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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

Yes, in Dutch practice it is possible to obtain more than one patent right for the same and for one invention. The former case is possible due to the lack of examination in the current Dutch patent system, such that two or more patents can be registered for the same invention. The latter case is applicable to divisional applications, where the subject matter should not be the same for the original and divisional applications. Article 10 DPA stipulates that when a granted Dutch patent claims the priority of an earlier Dutch patent application, the earlier patent application shall have no legal effect insofar as it relates to the same invention as the first-mentioned patent. There is no clear indication that the Dutch court will deviate from the European case law.

In the end it is the District Court of The Hague that rules whether two patent rights constitute the same subject matter. Appeal is possible at the Court of Appeal in The Hague and, further, limited appeal at the Supreme Court of The Netherlands.

The Dutch Patent Act (DPA) is to be completely reformed in the coming years. In the reformed DPA patent applications will be examined before grant. Therefore, the former case of registered patents for the same invention will likely not be possible anymore. Article 10 DPA will be maintained in the reformed DPA.

8

The reformed DPA creates the possibility to file objections at the Dutch Patent Office, similar to opposition at the European Patent Office, to the grant of a Dutch patent. That decision can be appealed at the District Court of The Hague, and further appealed at the Dutch Supreme Court on points of law.

In both cases, Article 28 DPA stipulates that divisional applications can be filed, where the divisional application should not extend beyond the contents of the patent application as originally filed.

Dutch case law holds the view that claims do not necessarily have to be identical to relate to the same invention.

The European approach is that identical claims define the same invention, but obtaining more than one patent right for one invention is possible, as far as the subject matter of these patent rights is not the same. Whether a divisional application and the parent patent have identical claims is at first decided in examination during prosecution.

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

No. In the current DPA, Article 77 DPA stipulates that European patents validated for The Netherlands overrule a Dutch patent related to the same invention and granted to the same inventor or their successor in right with the same filing or priority date, as far as it protects the same invention. Currently, a designation of The Netherlands in a PCT application will be regarded as a designation for a European patent, see current Article 18 DPA.

In the reformed DPA, this Article 77 DPA will disappear. In addition, the possibility to obtain a national Dutch patent via a PCT application will be added in an amended Article 18 DPA.

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

According to the Dutch practice, the criteria for assessing double patenting are whether two or more patents describe the same inventive concept, although other terms are used.

According to the European practice, the criteria for assessing double patenting are whether two or more patents in the name of the same patentees define the same subject-matter. Partial overlap between two or more patents should not result in a double patenting objection.

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

a. Identical

b. Identical or substantially identical

c. Identical or substantially identical or non-obviously distinct

d. Other

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

A. Divisional patent applications of European patent rights cannot have identical claims in relation to the parent application or parent patent. G4/19 Nestlé: A European patent application can be refused under A. 97(2) EPC jo. A. 125 EPC if it claims the same subject matter as a European patent which has been granted to the same applicant and does not form part of the prior art for the patent application under examination.

T0936/04 (24 April 2008): double patenting is not a ground for opposition, but the divisions of the EPO have the discretion to raise the objection of double patenting in opposition proceedings.

B. For the Netherlands several situations occur. In *Medinol v Cordis*, BIE 2005/59, the District Court of the Hague ruled that it is not possible to enforce more than one patent right that protects the same invention against one and the same party, not even in subsequent litigation. However, it is

possible, when one or more of those patent rights have been invalidated, to enforce the other patent right that is still in force. It is also possible to invoke one of the granted patents that belongs to the same family against another party.

Another situation is the *Teckru/Duyvis* appeal decision from 14 October 2014. There, the Court of Appeal declared the Dutch part of a European patent invalid. The patentee *Duyvis* however, also still held the Dutch priority patent for this European patent. *Teckru* argued that this priority patent lost its legal effect based on Article 77 DPA since it protected the same invention (see also under 5 below). *Duyvis* thereupon changed the claims of the Dutch patent, but the Court of Appeal considered that these changes did not take away the fact that the Dutch patent protected the same invention as the European patent and declared that the Dutch patent lost its legal effect.

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

- a. against granted rights
- b. against published applications
- c. only against rights that are in force (not lapsed or invalidated)
- d. only between the same type of rights (e.g., patent application to patents, utility model application to utility models, etc.)
- e. also other criteria apply (please specify)

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

With respect to European patent applications, it is noted that a European patent application may be refused under A. 97(2) EPC jo. A. 125 EPC if the European patent application claims the same subject-matter as a European patent that has been granted to the same applicant and does not form part of the prior art for the patent application under examination.

In case of a corresponding European patent application that is in the name of the same applicant and does not form part of the prior art for the European patent application, the examiner of the EPO most likely will not refuse the European patent application. However, the examiner will make a remark regarding a possible risk of double patenting.

