UNITY OF INVENTION

Topic 9
Presented by Anton Blijlevens
Wednesday 15 February 9-10 am

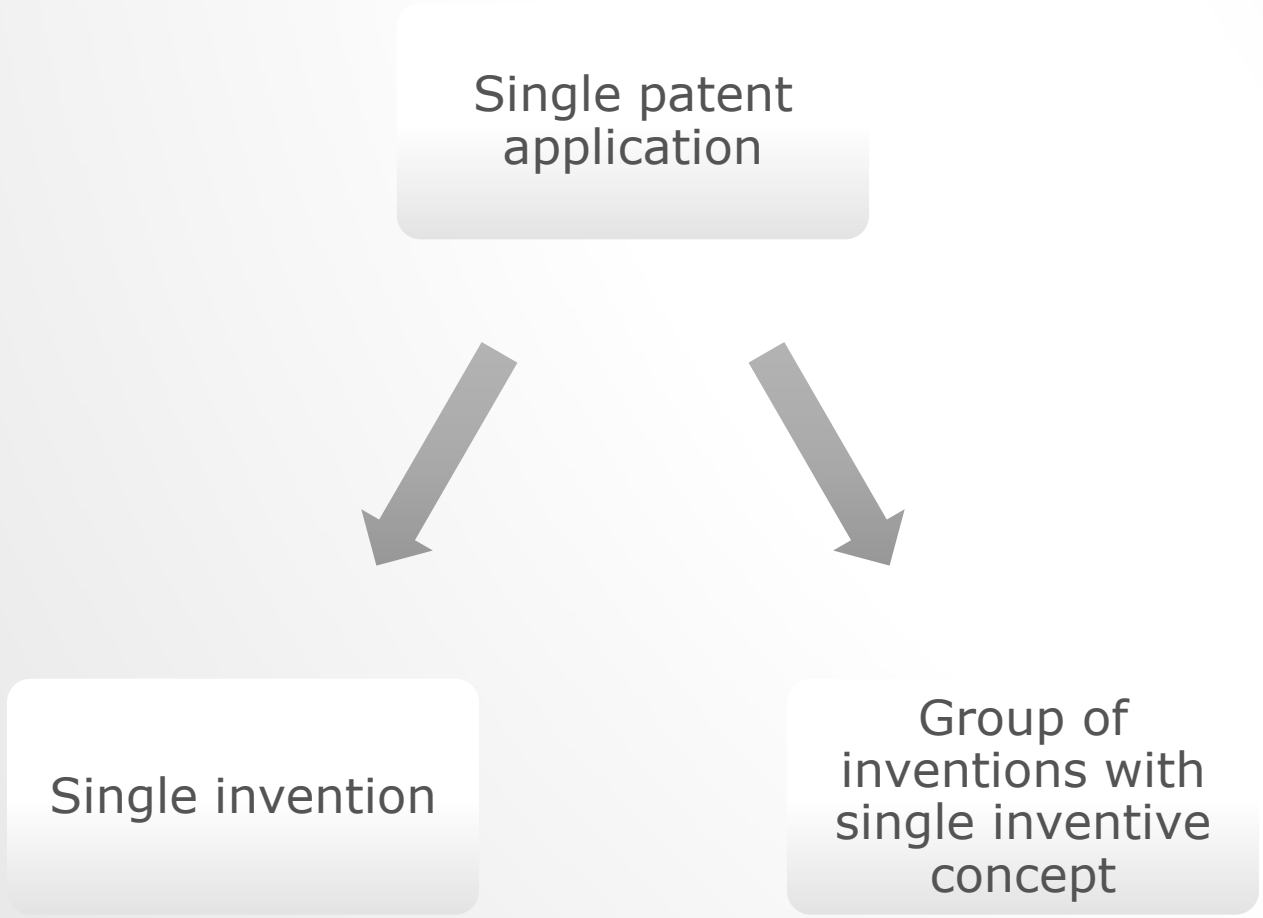
OVERVIEW

- Overview
- Patent Cooperation Treaty (PCT)
- Europe
- United States of America
  - election of species
  - restriction requirement

