

CONVERGENCE OF PRACTICE

WORKING GROUP 1 - EXAMINATION OF UNITY OF INVENTION

SUMMARY OF THE RESPONSES TO THE QUESTIONNAIRE OF 4 FEBRUARY 2020

The EPO Secretariat of the Convergence of Practice programme has received 20 responses to the questionnaire on the “Examination of Unity of invention” of 4 February 2020 from Denmark (DK), Estonia (EE), , France (FR), Germany (DE), Greece (GR), Hungary (HU), Italy (IT), Lithuania (LT), Latvia (LV), Montenegro (ME), Macedonia (MK), Netherlands (NL), Norway (NO), Poland (PL), Portugal (PT), Romania (RO), Spain (ES), Sweden (SE), Turkey (TR), and the United Kingdom (GB). The EPO has also provided its responses to the questionnaire. The responses to the questionnaire can be summarised as follows:

1. Description of the applicable legal framework

- 1.1. What are the provisions applicable to the assessment of unity of invention in your Office? (Please provide a link to an English version of the applicable legal texts and practice guidelines, if possible)

N/A

- 1.2. Are those provisions harmonized with the PCT (Rule 13(1) and (2) PCT) as to the standard to be applied? If not, please explain why and clarify the differences.

All the participating states that have responded to the questionnaire provide provisions harmonised with Rule 13 (1) PCT.

Despite small differences in the wording, most states and the EPO seem to also have harmonised provisions with Rule 13 (2) PCT, such as DK, ES, FR, GB, GR, LV, ME, MK, NO, PL, RO, and SE.

In some other states (DE, EE, HU, PT and TR), an approach consisting in or to some extent equivalent to determining the common “special technical features” of the claimed inventions as determined in Rule 13(2) PCT is followed.

LT and NL do not carry out substantive examination of patent applications. In NL the approach provided for in Rule 13(2) PCT is incorporated in the internal guidelines but it is not consistently applied in practice. This because the criterion of “special technical feature” is considered as too strict and leading to too many objections of lack of unity a posteriori. In LT, Rule 13 (2) PCT is not implemented.

2. Description of the practice and method for the assessment of unity of invention

- 2.1. Please describe your practice regarding the application of those provisions, i.e. what are the criteria to assess whether an application meets the unity requirement? In particular, please specify how a unifying technical relation is determined between the inventions or groups of inventions claimed

As mentioned, the applicable legal provisions in the large majority of the participating states stipulate that several inventions are considered so linked as to form a single general inventive concept (Rule 13.1 PCT), and therefore unitary, where they share one or more of the same or corresponding special technical features (Rule 13.2 PCT).

In the case of LT, unity appears to be established by determining the existence of common matter among the claimed inventions, without assessing its contribution over the prior art. In the NL, the lack of unity does not appear to have immediate legal consequences on the search (see below questions 4.2 and 4.4).

Along with the “special technical features” approach, a number of participants simultaneously use the so-called “single general inventive concept” approach (EE, ES, NO, PT, SE), which is held to lead to equivalent results and which was also traditionally used at the EPO. It is however no longer included in the EPO guidelines for examination. In the case of NO, the latter approach appears to be recommended over the “special technical features” when the claims include Markush groupings or there is a plurality of independent claims.

- 2.2. How are these criteria defined, interpreted and applied in practice?

In the description of the special technical features approach submitted by the participants the main points of interest concern the definition of what are considered “corresponding features” and the assessment of the contribution of the common features (same or corresponding) over the prior art, namely whether they can be considered as “special”.

The issue of whether (special) technical features are the same or corresponding is closely linked to the existence of a single general (inventive) concept or problem. For some participating states (DE, FR, HU, NO) and the EPO, “corresponding features” are those achieving the same technical effect or solving the same technical problem. Some others put the stress on the effect or result achieved by those features alone or

in combination (ES) or, simultaneously, in the “concept” - apparatus/process/product - (DK). In this context, expressions such as “single technical problem” (RO), “same substantial technical idea” (GR) or “same technical finding” (HU) may ultimately be considered as equivalent. In GB, examiners can use the technique of re-writing the claims to produce a notional set of independent claims and then consider the common subject matter of those claims.

