



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. Please refer to the 'Protocol for the preparation of Reports'.



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.

YES. Under Finnish law, there is no explicit statutory prohibition against double patenting. Accordingly, it is possible for the same applicant to obtain more than one patent right for the same invention, where the applications claim the same priority date.

- 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.

YES. The same applicant can end up holding more than one patent right for the same invention via different routes – for example, a Finnish national patent, a PCT application entering the Finnish national phase, and a European patent validated in Finland (or protection obtained via a Unitary Patent).

- 3) What are the criteria for assessing double patenting? Please add a brief explanation.

As mentioned, there is no explicit statutory prohibition against double patenting under Finnish law. This means that double patenting is generally permitted, except in the specific context of divisional applications, where Finnish practice is strict (see answer to question 15 below).

4) For two patent rights to be considered to constitute double patenting, the scope of protection must be:

a. Identical [YES/NO]

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b. Identical or substantially identical [YES/NO]

-

c. Identical or substantially identical or non-obviously distinct [YES/NO]

-

d. Other [YES/NO]

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Please provide a brief explanation: [Finnish law does not contain an explicit prohibition on double patenting.](#)

5) Assessment of double patenting is made:

a. against granted rights [YES/NO]

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b. against published applications [YES/NO]

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c. only against rights that are in force (not lapsed or invalidated) [YES/NO]

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d. only between the same type of rights (e.g., patent application to patents, utility model application to utility models, etc.) [YES/NO]

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e. also based on other criteria that apply [YES/NO] (please specify)

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Please provide a brief explanation: [Finnish law does not contain an explicit prohibition on double patenting.](#)

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

[YES. Finnish law does not contain an explicit prohibition on double protection with respect to utility models either.](#)

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: [Finnish law does not contain an explicit prohibition on double patenting.](#)

Divisional Applications

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

[Divisional applications may be filed for both patents and utility models, either voluntarily or following a non-unity objection.](#)

Patents

[A divisional application may be filed before the patent authority has notified the applicant of the acceptance of the parent application \(Section 19\(2\) of the Finnish Patents Act 550/1967 and Section 22 of the Finnish Patents Decree 669/1980\). A legislative amendment allowing divisional applications to be filed at any time prior grant has been proposed and is currently under consideration by the Finnish Parliament, with an intended entry into force on 1 January 2027 \(Government's Proposal HE 204/2025 vp\).](#)

[Where the parent application has been refused, a divisional application may be filed within the time limit for appeal, irrespective of whether an appeal is filed \(Section 42\(1\) of the Finnish Patent Regulations PRH/1217/01/2022\).](#)

[Where the parent application has been abandoned, a divisional application may be filed within the time limit for requesting further processing, irrespective of whether such further processing is requested \(Section 42\(2\) of the Finnish Patent Regulations\).](#)

[The invention claimed in the divisional application must be disclosed in the parent application as filed \(Section 24\(2\) of the Finnish Patents Decree\). The applicant must specify which parts of the parent application form the basis for the claims of a divisional application \(Section 41 of the Finnish Patents Regulations\).](#)

Utility models

[The Finnish Utility Model Act allows for the filing of divisional applications but does not contain a specific provision on the applicable timeline \(Section 9\(2\) of the Finnish](#)

Utility Model Act 800/1991). Accordingly, a divisional application may be filed before registration of the utility model.

Where a non-unity objection has been raised and the utility model application is limited (e.g., to a particular claim) in response to that objection, a divisional application must be filed within two months from the filing of the limitation in order to retain the same filing date as the parent application (*Section 16(3) of the Finnish Utility Model Decree 1419/1991*).

Where the parent application has been refused, a divisional application may be filed during the time limit for appeal, irrespective of whether an appeal is filed (*Section 39(1) of the Finnish Utility Model Regulations PRH/2207/01/2023*).

Where the parent application has been abandoned, a divisional application may be filed within the time limit for requesting further processing, irrespective of whether such further processing is requested (*Section 39(2) of the Finnish Utility Model Regulations*).

As with patents, the invention claimed in the divisional application must be disclosed in the parent application as filed (*Section 16(2) of the Finnish Utility Model Decree*).

