

Country	Time Period for Filing a Divisional Application	Requirements of a divisional application	Claims of a divisional application and double patenting issues	Examination of a divisional application
Mexico	<ol style="list-style-type: none"> When responding to an Office Action raising a lack of unity rejection; and/or Any time prior to the grant of a Mexican patent application. 	<ol style="list-style-type: none"> A copy of the description and drawings; A set of claims to be pursued; and If appropriate (namely, if an Applicant has assigned its rights in the parent application to a third party), an assignment and Power of Attorney. <p>No new matter is permitted.</p>	<p>A divisional application can be filed with one or more claims as originally filed. If an Applicant files a divisional application containing one or more claims that are identical to claims that have previously undergone substantive examination by IMPI (such as in a previous parent or divisional application), then the Applicant should amend the claims in question so as not to be identical with any such previously amended claims.</p> <p>IMPI will not conduct substantive examination twice for identically claimed subject matter in a pending divisional application when the same claimed subject matter has already been examined in a previous parent or divisional application.</p>	<p>Like an original (parent) application, a divisional application is examined in chronological order. However, this rule is not strictly applied in all substantive examination groups. In some groups, divisional applications are examined more quickly than non-divisional applications.</p>
Brazil	<p>Any time up until the end of examination. The “end” of examination occurs when:</p> <ol style="list-style-type: none"> An Examiner issues a conclusive (“final”) Office Action rejecting the claims as 	<ol style="list-style-type: none"> A copy of the specification, abstract, drawings, a new set of claims and a power of attorney; A specific reference to the parent (original) application; 	<p>The claims of a parent and divisional application cannot be identical as this creates an issue of double protection or double patenting.</p> <p>The subject matter of the claims</p>	<p>Divisional applications are not given any priority status in terms of examination by INPI. Typically, Examiners examine both the parent and divisional applications simultaneously and publish Office Actions in</p>

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	<p>not patentable; or</p> <p>2. Thirty days prior to the publication of the conclusive Office Action, such as a rejection decision or the allowance of the application (each conclusive Office Action is published in the Official Gazette (the time period for when such will occur cannot be predicted)),</p> <p>whichever occurs last.</p>	<p>and</p> <p>3. All official fees (namely, filing fees, examination fees, annuities and the fee(s) for claiming priority, if any).</p> <p>No new matter is permitted.</p>	<p>in a divisional application is restricted to the subject matter of the claims contained in a parent application pending up until the time a request for examination is filed in the parent application.</p> <p>New categories of claims or embodiments not included in the claims of a parent application before a request for examination is filed will not be accepted by INPI in a divisional application.</p>	<p>both applications since it is necessary for an Examiner to analyze whether the set of claims in the divisional application exceed the scope of the subject matter of the claims pending at the time a request for examination was filed in the parent application.</p>
<p><u>U.S.</u></p>	<p>Any time prior to the grant of a U.S. patent application.</p>	<p>1. A copy of the specification, drawings and abstract;</p> <p>2. A set of claims to be pursued;</p> <p>3. An oath or declaration (although this can be filed no later than in response to a Notice of Allowability); and</p> <p>4. Filing, search, examination, publication and processing fees (these fees can be paid after filing).</p> <p>No new matter is permitted in a</p>	<p>U.S. law provides that if an application contains claims directed to two or more independent and distinct inventions, an Applicant may be required to elect a single invention for examination on the merits. Each non-elected invention may be pursued in what is referred to as a “divisional” application(s). Because restriction was required in the parent (original) application, the parent application cannot serve as the basis of a double patenting rejection as long as the claims of the divisional application are</p>	<p>A divisional application:</p> <p>1. Receives its own (new) application number;</p> <p>2. Requires payment of certain fees (separate from the fees paid in the parent application);</p> <p>3. Is prosecuted separately from the parent application; and</p> <p>4. Results in a patent that is independent from the parent</p>

