

WIPO



PCT/MIA/11/11

ORIGINAL: English only

DATE: February 8, 2005

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Eleventh Session
Geneva, February 21 to 25, 2005

APPLICATION OF PCT RULES 13.1 AND 13.2
(LACK OF UNITY OF INVENTION)

Document prepared by the International Bureau

1. The Annex contains a paper by the European Patent Office (EPO) concerning the application of PCT Rules 13.1 and 13.2 to the case where prior art exists which is relevant to the novelty and inventive step of all the independent claims.

2. *The Meeting is invited to discuss the interpretation and application of Rules 13.1 and 13.2, as requested in the Annex, and to consider whether any clarification of these Rules or the relevant guidelines may be desirable.*

[Annex follows]

E

ANNEX

APPLICATION OF PCT RULES 13.1 AND 13.2
(LACK OF UNITY OF INVENTION)

The EPO would like to have the other authorities view on the following problem we have encountered when applying Rule 13.2:

Rule 13.1 PCT states that 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.

Rule 13.2 PCT further specifies this by stating that Rule 13.1 is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression “special technical feature” meaning those features that define a contribution which each of the claimed inventions makes over the prior art.

The problem we have encountered will be illustrated by way of example:

Example: Consider an application containing 3 independent claims which are directed to three different inventions; as an extreme example we take (i) a radio, (ii) a pencil and (iii) aspirin.

Applying Rule 13.1 and 2 PCT we notice that there are no common or corresponding features at all and therefore conclude that the application lacks unity of invention. This works fine as long as each claim has a special technical feature defining a contribution over the prior art; i.e. as long as we have three “real” inventions.

Now, considering the case where the claims indicated above contain no further features than any conventional radio, pencil or aspirin; ie the claims are not novel and therefore obviously do not have any “special technical features” at all.

In such case two interpretations of Rule 13.2 are possible:

- a) Since there are no special technical features there cannot be any *common* special technical features providing the required unifying technical relationship; or
- b) Since there are no special technical features, we don't have different inventions (in fact we have no inventions at all) and therefore cannot raise a lack of unity objection.

In the above simple example it might be considered that it does not make much difference which approach is taken, however, in most real cases the search examiner will have made three complete searches before being able to determine that the “inventions” actually were not “inventions”. Therefore, if Rule 13.2 is interpreted as stated under b) no lack of unity of invention could be raised for cases where the searches revealed pertinent documents for all claims.

This also has an impact on the examination under Chapter II, since if interpretation b) is chosen then lack of unity cannot be raised under Chapter II, although 3 “inventions” would have to be examined.

Conclusion: we doubt that the second interpretation (b) was intended when the Rule was drafted (see also eg the paper SCP/8/4 from 2002 which contains “Practice Guidelines under the substantive patent law treaty” and which clearly states that “the essential purpose of the requirement of unity of invention is to facilitate the administration and the search of applications”).

Such interpretation would also not be in line with equal treatment between applicants, since an applicant who files a non-unitary application would have enormous advantage over another applicant who filed each invention in a separate application.

However, due to the wording of Rule 13.2 PCT the EPO Boards of Appeal have in some recent decisions taken the view that this second interpretation is to be applied. In other words, that in the case where pertinent prior art is found for all inventions a lack of unity objection cannot be raised.

We would, therefore, like to have a feedback from the other authorities on how they handle these kind of cases.

[End of Annex and of document]