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PROPOSAL TO AMEND PCT RULE 13

*Submitted jointly by the European Patent Office,
the Japanese Patent Office and the
United States Patent and Trademark Office*

* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

Joint EPO-JPO-USPTO
proposal to amend
Rule 13 PCT
"Unity of invention"

Present text	Proposed version
Rule 13	Rule 13
13.1 Requirement	13.1 Requirement
<p>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 ("requirement of unity of invention").</p>	<p>[No change]</p>
13.2 Claims of Different Categories	13.2 <u>Circumstances in which the Requirement of Unity of Invention to Be Considered Fulfilled</u>
<p>Rule 13.1 shall be construed as permitting, in particular one of the following three possibilities:</p>	<p><u>Where a group of inventions 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 which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.</u></p>
<p>(i) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of said product, and the inclusion in the same international application of an independent claim for a use of the said product, or</p>	
<p>(ii) in addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the said process, or</p>	
<p>(iii) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the process.</p>	

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Present text	Proposed version
<p><i>13.3 Claims of One and the Same Category</i></p>	<p><u>13.3 Determination of Unity of Invention Not Affected by Manner of Claiming</u></p>
<p>Subject to Rule 13.1, it shall be permitted to include in the same international application two or more independent claims of the same category (i.e. product, process, apparatus, or use) which cannot readily be covered by a single generic claim.</p>	<p><u>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.</u></p>
<p><i>13.4 Dependent Claims</i></p>	<p><i>13.4 Dependent Claims</i></p>
<p>Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered in themselves an invention.</p>	<p>[No change]</p>
<p><i>13.5 Utility Models</i></p>	<p><i>13.5 Utility Models</i></p>
<p>Any designed State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 13.1 to 13.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.</p>	<p>[No change]</p>

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Reasons

1. At the 1998 Trilateral Conference in Tokyo between the EPO, JPO and USPTO, in the 6th Memorandum of Understanding (MOU) dated 1 November 1988 the following was agreed:

“The three Offices finalized and agreed upon a text (annexed to this Memorandum of Understanding) for harmonizing the unity of invention practice. Each Office agreed to promptly initiate the steps necessary to obtain the authorization needed to implement the unity of invention practice set forth in the annexed text. It was further agreed that the three Offices would work jointly to secure the incorporation of the results of the Trilateral efforts on unity of invention into the Regulations under the Patent Cooperation Treaty.

Each Office may consider putting forward proposals with a view of incorporating the said results into the WIPO Draft Treaty on the Harmonization of Certain Provisions in Laws for the Protection of Inventions, and the Draft Regulations thereunder.”

2. The Trilateral Agreement on unity was thereafter introduced into the Draft Harmonization Treaty currently discussed in the framework of WIPO.

The basic provisions of the Trilateral agreement now appear, with some further refinement, in the latest version of Article 5 and Rule 3 of the draft Treaty (HL/CE/VIII/2). The basic test to be applied in determining whether or not there is unity of invention is set out in draft Rule 3. The details concerning the application of those provisions are contained in the explanatory notes particularly on Rule 3 (see Annex).

3. The proposal concerning Rule 3 was discussed and, subject to a slight modification, unanimously approved by the WIPO Committee of Experts at its meeting in June 1990.

4. A proposal amending Rule 30 EPC with a view to implementing the Trilateral Agreement and harmonizing Rule 30 EPC with Rule 3 of the draft Harmonization Treaty has been submitted to the Administrative Council of the EPO for adoption at its December 1990 meeting. The proposal was unanimously approved by the EPO Administrative Council's Ad hoc working Party for the Examination of Amendments to the EPC Implementing Regulations at its recent meeting on 17 and 18 September 1990. Once approved, Rule 30 EPC as amended will come into effect on 1 June 1991.

5. At the 8th Trilateral Conference on 25 October 1990 in Munich, the EPO, the JPO and the USPTO agreed to make a joint proposal for amending Rule 13 PCT in order to bring that Rule into line with Rule 3 of the draft Harmonization Treaty and the proposed wording of Rule 30 EPC. The current revision of the Regulations under the PCT offers an ideal opportunity to amend Rule 13 as proposed in this document. The proposed amendment will be beneficial to all PCT applicants, the International Authority under the PCT as well as the designated or elected Offices, in providing a comprehensive and reliable test for interpreting the concept of unity of invention.

6. The EPO, Japan and United States of America further propose that once Rule 13 PCT has been amended as proposed, the essence of unity of invention practices set out in more detail in the Notes on Rule 3 of the draft Harmonization Treaty, be incorporated into the Guidelines for International Search under the PCT.

[Annex follows]

[Notes on Rule 3, continued]

HL/CE/VIII/2
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Notes on Rule 3

R3.01 Paragraph (1) contains the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an application. According to that method, unity of invention will exist only when there is a technical relationship among the inventions involving one or more of the same or corresponding "special technical features." The expression "special technical features" is defined in paragraph (1) as meaning those technical features that define a contribution that each of a inventions, considered as a whole, makes over the prior art.

