

PRACTICE NOTE SIX (6)

PROCEDURE FOR FILING DIVISIONAL APPLICATIONS

1. Section 36(2) of the Industrial Property Act, 2001 and regulation 20(6) of the Industrial Property Regulations, 2002 provide for filing of divisional applications, where applicants may file divisional applications on their own volition or in response to an examination objection with regard to unity of invention. Under section 36(2), a divisional application may be filed at any time so long as a patent has not been granted on the initial application. A divisional application is filed by dividing the initial patent application (the initial application) into two or more applications in order to comply with the provisions of section 35 of the Act, which requires that each patent application should relate to only one invention or to seek protection for further inventions contained in the initial application.
2. Section 44(2), on the other hand, requires applicants to request for substantive examination within three (3) years from the filing date.
3. There has been some confusion as to whether the time limit under section 44 (2) of the Act applies with respect to divisional applications, considering that in some instances, by the time a divisional application is filed in accordance with the provisions of section 36(2), the aforementioned time limit of three (3) years for requesting substantive examination has expired.
4. **It is hereby clarified** that the request for, and payment of, substantive examination fees for divisional applications is in effect payment of additional examination fees for the additional inventions and therefore the time limit under section 44(2) does not apply where the applicant had already requested substantive examination of the initial application in accordance with the provisions of section 44 of the Act.
5. With regard to payment of fees for divisional applications, it is noted that regulation 20(6) (c) requires applicants to pay “any other fees payable in respect of the additional applications resulting from the division”. Such fees include annual fees payable under section 61 of the Act. **It is hereby clarified** that payment of the annual fee in arrears is not considered to be late payment of the fee and therefore is not subject to payment of a surcharge in accordance with the provisions of section 61(2). Consequently, applicants are not required to remit a surcharge for any annual fee that was due before the divisional application was filed.
6. Although divisional applications are treated as new applications and a new application number allocated, each divisional application retains the filing and priority dates of the initial application. For each divisional application, the applicant is required to submit a request as provided for

under regulation 12 for national applications, or regulation 32 for PCT applications, and remit all fees that were due from the filing date of the initial application, in arrears. **It is hereby clarified** that where a divisional application is based on lack of unity of invention, the applicant is also required to amend the initial application as provided for under regulation 20(5) to delete the claims of the additional sets of inventions.

Dated this 28th day of February 2013

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