

Divisional patent applications: what are they and why should you use them?

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Divisional patent applications

A divisional patent application (sometimes referred to as a “divisional application” or simply a “divisional”) is a patent application which has been divided out of an earlier filed patent application (known as the parent application).

Generally speaking there are two types of divisional applications:

- A standard divisional application which relates to one part of the parent application; and
- A “whole contents” divisional application which is identical to the parent application

These two types of divisional applications can be used for different purposes (discussed below).

While a divisional application is filed later than the parent application it can retain the parent application’s filing date and will have the same priority date as the parent (subject to certain restrictions discussed below).

What are the requirements for a divisional patent application?

A New Zealand divisional application must meet certain criteria:

- If it is to retain the priority date of the parent application, the subject matter of the divisional application must be fairly based on (for applications filed under the Patents Act 1953) or supported by (for applications filed under the Patents Act 2013) the disclosure in the parent application; and
- The claims of the parent application they must also be fairly based on or supported by the disclosure in the parent application (depending on the applicable Act).

When must a divisional patent application be filed?

The deadline for filing a divisional application depends on whether the parent application is being examined under the Patents Act 1953 or the Patents Act 2013.

For applications examined under the Patents Act 1953, divisionals must be filed before the parent application has been accepted.

For applications examined under the Patents Act 2013, divisionals must be filed before the parent application has been accepted **and** within five years of the effective filing date of the parent application. Examination of the divisional application must also be requested by this five-year deadline.

Why would I use a divisional patent application?

There are three main reasons why you would file a divisional application:

1. When your application contains more than one invention: In New Zealand, a patent application must relate to a single invention. This is known as “unity of invention”. Sometimes, a single patent application will cover more than one invention. This may be a deliberate tactic by the patent applicant to reduce costs (i.e. rather than preparing and filing two separate specifications the patent applicant may choose to file a single specification and then divide one of the inventions out of that specification as a divisional application during examination).
2. When more time is required: Examination reports for New Zealand patent applications will typically specify a timeframe by which the application must be placed in order for acceptance. Towards the end of the examination process this deadline often becomes non-extendable. If more time is required to overcome the examiner’s objection to a parent application, a whole contents divisional application can be filed and the parent application abandoned. The divisional application will then be re-examined and the timeframe for responding to the examination report reset.
3. As an opposition/litigation tactic: It is a strategy to file divisional applications immediately before acceptance of valuable or contentious patents.
4. While the divisional application remains pending, the patent applicant has

comparatively greater scope to amend the wording of the claims. This can be particularly useful if the parent application is opposed (the divisional can be amended to address the grounds of opposition) or the patent applicant learns of a third party infringer of the parent patent (the divisional can be tailored to capture the third party’s product or process and make a case for infringement more straightforward).

Why not?

The main reasons not to proceed with divisional applications are cost (discussed below), additional complexity in managing the patent family and/or the parent application containing insufficient basis to provide flexibility for the amendments you would like to make.

Costs

The cost of preparing and filing a whole contents divisional are quite low.

Similarly, where a standard divisional application relates to an invention already adequately disclosed in the parent application, it can be filed relatively cheaply. Additional costs may be incurred if it is necessary to rewrite parts of the divisional application before filing and/or to address any new objections raised against the subject matter of the divisional application when it is examined.

After filing a divisional application, standard costs of progressing the application (e.g. requesting examination (if applicable) and dealing with any adverse examination reports) apply.

IP strategist

It is important to discuss all matters concerning invention with an IP strategist and to integrate

such discussions/decisions into your overall business strategy.

That way, maximum benefit can be taken from your specialist's knowledge of how to work the intellectual property system to your advantage.

Disclaimer

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