

18.05 Heading for Lack of Unity Action for PCT Applications During the International Phase (Including Species)

REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR 1.475(a), an international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in an international application, the requirement of unity of invention 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 expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

When Claims Are Directed to Multiple Processes, Products, and/or Apparatuses:

Products, processes of manufacture, processes of use, and apparatuses are different categories of invention. When an application includes claims to more than one product, process, or apparatus, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the “main invention” in the claims. In the case of non-compliance with unity of invention and where no additional fees are timely paid, the international search and/or international preliminary examination, as appropriate, will be based on the main invention in the claims. See PCT Article 17(3)(a), 37 CFR 1.475(d), 37 CFR 1.476(c) and 37 CFR 1.488(b)(3).

As provided in 37 CFR 1.475(b), an international application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Examiner Note:

1. Begin all Lack of Unity actions for PCT applications during the international phase (including species) with this heading.
2. Follow with form paragraphs 18.06 - 18.06.02, 18.07 - 18.07.03, as appropriate.
3. Use form paragraph 18.18 for lack of unity in U.S. national stage applications submitted under 35 U.S.C. 371.

18.18 Heading for Lack of Unity Action in National Stage Applications Submitted Under 35 U.S.C. 371 (Including Species)

REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR 1.475(a), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention 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 expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

When Claims Are Directed to Multiple Categories of Inventions:

As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

Examiner Note:

1. Begin all Lack of Unity actions in national stage applications submitted under 35 U.S.C. 371 (including species) with this heading.
2. Follow with form paragraph 18.19 or 18.20, as appropriate.
3. For lack of unity during the international phase, use form paragraph 18.05 instead of this form paragraph.

18.19 Restriction Requirement in National Stage Applications Submitted Under 35 U.S.C. 371

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Examiner Note:

1. This form paragraph is to be used when making a restriction requirement in a national stage application submitted under 35 U.S.C. 371.
2. This form paragraph is to be followed by form paragraphs 18.06 - 18.06.02, as appropriate, and by form paragraphs 18.07 - 18.07.02, as appropriate.
3. All restriction requirements between a product/apparatus and a process of making the product/apparatus or between a product and a process of using the product should be followed by form paragraph 8.21.04 to notify the applicant that if all product/apparatus claims are found allowable, process claims that require all the limitations of the patentable product/apparatus should be considered for rejoinder.
4. When all of the claims directed to the elected invention are in condition for allowance, the propriety of the restriction requirement should be reconsidered to verify that the non-elected claims do not share a same or corresponding technical feature with the allowable claims.

18.20 Election of Species in National Stage Applications Submitted Under 35 U.S.C. 371

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

[1]

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Currently, the following claim(s) are generic: [2].

Examiner Note:

1. This form paragraph is to be used when making an election of species requirement in a national stage application submitted under 35 U.S.C. 371.
2. In bracket 1, identify the species from which an election is to be made.
3. In bracket 2, identify each generic claim by number or insert the word --NONE--.
4. This form paragraph is to be followed by form paragraphs 18.07 - 18.07.03, as appropriate.

18.07 Lack of Unity - Reasons Why Inventions Lack Unity

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Examiner Note:

Follow with form paragraphs 18.07.01 through 18.07.03, as appropriate.

18.07.01 Same or Corresponding Technical Feature Lacking Among Groups

[1] lack unity of invention because the groups do not share the same or corresponding technical feature.

Examiner Note:

1. This form paragraph may be used, for example, where the claims of Group I are directed to A + B, whereas the claims of Group II are directed to C + D, and thus the groups do not share a technical feature.
2. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) where inventions have been grouped using form paragraphs 18.06 - 18.06.02, or identify the species involved where species have been listed using form paragraph 18.20.

18.07.02 Shared Technical Feature Does Not Make a Contribution Over the Prior Art

[1] lack unity of invention because even though the inventions of these groups require the technical feature of [2], this technical feature is not a special technical feature as it does not make a contribution over the prior art in view of [3]. [4]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) where inventions have been grouped using form paragraphs 18.06 - 18.06.02, or identify the species involved where species have been listed using form paragraph 18.20.
2. In bracket 2, identify the technical feature shared by the groups.
3. In bracket 3, insert citation of prior art reference(s) demonstrating the shared technical feature does not make a contribution over the prior art. Whether a particular technical feature makes a “contribution” over the prior art, and, therefore, constitutes a “special technical feature,” is considered with respect to novelty and inventive step.
4. In bracket 4, explain how the shared technical feature lacks novelty or inventive step in view of the reference(s).

18.07.03 Heading – Chemical Compound Alternatives of Markush Group Are Not of a Similar Nature

Where a single claim defines alternatives of a Markush group, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, is considered met when the alternatives are of a similar nature. When the Markush grouping is for alternatives of chemical compounds, the alternatives are regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity; AND

(B)(1) a common structure is present, that is, a significant structural element is shared by all of the alternatives;
OR

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The phrase “significant structural element is shared by all of the alternatives” refers to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity.

The phrase “recognized class of chemical compounds” means that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

Examiner Note:

1. This heading should be used when the chemical alternatives of a Markush group are determined to lack unity of invention.
2. Follow with form paragraphs listed using form paragraphs 18.07.03a - 18.07.03c, as appropriate.

18.07.03a Alternatives Lack Common Property or Activity

The chemical compounds of [1] are not regarded as being of similar nature because all of the alternatives do not share a common property or activity. [2]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., "Groups I and II") in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the species involved where species have been listed using form paragraph 18.20.
2. In bracket 2, insert reasoning.

18.07.03b Alternatives Share a Common Structure - However, the Common Structure is Not a Significant Structural Element and the Alternatives Do Not Belong to a Recognized Class

Although the chemical compounds of [1] share a common structure of [2], the common structure is not a significant structural element because it represents only a small portion of the compound structures and does not constitute a structurally distinctive portion in view of [3]. Further, the compounds of these groups do not belong to a recognized class of chemical compounds. [4]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., "Groups I and II") in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the species involved where species have been listed using form paragraph 18.20.
2. In bracket 2, identify common structure.
3. In bracket 3, insert citation of prior art reference(s) relied upon to demonstrate the commonly shared structure is not distinctive.
4. In bracket 4, explain why the compounds do not belong to a recognized class of chemical compounds.

18.07.03c Alternatives Do Not Share a Common Structure or Belong to Recognized Class

The chemical compounds of [1] are not regarded as being of similar nature because: (1) all the alternatives do not share a common structure and (2) the alternatives do not all belong to a recognized class of chemical compounds. [2]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., "Groups I and II") in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the species involved where species have been listed using form paragraph 18.20.
2. In bracket 2, insert reasoning.

18.21 Election by Original Presentation in National Stage Applications Submitted Under 35 U.S.C. 371

Newly submitted claim [1] directed to an invention that lacks unity with the invention originally claimed for the following reasons: [2]

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

18.22 Requirement for Election and Means for Traversal in National Stage Applications Submitted Under 35 U.S.C. 371

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Note:

1. This form paragraph should be used when requiring restriction (including an election of species) in an application that entered the national stage under 35 U.S.C. 371.

2. This form paragraph should follow form paragraph 8.23.01 when a telephone call was made that did not result in an election being made.