

Subject: Comments on certain issues identified at the sixth session of the SCP in connection with the first session of the Working Group on Multiple Invention Disclosures and Complex Applications

(1) Unity of invention

According to the PCT Rule 13(1) “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) says “Where a group of invention 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. 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.”

According to Rule 13(3) “The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.”

According to the current version of the Article 6 of the draft SPLT “The claims in the application shall relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept.” The current version of Rule 7 of the draft SPLT on Details Concerning the Requirement of Unity of Invention Under Article 6 is entirely in line with the Rule 13(2) and (3) of the PCT.

In the Hungarian Law No. XXXIII of 1995 on the Protection of Inventions by Patents the Article 59 provides that “A patent application may seek patent protection for one invention only or for a group of inventions so linked as to form a single general inventive concept.” According to Article 73 “If the applicant has claimed patent protection for more than one invention in one application, he may divide the application, retaining the date of filing and any earlier priority, until such time as the decision on the grant of a patent becomes final.” A fee prescribed by special legislation shall be paid for division within two months from the filing of the relevant request.

The fee for the request for the division of a patent application corresponds to the filing and search fee, if filed prior to the request for substantive examination and corresponds to the sum of the filing and search fee and the examination fee after the filing of that request, for each further application.

It can be seen that the Hungarian legislation is fully in line which the corresponding provisions of the PCT and the draft SPLT. The costs of the search of the independent inventions will be paid at the division of the application which didn't meet the criteria of unity of the invention. In that case, after the application was divided, we use (of course) the results of our earlier search. So, in simpler cases, excepting the new challenges of the complex technology applications, which doesn't represent a big part of our workload, we are totally satisfied which the current and the planned international legislative issues.

(3) Number of claims

According to the current plans of the Working Group might consider the possibility of a reasonable limitation on the number of claims or the number of independent claims. We don't think that any legal limitation on the number of claims would be an acceptable solution for the applicants. In the Hungarian legislation the filing and search fee is increased by a certain amount of fee for the eleventh and each subsequent claim. By this solution it is possible to achieve a reasonable number of claims from the point of view of the applicant and that of the office as well.

(5) Special procedures to treat complex applications, such as mega-applications, or large sequence listing

It was not very long ago that the Hungarian Patent Office got the first complex applications; but nowadays we really face the problem of searching and examining them. So, we have a big interest in the fact that the Working Group tries to explore the best practice for processing the complex applications.

Seeking answer to the arising questions the Hungarian Patent Office tried to follow the recent developments in biotechnology patenting, and studied thoroughly the relating earlier and recent decisions of the EPO technical boards of appeal about the approach to the requirements of Article 83 EPC (sufficiency) and Article 84 EPC (clarity and support).

Two years ago the EPO adopted the complex applications approach (OJ EPO 2000, 228) and introduced amended guidelines in search and examination using the provisions of Rule 45 EPC (or Art 17.2 PCT) to issue partial search reports. This approach means that unduly broad claims will be searched on the basis of the examples, and desiderata claims may not be searched at all. A strict approach to clarity, support and sufficiency is then taken in substantive examination. The new guidelines point out that once reasoned has been raised by the examiner, the burden of proof is on the applicant to refuse the objection. The examiner is furthermore not required to cite a document as basis for raising an objection. The Hungarian Patent Office hasn't adopted this method yet.

According to the statistics of the EPO during the first years of the new approach, about 2% of all searches were issued as partial search reports; the rate was nearly times as high for PCT searches as for European ones. Most cases were in chemistry and pharmacology, followed in frequency by biotechnology and food chemistry.

According to the presentation of Dr. Yeats the proportion of biotech applications exhibiting lack of unit of invention is inordinately high (at least 20%). Many of these concern several unrelated DNA sequences in one application; a recent file disclosed over 83,000 sequences. Where the sequences are not linked by a common inventive concept as required by Article 82 EPC, an objection of lack of unity of invention is raised and a partial search report covering only subject matter related to the first sequences is issued. The consequences can be that examination of the remaining sequences is deferred for several years.

If the original file is a PCT application, the applicant may decline to pay additional search fees in the international phase and enter the national or the regional phase with an unamended application. At the start of the national or the European examination, the applicant has a

further opportunity to pay additional search fees and obtain a search for one or more of the other sequences disclosed in the application. According to the European practice, when the first invention is granted, at the Rule 51(6) EPC stage, the applicant may file a divisional application containing all the remaining sequences originally disclosed. He may later file yet another divisional based on the original, so-called grandparent application. In this way examination of any particular sequence, together with other associated subject-matter, may be postponed for a substantial period of time, thus giving the applicant much flexibility in deciding which subject matter to pursue and when. The Hungarian Patent Office will perhaps follow this practice, but we might wait for the developments on this issue.

The situation is the same regarding the applications relating to inventions based, at least to some degree, on bioinformatics. The principal type involves the identification of open reading frames and the prediction of protein functions by means of computerized sequence comparisons. Other fields include the use of computer models of protein crystal structure in drug design and in silico methods for identifying compounds which modulate activities. In cases where computer programs or inventions with computer aspects are claimed, the exclusion of computer programs as such from under Article 52(2)(3) EPC plays a role in examination. We follow the case-law of the EPO in examining computer-implemented inventions according to that inventions having a technical character when considered as a whole are not excluded from patentability. According to T 1173/97 (OJ EPO 1999, 609), claims directed to computer programs are also patentable if the corresponding method claim is patentable and the program recites all the features in the method claim. The examination practice is to assess whether the invention solves an objective technical problem over the closest prior art. If so, normal examination of inventive step ensues.

We are looking forward with great expectations to the results of the Working Group.

Sincerely yours,

Márta Posteiner-Toldi

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