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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

WORKING GROUP ON REFORM OF THE PATENT COOPERATION TREATY (PCT)

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DIVISIONAL APPLICATIONS UNDER THE PCT

Document prepared by the International Bureau

BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was a proposal to allow for divisional applications to be filed under the PCT.

2. The Working Group's discussions on this proposal are summarized in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 50 and 51, as follows:

> "*Divisional Applications*
>
> "50. Several delegations supported the proposal that further consideration should be given to providing under the PCT for the filing of international applications as divisional applications of earlier international applications, with a view to taking the greatest possible advantage of the centralized processing offered by the international phase, particularly in cases where there had been a finding of lack of unity of invention. However, while there was no objection in principle to such a possibility, it was recalled that problems had been identified when such a proposal had been made in the past, in

particular with regard to the added complexity involved, to the difficulty in according an international filing date in accordance with both Article 11 and the Paris Convention, and to the need for compliance with time limits for international search and international preliminary examination.

"51. It was agreed that the International Bureau, in cooperation with the Delegation of the Netherlands, should further consider the matter and that any proposal which emerged would be considered by the Working Group at a future session."

3. The International Bureau and the Delegation of the Netherlands have consulted on the matter since the third session of the Working Group. The present document was prepared by the International Bureau in the light of those consultations, but it does not reflect an agreed position.

Divisional applications under the Paris Convention

4. Article 4G of the Paris Convention for the Protection of Industrial Property ("Paris Convention") requires countries of the International Union for the Protection of Industrial Property ("Paris Union") to provide for the filing of divisional applications, as follows:

"[4G](1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

"(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized."

Divisional applications under the 1968–1970 drafts of the PCT

5. While, at present, the PCT does not provide for the filing, during the international phase, of divisional applications, it is to be noted that the 1968 draft of the PCT contained provisions in both the draft Treaty and the draft Regulations under the Treaty which would have allowed the applicant, in the case of lack of unity of invention, at his option, to either (i) restrict the claims, or (ii) to pay additional fees, or divide the application, or both (see document PCT/III/5 (Draft Treaty), Articles 17 (Procedure Before the Searching Authority) and 34 (Procedure Before the Preliminary Examining Authority), and document PCT/III/6 (Draft Regulations under the PCT), Rules 37 (Lack of Unity of Invention (Search)) and 62 (Lack of Unity of Invention (Preliminary Examination)). Excerpts of the 1968 draft of Articles 11 (Filing Date and Effects of the International Application), 17 and 34, as well as the 1968 draft of Rules 37 and 62, are reproduced for ease of reference in Annex IV to this document.

6. However, in the 1969 draft of the PCT those provisions were deleted, and the final text of the PCT as signed at the Washington Diplomatic Conference in June 1970 does not contain any provisions concerning the division of international application during the international phase. The records of the Washington Diplomatic Conference on the PCT (1970) do not state any reasons for the deletion in the 1969 draft of the provisions concerning divisional

applications as contained in the 1968 draft. Document PCT/DC/3 (Main Differences between the 1968 and 1969 Drafts), paragraph 31, simply states the following:

> "31. *Division of the international application.* As opposed to the 1968 Draft (Articles 17(3)(a)(ii) and 34(3), Rules 37.5, 37.7 and 62), the International Searching Authority and the International Preliminary Examining Authority cannot request, nor can the applicant volunteer, under the 1969 Draft, division of the international application in the international phase. Of course, the designated or elected Offices may require division if the international application does not comply, in their opinion, with the requirement of unity of invention as defined in Rule 13. Furthermore, the applicant may voluntarily divide his application before any national Office to the extent permitted by the national law of that Office."

