

Chapter 10 Division and Conversion

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Chapter 10 Division and Conversion

A patent application that substantially contains two or more inventions may be divided into two or more divisional applications. An application after filing may be converted to a patent application of other types. This chapter provides explanation on the relevant criteria for divisional applications and conversion of applications, the two types of special applications.

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A. 108
A. 132

1. Divisional Application

1.1 Introduction

A patent application for invention shall relate to one invention; yet two or more inventions so linked as to form a single general inventive concept may be filed in one application. An applicant may divide a patent application that substantially contains two or more inventions into two or more divisional applications.

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For inventions disclosed in the description or drawings but not recited in the claim(s), if the applicant wishes to claim such inventions, he or she may amend the claim(s) or apply for divisional application(s) during examination process. Divisional application(s) may also be filed within three (3) months after the date on which the approval decision is served... Upon the filing of divisional application, if the inventions are substantially identical, double patenting concerns will be raised, which violates the first-to-file principle.

A. 31
A. 34. II

For a divisional application filed after the date on which an approval decision is served, it shall be based on the invention(s) disclosed in the description or the drawing(s) and shall not be the same as that have been approved in the original patent application, thereby avoiding double patenting.

A. 34. VI

The filing date of the divisional patent application (hereinafter divisional application) shall be the same as the filing date of the original application. In order to balance the interests of the applicant and the public, and to take into account the first-to-file principle and the stability of the pending rights, the scope of the divisional patent application shall not extend beyond the scope of content disclosed in the description, claim(s), or drawing(s) of the original patent application as filed.

A. 34. IV

The “original application” in this section does not refer exclusively to the application that obtains the first filing date (parent application). If the application that obtains the first filing date (parent application) is divided into a divisional application (child application), and the divisional application (child application) is further divided

into a further divisional application (grandchild application), then the “original application” of the further divisional application (grandchild application) refers to the divisional application (child application) rather than the application that obtains the first filing date (parent application).

1.2 Requirements for Divisional Application

1.2.1 Formal Requirements

For the “Applicant for Divisional Application,” “Statutory Period of Divisional Application,” “Required Documents and Recitations,” Please refer to PART I “Procedural Examination and Patent Rights Management,” Chapter 13 “Division and Conversion” 1. “Apply for Divisional Application.”

Where the description of a divisional application is not completely quoted from the description of the original patent application as filed, in order to protect the rights and interests of the applicant and improve efficiency of examination, so as to correctly determine whether the divisional application extends beyond the scope of content disclosed in the description of the original application as filed, the applicant shall attach a markup page showing the discrepancies between the description of the divisional application and the “Description of the Original Application as Filed.” The deleted original disclosure shall be indicated by a strikethrough of the deleted text(s). The added disclosure shall be indicated by underlining the added text(s). The discrepancies may be illustrated in the divisional application request form. For the definition of “original application” stated above, please refer to Section 1.1 “Introduction” of this chapter.

R. 28. III

1.2.2 Substantial Requirement

(1) If the claimed invention lacks unity, the applicant may apply for a divisional application to overcome the grounds of rejection, as shown in the following scenarios:

- a. The claimed invention recited in the claim(s) substantially includes two or more inventions that lack unity.
- b. When one or more independent claims does not meet the patentability requirements, and even upon amendment or cancellation, the claimed invention recited in the remaining claims still lack the unity of invention, as shown in the following exemplary claims:
 1. A compound X, comprising....
 2. A method for preparing compound X, comprising the steps of....

3. A use of compound X as a cleaning agent, comprising....

If, with respect to the prior arts, the “compound” recited in claim 1 lacks novelty or inventive step, even when applicant thus cancels claim 1, claims 2 and 3 still lack unity of invention due to the absence of same or corresponding special technical feature(s).

c. When the claim(s) of an application is amended or new claim(s) added, while not extending beyond the scope disclosed in the description, claim(s), or drawing(s) as filed, but the amended claims lack unity of invention.

(2) The claimed invention substantially including two or more inventions does not only refer to the subject matters recited in the claims. If the contents recited in the description or the drawing(s) of the original application substantially include two or more inventions, the applicant may divide one or more of the inventions into another or more applications.

