

GUIDELINES2DAY

NON-UNITY: QUESTIONS AND ANSWERS FROM
THE LIVE SESSION 25.02.2021

1. What was the reason to skip explanation of a priori and a posteriori, if it stays?

Lack of unity may arise *a priori* or *a posteriori*. However, the way in which unity is assessed is the same in both cases. It only differs in the available prior art. In the *a priori* cases, the prior art at hand is the information contained in the description and the common general knowledge of the skilled person, whereas in the *a posteriori* cases, lack of unity commonly arises from the documents revealed during the search.

Since there is no difference in how unity is assessed in both these cases, the previous edition of the Guidelines, which separately explained the assessment of unity *a priori* and *a posteriori*, incurred in considerable repetition. The new Guidelines still draw the difference between lack of unity *a priori* and *a posteriori* (see F-V, 2.2 and F-V.3 (i)), but the description of the assessment of unity at the EPO is described jointly for both cases, by referring in the second step to the “prior art at hand”.

2. Has the concept of "complex applications" been dropped? Complex is matters of unity.

The concept of “complex applications” is not *per se* a criterion for the assessment of unity under Article 82 and Rule 44 EPC. It is rather a term which may be used at the EPO to refer to some applications where the claims lack support in the description or which lack clarity and/or conciseness to such an extent that no meaningful search is possible (see Rule 63 EPC). In some of those cases, the requirement of unity may not either be complied with (B-VIII, 3.4). Most of the times it will be a combination of several objections. In such cases, often an invitation under Rule 63 EPC will be issued, sometimes followed by an incomplete search, or, in extreme cases, a declaration of no search.

3. Regarding the analysis of remaining features: If I have a list of claimed protein backbones SEQ ID NO. 1-10, wherein sequences 1-5 create a special effect and sequences 6-10 create another special effect, will I then have 10 different inventions or 2? The special effects are only given in the description.

Reformulated question: The claim contains a list of 10 alternatives, wherein alternatives 1-5 create effect A (not mentioned in the claim) and alternatives 6-10

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create effect B (also not mentioned in the claim), will there be 2 or 10 inventions?

This depends. If the technical effect achieved by sequences 1-5 provides a contribution over the prior art at hand, then sequences 1-5 will be grouped into one single group of inventions. If however there is no contribution over the prior art at hand, it is at the discretion of the examiner how to proceed. If no additional search effort is required but examination would require an additional effort for each invention, lack of unity can possibly be raised for each of sequences 1-5 without asking for further search fee. That is, lack of unity will need to be remedied in examination by selecting one of sequences 1-5. Alternatively, if there is no contribution over the prior art at hand and no additional search as well as examination effort is required, then the examiner may decide not to raise a lack of unity objections at all, as an objection of lack of novelty or inventive step would be raised, instead. This concerns situations where the claimed subject-matter of all alternatives is straightforwardly not allowable, i.e. not novel or not inventive. The same holds for alternatives 6-10.

This approach is identical in all situations where alternatives are claimed, for example also for chemical compounds defined by Markush formulas.

4. I hope that we shall not receive A82 arguments against dependent claims of a single independent claim unless novelty destroying prior art is available.

A non-unity objection may be raised if there is no “single general **inventive** concept” underlying a group of inventions. In case of a single independent claim, there may be lack of unity amongst the dependent claims if the independent claim is either not novel **or not inventive** (F-V, 3.2, F-V, 3).

The amendments introduced into the Guidelines 2021 are meant to further harmonize the reasons provided to applicants when raising a lack of unity. There is no change in practice and therefore applicants do not have to expect any “new” objections or an increase in the number of non-unity objections. As previously, F-V, 2.2 stresses that an objection of lack of unity is certainly made only in clear cases and it is neither raised nor insisted upon on the basis of a narrow, literal or academic approach. This is particularly so during search when the possible lack of unity does not necessitate a further search (F-V, 2.2).

Furthermore, F-V, 3.4 explains that trivial claims relating exclusively to features that seem unimportant in the light of the invention or that are generally known in the technical field of the invention are disregarded.

5. Claim 1 is found to lack novelty over D1. Dependent claims 2-15 cover different developments of the subject-matter of claim 1. If such developments are deemed to be “unrelated”, as they might typically be, each of the DEPENDENT claims 2-15

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can be deemed to lack unity (a posteriori)? The applicant can then be requested to pay 14 additional search fees?

See also the answer to question 4 above. In line with F-V, 4 the consideration of the requirement of unity of invention is always made with a view to giving the applicant fair treatment and the invitation to pay additional fees is made only in clear cases. The applicant should not be invited to pay an additional search fee for claimed inventions that are either not novel or do not possess an inventive step over the prior art at hand. Nevertheless, the search division may still raise an objection of lack of unity for such alleged "sub-inventions" in view of potential amendments that could be reasonably expected in the light of the description and any drawings.

However, if the inventions concern non-obvious alternatives to the disclosure of the prior art at hand or technical details of different apparatuses/methods/products that require a completely new search for an enabling disclosure, the search division may invite the applicant to pay additional fees for all the inventions.

In practice, whether further searches will be needed and, if so, how many, will very much depend on the particular circumstances of the case. For trivial claims (F-V, 3.4) usually no further search fee will be requested. However, the search division may still ask for an additional fee if in the light of the description a further search fee would appear reasonable in view of possible fallback positions (B-III, 3.5). In most cases, several dependent claims will be grouped together in the light of the technical problem they solved such that the amount of additional fees requested will usually be less than the number of dependent claims.

6. Could we not decide on a lack of unity if a potential applicant could give two licenses and both licenses can act separately?

