this is not the case for continuation like and continuation-in-part like applications. Divisional applications can be filed until the decision on the grant of a patent for the parent application becomes final but no new matter can be added. Continuation like and continuation-in-part like applications can be filed within twelve months as from the filing date of the parent application. Double patenting and extension of the patent term is not possible by these type of applications. In the opinion of the Hungarian Group, the filing of divisional applications should be permissible, but this does not apply to continuation and continuation-in-part applications.

Résumé

Les demandes divisionnaires sont possibles en Hongrie, le système de la "priorité interne" permettant de déposer des demandes du type "continuation" ou "continuation partielle". Les demandes divisionnaires en cascade sont autorisées, mais ce n'est pas le cas pour les demandes du type continuation ou continuation partielle. Les demandes divisionnaires peuvent être déposées jusqu'à ce que la décision concernant l'accord du brevet pour la demande de brevet devienne finale, cependant aucune matière nouvelle ne peut être ajoutée. Les demandes du type continuation ou continuation partielle peuvent être déposées dans un délai de douze mois à compter du dépôt de la demande parente. La protection cumulée et l'extension de la durée de protection ne sont pas possibles dans le cas de ces types de demandes. Le Groupe Hongrois est d'avis qu'il faudrait autoriser le dépôt de demandes divisionnaires, sans pourtant que cela s'applique aux demandes continuation ou continuation partielle.

Zusammenfassung

Teilansmeldungen sind in Ungarn möglich, und das System der "inneren Priorität" ermöglicht Anmeldungen, die den Continuation- beziehungsweise Continuation-in-part-Anmeldungen ähnlich sind. Kaskaden von Teilansmeldungen sind erlaubt, jedoch handelt es sich dabei nicht um Continuation- und Continuation-in-part-Anmeldungen. Teilansmeldungen können eingereicht werden, bis der Patenterteilungsbescheid in der Stammanmeldung rechtskräftig geworden ist. Neue Inhalte (new matter) dürfen dabei nicht aufgenommen werden. Diese den Continuation- beziehungsweise Continuation-in-part-Anmeldungen ähnlichen Anmeldungen können innerhalb von 12 Monaten ab dem Anmeldungsdatum der Stammanmeldung eingereicht werden. Eine Doppelpatentierung oder Verlängerung der Patentschutzdauer ist bei diesen Anmeldungen nicht möglich. Nach Meinung der ungarischen Landesgruppe sollten Teilansmeldungen zulässig sein, das soll jedoch nicht für Continuation- und Continuation-in-part-Anmeldungen gelten.