

## Regulation 82: ~~Claims overlap between parent & divisional applications~~ Parent and divisional claims “for substantially the same matter”

This guideline outlines IPONZ’s practice on ~~claims overlap between applications~~ parent and divisional claims “for substantially the same matter” under [regulation 82](#).

### Regulation 82

- ~~1. Regulation 82 prohibits the Commissioner from accepting an application which includes claims for substantially the same matter as that already accepted for a divisional or parent application (of the same applicant).~~

~~It reads:~~

#### **82 Acceptance of complete specification**

The requirements prescribed for the purpose of [section 74\(1\)\(b\)](#) of the Act are—

(a) to pay any fee and penalty that has become due under the Act or these regulations; and

(b) in the case of a divisional application, if the Commissioner has accepted the complete specification relating to a parent application, that the divisional application must not include a claim or claims for substantially the same matter as accepted in the parent application; and

(c) in the case of a parent application, if the Commissioner has accepted the complete specification relating to a divisional application, that the parent application must not include a claim or claims for substantially the same matter as accepted in the divisional application.

### Introduction

1. Regulation 82 prohibits the Commissioner from accepting an application which includes claims for substantially the same matter as that already accepted in a divisional or parent application. In this guideline we refer to this as “prohibited overlap” or claims “for substantially the same matter”.
2. Claims for substantially the same matter in a parent and divisional is prohibited because there shouldn't be two patents granted to the same person which claim the same invention. This is undesirable and there is no justification for two patents being granted for the same invention.<sup>1</sup>

3. The prohibition of parent and divisional overlap has a long history. The Patents Regulations 1954 similarly prohibited overlap.<sup>2</sup>
4. Practice regarding claims “for substantially the same matter” in a parent and divisional examined under the Patents Act 2013 is informed by *Oracle International Corporation* [2021] NZIPOPAT 5 (“*Oracle*”)<sup>3</sup> and *Ganymed Pharmaceuticals GmbH et al.* [2021] NZIPOPAT 6 (“*Ganymed*”)<sup>1</sup>.

### **When regulation 82 applies**

- ~~2.5.~~ Regulations 52 and 82 were amended on 5 April 2018<sup>4</sup>; ~~4~~ This was to clarify that overlap is an issue for considered during examination of an application, does not need to be free of prohibited overlap at filing. The practice in relation to considering overlap is otherwise unchanged between regulations 52 and 82.
- ~~6.~~ *Ganymed Pharmaceuticals GmbH*<sup>2</sup> clarified that applications Applications submitted prior to 5 April 2018 will be considered under regulation 52. Applications submitted on or after this date will be considered under regulation 82.<sup>5</sup>
- ~~3.7.~~ For brevity this guideline refers to regulation 82, this This may be used interchangeably with regulation 52 where applicable.

### **What applications regulation 82 applies to**

8. Regulation 82 only refers to a parent and divisional application. The intent of this regulation however is to prevent two or more patents being granted for the same invention<sup>1</sup>.
9. IPONZ considers that regulation 82 is applicable to any application within the same divisional patent family. That is, any application that is linked by a divisional chain back to a single New Zealand parent application.
10. Therefore, examiners will consider any application that is within the same divisional patent family. This includes grandparent, parent, sibling and child applications of the application under examination.
11. A formal objection will only be raised when there is prohibited overlap with an application that has been accepted.
12. An informal notice may be raised to make the applicant aware of prohibited overlap with other applications that have not yet been accepted.
13. Formal objections and informal notices may be raised against multiple applications within a patent family when appropriate.
14. It’s in the applicant’s best interests to address and resolve objections and informal notices regarding prohibited overlap as soon as reasonably possible. If an informal notice isn’t

addressed and both applications are approaching acceptance, IPONZ will not allow both applications to proceed to acceptance.

### **Commissioner has no discretion to allow claims of substantially same matter**

- 4.—It's clear from the wording of regulation 82, namely the use of the words '*must not*', that the Commissioner has no discretion to allow claims in a parent and divisional application (or vice versa) to cover '*substantially the same matter*'. This was confirmed in *Oracle International Corporation*<sup>3</sup>.

