

Understanding Chinese Voluntary Divisional Application Patent Practice

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For many parts of the world, a voluntary divisional application (known as a continuation application in the U.S.) may be filed at any time during the pendency of any parent application. The claims in the voluntary divisional application must be supported by the original specification and cannot introduce any new matter. Applicants often file one patent application at a time, and upon allowance, file a voluntary divisional application to pursue alternative subject matter disclosed in the original application. In this manner, serial applications can be filed until the patentable subject matter disclosed in the original application is exhausted or the application expires (subject to any term limitations, which in the U.S. is 20 years from the filing date of the earliest non-provisional priority application).

In certain jurisdictions, including China, voluntary divisional application practice departs from this standard. In China, voluntary divisional applications can only be filed during pendency of the first-filed Chinese parent application. Once the first-filed Chinese parent application issues or is abandoned, voluntary divisional applications can no longer be filed. In other words, a voluntary Chinese divisional application can be filed up until any the following time periods, in which the first-filed Chinese parent application is considered to be pending:

- 1) within 2 months from the deemed date of receipt of a notice of allowance,
- 2) within 3 months from the deemed date of receipt of a notice of final rejection,
- 3) during reexamination proceedings, or
- 4) during the administrative litigation proceedings such as an appeal of a reexamination decision to the Beijing IP Court.

Once the first-filed Chinese parent application is no longer pending, but a divisional application in the family is still pending, another divisional application can still be filed but is limited in scope to claims previously restricted under a lack of unity objection. What this means is that before the first-filed Chinese parent application loses pendency, at least all potential independent claims should be filed in one divisional application to encourage the examiner to issue a lack of unity objection. Thereafter, serial divisional applications may be filed based on claims that were subject to the lack of unity objection. Hence, an important strategy consideration in China is to file all potentially viable claims before the first-filed Chinese parent application loses pendency.

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