

## Regulation 82: Claims overlap between parent & divisional applications

This guideline outlines IPONZ's practice on claims overlap between applications 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.

### **When regulation 82 applies**

2. Regulations 52 and 82 were amended on 5 April 2018<sup>1</sup>, to clarify that overlap is an issue for examination of an application, not filing. The practice in relation to overlap is unchanged between regulations 52 and 82.
3. *Ganymed Pharmaceuticals GmbH*<sup>2</sup> clarified that 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. For brevity this guideline refers to regulation 82, this may be used interchangeably with regulation 52 where applicable.

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

2.4. 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

3.5. 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>-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."

4.6. This approach was subsequently codified in a series of further UK cases considering duplication of claiming.

5.7. While in *Abbott Laboratories<sup>3</sup>-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'

~~6. There are currently no decisions considering the meaning of the words 'substantially the same matter' in regulation 82. In the absence of case authority the words must be taken to assume their plain meaning:~~

~~**Substantially:** to a great or significant extent; for the most part.~~

~~**Same:** of an identical type; exactly similar.~~

~~**Matter:** a subject or situation under consideration~~

7.8. 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 the most part (or to a significant extent) identical' 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*.

8.9. 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.

9.10. 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.

### Overcoming an overlap objection

11. Following *Ganymed*, a parent-divisional overlap may be overcome by:

- Providing a persuasive objection response, or
- Amendment of the pending application, or
- Amendment of the accepted application or granted patent, or
- Withdrawal of the accepted application, or surrender of the granted patent.

### Relevant case law

#### 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.

10.13. ~~While there have been no decisions under regulation 82 of the Patents Regulations 2014 to date,~~ IPONZ Hearings Office decisions under regulation 23(2) of the Patents regulations 1954 offer some useful guidance on how ~~it~~ it-overlap should be approached (while noting the slightly more prohibitive language of the previous provision).

11.14. 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."

12.15. In *Whitehead<sup>3</sup>-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."

13.16. 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.

14.17. 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.

15.18. 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.

16.20. In *Arrow Electric Switches<sup>4</sup>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.

17-21. 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."

18-22. 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."

19-23. 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."

20-24. The *Armstrong-Kropp<sup>5</sup>-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.”

21-25. 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

~~22. IPONZ examiners will apply the following general approach when considering claim overlap under regulation 82:~~

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

### Examples of a permissible degree of claim overlap

23-26. 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.

**24-27.** 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>6</sup>B<sup>9</sup>**.

**25-28.** 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>710</sup>

**26-29.** 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.

**27-30.** 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.

**28-31.** 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

**29-32.** 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>811</sup>

~~30-33.~~ Thus the examiner will consider if any independent claim can be notionally subdivided 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.

~~31-34.~~ 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~~ing~~ subject-matter that is substantially the same, then objection should be raised under regulation 82.<sup>912</sup>

~~32-35.~~ 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>4913</sup>

~~33.~~ UK Decisions based on section 18(5) and section 73(2) of the UK Patents Act 1977 are considered persuasive given the similarity of NZ and UK legislation.

### ~~Withdrawal or surrender of accepted application or patent not a cure~~

~~34.~~ An objection under regulation 82 cannot be cured by withdrawing or surrendering the accepted application or granted patent, because once that application or patent has been accepted the provisions of regulation 82 apply (notwithstanding the subsequent fate of the first accepted application). However, such an objection can be resolved by amending the claims of either the parent or the divisional application such that neither includes a claim for substantially the same matter as accepted in the other.

### 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

~~4-4~~ *Dreyfus' Application* (1927) 44 RPC 291

~~2-5~~ *Abbott Laboratories* [2003] NZIPOPAT 16

~~3-6~~ *Whitehead Institute for Biomedical Research et al* [2009] NZIPOPAT 21

~~4-7~~ [Arrow Electric Switches Ltd's Applications](#) [1944] 61 RPC 1

~~5-8~~ [Armstrong-Kropp Development Corporation's Applications](#) [1974] RPC 268

~~6-9~~ See *Abbott Laboratories* (supra) where *Arrow Electric Switches Ltd's Applications* [1944] 61 RPC 1 was referred to.

~~7-10~~ See [Kromschroder's Patent](#) [1960] RPC 75 and [Acumen Design Associates Ltd - Application](#) - UK - IPO BL O-031-17 [2017]

~~8-11~~ Following *Abbott Laboratories* and *Armstrong-Kropp Development Corporation's Applications* (supra)

~~9-12~~ Following *Dreyfus' Application* (supra)

~~10-13~~ See *Armstrong-Kropp Development Corporation's Applications* (supra) where the Superintending Examiner disregarded certain very minor and unimportant differences of wording.

SUPERSEDED