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		divisional application.	<p>directed to a non-elected invention. In another words, in a properly filed divisional application, a double patenting rejection cannot be made.</p> <p>Please see the post for a discussion of double patenting rejections and terminal disclaimers as it relates to continuation and continuation-in-part applications.</p>	application.
India	<p>A divisional application can be filed if a plurality of inventions is being claimed in an original (parent) application. Specifically, a divisional application can only be filed under the following circumstances:</p> <ol style="list-style-type: none"> 1. The original (parent) patent application claims subject matter directed to more than one invention and the Applicant, after filing of the original (parent) patent application but before grant, voluntarily decides to divide the original (parent) application into one or more 	<p>A copy of the specification, claims and drawings of the divisional application.</p> <p>No new matter is permitted.</p>	<p>A divisional application may be filed with the claims as originally filed in the original (parent) application or PCT application. According to the Indian Patents Act, 1970, an Applicant is entitled only to a single patent per invention. Therefore, the claims of a divisional application filed containing the claims of an original (parent) or PCT application will need to be amended at some point prior to issuance to ensure that neither the original (parent) or divisional application claim identical subject matter.</p>	<p>A divisional application:</p> <ol style="list-style-type: none"> 1. Is accorded a separate application number; 2. Requires separate fees; 3. Requires a separate request for examination; 4. Is prosecuted separately from the original (parent) application; and 5. Results in an independent patent from the original (parent) application. <p>A divisional application is</p>

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	<p>divisional applications; and</p> <p>2. An objection is raised in an Office Action that the claims of the original (parent) patent application relate to more than one invention (namely, the claims lack unity), and hence are not allowable under the Indian Patents Act, 1970. In this case, an Applicant can file a divisional application to overcome such an objection.</p>			<p>typically examined with the original (parent) application so as to avoid claim overlap resulting in double patenting.</p> <p>A divisional application is examined only when a Request for Examination (“Request”) is filed within the prescribed period (namely, forty-eight months from the date of filing of the application or from the date of priority of the original (parent) application or within six months from the date of filing of the divisional application, whichever is later). If a Request is not filed within time, the application will be considered as withdrawn.</p>
Russia	<p>A divisional file can be filed for any reason at any time:</p> <p>1. Up until the date of issuance of a patent in a parent application (which typically occurs within 2-3 months following payment of</p>	<p>A copy of the specification (including the abstract), claims and drawings as well as an entry form indicating the name and address of the Applicant and the inventor(s).</p>	<p>A divisional application may be filed with the claims as originally filed in the parent application or PCT application. However, the claims of a divisional application filed containing the claims of a parent or PCT application will need to</p>	<p>A divisional application:</p> <ol style="list-style-type: none"> 1. Receives its own (new) application number; 2. Requires payment of certain fees (separate from the fees paid in the parent

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	<p>the Grant fee); or</p> <p>2. Within 6 months from the date of receipt of a Final Rejection in a parent application.</p>	<p>No new matter is permitted.</p>	<p>be amended at some point prior to issuance to ensure that neither the parent or divisional application claim identical subject matter. There should be no overlapping of claimed subject matter in the parent and the divisional application.</p> <p>Any patent issuing from a parent and a divisional application cannot claim the identical subject matter as this presents a double patenting problem. To determine whether or not double patenting exists, the claims as allowed are examined to determine whether or not identical subject matter is being claimed. Specifically, claimed subject matter will be recognized as being identical if:</p> <ol style="list-style-type: none"> 1. The independent claims in the parent and divisional application are completely (100%) identical with one another; or 2. One or more independent claims in the parent or divisional application recite one 	<p>application);</p> <ol style="list-style-type: none"> 3. Requires the filing of a request for examination (separate from the filing of a request for examination in the parent application); 4. Is prosecuted separately from the parent application; and 5. Results in a patent that is independent from the parent application.

