**Study Guidelines**

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**2026 – Study Question**

# Divisional applications and double patenting

## Introduction

1) Divisional patent applications are a key mechanism for applicants seeking to secure protection for multiple inventions disclosed in a single parent application. They allow applicants to pursue distinct subject matter while retaining the filing date of the original filing. However, the procedural and substantive requirements for filing divisional applications vary widely across jurisdictions.

2) A central issue associated with divisional applications is double patenting. Double patenting, as its name suggests, refers to the granting of two or more independent patent rights for the same invention. Double patenting may arise, e.g., when overlapping claims in the parent and the divisional patent(s) lead to concerns about claim distinctiveness. The criteria used to assess double patenting also vary significantly across jurisdictions. While some jurisdictions provide mechanisms such as terminal disclaimers to

address potential overlaps, others apply stricter requirements that may limit the applicants´ ability to obtain appropriate protection for inventions related to one another.

3) This Study Question examines whether additional harmonization in the area of double patenting and divisional application practice is desired.

**Why AIPPI considers this an important area of study**

4) The patent system is based on a trade-off between the inventor (patentee) and society: In exchange for disclosing the inventive contribution, the inventor is granted a time-limited exclusive right in such inventive contribution.

5) Significant divergences exist among jurisdictions regarding double patenting, including the legal basis, substantive assessment criteria, exceptions, and procedural arrangements.

6) In addition, it has been argued that divisional applications could also serve purposes beyond protecting inventions separated from the parent application, for example, by prolonging the prosecution of the invention through divisional filings maintaining uncertainty in protection scope; by circumventing unfavorable decisions on parent applications by filing sequential divisional applications (even without amending claims) instead of responding to office actions; and through the accumulation of multiple pending applications (including cascades) . The issue of double patenting and abuse of the divisional system as a legal strategy to extend the patent exclusivity has been flagged by the European Commission in its decision dated 31 October 2024 in the Case AT.40588 – Teva Copaxone. While this decision of the European Commission was in the context of the use of the divisional regime and anti-competitive practices, there is uncertainty whether such abuses can be dealt within the existing patent law regime itself. (See for ex. Ericsson v. Competition Commission of India, decision dated 13 July 2023 by the Delhi High Court; Fosamax and Humira Litigation in Europe).

7) Given that most applicants seek patent protection in multiple jurisdictions for the same invention or related inventions, the lack of harmonization in the treatment of both divisional applications and double patenting increases complexity and unpredictability. A consistent approach across jurisdictions would provide greater clarity regarding the scope of protection, improve procedural efficiency, and ensure that applicants can effectively secure rights without unnecessary legal barriers.

**Relevant treaty provisions**

8) No international treaty contains an explicit provision on double patenting.

9) The right for the patent applicant to divide a patent application on his own initiative was enshrined in Article 4G(2) of the Paris Convention at the Lisbon Revision Conference in 1958. It reads (in English translation, the French version is the authentic one):

*"The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized."*

**Scope of this Study Question**

10) This Study Question will focus on examining the boundaries of divisional applications and double patenting, as well as the procedural safeguards relating to the use of the divisional system. This Study Question covers patents and utility models.

11) This Study Question will focus only on voluntary divisional applications; involuntary/passive filing of divisional applications is excluded from the scope. This Study Question is limited to patent-law aspects and does not address antitrust or unfair competition issues.

**Previous work of AIPPI**

12) Article 4G(2) of the Paris convention is based on preparatory work carried out by AIPPI in the 1930s and 1950s: After the Executive Committee of the AIPPI had formulated a corresponding proposal at its meeting in Brussels in 1931, a majority resolution at the 1932 AIPPI Congress in London expressed the desire that the applicant should also be entitled to request the division of the application during the examination procedure. At the AIPPI Congresses in Berlin in 1936 and Prague in 1938, the demand for the admission of voluntary division in the Paris Convention was upheld and repeated at the Paris Congress in 1950. Referring to these recommendations of the 1950 AIPPI Congress in Paris, Article 4G(2) of the Paris Convention was adopted at the 1958 Lisbon Revision Conference.

13) AIPPI has studied divisional applications in Study Question Q193 "Divisional, Continuation and Continuation in Part Patent Applications" (Singapore 2007), concluding, e.g., that the filing of divisional applications, on the applicant's own volition or in response to unity objections, should be possible and that the filing of divisional applications should be permitted at any time during the pendency of a parent application. AIPPI further concluded that it should be possible to claim in a divisional application subject matter that was unclaimed, but was disclosed in the parent application, and that the patent term of a divisional application should not exceed the patent term of the parent application. Some details, such as the precise definition "pendency", remain undefined.