### **Rationale for precluding claims for substantially the same matter**

- 5.—The rationale for prohibiting claims to substantially same the matter was considered in *Abbott Laboratories* [2003] NZIPOPAT 16. The Assistant Commissioner cited the UK decision in *Dreyfus*<sup>4</sup> in which the Solicitor General hearing the case described the following public interest reasons why an applicant should not be able to claim the same matter in multiple applications:

“... The Patents Acts do not appear to contemplate and provide for a situation such as has arisen in this case and I infer from the absence of provisions that it was not intended to allow one man to have two grants for the same invention. Why should he? If two, why not three? The result would be to cause confusion in matters which ought to be as clear as possible. A patent confers a monopoly. There is no sense in saying twice over that a man is to have a monopoly in respect of one and the same invention. I am of the same opinion as the *Assistant Comptroller*, that to do so would lead to considerable public inconvenience and possibly to public damage. The *Assistant Comptroller* was right, in my judgment, and I dismiss the appeal.”

- 6.—This approach was subsequently codified in a series of further UK cases considering duplication of claiming.
- 7.—While in *Abbott Laboratories*<sup>5</sup> the Assistant Commissioner considered the effect of regulation 23(2) of the Patents regulations 1954, IPONZ considers the same rationale equally applies to regulation 82 of the Patents Regulations 2014. The difference in terminology between the respective regulations ('*neither ... includes a claim for matter claimed in the other*' vs '*not include a claim or claims for substantially the same matter*') are not such that they give rise to different considerations.

### **Meaning of 'substantially the same matter'**

15. Substantially the same is defined as “essentially the same”, “the same but for minor unimportant details”, and/or “not substantially different”.<sup>6</sup>
16. This means that claims may have some differences while still being to substantially the same matter.
- 8.—From *Oracle*, paragraph 9, “‘substantially the same’ means ‘essentially the same’, ‘the same but for minor unimportant details’, and/or ‘not substantially different’”. Having regard to the plain meaning of the words, the claims of the respective applications must be ‘for

*substantially the same matter*' to trigger regulation 82. It is not enough that the respective claims have some overlap. They must overlap to a significant extent to be for *substantially the same matter* such that they could invoke the public interest concerns described in *Dreyfus*.

9. The requirement of regulation 82 is that a claim of a divisional application must not include a claim for '*substantially the same matter*' as a claim in an accepted parent or vice versa. The notion of '*substantial identity*' is not determinative, because two claims can have '*substantial identity*' and yet each include subject matter that is outside the scope of the other, such that they are not for '*substantially the same matter*'. The notion of '*substantial identity*' therefore falls outside the notion conveyed by the expression '*the same*'. *Substantial identity* is not by itself sufficient to render the invention claimed in one substantially the same as the other.
10. At the other end of the spectrum, the fact that the claims of a divisional are not literally identical to the claims accepted in the parent does not necessarily mean that they are not for the same invention. If the differences in the wording of the claims are inconsequential, the two sets of claims may nevertheless relate to the same invention.

### **Regulation 82 is directed to the scope of the claims**

17. Consideration of the claims of a parent and divisional under regulation 82 is directed to the scope of the claimed invention. This is discussed in *Oracle* where it clarifies that reference to "a claim for matter" in regulation 82 is directed to "the scope of the claimed invention".<sup>7</sup>

### **Double infringement test**

18. The "double infringement" test<sup>8</sup> for assessing overlap asks:
- Would an infringement of the claim(s) of the first application also be an infringement of the claim(s) of the second?
  - And would an infringement of the claim(s) of the second application also be an infringement of the claim(s) of the first?
19. If the answer to both questions is yes, then the claims are considered to be "for substantially the same matter" and prohibited overlap is present.
20. When applying the double infringement test, the claim(s) are to be construed as they would be understood by the person skilled in the art. Further, as discussed at paragraph [17], it is the scope of the claims that is to be considered when applying the double infringement test.
21. The term "an infringement" in the double infringement test is therefore taken to mean "all infringing embodiments" that fall within the scope of the claim, not just any "single infringing embodiment". If there are infringing embodiments within the scope of one claim which are not within the scope of the other claim, this will not meet both arms of the double infringement test.

### **No discretion to allow overlap**

22. The Commissioner does not have any discretion under regulation 82 to allow claims in a parent and divisional application to cover "substantially the same matter", due to the

wording “must not”.<sup>9</sup> Therefore, when there is prohibited overlap an objection must be raised.

23. In contrast, regulation 23(2) of the Patents Act 1953 allowed the Commissioner discretion regarding overlap due to the wording “may require such amendment”.

24. Discretion under regulation 23(2) was whether to object and require amendment of the claims. Where amendment was deemed to be inappropriate, the Commissioner could decide to not object. This discretion was not in how overlap was assessed.