7. Thus, as indicated above, there is at present no provision in the PCT which would allow for the filing, during the international phase, of divisional applications based on an "initial international application." If the international application does not, in the view of a designated/elected Office, comply with the requirement of unity of invention as defined in Rule 13 in that it contains more than one inventions (compare Article 4G(1) of the Paris Convention), the applicant may, before each designated/elected Office, be required, under the national law applicable by that Office, to restrict the claims to a single invention or to file a separate divisional application in respect of each additional invention contained in the international application.

8. Obviously, the introduction of a procedure allowing the applicant to file an international application as a divisional application of an initial international application ("divisional international application") would greatly simplify, from the applicant's perspective, the processing of the international application where the International Searching Authority or the International Preliminary Examining Authority makes a finding of lack of unity of invention, replacing the need to individually file, after national phase entry, divisional (national) applications with each designated or elected Office concerned. Similar considerations apply where applicants wish to file one or more divisional international applications on their own initiative (as provided for under Article 4G(2) of the Paris Convention).

9. On the other hand, it needs to be remembered that the present system already provides for a procedure which enables the applicant, in the case of a finding of lack of unity of invention by the International Searching and Preliminary Examining Authority, to obtain an international search report and an international preliminary examination report in respect of all parts of the international application, no matter how many inventions are contained in it, against the payment of additional (search and preliminary examination) fees. The introduction of a further procedure which would allow the applicant to divide the initial international application, during the international phase, by filing divisional international applications, would not necessarily be desirable if the result was to add further complexity to the overall system, as might be the case if complicated amendments to the Regulations were needed.

DIVISION OF INTERNATIONAL APPLICATIONS DURING THE INTERNATIONAL PHASE

10. The Annexes to this document set out three separate possibilities in the form of preliminary proposals, each of which is designed to permit the division of international applications by taking steps during the international phase of the PCT procedure. It is hoped

that consideration of those proposals will facilitate discussion of possible future work on the matter. The possibilities are the following:

(i) *possible revision of the PCT (Treaty)* in order to provide expressly for the filing of divisional international applications;

(ii) *amendments of the Regulations* in order to provide expressly for the filing of divisional international applications;

(iii) *amendments of the Regulations* to provide a new procedure allowing for the *"internal" division* of international applications during the international phase, to be followed by a simplified way of proceeding with the divided parts of the international application as separate divisional applications in the national phase.

POSSIBLE REVISION OF THE PCT (TREATY)

11. Annex I contains a proposal for a new Article 17*bis* of the Treaty which would expressly provide for the filing of divisional international applications. Consequential amendments of other Articles would also be required, such as Articles 2 (Definitions), 8 (Claiming Priority) and 11 (Filing Date and Effects of International Application), as well as other Articles concerning the international search procedure, international publication and communication to designated Offices, the international preliminary examination procedure, and national phase entry.

DIVISIONAL INTERNATIONAL APPLICATIONS

12. Annex II contains proposals for amendment of the Regulations which would allow the applicant to divide an initial international application into separate divisional international applications during the international phase. Those proposals are based on the premise that the Treaty as currently worded would permit the Regulations to be amended by the Assembly to provide for the division of international applications in order to comply with Article 4G of the Paris Convention, noting that, under PCT Article 62(1), any PCT Contracting State must be a member of the Paris Union and thus must apply all of the mandatory provisions of the Paris Convention, including the obligation under Article 4G of that Convention. On that view, amendment of the PCT Regulations to provide for the division of international applications, including the preservation of the (filing) date of the initial international application as the (filing) date of a divisional international application, would appear to be possible under Article 58(1)(iii) in that it would provide Rules concerning "details useful in the implementation of the Treaty" including Article 62(1). If, contrary to that premise, the Working Group considers that the Treaty as currently worded would not permit such amendment of the Regulations, it would not appear possible to provide for the filing of divisional international applications until the Treaty itself is revised in this respect.

Filing of Divisional International Applications

13. *Possibility of filing divisional international applications:* Proposed Rule 30*bis*.1 would give effect to the general provisions of Article 4G(2) of the Paris Convention relating to the filing of divisional international applications. It is proposed that divisional international applications be able to be filed either where there has been a finding of lack of unity of invention by the International Searching Authority or where the applicant acts on his own initiative.

