

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Thirty-First Session
Beijing, October 16 and 17, 2024

PROPOSED MODIFICATIONS REGARDING BOX IV OF PCT/ISA/237 AND PCT/IPEA/409 AND GUIDELINES ON LACK OF UNITY OF INVENTION

Document prepared by the China National Intellectual Property Administration

SUMMARY

1. On the basis of the four priority items determined at the thirtieth session of the Meeting of International Authorities, the China National Intellectual Property Administration (CNIPA) would like to propose modifications to one of the priority items, regarding PCT/ISA/237 and PCT/IPEA/409 and the PCT International Search and Preliminary Examination Guidelines on lack of unity of invention.

BACKGROUND

2. According to the discussion at the thirtieth session of the Meeting of International Authorities in 2023, the Authorities agreed to discuss the four priority items for Proposal to Promote the Improvement of the International Search Report and the Written Opinion (see paragraph 31 of document PCT/MIA/30/10). On the basis of the relevant clauses of the PCT Regulations and the PCT International Search and Preliminary Examination Guidelines (the Guidelines), the CNIPA proposes the following modifications to Box IV "Lack of unity of intention" of PCT/ISA/237 and PCT/IPEA/409 and relevant paragraphs of the PCT International Search and Preliminary Examination Guidelines.

CURRENT REGULATIONS AND FORMS REGARDING BOX IV OF PCT/ISA/237 AND PCT/IPEA/409

CURRENT REGULATIONS

3. Article 34(3)(a) in the PCT and Rule 70.13 in the PCT Regulations serve as the legal basis for filling in Box IV of the Written Opinion of the International Searching Authority, the Written Opinion of the International Preliminary Examining Authority and the International Preliminary Examination Report on Patentability. Furthermore, paragraphs 17.38 to 17.41 of the Guidelines specify the filling requirements for Box IV (Lack of unity of invention).

TITLE AND CONTENT OF BOX IV OF PCT/ISA/237

4. The title of Box IV of PCT/ISA/237 is "Lack of unity of invention". There are four items: (a) the response of the applicant after the examiner issued PCT/ISA/206 in the international search stage; (b) the scenario where the examiner does not invite the applicant to pay additional fees; (c) the conclusion on whether lack of unity exists; and (d) indication of the claims which the written opinion is in respect of.

TITLE AND CONTENT OF BOX IV OF PCT/IPEA/409

5. The title of Box IV of PCT/IPEA/409 is "Lack of unity of invention". There are four items: (a) the response of the applicant after the examiner issued PCT/IPEA/405 in the international preliminary examination stage; (b) the scenario where the examiner does not invite the applicant to restrict the claims or pay additional fees; (c) the conclusion on whether lack of unity exists; and (d) indication of the claims which the international preliminary examination report is in respect of.

PROPOSED MODIFICATIONS TO BOX IV OF PCT/ISA/237 AND PCT/IPEA/409

REASONS FOR MODIFICATIONS

6. The title of Box IV of PCT/ISA/237 and PCT/IPEA/409 is "Lack of unity of invention", however, the first checkbox in item 3 presents the condition that meets the requirement of unity of invention. In the feedback of the survey conducted through PCT Circulars C. PCT 1607 and C. PCT 1608 in 2020, some Offices stated that the wording of the title of Box IV and the first checkbox in item 3 appears to be contradictory. The condition to check the first checkbox in item 3, Box IV of PCT/ISA/237 is: after PCT/ISA/206 is issued regarding the lack of unity of invention, the applicant has paid additional fees as well as protest fee, and the protest to all of the additional inventions are found to be justified, therefore the application is considered to comply with the requirement of unity of invention.

7. The conditions to check the first checkbox in item 3, Box IV of PCT/IPEA/409 are as follows: after PCT/IPEA/405 is issued regarding the lack of unity of invention, (a) the applicant has paid additional fees as well as protest fee, and the protest to all of the additional inventions are found to be justified, or (b) the applicant has restricted the claims as suggested in PCT/IPEA/405.

8. The current title of Box IV of the two forms does not cover all the scenarios, and there is no description for the applicable scenarios of the first checkbox in item 3 either in the forms or in the Guidelines.

CONTENTS OF MODIFICATIONS

9. In order to present Box IV accurately and comprehensively regarding unity of invention, and improve the quality and efficiency of the work products in the international phase, and thus to facilitate the use by applicants and the public, the CNIPA proposes the following modifications to Box IV of PCT/ISA/237, Box IV of PCT/IPEA/409 and paragraph 17.39 of the PCT International Search and Preliminary Examination Guidelines:

- (a) Modifications to Box IV of PCT/ISA/237 (Annex I)
 - (i) Modifying the title of Box IV to “Observations on the lack of unity of invention”;
 - (ii) Adding text to describe the applicable condition of the first checkbox in item 3 (see Annex I for details).
- (b) Modifications to Box IV of PCT/IPEA/409 (Annex II)
 - (i) Modifying the title of Box IV to “Observations on the lack of unity of invention”;
 - (ii) Adding text to describe the applicable conditions of the first checkbox in item 3 (see Annex II for details).
- (c) Modifications to the PCT International Search and Preliminary Examination Guidelines (Annex III)
 - (i) Modifying the title before paragraph 17.38 to “Box No. IV: Observations on the lack of unity of invention”;
 - (ii) Adding item (vii) to paragraph 17.39 to reflect the conditions of compiling with the requirement of unity for the first checkbox in item 3, Box IV of PCT/ISA/237 and PCT/IPEA/409 (see Annex III for details).

10. The International Authorities are invited to comment on:

(i) the proposed modifications to Box IV of PCT/ISA/237 in Annex I, Box IV of PCT/IPEA/409 in Annex II; and

(ii) the proposed modifications to the PCT International Search and Preliminary Examination Guidelines in Annex III.

