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National Workshop on the Patent Cooperation Treaty (PCT) System

# Unity of Invention

November 28, 2016

Japan Patent Office

- I. Definition and Purpose of “Unity”
- II. How to examine “Unity”

# I. Definition and Purpose of “Unity”

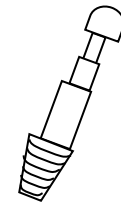
## A. Definition

The unity of invention is one invention or a group of inventions so linked as to form a single general inventive concept.

- ✓ The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). (Rule 13.1)

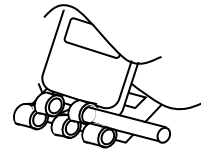
Claim 1 :

Antenna of high sensitivity for a cell phone.



Claim 2 :

Hinges for folding a cell phone.



Satisfy the “Unity” requirement?

# I. Definition and Purpose of “Unity”

## B. Purpose

The search fee is intended to compensate ISA for carrying out an international search on the international application relating to one invention only or to a group of inventions so linked as to form a single general inventive concept. (PCT Applicant’s Guide 7.015)

- ✓ The international application shall comply with the prescribed requirement of unity of invention. (Art.3, (4)(iii))
- ✓ If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant to pay additional fees. (Art.17, (3)(a))

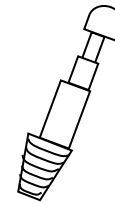
## II. How to examine “Unity”

### A. Finding Independent Claims

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. (PCT guideline 10.06)

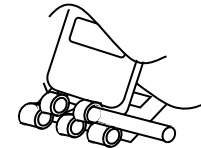
Claim 1 :

Antenna of high sensitivity for a cell phone.



Claim 2 :

Hinges for folding a cell phone.



Independent from  
Claim 1

## II. How to examine “Unity”

### B. Considering the Same or Corresponding Special Technical Features (STF)

#### 1. General

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. (Rule 13.2)

- ✓ The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. (Rule 13.2)
- ✓ Whether or not any particular technical feature makes a “contribution” over the prior art, and therefore constitutes a “special technical feature,” is considered with respect to novelty and inventive step. (PCT guideline 10.02)

## II. How to examine “Unity”

### B. Considering the Same or Corresponding STF

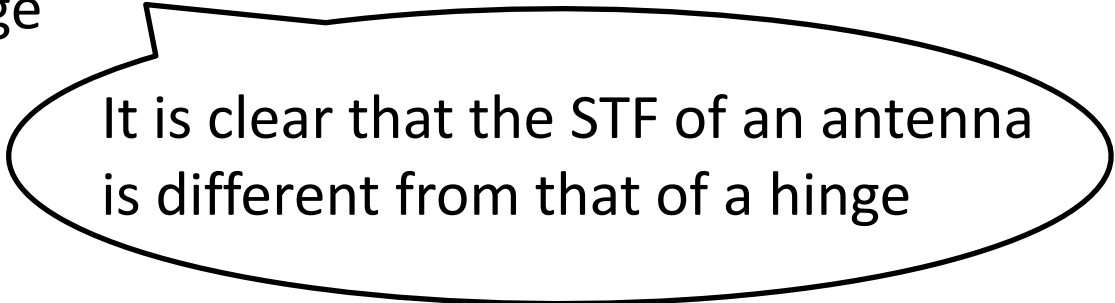
#### 2. “A priori” case

Lack of unity of invention may be directly evident “a priori,” that is, before considering the claims in relation to any prior art. (PCT guideline 10.03)