R3.02 Independent and Dependent Claims. Unity of invention is to be considered in the first place only in relation to the independent claims in an application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed—for example, product, process, use or apparatus or means, etc.).

R3.03 If the independent claims are patentable and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim is patentable. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim is patentable and the combination claim includes all the features of the subcombination.

R3.04 If, however, an independent claim is not patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity a posteriori (that is, arising only after assessment of the prior art) should be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

R3.05 It is intended that the method contained in paragraph (1) for determining whether unity of invention exists should be able to be applied without it being necessary to search the prior art. Where the Office does search the prior art, an initial determination of unity of invention, based on the assumption that the claims are not invalidated by the prior art, might be reconsidered on the basis of the results of the search of the prior art. Where the Office does not search the prior art, unity of invention would be determined on the assumption that the claims are not invalidated by the prior art, unless it is obvious to the person making the determination that the claims are invalidated by the prior art.

R3.06 Illustrations of Particular Areas. There are three particular areas of practice where the application of the method for determining unity of invention contained in paragraph (1) of Rule 3 may be illustrated:

(i) combinations of different categories of claims; (ii) so-called "Markush practice"; and (iii) the case of intermediate and final products. Principles for the interpretation of the method contained in paragraph (1) in the context of each of those areas are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of paragraph (1) of Rule 3. Contracting Parties that wish to adopt, in their patent legislation, more detailed provisions on unity of invention than those contained in Article 5 and Rules 3 and 4 could include the substance of the principles of interpretation set out below.

R3.07 In order to secure the greatest possible harmonization of practice, the administrative provisions of the Treaty (see document HL/CE/VIII/4), provide for the Assembly to adopt guidelines for the implementation of obligations under the Treaty and the Regulations. Under that procedure, the Assembly could adopt, and revise where necessary, the principles of interpretation on the three areas of special concern referred to in the preceding paragraph and set out below. Alternatively, those principles of interpretation could be adopted in the form of an agreed text or statement by the Diplomatic Conference when the Treaty is adopted. The latter method, however, is less flexible, since the text could probably not be later modified in the light of experience in the way that guidelines could be modified by the Assembly.

R3.08 Combinations of Different Categories of Claims. The method for determining unity of invention contained in paragraph (1) of Rule 3 should be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same application:

- (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or
- (ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or
- (iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

[Notes on Rule 3, continued]

R3.09 As indicated in the last part of paragraph R3.08, above, a process should be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process. They are also not intended to imply that the same kind of process of manufacture could not also be used for the manufacture of other products.

R3.10 As also indicated in the last part of paragraph R3.08 above, an apparatus or means should be considered to be "specifically designed for carrying out" a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. On the other hand, the words "specifically designed" should not imply that the apparatus or means could not be used for carrying out another process, or that the process could not be carried out using an alternative apparatus or means.

R3.11 "Markush Practice." The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Article 5 and Rule 3. In that special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in paragraph (1) of Rule 3 should be considered to be met when the alternatives are of a similar nature.

R3.12 When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where the following criteria are fulfilled:

- (a) all alternatives have a common property or activity, and
- (b) (i) a common structure is present, i.e., a significant structural element is shared by all of the alternatives; or
- (ii) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

[Notes on Rule 3, continued]

R3.13 In (b)(i), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

R3.14 In (b)(ii), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

R3.15 The fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

R3.16 When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel, unity should be reconsidered by the examiner. Reconsideration should not necessarily imply that an objection of lack of unity must be raised.

R3.17 Intermediate and Final Products. The situation involving intermediate and final products is also governed by Article 5 and Rule 3.

R3.18 The term "intermediate" is intended to mean intermediate or starting products. Such products have the ability to be used to produce patentable final products through a physical or chemical change in which the intermediate loses its identity.

R3.19 Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

- (a) the intermediate and final products have the same essential structural element, i.e.,
 - (i) the basic chemical structures of the intermediate and the final products are the same, or
 - (ii) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and
- (b) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

[Notes on Rule 3, continued]

R3.20 Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known—for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

R3.21 It should be possible to accept in a single application different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

R3.22 The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new.

R3.23 If the same application claims different intermediates for different structural parts of the final product, unity should not be regarded as being present between the intermediates.

R3.24 If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

R3.25 As long as unity of invention can be recognized applying the above guidelines, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not affect the decision on unity of invention.

R3.26 Paragraph (2) requires that the determination of the existence of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

R3.27 Paragraph (2) is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in Rule 3(1)) remains the same regardless of the form of claim used.

R3.28 Paragraph (2) does not prevent an Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Office.

(End of
Annex
Document)

[End of Notes]