14) While the Q193 resolution did not address double patenting as such, the Q193 Summary Report notes that a vast majority of jurisdictions prohibit double patenting and further discusses the difference between "overlapping protection scope" in parent/divisional applications and "same invention" in double patenting. It is also suggested in the Q193 Summary Report that double patenting may be found more often in from the voluntary divisional applications than in the involuntary/passive divisional applications in some jurisdictions.

15) Moreover, AIPPI has also studied concepts around potential abuse of IP rights, e.g., in Q292 (Hangzhou2024).

**Discussion**

16) Although patent laws in various jurisdictions generally prohibit double patenting, there are significant differences in specific examination standards and operational practices. For example, different patent offices may have varying standards for determining whether the protection scopes are the same or overlap. These differences create legal uncertainty, posing challenges and risks to the global patent layout of the same invention.

17) When considering what constitutes double patenting, the first inquiry concerns the definition of "same invention": The answers to this question vary as some jurisdictions strictly prohibit claims with identical scope, while others extend the prohibition to obvious variants; some allow terminal disclaimers to overcome certain types of double patenting, whereas others do not recognize this mechanism. These differences pose considerable challenges to international harmonization.

18) To look at some examples, in Europe, Part G, Chapter IV, Article 5.4 of the Guidelines for Examination in the European Patent Office defines the prohibition on double patenting as "two patents cannot be granted to the same applicant with claims directed to the same subject-matter". However, the European patent system allows broad mechanisms for dual filings: As a member state of the European Patent Convention (EPC), e.g., Germany applies basically the same standard, but allows the simultaneous protection of a national patent and a European patent with the same subject matter. Similarly, it may be possible to have utility models and patents for the same subject matter.

19) Likewise, in China, Article 9 of the Chinese Patent Law stipulates that "For any identical invention-creation, only one patent right shall be granted". This implies that two patents should be identical to constitute double patenting. However, China provides an exception of dual filing system that allows an applicant to file both an invention patent application and a utility model patent application for the same invention on the same day, and the

invention patent application may be granted if the utility model patent granted earlier has not been terminated and the applicant declares to abandon the utility model patent.

20) The United States employs a distinctive standard. "Statutory" double patenting bars two patents from containing claims that are literally identical, whereas "obviousness-type" double patenting (ODP) bars claims that, though not identical, are not patentably distinct from the claims of the reference patent. Even after a finding of double patenting, an applicant may cure the defect by withdrawing or amending the later application, or by abandoning the earlier patent. In the United States, an obviousness-type double-patenting rejection may also be overcome by the filing of a terminal disclaimer.

21) Some jurisdictions view double patenting as more likely to arise in certain situations, namely those including divisional applications. As an example, the EPO specifies in Part G, Chapter IV, Article 5.4 of the Guidelines for Examination that in the prosecution proceeding, double patenting "would especially be the case in the following typical situations: two applications filed on the same day, parent and divisional applications, or an application and its priority application". While the mechanism of a divisional application allows applicants to split multiple inventions contained in one parent application while it is still pending, forming one or more new independent applications poses a risk of double patenting: When drafting the claims of a divisional application, the applicant may intentionally or unintentionally overlap or substantially overlap the scope of protection with the parent application or other divisional applications (or other patent rights). If the examiner fails to detect such overlap, it may result in duplicate patent rights being granted for the same invention.

22) Thus, a particular correlation exists between divisional applications and the risk of double patenting.

23) Moreover, when the divisional application reaches substantive examination, the parent application may still be pending, meaning the examiner has no granted “reference” against which to determine double patenting. To reduce

this risk, some commentators have proposed that the parent and divisional applications be assigned to a single examiner and examined in parallel, or at least that their examination proceedings be synchronized. However, no harmonized rule exists across jurisdictions, leaving the relevant public to bear the legal uncertainty created by these divergent practices.

**You are invited to submit a Report addressing the questions below.**

**Questions**

Please note that unless the question makes a distinction between patent right, utility model, and design patent right, the term "patent right" is to be understood to include all said three rights.

## I. Current law and practice

Please answer all questions in Part I on the basis of your Group's current law.

### Double patenting

1) Is it possible for the same applicant to obtain more than one patent right for one invention? [YES/NO] Please add a brief explanation.
2) Is it possible for the same applicant to have the same claim scope protected by patent rights granted by different granting authorities for the same (or overlapping) geographical scope? [YES/NO] Please add a brief explanation.
3) What are the criteria for assessing double patenting? Please add a brief explanation.
4) For two patent rights to be considered to constitute double patenting, the scope of protection must be:
    a. Identical [YES/NO]
    b. Identical or substantially identical [YES/NO]
    c. Identical or substantially identical or non-obviously distinct [YES/NO]
    d. Other [YES/NO]
    Please provide a brief explanation
5) Assessment of double patenting is made:
    a. against granted rights [YES/NO]
    b. against published applications [YES/NO]
    c. only against rights that are in force (not lapsed or invalidated) [YES/NO]
    d. only between the same type of rights (e.g., patent application to patents, utility model application to utility models, etc.) [YES/NO]
    e. also based on other criteria that apply [YES/NO] (please specify)

    Please provide a brief explanation.

