

WIPO Circular C.9199

Contribution of Germany to a study on various aspects of the unity of invention, including divisional application

A. Introductory Remarks

In German law, the concept of “unity of invention” is enshrined in Section 34 para 5 German Patent Act. According to that provision, *“the application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept”*.¹ The purpose of this provision, doctrinally categorized as so-called “Ordnungsvorschrift” (provision of a character establishing order),² is to safeguard, in the interest of the examination and classification tasks of the Patent Office and the informational interest of the public, concise and clear content of every single application,³ thus providing for well-defined and well-documented IP titles⁴ and ensuring legal certainty as well as searchability. At the same time, it prevents abusive circumvention of fees.⁵

B. Examination of unity of the application

The German Patent and Trademark Office concretely applies section 34 para 5 German Patent Act as follows.⁶ To determine lack of unity, the examiner must assess whether, in view of the technological context and the clarity of the inventive complex, processing in different procedures seems appropriate.⁷ Where lack of unity is found, the objection must be well-founded. Even if lack of unity is apparent even without reference to the state of the art, i.e. is obvious, so to speak, patentability of the subject matter of the application must be substantively commented on and the state of the art to be taken into consideration here must be stated. However, an applicant is only entitled to a substantive examination for one subject matter for which lack of unity has been established, since a separate application is required

¹ Translation according to https://www.gesetze-im-internet.de/englisch_patg/englisch_patg.html#p0092, an online service by the German Federal Ministry of Justice. Please note that the translations of German statutes into languages other than German available there are intended solely as a convenience to the non-German-reading public and that any discrepancies or differences that may arise in translations of the official German versions of these materials are not binding and have no legal effect for compliance or enforcement purposes (https://www.gesetze-im-internet.de/Teilliste_translations.html). The original German wording of the provision is: *“Die Anmeldung darf nur eine einzige Erfindung enthalten oder eine Gruppe von Erfindungen, die untereinander in der Weise verbunden sind, daß sie eine einzige allgemeine erfinderische Idee verwirklichen.”*

² Cf. BGH, 29th July 1971, X ZB 22/70, GRUR 1971, 512 (514) – *Isomerisierung*; Ann, Patentrecht, 8th edn. 2022, § 24 para 105; Schulte, Patentgesetz mit EPÜ, 11th edn. 2022, § 34 PatG, Rn. 249.

³ Ann, Patentrecht, 8th edn. 2022, § 24 para 105.

⁴ Cf. Busse/Keukenschrijver, PatG, 9th edn. 2020, § 34 para 97.

⁵ Cf. Benkard PatG/Schacht, 12th edn. 2023, PatG § 34 para 283; Ann, Patentrecht, 8th edn. 2022, § 24 para 105.

⁶ Cf. Section 2.3.3.4 *Richtlinien für die Prüfung von Patentanmeldungen* of 7th March 2022, available at <https://www.dpma.de/docs/formulare/patent/p2796.pdf> (the English version is currently being updated - a new version will be available soon).

⁷ Cf. German Federal Supreme Court (BGH) GRUR 1979, 619 – *Tabelliermappe*.

for each invention, even if it is expedient for reasons of procedural economy to mention further material relating to the other subject matter.⁸

C. Consequences of lack of unity

In case lack of unity is found, the examining section informs the applicant that the application might be refused and invites him, according to Section 42 para 1 or Section 45 para 1 German Patent Act, to correct the deficiency. Unity can then be established

- either by issuing a **declaration of division (“Ausscheidungserklärung”)**
- or by **abandoning the part that lacks unity (“Verzicht”)**.

D. Declaration of division (“Ausscheidungserklärung”)

The declaration of division (“Ausscheidungserklärung”) is **not explicitly codified** in the Patent Act, but widely acknowledged as an **unwritten legal institution**.⁹ **Section 39** of the German Patent Act (“Free division of the application”, which can at any time be made by the applicant)¹⁰ can, according to the current state of case law and prevailing line of analysis, **not be applied by analogy** to the declaration of division (“Ausscheidungserklärung”).¹¹ Differently to a free division under Section 39, the declaration of division (“Ausscheidungserklärung”) under Section 34 para 5 German Patent Act requires **initiation by the examining section and consent between the examining section and the applicant**.¹² The strict separation between declaration of division (“Ausscheidungserklärung”) on the one hand and free division under Section 39 German Patent Act on the other hand has been analysed as a difference between German law and the law of the European Patent Convention.¹³

The declaration of division (“Ausscheidungserklärung”) must rectify the deficiency of lack of unity in such a way that it becomes clear what remains in the parent application (“Stammanmeldung”). The subject matter of the divisional application must not go beyond the disclosed content of the parent application. If the declaration of division is ambiguous, the applicant is to be invited to clarify the matter within a fixed time limit. If no clarification is received, the original application must be refused. Upon division of an application, the divisional application will immediately become independent under procedural law; processing continues at the procedural stage which the original application had reached at the time of

⁸ Cf. BPatG Mitt 1978, 15.

⁹ Cf. Benkard PatG/Schacht, 12th edn. 2023, PatG § 34 para 314; Busse/Keukenschrijver, PatG, 9th edn. 2020, § 39 para 43.

¹⁰ According to Section 39 para 1 German Patent Act, the applicant may at any time divide his application by written declaration until the expiry of the time limit for lodging an appeal against the decision to grant the patent, cf. BGH GRUR 2000, 688 – *Graustufenbild*.

¹¹ Against analogy: BGH 10th July 1986 X ZB 29/84, GRUR 1986, 877 – *Kraftfahrzeuggetriebe*; Benkard PatG/Schacht, 12th edn. 2023, PatG § 34 Rn. 316; Mes, 5th edn. 2020, PatG § 34 Rn. 91; Busse/Keukenschrijver, PatG, 9th edn 2020, § 34 para 44; in favour of application of Section 39 however Ann, Patentrecht, 8th edn. 2022, § 25 para 234 et seq.

¹² Cf. Benkard PatG/Schacht, 12th edn. 2023, PatG § 34 para 314.; Mes, 5th edn. 2020, PatG § 34 para 91.

¹³ Benkard PatG/Schacht, 12th edn. 2023, PatG § 34 para 316.

the division.¹⁴ In the procedure of the divisional application, the applicant must file new documents as in the procedure for the parent application. If he does not file them within a time limit fixed by the examining section, the divisional application must be refused. The previous procedural acts in the parent case file are also a component of the divisional case file.

¹⁴ BGH GRUR 1986, 877 - *Kraftfahrzeuggetriebe*.