14. While certain special requirements would apply for divisional international applications with regard to filing, international search and international preliminary examination (see below), every divisional international application would be treated as a "regular" international application (separate and distinct from the initial international application from which it was divided) in respect of which fees would have to be paid, an international search report would be established, international publication would take place and, if so requested by the applicant by making a demand, international preliminary examination would be carried out.

15. *International filing date and right of priority:* In accordance with Article 4G(2) of the Paris Convention, every divisional international application would preserve as its international filing date the international filing date of the initial international application and its right of priority, if any, provided that the conditions set out in subparagraphs (a) and (b) are met.

(a) *Subject matter and disclosure:* It is implicit in Article 4G of the Paris Convention, in order for a divisional international application to preserve as its international filing date the international filing date of the initial international application, that the subject matter contained in the divisional international application must have been wholly contained within the initial international application as filed. In other words, using the terminology of PCT Rule 66.2(a)(iv), the disclosure in the divisional international application may not go beyond the disclosure in the initial international application on its international filing date. Note that the approach suggested here is different from the approach chosen in the 1968 draft Regulations under the PCT (see draft Rule 37.5(a) in Annex IV to this document).

(b) *Time limit:* Since divisional international applications will mainly (although not necessarily) be filed in response to a finding by the International Searching Authority of lack of unity of invention and the invitation to pay additional (search) fees, it appears necessary to allow the applicant sufficient time to consider (i) the results of the international search, particularly if one or more additional fees referred to in Article 17(3)(a) had been paid, and (ii) the result of any protest procedure under Rule 40.2(c), before deciding whether to file divisional international applications. Since these considerations are also relevant to making a demand, it is proposed that the time limit for filing a divisional international application should be the same as the time limit for making a demand under Rule 54*bis*.1 in respect of the initial application, that is, three months from the date of receipt of the international search report on, or 22 months from the priority date of, the initial international application, whichever expires earlier.

16. In addition to the matters just outlined, which are dealt with in proposed Rule 30*bis*, a number of other matters would need to be dealt with in amendments of the Regulations if it is decided to proceed further in this direction. Some of those other matters are outlined in the following paragraphs.

Status of Initial International Application

17. It may be desirable to clarify expressly that the initial international application must be pending when a divisional international application divided from it is filed.

Priority claims

18. Any time limit which is computed from the priority date (see Article 2(xi)) would be computed from the priority date of the divisional international application. A divisional international application would retain the right of priority of the initial international application, without the need to formally claim it in the divisional international application. The making of priority claims may, however, need to be regulated in the specific context of the PCT procedure, for example:

(i) by expressly providing that priority claims in the initial international application would be considered to be made in the divisional international application;

(ii) to deal with cases where priority claims are added or corrected under Rule 26*bis*.1 or withdrawn under Rule 90*bis*.3.

Competent receiving Office

19. Some specific provision may be needed as to the Offices which would be competent to receive divisional international applications. For example, should the matter be left to existing Rule 19, as for any international application, to govern the matter according to the nationality and residence of the applicant(s), or would it be preferable to somehow provide for filing of divisional international applications with the International Searching Authority or International Preliminary Examining Authority which had made a finding of lack of unity of invention?

Designations

20. The filing of a request in respect of a divisional international application should presumably constitute the designation of all Contracting States that are designated in the initial international application on the date of receipt of the divisional international application by the receiving Office. It should not be possible, by filing a divisional international application, to add the designation of a Contracting State which was not designated in the initial international application at the time of filing the divisional international application.

Request Form

21. The request form would need to indicate the divisional international application as such and identify the initial international application from which the divisional international application derives (see Rules 4.1 and 4.11).

Language

22. It may be desirable to require that a divisional international application be filed in a language in which international search can be carried out and in which international publication can take place.