6) Are the criteria for assessing double patenting the same for patents and utility models? [YES/NO] Please provide a brief explanation.

7) If a patent application is deemed to constitute double patenting, what measures are available to resolve the issue?
   a. Amend the claims of the patent application [YES/NO]
   b. Abandon the earlier patent right [YES/NO]
   c. Terminal disclaimer [YES/NO]
   d. Other [YES/NO]

   Please provide a brief explanation.

**Divisional Applications**

8) What are the requirements for filing a divisional application?

9) What are the timelines for defining "pendency"? You may add a brief explanation.

10) Is there a limit on the number of divisional applications that can be filed from the same patent family? [YES/NO] You may add a brief explanation.

11) Can a divisional application be filed based on another divisional application (cascading divisionals) or only based on the parent application? [YES/NO] You may add a brief explanation.

12) Can a divisional application be filed based on another divisional application when the parent application has already been allowed? [YES/NO] You may add a brief explanation.

13) Are there any particular procedural requirements that the applicant has to fulfil for filing a divisional application (e.g., a requirement to justify the legitimate need for division at filing, explanation of the relationship between the divisional and the parent, etc.)? [YES/NO] You may add a brief explanation.

14) Is prosecution history estoppel from parent applications binding on divisional applications? [YES/NO] You may add a brief explanation.

15) Are the criteria for determining double patenting the same with respect to divisionals than other patent rights?

16) Are there any other procedural exceptions regarding divisionals? [YES/NO] You may add a brief explanation.

17) Are there any practices that are considered to be outside the scope of a legitimate use of the patent system (i.e., abusive) regarding divisional applications? [YES/NO] You may add a brief explanation.

## II. Policy considerations and proposals for improvements of your Group's current law

18) According to the opinion of your Group, is your current law regarding double patenting adequate and/or sufficient? Please answer YES or NO and please explain your chosen view briefly.

19) According to the opinion of your Group, what is or should be the policy rationale for regulations addressing double patenting?

20) According to the opinion of your Group, is your current law regarding divisional applications adequate and/or sufficient? Please answer YES or NO and please explain your chosen view briefly.

21) According to the opinion of your Group, what is or should be the policy rationale for regulations addressing divisional?

22) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

## III. Proposals for harmonisation

### Double patenting

23) Do you consider that there is a need to have harmonization regarding issues involving double patenting? Please answer YES or NO and add a brief explanation.

If your answer to question 23)) was YES, please continue to answer the questions below. Even if you answered NO to question 23)), please address the following questions to the extent your Group considers that the current law or practice could be improved.

24) Should it be categorically prohibited to have more than one patent right for one invention for the same geographical area with the same or substantially the same claim scope (double patenting)?
   a. YES, it should be categorically prohibited (i.e., only one patent right per invention per territory).
   b. NO, it should not be categorically prohibited as exceptions should apply.

   Please provide a brief explanation

25) Irrespective of your answer to question 24)) above, if it were possible to have more than one patent right for the same or substantially the same claim scope, should it be possible to have patent rights covering the same geographical area granted by different national or regional bodies for the same or substantially the same claim scope? [YES/NO]
   Please add a brief explanation.

26) Should it be possible to have protection for the same or substantially the same claim scope through different "patent rights" (e.g., utility model, design patent)? [YES/NO]
   Please provide a brief explanation

27) Irrespective of your answer to question 26)) above, if such parallel protection was available, should it be possible to have, for the same or substantially the same claim scope,
    a. a patent right and a utility model right? [YES/NO]
    b. a patent right and a design patent right? [YES/NO]
    c. a utility model right and a design patent right? [YES/NO]
    d. a utility model right and a utility model right? [YES/NO]
    e. a patent right and a patent right? [YES/NO]
    f. other? [YES/NO]

    Please provide a brief explanation

28) Irrespective of your answer to question 26)) and 27)) above, for two patent rights to be considered to constitute double patenting, the scope of protection should be
    a. identical? [YES/NO]
    b. identical or substantially identical? [YES/NO]
    c. identical or substantially identical or non-obviously distinct? [YES/NO]
    d. other? [YES/NO]

    Please provide a brief explanation

29) When determining whether a patent application would constitute double patenting, should there be restrictions on the legal status of the "other patent" to which the double patenting is compared to? [YES/NO]

    Please provide a brief explanation

30) Irrespective of your answer to question 29)) above, if such assessment was to be made:
    a. Should double patenting be assessed against granted rights? [YES/NO]

b. Should double patenting be assessed against published applications? [YES/NO]
c. Should double patenting be assessed only against rights that are in force (not lapsed or invalidated)? [YES/NO]
d. Should double patenting be assessed only between the same type of rights (e.g., patent application to patents, utility model application to utility models, etc.)? [YES/NO]
e. Should other criteria apply? [YES/NO]

Please provide a brief explanation.