OVERVIEW

- A patent application can only claim one invention or a group of closely related inventions
- Patent offices will raise a unity of invention objection during examination of a patent application if they believe more than one invention is being claimed
  - this objection cannot be raised if there is only one independent claim
  - if more than one independent claim is present, then the patent office will examine for unity
  - if more than one invention is claimed during the PCT application process, an invitation to pay additional search fees will issue

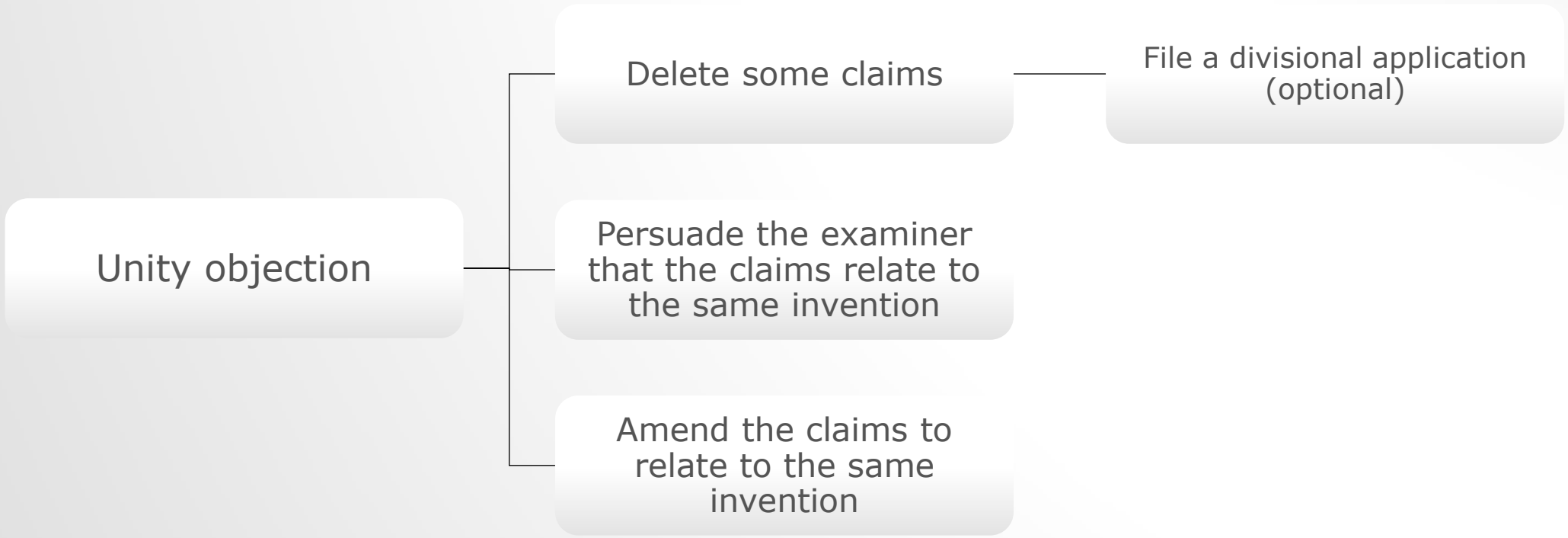
OVERVIEW


Single patent application
Single invention
Group of inventions with single inventive concept

UNITY OBJECTION IS NOT FATAL

- When a patent application is objected to for lack of unity, the application may still proceed to grant.
- Typical solutions to the objection include:
  - unify the multiple independent claims
  - cancel the offending claims
    - a divisional patent application can usually be filed for the second invention, and for the further inventions, if any
  - make a technical argument that there is unity of invention

UNITY OF INVENTION



PATENT COOPERATION TREATY

- Under the Patent Cooperation Treaty, a PCT application
  - "shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept". Rule 13.1
- If the requirement of unity of invention is not met, the International Searching Authority (ie, the patent office in charge of carrying out the international search) “is entitled to request the applicant to pay an additional search fee for each invention beyond the first which is to be searched"

EUROPE

- European application must "relate to one invention only or to a group of inventions so linked as to form a single general inventive concept”
- An initial opinion on whether the claims of an application fulfil the requirement of unity or not is formed by the search division (ie, the search examiner). The applicant is informed if a lack of unity objection is raised at this stage and if additional search fees have to be paid to get more than the first invention searched.
- Applicants refusing to pay additional fees do not suffer any loss of rights (scope of protection, validity of priority, filing date, etc)

EUROPE

- The requirement of unity of invention 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" means, in any one claim, the **particular technical feature or features** that define a **contribution** that the claimed invention considered as a whole makes **over** the prior art.
- It is not necessary that the special technical features in each invention be the same. Rule 44(1) makes clear that the required relationship may be found between corresponding technical features.

