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# Unity of invention

IP5 ICG, The Hague, 16 January 2019



EPO/CNIPA

16 January 2019

## Procedural patent harmonisation – IP5 PHEP

- **Unity of invention:** EPO/CNIPA
  - determination and application of unity of invention criteria
- **Citation of prior art:** KIPO/USPTO
  - prior art disclosure requirements
- **Written description and sufficiency of disclosure:** JPO
  - issues re enablement, sufficiency of disclosure, written description and claims

<http://www.fiveipoffices.org/activities/harmonisation.html>

## Unity of invention (EPO/CNIPA)

- IP5 Industry consensus proposals
  - October 2014
  - essential “guidelines” for the IP5 Offices
- Basic principles
  - adherence to the PCT standard for unity
  - case studies
  - uniform application of the PCT standard
- Continuous coordination with IP5 Industry

## Unity of invention (EPO/CNIPA)

### ➤ Scope of work

- alignment of practices re **international applications**

### ➤ Methodology

- consolidation of data of IP5 report
- case studies – 3 areas: mechanics, electricity, chemistry

### ➤ Intermediate review

- certain practice elements already **aligned**
- differences in **substantive patent laws** may lead to different outcomes

## Unity of invention (EPO/CNIPA)

### ➤ Objective

- suggest **improvements in non-unity reasoning**
- formulate a complete non-unity **example** including a reasoning
- reach a common way of raising non-unity objections, currently not available in the ISPE
- enhance consistency of approach, **transparency** and **predictability**

## Unity of invention (EPO/CNIPA)

### ➤ Status of work

- EPO/CNIPA draft proposal presented at the April 2018 ad hoc PHEP meeting
  - review cycle over the summer 2018
  - final draft, incl. IP5 Offices input, endorsed by **PHEP November 2018**
  - conclude work and close the project
  - share with **IP5 Industry** – ICG January 2019
  - present to IP5 Heads and IP5 Industry – June 2019
  - publish on IP5 website
- 
- Implementation of **measures towards practice alignment**
    - follow-up where necessary

# Unity in the PCT



Rule 13.1

A **Single General Inventive Concept**



Rule 13.2

A **technical relationship...**

...involving same or corresponding **Special Technical Features**

## Key requirement



*“a logical and complete chain of reasoning”*

*10.63 In the invitation to pay additional fees, the International Searching Authority sets out a **logically presented, technical reasoning containing the basic considerations** behind the finding of lack of unity.*



## Minimum reasoning

- ➔ The **common matter**, if any, between the (groups of) inventions.
- ➔ The reasons why this matter cannot provide a **single general inventive concept** based on same or corresponding **special technical features**.
- ➔ The reasons why there is no **technical relationship** among the (groups of) inventions, if not apparent.

A **concluding statement** that, because neither the same nor corresponding special technical features are present in the claims, there is no single general inventive concept and the requirements for unity of invention are not met.

## Common matter

Is there **common subject-matter** between the (groups of) inventions?



The **common matter** must be identified in the reasoning.



The **absence** of common matter must be explicitly indicated.

## **ii** No Single general inventive concept in the common matter

Why are none of the common technical features special?

- ➔ Prior art document.
- ➔ General knowledge.
- ➔ The teaching of the application itself.

## **iii** Technical relationship

Why is there no **technical relationship** among the (groups of) inventions?

- ➔ Indicate **non common** technical features & **why** claims may be **grouped** together.
- ➔ Explicitly state that these features are **different**.
- ➔ For each group, identify the **technical properties** demonstrated through their features.
- ➔ For each group, explain why their technical properties are **different**.

## iii Technical relationship (special cases)

Where appropriate (e.g. **chemistry**), the reasoning can instead explain why:

- A grouping of alternatives of compounds are not of a **similar nature**.
- The **intermediate** and **final** products do not have the same essential structural element and are not **technically closely interrelated**.
- A process is not **specially adapted** to the production of a product.
- A product itself does not provide a **SGIC linking different uses**.
- A use in itself does not provide a **SGIC linking the claims**.

## iv Concluding statement

The reasoning must **conclude** that:

Since neither the same nor corresponding special technical features are present in the claims, the inventions are not linked by a single general inventive concept and the requirements for unity of invention are not met.