Regarding the inventiveness of the single general concept or whether the special technical features define a contribution of the linked inventions over the prior art, DE does not appear to have a clear legal basis to require that contribution. In some states where patents are granted without substantive examination and where, thus, unity is only assessed a priori no assessment of that contribution is made (LV) or it is merely made on the basis of common general knowledge (LT). The information provided by the rest of the participating States appears quite homogeneous on this point. In the GB, where the common matter of multiple inventions in dependent claims is provided by a too broad independent claim not being novel or inventive, no objection of lack of unity is raised but just a novelty or inventive step objection.

- 2.3. Does the examiner enjoy any discretion to deviate from the application of the criteria described above and, if so, in which circumstances?

In EE, GB, LT and NL examiners appear to have a broad discretion to decide on unity, whereas in the rest of the participating states examiners are more strictly bound to the existing instructions. In some cases, examiners are however instructed not to pursue objections or insist on them on the basis of a narrow or academic approach, particularly if no additional search is needed (EPO, ES, NO). In DK, where despite the lack of unity the examiner is able to search and examine more than one invention without undue burden, he may decide not to raise the objection.

- 2.4. Are there any requirements as to the minimum reasoning to be given when raising a non-unity objection and the logical steps to be followed by the examiner when presenting the objection?

In nearly all of the participating states, reasons for the objected lack of unity are to be given, including the appropriate legal basis and the resulting groups of inventions. An objective and formalized standard reasoning appears to be required in DK, ES, FR, HU, LT, ME, MK, PT, SE, as well as the EPO. In countries like HU and SE the instructions vary in the case of a priori and a posteriori objections.

3. Unity of invention practice in particular cases

- 3.1. Can the lack of unity be raised among the claims for a product, a process adapted for the manufacture of said product, a use of said product?

It is permitted to have an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for the use of said product in DE, DK, EE, ES, FR, GB, GR, HU, IT, LT, ME, MK, NL, NO, PL, PT, RO and TR.

A a posteriori non-unity objection is possible in DK, EPO, GR, HU, IT, ME, NL, PT, SE and TR if the product (unifying concept) is not patentable.

- 3.2. Is it possible for a lack of unity of invention to exist

- within a single claim: *This is a possibility that exists for all the countries responding to this questionnaire in the case of several alternatives within one claim.*
- among the independent claims: *This is the usual case for all countries replying to this questionnaire.*
- between an independent claim and its dependent claims: *All the countries seem to agree that this is not a common situation to raise non-unity. Some countries (DK, GB, GR, HU, IT, NL and PL) and the EPO explicitly mentioned situations where non-unity objection may still be raised in this configuration. This happens in particular in the case of pseudo-dependent claims (the dependent claims do not have all the features of the independent claims). These remain exceptional cases.*
or
- among dependent claims of the same independent claim: *The subject-matter of the independent claim is the unifying concept in this situation. However, the lack of patentability of independent claims may lead to a lack of unity among the dependent claims for DK, DE, EE, EPO, GB, GR, HU, IT, NL, NO, PL, PT, RO, SE and TR.*

- 3.3. Are there established findings regarding the assessment of unity in particular cases, notably in case of a combination of claims of different categories, intermediate and final products, or Markush groupings?

EE, ES, EPO, FR, GB, GR, HU, IT, ME, NO, PT, PL, SE and TR seem to follow the PCT practice (or similar) for special cases, while in particular DK seems to follow a different approach.

3.4. Please explain how unity is assessed in these cases

Countries which have replied to this question are usually following the PCT guidelines and its examples and/or the EPO guidelines or similar practice. DK does not seem to make any distinction in the treatment of special cases for the assessment of non-unity and follows the special technical feature method.

