

Using divisional patent applications to protect multiple or complex inventions

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10 Jul 2023

A divisional patent application is a separate application that is derived from a parent patent application. An application can be "split" into two (or more) applications, usually because the original application claimed multiple (but distinct) inventions, simultaneously.



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In some cases, the scope of a patent application may be too broad, or the claims may be too diverse to be adequately examined within a single application. Divisional patent applications can be divided out from an application, so that each application (the parent and all the divisionals) claim distinct inventions, providing more focused examination and protection for these inventions.

A divisional application claims only one or more, but not all, of the independent inventions of the earlier application, while claiming the benefit of the parent's filing date. Each application must be strictly focused on one invention or on "a group of inventions, so linked as to form a single general inventive concept," to be permissible.

Unity of invention

In many parts of the world, a voluntary divisional application may be filed at any time while a parent application is pending. In examining jurisdictions, divisional applications are usually the result of a restriction requirement or lack of unity objection, made by an examiner in an Office Action.

In other words, an application may not contain multiple, different inventions. If an application does not have unity of invention, the examiner may direct that the applicant remove the additional inventions from the original application. In these circumstances, the applicant may file one or more divisional applications, each claiming a single inventive concept. The claims of a divisional application must be supported by the original specification and cannot introduce any new matter.

Cascading divisional applications

The concept of cascading divisional applications occurs when a divisional application forms the basis of subsequent divisional applications. This means that the divisional application becomes the immediate parent application for another divisional application.

Cascading divisionals enable a further breakdown of inventions and claims, allowing inventors to pursue even more specific aspects of their original inventions. The characterising feature of a cascade of divisional applications each divided out from its predecessor, is that each subsequent application has the filing date of the original parent application.



IP is the name of the game

Brett Weinberg 8 Sep 2022



Cascading divisionals in the USA, UK and Europe

The US Patent and Trademark Office (USPTO) allows for the filing of divisional applications, as long as the application is filed before the grant or abandonment of the parent application. Furthermore, the USPTO permits cascading divisionals, meaning that a divisional application may be a parent application to subsequent divisionals, allowing for a cascade of applications.

In the UK and Europe, it is also possible to file second and subsequent generational divisional patent applications. This is helpful, because in the UK and Europe (and many other jurisdictions) it is only possible to file divisional patent applications while a higher generation patent application is pending. Accordingly, if the immediate parent patent application is no longer pending, but a divisional patent application was filed and is still pending, it is still possible to file a further divisional patent application from the pending divisional application.

Benefits of cascading divisionals

While some argue that filing cascades of divisional patent applications at different times, often relate to the same weak parent application and is used as a delay tactic to prolong pendency, there are also benefits to filing cascading divisionals.

For example, it may be useful to have a pending divisional application because equivalent applications have not yet been allowed in other jurisdictions and the applicant may wish to retain the right to make pre-grant amendments based on the prosecution outcomes of these equivalent applications.

There may also be ongoing commercial negotiations relating to the technology and it might be beneficial to have a pending divisional where the applicant has the freedom to amend the claims to suit its commercial objectives.



Divisional patent practice before the South African Patent Office

In South Africa, the Patents Act provides for the filing of divisional applications. Section 37(1) of our Patents Act, states that:

1. "Where at any time after an application has been lodged at the patent office and before it is accepted, a fresh application is made in the prescribed manner by the same applicant in respect of part of the matter disclosed in the first mentioned application, the registrar may, on application made to him in the prescribed manner before that application is accepted, direct that such fresh application be ante-dated to a date not earlier than the date on which the first-mentioned application was so lodged.
2. A patent granted on such fresh application shall not be revoked or invalidated on the ground only that the invention claimed in such fresh application is not new having regard to the matter disclosed in the first-mentioned application."

Other than the sections set out above, our Act is silent on the requirements for divisional applications, and there is no case law on whether a second divisional application can be filed from a first divisional application.

In our view, the references to "application" in our legislation should be interpreted to mean "parent application" or "divisional application" and that a divisional application is "an application lodged at the patent office" and can thus serve as the basis for a further divisional application. On this interpretation, a second divisional application may be filed from the first divisional application (before it is accepted) irrespective of whether or not the original parent application is pending.

In practice, the South African Patent Office does not limit the number of divisional applications that can be cascaded from another divisional application, provided of course that a divisional application is filed before acceptance of the parent application from which it is filed.

Conclusion

Divisional patent applications serve as valuable tools for applicants to obtain comprehensive protection for their inventions. While some are of the view that cascading divisional applications are not permitted by our law, our view is that this is an allowable practice.

Cascading divisionals enable an applicant to be more flexible in their filing strategy and to target the protection of commercially significant embodiments of the invention. Understanding the regulations and practices governing divisional patent applications in different jurisdictions, is essential for applicants seeking optimal protection for their inventions.

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