

Preparing for the Zombie Divisional Apocalypse!

If you have filed a patent application in New Zealand under the new Act (i.e. the 2013 Act) and are considering filing a divisional application at some stage before acceptance of the parent, you may not be able to request examination of the divisional! The divisional application would effectively be a zombie application – dead but still walking.

Whilst divisional applications can be filed at any time before acceptance of the parent application, due to the relevant provisions and accompanying regulations of the new Act, it is only possible to request examination of that divisional application within 5 years of the parent's complete filing date (i.e. the PCT filing date for national phase entry applications). Thus, from about **March 2018**, the 5 year bar to requesting examination will start to kick in for new Act patent applications that entered the national phase in New Zealand shortly after the new Act came into force. You need to review your portfolio with this issue in mind, and request instructions from clients earlier than you might otherwise have expected...

IPTA is liaising with IPONZ to remove this barrier, which we consider to unfairly restrict an applicant's genuine attempt to prosecute its application before IPONZ, but you should not assume that the current situation will change.

There are some other issues that you need to be aware of with New Zealand divisional applications, specifically:

- *Substantive Response* - divisional applications need to be filed within the initial response period set after issuance of an examination report, and without reliance on any extension of time, otherwise a "substantive response" must be filed on the parent in order to validly file the divisional;
- *Self-collision (poisonous priority)* - divisional applications may result in self-collision with its parent application where claims of the parent and/or divisional contain added subject matter not present in the original priority/provisional filing, and therefore any added subject matter should be quarantined in separate claims for both parent and divisional applications; and
- *Double patenting* - increased strictness - parent/divisional claims must not cover "substantially the same matter" and this is also a requirement at the time of filing the divisional.

Read on for further information.

Old Act Practice (1953 Act)

Old Act applications cover any applications that were directly filed or entered the national phase in New Zealand prior to 13 September 2014 (including any divisional applications thereof filed after 13 September 2014). Issuance of a first examination report sets a response deadline for an old Act application of 15 months plus 3-month extension (retrospectively applied).

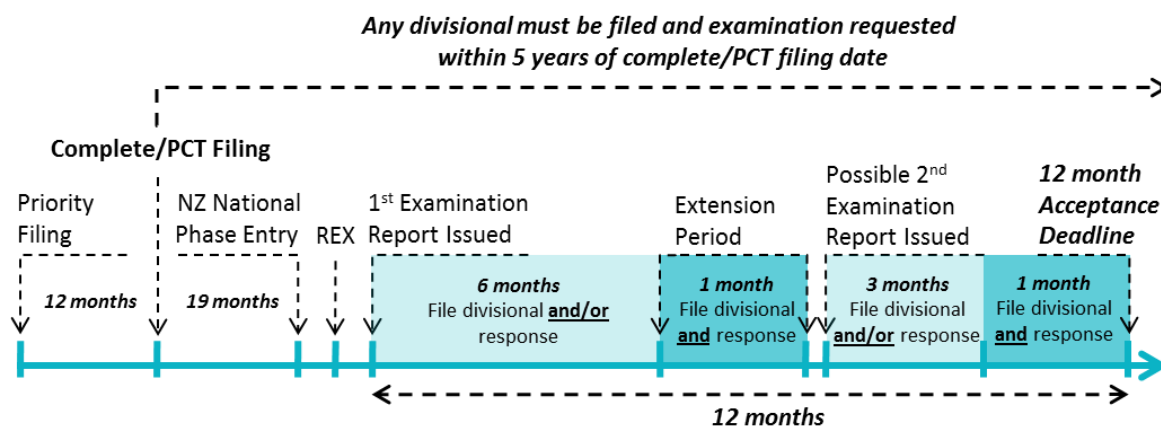
An application may proceed automatically to acceptance when filing a response and therefore divisional applications should be filed at the same time as filing a response on a parent application. However, where a divisional application is filed in the 3-month extension period, there is no requirement to file any substantive response on the parent application, which now contrasts with new Act practices.

New Act Practice (2013 Act)

New Act applications cover any applications that were directly filed or entered the national phase in New Zealand after 13 September 2014. Issuance of a first examination report now sets a 12-month final acceptance deadline in which a shorter 6-month response deadline is provided within the 12-month acceptance deadline. The 6-month response deadline can be retrospectively extended by up to 1-month.

A divisional application can be filed without a “substantive response” during the 6 month response period. However, if a divisional application is filed in the 1-month extension period then a “substantive response” must also be filed on the parent. The “substantive response” requires objections raised by the Examiner to be addressed either by amendment and/or by fair and substantial submissions/argument.

Any divisional application also needs to be filed at the time of filing any response since it is standard practice to withdraw the postponement of acceptance at the time of filing the response. Should objections be maintained and a 2nd examination report issue, a new response deadline is provided (usually 3 months). The same divisional filing protocols apply for any subsequent examination report and response deadline, noting that any further extension period ends after 1 month or at the 12 month acceptance deadline, whichever is earlier.



It is also important to be aware that divisional applications may result in self-collision (poisonous priority) with its parent application where the claims of the parent and/or divisional contain added subject matter not present in the original priority/provisional filing. Separate claims should be provided in the parent and divisional applications to quarantine any added subject matter from original priority entitled subject matter.

The self-collision (poisonous priority) issues arise because ‘whole of contents’ novelty operates in combination with added subject matter to disentitle a claim to its earliest priority date and in New Zealand each claim can have a single priority date only. If you are aware of any added subject matter claimed at the time of filing a parent or divisional application, then you should consider appropriately amending to quarantine claims to address any self-collision issues that may be triggered when filing a divisional application.