

CHAPTER 14

DIVISIONAL APPLICATIONS

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Introduction

14.01 What is a Divisional Application ?

A Divisional application filed under s.15(9) is most commonly filed to overcome a Patent Examiner's objection under s.14(5)(d) to plurality of invention in an earlier application. This means that more than one invention has been disclosed in the earlier application which is known as the "parent" application. The subject matter of the Divisional application must have been present in the "parent" and is then 'divided out' to form a separate application.

14.02 Who can file a Divisional application?

S.15(9)(a) also requires that the Divisional application is made by the same applicant (or their successor in title). If these criteria are met, the Divisional application may provisionally be accorded the same date of filing as the "parent".

14.03 When can a Divisional **not** be filed?

A Divisional application cannot be made if:-

- a) the "parent" has been refused;
- b) the "parent" has been withdrawn by the applicant; *
- c) the "parent" has been taken to be withdrawn by the office;
- d) the "parent" has been granted - the date of grant is taken to be the date on which the grant letter ('B' Letter) is issued;
- e) the r.30 compliance period for the "parent" has expired.

* A Divisional can proceed if the "parent" is withdrawn after the Divisional application has been lodged.

Periods for filing a Divisional application (Rule 19)

14.04 The relevant periods for filing a Divisional application are set out under r.19(3)(a)&(b).

There are **two** possible periods depending on the status of the 'parent' case, The Formalities Examiner should check the Patent Examiner's

previous reports on the 'parent' case before proceeding (see (a) and (b) below).

a) If the Patent examiner has issued an Examination report under section 18(4) which **notifies** the applicant that the earlier application complies with the Act, then any divisional must be filed within and up to **2 months** from the date of notification.

For example: If the report was issued 01/07/2009 then the Divisional must be filed before or on 01/09/2009.

Or - in any other case

b) The period is 3 months before the compliance date of the 'parent' application.

For example: If the compliance date is 26/01/11 then the Divisional must be filed no later than 26/10/10.

Extending the r.19 period for filing a new Divisional application

14.05 **The r.19 period can be extended by a discretionary extension agreed by the Deputy Director/Patent Examiner, it is restricted to 2 months only but no fee and no form 52 is required.**

The r.19 period is extendable by a discretionary extension under r.108(1). The extension is however subject to restriction under r.108(5) and r.108(7), (see 10.37- 41) as it is listed in Part 3 of Schedule 4 to the Patents Rules 2007. The extension (or any further extension) is restricted to 2 months only. Any such request should be made in writing and referred to the Deputy Director/Examiner. There is no fee or Form 52 required.

N.B. There is the possibility that a Divisional application may itself give rise to a further Divisional. (see S.15(9)). Should this occur, the time period is extended in the same manner as outlined above.

Alternatively the compliance date of the parent application may be extended under r.108(3) to allow more time to file a divisional. The compliance date of the parent must be extended prior to or on the same date as the filing of the divisional. If a discretionary extension is refused for a late filed divisional it may be re-filed after the compliance period of its parent has been extended.

Initial Formalities Action

14.06 Preparing the Dossier

A new Divisional application it should be treated as urgent and on receipt the “parent” application identified. If there is less than 4 months of the r.30 compliance period remaining, priority procedures should be followed. The Formalities Examiner should annotate the front cover “Rule 30 period imminent”, ensure that the dossier front cover annotation box includes the r.30 compliance date and mark all messages **Urgent**.

14.07 Checking the filing date

The F1 will show the date of filing accorded to the application. The filing date is derived from the parent application whose details are entered in part 6 of the F1.

If there is a priority claim on the parent then these details should be in part 5. The initiation date (ie the date the divisional was received in the Office) is the date stamped on the F1 or in the case of an electronically filed application the initiation date is recorded on the filing receipt.

14.08 Checking the Applicant/Inventor details

The Formalities Examiner should check that the Divisional has been filed by the same named applicant as the "parent" (or their obvious successor in title).

14.09 An objection should be raised if the reason for any difference is not apparent e.g. from the derivation of right on F7. In such cases, the Formalities Examiner should carry out the following actions:

- a) issue a suitably amended LFL (see chapter 6) allowing a period of **two weeks** for reply;
- b) set a suitable diary date to monitor the case and forward to the Patent Examiner.

14.10 **N.B. A Form 7 is always required** on a divisional application; including divisionals of PCT cases as some of the inventors on the F7 may apply only to the parent application and not to the divisional, for further details see Chapter 3.

14.11 **Checking the Divisional application is valid**

A Divisional application cannot be made if:

- a) the "parent" has been refused;
- b) the "parent" has been withdrawn;
- c) the "parent" has been taken to be withdrawn;
- d) the "parent" has been granted - the date of grant is taken to the date on which the grant letter ('B' Letter) is issued;
- e) the r.30 compliance period for the "parent" has expired.

14.12 If it is discovered that a Divisional cannot proceed for any of the above reasons the matter should be referred to the Formalities Manager before taking any further action.