25. See *Abbott Laboratories* [2003] NZIPOPAT 16<sup>10</sup> and *Whitehead Institute for Biomedical Research et al* [2009] NZIPOPAT 21<sup>11</sup> for decisions under regulation 23(2) of the Patents Regulations 1954 which discuss the application of discretion in more detail.

### **Overcoming an ~~overlap~~ objection to “substantially the same matter”**

4.26. Following *Ganymed*, a parent ~~divisional overlap *Ganymed*<sup>1</sup>~~, an objection under regulation 82(b) or (c) may be overcome by:

- Providing a persuasive objection response, or
- Amendment of the ~~pending relevant~~ application, ~~or(s) to remove prohibited overlap (either pre-acceptance or post-acceptance), or~~
- ~~Amendment of the accepted application or granted patent, or~~
- Withdrawal of the accepted application, or surrender of the granted patent.

### **Relevant case law**

27. Two IPONZ Hearings Office decisions on aspects of regulation 82 inform current examination practice.

### ***Oracle International Corporation* [2021] NZIPOPAT 5 (“Oracle”)<sup>3</sup>**

28. The Assistant Commissioner considered parent and divisional claims with similar but not identical wording.

29. In the decision, the Assistant Commissioner:

- (a) Established the “double infringement” test for assessing overlap (see paragraphs 18-21 above);<sup>8</sup>
- (b) Provided a definition of “substantially the same” (see paragraph 15 and 16 above);<sup>6</sup> and
- (c) Confirmed that the Commissioner has no discretion to allow claims in a parent and divisional application to cover substantially the same matter (see paragraph 22 above).<sup>9</sup>

30. The Assistant Commissioner upheld the objection under regulation 82, finding that despite minor differences in wording, the claims of the parent and divisional were identical in scope and so met the double infringement test.

31. The decision emphasizes that the claims must be construed as they would be understood by a person skilled in the art. If the skilled person would consider all infringing embodiments of

a claim of the first application to infringe the second, and vice versa, the requirements of the test are met.<sup>8</sup>

### **Ganymed Pharmaceuticals GmbH et al. [2021] NZIPOPAT 6 (“Ganymed”)<sup>1</sup>**

32. The Assistant Commissioner considered whether post-acceptance changes could overcome an objection under regulation 82.

33. The applicants’ surrender of the parent patent was found to overcome the objection.

34. This decision clarified IPONZ’s practice in two aspects:

(a) When overlap is to be considered under regulation 52 versus 82 (see paragraphs 5 and 6 above);<sup>5</sup> and

(b) That withdrawal of an accepted application (or surrender of a granted patent) can overcome an objection to prohibited overlap (see paragraph 26 above).<sup>12</sup>

### **IPONZ Hearings Office decisions**

12. In *Oracle*, the relevant claims were held to relate to substantially the same matter, even though they were not worded identically. In *Ganymed*, the extent of overlap was not considered as the relevant claims were conceded as being substantially the same matter.

13. IPONZ Hearings Office decisions under regulation 23(2) of the Patents regulations 1954 offer some useful guidance on how overlap should be approached (while noting the slightly more prohibitive language of the previous provision):

14. In *Abbott Laboratories*, the Assistant Commissioner noted:

“The answer to the first question [does either the parent or the divisional specification include a claim for matter claimed in the other] must be in the affirmative. As noted above, Claim 6 of the parent specification (No 326132) lists 14 compounds, the first of which is the compound claimed in claim 1 of the divisional application (No 510328), “or a pharmaceutical salt, ester, or prodrug thereof”. The parent Claim 6, as I understand it, can be notionally considered as 14 independent claims, each to one of the 14 compounds “or a pharmaceutical salt, ester, or prodrug thereof”. Furthermore, Claim 7 of the parent specification actually claims the compound of Claim 1 of the divisional specification “or a pharmaceutical salt, ester, or prodrug thereof”. Thus, in my view there can be no possible doubt that the both specifications include a claim for the compound of Claim 1 of the divisional specification. Similarly, both specifications, as I understand them, contain claims to pharmaceutical compositions containing this compound and a method for its preparation.”

15. In *Whitehead*<sup>6</sup> the applicant’s sought to distinguish their situation from *Abbott* at [58]:

“[58] In *Abbott* the applicant sought to claim a compound that had already been claimed in the parent. In the present case... the applicants are seeking by way of a divisional to protect those aspects of their disclosed invention that fall outside the scope of the claims of the parent.”

