



American Intellectual Property Law Association

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Via email: prigopoulos@epo.org

Re: Comments on Draft Template on Unity of Invention

Dear Mr. Rigopoulos,

Thank you for asking the American Intellectual Property Law Association (AIPLA) to provide comments on the current study being conducted by the Patent Harmonization Experts Panel (PHEP) of the IP5 Patent Offices on Unity of Invention. We are writing now in response to the request of February 6, 2017.

With respect to Unity of Invention practice, it should be noted for clarification that AIPLA has taken a position in past actions of its Board of Directors that the U.S. should change its law to provide for the Unity of Invention standard to be used in examination of all U.S. patent applications regardless of whether they are national applications or PCT National or International applications.

The EPO has developed a template to gather information on the IP5 offices approaches to handling Unity of Invention, and AIPLA was asked to comment on a draft of the template. The members of the AIPLA Patent Harmonization Task Force and a few additional selected AIPLA members were asked to review and comment on the draft template. Based on the recent discussions at the Industry Consultation Group in January, we understand that EPO would like to receive comments on the draft template directed to the following general areas:

- study approach
- methodology
- scope of study
- selected technical areas
- specific study template
- issues of importance re unity of invention in the field of case study 1 – mechanics
- application of unity of invention requirement in the IP5 jurisdictions
- recurrent problems, i.e. divergences

This response provides a summary of the responses received to date. It does not reflect an official position of AIPLA. Only a few members have submitted comments, and the comments

generally found the draft template and its implementation to need some further consideration. The majority of the comments received are not broken into the specific general areas listed above, so they are simply repeated below for the benefit of the EPO's information and study.

One member provided the following comment:

I would have expected that the study on unity of invention would have started with Chapter 10 of the PCT ISPE <http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf> as the benchmark as identified in the EPO presentation slides. Chapter 10 has 39 examples. Then the focus would be harmonizing among the IP5 offices on the approaches taken to how to handle these 39 examples uniformly and consistently on a best practices basis in the international phase. Following that international phase study focusing on how the IP5 would handle the 39 examples under national law practices should be studied to ascertain the best practices for handling these 39 examples. I have no quarrel with the questions asked. They are pragmatic. Addressing all 39 examples would give scope to the study by technical areas.

Another member commented as follows:

1) The survey asks questions on how an examiner would respond to certain scenarios. Of course in answering this, patent offices can be expected to provide the textbook answers that should be used. But that does not reflect how examiners respond in real practice, which is far different from the theoretical responses that the patent offices likely will give.

It is necessary to see actual cases on how examiners, especially in the U.S., do not understand unity of invention practice and instead, apply restriction practice even to unity situations. For example, in the national phase, where unity applies, U.S. examiners ask for selection of species, which is totally inapplicable to a unity rejection.

Perhaps we should ask our members to submit examples of such bad applications of unity, and instead of, or in addition to, seeking theoretical answers to scenarios, look at actual cases submitted by our members.

2) All of the scenarios that the EPO put together are based upon the European understanding of unity and how it is applied. Perhaps they should ask the U.S. patent office and Japanese patent office to each put together scenarios based upon their respective understandings of unity, so we get a variety of scenarios from different patent offices reflecting different approaches to unity understanding. Then we could let all the patent offices respond to these different scenarios put together by a variety of patent offices.

3) It would be helpful to have these scenarios answered not only by patent offices, but also by patent attorneys, based upon their experience, and then compare the patent offices' views as compared to the attorneys' views.

4) Harmonizing unity of invention must be approached on two levels. The first level is to make sure that all patent offices, in theory, have the same understanding and approach to these various scenarios. However on a second level, we must make sure

that each examiner within a single patent office has the same understanding of unity as his own patent office.

It is this second level that is most distressful. While in theory the office can say we interpret unity a certain way, but when it comes to the actual examination, the individual examiners have no concept of what that is and that's where the problems arise.

