

10 Things You Need to Know about Malaysian Divisional Applications

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Just one might not be enough for what's needed. Often, not all aspects of an invention that the inventor wanted to protect could be covered by a single patent application. Some inventors even questioned why divisional applications are needed. You may or may not need a divisional application, but here are 10 things about Malaysian divisional applications worth noting.

1. What is a divisional patent application?

A divisional patent application, or simply, a divisional application, is a later-filed patent application that spawned from an earlier-filed patent application, called a parent application. A divisional application is entitled to the filing date and, where appropriate, the priority date of the parent application. In other words, it keeps the same filing and priority dates as the parent application. Under Malaysian patent law, a divisional application is generally the only allowed form of a continuation patent application.

2. What are the advantages?

Divisional applications allow the patent applicant to file one or more separate patent applications and to keep the priority rights from the parent application. Divisional applications are, at times, used as tools for maximizing patent protection for an invention or a group of related inventions.

They provide the needs to the applicants as well as the Examiners. When the Examiner determines that more than one invention is being claimed in a single patent application, the Examiner may request the applicant to elect a group of claims directed to one invention to be pursued in the original application. If the applicant is not content with limiting the scope of claims in the original application, the applicant may respond by electing one of the inventions and take action to protect the non-elected claims by filing one or more divisional applications for the non-elected inventions.

3. Why file a divisional application?

A divisional application could be filed either voluntarily by the patent applicant, while the parent application is pending, or in response to the Examiner's objection due to lack of unity of invention that may be raised in an examination report.

4. Deadline for filing divisional applications

A voluntary divisional application may be filed anytime from the filing of a patent application (known as the parent application) up to 3 months from the mailing date of the first examination report issued to that parent application. The first examination report may be a substantive examination adverse report where an office action is issued or may also be a substantive examination clear report in the case of a direct allowance without receiving any office action. It must be noted that the examination report in this context covers both normal and modified substantive examination reports.

If the first examination report is the substantive examination clear report, no voluntary divisional application can be filed after the 3-month deadline.

If the first examination report is the substantive examination adverse report, it is still possible to file voluntary divisional applications after the expiry of the 3-month deadline under an extension of time. Filing of divisional applications in this case is generally permitted as long as the parent application remains pending (i.e., not issued/granted, refused, abandoned or withdrawn), subject to the filing of the request for extension of time covering the period from the 3-month deadline until the filing date of the divisional application. If a divisional application is to be filed after the expiry of the 3-month deadline, the request for an extension of time will only be necessary at the time of filing the divisional application. That is to say, filing of the request for extension of time in advance is not required.

In the case that an objection of unity of invention is raised by the Examiner in the examination report, the deadline for filing a divisional application would be within 3 months from the date of mailing of the examination report containing that objection and this deadline is also extendible. It should be noted that if an extension of time is requested for filing the response to the examination report, it does not automatically extend the deadline for filing a divisional application. The request for extension of time will still be required at the time the divisional application is filed.

5. Further Divisional Applications

One or more divisional applications may be divided from a parent application. Divisional applications can also be chained by filing a first divisional application before a notice of grant is issued to the parent application, and filing a second divisional application before a notice of grant is issued to the first divisional application, and so on. The filing of the second divisional application originating from the first divisional application is possible even when the parent application is no longer pending.

6. Content of the Patent Specification

The description of a divisional application can be identical to or different from the description of the parent application but shall not contain anything not disclosed by the parent application. However, a divisional application may claim matter that was not claimed in the parent application from which the divisional application derives and may have claims directed to a different invention than that claimed in the parent application. The divisional application can also be pursued with claims having broader scope of protection than that of the parent application. Any new claims can be added to the divisional application as long as they are fully supported by the contents of the initial or parent application.

7. Formal Requirements

A complete specification must be filed at the time of filing the divisional application and a request for substantive examination must also be filed with the divisional application. A divisional application may be filed only for subject matter which does not go beyond the initial disclosure of the parent application.

8. Filing of the divisional application

A divisional application must name at least one inventor in common with the inventor(s) named in the parent application. Only the applicant(s) of the parent application can file a

divisional application and once the divisional application is filed, it can be assigned to another party independently.

9. Type of Examination

Under Malaysian patent practice, the type of examination that is requested at the time of filing a divisional application must be the same as that requested for the parent application. If the parent application has requested for modified examination, similarly the divisional application should also request for modified examination, but this will only be possible if a relevant foreign divisional patent has been granted. In the case where the relevant foreign divisional patent has not yet been granted, the divisional application may still be filed with a request for normal substantive examination at the time of filing the divisional application and with claims amended at a later date during the prosecution of the divisional application.

In cases where the examination request has not been filed for the parent application, it is advisable to defer filing of divisional application until the examination has been requested for the parent application.

10. Patent Protection Terms

A divisional application takes the same effective filing date as the parent application. The divisional application will have a maximum term expiring at the same time as the parent application, that is 20 years from the effective filing date of the divisional application.