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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
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## STANDING COMMITTEE ON THE LAW OF PATENTS

### WORKING GROUP ON MULTIPLE INVENTION DISCLOSURES AND COMPLEX APPLICATIONS

Third Session  
Geneva, May 13, 2003

#### STATUS OF DISCUSSION

*Document prepared by the International Bureau*

#### I. SPECIAL PROCEDURES TO TREAT COMPLEX APPLICATIONS, SUCH AS MEGA-APPLICATIONS OR LARGE SEQUENCE LISTINGS

1. The discussion at the second session of the Working Group on Multiple Invention Disclosures and Complex Applications (“the Working Group”) revealed that many Offices were effectively dealing with complex applications by way of a strict application of existing rules, although the treatment of complex applications raised some operational concerns. No delegation spoke in favor of including any provisions relating to complex applications in the draft Substantive Patent Law Treaty (SPLT). There was general agreement that the issue of complex applications should be dealt with in other fora, such as among the Trilateral Offices or in the relevant bodies of the Patent Cooperation Treaty (PCT) (see paragraph 344 of the draft Report (document SCP/8/9 Prov.2)).

2. The seventh session of the Meeting of International Authorities Under the PCT (MIA), held in Geneva from February 10 to 14, 2003, discussed draft combined Guidelines for International Search and Preliminary Examination under the PCT. The issue of complex applications has been addressed, in particular, in connection with certain situations in which limited international search or international preliminary examination is conducted. The Trilateral Offices, which are presumably mostly affected by such complex applications, may

share their experience and information regarding the Trilateral projects on this matter with other members and observers of the Working Group. In view of the discussion at the last session of the Working Group, the members and observers of the Working Group are invited to consider the desirability of further discussion on this topic by the Working Group.

## II. NUMBER OF CLAIMS / CLEAR AND CONCISE CLAIMS

3. The Working Group, at its second session, generally agreed that matters which could be further discussed in the context of the draft SPLT should be reviewed by the Standing Committee on the Law of Patents (SCP), as a number of different reasons motivated the filing of a large number of claims (see paragraph 344 of the draft Report (document SCP/8/9 Prov.2)). One possible way to reflect the discussions in the Working Group may be to clarify the issues as much as possible in the Practice Guidelines, for example, by establishing a list of examples of unduly multiplied claims that do not meet the requirements of clarity and conciseness. In connection with PCT Rule 6.1(a), it should be noted that the issue has been addressed at the MIA in conjunction with the discussion on the draft combined Guidelines for International Search and Preliminary Examination under the PCT. In view of the discussion at the last session of the Working Group, the members and observers of the Working Group are invited to consider the desirability of further discussion on this topic by the Working Group, or whether the SCP should discuss this matter further.

## III. LINKING OF CLAIMS

4. The discussion at the second session of the Working Group showed that a majority of delegations as well as user groups accepted the dependency of multiple dependent claims on other multiple dependent claims without any difficulty (see paragraph 344 of the draft Report (document SCP/8/9 Prov.2)). In view of the discussion at the last session of the Working Group, the members and observers of the Working Group are invited to consider the desirability of further discussion on this topic by the Working Group, or whether the SCP should discuss this matter further.

## IV. UNITY OF INVENTION

5. At the second session of the Working Group, two delegations noted the problems derived from the unity of invention requirement under draft Rule 6 of the Regulations under the SPLT, which is in line with the relevant provisions under the PCT (see paragraph 344 of the draft Report (document SCP/8/9 Prov.2)). One of the issues at stake relates to the definition of the expression “special technical feature” in draft Rule 6, which may require a determination of lack of unity of invention *a posteriori*, i.e., an objection to unity of invention may arise only after taking the prior art into consideration. In the context of the PCT, such an *a posteriori* test would not seem to cause any difficulty, since lack of unity of invention would be raised by the international search authority or the international preliminary examination authority in conjunction with international search or international preliminary examination, respectively. However, in the context of the SPLT which would harmonize national/regional patent laws, an *a posteriori* determination would, in practice, not be applicable to certain Offices, for example, Offices that do not conduct substantive examination. Despite the different nature of the processing of international applications under the PCT during the international phase and the processing of national/regional applications

within national/regional patent systems, for the users of the patent system, it may be desirable to harmonize the unity of invention requirement in order to apply the same standard both under the PCT and under the national/regional laws.

6. For the purpose of facilitating the discussion, different alternative approaches may be envisaged. The first approach would be to maintain current draft Rule 6 of the SPLT according to which the expression “special technical features” means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Offices that do not conduct substantive examination may only determine unity of invention *a priori* based on the assumption that the claimed inventions avoid the prior art. Since lack of unity of invention is not a ground for the revocation of patents, in the countries of those Offices, the absence of unity of invention *a posteriori* would not be raised. Consequently, there would be no international harmonization as regards unity of invention.

7. The second approach would be to explore the feasibility of a new *a priori* test that could be applied by any Office, while maintaining the concept that the requirement of a single general inventive concept would be complied with only when there is a technical relationship among those inventions involving one or more of the same or corresponding “special technical features”. In line with national practices applied in some Offices (see examples in Annex I), an *a priori* test would focus solely on the technical relationship among a group of inventions concerned without taking account of the prior art. The required technical relationship may be assumed where a group of inventions fall under, for example, the situations described in Annex II.