It is suggested that the scenarios should be answered both on an administrative level on behalf of each patent office, and then an arbitrary selection of examiners within each patent office should be made, and those arbitrary examiners should respond to the same scenarios and see how close they come to the theoretical response that the administration in the patent office provides.

Another member responded as follows:

I am fine with this. The only question that I thought was not necessary is "Does the order of the claims make a difference in the number of the inventions?" But fine to include it.

The following further comment was received:

First, as to the request for comments, the focus is on the practice of the offices, particularly in the International stage (title is PCT CH 1). Most of the problems that we encounter are in the national stage, where the U.S. Examiner is more likely to mix domestic restriction practice and international unity practice. This is also where a misunderstanding of unity occurs, even if proper reference is made to PCT Rule 13. This is where the role of "special technical feature" is typically misapplied.

Second, the survey should look into the statistics of an applicant successfully overcoming a requirement for unity. That can be done in several ways. First, it can be shown that there is a special technical feature that is not in the prior art. Second, the prior art cited can be attacked to show that the special technical feature is not in the prior art, because the art was misapplied, is misunderstood or is not in an analogous art area. Third, the claim can be amended to overcome the prior art, as applied. These three approaches are most likely to be seen in the national stage. Information on the success of each approach and the strategies for using them would be useful to applicant's worldwide and would help in achieving uniformity in the application of the unity standard.

In general, the entities best equipped to answer the survey for the U.S., aside from the USPTO, are large companies like IBM and GE that file a lot of PCT cases.

A final comment provided some specific ideas related to the items identified in the Industry Consultation Group discussions:

- *study approach - I like the idea of sending out a template and getting Office input on scenarios and specific general questions. If the Offices cannot agree on how to apply unity, what can a practitioner do? I think the offices should decide among themselves*

how to similarly handle unity of invention and then train the Examiners to follow the rules the same way.

- *methodology - Not sure what the difference is between study approach and methodology.*
- *scope of study - Keeping it small at first is a good idea.*
- *selected technical areas - This is as good a place as any to start. Mechanical claims are the least specialized so they are good to flesh out general concepts. Eventually should do other areas.*
- *specific study template - Good start. Again, I like to keep it small and manageable. However, I do not like that it is very problem oriented. It should focus on where the Examiner has to search. Otherwise, why do we have common classifications?*
- *issues of importance re unity of invention in the field of case study 1 – mechanics Would an examiner look in the same places for art regarding the various claims to justify them being a unitary concept? Both claims are to a knife with electronics. If memory sticks and laser pointers are in the same search classes they should be kept together.*
- *application of unity of invention requirement in the IP5 jurisdictions - It should always apply. However, with U.S. rejoinder practice, we often get back to the same place with U.S. restriction practice as with unity practice, but for species. However, again, if the different species are in different classes, I think it is fair to keep them in separate patents or require an extra search fee. In Chemical practice, we can artificially create Markush groups with species that are not chemically related. Unless we agree they are patentably indistinct (which never happens) the examiner really would be forced to search multitude of very different inventions.*
- *recurrent problems, i.e. divergences. U.S. Examiners not trained sufficiently in Unity practice. They give three pages of boiler plate regarding the rules and then still apply them incorrectly. Particularly in chemical cases, the U.S. Examiner always seems to split claims to a product and a process for making the product, even if it is fairly apparent that the product is the invention. Thus, if we elect the process and after searching, those claims are allowed, I have never seen a U.S. Examiner admit that the claims were allowed because he or she could not find the product made by the process, and then rejoin the claims to the product. Of course, as mentioned above, if we elect the product and get allowed product claims, the process claims for making that product usually are rejoined. However, under best practices, claims should be rejoined in both instances.*

Thank you for the opportunity to consult with you and your colleagues on this important issue. We welcome the opportunity for further discussion on this and other matters of interest as this survey on Unity of Invention moves forward.

Sincerely,



Mark L. Whitaker

President

American Intellectual Property Law Association