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## **STANDING COMMITTEE ON THE LAW OF PATENTS**

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**UNITED STATES PROPOSAL FOR A WORKING GROUP ON MULTIPLE INVENTION  
DISCLOSURES AND COMPLEX APPLICATIONS**

*Proposal by the Delegation of the United States of America*

## INTRODUCTION

The United States of America proposes the formation of a Working Group to investigate the possibility of new standards for limitations on claiming in patent applications. In the United States of America, the current practice is called “restriction” practice based on the independent and distinctness standard found in 35 U.S.C. 121. In the Patent Cooperation Treaty (PCT), and in some other major patent systems, the standard of “Unity of Invention” is employed limiting claims in applications to a “single general inventive concept.”

Currently, most of the major offices of the world are facing significant workload challenges. Application filings were up 12% last year in the United States Patent and Trademark Office (USPTO), and similar increases were reported in the European Patent Office (EPO) and the Japan Patent Office (JPO). Offices using the Unity of Invention standard and the Independent and Distinct standard are affected. As the number of applications swells, we also note that the complexity of the prosecution grows as new technologies must be examined by new techniques, raising the costs of patent processing. Complex applications create a further strain on examination, containing, for example, a voluminous number of claims, or a large number of biotech sequence listings, or claims without support in the disclosure. Though many factors contribute to the workload problem, the adoption of a more refined practice for limiting claims in applications could help keep the burdens and the resources better in balance.

## PROBLEMS OF CURRENT PRACTICES

The different standards used today have limited success in reducing the workloads of patent examiners. For example, both Unity of Invention (Unity) and Independent and Distinct Restriction (I & D) require varying amounts of pre-restriction searching, an important source of potentially unfruitful work. With Unity, a search and an *a priori* or *a posteriori* consideration of whether claims avoid the prior art are necessary if multiple claimed inventions share a “special technical feature.” The I & D practice appears more efficient in this respect. However, the Markush practice used in I & D leads to a “rolling search” of the prior art until unpatentable species are found. This also raises a question of efficiency.

Both Unity and I & D are umbrella concepts covering a series of practices involving claim types (e.g. product, method of making, method of using); claim relations (e.g. combination and subcombination, genus and species); and special practices (e.g. Markush, sequence listings). Some of these practices are efficient in focusing and narrowing the prosecution; others are not. In addition, new practices, such as fully searching any linking claims before committing to the search of linked inventions, may be worth considering to reduce overall costs. Provisional elections by the examiner, or the use of rejoinder after the discovery of allowable subject matter are also possible tools of a more efficient practice.

This proposal therefore supports the establishment of a Working Group to investigate individual practices used in the various systems around the world and to propose, if feasible, an improved set of practices that would help reduce the burden on the examiners while considering the needs of applicants.

## A WORKING GROUP WOULD SUGGEST AND SCRUTINIZE PRACTICES FOR REASONABLE WORK MANAGEMENT

This proposal invites the formation of a Working Group to suggest practices for the management of examination workloads and analyze their effectiveness. Specifically, the practices of the various procedures, including those based on Unity of Invention and on Independent and Distinct Inventions, would be considered against a number of objectives. Those practices which positively address the objectives would be combined into a proposal for consideration by the Standing Committee on the Law of Patents (SCP) for the Substantive Patent Law Treaty (SPLT). The Working Group could consist of interested representatives from various delegations and could meet simultaneously with or on the margins of future SCP meetings.

The Working Group should not be constrained to consider only those practices currently in use. To address the challenges of the complex technology applications being received and yet to come, the Working Group should be free to consider new practices of significant value for addressing the issues as part of a total solution to the problem.

### OBJECTIVES OF THE WORKING GROUP

Objective 1: Reduce the burden on the examiner. Offices are overworked, and the backlogs seem to be growing.

A major objective of the Working Group should be the reduction of the examiner workload, and the improvement of efficiency in the examination process. Of specific interest are the following factors: (1) significant search requirements imposed on the examiner before the applicant responds to a restriction or unity requirement; and (2) reduction of re-searching the prior art in a particular application when the claimed concept has diverted from the subject matter of the initial search.

In addition to those specific issues concerning workload, the Working Group should also consider other factors, such as the simplicity of the process. Examples of practices under consideration could be linking claims, limited number of claims (independent or total), or special procedures to treat complex applications.

Objective 2: Focus the prosecution of an application on a single invention, to expedite the classification and information content of the patent.

All major patent systems agree that a patent application should be directed, broadly, to one invention. In the PCT, Rule 13.1 states: "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." In United States law, the Director of the USPTO may require restriction if "two or more independent and distinct inventions are claimed in one application." Beyond the workload issue mentioned above, narrowly directed patents facilitate the proper classification and presentation of new technology information for easier categorization, use and understanding by the recipients of this data. It allows more focused searching by those users, and more successful information retrieval.

Objective 3: Develop a practice for limiting claims in applications that is easy to understand, and can be applied consistently in practice and that is fair to the applicants.

An ideal standard would allow the applicant to know with confidence whether or not two inventions should be combined in a single application, thus obviating the need in many cases for the Office to initiate the restriction or unity practice at all. A simplified, fair and consistently applied set of global rules on such practices would avoid much of the uncertainty now inherent in the restriction and unity practices of the various offices.

Objective 4: Consider the long term viability of these practices for future needs.

The workgroup should consider the varied and increasing difficulties of examining complex applications. Any proposed practices must handle them in an efficient manner. As subject matter, claiming practices, intellectual property strategies and applicant demands change over the coming years, a robust system for limiting claiming will need to adapt to address the new challenges.

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