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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

First Session
Geneva, May 7 and 8, 2002

POINTS FOR DISCUSSION

prepared by the International Bureau

INTRODUCTION

1. In accordance with the decision made by the Standing Committee on the Law of Patents (SCP), at its sixth session in November 2001, the International Bureau invited input from the members and observers of the SCP for the first session of the Working Group, which will be held on May 7 and 8, 2002 (see document SCP/6/9 Prov. 2, paragraph 212). The contributions received are posted on the SCP electronic forum: <http://www.wipo.int/scp>.
2. In view of the limited number of responses received, the International Bureau considers that, at this point, rather than to submit a complete set of suggestions by the International Bureau, it is appropriate to present a list of discussion points related to the five issues identified by the SCP, namely, unity of invention, linking of claims, number of claims, the requirement of "clear and concise" claims and special procedures to treat complex applications, such as mega-applications or large sequence listings.
3. In view of the limited working hours available for the session of the Working Group, it will be necessary to adopt a working procedure that will ensure timely reporting of the Working Group to the SCP so as to facilitate the discussion of the draft Substantive Patent Law Treaty (SPLT). Therefore, this document is also posted on the SCP electronic forum (<http://www.wipo.int/scp>), so that members and observers of the Working Group can share

information and exchange views among them prior to the first session of the Working Group. In particular, patent offices are invited to share their experiences and practices as regards the five issues agreed by the SCP. Members and observers of the Working Group are invited to participate in this process prior to the meeting so that substantive progress may be achieved by the first session of the Working Group.

A. Unity of invention

4. Consideration might be given to the question of whether the unity of invention standard set out in Article 6 of the draft SPLT (see document SCP/7/3) and Rule 6 of the draft Regulations under the SPLT (see document SCP/7/4) and PCT Rule 13.1 to 13.3 is an appropriate standard for the present as well as the future international patent system. According to this standard, where a group of inventions are claimed, they should be linked so as to form a single general inventive concept. The single general inventive concept is defined in a manner that there must be a technical relationship among those inventions involving one or more of the same or corresponding special technical features that define a contribution which each of those inventions, considered as a whole, makes over the prior art. Thus, in order to define those technical features, the prior art must be identified. As a consequence, the assessment of unity of invention has to be made *a posteriori*, i.e., after comparison of the claims with the prior art. However, in practice, lack of unity of invention might be directly evident *a priori* in some cases, or may only become apparent *a posteriori*.

- *Should such an a posteriori consideration be reviewed? If yes, should the Working Group identify a mechanism that allows a priori consideration, for example, the determination of the required relationship among the group of inventions contained in a single application on the basis of the language of the claims as presented?*

- *What are the methodologies used by the examiners of national/regional patent offices in order to determine compliance with the unity of invention standard (or “independent and distinct restriction” standard)? How, if necessary, could the effectiveness of the examination be improved while striking a balance with the fair treatment of the applicants? (These questions are also relevant as regards Part E., Special procedures to treat complex applications, such as mega-applications, or large sequence listings.)*

5. As pointed out by the Delegation of the United States of America (see page 2 of document SCP/6/6), both the unity of invention standard and the distinctness or independence of claimed inventions standard in the United States of America are umbrella concepts covering a series of practices as to the allowability of one or more claims in a single application. They cover claim categories (e.g., a claim for a product and a claim for a process especially adapted for the manufacture of the product and a claim for a use of the product, a claim for a process and a claim for an apparatus or means specifically designed to carry out the process), claim relation (e.g., combination and sub-combination claims, genus and species claims), and special practices (e.g., Markush-type claim). The practices concerning linking claims in the United States of America are described in the comment from the United States of America.¹ The Guidelines for Examination in the European Patent Office (EPO), Part C,

¹ See http://www.wipo.int/scp/en/working_group/comments.htm

Chapter III, item 7² and the Case Law of the Boards of Appeal, Part II, Chapter C³ provide detailed explanations concerning practices applied by the EPO. Further, it should be noted that amended Rule 29(2) of the Implementing Regulations to the Convention on the Grant of European Patents (hereinafter referred to as the “Regulations under the EPC”), which is intended to have the same effect as a strict application of Article 84 of the European Patent Convention (EPC) and former Rule 29(2) of the Regulations under the EPC, entered into force on January 2, 2002. In Japan, Section 37 of the Japanese Patent Law provides the joinder of inventions in a single application.⁴

- Should the Working Group establish guidelines or a set of examples concerning the type of claims acceptable in a single application? If yes, should they be included in the Practice Guidelines under the SPLT?