14.13 **Referring the application to the Patent Examiner for the first time**

When the Divisional is being referred to the Patent Examiner for the first time, the Formalities Examiner should carry out the following actions:

- a) Annotate the TOC next to the F1:

“Ante-dating requested”
- b) Annotate the front cover as follows:

Divisional Application Filed - see No.....
- c) Send a message in MADRAS to the Patent Examiner.

Declaration of Priority

14.14 Divisional applications may, but need not, make a declaration of priority where one was made on the "parent". Any declaration of priority must be made at the time of filing of the Divisional application. It is not possible for a Divisional to make a claim to priority which was not made on the parent application (r.8).

14.15 If a divisional does not make a claim to priority when one is present on the parent the agent should be contacted to establish if this is intentional or an error. If a priority claim was omitted in error, the F1 should be corrected

under s.117 by a request in writing. Any request to correct the F1 in this manner must be referred to the Formalities Manager.

- 14.16 The compliance date of the divisional on filing is **ALWAYS** the same as that of the parent regardless of whether both claim the same priority date. However, Optics will not calculate the compliance date correctly if the parent and divisional have different earliest dates. Optics should be checked to ensure that the compliance date of the divisional matches that of the parent. If it does not then it should be corrected manually using CHA CAS - Time Limits.

Priority Documents and Translations

- 14.17 When the declared priority on a Divisional is an earlier UK patent application, or an International application or other foreign application where a copy is already held in the Office, a Form 23 requesting a certified copy of such applications is **not** required under r.8(4)(b). The Formalities Examiner should ensure a copy of the priority application is transferred to the Divisional together with any translation (copies of priority documents and translations should be found on the parent file). [Further instruction on the preparation of Certified Office Copies can be found in Chapter 16.]

Periods for filing forms and documents

- 14.18 As a Divisional application is treated as having the same date of filing as the "parent" application, the periods for filing forms and documents should be calculated from the earliest date of the "parent" application. However, as most Divisional applications are filed late in the life of the "parent" it is likely that these periods will have already elapsed.
- 14.19 Rules 22, 21 and r.28 therefore provide special time periods for filing documents for divisional applications filed under s.15(9).
- 14.20 The following table summarises the time periods for filing the forms, fees and documents that make up a divisional application. It is intended to provide an overview and is not a definitive guide to every possible situation.
- 14.21 If the divisional has been filed within six months of the compliance period then all documents must be filed with the divisional. If more than six months remain before the compliance date when the divisional is filed then forms, fees and documents should be filed in accordance with the table below. A minimum period of 2 months from the initiation date of the divisional is provided in every case.

14.22

The asterisked (*) time periods are extendible by 2 months under r.108(2). A further 2 month extension is available under r.108(3) but it is unlikely that this will be requested.

Document/Fee Required	Divisional filed more than 6 months before the compliance date	Divisional filed less than 6 months from compliance date	Governing Rule and Relevant Section
Application Fee	2 months from the initiation date OR same as for the parent if that is later*	On initiation date [^]	s.15(10)(c) r.22(5)(a) or r.22(6)
Form 9	As Above*	On initiation date [^]	s.15(10)(d) r.22(5)(a) or r.22(6)
Abstract	As Above*	On initiation date [^]	s.15(10)(a) r.22(5)(a) or r.22(6)
Claims	As Above*	On initiation date [^]	s.15(10)(a) r.22(5)(a) or r.22(6)
Description to replace a reference	As Above*	On initiation date [^]	s.15(10)(b)(i) r.22(5)(a) or r.22(6)
COC to substantiate a reference	2 months from the initiation date OR 4 months from filing of the parent if that is later*	On initiation date [^]	s.15(10)(b)(ii) r.22(5)(b) or r.22(6)
Form 7	2 months from initiation date OR same as for the parent if that is later*	On initiation date*	s.13(2), r.10(3) r.21(1)(a) or r.21(2)(a)
Foreign Priority Document	As Above+	On initiation date+	s.5(2), r.8(5) r.21(1)(b) or r.21(2)(b)
Form10	2 months from the initiation date OR 2 years from the earliest date if that is later*	On initiation date [^]	s.18(1) r.28(5) or r.28(6)

* Time period extendible under r.108(2) & r.108(3) but restricted by r.108(5)&(7). F52

+ Time period extendible under r.108(2) & (3) without restriction. F52

[^] Time period extendible under r.108(1) but restricted by r.108(5)&(7). No F52 needed.

14.23 Failure to file any of the documents within the prescribed periods should be reported to the Applicant/Agent as soon as it has been identified. If it is possible to extend the period for filing the document under r.108 this should also be reported. If it is not possible for the document to be filed within the prescribed periods as extended the Applicant/Agent should be told that the divisional application will be treated as withdrawn through failure to file the document.

14.24 It may be possible for the Applicant/Agent to re-file the divisional application containing the missing document if there is still time left in the period prescribed by r.19(1), see 14.04 above.

Re-dating of Divisionals

14.25 If it is discovered that a drawing (or drawings) or pages were omitted when a Divisional application was lodged, the Formalities Examiner should follow the procedure outlined for any new application see (5.34). Should re-dating be required it is the initiation date that is re-dated to the date on which the missing drawing(s) or pages are received.

