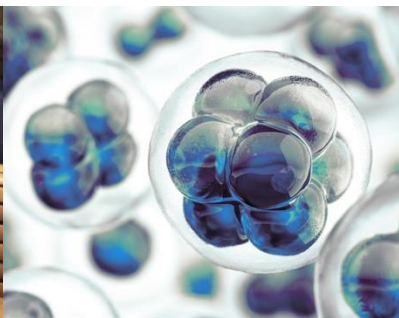




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5b. IP5 Co-operation: PHEP US Bar EPO Liaison Council

Washington, DC, 24 September 2019



Procedural patent harmonisation – IP5 PHEP

- IP5 PHEP
 - established in 2012
 - promote alignment of practices among the IP5
 - impetus provided by IP5 Industry

- Industry IP5 Harmonisation Topics List (Sep 2013), including *inter alia*
 1. Unity of invention (EPO/CNIPA)
 2. Citation of prior art (KIPO/USPTO)
 3. Written description and sufficiency of disclosure (JPO)

<http://www.fiveipoffices.org/activities/harmonisation.html>

Procedural patent harmonisation – IP5 PHEP

- **Citation of prior art:** KIPO/USPTO
 - prior art disclosure requirements
 - transition to an automatic, electronic prior art citation practice
 - submission of relevant prior art items only once, compliance with all duties and obligations of disclosure
 - development of workflow models → final report June 2019 → IT review

- **Written description sufficiency of disclosure:** JPO
 - issues re enablement, sufficiency of disclosure, written description and claims
 - pursue a consistent approach to the assessment of claim support and written description, sufficiency of disclosure and enablement
 - case studies → final report June 2019

Unity of invention (EPO/CNIPA)

- Determination and application of unity of invention criteria
- **IP5 Industry consensus proposal** (October 2014)
 - adherence to the PCT standard for unity
 - case studies
 - uniform application of the PCT standard
 - continuous coordination **with IP5 Industry**
- **Scope of work, methodology**
 - alignment of practices re international applications
 - case studies, 3 areas: mechanics, electricity, chemistry

Unity of invention (EPO/CNIPA)

▪ Objective

- suggest **improvements in non-unity reasoning**
- formulate a complete non-unity **example** including a reasoning
- reach a common way of raising non-unity objections, currently not available in the ISPE
 - notwithstanding differences in substantive patent laws that may lead to different outcomes
- enhance consistency of approach, **transparency** and **predictability**

▪ Next steps

- expand application of the agreed methodology outside the IP5 framework
→ **PCT MIA**

Unity in the PCT



Rule 13.1

A **Single General Inventive Concept**



Rule 13.2

A **technical relationship...**

...involving same or corresponding **Special Technical Features**

Key requirement



“a logical and complete chain of reasoning”

10.63 *In the invitation to pay additional fees, the International Searching Authority sets out a **logically presented, technical reasoning containing the basic considerations** behind the finding of lack of unity.*

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** 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.

Common matter

Is there **common subject-matter** between the (groups of) inventions?



The **common matter** must be identified in the reasoning.



The **absence** of common matter must be explicitly indicated.

ii No Single general inventive concept in the common matter

Why are none of the common technical features special?

- Prior art document.
- General knowledge.
- The teaching of the application itself.

iii Technical relationship

Why is there no **technical relationship** among the (groups of) inventions?

- Indicate **non common** technical features & **why** claims may be **grouped** together.
- Explicitly state that these features are **different**.
- For each group, identify the **technical properties** demonstrated through their features.
- For each group, explain why their technical properties are **different**.

iii Technical relationship (special cases)

Where appropriate (e.g. **chemistry**), the reasoning can instead explain why:

→ A grouping of alternatives of compounds are not of a **similar nature**.

→ The **intermediate** and **final** products do not have the same essential structural element and are not **technically closely interrelated**.

→ A process is not **specially adapted** to the production of a product.

→ A product itself does not provide a **SGIC linking different uses**.

→ A use in itself does not provide a **SGIC linking the claims**.

iv Concluding statement

The reasoning must **conclude** that:

Since neither the same nor corresponding special technical features are present in the claims, the inventions are not linked by a single general inventive concept and the requirements for unity of invention are not met.