International Search

23. A number of specific provisions may need to be made in connection with the international search procedure for divisional international applications, including the matters outlined in subparagraphs (a) to (c).

(a) *Competent International Searching Authority:* In order to minimize duplication of work, it may be desirable to provide that that the International Searching Authority which is to carry out, or has carried out, the international search on the initial international application should also be the sole competent International Searching Authority for any divisional international application.

(b) *Refund of search fees:* Rule 16.3 provides for the (partial) refund of international search fee where an international application claims the priority of an earlier international application which has been the subject of an international search. For consistency with this provision, the international search fee paid in connection with a divisional international application should be partially refunded where the international search report on that divisional international application can be wholly or partly based on the results of the international search carried out on the initial international application, due account being taken of any payment by the applicant of additional fees referred to in Article 17(3)(a)).

(c) *Remarks on possible "double patenting":* In order to assist designated and elected Offices as well as applicants, the written opinion by the International Searching Authority (and hence the international preliminary report on patentability under Chapter I) could include appropriate observations where the claims of a divisional international application overlap with the claims in the initial international application or another divisional international application deriving therefrom.

International Publication

24. The general rule under PCT Article 21 is that an international application is published promptly after the expiration of 18 months from the priority date. That would not be possible for a divisional international application in cases where it is filed after that period (see paragraph 15(b), above). It would appear to be consistent with Article 21(2)(a) to provide for a divisional international application to be published promptly after it had been filed, but not before the expiration of 18 months from the priority date (a similar approach is taken under some national and regional laws, such as the European Patent Convention).

International Preliminary Examination

25. A number of specific provisions may need to be made in connection with the international preliminary examination procedure for divisional international applications, dealing, for example, with the matters set out in subparagraphs (a) to (c).

(a) *Time limit for making a demand:* A demand in respect of a divisional international application would, in general, have to be submitted within the applicable time limit under Rule 54*bis*.1 in respect of the initial international application if the deadline for the international preliminary examination report of 28 months from the priority date is to be met. That is, in practice, the demand would generally need to be filed at the same time as the divisional international application. Special consideration might be given to cases where the initial international application is subsequently withdrawn.

(b) *Competent International Preliminary Examining Authority:* In order to minimize duplication of work, it may be desirable to provide that that the International Preliminary Examining Authority which is to carry out, or has carried out, the international search on the initial international application should also be the sole competent International Preliminary Examining Authority for any divisional international application.

(c) *Remarks on "double patenting":* In order to assist designated and elected Offices as well as applicants, the international preliminary report on patentability under Chapter II could include appropriate observations where the claims of a divisional international application overlap with the claims in the initial international application or another divisional international application deriving therefrom.

"INTERNAL" DIVISION OF INTERNATIONAL APPLICATIONS DURING THE INTERNATIONAL PHASE

26. Annex III contains a proposal which would give effect to a procedure that could be introduced by way of amendment of the Regulations, pending a future revision of the Treaty as proposed in Annex I, allowing for the "internal" division of international applications during the international phase under Chapter II, to be followed by a simplified way of proceeding with the divided parts of the international application as separate divisional applications in the national phase.

27. The proposal is based on the fact that the present system enables the applicant, in the case of a finding of lack of unity of invention by the International Searching Authority or International Preliminary Examining Authority, to obtain an international search report or international preliminary examination report in respect of all parts of the international application, no matter how many inventions are contained in it, provided that additional (search and preliminary examination) fees are paid.

28. Under the proposal, instead filing one or more divisional international applications during the international phase, the applicant would be permitted, after having made a demand for international preliminary examination, to amend the claims, the description and the drawings of an international application under Article 34(2)(b) by dividing the corpus of the international application internally into two or more separate parts, each containing the description, claims and drawings of the international application corresponding to a divisional application which would proceed as such into the national phase.