14.26 This re-dating might result in the period specified in r.19 having expired (see 14.04 above) but an extension of up to 2 months to this period may be allowed by exercise of the Comptroller's discretion under r.108(1) if considered appropriate. Any Divisional application that falls into this category should be referred to the Deputy Director via the Formalities Manager.

Refund of Fees

14.27 A request for a refund of the fee paid on F9A on a Divisional application may be allowed if requested by the applicant under r.106(2)(b). Such a request should be made in writing (r.106(1)). Any requests for such a refund should be referred to the Patent Examiner in a minute. The Patent Examiner will consider whether or not a refund is appropriate and, if appropriate, decide at what stage it should be made i.e. straightaway or at grant.

14.28 If it is decided to issue an early refund, the Patent Examiner will include clause RC41 in his official letter and clearly instruct Formalities to prepare the refund in a minute. If it is decided to defer the refund until grant, the Patent Examiner will include clause RC42 in his official letter.

14.29 In this case, the Patent Examiner will reconsider the refund at a later date, prior to marking the case as being "*In order*" and will clearly instruct

Formalities to prepare the refund in a minute. (General instructions on the preparation of refunds can be found in Chapter 12).

Allowance of Filing Date

- 14.30 When a substantive examination is carried out before s.16 publication, the Patent Examiner will determine whether or not ante-dating is allowable and advise the applicant accordingly using standard paragraph RC21. In this case, no front page footnote (7) with regard to provisional according of the earlier date need be prepared for 'A' publication.
- 14.31 In the case where the Patent Examiner has not determined whether or not to allow ante-dating, a front page footnote advising that the allowance of the filing date is provisional and may be subject to ratification or amendment should be prepared for 'A' publication. The Patent Examiner will request that Footnote 7 is entered on Optics by the Formalities Examiner. [The Formalities Examiner should carry out the appropriate **REC FOO** actions prior to early publication]

'A' Publication of Divisionals

- 14.32 When most Divisional applications are filed they are overdue for s.16 publication and sometimes substantive examination. If a Divisional is not due for substantive examination, the Patent Examiner will issue a normal (s.17) search report and direct that the application be forwarded for publication.
- 14.33 When substantive examination is overdue the Patent Examiner will issue a combined search report/examination report (ss.17 & 18 reports) and inform the applicant that the application is being forwarded for 'A' publication. (Most Divisional cases will have the CS&E status)
- 14.34 **Completion of Pre Publication Check**
- The usual Pre Publication checks should be made (see Chapter 8),
- 14.35 **Reply to Examiner's report received during A Publication cycle**
- If a response to the Examiner's report is received during the 'A' Publication cycle, the Formalities Examiner should confirm the Rule 30 compliance period end date. If this date is imminent then a message should be sent to the Patent Examiner immediately. No attempt should be made to use OPTICS function **REC PRO** to amend the processing status (OPTICS has been blocked to prevent such an action during the Publication cycle). Optics should be up-dated after 'A' publication has taken place.

14.36 **Publishing amended claims.**

If amended claims are filed before A Pub then they should be treated as per 8.54.

Post Publication Formalities Examination

- 14.37 On receipt of the “A' publication completed” message the Formalities Examiner should:
- a) Check that the correct ‘A’ specification has been correctly imported to the relevant case.
 - b) Ensure that TOC is updated to show documents open for public inspection and that any OLF action has been done correctly.
 - c) Check for any amended pages that need to be actioned.
 - d) If amended pages have already been seen by the Patent Examiner, check that a diary has been set; if not, check to confirm that a letter has been issued with a respond by date.
 - e) If the pages have not been seen by the Patent Examiner then update the TOC and send a message to Patent Examiner.

Compliance Period – Rule 30

14.38 The r.30 compliance period for putting a divisional application in order for grant is **ALWAYS** the same as its parent –

Either

- 4 years 6 months from the earliest date of the parent

Or

- 1 year from the issue of the first examination report on the parent. (r.30(2)).

Extending the R.30 compliance period

14.39 A Form 52 and fee are required to extend the r.30 period of the parent application by 2 months. This form should be filed before the 2 month extension period expires.

If the Form 52 is filed **on or before** the date on which the divisional is lodged then the divisional will automatically take the extended compliance date of its parent. (rule 2(2)).

If a Form 52 is filed to extend the compliance date of the parent **after** any divisional has been lodged then a separate Form 52 will be required to extend the compliance date of each divisional (rule 108(4))

However, if enough time remains a divisional may be withdrawn and re-filed so as to automatically receive the extended compliance date.

Optics should always be checked to ensure the correct compliance date is shown.

OPTICS

14.40 A Divisional application requires the same data to be entered on OPTICS as any patent application. This means that the same OPTICS functions are used to record the information on the system, namely:

- a) ADD F1 - To delog F9A and record the Address for Service.
- b) REC F7 - To delog F7 and record the inventor(s) names and addresses.
- c) REC PRE - To delog F10.
- d) REC FOR - To enable the application to enter the publication cycle.
- e) REC FOO - To record Footnotes for the front page of the 'A' document.
- f) REC PRO - To amend the processing status of the application.