

**Comments by the Federal Republic of Germany
on Questions posed in the
Annex to Circular C. 6717**

(1) – Unity of invention

Q 1: According to German law, the admissibility of a group of inventions being claimed in a single patent application depends upon whether the principle of unity has been respected. Unity can be supposed if a technical link exists between inventions forming a single general inventive concept, which is expressed in corresponding or correspondingly functioning special technical features.

In determining whether there is a lack of unity, the German courts consider whether in the light of the technical relationship, whilst taking into account the practicability of the granting procedure and the clarity of the invention complex, it seems imperative to handle the claim in separate procedures.

The relevant norm pertaining to the necessity of unity is Section 34(5) of the German Patent Act (Patentgesetz/PatG), which provides that a patent application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Unity is also a peremptory provision of the German Order Concerning Patent Applications (hereinafter PatAnmV), particularly in connection with the admissibility of unconnected (independent) patent claims (ref. Section 4(5) PatAnmV). In addition to this, the “Examination Procedure Guidelines” adhered to by the German Patent and Trademark Office make reference to compliance with unity.

Since it is not possible for an examiner to conduct examinations of compliance with the principle of unity according to a rigid format, but only individually and according to the legally prescribed general principles having regard to relevant court decisions, examiners in the German Patent and Trademark Office are not required to adhere to any further, binding methodology.

Q 2 and Q 3: Although in some cases the question of unity is difficult to answer from a technical point of view, the “standards” exceeding the decisive criteria described in the answer to **Q1** do not appear to be expedient due to the fact that such these more extensive “standards” are generally developed in the course of handling future cases, and are not determinable beforehand.

Q 4: According to domestic interpretation, the necessity of unity should be rooted in the Substantive Patent Law Treaty (SPLT). It would thus seem prudent to make use of the broadly worded formulation in Section 34(5) PatG to this end.

Section 34(5) PatG reads as follows:

“The patent application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”

(2) – Linking of claims

Q 5: The German Patent Act currently in effect does not speak specifically of dependent or independent claims. Instead, it covers claims in general. The applicable Order Concerning Patent Applications, supplementary to the Patent Act, explicitly declares both types of claims as being admissible (ref. Section 4(4) – principal claims – and Section 4(6) PatAnmV – dependent claims).

The “Examination Procedure Guidelines” adhered to by the German Patent and Trademark Office contain references to the definition of dependent and independent claims. Pursuant thereto, dependent claims referring to a particular embodiment or distinct types (dependent claims) may be linked to principal claims. Moreover, additional independent claims are admissible, if they address a single problem.

Q 6: Neither the German Patent Act, nor the Order Concerning Patent Applications, nor the Examination Procedure Guidelines contain restrictions on how to link independent and/or dependent claims. The authoritative source in this matter is the principle of unity, which, pursuant to Section 34(5) PatG, must be complied with at all times.

Q 7 and Q 8: The same answer as was provided for **Q 2** also applies here. It would appear to be sufficient to roughly lay down the definition of dependent and independent claims in the “Guidelines”.

(3) – Number of claims/clear and concise claims

Q 9 In German law, it is not possible to limit the number of claims on the basis of the stipulation alone that claims must be formulated clearly and concisely. However, where

numerous claims with consequent cross references exist, the examiner is required to ensure that redundancy and nonsensical statements in technical areas do not arise and that the concept of unity is complied with. Nevertheless, it does not seem necessary to address the terms “clear and concise” in the draft SPLT, as experience has shown in Germany that the applicant has an intrinsic interest in formulating claims in a clear and concise manner. This is due to the fact that providing concrete and overly detailed descriptions of the subject matter of the invention in the claim invariably pose the risk of an inappropriate reduction in the extent of protection.

Q 10 to Q 13: The German Patent and Trademark Office cannot currently limit the number of claims except for factual reasons relating to the subject matter (see elaboration on **Q 9**). Still, applications containing numerous claims generate more work for the examiner. It may therefore be worth considering, for instance, whether provision should be made for a scale of graduated fees.

(4) - Mega-applications or large sequence listings

Q 14: For the time being, the number of so-called mega-applications being filed with the GPTO is presently manageable, while a further increase is expected particularly in the area of biotechnology. In order to avoid problems in the processing of, at times, enormous amounts of paper and extensive publication costs, electronic solutions will increasingly be employed.

For instance, sequence reports will only be submitted in future in a form that can be read electronically; also, patent applications containing more than 300 pages will only be published electronically.

Q 15: Hardcopy sequence reports are practically irrelevant in the examination process. The examination is conducted exclusively in electronic form (structural comparison via applicable DP programs).

As far as the research and detailed examination of other mega-applications is concerned, up to now no proposal has been made to consider the development of new strategies or special measures. For the time being, legal provisions and references in the patent literature delineating how to formulate patent claims have been a sufficient apparatus. However, the research and examination Guidelines of the German Patent and Trademark Office are presently being revised with a view to increasing precision. The hope is, in particular, to facilitate research and examination of especially extensive applications.

Q 16: From our point of view, it would be appreciated if the regulations in the SPLT regarding patent applications, which contain different invention subject matter and mega-applications, would be drafted as broadly as possible, so as to allow the Offices as much flexibility as possible for employing measures in the treatment of these particularly work-intensive applications.

Moreover, it might be sensible to introduce special fee schedules, such as a fee required for applications exceeding a certain number of pages or a special fee for sequence reports on databases, as provided for by the PCT in rule 15.2 of the implementing regulations (AusfO), or in Section 803 of the administrative regulations. Financial participation on the part of the applicant in the high costs of the processing of extensive applications could perhaps lead to a greater concentration on the absolute essentials in the preparation of applications.