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SUBJECT: Convergence of practice: recommendation for a common practice
as regards the examination of unity of invention

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

The document contains a recommendation for a common practice concerning the examination of unity of invention resulting from the discussions within Working Group 1 of the Convergence Programme. The common practice covers the information to be provided to applicants as minimum reasoning when raising non-unity objections.

TABLE OF CONTENTS

Subject	Page
I. STRATEGIC/OPERATIONAL	1
II. RECOMMENDATION	1
III. MAJORITY NEEDED	1
IV. BACKGROUND	1
V. EXPLANATORY REMARKS	3
VI. ALTERNATIVES	6
VII. FINANCIAL IMPLICATIONS	6
VIII. LEGAL BASIS	6
IX. DOCUMENTS CITED	6
X. RECOMMENDATION FOR PUBLICATION	6
ANNEX 1 RECOMMENDATION FOR A COMMON PRACTICE AS REGARDS THE EXAMINATION OF UNITY OF INVENTION	7
APPENDIX	9
I. "COMMON MATTER"	9
II. "PRIOR ART AT HAND"	10
III. THE TECHNICAL PROBLEM IN THE NON-UNITY ASSESSMENT	11

I. STRATEGIC/OPERATIONAL

1. Operational

II. RECOMMENDATION

2. The Committee on Patent Law is requested to give its opinion on the proposed recommendation for a common practice as regards the examination of unity of invention set out in Annex 1 to this document.

III. MAJORITY NEEDED

3. N/A

IV. BACKGROUND

4. The requirement of unity of invention has its basis in the Paris Convention (Article 4.F). The EPC (Article 82 EPC) and the national laws of the EPC contracting states share the requirement of unity of invention. Like the EPC, many national laws are aligned with the requirement of unity enshrined in the PCT.
5. A principle which is also reflected in the PCT is that a patent application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (cf. Rule 13.1 PCT). This is fulfilled where there is a technical relationship between those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" refers to those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (cf. Rule 13.2 PCT). The determination of whether a group of inventions is so linked as to form a single general inventive concept is made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim (Rule 13.3 PCT).
6. While the EPO and the EPC contracting states are generally aligned with the above principles, there may be some differences in terms of their practical application.

7. With the adoption of the Strategic Plan 2023, discussions were launched on a convergence programme aimed at reducing or overcoming differences in administrative practices by setting common practices in identified areas where it could be expected that a more uniform approach would provide the most beneficial results for users and patent offices. At its 51st meeting, the Committee on Patent Law gave a favourable opinion on this proposal (CA/PL 14/19). Examination of unity of invention was identified as an area for a possible convergence of practice. In accordance with the agreed working method, a working group was set up to explore possible common practices in this area (Working Group 1 – Examination of unity of invention) and to submit a recommendation by the end of 2020.
8. In response to the call for interest issued in December 2019, 20 EPC contracting states and 1 extension state expressed their interest in participating in the discussions of working group 1. The composition of the group was as follows: Denmark (DK), Estonia (EE), France (FR), Germany (DE), Greece (GR), Hungary (HU), Italy (IT), Lithuania (LT), Latvia (LV), Montenegro (ME), North Macedonia (MK), Netherlands (NL), Norway (NO), Poland (PL), Portugal (PT), Romania (RO), San Marino (SM), Spain (ES), Sweden (SE), Turkey (TR), the United Kingdom (GB) and the EPO.
9. In early February 2020 the chair of the Working Group (a representative of the Office) issued a questionnaire in order to obtain more information on the participating EPC contracting states' practices as regards the examination of unity of invention. The answers to the questionnaire were compiled in a summary. This summary was then adopted by the group and served as basis for exploring possible areas for discussion of common practices. This resulted in a discussion paper with additional questions to the members of the Working Group about the definition of single general concept/corresponding features, *a priori* assessment of unity of invention and the minimum reasoning in support of non-unity objections.
10. In parallel to the discussions in the working group and in accordance with the methodology agreed by the Committee on Patent Law (see CA/PL 14/19 point 21), users were regularly consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 31 March 2020, 18 June 2020, 23 July 2020 and 8 October 2020. In order to further broaden the scope of the consultation process, on 21 September 2020 the EPO organised a virtual discussion platform, informing users and offices about the results achieved within the working group until then.
11. These consultations, together with the very fruitful discussions at the Working Group's in total five meetings, led to a recommendation for a common practice as regards the information to be provided to applicants when raising non-unity objections in the area of the examination of unity of invention (minimum reasoning).

12. The recommended minimum reasoning is supplemented by definitions of the terms "common matter", "prior art at hand" and "technical problem", which are instrumental in ensuring a consistent application of the common practice.