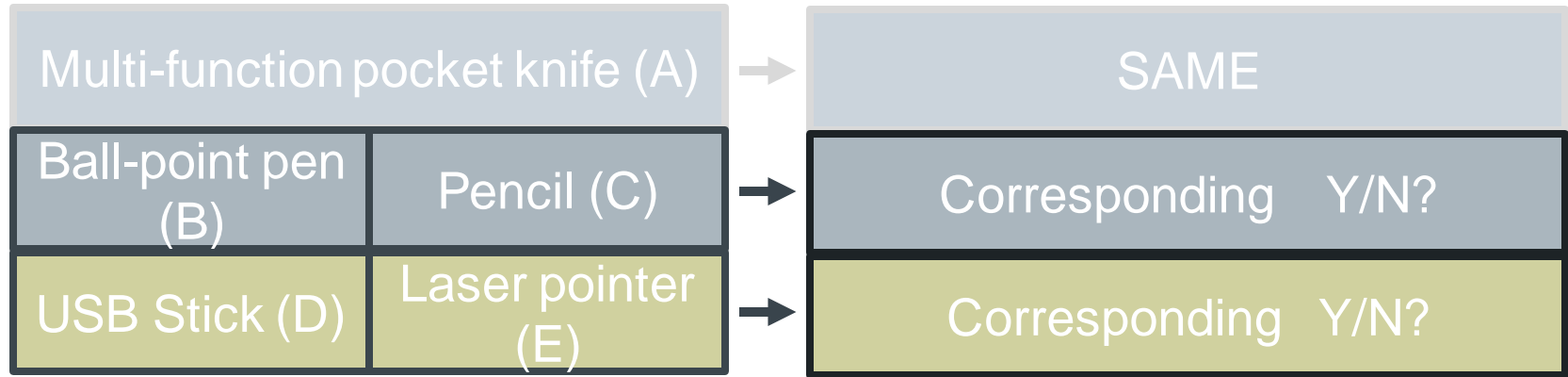
Example - lack of unity in practice

Claim 1: A multi-function pocket knife (A) with a ball-point pen (B) + a USB Stick (D)

Claim 2: A multi-function pocket knife (A) with a pencil (C) + a laser pointer (E)



What is the same and what is corresponding?



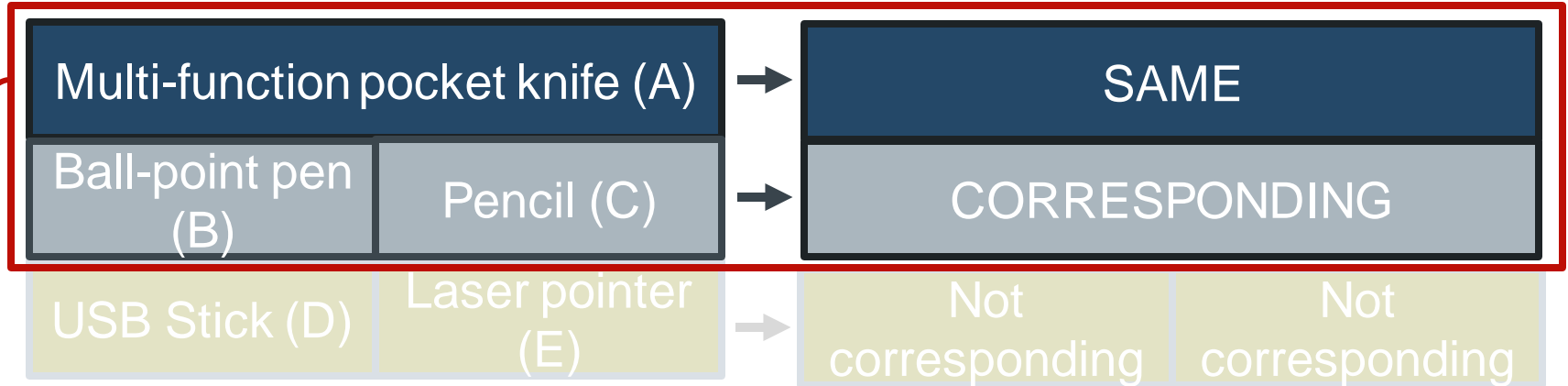
Ball-point pen (B) : writing means

Pencil (C) : writing means

USB stick (D) : means adapted to save data electronically

Laser pointer (E) : means adapted to point at an object

Reasoning : Common matter



The **common matter**, if any, between the different (groups of) inventions

Special technical features?

Application

Multi-function pocket knife (A)	
Ball-point pen (B)	Pencil (C)
USB Stick (D)	Laser pointer (E)

Prior Art 1

Multi-function pocket knife (A)
with Fountain pen (F)

- The same features (A) are known from Prior Art 1 so are not special
- The fountain pen (F) of Prior Art 1 is a writing means. **The corresponding technical feature is not special**
- **The common matter has neither same, nor corresponding special technical features**

Technical relationship

Application

Multi-function pocket knife (A)	
Ball-point pen (B)	Pencil (C)
USB Stick (D)	Laser pointer (E)

Prior Art 1

Multi-function pocket knife (A)
with Fountain pen (F)

- Assume that (B) and (C) are obvious alternatives to (F) and so are not special
- (D) and (E) do make a technical contribution over Prior Art (1). However, they have different technical properties.
- **There are two separate and unrelated inventions**

Conclusion

Since neither the same nor corresponding special technical features are present in claims 1 and 2, the inventions are not linked by a single general inventive concept and the requirements for unity of invention are not met.

IP5 PHEP – Future work

- Focus on **procedural, large impact** issues
 - within the **scope of the IP5 PHEP**
 - clear “business case”
- Set **realistic, manageable goals**
 - acknowledge constraints
- Process in place
 - finalisation target date: **end October 2019**



Thank you for your attention!

