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**UNITED STATES PROPOSAL FOR A WORKING GROUP ON MULTIPLE  
INVENTION DISCLOSURE AND  
COMPLEX APPLICATIONS  
-  
WIPO SCP/6/6**

**UNICE COMMENTS**

**1) UNITY OF INVENTION**

UNICE strongly believes that the conditions for unity of invention laid down in Rule 13 PCT are adequate and preferable over the US restriction practice.

The US restriction practice leads to unnecessary requirements imposed by the USPTO 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".

"Special technical features" are those features that distinguish the invention in a patentable manner from the closest prior art document and that thereby make the invention patentable over the prior art. Clearly, if all independent claims have the same or corresponding "special technical features", there is only one invention presented 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.

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

**2) LINK BETWEEN THE CLAIMS**

UNICE 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<sup>1</sup>.

**3) NUMBER OF CLAIMS**

UNICE does not share the view to have a general rule saying that no patent 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. 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 patent systems, such number-of-claims-dependent fee structures already exist. For the time being, the PCT search fee and the PCT preliminary examination fees do not yet depend on the number of claims. For example, the EPO could easily replace its

<sup>1</sup> Please also consult UNICE's comments on Rule 6 PCT which were posted on WIPO  
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present fixed PCT search fee of EUR 945 by a claim -number-dependent PCT search fee of EUR690plusEUR40foreachclaimabovethefirst10claims.

#### 4) REQUIREMENT THAT CLAIMS SHALL BE "CLEAR AND CONCISE "

UNICE is fully satisfied with this requirement, which has well served both the PCT users (Article 6 PCT) and the EPC users (Article 84 EPC) since 1978. Against this background, UNICE does not see any reason why this requirement should be replaced by something else .

While 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, 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 well 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

UNICE strongly believes that there is no need for additional measures 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* .),
- 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* .),
- Rule 13 PCT ( *Unity of invention* ),
- 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.

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