

Chapter V – Unity of invention

1. Unity of invention under Chapter II

If an invitation to pay additional fees was issued during Chapter I and the applicant paid some or all of the required additional fees, and if, where applicable, the objection as to lack of unity was at least partly upheld during a protest procedure, then under Chapter II the applicant will normally be invited (using Form 405) to pay additional examination fees if all the searched inventions are also to be examined under Chapter II. Inventions for which no search fees were paid cannot be pursued and will thus also not be objected to or commented on. A review of the decision taken under Chapter I is not provided for in the PCT.

Art. 34(3)(a)-(c)

Rule 68.2

GL/ISPE 10.74

A single WO-IPEA/IPER is then drafted by the examiner, dealing with all the inventions for which examination fees have been paid.

In reply to the WO-ISA the applicant may have filed redrafted claims which differ substantially from those for which lack of unity was raised. In such a case it should be carefully considered whether:

- the lack of unity objection still applies to the new set of claims
- the amended claims relate to searched subject-matter
- the reasoning as to lack of unity has to be amended because of the new claims and/or the arguments presented.

Normally, the examiner under Chapter II agrees with the objection made at the search stage. Exceptionally, if this is not the case (e.g. if the search and WO-ISA were made by another office), it is possible to send out an invitation to pay further examination fees (Form 405) even if this was not done at the search stage. However, if a lack of unity objection was raised at the search stage resulting in a partial search and a different conclusion is reached under Chapter II, there is no possibility to ask for an additional search for unsearched subject-matter. In this case, examination in Chapter II is restricted to what has been searched.

Furthermore, it is possible that the original claims did not lack unity but the amended claims do. In such a case, if the amended claims lacking unity relate to unsearched subject-matter, they are not examined, and a WO-IPEA/IPER is established on searched subject-matter only (no Form 405 is to be sent out). On the other hand, if e.g. the applicant has generalised the original independent claim so that it is no longer novel and lack of unity a posteriori occurs, then an invitation to pay additional fees is sent before the WO-IPEA/IPER.

For information on the exceptional situation of a non-unitary application, where all inventions examined were found novel and inventive, but still lacking unity as the only remaining objection, see GL/PCT-EPO C-VIII.3.