

### 3.4. No assessment of lack of unity in opposition proceedings

In G 1/91 (OJ 1992, 253) the Enlarged Board held that unity of invention did not come under the requirements which a European patent and the invention to which it related had to meet under Art. 102(3) EPC 1973 (Art. 101(3)(a) EPC) when the patent was maintained in amended form. It was consequently irrelevant in opposition proceedings that the European patent as granted or amended did not meet the requirement of unity. It was clear from the "travaux préparatoires" not only that lack of unity was deliberately excluded as a ground for opposition, but also that any lack of unity arising during opposition proceedings as a result of amendment of the patent had to be accepted. Although unity of invention under Art. 82 EPC 1973 was a material requirement, it was still merely an administrative regulation. It served a number of administrative purposes, particularly in demarcating the respective responsibilities of the departments. The administrative purposes of unity were fulfilled in the main up to the time the patent was granted. The purpose of opposition proceedings was to give a competitor the opportunity of opposing unjustified protective rights. He did not also need to be given the opportunity of contesting a patent on the ground of lack of unity. Lack of unity did not in fact rule out patent protection; it could only result in an application being divided to produce two or more patents. See also T 830/11.

## 4. Criteria for determining lack of unity

### 4.1. Analysis of the technical problem as a precondition

According to the established case law of the boards of appeal, determining unity of invention requires as a precondition an analysis of the technical problem or problems underlying the respective group of inventions (see W 11/89, OJ 1993, 225; W 6/97, T 188/04), i.e. whether or not the subject-matter claimed as the solution to such a problem represents a single general inventive concept (see W 6/91; also T 2248/12 and T 129/14). Disregarding this principle would be in itself sufficient justification for the reimbursement of the additional search fees. In W 8/94 the board held that a discussion of the problem underlying the claimed subject-matter was required, because only then was it possible to decide whether or not a common special technical feature within the meaning of R. 13.1 and R. 13.2 PCT existed for different embodiments (see W 11/89, OJ 1993, 225; W 14/89, W 59/90, W 14/91, W 17/91; also T 1414/18, with further references).

In W 6/97 the board found that establishing the technical problem underlying a claimed invention or group of inventions in relation to the state of the art should start, as a rule, from what was considered in the description as having been achieved by the claimed invention, since claims directed to compositions of matter at least were normally silent on the technical effects to be achieved by such compositions. As soon as the search revealed prior art which was clearly more relevant than that already acknowledged in the description of the international application, it was necessary to determine what was to be considered as the particular technical problem in view of both the disclosure of the international application as a whole and the prior art thus revealed (see W 6/91). Unity of invention might be assessed only after the technical problem had been determined in such a manner.