16. The Assistant Commissioner accepted this argument and allowed the disputed application to proceed to acceptance based on the material fact that the claim set of each was both narrower and broader than that of the other.

17. The Assistant Commissioner also noted that the claim sets of the two were complementary to each other, and together they afforded the full protection for the matter disclosed by the applicants as the invention. The Assistant Commissioner also followed the established premise that the applicants are entitled to obtain protection by way of a divisional for the full scope of the disclosed invention, particularly for those aspects of their invention that fall outside the scope of the claims of the parent.

18. Distinguishing *Whitehead* from *Abbott* the Assistant Commissioner stated at [70] & [74]:

“[70] In the present case I believe it would be unfair to the applicants to consider notionally rewriting the claims of the parent specification, as one would be looking at a great number of separate claims. The circumstances of the *Abbott* decision are, therefore, different from those of the present case. Hence, I do not think it is reasonable for me to follow that decision in the present case.”

“[74] The New Zealand and UK decisions that have prohibited an overlap between parent and divisional are ones where one set of claims falls wholly within the scope of the other. This is not the situation in the present case.”

#### UK case law

19. UK Decisions based on section 18(5) and section 73(2) of the UK Patents Act 1977 may be considered persuasive given the similarity of NZ and UK legislation.

20. In *Arrow Electric Switches*<sup>7</sup>, the parent specification claimed, in claim 1, an electric switch and, in claim 2, the switch when operated by any means responsive to overload conditions in an electric circuit. The divisional specification claimed a particular device, responsive to overload conditions, for operating an electric switch. Claim 2 of the parent specification was not limited to use of the particular device of the divisional. In a United Kingdom Patent Office decision the Supervising Examiner decided that there would be ‘overlap’ unless the applicants inserted, in the divided application, an express disclaimer of the switch plus the operating means.

21. Morton J, in *The Patents Appeal Tribunal*, overturning this decision, said:

“If Rule 12, on its true construction, is intended to ensure that there is no overlap between the two patents to be granted, in the sense that no one act by a member of the public can possibly render him liable to a suit under both patents, the practice does not achieve that result. Even if claim 2 were struck out from the parent specification a person who used A plus B, that is to say, the switch in combination with the operating means, would clearly infringe claim 1 of both patents. Logically if that is the true meaning and intent of Rule 12, one of the two specifications should contain a disclaimer of A plus B, whether there is or is not an express claim of A plus B in either specification. On the other hand, if the practice were carried to its logical

conclusion, and if Rule 12 were interpreted in this very strict manner, very serious hardship might result to inventors. Taking the present case, if the rule were construed in the strictest way, the applicants could not in any way avoid inserting a disclaimer of A plus B in the divided specification; yet the contemplated use of their operating means is a use in combination with the switch, and it would seem strange if they were compelled to disclaim such a use. Furthermore, a disclaimer would have this disadvantage from the point of view of the applicants, that if for any reason the patent granted on the parent application became void, they would have no protection at all for the use in combination of their two inventions."

22. Allowing the appeal in favour of the applicant Morton J said:

"It seems to me quite reasonable that the applicants should be able to claim the switch, and the switch used in combination with the operating means, in their parent specification whilst claiming the operating means, but not the operating means used in combination with the switch, in their divided specification."

23. In *Abbott* referring to *Arrow Electric* the Assistant Commissioner noted:

"It appears to me that this situation is different from that before me. In the present case the same compounds are claimed per se in both the parent and the divisional application, whereas, as I understand it, in the *Arrow* case there was no duplication of claiming — rather, the claim to "B" in the divisional application would be infringed by anyone using "A plus B" as claimed in the parent. Thus, as I see it, this case is not strictly relevant to the present situation."

24. The *Armstrong-Kropp*<sup>8</sup> case, heard by the Superintending Examiner in the UK Patent Office, is adequately described by the headnote which reads:

"The applicants filed an application for a patent in respect of an aerosol dispenser. Subsequently, while the application was still pending, they filed a divisional application for the same invention but with broader claims, and requested that it be antedated in the customary manner. The examiner objected to allowing two applications for the same invention to proceed to acceptance, and the applicants sought a hearing.

**Held**, that the purpose of the Act in providing for divisional applications was to safeguard the rights of an applicant who has disclosed more than one invention in a single application and not to allow narrower and broader protection for the same invention in different applications. Moreover, the present applications did not comply with rule 13(3) [which is identical in wording to regulation 23(2)] because, although the respective claims were not substantially identical, one claim was for matter included in the other. The difficulty could not be cured by a disclaiming amendment in the divisional specification because the disclosure in both specifications was substantially the same, and any such amendment would leave the



claim of the divisional application insufficiently supported by the description in the body of the specification.”

