

Study on Unity of Invention (SCP/36/4)

Presentation by the Secretariat

Standing Committee on the Law of Patents
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Background

- SCP/35 decision for Secretariat to prepare a study on various aspects of unity of invention, including divisional applications
- SCP/36/9 contains the study, based on information from MS and regional patent offices, including national and regional legislation and IPO and court decisions, as well as other sources of information

Structure

1. Purpose and Rationale Behind the Unity of Invention Principle
2. Options Available After a Finding of Non-Unity
3. International Legal Framework
4. General Process of Assessing Unity
5. National and Regional Laws and Practices
6. Complex Claim Structures and Unity of Invention

Purpose and Rationale Behind the Unity of Invention Principle

- Objectives underlying the unity of invention principle
 - Streamlining the Examination Process
 - Ensuring Sustainability of Patent Office Operations
 - Enhancing Legal Clarity

Options Available After a Finding of Non-Unity

- After a Finding of non-unity, in general, applicants have several options:
 - Amend Claims
 - Challenge the Finding
 - File Divisional Applications
 - Abandon the Application

International Legal Framework

- The right of applicants to avail themselves of divisional applications in the case of non-unity is explicitly recognized by Article 4G of the Paris Convention
- PCT Rule 13.1
 - “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”
- PCT Rule 13.2
 - 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 that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

General Process of Assessing Unity

- Preliminary Analysis of Independent Claims
- Detailed Analysis of Independent Claims (a priori evaluation)
- Review and Comparison with the Prior Art (a posteriori evaluation)

National and Regional Laws and Practices

- Most member states have very similar laws and practices with respect to unity of invention
- The notable exception is the United States of America

Complex Claim Structures and Unity of Invention

- Markush Claims
- Intermediate and Final Products

Thank you for your attention.

