

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PATENT COOPERATION TREATY (PCT)

Tenth Session

Geneva, September 13 to 15, 2004

UNITY OF INVENTION:  
MODIFICATION OF ANNEX B  
OF THE ADMINISTRATIVE INSTRUCTIONS:  
MARKUSH PRACTICE

*Document prepared by the International Bureau*

## SUMMARY

1. A minor modification of a substantive nature of Annex B of the Administrative Instructions is proposed, to be considered for introduction together with the modifications proposed in document PCT/MIA/10/2, which are of a formal nature. This sets out more clearly the interpretation of Markush practice which was considered appropriate by the Meeting for inclusion in the PCT International Search and Preliminary Examination Guidelines with effect from January 1, 2004.

## BACKGROUND

2. In discussions at its seventh to ninth sessions, the Meeting agreed that clarification was required to the guidelines on how to deal with unity of invention in the case of "Markush" groupings. Following consultation using the electronic forum, an appropriate approach was agreed and incorporated into paragraph 10.17(b) of the PCT International Search and Preliminary Examination Guidelines (document PCT/GL/ISPE/1).

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3. It would be desirable also to clarify the matter directly in the Administrative Instructions, particularly in view of the fact the PCT International Search and Preliminary Examination Guidelines are directed to the International Authorities performing international search and international preliminary examination, whereas the Administrative Instructions are also relevant to processing of the international application in the national phase.

#### PROPOSAL

4. The Annex to this document contains a proposed addition to paragraph (f)(ii) of Part 1 of Annex B of the Administrative Instructions to address this issue. The modified text would correspond to that in paragraph 10.17(b) of the PCT International Search and Preliminary Examination Guidelines.

5. If the Meeting considers this modification to be appropriate, the International Bureau would include the additional text in the proposed consultation with designated and elected Offices concerning modification of Annex B of the Administrative Instructions outlined in paragraph 5 of document PCT/MIA/10/2.

*6. The Meeting is invited to comment on the proposed approach to modification of Annex B of the Administrative Instructions set out in paragraphs 4 and 5, above.*

[Annex follows]

ANNEX

PROPOSED MODIFICATIONS OF PARAGRAPH (F) OF ANNEX B  
OF THE ADMINISTRATIVE INSTRUCTIONS (UNITY OF INVENTION)

(f) **“Markush Practice.”** The situation involving the so-called “Markush practice” wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

(i) When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

(ii) In paragraph (f)(i)(B)(1), above, the words “significant structural element is shared by all of the alternatives” refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, [and the common structure is essential to the common property or activity](#). The structural element may be a single component or a combination of individual components linked together.

(iii) In paragraph (f)(i)(B)(2), above, the words “recognized class of chemical compounds” mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

(iv) The fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

(v) When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised.

[End of Annex and of document]