31) Should the criteria for assessing double patenting be the same for patents, utility models, and design patents? [YES/NO] Please provide a brief explanation.

32) If a patent application is deemed to constitute double patenting, what measures should be available to resolve the issue?
a. Amend the claims of the patent application? [YES/NO]
b. Abandon the earlier patent right? [YES/NO]
c. Terminal disclaimer? [YES/NO]
d. Other? [YES/NO]

Please provide a brief explanation

**Divisional applications**

33) Should Resolution Q193 be considered sufficient for addressing harmonization regarding divisional applications? [YES/NO] Please provide a brief explanation.

34) If your answer to question 33)) above was NO, what kind of issues/aspects should generally be subject to additional harmonization?
Even if your Group would not prefer further harmonization, please continue answering the questions below.

35) With reference to Resolution Q193, item 3, which states that "The filing of divisional applications should be permitted at any time during the pendency of a parent application", how should "pendency" be legally defined to guide filing timelines?

a. Should pendency include the time preceding the grant of the original parent application? [YES/NO]
b. Should pendency include the time preceding the first instance opposition decision of the original parent application? [YES/NO]
c. Should pendency include the time preceding the decision on an opposition appeal of the original parent application? [YES/NO]
d. Other?

Please provide a brief explanation.

36) Should there be a limit on the number of divisional applications? [YES/NO]
You may add a brief explanation.

37) Should it be possible to file a divisional application:

a. Only based on another divisional application [YES/NO]
b. Only based on the parent application [YES/NO]
c. Based on divisional application or parent application [YES/NO]

You may add a brief explanation.

38) Should a divisional application be filed based on another divisional application when the parent application has already been allowed? [YES/NO]
You may add a brief explanation.

39) When a lack of unity objection is issued by the examiner of a patent application:

a. Should the applicant be required to file all the divisional applications of interest at that moment [YES/NO]

b. Should it be possible to file a single divisional containing more than one invention [YES/NO]

40) Should the examiners be permitted to issue lack of unity objections in divisional applications, thus, allowing the applicant to further divide a divisional application with a lack of unity issue when the main (parent) application has issued [YES/NO]

41) Should applicants be required to justify the legitimate need for division at the time of filing? [YES/NO] You may add a brief explanation.

42) Should a family of parent and divisional applications be examined by the same examiner? [YES/NO] You may add a brief explanation.

43) When filing a divisional application, should the applicant be required to explain the relationship between the claimed technical solution in the divisional claims and the parent claims? [YES/NO] You may add a brief explanation.

44) Should prosecution history estoppel from parent applications be binding on divisional applications? [YES/NO]

45) Should the prosecution period of divisional applications be limited? [YES/NO] You may add a brief explanation.

46) Should delayed examination be allowed for divisional applications? [YES/NO] You may add a brief explanation.

47) Should amendments to the claims of divisional applications be restricted? [YES/NO You may add a brief explanation.

48) Should the same criteria for assessing double patenting in the case of divisional applications apply as for other patents?

a. NO.
b. YES, for mandatory and voluntary divisionals.
c. YES, for mandatory divisionals only.
d. YES, for voluntary divisionals only.
e. Other.

You may add a brief explanation.

49) Should the filing of divisional applications be considered categorically exempt from being considered an abuse of the IP system? [YES/NO] You may add a brief explanation.

50) In what kind of situations, if any, should the enforcement of divisional applications be considered as abusive (outside of the scope of the legitimate use of the patent right)? If/when identifying such situation(s), please also mention the evidence which would be required to support such a finding. Irrespective your answer to the above, are there any other practices that should be considered to be outside the scope of a legitimate use of the patent system (i.e., abusive) regarding divisional applications? [YES/NO] You may add a brief explanation.

51) If any, what kind of remedies should be available if the enforcement of divisional applications is considered as abusive? Please comment on any additional issues concerning any aspect of divisional applications or double patenting that you consider relevant to this Study Question.

52) Please indicate which industry sector views provided by in-house counsels are included in your Group's answers to Part III.