The applicant must specify which parts of the parent application form the basis for the claims of a divisional application (*Section 38 of the Finnish Utility Model Regulations*).

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

Finnish legislation does not use the term "pendency". Instead, it defines specific time limits within which a divisional application may be filed. See the answers to question 8 above.

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.

NO.

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.

YES. Cascading divisionals are permitted.

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.

YES. Cascading divisionals are permitted even if the parent application has already been allowed, as long as the application based on which the divisional is filed fulfils the requirements outlined in answer 8 above.

- 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.

YES. The applicant must specify which parts of the parent application form the basis for the claims of a divisional application, as outlined in answer 8 above.

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

NO. Finnish law does not recognize prosecution history estoppel as an explicit legal doctrine, and there is no case law establishing that statements or amendments made during prosecution of a parent application would be binding on a divisional application.

However, under the principle of free evaluation of evidence, the courts are generally free to assess the bearing of the evidence presented by the parties without being bound by any rules in this regard. This principle of free evaluation of evidence is set out in the Finnish Code of Judicial Procedure (4/1734).

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

NO. Finnish law allows parallel protection with identical claims in several contexts outside divisional practice. For example, it is permissible to file a Finnish utility model application and a patent application with the same priority date and identical claims. Likewise, a European patent with the same priority date may be validated in Finland with claims identical to those of a national Finnish patent, and a PCT application may enter the Finnish national phase with claims identical to those of an already pending national Finnish patent application (or utility model) that has the same priority date.

However, different criteria apply to divisional applications. A divisional application may not be filed with claims identical to those of the parent application, nor is it permissible to file a divisional application with narrower claims where the scope of the parent

includes the scope of the independent claim of the divisional (this follows from the Finnish Supreme Administrative Court's decision 3527/2013). By contrast, it is permissible to file a divisional application with claims broader than those of the parent application, or to limit the claims of the parent application so that its independent claims become narrower than those of the divisional application.

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

YES, for utility models. As stated above in the answer to question 8, where a non-unity objection is raised and the utility model application is limited (e.g., to a particular claim) in response to that objection, a divisional application must be filed within two months of filing the limitation in order to retain the same filing date for the divisional application as for the parent application.

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.

NO.

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.

NO. In the opinion of the Finnish Group, the current Finnish law regarding double patenting is not sufficient.

Finnish legislation does not contain explicit provision on double patenting. Leaving this issue to be resolved primarily in case law creates legal uncertainty for both applicants and third parties, as outcomes may depend on case-by-case interpretation. The Finnish Group therefore considers that clearer and more specific statutory rules on double patenting would be desirable.

At the same time, the Finnish Group is generally satisfied with the current framework insofar as it allows applicants to (i) obtain patent protection through multiple applications sharing the same priority, (ii) obtain patent rights granted by different authorities for the same or overlapping geographical scope (for example, a Finnish national patent and a European patent validated in Finland); and (iii) obtain different forms of protection for the same invention (such as a Finnish utility model and a patent).

However, the Finnish Group considers that Finnish practice is unduly strict with respect to double patenting in the context of divisional applications. This issue is addressed in more detail in the answer to question 20 below.

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

The regulation of double patenting should ensure:

(i) legal certainty for third parties;

(ii) prevention of unjustified multiplication or extension of patent rights;

(iii) balanced protection of applicants' legitimate interests in pursuing different claim scopes but also in pursuing different rights (patent, utility model) and optimizing the allowed term of protection (such as filing a later application within the priority year); and

(iv) alignment with international and EPO practice to improve predictability.

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.

NO. In the opinion of the Finnish Group, the current Finnish law and practice regarding divisional applications are not adequate.

As explained above in the answer to question 15, it follows from the Finnish Supreme Administrative Court's decision 3527/2013 that a divisional application may not be filed with claims narrower than those of the parent application where the scope of an independent claim of the divisional is entirely encompassed by the scope of an independent claim of the parent application.