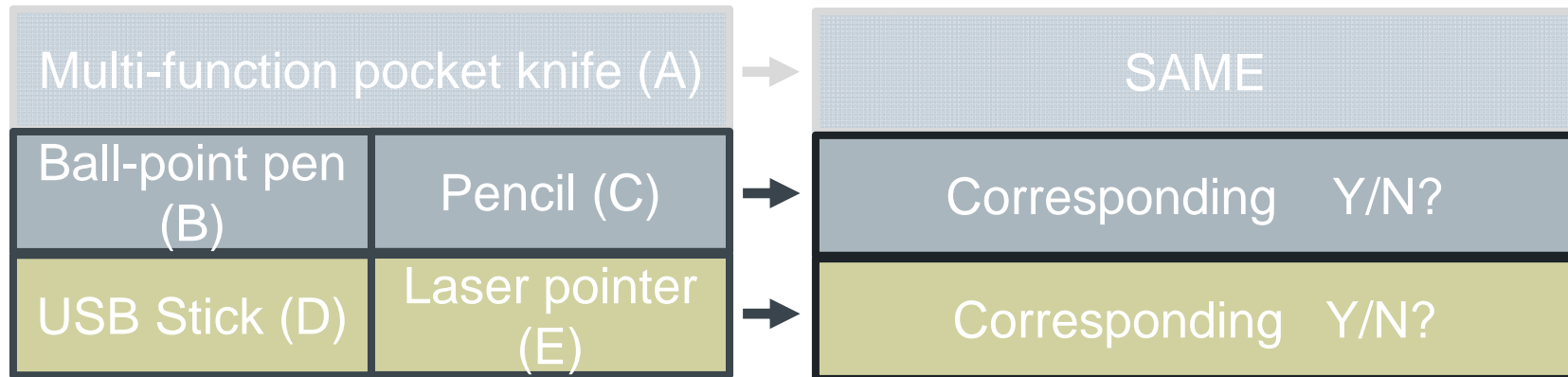
## Example - lack of unity in practice

Claim 1: A multi-function pocket knife (A) with a ball-point pen (B) + a USB Stick (D)

Claim 2: A multi-function pocket knife (A) with a pencil (C) + a laser pointer (E)



## What is the same and what is corresponding?



**Ball-point pen (B)** : writing means

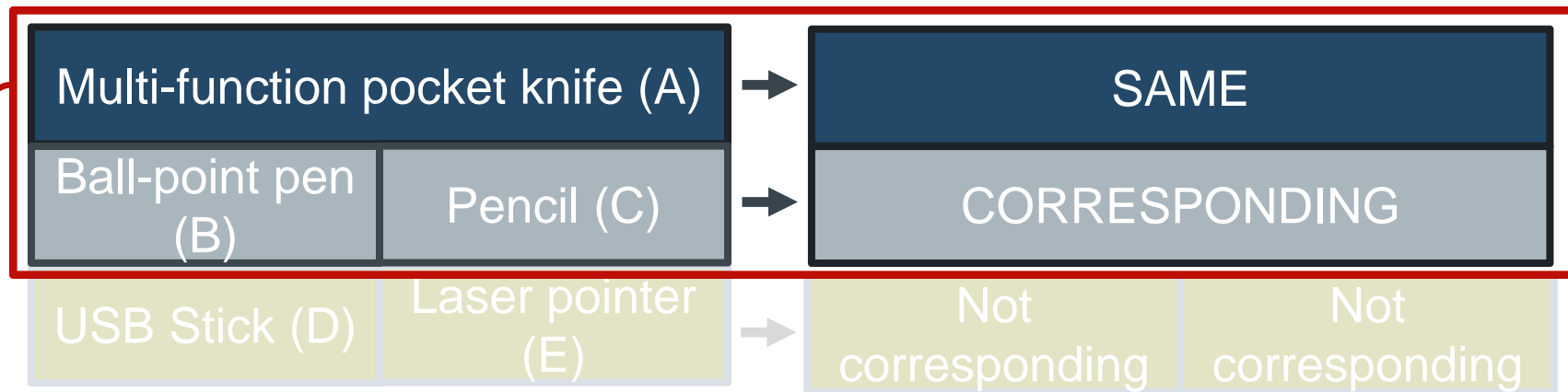
**Pencil (C)** : writing means

**USB stick (D)** : means adapted to save data electronically

**Laser pointer (E)** : means adapted to point at an object



## Reasoning : Common matter



The **common matter**, if any, between the different (groups of) inventions

## Special technical features?

Application

Multi-function pocket knife (A)	
Ball-point pen (B)	Pencil (C)
USB Stick (D)	Laser pointer (E)

Prior Art 1

Multi-function pocket knife (A)
with Fountain pen (F)

- The same features (A) are known from Prior Art 1 so are not special
- The fountain pen (F) of Prior Art 1 is a writing means. **The corresponding technical feature is not special**
- **The common matter has neither same, nor corresponding special technical features**

## Technical relationship

Application

Multi-function pocket knife (A)	
Ball-point pen (B)	Pencil (C)
USB Stick (D)	Laser pointer (E)

Prior Art 1

Multi-function pocket knife (A)
with Fountain pen (F)

- Assume that (B) and (C) are obvious alternatives to (F) and so are not special
- (D) and (E) do make a technical contribution over Prior Art (1). However, they have different technical properties.
- **There are two separate and unrelated inventions**

## Conclusion

Since neither the same nor corresponding special technical features are present in claims 1 and 2, the inventions are not linked by a single general inventive concept and the requirements for unity of invention are not met.



Thank you for your attention!