Even though such an approach could in some cases lead to similar results, the EPO is bound to the provisions of the EPC and the PCT on unity of invention. The minimum reasoning set out in the Guidelines aims at ensuring those provisions and the criteria therein contained are applied in a transparent and consistent way.

7. Another way to look at unity, would it not be when we have partial problems in IS?

The concept of partial problems in inventive step is used when there is a juxtaposition of features in a single claim where there is no technical effect achieved by all the distinguishing features taken in combination (G-VII, 5.2).

The technical problem in the non-unity assessment may be different from that in a patentability assessment since the overall object is to find out what the claims have in common (F-V, 3). Therefore, the concepts of partial problems in the assessment of

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inventive step do not appear to be linked to the assessment of technical problem in the determination of the common matter and in the analysis of the remaining technical features.

8. If an "a posteriori" objection is raised, is it possible to "delete" the prior art at hand with the introduction of an allowable (supported) disclaimer?

If lack of unity between dependent claims is raised in view of prior art document D1, which discloses the subject-matter of independent claim 1, the introduction of a disclaimer into claim 1 disclaiming the disclosure of D1, will not necessarily result in the lack of unity objection to be dropped. In the assessment of whether the common matter identified makes a contribution over the prior art or not the principles of novelty and inventive step are used, see F-V, 2. That is, the objection of lack of unity will only be dropped if the common matter, i.e. claim 1, is not only novel over D1 but also if it is inventive over D1.

Moreover, the introduction of a disclaimer into a claim, which was originally not present, needs to comply with the provisions of Article 123(2) EPC and may be problematic, see H-V, 4.2. Disclaimers stemming from prior rights under Article 54(3) EPC are not required since these documents are not to be used for the assessment of unity, see F-V, 3.1.

9. Could you elaborate on why there is a lack of unity if the technical problem solved by inventions is known? I would assume that a claim set is unitary if all the claims disclose a non-obvious solution to a known problem.

If multiple alternative solutions are claimed, each alternative itself may be inventive in itself. However, for those alternatives to be unitary among themselves (F-V, 3 (ii)) what they have in common must also be inventive ("single general **inventive** concept"); and what they have in common will usually be the technical problem they address.

This assessment is unchanged with the new Guidelines.

10. Relation with unity and R 137(5). Often not admitted when features from the description are taken to limit the independent claim.

The procedure for unsearched subject-matter in the context of Rule 137(5) EPC is outlined in H-II, 6. The assessment is carried out such that the amended claims are compared to the claims originally searched to determine whether a non-unity objection would have been raised at search stage if both claims' sets were present. This procedure has not changed.

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11. Procedural question: Let's assume in the 10 alternatives example I get an invitation to pay 9 additional search fees. What can I do to have the invitation changed to just 1 additional search fee?

If the applicant disagrees with the finding of lack of unity, with the grouping of the claims or the amount of additional search fees requested, he can provide his arguments as a reply to the (final) Extended European search report and / or request a refund of additional search fees paid (C-III, 3.3). A reply to the provisional opinion is not required and will not be taken into account when the extended European search report (EESR) is issued (F-V, 4.1). The examining division will then review the search division's finding of lack of unity and whether the request for refund should be granted (C-III, 3.3). Ultimately, an interlocutory decision (Art. 106(2) EPC) can be issued if the examining division finds that a request for refund should not be granted, after having heard the applicant.

12. In your case study 1 let us assume claim 3 is dependent on claim 1 and 2. If now the examiner raises unity objection again (claim 1 not new in view of D1, unity selection between claim 2 and 3) and you decide to choose invention of claim 2 by pulling its features into claim 1, will claim 3 have to be removed or may remain as dependent claim of new claim 1?

This situation is described in F-V, 3.2.4. "*Dependent claims comprising features of two or more groups of inventions belong to all of the two or more groups of inventions.*"

13. An application contains a product claim, a claim directed to a method for producing the product and a claim directed to the use of the product.

A prior art appears which discloses the product as well as the method and use mentioned in the claims of the application.

Would you still raise the objection of lack of unity because the common matter (the product) is known or would you just raise an objection of lack of novelty?

Normally, the search examiner will not raise a lack of unity and ask for payment for further search fees if the subject-matter of the different claims is not novel or inventive over the prior art at hand. Only in exceptional circumstances, considering fallback positions in the description, lack of unity may be raised, see F-V, 4. There is no change in respect of this procedure in the Guidelines 2021.

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14. For case study 1, do the GL confirm that it is a novelty requirement which must be met and not inventive step? That is, what if the examiner considers it not inventive?

No, the underlying requirement is defined by Article 82 EPC, namely, that a lack of unity can be raised if there is no “single general **inventive** concept” underlying a group of inventions. In case of a single independent claim, there may be a lack of unity amongst the dependent claims if the independent claim is either not novel **or not inventive** (F-V, 3.2, F-V, 3).

15. What does the examiner do if the technical problem related to a specific feature is not explicitly explained in an application?

The requirement of unity of invention does not prescribe that the technical effect has to be provided in the claims. It is determined on the basis of the remaining technical features and their effect which should be analysed in the light of the description (F-V, 3 (iii)). If the description itself does not describe the technical effect related to these features, the examiner will apply the same principles as in the assessment of inventive step when formulating the objective technical problem solved. That is, the technical effect needs to be derivable from the application itself, i.e. it needs to be disclosed in the application or be known from the common general knowledge. If the applicant feels that the search examiner has wrongly assessed the technical problem associated with the remaining technical features, arguments can be provided as a reply to the Extended European search report and / or refund of an additional search fee can be requested. Upon entry into examination, the examining division will then review the finding of lack of unity and / or decide on a request for refund of an additional search fee.

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