In this regard, the Finnish practice deviates from the established EPO practice as set out in decisions G1/05 and G1/06 and applied, for example, in decision T2402/10. Under EPO practice, the prohibition is limited to claims that contain the same subject matter as that of a granted claim and does not extend to situations involving only partially overlapping subject matter. Decision T2402/10 expressly allows a divisional application to contain claims that are narrower than, and fully encompassed by, broader claims in the parent patent.

Further, as explained above in the answers to questions 8 and 13, Finnish practice requires applicants to specify which parts of the parent application form the basis for the claims of a divisional application. Finnish practice deviates from EPO practice in this regard. Under EPO practice, while there must be a basis for the claims of a divisional application, the applicant is required to identify that basis only if the EPO raises the issue in an office action.

The Finnish Group considers that the Finnish practice should be aligned with the established EPO practice.

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

Applicants may have different reasons for seeking to obtain either a narrower claim scope (for validity/stronger patent) or a broader claim scope in divisional applications. The regulatory framework should accommodate both objectives.

Accordingly, applicants should generally be permitted to pursue divisional applications with claim scopes that are either narrower or broader than those of the parent application. The principal limitation should be that a divisional application cannot have an identical claim scope to that of the parent application or, in the case of cascading divisionals, to any earlier parent.

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?

NO.

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.

YES.

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

b. NO, it should not be categorically prohibited, as exceptions should apply.

Double patenting should not be categorically prohibited. In practice, there are legitimate circumstances in which parallel patent rights may arise, such as same-day filings or applications claiming the same priority. These situations arise naturally from the structure of the patent system and do not, as such, undermine third-party legal certainty.

Harmonization should therefore focus on defining clean and limited exceptions, rather than imposing an absolute prohibition. Such exceptions are necessary to safeguard the legitimate interests of applicants, for example where: (i) different claim scopes are pursued in divisional applications, (ii) international and national filing routes overlap, (iii) a later filing within the priority year claiming priority from the earlier application, or (iv) procedural strategy requires parallel protection (such as pursuing a narrow and fast parent application alongside a broader divisional application, or filing a patent and utility application with the same claim scope) without extending the patent term with the exception of point (iii).

What should be prohibited is granting multiple patents with the identical claim scope. However, this should not apply to patents with overlapping geographical scope or

cumulative protection for different “patent rights”, as set out in questions 25 and 26 below. Further, the right of priority should also be preserved: Once an applicant has filed a patent application for a particular invention, they should have the opportunity, within 12 months of the filing date of the first application, to file a subsequent application and claim priority from the earlier application.

- 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.

YES. It should be possible for such rights to be granted by different national and regional bodies covering the same geographical area. Applicants may have legitimate reasons to pursue different filing routes, including strategic, procedural, or timing considerations.

- 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

YES. Cumulative protection for the same or substantially the same claim scope under different “patent rights” should be allowed, provided that each right meets its respective statutory requirements. Given that patents, utility models, and registered designs each serve different purposes and operate under different substantive requirements, a general prohibition on cumulative protection would not be justified.

- 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]

YES, for the reasons set out in question 26 above.

- b. a patent right and a design patent right? [YES/NO]

YES, for the reasons set out in question 26 above.

c. a utility model right and a design patent right? [YES/NO]

YES, for the reasons set out in question 26 above.

d. a utility model right and a utility model right? [YES/NO]

NO, with the exception of claiming the same priority, as set out in question 24 above.

e. a patent right and a patent right? [YES/NO]

NO, with the exception of the same geographical scope and claiming the same priority, as set out in questions 24 and 25 above.

f. other? [YES/NO]

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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]

YES

b. identical or substantially identical? [YES/NO]

NO

c. identical or substantially identical or non-obviously distinct? [YES/NO]

NO

d. other? [YES/NO]

NO

The prohibition on double patenting should apply only where two patents protect claims of identical scope. Since patents serve a single, unified purpose and operate under the same substantive requirements, a second patent covering identical claims adds nothing beyond what the first already protects and would simply extend the monopoly without justification. A broader threshold such as "substantially identical" or "non-obviously distinct" would introduce unnecessary subjectivity, risk penalizing legitimate follow-on innovation, and blur the distinction between double patenting and the separate concept of inventive step.