8. Such a test should, in practice, be applicable to all national/regional Offices concerned. It should accommodate the interests of both examining and non-examining Offices as well as both small and large Offices. It should further be clear and straightforward so that it could be applied by any Office in a uniform manner. Harmonized rules for the determination of unity of invention applicable both under the PCT and national/regional laws constitute another important issue. As regards the PCT, currently, Annex B of the Administrative Instructions Under the PCT contains detailed guidelines on the unity of invention requirement. In view of its relevance to international search and international preliminary examination, the MIA has been discussing the incorporation of Annex B into the draft combined PCT International Search and Preliminary Examination Guidelines with possible modifications.

[Annex I follows]

ANNEX I

EXAMPLES: SUMMARY OF THE PRACTICES OF THE SWISS FEDERAL INSTITUTE  
OF INTELLECTUAL PROPERTY AND THE RUSSIAN PATENT OFFICE  
(ROSPATENT)<sup>1</sup>

*Swiss Federal Institute of Intellectual Property*

Since the Swiss Federal Institute of Intellectual Property does not examine the novelty and inventive step of patent applications, it needs a workable system to examine unity of invention without having to first look into the prior art.

Article 30(1) of the Patent Ordinance stipulates that, where the patent contains several independent claims, the technical link expressing the general inventive concept must be evident from the claims themselves. This requirement is complied with, in particular, where the application contains one of the combinations among the independent claims enumerated in Article 30(2) of the Patent Ordinance, namely:

(i) in addition to a first claim for a given process, a claim for a means designed for carrying out the said process, a claim for the product resulting from the process and either a claim for an application of the process or for a use of the product, or

(ii) in addition to a first claim for a given product, a claim for a process for the manufacture of the said product, a claim for a means designed for carrying out the said process and a claim for a use of the said product, or

(iii) in addition to a first claim for a given device, a claim for a process for the operation of the said device and a claim for the manufacture of the said device.

Further, certain combinations of claims of the same category are also considered to comply with the unity requirement. Where the inventions concern processes, different processes are considered to meet unity, if their starting point and end point are identical, i.e., the differences reside only in the proceedings in between those points, or if their starting point or end point are identical, and the proceedings in between match to a large extent. Where the inventions concern products, two products meet unity, if they are technically so complementary that they work together, e.g. key and lock. Two products also meet unity, if together they form a pair representing a part and the whole, e.g. filter of a cigarette and cigarette.

*Russian Patent Office (ROSPATENT)*

In accordance with the Patent Office Rules, an application is considered to relate to one invention, if the claims contain one independent claim, including the cases where the claim

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<sup>1</sup> Further information regarding unity of invention practices applied under various national/regional laws are available on the SCP Electronic Forum web site (<http://www.wipo.int/scp>; see the Working Group, second session).

contains alternatives. An independent claim is not considered to relate to one invention and the use of alternatives is not permitted in the following cases:

- (i) where the alternative features do not lead to the same technical result;
- (ii) the alternative relates to a group of features each of which includes several functionally independent features;
- (iii) the choice of the alternative depends on the choice made for the other feature(s).

In addition, an independent claim is not considered to relate to one invention where it includes the characteristics of inventions relating to subjects of different kinds, or an array of means, each of which has its own designation, without a common general purpose.

Where a group of inventions is characterized in more than one independent claim, the requirement of unity of invention is considered to be met in the following cases:

- (i) one of the inventions is designed to obtain another invention;
- (ii) one of the inventions is designed to produce another invention (e.g., a method and a device for carrying out the method);
- (iii) one of the inventions is designed for use in another invention (e.g., a method and a substance designed for use in a method);
- (iv) one of the inventions is designed for use of another invention (e.g., an electric lamp and an attached holder);
- (v) the inventions relate to an objective of one kind, or an identical purpose, for obtaining the same technical result.

In order to comply with the unity requirement, a direct link between any claim and at least one other claim, as well as indirect link with the remaining claims, are sufficient.

[Annex II follows]

ANNEX II

UNITY OF INVENTION CHECK LIST<sup>1</sup>

- (A) Where claims belong to different categories,
- (i) a product and a process for manufacturing the product;
  - (ii) a product and a method of use of that product;
  - (iii) a product, a process for manufacturing the product and a method of use of that product;
  - (iv) a process and an apparatus or means to carry out the process;
  - (v) a product, a process for manufacturing the product and an apparatus or means to carry out the process;
  - (vi) a product, a process for manufacturing the product, an apparatus or means to carry out the process and a method of use of that product.
- (B) Where claims belong to the same category,
- (i) combination and sub-combination;
  - (ii) inventions which function in a cooperative manner (interrelated subject matter);  
ex. transmitter and receiver; canon and munitions; key and lock
  - (iii) an invention which is specially adapted to use for another invention, including “a part and the whole”;  
ex. filament A for a lamp and lamp B having filament A; compound X and insecticide composition comprising compound X and a carrier
  - (iv) inventions which share a main common feature characterizing the inventions;  
ex. display with features A+B and display with features A+B+C
  - (v) alternatives;  
ex. Markush practice
  - (vi) intermediate/final product.

[End of Annex II and of document]

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<sup>1</sup> If the suggested approach is acceptable, the list would require further elaboration. For example, as regards the inventions in different categories, for example in item (i), whether a process need to be “especially adapted” for manufacturing the product may be the subject of further consideration.