(3) The claimed invention(s) cannot be the same between the original application and its divisional application, or the divisional of a divisional application. However, whether the contents recited in the description or drawing(s) are the same is irrelevant. For example, the original application before division contains two inventions, A and B; upon division, if the claim(s) of the original application only recite invention A, the description thereof may recite only invention A or may include both inventions A and B; on the other hand, the claim(s) of the divisional application may only recite invention B but not invention A. As to the description of the divisional application, it may recite only invention B, or it may also include inventions A and B.

(4) After the filing of a divisional application, if the applicant wishes to amend the description, claim(s), or drawing(s) of the original application, the examination proceedings will continue in accordance with the procedure of amendments.

A. 34.IV

(5) The filing date of the divisional patent application shall be the same as the filing date of the original application. Thus, the description, claim(s), or drawing(s) of the divisional patent application shall not extend beyond the scope of content disclosed in the description, claim(s), or drawing(s) of the original patent application as filed. For the determination of whether the scope extends beyond the original disclosure, please refer to Chapter 6. If a divisional application extends beyond the scope of content disclosed in the description, claim(s), or drawing(s) of the original application, the applicant shall be notified to file a response for violating the provision that divisional application shall not extend beyond the scope of content disclosed in the description, claims(s), or drawing(s) of the original application as filed. If no response is made within the time limit or if the response is groundless, a Decision of Refusal shall be made. For the determination of whether inventions

applied for on the same day are identical, please refer to Chapter 3, Section 5.5 “Criterion for Determination on Whether Inventions Filed on the Same Day are Identical.”

- (6) For a divisional application that is filed before the approval decision of the original application, during the examination of the divisional application, if the claim(s) of the divisional application includes the same invention as the original application and therefore leads to double patenting, the applicant shall be notified, on the grounds of violating the first to file principle, to select one patent application within a specified time period; failure to make a selection within the time period shall result in the rejection of all such patent applications. A. 31
- (7) For a divisional application that is filed after the approval decision of the original application, during the examination of the divisional application, if the claim(s) of the divisional application includes the same invention as the claims of the approval decision and therefore leads to double patenting, the applicant shall be notified, on the grounds of violating the rules of divisional after the approval decision, to amend within a specified time period; failure to amend within the time period shall result in the rejection of the divisional application. A. 34.VI
- (8) If grounds for unpatentability are found upon examination of the divisional application, the applicant shall be notified to respond within a specified time period.

1.2.3 Exemplary Cases

Example 1.

Original Application before Division

[Claim(s)]

1. A method for preparing compound A.
2. A diagnosis method for hepatitis C using compound A.

Original Application after Division

1. A method for preparing compound A.

Divisional Application

1. A diagnosis method for hepatitis C using compound A.

[Remark]

The original application before division included a method for preparing compound A and a method for diagnosing hepatitis C using compound A. Although both claims pertain to the same compound A, after examination, it is found that compound A had been published or used publicly and is not a special technical feature. Claim 1 and claim 2 of the original application therefore do not possess the same or corresponding special technical features and hence lack unity of invention. Thus, it is necessary to apply for a divisional application so that claim 1 and claim 2 do not coexist

in the same application, or to delete one of them.

Example 2.**Original Application before Division**

[Claim(s)]

1. A filament A.
2. A light bulb B made using filament A.

Original Application after Division

[Claim(s)]

1. A filament A.

Divisional Application

[Claim(s)]

1. A light bulb made using filament A.

[Remark]

Claims 1 and 2 of the original application before division recite a filament A and a light bulb B made with filament A. A common special technical feature, the filament, is shared between the two claims. The claims thus possess unity of invention and can be included in a single application. They may also be divided and filed in different applications.

1.3 Effect of Divisional Application

- (1) The filing date of a divisional patent application shall be the same as the filing date of the original application.
- (2) Where the priority claim has been made, the applicant may claim priority for the divisional patent application. The examination of patentability requirements therefor shall be based on the priority date as the reference date.
- (3) If an original application asserts grace period, the divisional application thereof may also assert grace period.
- (4) Where the original application declares that the same applicant applies for an invention application and a utility model patent application for the same creation on the same day, and subsequently divides the same creation from the invention application and claims that the patent right of the divisional application is continued from the patent right of the utility model patent application, the divisional application may cite the declaration in the original invention application. The citation of the declaration in a divisional application shall be made at the time of division and may not be made at a later time.