In the Netherlands, there is no assessment as there is a registration system. Therefore, assessment of double patenting will or may be done during enforcement of, for example, a Dutch and European patent. In line with A. 77 DPA, the Dutch patent will lose its legal effect, which legal effects will not be revived when the European patent is nullified at a later stage.

Under the reformed DPA, it is possible to file an objection against a Dutch patent within 9 months after grant of the respective Dutch patent, comparable with the opposition procedure of the EPO. An appeal against the decision of the Dutch patent office will be handled by the Dutch court in The Hague as administrative court.

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.

not applicable

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

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

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

For a European patent application deemed to constitute double patenting, the issue may be resolved by amending the claims by incorporating a feature from the description. On the other hand, the European patent causing the double patenting issue, for example, may be limited or invalidated during opposition, whereafter the double patenting issue likely will be withdrawn.

In the Netherlands, a patent application will not be examined so a double patenting objection does not have to be resolved. However, a deed of partial withdrawal may be filed with respect to a Dutch patent, thereby amending the claims so as to achieve that it does not protect the same invention. This may be used to resolve the issue with respect to double patenting.

Under the reformed DPA, Dutch patent applications will undergo substantive examination, in line with the European examination procedure.

19. **Divisional applications**

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

A divisional application can be filed where the original application is still pending. The subject-matter of the divisional patent application must be directly and unambiguously derivable from the parent application as filed. This criterion applies to both national Dutch patent applications and European patent applications, Article 28 DPA and Article 76 EPC.

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

For The Netherlands, the parent application is considered pending until grant or final refusal. Please note the granted patent is generally published about two months after grant. Article 28 DPA stipulates that a divisional application may be filed till the parent application is registered into the patent register, provided that the Applicant has a time period of at least 2 months to file a divisional application after receipt of a search report in relation to the parent application. Article 31 DPA stipulates that a divisional application will be registered into the patent register as soon as possible after filing thereof, but not before registration of the parent application.

For the European Patent Office, the parent application is considered pending until the publication of the grant or, after refusal in first instance, until the time limit for filing a notice of appeal has lapsed. If a notice of appeal has been filed against the refusal in first instance, the application is considered to be pending until the appeal proceedings have been concluded.

For those in despair, there are some cases with the European Patent Office, in which the Applicant filed an appeal against a Decision to Grant issued by the European Patent Office, after approval of the text for grant, to keep a patent application pending so that a divisional application may be filed, see for 13

example J 1/24. It is emphasized that this strategy is not supported by all divisions of the European Patent Office and, thus, is not recommended.

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, Dutch law and European Patent Convention do not impose a numerical limit on divisional applications.

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.

Yes, a divisional application of any generation can serve as the "earlier application" for a further divisional. This applies to both the Dutch and European practice.

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.

Yes, as long as the direct parent (the divisional from which the new divisional is split) is still pending, a further divisional can be filed even if the original grandparent application has been granted or refused. This applies to both the Dutch and European practice.

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.

No, according to the Dutch law and European Patent Convention, there is no requirement to justify the legitimate need for division at filing. The applicant simply needs to file within the prescribed time limits, request a search and pay the prescribed fees.

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

Yes

No

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

No, divisional applications are procedurally independent from parent applications. Facts, evidence, and submissions made in parent proceedings are not automatically part of divisional proceedings. At the moment, this applies mainly to European divisional applications, as the Netherlands has a registration system, but will likely be applicable to Dutch divisional applications under the reformed DPA.

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

Yes

No

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

Yes

No

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

No, divisional applications are treated in the same manner as any application and are subject to the same requirements.

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.

Yes, while Dutch patent law does not explicitly define abusive practices, the courts have addressed such issues. Multiple patenting by the same applicant has been considered contrary to the patent law system (The Hague District Court 31 March 2004, ECLI:NL:RBSGR:2004:AT7693, Medinol/Cordis). The European Commission's Teva Copaxone decision (2024) flagged abuse of the divisional system as a strategy to extend patent exclusivity. However, the standards for what constitutes abuse remain uncertain under current Dutch patent law and competition law.

## 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

Yes. According to the opinion of the group, the current law regarding double patenting is adequate, although it allows patentees to obtain more than one patent for the same invention. An issue with respect to double patenting, usually, is solved during enforcement.

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

The main principle is that one inventor can only have one patent for one specific invention. Policy rationales associated with this are several, such as

- striking the right balance between promoting innovation and protecting the public domain;
- ensuring legal certainty – third parties should know as early as reasonably possible whether divisional applications are granted and what the subject matter (wording of the claims) will be;
- avoidance of subsequent, multiple proceedings relating to the same invention;
- promoting actual inventions rather than (obvious) variants developed for the mere purpose of prolonging the lifetime of an earlier invention (avoiding 'evergreening').

