



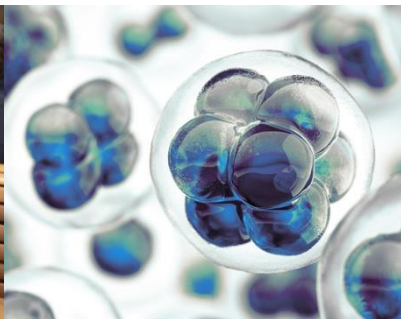
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Guidelines2day

Non-Unity



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Presenting today

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Overview

- The requirement of unity
- Unity in the Guidelines for Examination
- The assessment of unity at the EPO
- The “minimum reasoning” in case of non-unity objections
- Study case 1
- Study case 2

The requirement of unity

The application must *relate to one invention only or to a group of inventions so linked as to form a **single general inventive concept***

*Whether a group of inventions are so linked as to form a single general inventive concept 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 EPO applies the same standard in procedures under the PCT and the EPC

Art. 82 EPC
Rule 13.1 PCT

Rule 44 EPC
Rule 13.2 PCT

The requirement of unity

Basic principle:

a patent is granted **for each invention** separately

GL F-V, 1

Equal treatment of applicants

No undue burden on **third parties** monitoring prosecution of European patent applications

The requirement of unity in the EPO Guidelines

- **GL, F-V**
- **Background:** 2018 revision
 - Detailed description of the EPO assessment of unity
 - “minimum reasoning” agreed on by IP5 Offices

GL F-V

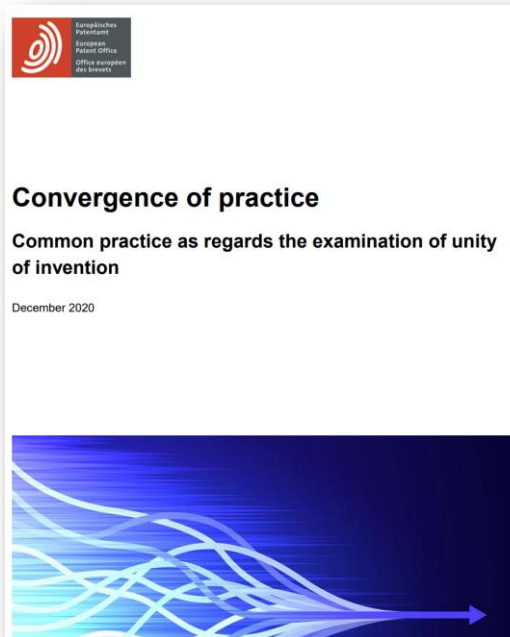
Minimum reasoning (IP5)

- ➔ The **common matter**, if any, between the (groups of) inventions.
- ➔ The reasons why this matter cannot provide a **single general inventive concept** based on same or corresponding **special technical features**.
- ➔ The reasons why there is no **technical relationship** among the (groups of) inventions, if not apparent.

A **concluding statement** that, because neither the same nor corresponding special technical features are present in the claims, there is no single general inventive concept and the requirements for unity of invention are not met.

The 2021 Guidelines revision

- Convergence of practices. Common practice:
 - Information to be provided when raising a non-unity objection
 - Definitions: “common matter”, “prior art at hand” and “technical problem”
- Other (minor) changes:
 - No separate explanation of the “a priori” and “a posteriori” assessment
 - Rearrangement of the existing contents



GL F-V

<https://www.epo.org/law-practice/convergence-of-practice.html>

The 2021 Guidelines revision

Chapter V – Unity of invention

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GL F-V

Unity assessment

- determining, in the light of the application as a whole, **the common matter**
- comparing the common matter with the "**prior art at hand**"
- analysing any **remaining technical features** which are not part of the identified common matter

Rule 44(1) EPC
Rule 13.2 PCT

F-V, 3

Determining the common matter

- Potential single general inventive concept among the claims
- Present in features that are either
 - the **same** (identical features) or
 - **corresponding** (features providing a common technical effect or the solution to a common technical problem)

GL, F-V, 3

Rule 44 EPC
Rule 13.2 PCT

Determining the common matter

- May be embodied in features of claims of different categories
 - e.g. claim 1: a product; claim 2: a process specially adapted for the manufacture of said product; claim 3: use of said product.
 - The product may represent the common matter
- May be embodied in interrelated product features, if in their interaction they contribute to the same technical effect or to the solution of the same technical problem

GL, F-V, 3

Rule 44 EPC
Rule 13.2 PCT

Technical problem in the non-unity assessment

- Relevant in determining what the claims **have in common**
- The starting point is usually the technical problem put forward by the applicant in the description.
- Should **neither be too narrow nor too general**
 - If too narrow, possible wrong conclusion that there is nothing in common (no corresponding technical features)
 - If too general, the common aspects of the problem may be known
 - possible wrong conclusion that there is lack of unity

GL, F-V, 3

Comparison with the prior art

- If common matter is identified it must be compared with the “prior art at hand”
- Does it define a non-obvious contribution over that prior art?