Before the approval of either the original invention application or the divisional

application, if there still exists the issue of double patenting, the applicant shall be notified to ascertain only one invention application as the continuing application, so as to comply with the legislative intent of continuing rights between a utility model application and an invention application filed on the same date for the same creation in accordance with the Patent Act.

1.4 Notes for Examination

- (1) The type of patent of a divisional application cannot be changed from that of the original application.
- (2) For invention(s) disclosed in the description or drawing(s) of an original application but not recited in the claim(s), a division application may be filed directly without amending the original application to add the invention to the claim(s) of the original application.
- A. 38 (3) If there is a need of substantive examination for a divisional application, a request for substantive examination shall be made within three (3) years after the filing date of the original application. If the three (3) year time period has lapsed, a request for substantive examination may be made within thirty (30) days after such request for division.
- (4) Upon filing of a divisional application, even if the original application is subsequently withdrawn, abandoned, not accepted, decided, or revoked, it will not affect the validity of the divisional application.
- A. 34.VII (5) For a division application filed after the original application has been approved, since the original application has been approved, the description, claim(s), or drawing(s) of the original application shall not be altered, and shall be published based on the claim(s) and drawing(s) as originally approved. The division application may only be used to apply for a patent based on the technical content disclosed in the description or drawings of the original application, and not belonging to the same invention as the claims approved in the original application.
- (6) For a divisional application filed after the original application is approved, even if the applicant of the original application has waived the right to pay fees and obtain patent certificate, if any of the claims in the divisional application and the claims in the approved original application recite the same invention, the divisional application still does not comply with the provisions of Article 34, Paragraph 6 of the Patent Act.

2. Conversion of Application

2.1 Introduction

The term patent is classified into three types: invention patent; utility model patent; and design patent. Invention and utility model patents protect the creation of technical ideas, utilizing the laws of nature, while design patent protects the creation made in respect of the shape, pattern, color, or any combination thereof, of an article as a whole or in part by visual appeal. The type of patent application applied for is determined by the applicant. If, after filing a patent application, an applicant discovers that the type of patent applied for does not meet his needs or does not meet the invention subject matter prescribed by the Patent Law, such as applying for a method invention in an utility model application, in this case, if the original patent application (hereinafter referred to as an original application in this section) that has obtained a filing date can be directly converted to an “different type” of patent application (hereinafter referred to as a conversion application in this section), which shares the same filing date of the original application, it will be rather convenient and beneficial for the patent applicant.

Because a conversion application shares the same filing date as the original application, in order to balance the interests of the applicant and the public, and to take into account the first-to-file principle and the stability of the pending rights, a converted patent application shall not extend beyond the scope of content disclosed in the description, claim(s), or drawing(s) of the original patent application as filed.

2.2 Requirements for Conversion of Application

2.2.1 Formal Requirement

For the formal requirements for conversion of application, such as “applicant for conversion of application,” “legal period for conversion of application,” “required documents and matters to be recorded,” and “regulations on repeated conversions,” please refer to Part 1 “Procedural Examination and Patent Rights Management,” Chapter 13 “Division and conversion of application,” 2. “Application for conversion of application.”

2.2.2 Substantial Requirement

- (1) When handling a converted application, if substantial examination is requested, it shall be examined in accordance with the patentability requirements of general patent applications.
- (2) Since the filing date of a converted patent application is the same as the filing date of the original application, a converted patent application shall not extend beyond the scope of content disclosed in the description, claim(s), or drawing(s) of the original patent application as filed. For the determination whether the converted application extends beyond the original scope, please refer to Chapter 6. If the description or drawings of the converted application exceeds the scope disclosed in the description, claim(s), or drawing(s) as filed, it shall be regarded as a ground for patent refusal and the applicant shall be notified to provide response by an Office Action.

A. 108.III

A. 132.III

2.3 Effect of Conversion of Application

- (1) The filing date of a converted patent application is the filing date of the original application.
- (2) Where the priority claim has been made, the applicant may claim priority for the converted patent application. The examination shall be based on the priority date as the reference date for the determination of patentability requirements.
- (3) For an original application that claims grace period, a converted application thereof may also claim the grace period.

2.4 Notes for Examination

If there is a need of substantial examination for a converted invention application, a request for substantive examination shall be made within three (3) years after the

filing date of the original application. If the three (3) year time period has lapsed, a request for substantive examination may be made within thirty (30) days after such request for conversion.

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