

UNITY OF INVENTION AND FURTHER SEARCHES

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Under article 82 of the European Patent Convention (EPC), a European application must “relate to one invention only or to a group of inventions so linked as to form a single general inventive concept”—ie, show a unity of invention. Until now, a patentee seeking a Euro-PCT application (the European phase of international applications), when faced with a unity of invention objection, has been given different options depending on the national or regional patent office(s) chosen as the ISA (International Search Authority) and SISA (Supplementary International Search Authority).

Now, the rule relating to unity of invention and further searches of Euro-PCT applications (rule 164, EPC) has been amended so that even though differences will still exist in the European phase, an applicant’s ability to further pursue the preferred part of a Euro-PCT application will now be the same, irrespective of the national or regional patent office(s) chosen as the ISA or SISA.

Before, if the European Patent Office (EPO) was chosen as the ISA or SISA, and found a lack of unity of invention in the international phase, the applicant would be invited to pay one or more additional fees to have the non-searched invention(s) searched. If they were not paid, there was no option to pay them in the European phase.

On the other hand, if the EPO was not chosen as the ISA or SISA, the EPO would make a supplementary European search in the European phase. If the EPO found a lack of unity of invention, only the invention first mentioned in the claims would be searched in the supplementary European search.

The other inventions could be pursued only by filing divisional applications even though they had been searched by the ISA or SISA, adding costs for the applicant. However, when entering the European phase, the applicant could switch the order of the claims. The supplementary European search would then cover the first mentioned invention of the claims, which would be the invention that could be pursued through that application.

So if the EPO was not chosen as the ISA or SISA, and the business interests of the applicant changed to non-searched claims before the 31-month time limit to enter the European phase, the applicant was given another chance without having to pay additional costs.

This could be considered unfair since many applicants in the EPO states are only able to choose the EPO as the ISA. From another point of view, it might seem unfair to any applicant using an ISA and SISA other than the EPO, because if the EPO found a lack of unity of invention, the EPO would not give the applicant the option to pursue the non-searched claims unless a divisional application was filed. That is despite those claims having been

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searched by the ISA or SISA in the international phase and the ISA or SISA not finding a lack of unity of invention.

Under the new, amended rules, the EPO will—if the EPO finds lack of unity of invention, and if the EPO was not chosen as the ISA or SISA—issue a partial supplementary European search report, where the applicant is informed that an extended supplementary European search report will also cover those inventions, for which the applicant pays additional search fees. In the procedure before the examining division, the applicant is invited to limit the application to one of the searched inventions, but in the European phase the applicant is given the opportunity to choose the invention to be pursued.

Where the EPO was chosen as the ISA or SISA, and not all additional search fees were paid in the international phase, the applicant is informed that a search will be drawn up on the inventions for which additional search fees are paid. Together with the search, the applicant will receive either an examination report or a report about the text the EPO intends to grant, as well as an invitation to limit the application to one invention.

The amended rules give the applicant an opportunity to have all inventions searched at a relatively low cost. Based on the search results, the applicant can then choose the invention to be examined, and file one or more divisional applications well aware of the possibilities to receive a granted patent.

The new rules will be valid from November 1, 2014 and will apply to cases where (i) the supplementary European search report (if the EPO was not the ISA or SISA); or (ii) an examination report from the EPO (if the EPO was the ISA or SISA), has not been issued before that date. That might be the case even though the international application entered the European phase several years ago. ■

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