4. Procedural consequences in cases of non-compliance with the unity requirement

4.1. Please indicate the stages of the procedure in which non-unity objections can be raised.

In general, non-unity objections may be raised during search and/or preliminary examination (DE, EE, EPO, ES, FR, GB, GR, HU, IT, NL, PL, PT, SE, TR) and during substantive examination (DE, DK, EE, ES, GB, LT, LV, ME, MK, NO, PL, PT, RO, SE, TR).

DE, EE, FR, GR, NO, PL and SE additionally allow for non-unity objections to be raised already before the start of the search. This applies for example during the formalities examination or even before if an obvious lack of unity is detected a priori.

4.2. What is the impact of a non-unity objection on the subject matter to be searched/examined?

Where the existence in the application of a plurality of non-unitary inventions is established, most states limit the search to the first invention mentioned in the claim.

While EE, GB, PT, SE and TR do not search the further non-unitary inventions contained in the application, ES extends the search to the entire scope of protection. So do DK, EPO and HU in case this does not involve special effort.

The EPO will also search the further inventions, if an additional search fee is paid in respect of each of them.

NO only limits the search to the first invention mentioned in the claim, in case of a priori lack of unity and only if the application claims priority and the applicant does not choose one of the inventions to be searched. In case of a posteriori lack of unity and when the application does not claim priority, NO will have all inventions searched.

Although the search is limited to the first invention mentioned in the claims so linked as to form a single general inventive concept in DE, regarding examination, it is practice to mention further material relating to the other object.

Non-unitary subject matter will not be searched in GR, IT, LT, MK, PL and RO. However, in most cases this will not be the immediate consequence, but the result of a previous invitation for clarification followed by no or an unsatisfactory reply. Furthermore, in PL a search is still executed if the non-unitary subject matter is non-technical as such, or if there is an evident lack of novelty of non-unitary subject matter, or if an examiner sees the possibility to avoid a unity problem.

Only in LV and NL there seems to be no impact of a non-unity objection.

4.3. How can the applicant react in case a non-unity objection has been raised?

The main possibilities for the applicants to react to a non-unity invention are:

- *to a divisional application, or to amend the claim (DE, DK, EE, EPO, ES, FR, GB, GR, HU, IT, LT, LV, ME, MK, NL, NO, PL, PT, RO, SE, TR), or*
- *to file objections against the non-unity decision (DK, EE, EPO, ES, FR, GB, GR, HU, IT, LV, NO, PL, PT, RO, TR).*

In PL there is the possibility of submitting a request for re-examination of the matter.

In LT applicants may appeal to the Appeals Division.

The payment of additional search fees for searching the additional claims relating to the non-unity subject matter is at least an option in ES, GB, ME.

NL does not provide for the possibility of objecting/appealing against the decision of non-unity. [This also seems to be the case in DE, MK and SE].

4.4. What are the legal consequences, in the different stages of the procedure, if the unity requirement is not met by the applicant?

For more than half of the participants the legal consequence may be a rejection of the application (DE, DK, EE, FR, MK, NO, GB, HU, IT, LT, ME, SE and the EPO); in most cases, after the claim has not been amended by excising the non-unitary subject-matter. The latter may be further pursued by way of divisional applications.

In DE, EPO, ES, FR, HU, LV, ME, PL, PT, RO and TR a partial search report and (consequently) a partial examination are also a legal and practical consequence if the unity requirement is not met.

In GR and NL there are no legal consequences if the unity requirement is not met by the applicant.

- 4.5. Please provide information regarding the rate of objections raised on the grounds on non-unity at your office. If possible, please provide a break down according to technical areas.

For most participants the rate of objections is rather low (DE, ES, GR, HU, IT, LV, LT, MK, NL, PL, SE, TR).

The cases are more frequent in EE and GB, and before the EPO.

No information as regards the objection rate can currently be provided by DK, FR, ME, NO, PT, RO.