V. EXPLANATORY REMARKS

13. The recommendation as regards the minimum reasoning aims to formulate a common practice to be implemented and applied by EPC contracting states and the EPO on a voluntary basis. The EPO practice is already in line with the common practice.
14. It is not intended to harmonise the non-unity substantive assessment and its outcome, or the related consequences. The recommendation is aimed at improving the quality of communication between patent offices, enhancing their co-operation and facilitating the possible reuse of products among them.
15. Even more importantly, it also aims to improve the communication between offices and their applicants by guaranteeing that, when non-unity objections are raised, a defined set of information is presented that enables the applicant to understand the outcome of the non-unity assessment performed by the examiner and make informed decisions based on the reasoning.
16. The recommended minimum reasoning includes information introducing the objection, presenting the grounds for the objection and setting out the conclusion.
17. It should be noted that the way in which the information in the recommended minimum reasoning is presented is not meant to reproduce the logical steps of the non-unity assessment. It merely provides a framework for the information which should be given to the applicant, namely an explanation of the result of that assessment, should the examiner raise a non-unity objection. Hence, the recommendation does not limit the examiner's discretion as to whether to raise any objections. The order in which the information is presented in the minimum reasoning is not critical.
18. The introduction to the objection in the recommended minimum reasoning includes, where appropriate, a statement of the legal basis for the objection and identifies the different groups of inventions.

19. The grounds for objection include an identification of the common matter between the different groups of inventions or, if appropriate, a statement on the lack of common matter. If common matter has been identified, a comparison with the "prior art at hand" is provided to explain, if applicable, why the features identified as being part of the common matter do not define a contribution over the "prior art at hand" and, if prior art is relied upon, to identify that prior art. This will normally be done by citing the document relied upon. In obvious cases, it may be sufficient to refer to common general knowledge. In such cases, it may not be necessary to make a reference to a specific document, e.g. where the common matter is a car or a mobile phone.
20. The grounds for the objection also include an analysis of the remaining technical features which are not part of the identified common matter, and an explanation of why there is no unifying technical relationship among the groups of inventions, if applicable by identifying the differences between the remaining technical features and considering the technical effects achieved or the technical problems solved by these remaining features. The expression "if applicable" is included to clarify that different approaches may be used. If an office uses the "technical problem" approach it should be reported in a manner consistent with the practice laid out in this document.
21. The Working Group's discussions on the single general concept served as a basis for the proposed definition of "common matter" and "technical problem" in the grounds for objection. Those concerning the *a priori* assessment of unity fed into the definition of "prior art at hand". The definitions ensure a common understanding of the meaning of these terms and how they are applied. As mentioned above, the terms are instrumental in ensuring a consistent understanding and application of the common practice, but they do not have to be used in exchanges with the applicant or in public documents, such as guidelines or user manuals.
22. These terms were chosen very carefully, with a view to encompassing the different practices that exist at the different offices while ensuring that they are compatible with, in particular, the PCT. They allow all offices to apply the recommended minimum reasoning in their own jurisdiction.

23. For example, not all offices assess novelty and inventive step when examining whether an application meets the requirement of unity. Therefore, not all offices are in a position to assess the existence of a "single general inventive concept". By using "common matter" instead, all offices are enabled to use the recommended minimum reasoning, even in cases in which they do not carry out a search. Furthermore, the term "common matter" highlights the main aim of the assessment of unity of invention, i.e. the determination of whether the claims of an application have something in common.
24. Similarly, the term "prior art at hand" has been chosen to cover non-unity objections at all possible stages of the grant procedure, e.g. even if no prior art search has been carried out. This expression also highlights the difference from "prior art", which is the term commonly used in the patentability assessment. Within the framework of the novelty or inventive-step assessment, the claims are examined against the entire state of the art, i.e. the full collection of relevant information made available to the public in any form before the date of filing of the application.
25. The non-unity assessment is often carried out not with regard to the full collection of existing prior art but only with regard to the prior art available to the examiner at the time of the assessment. This may range from a complete search to none. The expression "prior art at hand" is therefore proposed with a view to encompassing all possibilities.
26. In order to prevent too broad a definition of the technical problem (such as "to improve the state of the art") from serving as a basis for the determination of the unifying technical relationship among the groups of inventions, with the result that everything would potentially fall within this definition, it is proposed to supplement the recommended minimum reasoning with some basic information on how the technical problem may or may not be determined in the non-unity assessment.
27. In the recommended minimum reasoning, the technical problem will normally be considered in two instances, namely in the determination of the common matter and in the analysis of the remaining technical features. Alternative approaches, such as analysing the technical effect achieved, are however possible. The recommended minimum reasoning may also be applied in cases where focusing on the technical problems is not necessarily appropriate. For example for Markush claims the analysis would rather focus on whether the grouped alternatives of chemical compounds are of a similar nature.