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

Yes, as the Applicant has a large degree of freedom with respect to the timing of filing and the contents of the divisional application. Moreover, in view of the Dutch registration system, no examination takes place – voluntary divisional applications are hardly ever filed.

The group, however, does not consider the law with respect to the timing of filing and the contents of the divisional applications at the EPO adequate and/or sufficient. The great freedom with respect to the timing of filing and contents of divisional applications combined with the many procedural options that the applicant has and the strict interpretation of the notion 'the same invention', allow for misuse of divisional applications, which is not sufficiently nor adequately curtailed.

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

The policy rationale for regulations at the EPO should be that the system of divisional applications as it currently functions at the EPO is vulnerable for misuse.

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?

Not currently. However, the Dutch Patent Act is being revised. The registration system will be abandoned, and the examination system that existed in the Netherlands earlier will be reinstated. If that happens, it is quite possible that the same problems with certain divisional applications will also occur in the Netherlands.

### 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

Harmonization as such may be beneficial for patent holders and for every party being confronted or working with the patent system.

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

Under the reformed DPA, an applicant may obtain a Dutch patent right and a European patent right valid for the Netherlands. This will allow Dutch patentees to choose between the Dutch court or the Unified Patent Court, for example, in case of infringement proceedings.  
The group considers it relevant that measures are provided for protecting the legal certainty of third parties, or to prevent a patentee from initiating subsequent proceedings against a third party based on a Dutch and European patent, respectively. An example of such a measure is Art. 29 of the Brussels I Bis regulation.

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

Yes. Under the reformed DPA, an applicant may obtain a Dutch patent right and a European patent right valid for the Netherlands. This allows Dutch patentees to choose between the Dutch court or the Unified Patent Court, for example, in case of infringement proceedings.

The group considers it relevant that measures are provided for protecting the legal certainty of third parties, or to prevent a patentee from initiating subsequent proceedings against a third party based on a Dutch and European patent, respectively. An example of such measure is Art. 29 of the Brussels I Bis regulation.

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

No. To introduce the reformed DPA, an online consultation has been conducted, the results of which indicate that there is no necessity for utility patents. There are already two parallel patent systems available in the Netherlands, which are considered sufficient.  
The group considers that a design patent is intended for protecting the unique, decorative appearance or visual characteristics of a functional product, such as its shape, configuration, or surface decoration, and, by definition, cannot have the same claim scope as a patent.

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

With respect to answers B and C, it is repeated that the group considers that a design patent is intended for protecting the unique, decorative appearance or visual characteristics of a functional product, such as its shape, configuration, or surface decoration, and, by definition, cannot have the same claim scope as a patent.

With respect to answer e, it is repeated that under the reformed DPA, an applicant may obtain a Dutch patent right and a European patent right valid for the Netherlands. This allows Dutch patentees to choose between the Dutch court or the Unified Patent Court, for example, in case of infringement proceedings. Again, measures should be provided for protecting the legal certainty of third parties. This is also applicable to answers A and D.

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

The group is in favor of the criteria that for two patent rights to be considered to constitute double patenting, the scope of protection should be directed at the 'the same invention'.

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

There should be no restrictions on the legal status of the "other patent", as the scope of a patent application may be amended substantively during examination. This may result in resolving the potential issue of double patenting. Further, only patent rights that are in force should be considered.

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

The group considers that double patenting should be assessed against rights that are equivalent according to the Paris Convention.

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

Yes, as long as it is about the same subject-matter, with respect to patents and utility models.

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

The measures are in line with the current Dutch and European practice.

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

No. Q193 is not considered to be sufficient, as an anti-abuse measure is lacking in Resolution Q193.

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.

An anti-abuse measure should be subject of additional harmonization, but the anti-abuse measure should not be in the form of a time limit. A competence should be assigned to the examiner, opposition division and/or Board of Appeal to refuse patent applications or patents in cases of abuse.

There was some discussion within the group about how the anti-abuse measure should be formulated. It is considered that the anti-abuse measure should not be formulated in too much detail, as it is very difficult, or perhaps even impossible, to foresee every situation that may be considered as abuse of the system.

Although there are diverging opinions, the group agreed upon mentioning an exemplary anti-abuse measure, which involves prohibiting a patentee to withdraw its patent during opposition or appeal proceedings at the EPO when one or more divisional applications have been filed, or to oblige the Opposition Division or Board of Appeal to issue a decision in such case. The withdrawal is after all done to avoid setting a precedent that may be problematic for the pending divisional applications. That is undesirable; it is important that a written decision be issued. The written decisions are precisely there to enable the EPO, courts and third parties to understand what was claimed and why it is not patentable.