GL, F-V, 3



It involves **special** technical features.

- The application is unitary



The common matter is known or obvious, the inventions are not linked as to form a single general **inventive** concept.

- The application lacks unity

The prior art at hand

- Prior art being available at the point in time where the assessment of unity is carried out.
- Prior art relied upon may vary depending on the stage of the proceedings (**iterative** assessment of unity)
- Assessment carried out **before the search** (“a priori”)
Background art provided by the applicant and common general knowledge
- **During / after the search** (“a posteriori”)
Other prior art may be revealed, and the prior art at hand may change during the proceedings.

GL, F-V, 3

Assessment of the remaining features

- Groups of potential different inventions need to be identified
- This grouping is performed on the basis of the technical problems associated with the remaining technical features of each of the claims.
- If problems of different groups are different or known from the prior art, then lack of unity is confirmed.

GL, F-V, 3 and F-V, 3.2

Minimum reasoning

- The **common matter**, if any, between the (groups of) inventions.
- The reasons why this matter cannot provide a **single general inventive concept** based on same or corresponding **special technical features**.
- The reasons why there is no **technical relationship** between the remaining technical features of the different groups of claims;

F-V, 3.3.1

A **concluding statement** that, because neither the same nor corresponding special technical features are present in the claims, there is no single general inventive concept and the requirements for unity of invention are not met.

Special cases

- **If applicable**, detailed reasoning proving that there is no technical relationship involving the same or corresponding special technical features **may explain**:
 - (1) why grouped **alternatives** of **chemical compounds** are not of a similar nature;
 - (2) in case of lack of unity between **intermediate and final products**, why the intermediate and final products do not have the same essential structural elements and are not technically closely interrelated;
 - (3) why a **process** is not specially adapted to the production of a product;
 - (4) why a product itself does not provide a single general inventive concept linking **different uses** as defined in the claims;
 - (5) why a **use in itself** does not provide a single general inventive concept linking the subject-matter of the claims.

GL, F-V, 3.2.5

GL, F-V, 3.2.7

GL, F-V, 3.3.1

Case study 1

- Claim 1: A system for inspecting cargo containers, the system comprising a processing unit, a vehicle and a sensor mounted on the vehicle to move along the cargo container and to collect data from the sensor
- Claim 2: A system according to claim 1, wherein the sensor is a radiation detector.
- Claim 3: A system according to claim 1, wherein the vehicle is a drone.

Case study 1: Unity assessment

- Determining the common-matter
 - claim 1

- Comparison with the prior art at hand
 - Search reveals D1 which discloses all the features of claim 1

 - the common matter does not involve special technical features.

Case study 1: Unity assessment

- Analysis of the remaining technical features
 - technical problem addressed by claim 2: identification of a hidden threat within a cargo container



- Technical problem addressed by claim 3: approach the cargo so closely so that the signal noise ratio of the collected data can be improved.
 - The application lacks unity a posteriori

Case study 1: Possible non-unity reasoning (part 1)

Introductory part

The application lacks unity (Article 82 EPC).

The following separate inventions or groups of inventions are not so linked as to form a single general inventive concept:

- Group I: claims 1 and 2
- Group II: claims 1 and 3

Case study 1: Possible non-unity reasoning (part 2)

The reasons are as follows:

- ❑ The common matter linking these separate inventions together is the subject-matter of independent claim 1.
- ❑ This common matter is already known as D1 discloses these features, e.g. in fig. 1 and par. 10.
- The common matter can therefore not constitute a single general inventive concept linking together the claims.

Case study 1: Possible non-unity reasoning (part 3)

- Starting from this common matter,
 - the potential invention 1 comprises the following **additional features** of:
 - 1) the sensor being a radiation detector.

 - the potential invention 2, on the other hand, comprises the additional features of:
 - 2) the vehicle being a drone.

Consequently, the features of potential invention 1 and potential invention 2 which make a technical contribution over the common matter are different.

The **problems** solved by these technical features can be construed as the wish to

- 1) identify a hidden nuclear threat within a cargo container;
- 2) approach the cargo so closely so that the signal to noise ratio of the collected data can be improved.

As the technical problems are different, **the different technical features cannot be considered as being “corresponding special technical features”**.

Case study 1: Possible non-unity reasoning (part 4)

Concluding statement

As the claims comprise neither the same, nor corresponding special technical features, the technical relationship between the subject-matter of the claims required by Rule 44 EPC is lacking and the claims are not so linked as to form a single general inventive concept. Therefore, the application does not fulfil the requirement for unity of invention in the sense of Article 82 EPC.

Further questions



Now

via chat to "All Panelists"

Later

via e-mail to patentlaw@epo.org