25. In *Abbott* referring to *Armstrong-Kropp* the Assistant Commissioner noted:

“Mr Tuffery submitted that this was a decision of the British Superintending Examiner who did not refer to higher authority to confirm his decision. However, in the absence of authority leading me in the opposite direction, and given the identical nature of the two statutory provisions, it seems to me that I am entitled to consider this decision as persuasive.”

### IPONZ approach to examining ~~claim overlap under reg 82~~

35. The approach to considering overlap during examination is to first make an initial assessment of the patent family.
36. The purpose of the initial assessment is to identify any claims that require further consideration to see if they are to “substantially the same matter”.
37. The initial assessment will not typically be included in the examination report. The steps of this assessment will depend on the circumstances of the case.
38. This initial assessment generally includes a comparison of all claims of the application being examined and the claims of all applications within the same divisional patent family. The dependent claims may be relevant where they are closer in scope than the main independent claims.
39. From this initial assessment, the claims which are most similar in scope are identified for further comparison. If no claims are identified from the initial assessment, then no formal comparison is required.

### Double infringement test

40. The test used to assess overlap is the double infringement test.
41. A claim comparison table can be used to compare claims of the respective applications.
42. Claims will be assessed as they would be understood by the person skilled in the art.
43. For the purpose of applying the individual arms of the double infringement test, the infringement being considered includes all recited features of the respective claim. This is then compared to the corresponding claim to consider if there would be infringement.
44. Where the person skilled in the art would understand that all infringing embodiments of the first claim would infringe the second, and all infringing embodiments of the second claim would infringe the first, it is considered that the claims are “for substantially the same matter”.
45. As there is no discretion under regulation 82, if prohibited overlap is found using the double infringement test, an objection must be raised.

## Objecting to prohibited overlap

46. An objection under regulation 82 needs to identify which claims are being objected to and which claims of the other application are considered to be “for substantially the same matter”.
47. This may be done by including a claim comparison table where appropriate.
48. The exception to this is where prohibited overlap is readily apparent prima facie. For example, a whole of contents divisional applications where the parent claims are clearly derived from the original claim set may be objected to more generally.

The following examples may be useful when considering claim overlap under regulation 82:

### **Examples of a permissible degree of claim overlap**

26. It is clear from the wording of regulation 82 that some degree of claim overlap is permissible, provided the claims of the parent and its divisional do not cover substantially the same matter. For example, in the following situations the claims of the parent and divisional applications are not considered to be for substantially the same matter and will not attract an objection under regulation 82:
- Where the overlap between the claims of a divisional and its parent is such that some features of the claim of the divisional do not fall wholly within the scope of claim accepted in the parent in the sense that the claim set of each is both narrower and broader than that of the other.
  - Where the overlap between the claims of a divisional and its parent is such that the claims accepted in the parent are of Markush type such as ‘*A compound of formula (I)*’ (encompassing hundreds of thousands of compounds within its scope), and five specific compounds falling within the scope of formula (I) are claimed in the divisional application. In this situation it may neither be practical nor possible to notionally sub-divide the Markush type claim of the parent into the ‘*notional alternatives*’.
  - Where some features of the claims of one are somewhat different so as to render some matter outside the substantially same matter claimed in the other, even though the difference may be very small but not trivial, irrelevant or inconsequential.
27. It is allowable to have protection for an invention **A** in a claim of the parent application and for a separate invention **B** in a claim of the divisional application, and a further claim to **A+B** in either the parent or the divisional application (but not both), provided there is support in the originally filed application and accordingly the corresponding divisional or parent application includes a disclaimer to **A+B**<sup>9</sup>.
28. There can be no objection under regulation 82 to a claim for invention **A** in a parent application and a claim to **A+B** in its divisional application or vice-versa, where **A** and **B** are separate inventions claimed in combination (rather than as alternatives **A** or **B**) if **A+B** cannot be notionally rewritten to present a distinct claim to **A**.<sup>10</sup>

29. No objection will arise where the examiner is unable to identify which claims of the divisional under examination claim substantially the same matter as in the parent or vice versa, or where the overlap between them is of the type that it is difficult to amend the claims to fully remove the overlap, or where there is a marginal difference in the features but that marginal difference is relevant enough to make a distinction between the subject matter and/or scope of the claims of the parent and its divisional.
30. As a general rule, if the parent and divisional applications claim separate and distinct elements **A** and **B** respectively which function in combination, one of the two applications may also include a claim for **A + B**. This effectively means either one of the parent or divisional applications may claim its own subject matter in combination with subject matter claimed in the other application.
31. If the scope of protection defined in the claims of either one of the parent or divisional applications is notionally different from the scope of protection conferred by the claims of the other accepted application such that at least one technical feature of the matter claimed clearly distinguishes the subject matter from the other, then claims of both applications are allowable.

