

CHAPTER 18**S22C DIVISIONAL APPLICATIONS****INDEX**

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INTRODUCTION

- 18.1 This section of the act allows applicants to make separate applications for design/s that have been divided out from an original application (the parent). Designs can be divided out as a result of an amendment to the name of the article, the monopoly statement or the representations. The parent case file must be consulted when considering whether S22C applies.

A divisional application (the child) must be made before the parent is either registered, lapsed or refused. The priority date of the child will be the same as that of the parent application.

Details of the parent application number should appear on the form 1 of the child application and not from a reference in correspondence in either the parent or child case files (Regulation 5, Schedule 1).

EXCLUDED BY AMENDMENT

- 18.2 Before an application under S22C can be made, the design which is the subject of the child application, must have been excluded by amendment under S22B from the parent application.

POSSIBLE OBJECTIONS REGARDING MULTIPLE DESIGNS

- 18.3 Most common practice is for multiple designs to be shown in the representations. The name of the article and the monopoly statement may also implicitly disclose further designs.

Representations, the name of the article and the monopoly statement should always be considered in conjunction with one another when considering if more than one article or design is shown or implied.

Remember, the article(s) or design(s) shown in the child application(s) must have been disclosed in the parent.

The ways of dividing out multiple designs are discussed below.

NAME OF ARTICLE

- 18.4 The name of the article should always name the article that has been shown. (eg) The article shown in the representations and the name for the article is a pen and cap, which can be one article. (Please refer to S4 of the act - article ("means a part of such an article if made separately")). However, the examiner should take the objection that the representations and name suggest more than one article.

The applicant may choose to either divide one article out of the application or describe the article as one article. A suitable name in this case would be "pen with cap".

If the applicant decides to divide out one of the articles from the application, the name of the article in the child application should then read "pen" or "cap".

"And" implies more than one article, where "with" implies one article.

STATEMENT OF MONOPOLY

- 18.5 When a monopoly statement makes a claim for shape and configuration only, and, shape, configuration, pattern and ornamentation have all been shown on the article in the representations, a Separate application can be made. The Separate application can only be made if pattern and ornamentation have been deleted from the monopoly statement in the parent. The child application could claim a monopoly in the pattern and ornamentation only.

Remember, that all four features were in essence disclosed in the parent.

In the reverse, if only shape and configuration was shown and claimed and no pattern and ornamentation. The applicant could not divide out and make a Separate application under S22C. Pattern and ornamentation could not be added to the design of the child application, because it was not in essence disclosed in the parent.

The examiner should also be aware that child applications can be made, where there has been part of the design or article disclaimed. Each case should be considered individually.

When an article has been shown such as in an exploded view. The examiner should take an objection that more than one article is shown. A disclaimer to the individual pieces should be made. This will avoid any confusion over there being more than one article protected.

REPRESENTATIONS AND DESCRIPTIONS

- 18.6 By reading the descriptions which sometimes accompany representations, the examiner may find that there is more than one embodiment of the design. This information should be checked against the representations lodged.

Sometimes it is necessary to compare all views very carefully. It is not always obvious from the perspective views that more than one design or article has been lodged.

Exploded views should be labelled accordingly and a disclaimer added to the monopoly statement, to avoid any confusion over there being more than one design shown and protected.

If the examiner, at any time feels that there is more than one design or article shown in the application, an objection should be raised. The applicant should clarify any doubt, amend the application and/or divide out.

TIME FRAMES

- 18.7 A child application must be made before its immediate parent is either registered, lapsed or refused. Separate renewal fees must be paid for each application. The term of registration will be the same as the parent or grandparent.

DIVISIONALS OF DIVISIONALS

- 18.8 It is possible to have divisionals of divisionals regardless of the status of the grandparent application. An application can be lodged at any time prior to registration, lapsing or refusal of its immediate parent application. The priority date and deemed date of lodgement of the child application will correspond to the grandparent application, S22C(2). S22C imposes no special constraints on the identity of the parent. The parent should have once included the design which is the subject of its child application/s.

In short, divisionals of divisionals are possible. As long as, at the time of lodgement of the child, the immediate parent is not registered, lapsed or refused. The priority date and term of the registration will be that of the grandparent application.

When a design has been excluded by amendment, does the design in the child application have to be identical?