28. The expression "if applicable" is meant to address the above mentioned possibility to use different approaches, as well as the fact that some offices are currently not in a position to always mention the underlying technical problems in their reasoning due to national constraints.
29. As a conclusion, it should be made clear in the recommended minimum reasoning that lack of unity was found. Furthermore, if it is considered appropriate, information on the procedural consequences of this result may be provided, if any. This information may be restricted to the direct consequences deriving from the non-unity findings at the procedural stage in which it is raised.

VI. ALTERNATIVES

30. N/A

VII. FINANCIAL IMPLICATIONS

31. N/A

VIII. LEGAL BASIS

32. Article 10(2) EPC

IX. DOCUMENTS CITED

33. CA/PL 14/19

X. RECOMMENDATION FOR PUBLICATION

34. Yes

ANNEX 1 RECOMMENDATION FOR A COMMON PRACTICE AS REGARDS THE EXAMINATION OF UNITY OF INVENTION

Having due regard to the requirement of unity of invention, which has its basis in Article 4.F of the Paris Convention and is enshrined in Article 82 EPC and national laws of EPC contracting states;

Taking account of the principles laid down in Rule 13 of the Patent Cooperation Treaty (PCT);

Considering the aim of establishing a common practice in the area of examination of unity of invention, in particular with regard to the minimum reasoning to be provided to applicants when raising a non-unity objection;

Aiming at ensuring a consistent application of the common practice in particular with regard to the use of the terms "common matter", "technical problem" and "prior art at hand" in the minimum reasoning;

Noting that any common practice will be implemented on a voluntary basis;

Working Group 1 recommends to the Administrative Council for adoption the following common practice as regards the information to be provided as minimum reasoning when raising a non-unity objection, including the definitions set out in the appendix of "common matter", "prior art at hand" and "technical problem", which form an integral part of the common practice on minimum reasoning:

Information to be provided when raising a non-unity objection

Introduction to the objection

- Where appropriate, statement of the legal basis for the objection, invoking a specific legal provision
- Identification of the different groups of inventions, including, where possible, the numbering of the groups and an indication of the claims belonging to each of these groups

Grounds for the objection

- Identification of the common matter between the different groups of inventions or, if appropriate, a statement on the lack thereof
- If common matter has been identified, a comparison with the "prior art at hand" which:
 - if applicable, explains why the features identified as part of the common matter do not constitute a contribution over the "prior art at hand"
 - if prior art is relied upon, identifies that prior art
- Analysis of the remaining technical features which are not part of the identified common matter
 - Explanation of why there is no unifying technical relationship among the groups of inventions, if applicable by identifying the differences between the remaining technical features considering the technical effects achieved or the technical problems solved by these remaining features

Conclusion

The concluding statement explaining that lack of unity has been found may be supplemented, where appropriate, with information on any procedural consequences of this result at the procedural stage in question

APPENDIX

I. "COMMON MATTER"

"Common matter" represents a potential single general inventive concept amongst the claims. It can be present in features that are identical or analogous (corresponding). Analogous features may be identified by checking which features provide, alone or in combination, a common technical effect or a solution to a common *technical problem*.

Common matter may also be embodied in features of claims of different categories, if they fulfil the above criteria. For example, in the case of a product, a process specially adapted for the manufacture of that product and the use of that product, the product may be the common matter which is present in the use and in the process as the effect or result of the process.

Common matter may also be embodied in interrelated product features (e.g. a plug and a socket). Although analogous (corresponding) features in interrelated products may be formulated quite differently, if in their interaction they contribute to the same technical effect or to the solution of the same technical problem, they may be part of the common matter.

II. "PRIOR ART AT HAND"

The prior art relied upon in the non-unity assessment may vary depending on the provisions applicable at each national office and on the stage of proceedings.

For example, if the assessment is carried out before the search, the only "prior art at hand" may be common general knowledge and/or the background art provided by the applicant in the description. It is also possible that no prior art at all is at hand at this stage of the proceedings.

When the assessment is carried out during the search, other prior art may be revealed and may form the prior art at hand for the non-unity assessment.

Therefore, the "prior art at hand" may range from nothing at all to the prior art found during a search and may change during the course of the proceedings.

III. THE TECHNICAL PROBLEM IN THE NON-UNITY ASSESSMENT

When analysing the technical problem for the purposes of the non-unity assessment, the overall objective is to find out what the claims have in common. The starting point is usually what is considered in the description to have been achieved but the technical problem may need gradual refinement as and when prior art is revealed.

The technical problem solved should not be too narrow or too general. If the technical problem is so broadly formulated that it is itself already known or could be recognised as generally desirable or obvious, unity usually cannot be established on the basis of this common problem.