#### **Examples of claims overlap that will attract an objection**

32. When there is 'complete overlap' between the respective claims in parent and divisional applications—where a claim of one effectively encompasses the subject matter of the claim of the other in its entirety, and it is reasonable to “notionally sub-divide” a claim into the “notional alternatives” and one of the notional alternatives is identical in substance or essence to what is claimed in an independent claim of the other application, then objection should be raised under regulation 82.<sup>11</sup>
33. Thus the examiner will consider if any independent claim can be notionally sub-divided into alternatives such that there is an effective claiming of alternatives between parent and divisional applications, so as to effectively re-monopolise protection for the same matter in both applications. For example if an independent claim in the parent application is for invention **[A + B]** and a claim in the divisional application is for invention **[A + B']** or vice-versa, where **B'** is a sub-set of **B**, then claim **[A + B]** can be notionally rewritten as two alternative claims: one to **[A + B']** and one to **[A + (B - B')]** so in effect the matter claimed in the two applications is substantially the same, which should be objected to under regulation 82.
34. The examiner will also consider whether there are any other claims effectively claiming substantially the same matter. If any of the claims in the parent and divisional applications are found to claim subject matter that is substantially the same, then objection should be raised under regulation 82.<sup>12</sup>
35. In determining whether the claims of the parent and divisional applications are directed to 'substantially the same matter' if it is found that there is a trivial difference or no difference in the scope of effective protection afforded by the claims of the two applications, then the examiner will raise objection under regulation 82. Even though different wording may have been used in the claims and regardless whether there is a difference in the language of the claims, and also when the claim of one includes the entire matter claimed in the other.<sup>13</sup>

#### **Examples**

### Example 1:

#### Parent

Claim 1. A mobile vehicle that includes a camera configured to capture a two-dimensional image, and a processor configured to determine the presence of an obstacle by analysing the two-dimensional image and to generate a control signal of the mobile vehicle.

#### Divisional

Claim 1. A mobile vehicle that comprises an imaging means that captures a 2D image, and a processing means that analyses the captured image to identify an obstacle, where a command for controlling the mobile vehicle is generated based on the identified obstacle.

The claims are compared below:

<u>Parent claim 1</u>	<u>Divisional claim 1</u>
<u>a mobile vehicle</u>	<u>a mobile vehicle</u>
<u>a camera configured to capture a two-dimensional image</u>	<u>an imaging means that captures a 2D image</u>
<u>a processor configured to determine the presence of an obstacle by analysing the two-dimensional image and to generate a control signal of the mobile vehicle</u>	<u>a processing means that analyses the captured image to identify an obstacle, where a command for controlling the mobile vehicle is generated based on the identified obstacle</u>

In view of the complete specification, the person skilled in the art would construe the “imaging means” and the “processing means” as claimed in the divisional as being substantially the same as the “camera” and the “processor” of the parent claim.

Applying the double infringement test, all infringing embodiments of the claim of the parent would infringe the divisional claim; and all infringing embodiments of the claim of the divisional would infringe the claim of the parent. Therefore, the claims are considered to be for substantially the same matter and an objection would be raised.

### Example 2:

#### Parent

Claim 1. A system for providing breathable gas to a patient including:

- a mask including a gas inlet port and a cushion for surrounding a patient’s airway/s;
- a blower for delivering the gas to the mask; and
- a hose for connecting the blower to the mask.

Claim 2. The system according to claim 1, where the cushion includes ports for fluid communication with the patient’s nares and the cushion surrounds the periphery of the underside of a patient’s nose.

#### Divisional

Claim 1. A mask for surrounding and providing air through a patient’s nostrils including:

- a cushion for surrounding the periphery of the underside of a patient’s nose; and
- a port for connection to a conduit for providing air of ambient pressure or above.

Claim 2. A system for providing air through a patient's nostrils including:

- a mask according to claim 1 wherein the cushion includes two openings for aligning with the patient's nostrils;
- a blower for delivering the gas to the mask; and
- a conduit for providing air of ambient pressure or above between the blower and the mask.