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

It is not desired to allow a patentee to file divisional applications during opposition and appeal proceedings, as this makes abuse of filing divisional applications easier. This has a negative effect on the legal certainty for third parties. During opposition procedures, any issues should be solved by filing auxiliary requests.

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

- Yes
- No

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

No. The group considers a limit on the number of divisional applications not desired. However, anti-abuse measures, for example, procedural rules, should be in place to prevent abuse.

A part of the group is of the opinion that filing of third- or fourth-generation divisional applications should at least be limited to situations in which an examiner has raised a non-unity objection. As a result, voluntarily filing of third or fourth generation divisional applications would no longer be possible. It is emphasized that there are diverging opinions within the group regarding this aspect

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

The group considers that there may be good reasons to base a divisional application on another divisional application, so it should be possible to file a divisional application based on a divisional application or parent application.

The group did note that third- and fourth-generation divisional applications are very rare. They are generally only seen in situations where an applicant intends to keep divisional applications hanging over the market for as long as possible and they are often filed at a very late stage, which suggests there is a situation of abuse. Limiting the filing of divisional applications to first and second generations for voluntary divisional applications – i.e. with an exception for non-unity cases – might be in place. It should be noted that there was a difference of opinion within the group about this measure.

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

Yes. The group is of the opinion that the option of filing a further divisional application should not be dependent on the status of the original parent application.

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

Yes, as the divisional application should be examined on its own merits and should meet all requirements of the relevant law.

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

The group considers that the applicant should not be required to justify the legitimate need for a divisional application at the time of filing. Instead, an anti-abuse measure is proposed, which may involve assigning a competence to the examiner, opposition division or Board of Appeal to ask for such an explanation where the examiner, upon review considers that the application appears abusive.

A part of the group is of the opinion that aspects of the prosecution, opposition or appeal procedure should be adjusted by introducing limitations with respect to filing divisional applications to prevent abuse, because a general anti-abuse measure does not necessarily prevent abuse. An example of such limitation is considered to allow an applicant to file a third- or fourth-generation divisional application only when a non-unity objection is raised during examination. It is emphasized that there are diverging opinions within the group with respect to this matter.

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

The group considers it not required that a family of parent and divisional applications is examined by the same examiner. After all, the outcome of prosecution should not be dependent on the examiner. The parent and divisional applications should be examined individually.

However, parent and divisional applications being examined by different examiners may result in a disadvantageous manner in contradictory decisions of the EPO. This may persuade an applicant to withdraw a divisional application and to file another divisional application, when the divisional application is likely to be refused. This may encourage abuse of the system.

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

The group considers that the relevant requirement is that the subject matter of the divisional application should be covered by the parent application. Thus, the applicant should not be required to explain the relationship between the claimed technical solution in the divisional claims and the parent claims.

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

No. The group considers that the prosecution period of divisional applications should not be limited, as there might be good reasons for the prosecution period taking longer. The applicant, however, must be able to provide reasoning for the prosecution period taking longer, in order to prevent abuse of the terms/deadlines, provided that the extended prosecution period is due to the applicant.

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

Yes

No

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

The group believes that delayed examination should be allowed for divisional applications, as divisional applications should be examined on their own merits. The applicant, however, must be able to provide reasoning for the delay, in order to prevent abuse of the terms/deadlines, provided that the delay is due to the applicant.

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

Yes

No

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

The group believes that amendments to the claims of divisional applications should not be restricted, as the divisional application should be examined on its own merits.

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

The same criteria for assessing double patenting in the case of divisional applications should apply as for other patents, as the divisional application should be examined on its own merits.

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.

The group considers that the filing divisional applications should not be considered categorically exempt from being considered an abuse of the IP system. Abuse of the IP system should be determined on basis of the proposed anti-abuse measure and/or one of the other proposed measures.

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 group emphasizes that it is not possible to provide an exhaustive list of situations in which enforcement of divisional applications should be considered as abusive, and that only examples can be provided. No individual divisional application practices can be marked as abusive as such, since an abusive nature will generally depend on the circumstances of the case.

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?

Yes

No

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

There are other practices that could be considered to be outside the scope of a legitimate use of the patent system (i.e., abusive) regarding divisional applications. An example of such other practices could be the use of what would be considered regular measures when used individually or incidentally, but in combination and repetitively could, under circumstances, constitute anti-competitive behaviour. However, each situation should be considered, taking the circumstances of the case into account, and ruling a use abusive should be applied with caution.

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.

The group considers that the following remedies should be available if the enforcement of divisional applications is considered as abusive: dismissal of the claim of the patentee; and award of costs without being bound to the standard rate.

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

The questionnaire and its answers have been shared and discussed within the Dutch Group, which includes representatives from large and small/medium-sized companies. This includes steel manufacturing.