



Unity of invention

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A patent application can relate to one invention only or a group of closely related inventions. The purpose of the unity requirement is to ensure equal treatment of applicants: Everybody has to pay one fee for one invention in one application. That said, the requirement also serves a regulatory function to limit search and examination work in the procedure up to grant. A further aspect of the unity requirement is to provide the public with full information and transparency and avoid "hidden" inventions in a patent application. The concept of unity of invention was first mentioned in the Paris Convention for the Protection of Industrial Property of 1883, and it is now found in all major patent systems worldwide.

The international application

An international PCT patent application must relate to only one invention or a group of inventions having the same general inventive concept.

The "single general inventive concept" can be identified by the following approach:

1. Identify the independent claims of the application.
2. Formulate a single general (i.e. "common") concept for all the independent claims.
3. If no single general concept can be identified, or if the single general concept is known or clearly obvious from the prior art, then the application lacks unity of invention because there is no single general inventive concept linking the different groups of claims.

For example, a patent application directed to several mutated genes each representing a biomarker for e.g. breast cancer does not meet the requirement of unity since it is already known to use mutated genes as

biomarkers for breast cancer. Therefore, the biomarkers do not form a single general inventive concept, but instead each biomarker represents one invention. The requirement of unity can be met if the biomarkers are claimed as a panel of biomarkers, wherein all genes are used to assess breast cancer. However, this may result in unnecessary limitation since the biomarkers can be used individually to assess breast cancer without infringing the patent.

Without contravening the requirement of unity, a patent application directed to a product may also contain claims directed to:

- a process specially adapted for the manufacture of the product,
- an apparatus specifically designed for carrying out the process and
- use of the product.

Such claims are all related to the same technical concept, namely the special technical features of the product and therefore comply with the requirements of unity.

If the International Searching Authority finds that the international application does not meet the requirement of unity, it establishes a partial search report in respect of the invention first mentioned in the claims, and invites the applicant to pay additional fees. The applicant must pay one additional fee for each additional invention to be searched. It is possible to object to the decision, but more often than not, the objection is dismissed. However, if the objection is found to be justified, the additional fee is reimbursed.

No rights will lapse if no or only some additional fees are paid. If no additional fees are paid, the international search report will be established in respect of the first invention only. The inventions of the other group(s) may be patented in national phase using different strategies. For example the claims can be amended to cover only the other group(s) of inventions or the other group(s) of inventions may be protected in a divisional application at the national stage subject to payment of fees in each individual country.

Europe

In European procedures, the unity of invention is examined according to the same principles as discussed above for the PCT procedures. The applicant is informed if a lack of unity objection is raised by the search division and is invited to pay additional search fees to get more than the first invention searched. This also applies if a unity objection was raised in the PCT phase and no or only some additional fees were paid.

Sometimes it is possible to convince the patent examiner of unity even though an objection has previously been raised, and in this case, any additional fees paid may be reimbursed. Thus, final decision as to unity is made by the examining division.

Any granted patent must relate to one invention only, and thus, even if additional fees are paid and multiple inventions are searched, the application must be limited to a single invention during the examining procedures with a view to possible patent protection. Other inventions can be pursued in one or more divisional applications.

USA

Although the concept unity of invention in the US in principle is examined as discussed above for the PCT and European procedures, significant differences exist with respect to the respective procedures in USA and Europe.

If the US Examiner identifies more than one invention in a patent application, a so-called restriction requirement is issued, which corresponds to a unity objection. A restriction requirement requires the applicant to elect one and only one invention to which the claims must be restricted.

There is no possibility for paying additional search fees. It is possible to object to the unity objection, but unfortunately it rarely succeeds.

The non-elected claims can be pursued in divisional or continuation patent applications.

Conclusion

The concept of unity of invention is based on a one patent for one invention principle that ensures equal treatment of applicants since only one invention is searched and examined for each set of fees paid. There is a risk that the patent system would be unclear and imbalanced if applicants could hide several inventions in the same patent. Therefore, a patent must be limited to one invention only. The patent claims are unitary if they relate to the same general inventive concept. Filing a patent application with several inventions does not necessarily result in a loss of rights, since further inventions can be pursued in divisional applications.

If you have any questions you are very welcome to contact your patent attorney at HØIBERG A/S.



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