

How to manage lack of unity of invention?

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Overview

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Introduction

- Interest of the applicant (best protection - costs - more than one patent)
- Interest of the patent office (Fees based to the assumption that the applications are restricted as to comply with the Unity of Invention requirement G 2/89)
- Interest of the third parties (patents should be clear and easy to understand)

Legal Sources

- EPC Art.82 : “The European Patent application should relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”
Rule 30
- PCT Art 3(4) (iii) and Rule 13 (1) to (5)
- EPC and PCT have identical provisions

Definitions

- one invention
- group of inventions so linked as to form a single general concept
- technical relationship among those inventions involving one or more of the same or corresponding technical features
- “special technical features” define a contribution which each of the claimed inventions considered as a whole makes over the prior art

Object of this legal provision

- administrative provision
- not in the opposition or national nullity proceeding
- Search and examination only for one invention - time and costs
- easy to search
- legal certainty for third parties

Lack of unity of invention - “a priori” and “a posteriori”

- separate search and examination in EPO and PCT proceedings
- “a priori” lack of unity: obviously more inventions - without evaluation of the novelty
- “a posteriori” lack of unity: general main claim is not novel over the searched state of the art - with evaluation of the novelty

Unity of Invention during Prosecution

- European Search
- European Examination
- International Search
- Preliminary International Examination
- Protest Proceeding before the Boards of Appeal of the EPO

Strategies to meet the Unity of Invention requirement

- Drafting the set of claims and the specification for a new invention
- US vs. European “style” - prosecution of US style documents in Europe
- Filing Divisional Applications

Thank you for your attention !

Good bye