

AIPPI COMMENTS ON THE SCP WORKING GROUP ON MULTIPLE INVENTION DISCLOSURES AND COMPLEX APPLICATIONS

1) Unity of invention

AIPPI strongly believes that the conditions for unity of invention laid down in Rule 13 PCT are adequate. Other practices lead to unnecessary requirements to drop claims (which can then be used in one or more divisional applications, thereby leading to doubling, tripling or worse of patenting costs) even when all independent claims in the application have the same or corresponding « special technical features », as defined in Rule 13 PCT : such practices must be avoided. Clearly, if all independent claims have the same or corresponding « special technical features », there is only one invention present in the application, so that the Office only needs to search and examine that one invention, so that there is no need whatsoever to require the applicant to file one or more divisionals.

AIPPI recalls that the present wording of Rule 13 PCT is based on a trilateral agreement, which is most regrettably still not implemented by all concerned offices.

2) Link between the claims

AIPPI believes that if an independent claim is patentable, all claims depending from that independent claim are necessarily patentable too. Such dependent claims therefore only need to be examined on clarity, conciseness and support in the description. For the remainder, AIPPI refers to its comments on Rule 6 PCT submitted to this electronic forum.

3) Number of claims

Clearly, it is not possible to have a general rule saying that no patents shall have more than 20 claims, because the nature of the invention may require a large number of claims. A plurality of independent claims may be necessary to cover all commercially relevant aspects of the invention. For example, an invention relating to a transmission system may have independent claims on an encoding method, an encoding device, a transmitter containing a decoding device, a decoding method, a decoding device, and a mobile handset containing a decoding device, plus dependent claims for each of these independent claims ; a similar situation with multiple independent claims will occur in the biotechnology field. There is nothing wrong with that, as long as the conditions of Rule 13 PCT have been met.

On the other hand, it is clear that the work for offices increases with the number of claims. The best way to compensate offices for that work is to have fees that depend on the number of claims. In several national patents systems, such number-of-claims-dependent fee structures already exist. At this moment in time, the PCT search fee and the PCT preliminary examination fees do not yet depend on the number of claims. Therefore, an extra fee could be provided for each claim above the first 20.

4) Requirement that claims shall be « clear and concise »

AIPPI is satisfied with this requirement, which has greatly served the PCT users (Article 6 PCT), and sees no good reason to replace this requirement by something else. In the transmission system invention example set out above, it is obviously necessary to have several independent claims covering distinct commercial aspects of the invention, but it is clearly not necessary to have a plurality of different independent claims on the same decoding device, each with a different permutation of technical features, thereby obscuring what the invention is all about. The « clear and concise » requirement can be clearly used to limit such a plurality of independent claims on the same commercial aspect of the invention.

5) Specific procedures for treating « complex applications », such as « mega-applications » or long sequence listings

AIPPI strongly believes that there is no need for measures additional to the already existing requirements laid down :

- in Article 5 PCT (The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art),

- in Article 6 PCT (The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description), and

- in Rule 13 PCT (Unity of invention),

when coupled with the already existing page-number-dependency of the international fee, and the above-suggested claim-number-dependency of the PCT search fee and the PCT preliminary examination fee.