[Annexes follow]

DRAFT MODIFICATION TO BOX NO. IV OF PCT/ISA/237¹

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

FOR FURTHER ACTION

See paragraph 2 below

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

International Patent Classification (IPC) or both national classification and IPC

Applicant

1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV ~~Lack of unity of invention~~ Observations on the lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

Name and mailing address of the ISA/

Date of completion of this opinion

Authorized officer

Facsimile No.

Telephone No.

Form PCT/ISA/237 (cover sheet) (July 2022)

¹ Added and deleted parts are indicated respectively by underlines and strikethroughs in relevant text.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

Box No. IV ~~Lack of unity of invention~~ Observations on the lack of unity of invention

1. In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has, within the applicable time limit:

paid additional fees.

paid additional fees under protest and, where applicable, the protest fee.

paid additional fees under protest but the applicable protest fee was not paid.

not paid additional fees.

2. This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is

complied with, since the applicant has paid all the additional fees for the additional inventions indicated in the Invitation to Pay Additional Fees (Form PCT/ISA/206) under protest to the effect that the international application complies with unity of invention, and paid the protest fee, where applicable, and this Authority has determined the protest to be justified.

not complied with for the following reasons:

4. Consequently, this opinion has been established in respect of the following parts of the international application:

all parts.

the parts relating to claims Nos. _____

DRAFT MODIFICATION TO BOX NO. IV OF PCT/IPEA/409²
PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference		FOR FURTHER ACTION See Form PCT/IPEA/416
International application No.	International filing date (<i>day/month/year</i>)	Priority date (<i>day/month/year</i>)
International Patent Classification (IPC) or national classification and IPC		
Applicant		
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of _____ sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> a total of _____ sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and/or sheets containing rectifications authorized by this Authority, unless those sheets were superseded or cancelled, and any accompanying letters (see Rules 46.5, 66.8, 70.16, 91.2, and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets containing rectifications, where the decision was made by this Authority not to take them into account because they were not authorized by or notified to this Authority at the time when this Authority began to draw up this report, and any accompanying letters (Rules 66.4bis, 70.2(e), 70.16 and 91.2).</p> <p><input type="checkbox"/> superseded sheets and any accompanying letters, where this Authority either considers that the superseding sheets contain an amendment that goes beyond the disclosure in the international application as filed, or the superseding sheets were not accompanied by a letter indicating the basis for the amendments in the application as filed, as indicated in item 4 of Box No. I and the Supplemental Box (see Rule 70.16(b)).</p> <p>b. <input type="checkbox"/> a separate electronic file containing a sequence listing (<i>sent to the International Bureau only</i>).</p>		
<p>4. This report contains indications relating to the following items:</p> <p><input type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention <u>Observations on the lack of unity of invention</u></p> <p><input type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>		
Date of submission of the demand	Date of completion of this report	
Name and mailing address of the IPEA/ Facsimile No.	Authorized officer Telephone No.	

Form PCT/IPEA/409 (cover sheet) (July 2022)

² Added and deleted parts are indicated respectively by underlines and strikethroughs in relevant text.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

Box No. IV **Lack of unity of invention** **Observations on the lack of unity of invention**

1. In response to the invitation to restrict or pay additional fees the applicant has, within the applicable time limit:
- restricted the claims.
 - paid additional fees.
 - paid additional fees under protest and, where applicable, the protest fee.
 - paid additional fees under protest but the applicable protest fee was not paid.
 - neither restricted the claims nor paid additional fees.
2. This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is:
- complied with, since the applicant has paid all the additional fees for the additional inventions indicated in the Invitation to Restrict or Pay Additional Fees (Form PCT/IPEA/405) under protest to the effect that the international application complies with unity of invention, and paid the protest fee, where applicable, and this Authority has determined the protest to be justified, or the applicant has restricted the claims as suggested in Form PCT/IPEA/405.
 - not complied with for the following reasons
4. Consequently, this report has been established in respect of the following parts of the international application:
- all parts.
 - the parts relating to claims Nos. _____

DRAFT MODIFICATION TO THE PCT INTERNATIONAL SEARCH AND PRELIMINARY
EXAMINATION GUIDELINES REGARDING BOX IV OF PCT/ISA/237 AND BOX IV OF
PCT/IPEA/409³

Box No. IV: ~~Lack of unity of invention~~ Observations on the lack of unity of invention

17.38 [No change].

Article 34(3); Rule 70.13

17.39 If the applicant has paid additional fees before the International Searching Authority or the International Preliminary Examining Authority, or has restricted the claims before the International Preliminary Examining Authority in response to an invitation to do so, or if the applicant has failed to respond to the invitation to pay additional fees or restrict the claims (see paragraphs 10.74 to 10.82), this is also indicated in the opinion or report. The possible indications (some of which are not relevant to the written opinion of the International Searching Authority) are that:

(i) the claims have been restricted before the International Preliminary Examining Authority;

(ii) additional fees have been paid without protest;

(iii) additional fees have been paid by the applicant under protest and, where applicable, the protest fee was paid;

(iv) additional fees have been paid by the applicant under protest but the applicable protest fee was not paid;

(v) the applicant has neither restricted the claims nor paid additional fees;

(vi) the examiner was of the opinion that the international application did not comply with the requirement of unity of invention but decided not to issue an invitation to restrict the claims or pay additional fees;

(vii) in a particular case referred to in paragraph (iii), above, the protest to all additional inventions was justified, or the applicant has restricted the claims as suggested in the Invitation to Restrict or Pay Additional Fees (Form PCT/IPEA/405), thus the international application complies with the requirement of unity of invention.

[End of Annex III and of document]

³ Added and deleted parts are indicated respectively by underlines and strikethroughs in relevant text.