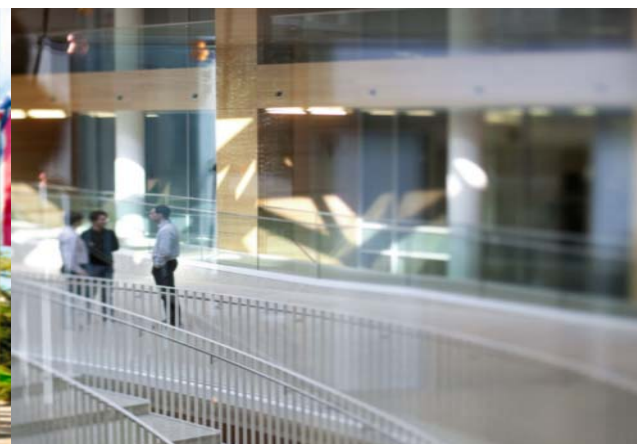




Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Unity of invention EPO/SIPO

ICG, 19 January 2017, EPO, Munich



Seek endorsement by the IP5 Heads of Office to

- reach a harmonised IP5 practice for unity of invention for international patent applications by end 2018
- Pending internal constraints, the alignment of practices with respect to applications entering the national/regional phase shall also apply to those offices

- Scope
 - alignment of practices re international applications, including applications entering regional/national phase to the extent that constraints permit

- How
 - benchmarking exercise
 - analyse practices against the background of the Chapter 10 ISPE
 - target gaps identified and consider measures towards alignment

- Timeframe
 - complete work at IP5 level by end 2018

- Interaction with other fora
 - support MIA work and share outcome of the PHEP study with the MIA



– EPO // SIPO proposal

➤ Template 1

- consolidation of information contained in IP5 Unity of invention report
- facilitate better usability of report data

➤ Template 2

- case study
- template to facilitate analysis of practices
- interpretation, underlying reasoning and the approaches followed

➤ Templates 1 + 2 to be completed: end January 2017

- Intermediate review: ad hoc PHEP, April 2017



Template 1 - part 1

General Questions about Unity

- Does the order of the claims make a difference to the assessment of Unity or the number of inventions?
- Does the choice of prior art make a difference to the number of inventions?
- At a respective Office, can lack of unity be raised among the claims for a product, a process adapted for the manufacture of said product, a use of said product?
- Can lack of unity of invention exist with a single claim/among the independent claims/between an independent claim and its dependent claims/among dependent claims of the same independent claims?
- Describe the standard of unity of inventions when dealing with the international applications in your offices. To what extent do the examiners in your office enjoy the discretion to decide whether to raise an objection of unity of invention?



Template 1 - part 2

PCT CH. I Questions

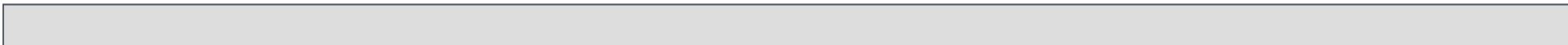
- Can the examiner raise a non-unity objection at the PCT search stage?
- Is the applicant informed of non-unity at the search stage?
- Is the applicant invited to pay additional search fees at the search stage for the other inventions?
- Is the applicant requested to limit the application at the search stage?
- If the independent claim 1 comprises several alternatives, is the "first invention" determined by the first mentioned alternative?
- Can the examiner select which invention to search?
- Does the examiner search only the claims within the first invention?
- Is the disclosure of the invention in the description taken into account when considering non-unity?

- More detailed examples of when an examiner would NOT raise a lack of unity objection at the search stage / would NOT request additional search fees at the search stage



Template 2 - example

Example	Stage of procedure / Scenarios	Claims / Further details of scenarios	Would your office consider these claims to be Unitary (U) or Non-Unitary (NU)	Would your office raise an objection of non-unity <u>at this stage</u> (R=raise / N= not raise)	Would your office request additional fees (Y/N)
Ex. 1	PCT CH.I Stage		U / NU	R / N	Y / N
	The application comprises two independent claims:	<p>Independent claim 1: A Multi-function Pocket Knife (A) with a USB memory stick (B), whereby B solves the problem (X) of how to provide a multi-function pocket knife which can carry data electronically.</p> <p>Independent claim 2: A Multi-function Pocket Knife (A) with a laser pointer (C), whereby C solves the problem (Y) of how to provide a multi-function pocket knife which can point at a distance.</p>			
	Scenarios:				
1a	A is novel and inventive (the multi-function pocket knife is novel and inventive)	B is novel. B and C are different. Problems X and Y are different.			
1b	D1 discloses multi-function pocket knives, so A is known.	B is novel. B and C are different. Problems X and Y are different.			



– EPO // SIPO proposal

- Additional templates to be introduced: ad hoc PHEP April 2017 (Chemistry and Electricity, tbc)
- Progress report at IP5 Deputy Heads meeting: April 2017
- Completion of a first analysis' cycle: PHEP October 2017
- Further analysis of study results and preparation of study outcome: 2018

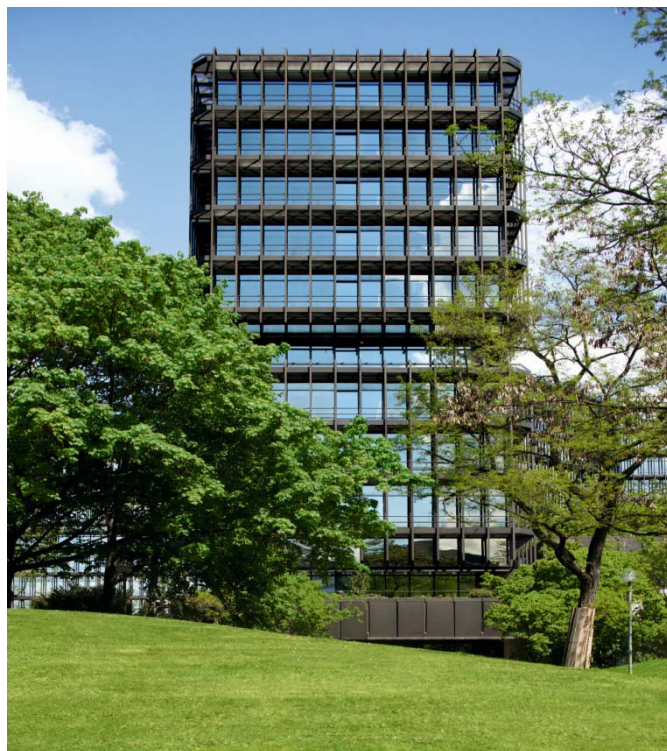


– IP5 ICG

- IP5 Industry to provide input on
 - study approach
 - methodology
 - scope of study
 - selected technical areas
 - specific study template
 - issues of importance re unity of invention in the field of case study 1 – mechanics
 - application of unity of invention requirement in the IP5 jurisdictions
 - recurrent problems, i.e. divergences

- continued interaction





Thank you for your attention!

