

Q297

Divisional applications and double patenting

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I. Current law and practice

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

5. **Double patenting**

1) Is it possible for the same applicant to obtain more than one patent right for one invention?

☒ Yes

☐ No

6. **1) (continued)** Please add brief explanation

There are various options for the same applicant to obtain more than one patent right for one invention. Possible options are e.g. patents having the same priority date, also including patenting in Hungary via the PCT or European route in addition to the priority national route, two patents filed on the same day, utility model protection branched off from a national or a European patent application, national patent branched off from a national utility model application, and patents granted for parent and divisional applications.

7. **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

☐ No

8. **2) (continued)** Please add brief explanation

The same applicant can have the same claim scope protected by a national patent granted by the Hungarian Intellectual Property Office (HIPO) and by a European patent granted by the European Patent Office (EPO), validated in Hungary.

9. **3)** What are the criteria for assessing double patenting?

Double patenting is not prohibited in Hungary, therefore there is no assessment of double patenting.

10. **3 (continued)** Please add a brief explanation.

No answer provided.

11. **4)** For two patent rights to be considered to constitute double patenting, the scope of protection must be: please select one that applies from the below

No answer provided.

12. **4) (continued)** You may add a brief explanation.

There is no assessment of double patenting in Hungary.

13. **5)** Assessment of double patenting is made: you may select multiple

No answer provided.

14. **5) (continued)** You may add a brief explanation.

There is no assessment of double patenting in Hungary.

15. **6)** Are the criteria for assessing double patenting the same for patents and utility models?

No answer provided.

16. **6) (continued)** You may add a brief explanation.

There is no assessment of double patenting in Hungary.

17. **7)** If a patent application is deemed to constitute double patenting, what measures are available to resolve the issue? You may select multiple

No answer provided.

18. **7) (continued)** You may add a brief explanation.

There is no assessment of double patenting in Hungary.

19. **Divisional applications**

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

As stipulated by Art. 73 of the Hungarian Patent Act (act No. XXXIII of 1995 on the protection of inventions by patents), a person who has claimed patent protection for more than one invention in one application may divide the application until the date of the decision with respect to patent grant/rejection. The date of filing and any priority are maintained in the divisional application. Official fee is also to be paid within two months of the filing of the request.

20. **9)** What are the timelines for defining "pendency"?

"Pendency" timeline in the context of divisional applications starts with the filing date and ends on the date of the HIPO decision with respect to patent grant/rejection. Accordingly, an application remains pending up to and including the day on which the decision on grant or refusal is issued. However, it is no longer considered pending during the period for filing an appeal, nor during any appeal proceedings, if an appeal is filed.

21. **9) (continued)** You may add a brief explanation.

No answer provided.

22. **10)** Is there a limit on the number of divisional applications that can be filed from the same patent family?

☐ Yes

☒ No

23. **10) (continued)** You may add a brief explanation.

No answer provided.

24. **11)** Can a divisional application be filed based on another divisional application (cascading divisionals) or only based on the parent application?

☒ Yes

☐ No

25. **11) (continued)** You may add a brief explanation.

A divisional application can be filed based on another divisional application.

26. **12)** Can a divisional application be filed based on another divisional application when the parent application has already been allowed?

☒ Yes

☐ No

27. **12) (continued)** You may add a brief explanation.

A divisional application can be filed based on another divisional application when the parent application has already been allowed.

28. **13)** Are there any particular procedural requirements that the applicant has to fulfil (e.g., requirement to justify the legitimate need for division at filing, explanation of the relationship between the divisional and the parent, etc.)?

☐ Yes

☒ No

29. **13) (continued)** You may add a brief explanation.

There are no particular procedural requirements that the applicant has to fulfil for filing a divisional application.

30. **14)** Is prosecution history estoppel from parent applications binding on divisional applications?

☐ Yes

☒ No

31. **14) (continued)** You may add a brief explanation.

