

Filing a Divisional Application in Saudi Arabia – Part 12

Lisa L. Mueller - Namir Sioufi

This is the twelfth post in our 16-part series examining divisional practice in Argentina, Brazil, Canada, China, Europe, India, Indonesia, Malaysia, Mexico, Pakistan, Russia, Thailand, Saudi Arabia, Singapore, the United States, and Vietnam (in no particular order). Our first eleven posts examining divisional practice in Brazil, Mexico, China, India, Argentina, Canada, Thailand, and Pakistan and can be found here: [Divisional Practice – Brazil](#), [Divisional Practice – Mexico](#), [Divisional Practice – China](#) and [Divisional Practice – India](#), [Divisional Practice – Argentina](#), [Divisional Practice – Canada](#), and [Divisional Practice -Thailand](#), [Divisional Practice – Pakistan](#), and [Divisional Practice – Malaysia](#), [Divisional Practice – Singapore](#) and [Divisional Practice in Russia](#).

Divisional Practice in Saudi Arabia

In Saudi Arabia, divisional practice is fairly flexible. Specifically, one or more divisional applications can be filed: (1) in response to a lack of unity rejection; and/or (2) at any time for any reason (e.g., voluntary divisionals are permitted).

Time Period for Filing a Divisional Application

A divisional application can be filed any time before a receipt of a decision to grant or reject an original (e.g., parent) application. A divisional application cannot be filed from another divisional application (e.g., no cascading divisionals are permitted).

Requirements for Filing a Divisional Application

Under Saudi Arabian patent law, the requirements for filing a divisional application are as follows:

1. Submission of a copy of the specification (including the abstract), claims and drawings of the divisional application as well as an entry form indicating the name and address of the Applicant and the inventor(s);
2. The divisional application cannot include any subject matter not disclosed in the parent and priority application(s); and
3. The parent application and the divisional application cannot claim identical subject matter.

The priority and filing dates of each divisional application will be identical to the priority and filing dates of the (original) parent application.

Claims of a Divisional Application

A divisional application may be filed with the claims as originally filed in the parent application or PCT application. However, the claims of a divisional application filed with the same claims as a parent or PCT application must be amended during examination to ensure that neither the parent or divisional application claim identical subject matter. In other words, there can be no overlap of claimed subject matter in the parent or the divisional applications and an Examiner will reject the claims of a divisional application in the event of such overlap. Nonetheless, the claims of the divisional application may encompass broader subject matter than a parent application (subject to examination and opinion of an Examiner).

Double Patenting

Any patent issuing from a parent and a divisional application cannot claim the identical subject matter as this would present a double patenting problem. In order to determine whether or not double patenting exists, the claims as allowed are examined to determine whether or not identical

subject matter is being claimed. Specifically, claimed subject matter will be recognized as being identical if:

1. The independent claims in the parent and divisional application are completely (100%) identical with one another; or
2. One or more independent claims in the parent or divisional application recite one or more alternatives and the one or more alternatives are identical with one or more alternatives claimed in the parent or (another) divisional application.

Examination of Divisional Applications

A divisional application is accorded the same filing date as the parent application but is treated as a new patent filing. As such, the divisional application:

1. Is allotted its own (new) application number;
2. Requires payment of its own filing fees (separate from the filing fees paid in the parent application) and all back annuities;
3. Requires the filing of a request for examination (separate from the filing of a request for examination in the parent application);
4. Is prosecuted separately from the parent application; and
5. Results in a patent that is independent from the parent application.

The fees for a divisional patent application are the same as for any parent application.

Examination fees must be paid within 18-24 months from the actual filing date of the divisional application. If the fees are not paid within a three-month notice period, the application will be considered to be withdrawn.

Pursuant to standard regulations, the Applicant or his legal representative will be notified of the publication.

The term of a patent issuing off of a divisional application is twenty years from the filing date of the parent application.

This post was written by Lisa Mueller and Namir Sioufi of Saba IP.