29. Following such an internal division of the international application, the international preliminary report on patentability under Chapter II would also be "internally" divided into corresponding different parts, provided that all additional search and preliminary examination fees have been paid.

30. Following such an internal division during the international preliminary examination procedure, the applicant would have "ready-made" divisional applications with which to proceed into the national phase. While that result could be achieved by proceeding into the national phase with the internally divided initial international application, to be followed by its division separately during the procedure before each national Office, it would be simpler to enable the initial international application to proceed into the national phase, from the outset, as separate divisional applications. Each such divisional application would be associated with the "divided" international preliminary report on patentability under Chapter II.

31. The Working Group is invited to consider the proposals contained in this document.

[Annex I follows]

ANNEX I

POSSIBLE REVISION OF THE PCT (TREATY):

DIVISIONAL INTERNATIONAL APPLICATIONS

Article 17*bis*

Divisional International Applications

An international application ("initial international application") may, as provided in the Regulations, be divided into one or more divisional applications ("divisional international applications") in accordance with Article 4G of the Paris Convention for the Protection of Industrial Property. A divisional international application shall, notwithstanding Article 11, preserve as its international filing date the international filing date of the initial international application and the benefit of the right of priority, if any.

[COMMENT: See paragraph 11 of the Introduction to this document. Modeled after Article 4G of the Paris Convention. Consequential amendments of other Articles may be required, such as Articles 2 (Definitions), 8 (Claiming Priority) and 11 (Filing Date and Effects of International Application), and Articles concerning the international search procedure, international publication and communication to designated Offices, the international preliminary examination procedure and national phase entry.]

[Annex II follows]

ANNEX II

POSSIBLE AMENDMENTS OF THE REGULATIONS:

DIVISIONAL INTERNATIONAL APPLICATIONS

Rule 30*bis*

Divisional International Applications

30*bis*.1 *Filing of Divisional International Applications*

(a) The applicant may, subject to these Regulations, divide the international application ("initial international application") by filing with the competent receiving Office one or more divisional applications as international applications ("divisional international applications").

(b) A divisional international application may be filed where the International Searching Authority has made a finding of lack of unity of invention in relation to the initial international application or on the initiative of the applicant.

[COMMENT: See Article 4G of the Paris Convention.]

30*bis*.2 *International Filing Date; Right of Priority*

A divisional international application shall preserve as its international filing date the international filing date of the initial international application and the benefit of the right of priority, if any, as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property, provided that:

[Rule 30bis.2, continued]

[COMMENT: See paragraph 15 of the Introduction to this document and Article 4G of the Paris Convention.]

(i) the divisional international application is received by the receiving Office before the expiration of the applicable time limit under Rule 54*bis*.1 for making a demand in respect of the initial international application;

[COMMENT: See paragraphs 15(b) and 19 of the Introduction to this document.]

(ii) the initial international application is pending on the date of receipt of the divisional international application by the receiving Office;

[COMMENT: See paragraph 17 of the Introduction to this document.]

(iii) the disclosure in the divisional international application does not go beyond the disclosure in the initial international application as filed.

[COMMENT: See paragraph 15(a) of the Introduction to this document.]

[Annex III follows]

ANNEX III

POSSIBLE AMENDMENTS OF THE REGULATIONS:

"INTERNAL" DIVISION OF INTERNATIONAL APPLICATIONS
DURING THE INTERNATIONAL PHASE

TABLE OF CONTENTS

Rule 66[1]

Procedure Before the

International Preliminary Examining Authority

66.1 [No change]

66.2 *First Written Opinion of the International Preliminary Examining Authority*

(a) If the International Preliminary Examining Authority

(i) to (v) [No change]

(vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination in respect of that claim, ~~or~~

(vii) considers that a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, or

[1] The "present" text shown is that of Rule 66 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

[Rule 66.2(a), continued]

(viii) considers that, where an amendment which internally divides the international application into two or more separate parts has been submitted in accordance with Rule 68.6, one or more of the claims contained in one of those parts defines matter for which protection is sought in another of those parts,

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

[COMMENT: See paragraph 25(c) of the Introduction to this document.]