- 18.9 Yes. Theoretically, to claim priority, the design should be identical to the design that was originally lodged. However, very minor changes may be accepted. These changes can only be as large as those allowed by S22B. (ie) Where the changes do not increase or change the scope of the application.

CAN REPRESENTATIONS BE TRANSFERRED FROM ONE APPLICATION TO ANOTHER?

- 18.10 Yes, as long the applicant has requested in writing that the office does so, and
- 1) they have given the reasons why,
 - 2) the applications are not registered,
 - 3) the designs in each application are identical,
 - 4) the perforated application no. is amended to the new application no.
 - 5) a note is made on both files that the representations have been transferred.

COMBINATION OF CLAIMS S49, S22C AND S25D

- 18.11 It is possible to claim any combination of the above claims. For further details please refer to S25D ADDITIONAL APPLICATIONS Chapter 19.

18.11.1 CAN A DIVISIONAL APPLICATION CLAIM A DIFFERENT CONVENTION PRIORITY TO THAT OF THE PARENT?

Yes it can. In some instances the priority date could be earlier or later than that of the parents. The authority on this is *Johnson & Johnson Companies, Inc.* Unreported.

In effect - the child application has its own convention priority date, while it also has divisional status.

There are overall requirements that need to be considered at examination;

- 1) all designs, convention documents and details must have been lodged in the parent application, and
- 2) that the designs were lodged within the 6 month convention period, &
- 3) once the child application has been made; the application form must make a claim under Sec 22c and state its convention priority details, as well.

Time limits and disclosure of the designs have to be checked carefully.

PROCEDURES**18.12** When an examiner receives an application and a S22C claim has been made, the following should be considered;

- 1) Desadmin enquiry screen will give the examiner the current status of the parent. (eg) Registration no. and the date of registration. (See Time frames 18.7).
- 2) The examiner will need the parent file to consider the S22C claim (see 18.2 to 18.6 above). If the parent case file is not available, the case should be put on search or requested from file storage.

The S22C claim cannot be considered without the parent file because it must be established that the subject of the child application was deleted by amendment from the parent.

- 3) To be certain that an amendment was made on the parent, you need to check that:

For representations,

- 1) a request in writing, to delete a design, was made by the applicant or their agent before or after examination,
- 2) the informal folder of the parent does contain representations that show the article or design which has now become the subject of the child,

- 3) the correspondence file, has the proposal and date that the amendment was requested,
- 4) the examining officers report (amendment sheet) to see what amendments were actioned,
- 5) the desadmin history record to see if there is a record of the amendment.

For the name of the article,

- 1) a request in writing, to delete a design, was made by the applicant or their agent before or after examination,
- 2) the correspondence file, has the proposal and date that the amendment was requested,
- 3) the examining officers report (amendment sheet) to show what amendments were actioned,
- 4) desadmin enquiry screen for the name of the article.

For the monopoly statement,

- 1) a request in writing, to delete a design, was made by the applicant or their agent before or after examination,
- 2) the correspondence file, has the proposal and date that the amendment was requested,
- 3) the examining officers report (amendment sheet) to see what amendments were actioned,
- 4) desadmin monopoly statement screen to check the monopoly statement.

18.13 If the applicant is in fact entitled to make a S22C claim, the other formality checks and search can be done. If the applicant is not entitled to claim S22C then an objection should be raised outlining the reasons why.

If the child application still shows more than one design, another objection should be raised. Request that the applicant make Separate applications for the designs that are to be divided out of the child application. (see 18.8).

- 18.15 The parent or grandparent case files should always be presented with the child to the supervising examiner.
- 18.16 When the applicant has responded and their submission has been considered, the examiner should either;
- 1) raise appropriate objections in a further report, or
 - 2) clear the application, if and when all objections that were raised have been overcome.
- 18.17 To clear the application for registration the appropriate amendments to the name of the article, the monopoly statement or the representations (according to the examiners objection) should be made. This is done by:
- 1) amending the case file,
 - 2) recording the appropriate actions on the amendment sheet,
 - 3) amending the data base on desadmin.
 - 4) The examiner should check and/or enter that the S22C details have been captured onto the desadmin data base.
- 18.18 When all the above procedures have been completed, the application should be submitted to the supervising examiner, so that it can be checked and cleared for registration.