There is no prosecution history estoppel from parent applications binding on divisional applications. In this context, a special provision in Art 28(3) of the Act XXXVIII of 1991 on the protection of utility models stipulates as follows: In case both utility model and patent protections have been obtained for the same subject matter, a final decision in the invalidity proceedings of one of the protections shall be binding for the HIPO in invalidity proceedings of the other protection, to the extent of the findings of the decision.

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

No answer provided.

33. **16.** Are there any other procedural exceptions regarding divisionals?

☒ Yes

☐ No

34. **16) (continued)** You may add a brief explanation.

If the divisional application is filed after the publication of the parent application, the divisional application is not published but proceeds to search/examination.

35. **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

36. **17) (continued)** You may add a brief explanation.

In the Hungarian laws and case law there are no practices that are generally considered to be outside the scope of a legitimate use of the patent system (i.e., abusive) regarding divisional applications. However, there may be exceptional cases where abusive use of the patent system may be concluded based on provisions outside of the Hungarian IP laws, e.g. based on the general prohibition of abuse of rights stipulated in the Civil Code.

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

Please answer the questions of this Part II below.

37. **18)** According to the opinion of your Group, is your current law regarding double patenting adequate and/or sufficient?

☒ Yes

☐ No

38. **18) (continued)** Please explain your chosen view briefly

The Hungarian Group is of the view that any possible abuse in the context of double patenting may fall into one of the following two categories:

- enforcing redundant/overlapping patents, and
- maintaining uncertainty by means of redundant/cascaded pendency of patent applications for or around the same invention in the same jurisdiction.

In the light that a granted patent is and should be per se enforceable, without any respect to any other granted patent, it seems to be rather difficult to conclude any fair, justified and effective restriction in the patent law in the enforcement of redundant/overlapping patents. Applying provisions outside of the patent law, particularly the general prohibition of abuse of rights stipulated in the Civil Code, should be applicable for the exceptional cases of abusive use of the patent system in this respect.

The Hungarian Group would be in favour of facilitating second or further invalidation proceedings within a group of redundant/overlapping patents in a practical way, e.g. a final decision in the invalidity proceedings of a patent could be binding for the invalidity proceedings of the other patents within the group, to the extent of redundancy/overlap. Furthermore, the outcome of invalidation proceedings within a group should be considered in assessing requests for preliminary injunctions based on other patents within the group.

As to redundant/cascaded pendency the Hungarian Group notes that in the vast majority of cases it is a non-abusive strategy, like simultaneous pendency of a national application and a PCT or European application also covering the same country, so redundant/cascaded pendency is not to be prohibited generally. There seems to be no justification in discriminatively prohibiting particular types or a single type of redundant/cascaded pendency, like prohibiting redundant/cascaded pendency of divisional applications in the patent law. Again, applying provisions outside of the patent law, particularly the general prohibition of abuse of rights stipulated in the Civil Code, should be applicable for the exceptional cases of abusive use of the patent system in this respect. The Hungarian Group would be in favour of streamlining examination of divisional applications based on the findings of examination already carried out for the parent application.

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

The Hungarian Group is of the view that double patenting is not to be prohibited generally in patent laws. Provisions outside of the patent law should be applied for the exceptional cases of abusive use of the patent system.

40. **20)** According to the opinion of your Group, is your current law regarding divisional applications adequate and/or sufficient?

☐ Yes

☒ No

41. **20) (continued)** Please explain your chosen view briefly

In our view, while the current Hungarian provisions on divisional applications are generally clear and workable, the definition of pendency is relatively restrictive. In particular, where the HIPO issues a decision rejecting an application, it could be beneficial to allow the filing of a divisional application during at least the appeal period or even up to the appeal decision, if any. Allowing divisional filings within this additional timeframe would provide applicants with greater procedural flexibility, without unduly affecting legal certainty.

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

The Hungarian Group is of the view that divisional applications should be freely available, without any patent law restrictions. Provisions outside of the patent law should be applied for the exceptional cases of abusive use of the patent system.

43. **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?

