Munich, 3 June 2020

CONVERGENCE OF PRACTICE

WORKING GROUP 1 - EXAMINATION OF UNITY OF INVENTION

DISCUSSION PAPER

I. Introduction

In early February, the Chair of the working group sent a questionnaire to the working group members in order to gain an overview of the detailed practice at national level with regard to "Examination of unity of invention" for each country. The input from the questionnaire was summarised in an overview which was presented and discussed at a meeting on 18 March 2020. The finalised summary served as basis for determining the commonalities and differences in practices at the various national offices and the EPO, and for exploring areas where common practices would be valuable and could be achieved. At the working group's second meeting on 23 April 2020, the EPO presented three possible areas, which were unanimously endorsed by the members of the group:

1. Definition of single general concept/corresponding features

2. Assessment of unity of invention *a priori*

3. Minimum reasoning in support of non-unity objections

The three areas are interrelated and will thus cross-fertilise the discussions. There were no additional proposals for other possible discussion areas.

This discussion paper aims at summarising the different practices in the three chosen discussion areas and at clarifying outstanding issues with a view to developing possible initial proposals for common practices in these areas.

II. Discussion areas

1. Definition of single general concept/corresponding features

a) Association of non-identical features

When assessing unity, examiners need to check whether the requirement of a single general inventive concept is fulfilled. Consequently, in order to check the unity of the application all offices need to define the "single general concept".

For some offices, a single general inventive concept can be established only when there is a technical relationship among the inventions which involves one or more of the same or corresponding special technical features. Those offices still need to define same or corresponding technical features.

Those definitions are key to the non-unity assessment because they help to determine what the claims have in common.

"Same" technical features are obviously "identical features". All offices take account of identical features when determining the single general concept. But what about non-identical features? Even offices which do not have a legal provision similar to Rule 13.2 PCT will generally not limit their assessment of the single general concept to identical features.

The single general concept will generally also include features which, although not the same, have something in common: The majority of countries consider that the single general concept should also include **non-identical features aiming at solving the same technical problem or, in other words, the technical features which, although not the same, are associated with the same technical effect.**

However, instead of technical features associated with "the same technical effect", some countries prefer to talk about technical features associated with the "same function" or "same result".

Those definitions seem to be equivalent but there might be nuances.

Question

The majority of states and the EPO define the single general concept/corresponding features as "different features aiming at solving the same technical problem or, in other words, the technical features which, although not the same, are associated with the same technical effect".

If your definition is different, do you consider it to be equivalent or divergent? Please explain in detail.

b) Interrelated product features and different category features

Some countries have a very precise definition of what should be included in the single general concept/corresponding features.
Besides the definition above, they explicitly mention interrelated products: features that together produce a result/effect (plug and socket, key and lock, etc.). Some of them also explicitly include different technical features from different categories that can be attributed to the same concept (apparatus/process/product).

Questions

1. Do you consider such features to be part of the single general concept?

2. If so, do you consider that those features are also covered by the more general definition given above ("different features aiming at solving the same technical problem, or in other words, the technical features which, although not the same, are associated with the same technical effect")?

2. Assessment of unity of invention *a priori*

Not only do the vast majority of the EPC contracting states carry out the assessment of unity "*a priori*" but, more importantly, this is in many cases the only way in which unity is assessed.

Of the typically two main steps required for the assessment of unity, namely the identification of the common matter ("single general concept") and the assessment of the contribution of that common matter over the prior art ("inventiveness" of the single general concept), it is the second one which, prima facie, presents the biggest difficulties for the *a priori* assessment. Since it is by definition carried out before the search, the contribution of the common matter over the prior art can be determined only to a certain extent. To do this, examiners can only rely on the background art provided by the applicant in the description and on the notorious prior art or common general knowledge which they may be aware of and which may not require immediate proof or further research.

From the contributions made so far by the working group members, it can be ascertained that the participating states mainly deal with this challenge in two different ways. At some states' offices, the lack of contribution over the prior art is questioned only where it becomes obvious at first sight or in the process of determining the search strategy. At some other offices, however, the "unity" of the claimed inventions is

determined *a priori* without having regard to the prior art. This means that only the existence of common matter or a common concept is assessed in practice. Some of the offices performing merely the *a priori* assessment take this approach. However, it is unclear whether these offices also disregard the general state of the art which is obvious at first sight. Furthermore, there are a number of offices for which no data are available yet. Reference is therefore made to the questions below, and in particular to question 3.

Otherwise, the definition of "single general concept" and "corresponding technical features", as discussed in parallel (see II.1.), may simultaneously contribute to the establishment of common practices for the assessment of unity *a priori*. In this context, it is proposed to jointly investigate whether the unifying technical relationship among the claimed inventions is determined differently in the cases of the "*a priori*" and the "*a posteriori*" assessment. In this regard, please see question 4 below.

Questions

1. Does your office assess unity "*a priori*"?

2. If so, at which stage of the procedure is or may be such an assessment carried out?

3. Is the contribution of the common matter over the prior art assessed as part of the *a priori* assessment?

   If so,

   3.1 only if it obvious?

   3.2 How is it assessed?

4. Is there any difference in the way the common matter or "single general concept" of the claimed inventions is determined in the cases of the "*a priori*" and the "*a posteriori*" unity assessment?

3. Minimum reasoning in support of non-unity objections

There are usually no legal provisions on the minimum requirements for the non-unity reasoning. Requirements can be developed only on the basis of court decisions or office practices.

Transparency of non-unity reasoning gives applicants the opportunity to make informed decisions on the future prosecution of their application. Many countries therefore acknowledged that there must be a reasoned case for lack of unity which the applicant can understand and respond to.

In order to improve both quality and consistency of communications with applicants with respect to lack of unity, some offices have developed standard sets of information that the examiners need to provide to applicants. Examiners are sometimes even provided with standard clauses to help them in drafting harmonised non-unity reasoning.

Based on the replies received so far, the following types of information (in various optional combinations) can be found in the offices' communications to applicants:

1) Indication of the specific paragraph of the law or regulation
2) Groups of invention
    a. Number and grouping of the claimed separate invention
    b. Specification of claims that do not meet unity criteria
3) Common matter/lack of common matter
4) Why common matter does not form a single general inventive concept
    a. In general
    b. Based on same or corresponding **special** technical features
    c. Why the technical features of the common matter do not provide a novel and inventive contribution in view of the available documents found during the search (”common matter not special”).
5) Prior art
    a. Reference to the documents that have been relied upon
    b. Documents in the state of the art
6) Indication of what is known from the prior art
7) Features making a contribution over the prior art
8) Problem solved by the features making a contribution over the prior art
9) Specification of technical characteristics that do prevent formulation of a single general inventive concept
10) Differences between each group of invention
11) Why there is no technical relationship among the group of inventions
    a. In general
    b. Based on technical problems, technical effects, technical properties, etc.
12) Technical problems solved by different inventions
13) Statement that only the first invention will be analysed
14) Conclusion

Questions

1. Which of the above items are already used in your office's non-unity reasoning?

2. Are those items which your office does not use for its non-unity reasoning

   2.1 consistent with your practice as to the non-unity assessment

   or

   2.2 incompatible with your practice? If possible, please explain for each such item why it is incompatible.

Items related to prior art can also be considered to be used where the common general knowledge is the only prior art available. States which only assess non-unity *a priori* can therefore also consider themselves compliant if these items can be applied in their country based on common general knowledge.

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