

usual sense which may be characterised in that the specific end products are envisaged at the outset of the process, but to a process of isolating genes which, in view of its set up, has resemblance to a screening process which, in turn, may be characterised in that the final product is not known at the outset, should have an influence on the assessment of unity. The board held that the decisive question was whether the product had actually been produced by the process and not whether it had been known at the start of it. Therefore, there was no difference in the assessment of unity between a manufacturing process and a screening process and their resulting products.

In W 18/01 the board pointed out that it followed from the definitions in the Regulations under the PCT and the PCT International Preliminary Examination Guidelines (which are binding on the EPO; see G 1/89, OJ 1991, 155, point 6 of the Reasons) that it was normally not sufficient merely to define and examine the common core of a group of inventions, for example by indicating the features which were specified in all the claims defining the inventions of the group. R. 13.2 PCT required an examination of the technical relationship among the inventions in a group. Such a relationship could exist even if the inventions did not involve the same technical features, provided they involved corresponding special technical features. The definition of "special technical features" given in R. 13.2 PCT required an analysis of the contribution which each of the claimed inventions made over the prior art. This first entailed analysing which of the features distinguished the claimed inventions from the cited prior art before their contribution could be examined in the light of the description, in particular the problems solved and the effects achieved by the claimed inventions.

5.3. Unity of single claims defining alternatives ("Markush claims")

R. 44(1) EPC and R. 13.2 PCT also apply where a single claim defines alternatives ("Markush claim"). According to R. 44(2) EPC and R. 13.3 PCT, the determination of whether a group of inventions is so closely 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 also W 35/91).

In considering whether the ISA had substantiated its findings of non-unity, the board in W 3/94 (OJ 1995, 775) referred to the section on the "Markush practice" in Annex B, Part 1(f) of the Administrative Instructions under the PCT, as in force from 1.7.1992 (see now Annex B, para. (f) PCT Administrative Instructions, as in force from 1.1.2019). Here it is stated that the requirement of a technical interrelationship and the same or corresponding special technical features as defined in R. 13.2 PCT shall be considered met when the alternatives are of a similar nature. The section then specifies when alternatives are to be regarded as "of a similar nature."

In W 1/94, the EPO acting as ISA had found that the compounds according to the "inventions" it had identified did not have a new structural element. Nevertheless the board concluded that the absence of such an element did not automatically destroy the unity of the invention. On the contrary, it was clear from the PCT Administrative Instructions that a technical relationship must be recognised for a group of alternative chemical compounds, such as all the compounds having a common property or activity, and such a common