



Unity of Invention

EPO/SIPO

IP5 Heads and IP5 Industry Meeting
Suzhou, 21 May 2015



Assignment

1. In the Heads Meeting held in Korea in June, 2014, the IP5 offices agreed to designate the EPO and SIPO as the lead offices of unity of invention.
2. In the 3rd PHEP Meeting in October, 2014, Beijing, the IP5 offices agreed to :
 - (1) complete an achievable fact-finding report first, and
 - (2) seek to propose several possible options for directions of future work.



Accomplished Work: compiled the fact-finding report

1. Designed the questionnaire on the rules and practices among IP5 Offices before the 3rd PHEP meeting;
2. Collected the feedbacks from other IP5 offices before January, 2015;
3. Compiled the fact-finding report and submitted it to the Deputy Heads Meeting in March, 2015.



The joint questionnaire on Unity of Invention includes :

1. Description of the applicable legal framework;
2. Description of the practice and method for the assessment of unity of invention;
3. Unity of invention practice in particular cases ;
4. Procedural consequences in cases of non-compliance with the unity requirement ;
5. Offices communications regarding unity.



Achievements: the fact-finding report

The report includes 4 parts:

- I. Introduction
- II. Summary of the IP5 offices' contributions
(Summarizing the feedbacks from IP5 offices on the five aspects of the joint questionnaire)
- III. Conclusions/Summary of the report findings
(Analyzing the similarities and differences among IP5 offices)
- IV. Annexes
 - Annex 1 Joint questionnaire
 - Annex 2 Contributions of the IP5 offices
 - Annex 3 Industry IP5 Consensus proposals to the PHEP



Achievements: the fact-finding report

Conclusions/Summary of the report findings:

1. The applicable legal frameworks
 - The EPO, JPO, KIPO and SIPO apply to a great extent the same principles and procedures both in their capacity as ISA/IPEA and in their capacity as national/regional office. At the USPTO the standard is different for non-PCT route national applications.
 - The considerations underlying the unity of invention requirement in the IP5 offices are primarily of economic and technical nature.



Achievements: the fact-finding report

Conclusions/Summary of the report findings:

2. The practice and methods for the assessment of unity of invention
 - The IP5 Offices require a group of inventions so linked as to form a single general inventive concept for the assessment of unity. For non-PCT route national applications in the USPTO, it applies the independent and distinct standard.
 - In general, lack of unity shall be determined after taking the prior art into consideration.



Achievements: the fact-finding report

Conclusions/Summary of the report findings:

3. Unity of invention practice in particular cases

- The requirements of the unity of invention in following particular cases are to a large extent the same among the EPO, KIPO, the JPO and SIPO, and also the same as the assessment of the PCT route applications before the USPTO:
 - (a) the combination of claims of different categories;
 - (b) the intermediate and final products;
 - (c) the Markush-Type



Achievements: the fact-finding report

Conclusions/Summary of the report findings:

4. Procedural consequences lacking unity of invention

- **While at the JPO and KIPO non-unity objections can only be raised during substantive examination, at the EPO, SIPO and the USPTO it can be made anytime throughout the prosecution of the file.**
- **In all five offices, the applicant has the possibility to restrict the claims or file divisional applications to overcome the non-unity objection.**
- **The EPO is the only Office before which applicants may have non-unitary subject-matter searched by paying additional fees regardless of the type of the application processed.**
- **Failure to meet the unity of invention requirement constitutes grounds for refusal/rejection of the application at the EPO, JPO, KIPO and SIPO.**



The Future Work

Based on the endorsement of IP5 Heads tomorrow

1. Share the initial report of unity of invention with IP5 industry and welcome stakeholders' input
2. Alignment of IP5 Offices' practices in international applications
 - consistent application and better implementation of the unity of invention standard embedded in the PCT



Thank You !