The closest claims identified in the initial assessment are claim 2 of the parent and claim 2 of the divisional.

The claims are compared below:

<u>Parent claim 2</u>	<u>Divisional claim 2</u>
<u>a system for providing breathable gas to a patient</u>	<u>a system for providing air through a patient's nostrils</u>
<u>the system includes a mask, a blower and a hose</u>	<u>the system includes a mask, a blower and a conduit</u>
<u>the mask includes...</u> <u>...a gas inlet port and</u> <u>...a cushion for surrounding a patient's airway/s</u>	<u>the mask includes...</u> <u>...a port for connection to a conduit for providing air of ambient pressure or above</u> <u>...a cushion for surrounding the periphery of the underside of a patient's nose</u>
<u>the cushion includes ports for fluid communication with the patient's nares...</u> <u>...and the cushion surrounds the periphery of the underside of a patient's nose</u>	<u>the cushion includes two openings for aligning with the patient's nostrils</u> <u>...and the cushion is for surrounding the periphery of the underside of a patient's nose</u>
<u>a blower for delivering the gas to the mask</u>	<u>a blower for delivering the gas to the mask</u>
<u>a hose for connecting the blower to the mask</u>	<u>a conduit for providing air of ambient pressure or above between the blower and the mask</u>

In view of the complete specification, the person skilled in the art would understand that any hose or conduit used in the system would be able to handle ambient pressure and above. The person skilled in the art would also construe the system being suitable for gas is equivalent to being suitable for air in this context.

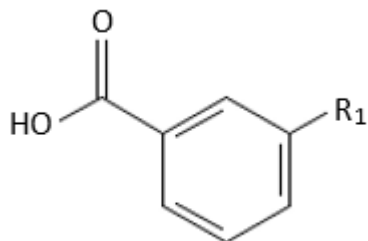
Applying the double infringement test, all infringing embodiments of claim 2 of the parent would infringe claim 2 of the divisional; and all infringing embodiments of claim 2 of the divisional would infringe claim 2 of the parent. Therefore, the claims are considered to be for substantially the same matter and an objection would be raised.

In contrast, applying the double infringement test to claim 1 of the parent and claim 1 of the divisional would not result in an overlap objection to these claims. Claim 1 of the parent and claim 1 of the divisional are not considered to be for substantially the same matter.

**Example 3:**

Parent

Claim 1: A compound of formula (I):



wherein R<sub>1</sub> is a halogen atom.

Divisional

Claim 1. A compound selected from:

- 3-chlorobenzoic acid;
- 3-bromobenzoic acid;
- 3-fluorobenzoic acid; and
- 3-iodobenzoic acid.

The complete specification defines halogens as the closed group fluorine (F), chlorine (Cl), bromine (Br) or iodine (I). This definition would be understood by the skilled person and is consistent with the common general knowledge.

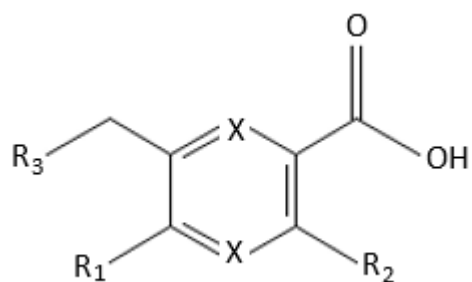
The person skilled in the art would construe the claim of the parent as a claim to four different compounds with each halogen being substituted at the R<sub>1</sub> position. These are the same four compounds as in claim 1 of the divisional.

Applying the double infringement test, all infringing embodiments of the parent claim would infringe the divisional claim; and all infringing embodiments of the divisional claim would infringe the parent claim. Therefore, the claims are considered to be for substantially the same matter and an objection would be raised.

**Example 4:**

Parent

Claim 1: A compound of formula (II):



wherein:

X is CH or N;

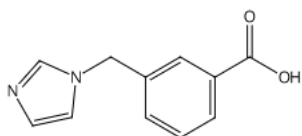
R<sub>1</sub> and R<sub>2</sub> are independently selected from H, C<sub>1-6</sub> alkoxy, C<sub>1-6</sub> alkyl and halogen; and R<sub>3</sub> is a cycloalkyl, heterocyclyl, aryl or heteroaryl optionally substituted with one or more of C<sub>1-6</sub> alkoxy, C<sub>1-6</sub> alkyl, C<sub>1-6</sub> haloalkyl, halogen, COOH, NH<sub>2</sub>, OH, CN, NO<sub>2</sub>, cycloalkyl, heterocyclyl, aryl or heteroaryl.