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

YES. Double patenting should primarily be assessed against patents that are granted and in force or against co-pending applications with overlapping scope. Comparing a pending application to expired, revoked, or finally refused patents should not trigger a double patenting objection, as such rights no longer produce enforceable exclusivity.

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]

YES.

b. Should double patenting be assessed against published applications? [YES/NO]

YES.

c. Should double patenting be assessed only against rights that are in force (not lapsed or invalidated)? [YES/NO]

YES. If the "other" right has lapsed and cannot be restored, there is no risk of duplicative exclusivity.

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]

YES. As a general rule, double patenting should be assessed within the same type of right (e.g., patent and patent). Jurisdictions that permit concurrent patent and utility model protection for the same invention (such as Finland) should have the possibility to maintain that system.

e. Should other criteria apply? [YES/NO]

YES. In order for a patent application to constitute double patenting, it should have the same applicant or same inventors, and the same granting authority (i.e., a national Finnish patent and a European patent validated in Finland should not be treated as constituting double patenting).

The exceptions set out in questions 24, 25 and 26 should apply.

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.

NO. Patents and utility models protect technical inventions and should share a common double patenting standard. Designs serve a different purpose by protecting appearance, so different standards may be reasonable. It should be possible to obtain cross-type cumulative protection (e.g., patent and utility model, patent and design, or utility model and design).

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]

YES.

b. Abandon the earlier patent right? [YES/NO]

YES, on a voluntary basis.

c. Terminal disclaimer? [YES/NO]

YES, in relevant jurisdictions. For example, terminal disclaimers are not available in Finland, as a divisional application will always have the same term of protection as the parent. However, jurisdictions that provide for terminal disclaimers should be allowed to maintain that system.

d. Other? [YES/NO]

YES. If the applicant does not resolve the double patenting objection by voluntary measures, the granting authority should have the right to refuse the later application.

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.

NO. While Resolution Q193 established important principles for harmonization, it should not be considered sufficient for addressing harmonization regarding divisional applications. For example, Resolution Q193 does not define the term “pendency” or address double patenting. Therefore, additional harmonization is needed.

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.

There should be a clear and harmonized framework defining when the filing of further divisional applications is permitted, in particular with respect to the meaning of the term "pendency". Additional harmonization is also needed to address double patenting.

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]

YES.

b. Should pendency include the time preceding the first instance opposition decision of the original parent application? [YES/NO]

NO. Including the period between the grant of the patent application and the first instance opposition decision within the definition of pendency would unduly prolong the period during which the scope of potential patent protection remains uncertain, thereby negatively affecting third parties' ability to operate.

c. Should pendency include the time preceding the decision on an opposition appeal of the original parent application? [YES/NO]

NO, for the same reasons as set out above in relation to question b.

Other? Please provide a brief explanation.

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

NO. Imposing an absolute numerical limit on divisional applications would be disproportionate. The need for multiple divisional applications varies across technical fields, and adequately protecting the full scope of a complex invention may legitimately require several divisional applications. Such a limit would therefore penalize bona fide applicants without meaningfully addressing potential abuse.

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

a. Only based on another divisional application [YES/NO]

NO.

b. Only based on the parent application [YES/NO]

NO.

c. Based on divisional application or parent application [YES/NO] You may add a brief explanation.

YES. Harmonization should support allowing divisional applications to be filed on the basis of either the parent application or earlier divisional application. Restricting the permissible basis to only one option would undermine the principles established in Resolution Q193.

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.

YES. It should be possible to file a divisional application based on another divisional application even when the parent application has already been allowed, provided that the immediate divisional parent application is still pending at the time of filing. The relevant criterion for determining the validity of subsequent divisional should be the pendency of the immediate parent divisional, not the ultimate parent application.

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]

NO. The filing of divisional applications should be permitted at any time during the pendency of the parent application, as confirmed in Resolution Q193. Requiring applicants to file all divisional applications of interest at the moment a lack of unity objection is issued would unduly restrict applicant's procedural flexibility. In addition, the notion of applications "of interest at that moment" is ambiguous.