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			<p>or more alternatives and the one or more alternatives are identical with one or more alternatives claimed in the parent or (another) divisional application.</p>	
<p>China</p>	<p>In China, an Applicant can file a divisional application:</p> <ol style="list-style-type: none"> At any time while a parent application is pending but no later than the expiration of 2 months from the date of receipt of the Notification to Grant Patent Right from the Chinese Patent Office (SIPO) [the 2 month period is the time during which the application proceeds through the formalities of registration]. An Applicant can file a divisional application during this 2 month period regardless of whether or not the Applicant proceeds with the formalities of registration (namely, paying the issue fee). However, see the important 	<ol style="list-style-type: none"> A copy of the specification, abstract and drawings from the parent application; A set of claims; Payment of all the necessary filing fees; A Power of Attorney; The priority document of the parent application; An assignment; and If the divisional application is being filed in response to a lack of unity rejection raised in a previously filed divisional application, a copy of the Office Action where the lack of unity 	<p>A divisional application may be filed with the claims as originally filed in the original (parent) application or PCT application. Much like India, in China, an Applicant is entitled only to a single patent per invention. Therefore, the claims of a divisional application filed containing the claims of an original (parent) or PCT application will need to be amended at some point prior to issuance to ensure that neither the original (parent) or divisional application claim identical subject matter (partial overlap is permitted).</p>	<p>A divisional application:</p> <ol style="list-style-type: none"> Receives its own (new) application number; Requires payment of certain fees (separate from the fees paid in the parent application); Requires the filing of a request for examination (separate from the filing of a request for examination in the parent application); Is prosecuted separately from the parent application; and Results in a patent that is independent from the parent

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	<p>note below.</p> <p>2. Within 3 months from the date the Applicant receives a Notification of Rejection in a parent application (regardless of whether or not the Applicant requests reexamination of the Examiner's decision). A Notification of Rejection notifies the Applicant that the application is rejected and that prosecution has been "closed" by the Examiner. An Applicant can file a request to the Board of Patent Reexamination (a Reexamination Request) to re-examine the application in view of the Examiner's decision.</p> <p>3. At any time after filing a Reexamination Request.</p> <p>4. If the Board of Patent Reexamination (Board) overturns the Examiner's rejection, the application is returned to the Examiner for further examination. During</p>	<p>rejection was raised.</p> <p>No new matter is permitted.</p>		<p>application.</p>

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	<p>this further examination, an Applicant can file a divisional application (but a divisional application can be filed no later than the expiration of 2 months from the date of receiving the Notification to Grant Patent Right).</p> <p>5. If the Board maintains the Examiner's Rejection, an Applicant may appeal to court (namely, a first instance court) within 3 months of receipt of the reexamination decision from the Board (Reexamination Decision). An Applicant can file a divisional application during this 3 month period regardless of whether or not the Applicant files an appeal.</p> <p>6. If an Applicant appeals to a first instance court after receipt of the Reexamination Decision.</p> <p>7. If the first instance court maintains the Reexamination Decision, an Applicant may further appeal to the second</p>			

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	<p>instance court within 15 days from receipt of the first instance court's decision. Regardless of whether or not the Applicant files an appeal with the second instance court, the Applicant can file a divisional application within 15 days of receipt of the decision from the first instance court.</p> <p>8. After appealing a decision from a first instance court to a second instance court.</p> <p>9. If the first instance court overturns the Reexamination Decision, an Applicant can file a divisional application.</p> <p>Important Note: An Applicant cannot file a divisional application after the expiration of the 2 month period from the date of receipt of the Notification to Grant Patent Right of the parent application, if the parent application has been withdrawn, or is deemed to have been withdrawn and the</p>			

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	<p>application has not been restored (namely, reinstated). Additionally, in accordance with current patent practice in China, a divisional application can be filed from a previously filed divisional application (meaning “cascading” divisionals are permitted).</p>			
<p>Canada</p>	<p>A divisional application can be filed for any reason or in response to a lack of unity rejection and must be filed before issuance of an original application (parent application).</p> <p>If a parent application becomes abandoned, a divisional application can be filed before the expiration of the time limit for reinstatement of the parent.</p>	<ol style="list-style-type: none"> 1. A copy of the specification, abstract and drawings from the parent application; 2. A set of claims; 3. A written statement that a patent is being sought; 4. Payment of all the necessary filing fees, as well as the annuity fees accrued since the filing date of the parent application; 5. The name of the Applicant; and 6. The address of Applicant’s 	<p>A divisional application may be filed with the claims as originally filed in the parent or PCT application. However, the claims of a divisional application filed with the same claims of a parent or PCT application will need to be amended at some point during prosecution to ensure that neither the parent or divisional application claim the exact same subject matter and are patentably distinct (meaning novel and nonobvious) from one another.</p> <p>Much like the U.S., Canada has a prohibition against double patenting. This prohibition</p>	<p>A divisional application:</p> <ol style="list-style-type: none"> 1. Receives its own (new) application number; 2. Requires payment of certain fees (separate from the fees paid in the parent application); 3. Requires the filing of a request for examination (separate from the filing of a request for examination in the parent application); 4. Is prosecuted separately from the parent application; and