(b) to (e) [No change]

66.3 to 66.9 [No change]

Rule 68

Lack of Unity of Invention (International Preliminary Examination)

68.1 to 68.5 [No change]

68.6 *Internal Division of International Application*

[Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied and chooses to invite the applicant under Rule 68.2, or on the applicant's own initiative,] the applicant may internally divide the international application by submitting, in accordance with Rule 66.1(b), an amendment under Article 34 which divides the description, claims and drawings of the international application into two or more separate parts as follows:

(i) a main part containing the description, drawings and claims relating to the main invention;

(ii) one or more additional parts, each containing the description, claims and drawings relating to an invention additional to the main invention.

[COMMENT: See paragraphs 26 to 30 of the Introduction to this document.]

Rule 70[2]

The International Preliminary Examination Report

70.1 to 70.11 [No change]

70.12 *Mention of Certain Defects and Other Matters*

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) [No change]

(ii) the international application calls for any of the observations referred to in Rule 66.2(a)(v) or (viii), it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;

[COMMENT: See paragraph 25(c) of the Introduction to this document and Rule 66.2 as proposed to be amended, above.]

(iii) and (iv) [No change]

[2] The "present" text shown is that of Rule 70 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

70.13 ~~*Remarks Concerning*~~ *Unity of Invention*

(a) If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a)), or on the main invention only (Article 34(3)(c)), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chose not to invite the applicant to restrict the claims or to pay additional fees.

(b) Where the applicant has:

(i) submitted an amendment which divides the description, claims and drawings of the international application into a main part and one or more additional parts in accordance with Rule 68.6; and

(ii) paid additional fees for the international preliminary examination;

the report shall also be divided into a main part and as many additional parts as additional fees for the international preliminary examination have been paid; both the main part and each additional part shall comply with the requirements of Rule 70.

[COMMENT: See paragraphs 26 to 30 of the Introduction to this document.]

70.14 to 70.17 [No change]

Rule 78*bis*

Internally Divided International Application to Proceed as Separate Divisional Applications Before Elected Offices

78*bis*.1 *Separate Divisional Applications*

Where the applicant has, under Rule 68.6, internally divided the international application ("initial international application") into two or more separate parts, the applicant may choose to proceed with [any of] those separate parts as separate applications so far as the procedure before any elected Office is concerned, specifying that those separate applications are to be considered as divisional applications of the initial international application, and the elected Office shall proceed accordingly.

[COMMENT: See paragraph 30 of the Introduction to this document.]

[Annex IV follows]

ANNEX IV

EXCERPTS FROM THE
1968 DRAFT TREATY (PCT) AND THE
1968 DRAFT REGULATIONS UNDER THE PCT

Article 11
Filing Date and Effects of the International Application

(1) The Receiving Office shall accord as the international filing date the date of receipt of the international application, provided that, at the time of receipt, that Office has found that:

(i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the Receiving Office,

(ii) the application is in the prescribed language,

(iii) the subject of the application is not obviously outside the purview of this Treaty as defined in the Regulations, and

(iv) at the time of receipt, the application contained at least the following elements:

(a) an indication that the application is intended as an international application,

(b) the name of the applicant,

(c) a part which on the face of it appears to be a description,

(d) a part which on the face of it appears to be a claim or claims.

(2) Any international application fulfilling the requirements of paragraph (1) shall have the effect of a regular national application in each designated State as of the international filing date.

(3) Any international application fulfilling the requirements listed in items (i) to (iv) of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

Article 17
Procedure Before the Searching Authority

(1) […]

(2) […]

(3)(a) If, in the opinion of the Searching Authority, the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant, at his option:

(i) to restrict the claims, or

(ii) depending on the invitation of the Searching Authority, to pay additional fees, or divide the application, or both.