Example

In one claim the special technical feature which provides resilience is a metal spring, whereas in another claim it is a block of rubber.

EUROPE

- In some jurisdictions, such as the European patent office, a lack of unity:
  - may be directly evident *a priori*, ie, before considering the claims in relation to the prior art, or
  - may only be become apparent *a posteriori*, ie, after taking the prior art into consideration. For example, a document within the state of the art shows that there is a lack of novelty or inventive step in an independent claim, thus leaving two or more dependent claims without a common inventive concept.

TWO INDEPENDENT CLAIMS IN A SINGLE PATENT APPLICATION – NO PRIOR ART

1. A vehicle comprising:
   - a frame
   - a front wheel connected to the frame
   - a rear wheel connected to the frame
   - a seat supported by the frame.

2. A vehicle comprising:
   - a frame
   - a front wheel connected to the frame
   - a rear wheel connected to the frame
   - a shock absorber connected to the rear wheel.

TWO INDEPENDENT CLAIMS IN A SINGLE PATENT APPLICATION – WITH PRIOR ART

1. A vehicle comprising:
   - a frame
   - a front wheel connected to the frame
   - a rear wheel connected to the frame
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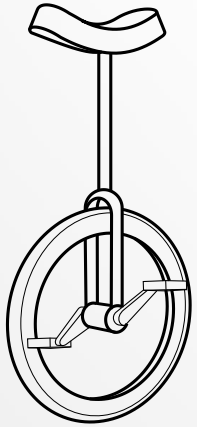
The prior art



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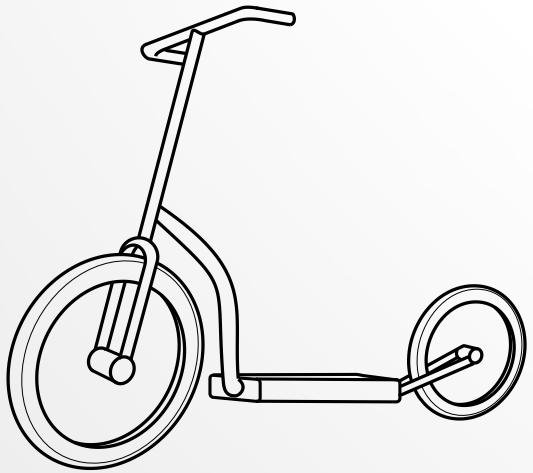

UNITY OF INVENTION IN THE US

- US application with claims to different categories of invention will be considered to have unity of invention if the claims are drawn to one of the following combinations of categories:
  - a product and a process specially adapted for the manufacture of said product
  - a product and process of use of said product
  - a product, a process specially adapted for the manufacture of the said product, and a use of the said product
  - a process and an apparatus or means specifically designed for carrying out the said process
  - a product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

UNITY IN THE USA – THE DANGER

My invention

- A scooter with shock absorber on front wheel and flexible arm supporting back wheel.

UNITY IN THE USA – THE DANGER

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   - a rear wheel connected to the frame
   - a shock absorber connected to the rear wheel.

2. A vehicle comprising:
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   - a front wheel connected to the frame
   - a rear wheel connected to the frame
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Prior art

UNITY IN THE USA – THE DANGER

- I argue that the flexible arm is the same as the pneumatic shock absorber for the front wheel and therefore I can keep the two claims.
- Then this prior art surfaces in a second official action that has a flexible arm at the back but no front shocks.

CONCLUSION (FOR MOST JURISDICTIONS)

- The concept of unity of invention is based on "one patent for one invention".
- The result of an assessment of unity often depends on the closest prior art.
- Multiple independent claims may be unitary if they are so linked as to form a single general inventive concept.
- The US is, from a unity standpoint, potentially treacherous.
- The final decision on unity is taken by the examiner.
- Filing an application with non-unitary claims does not necessarily result in a loss of rights.