Claim 2: A compound of claim 1 selected from:

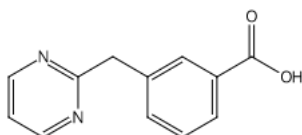
- 3-(1H-imidazol-1-ylmethyl)-benzoic acid (compound 1);
- 3-(2-pyrimidinylmethyl)-benzoic acid (compound 2);
- 3-(4-pyridinylmethyl)-benzoic acid (compound 3);
- 3-(3-pyridinylmethyl)-benzoic acid (compound 4); and
- 3-(2H-1,2,3-triazol-2-ylmethyl)-benzoic acid (compound 5).

#### Divisional

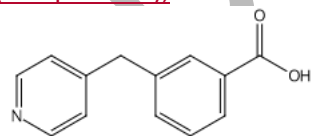
Claim 1. A compound selected from:



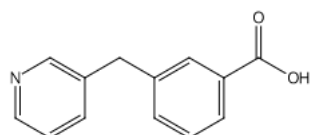
(compound 1);



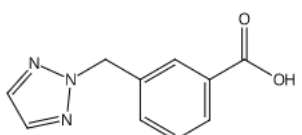
(compound 2);



(compound 3);



(compound 4); or



(compound 5).

The closest claims identified in an initial assessment are claim 2 of the parent and claim 1 of the divisional. The assessed claims are directed to the same five compounds so are the same in scope, despite one claim providing chemical names and the other providing structures.

Applying the double infringement test, all infringing embodiments of claim 2 of the parent would infringe claim 1 of the divisional; and all infringing embodiments of claim 1 of the divisional would infringe claim 2 of the parent. Therefore, these claims are considered to be for substantially the same matter and an overlap objection would be raised.

In contrast, applying the double infringement test to parent claim 1 and divisional claim 1 would not result in an overlap objection to these claims. Claim 1 of the parent and claim 1 of the divisional are not considered to be for substantially the same matter.

## Footnotes

1 See Patents Amendment Regulations 2018

2 See Ganymed Pharmaceuticals GmbH and TRON Translationale Onkologie an der Universitätsmedizin der Johannes Gutenberg Universität Mainz Gemeinnützige GmbH [2021] NZIPOPAT 6

3 Oracle International Corporation [2021] NZIPOPAT 5

4 Dreyfus' Application (1927) 44 RPC 291

5 Abbott Laboratories [2003] NZIPOPAT 16

6 Whitehead Institute for Biomedical Research et al [2009] NZIPOPAT 21

7 Arrow Electric Switches Ltd's Applications [1944] 61 RPC 1

8 Armstrong-Kropp Development Corporation's Applications [1974] RPC 268

9 See Abbott Laboratories (supra) where Arrow Electric Switches Ltd's Applications [1944] 61 RPC 1 was referred to.

10 See Kromschroder's Patent [1960] RPC 75 and Acumen Design Associates Ltd Application UK-IPO-BLO-031-17 [2017]

11 Following Abbott Laboratories and Armstrong-Kropp Development Corporation's Applications (supra)

12 Following Dreyfus' Application (supra)



13 See *Armstrong-Kropp Development Corporation's Applications* (supra) where the Superintending Examiner disregarded certain very minor and unimportant differences of wording.

1. *Ganymed Pharmaceuticals GmbH and TRON-Translationale Onkologie an der Universitätsmedizin der Johannes Gutenberg-Universität Mainz Gemeinnützige GmbH* [2021] NZIPOPAT 6 ("*Ganymed*"). Paragraphs [11] and [12] discuss not needing two patents for the same invention.

2. Regulation 23(2) of the Patents Regulations 1954.

3. *Oracle International Corporation* [2021] NZIPOPAT 5 ("*Oracle*").

4. Patents Amendment Regulations 2018.

5. *Ganymed*, above n 1, at [21]-[33].

6. *Oracle*, above n 3, at [9].

7. *Oracle*, above n 3, at [8].

8. *Oracle*, above n 3, at [41].

9. *Oracle*, above n 3, at [7] and [39].

10. *Abbott Laboratories* [2003] NZIPOPAT 16.

11. *Whitehead Institute for Biomedical Research et al* [2009] NZIPOPAT 21.

12. *Ganymed*, above n 1, at [170]-[171].