As this Study Question is limited to patent-law aspects, no particular considerations/proposals are included here for provisions outside of the patent law that may be applied for the exceptional cases of abusive use of the patent system.

III) Proposals for harmonisation

Please answer the questions of this Part III below.

44. **Double patenting**

23) Do you consider that there is a need to have harmonization regarding issues involving double patenting?

☒ Yes

☐ No

45. **23) (continued)** Please add brief explanation

A consistent approach across jurisdictions would be desirable.

46. 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.

47. **24) (continued)** Please add brief explanation

A granted patent should be per se enforceable, without any respect to any other granted patent, so it seems to be rather difficult to conclude any fair, justified and effective restriction in the patent law in the enforcement of redundant/overlapping patents. Redundant/cascaded pendency is in almost all cases a non-abusive strategy, like simultaneous pendency of a national application and a PCT or European application also covering the same country, so redundant/cascaded pendency is not to be prohibited generally, either.

48. **25)** Irrespective of your answer to question 24) above, if it was 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

49. **25) (continued)** Please add brief explanation

Due to statutory, procedural and/or case law differences, there may be justified strategies in prosecuting patent applications both with a national body and a regional body for the same or substantially the same claim scope.

50. **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

51. **26) (continued)** Please add brief explanation

Due to statutory, procedural and/or case law differences, there may be justified strategies in having protection for the same or substantially the same claim scope through different "patent rights".

52. **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. One may select multiple answers

- ☒ a. a patent right and a utility model right?
- ☒ b. a patent right and a design patent right?
- ☒ c. a utility model right and a design patent right?
- ☒ d. a utility model right and a utility model right?
- ☒ e. a patent right and a patent right?
- ☐ f. other?

53. **27) (continued)** Please add brief explanation

Although a design (patent) with the same or substantially the same claim scope as a patent or a utility model is hardly conceivable, options a. to e. should not be generally prohibited. There may be justified strategies in having substantially the same claim scopes by means of parallel rights.

54. **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?
- ☐ b. identical or substantially identical?
- ☐ c. identical or substantially identical or non-obviously distinct?
- ☒ d. other?

55. **28) (continued)** Please add brief explanation

Identical, substantially identical or significantly overlapping scopes should all be considered to constitute double patenting, including one scope entirely encompassing the other.

56. **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

57. **29) (continued)** Please add brief explanation

Due to a large number of possible legal statuses, including lapsed but revivable patents and patent applications, no practical restrictions are conceivable.

58. **30)** Irrespective of your answer to question 29)) above, if such assessment was to be made: One may select multiple answers

- ☒ a. Should double patenting be assessed against granted rights?
- ☒ b. Should double patenting be assessed against published applications?
- ☒ c. Should double patenting be assessed only against rights that are in force (not lapsed or invalidated)?
- ☐ 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.)?
- ☐ e. Should other criteria apply?

59. **30) (continued)** Please add brief explanation

Answers are indicated for the case if such an assessment were to be made.

60. **31)** Should the criteria for assessing double patenting be the same for patents, utility models, and design patents?

- ☒ Yes
- ☐ No

61. **31) (continued)** Please add brief explanation

If such an assessment was to be made, none of the listed options should be discriminatively excluded.

62. **32)** If a patent application is deemed to constitute double patenting, what measures should be available to resolve the issue? One may select multiple answers

- ☒ a. Amend the claims of the patent application?
- ☒ b. Abandon the earlier patent right?
- ☒ c. Terminal disclaimer?
- ☒ d. Other?

63. **32) (continued)** Please add brief explanation

Answers are indicated for the case if such an assessment were to be made. The Hungarian Group is not in favour of such an assessment, and is of the view that provisions outside of the patent law should be applied to the exceptional cases of abusive use of the patent system.

64. **Divisional applications**

33) Should Resolution Q193 be considered sufficient for addressing harmonization on divisional applications?

- ☒ Yes
- ☐ No

65. **33) (continued)** Please add brief explanation

Q193 is a good common ground for harmonization regarding divisional applications.