< a priori case >

Claim 1 : An antenna

Claim 2 : A hinge



It is clear that the STF of an antenna is different from that of a hinge



Lack of Unity

## II. How to examine “Unity”

### B. Considering the Same or Corresponding STFs

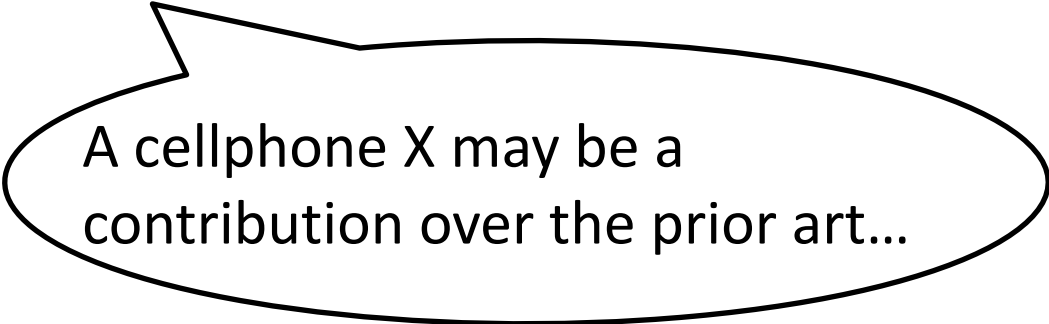
#### 3. “A posteriori” case -1/3

Lack of unity of invention may only become apparent “a posteriori,” that is, after taking the prior art into consideration. (PCT guideline 10.03)

< a posteriori case >

Claim 1 : A cellphone X + an antenna

Claim 2 : A cellphone X + a hinge



A cellphone X may be a contribution over the prior art...



## II. How to examine “Unity”

### B. Considering the Same or Corresponding STFs

#### 3. “A posteriori” case -2/3

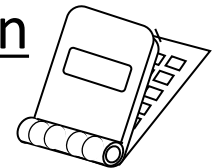
Lack of unity of invention may only become apparent “a posteriori,” that is, after taking the prior art into consideration. (PCT guideline 10.03)

< a posteriori case >

Claim 1 : A cellphone X + an antenna

Claim 2 : A cellphone X + a hinge

Cellphone X shown  
in the prior art



A cellphone X doesn't make any contribution over the prior art.

## II. How to examine “Unity”

### B. Considering the Same or Corresponding STF

#### 3. “A posteriori” case -3/3

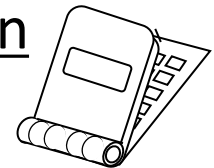
Lack of unity of invention may only become apparent “a posteriori,” that is, after taking the prior art into consideration. (PCT guideline 10.03)

< a posteriori case >

Claim 1 : A cellphone X + an antenna

Claim 2 : A cellphone X + a hinge

Cellphone X shown  
in the prior art



It is clear that the STF of an antenna  
is different from that of a hinge



Lack of Unity

## II. How to examine “Unity”

### C. Determining Which Claims should be Examined

The examiner determines which claims should be examined based on considering the same or corresponding STFs over the claims.

- ✓ After deciding that lack of unity exists, ... the International Searching Authority informs the applicant of the lack of unity of invention by a communication, preceding (but see paragraph 10.61, below) the issuance of the international search report and written opinion of the International Searching Authority, which contains an invitation to pay additional fees (Form PCT/ISA/206). (PCT guideline 10.60)
- ✓ The examiner may be able to establish both an international search and a written opinion covering more than one invention with negligible additional work, in particular, when the inventions are conceptually very close. In those cases, the examiner may decide to complete the international search and written opinion for the additional invention(s) together with that for the invention first mentioned. (PCT guideline 10.65)

## II. How to examine “Unity”

### D. Drafting Documents

Informing the applicant of the lack of “Unity” with:

1) the result for the invention first mentioned in the claims

-> PCT/ISA/206

- Partial ISR
- Reasons for which the international application is not considered as complying with the requirement of unity of invention
- Separate inventions, number of additional search fees, and the amount to be paid

2) the result for all the invention in the claims (without inviting the applicant to pay an additional search fee in respect of the additional inventions searched, but stating the finding of lack of unity of invention.)

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## II. How to examine “Unity”

### E. Reminder for examining “Unity”

The rule should not be applied rigidly.

- ✓ Although the lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. (PCT guideline 10.04)
- ✓ The Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the international search to certain classification groups. (PCT guideline 10.05)