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		<p>agent.</p> <p>No new matter is permitted.</p>	<p>comprises 2 branches:</p> <ol style="list-style-type: none"> 1. A “same invention” or “coterminousness” branch; and 2. An “obviousness” branch. <p>The “same invention” or “coterminousness” branch is similar to statutory double patenting in the U.S., where claims of a pending application and an issued patent cannot have the same exact (identical) scope. A rejection based on the “same invention” or “coterminousness” generally is not fatal and can be overcome by amending the rejected claims so as not to have the identical scope as claims of the issued patent or copending application.</p> <p>The “obviousness” branch is similar to “obviousness-type” double patenting in the U.S. but can be much more problematic in Canada. Under this branch, the claims of a pending application (such as a divisional application) must be patentably</p>	<p>5. Results in a patent that is independent from the parent application.</p>

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			<p>distinct (meaning novel and nonobvious) over the claims of an issued patent or copending application. In the U.S., in most instances, an obviousness-type double patenting rejection can be obviated by the filing of a terminal disclaimer. However, Canadian law does not provide for the procedural equivalent of a terminal disclaimer.</p> <p>Nonetheless, according to Canadian case law, if the claims being pursued in a divisional application were filed in response to a lack of unity rejection in a parent application, then the claims of the divisional application are immune from a double patenting attack based on the parent application</p>	
Europe	A divisional application can be filed for any reason while a parent application is pending (a parent application cannot be granted, definitively refused or definitively withdrawn).	<ol style="list-style-type: none"> 1. A written statement that a European patent is being sought; 2. Information identifying the Applicant or allowing the Applicant to be contacted; and 	<p>A divisional application may be filed with or without any claims.</p> <p>If a divisional application is filed without any claims, the European Patent Office will set a two month period for the</p>	<p>A divisional application:</p> <ol style="list-style-type: none"> 1. Receives its own (new) application number; 2. Requires payment of certain fees (separate from the fees paid in the parent

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	<p>A patent application is still considered to be pending:</p> <ol style="list-style-type: none"> 1. Until expiry of the deadline for filing an appeal (even if an appeal is not subsequently filed), when the Examining Division has refused a parent application; and 2. While a patent application is involved in an appeal against a refusal by the Examining Division. 	<ol style="list-style-type: none"> 3. A description or reference to a previously filed application (A reference to a previously filed application must state the filing date and the number of the application and the Office in which it was filed. Such reference must indicate that it replaces the description and any drawings). <p>No new matter is permitted.</p>	<p>Applicant to provide a set of claims. Alternatively, a divisional application may be filed with the claims as originally filed in the parent or PCT application. However, the claims of a divisional application filed with the same claims of a parent or PCT application will need to be amended at some point during prosecution to ensure that neither the parent or divisional application claim the exact same subject matter from one another.</p>	<p>application);</p> <ol style="list-style-type: none"> 3. Requires the filing of a request for examination (separate from the filing of a request for examination in the parent application); 4. Is prosecuted separately from the parent application; and 5. Results in a patent that is independent from the parent application.

The above posts were written by Lisa Mueller, Laura Opperman and Julia Cox of Michael Best, Pedro Herrera of Olivares, Silvia Moreira Taketsuma Costa of Dannemann Siemsen, the attorneys at Chadha & Chadha, Vladislav Ugryumov and Tatiana Lyu from Gowlings (Russia), Ivan Shen, Shen IP, Trevor Newton, Gowlings (Canada) and Micaela Modiano of Modiano & Partners.