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

N/A

67. **35)** With reference to Resolution Q193, item 3, according to which "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? One may select multiple answers

- ☒ a. Should pendency include time preceding the grant of the original parent application?
- ☐ b. Should pendency include time preceding first instance opposition decision of the original parent application?
- ☐ c. Should pendency include time preceding decision on opposition appeal of the original parent application?
- ☐ d. Other?

68. **35) (continued)** Please add brief explanation

There is a large number of jurisdictions without opposition proceedings. Including opposition into pendency would open the door also towards invalidity proceedings, which would be unjustified. The "time preceding the grant" should also include eventual appeals.

69. **36)** Should there be a limit on the number of divisional applications?

- ☐ Yes
- ☒ No

70. **36) (continued)** You may add a brief explanation

Any such limit should not be included into patent laws, but provisions outside of the patent law, particularly the general prohibition of abuse of rights stipulated in the Civil Code, should be applicable for the exceptional cases of abusive use of the patent system in this respect.

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

- ☐ a. Only based on another divisional application
- ☐ b. Only based on the parent application
- ☒ c. Based on divisional application or parent application

72. **37) (continued)** You may add a brief explanation

There may be justified strategies in each option of c.

73. **38)** Should a divisional application be filed based on another divisional application when the parent application has already been allowed?

- ☒ Yes
- ☐ No

74. **38) (continued)** You may add a brief explanation

There may be justified strategies in this option as well.

75. **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

☐ a. Yes

☒ a. No

☒ b. Yes

☐ b. No

76. **39) (continued)** You may add a brief explanation

No answer provided.

77. **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

78. **40) (continued)** You may add a brief explanation

No answer provided.

79. **41)** Should applicants be required to justify the legitimate need for division at the time of filing?

☐ Yes

☒ No

80. **41) (continued)** You may add a brief explanation

No answer provided.

81. **42)** Should a family of parent and divisional applications be examined by the same examiner?

☒ Yes

☐ No

82. **42) (continued)** You may add a brief explanation

No answer provided.

83. **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

84. **43) (continued)** You may add a brief explanation

No answer provided.

85. **44)** Should prosecution history estoppel from parent applications be binding on divisional applications?

☒ Yes

☐ No

86. **45)** Should the prosecution period of divisional applications be limited?

☐ Yes

☒ No

87. **45) (continued)** You may add a brief explanation

The Hungarian Group confirms Resolution 8) of Q193, according to which in order to reduce the delaying effects of cascading divisional applications resulting in legal uncertainty, patent granting authorities should expedite the publication of, examination of and decision on divisional applications.

88. **46)** Should delayed examination be allowed for divisional applications?

☐ Yes

☒ No

89. **46) (continued)** You may add a brief explanation

No answer provided.

90. **47)** Should amendments to the claims of divisional applications be restricted?

☐ Yes

☒ No

91. **47) (continued)** You may add a brief explanation

No answer provided.

92. **48)** Should the same criteria of assessing double patenting in the case of divisional applications apply than 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

93. **48) (continued)** You may add a brief explanation

No answer provided.

94. **49)** Should filing of divisional applications be considered categorically exempt from being considered an abuse of IP system?

☐ Yes

☒ No

95. **49) (continued)** You may add a brief explanation.

No answer provided.

96. **50)** In what kind of situations, if any, should 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 finding.

The abusive character of the enforcement of divisional applications should be assessed on a case-by-case basis, based on respective provisions outside of the patent law, particularly the general prohibition of abuse of rights stipulated in the Civil Code. General evidencing provisions should apply.

97. **50)** 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?

No answer provided.

98. **50) (continued)** You may add a brief explanation.

No answer provided.

99. **51)** If any, what kind of remedies should be available if 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.

Provisions outside of the patent law, particularly the general prohibition of abuse of rights stipulated in the Civil Code should apply also for remedies of abusive enforcement.

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

Pharmaceutical industry