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

YES. It should be procedurally possible to file a divisional application that contains more than one invention. However, a patent should not be granted on such a divisional application without addressing the unity requirement. If the application contains several non-unitary inventions,

examination should be limited to the first claimed invention, and the applicant should have the possibility to file further divisional applications for the additional inventions.

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]

YES. The unity requirement should apply to divisional applications on the same basis as to any other patent application and there is no basis for treating divisional applications differently from parent applications in this regard.

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.

NO. The requirement that the subject matter of the divisional application must be disclosed in the parent application as filed already provides a sufficient substantive safeguard against misuse. No justification is required under Article 4G(2) of the Paris Convention either.

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

YES. This would be ideal, as examination by the same examiner could promote consistency and efficiency. However, in practice this may not always be possible due to resource constraints or changes in the examiner staff.

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.

NO. Imposing such an obligation would be disproportionate and is not required under the Paris Convention framework. The existing requirement that the subject matter of the divisional application must be disclosed in the parent application as filed provides a sufficient substantive safeguard. Examiners should, however, retain the ability to request such clarification during examination where concerns arise, for example in relation to added subject matter.

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

NO. Prosecution history estoppel arising from statements, amendments, or concessions made during the prosecution of a parent application should not automatically bind a divisional application. Each divisional application undergoes independent examination, pursues independently defined claims, and gives rise to a separate patent right. Importing estoppel from one prosecution stream into another would unduly deprive the applicant of the ability to define claim scope on the merits of the divisional application itself.

That said, the prosecution history of the parent application should not be wholly disregarded. It may serve as relevant interpretive context, particularly in post-grant proceedings such as opposition, invalidity, or infringement proceedings, for example where statements or surrenders of scope made during the prosecution of the parent application concern claim language common to both applications, or where the divisional application appears to be used strategically to recapture subject matter that was expressly conceded during prosecution of the parent application.

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

NO. The prosecution period of divisional applications should not be subject to any additional specific limitation beyond the rules that already apply to patent applications generally. The filing of divisional applications should only be limited by the pendency of the parent application.

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

NO. Divisional applications already provide applicants with sufficient flexibility to pursue protection for different aspects of an invention disclosed in the parent application. Allowing delayed examination for divisional applications would risk prolonging the period during which the scope of potential patent protection remains uncertain. Such prolonged uncertainty could negatively affect third parties, in particular by making it more difficult to assess their freedom to operate.

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

NO. Amendments to the claims of divisional applications should not be subject to restrictions beyond the general amendment requirements applicable to patent applications, such as compliance with added-matter rules.

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.

b. YES, for mandatory and voluntary divisionals. The criteria for assessing double patenting should be applied consistently, regardless of whether the potential overlap arises from divisional applications or from other types of patent filings.

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.

NO. While divisional applications are an important and legitimate mechanism within the patent system, their filing should not be categorically exempt from being considered an abuse of the IP system.

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.

The enforcement of divisional applications should be considered abusive only in exceptional circumstances where the applicant's conduct clearly exceeds the legitimate exercise of patent rights. Such situations may arise, for example, where divisional applications are used strategically and in bad faith to target products that have already entered the market or to prevent competitors from entering the market.

A finding of abuse should require clear and convincing evidence demonstrating that the applicant's conduct was primarily aimed at circumventing the objectives of the patent system rather than protecting genuine inventive subject matter. Such evidence

could relate to filing and withdrawal patterns, timing linked to market entry, internal indications of exclusionary intent, and exclusionary effects.

NO. Beyond such exceptional circumstances, there are no additional practices specific to divisional applications that should categorically be considered outside the scope of legitimate use of the patent system.

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.

In exceptional cases where divisional applications are enforced abusively, courts should have the discretion to apply appropriate remedies. Such remedies could include dismissing the enforcement action in whole or in part, or at least taking the abusive conduct into account when allocating costs.

In addition, measures under competition law may be relevant where divisional patents are used in a manner that restricts or distorts competition.

Any such remedies should, however, be applied cautiously and only where clear and convincing evidence of abusive conduct exists.

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

Elevator industry sector.