B. Linking of claims

6. Rule 5(5) of the draft SPLT (see document SCP/7/4) and PCT Rule 6.4 provide the rules concerning dependent claims and multiple dependent claims. The applicability of these rules might be further explored in view of increasing the efficiency of the examination procedure without creating unreasonable prejudice to the rights of applicants. In particular, the Working Group may consider the following issues:

- Should multiple dependent claims be allowed to refer in the cumulative to the claims on which they depend?

- Should the multiple dependent claims be allowed to depend on other multiple dependent claims?

7. The Delegation of the United States of America expressed concerns about different existing practices concerning the treatment of dependent claims and stated that a dependent claim should be examined fully and separately, i.e., as an independent claim containing all the limitations of the claim on which it depends.⁵ Such a difference, if any, may be due to the interpretation of the term “dependent claim” in draft Rule 5(5) of the SPLT.

- How should the term “dependent claim” in draft Rule 5(5) of the SPLT be defined? For example, should the following examples be covered by draft SPLT Rule 5(5)?

Ex. 1: An apparatus for carrying out the process of claim 1

Ex. 2: A plug for cooperation with the socket of claim 1 ...

Ex. 3: A machine according to claim 1 modified in that feature X is replaced by feature Y...

- Are there any obvious cases where the patentability of a dependent claim could be presumed based on the patentability of the claim on which it depends (for example, a

² Available at: http://www.european-patent-office.org/legal/gui_lines/index.htm

³ Available at: http://www.european-patent-office.org/legal/case_law/e/index.htm

⁴ Available at: <http://www.jpo.go.jp/shoukaie/patent.htm>

⁵ See http://www.wipo.int/scp/en/working_group/comments.htm

dependent claim for the use of a product claimed in an independent claim, where the product is patentable and is used with its features as claimed)?

C. Number of claims

8. A practice for limiting claims should be developed striking a balance between an easy comprehension of claims and fairness to the applicant. The following questions may be discussed by the Working Group under this heading:

- Should offices be allowed to limit the number of independent claims to a reasonable level? If yes, how should “reasonable level” be defined?

- Should offices be allowed to limit the number of dependent claims or distinct embodiments, such as large “Markush” groupings or other large groupings of independent species inventions, to a reasonable level? If yes, how should “reasonable level” be defined?

- Could the requirement concerning clarity and conciseness of the claims be invoked, and would it be sufficient, to refuse a plurality of claims containing substantially the same invention?

- Are there any alternative measures to avoid an application with an excessive number of claims? Could a fee structure depending on the number of claims be an effective measure?

D. Requirement of “clear and concise” claims

9. Article 11(2) of the draft SPLT provides that the claims, both individually and in their totality, shall be clear and concise. The Working Group may consider the interpretation of those terms in relation to the complexity of applications, in particular in the field of new technologies. The requirement of clarity and conciseness of the claims is linked to the issues of unity of invention, the number of claims and the linking of claims, such as dependent claims. The following issues, in particular, may be discussed:

- Under what circumstances could the requirement of clear and concise claims be invoked? In view of the fact that, under some national/regional laws, this requirement is not a ground for the revocation of patents, is this requirement considered to be of a formal nature under those laws?

- In connection with Rule 5(5)(c) of the draft SPLT, should there be any guidelines on how dependent claims and multiple dependent claims should refer back to other claims?

E. Special procedures to treat complex applications, such as mega-applications, or large sequence listings

10. The Working Group may explore best practices for processing complex applications, such as mega-applications and applications containing large sequence listings, during the search and examination procedure. In document SCP/6/6, the Delegation of the United States of America expressed interest, for example, in discussing a reduction of re-searching the prior art in relation to a particular application, where the claimed concept has diverted from the

subject matter of the initial search. In addition, the following issues were addressed by Member States:

- The number of nucleotide sequences in claims contained in a single application may be limited to a reasonable number (see comments by the United States of America⁶);

- Where the claim is unduly broad, the search may be conducted on the basis of the examples given (partial search), and desiderata claims (claims written in a manner that simply describe a wish to attain something) may not be searched at all (impossibility of search) (see comments by Hungary⁶).

[End of document]

⁶ See http://www.wipo.int/scp/en/working_group/comments.htm