(b) […]

Article 34
Procedure Before the Preliminary Examining Authority

(1) […]

(2) […]

(3) If, in the opinion of the Preliminary Examining Authority, the international application does not comply with the requirement of unity of invention as set forth in the Regulations, the said Authority may invite the applicant, at the latter's option, either to restrict the claims or to divide the application so as to comply with the requirement.

(4) […]

Rule 37
Lack of Unity of Invention (Search)

37.1 *Invitation to Restrict, Divide or Pay*

(a) The invitation to restrict the claims or to divide the application provided for in Article 17(3)(a) shall specify at least one possibility of restriction or division which, in the opinion of the Searching Authority, would be in compliance with the applicable requirements.

(b) […]

37.2 […]

37.3 *Time limit*

The time limit provided for in Article 17(3)(b) shall be fixed, in each case, according to the circumstances of the case, by the Searching Authority; it shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

37.4 […]

37.5 *Procedure in the Case of Dividing the Application*

(a) If the applicant chooses to divide the application, neither the description nor the drawings may be modified. They will remain the same for the parent application (that is, the international application as restricted) and the divisional applications.

(b) For the parent application, the applicant shall be required to specify the claims maintained or to file restricted claims, and to submit a new abstract when necessary.

(c) For each divisional application, the applicant shall be required to file a request, a claim or claims, and an abstract. The receiving Office shall, itself, attach to those papers a copy of the application in its original form, and the description and drawings (if any) thereof shall also be the description and drawings of each divisional application. The request of each divisional application shall identify the original application by its international application number and, where less than the totality of the description is relevant for the divisional application, a separate statement, submitted at the same time as the request, shall identify those portions of the description which are relevant.

(d) Each divisional application shall be treated as a new, independent international application, except that:

(i) the date of actual receipt of any divisional application by the receiving Office shall be certified by that Office on the record copy and on the search copy of such application;

(ii) the international filing date of the original application shall also be the international filing date of the divisional application, provided that the latter was filed with the receiving Office within the time limit fixed in Rule 37.3, and to the extent that it contains no new matter.

(e) If the parent application or any divisional application does not comply with the requirement of unity of invention, the Searching Authority shall proceed as provided in Article 17(3((b).

37.6 […]

37.7 *Voluntary Division*

(a) Subject to Rule 62.4, the applicant may divide the application on his own initiative any time before the expiration of the 16th month from the priority date. If the division takes place after the search report has been established, the communication of the search report and any publication thereof shall state that fact.

(b) The procedure provided for in Rule 37.5 shall apply also in the case of voluntary division.

Rule 62
Lack of Unity of Invention (Preliminary Examination)

62.1 *No Invitation to Restrict or Divide*

Where the Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to divide the application, it shall establish the preliminary examination report, subject to Article 34(4)(b), in respect of the entire application, but shall indicate, in the said report, that, in its opinion, the requirement of unity of invention is not fulfilled and shall briefly indicate the reasons for this opinion.

62.2 *Invitation to Restrict or Divide*

Where the Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at the latter's option, to restrict the claims or to divide the application, it shall specify at least one possibility of restriction or division which, in the opinion of the Preliminary Examining Authority, would be in compliance with the applicable requirement. It shall, at the same time, fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

62.3 *Procedure in the Case of Division*

If the applicant chooses to divide the application, the procedure provided for in Rule 37.5 shall apply with the exception of paragraph (e) of that Rule.

62.3 *Voluntary Division*

(a) The applicant may divide the international application on his own initiative any time prior to the beginning of the preliminary examination but in no case after the expiration of the 16th month from the priority date.

(b) The procedure provided for in Rule 37.5, except paragraph (e) of that Rule, shall apply also in the case of voluntary division effected under paragraph (a).

[End of Annex IV and of document]