

UNITY OF INVENTION: A MATTER OF CONCERN

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Provisions for unity of invention in many jurisdictions usually mean that an application may relate only to one invention. However, a group of inventions may also be covered by the same application if the inventions are linked so that they form a single general inventive concept. This is an essential requirement for grant of a patent besides novelty and inventive step.

The Pakistan Patents Ordinance 2000—presently in force in Pakistan—prior to a 2002 amendment, had a similar provision under Section 13(3), which provided that each application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. On October 26, 2002, this provision was amended by omitting the words “or to a group of inventions so linked as to form a single general inventive concept”, which completely changed the concept of unity of invention and rendered the patents regime in Pakistan contrary to the generally accepted concept throughout the world.

In view of the amended provision an application is required to relate to one invention only, and accordingly the Patent Office’s examination practice regarding unity of invention in claims has also changed. Under the prevailing provision, any claim relating to more than one form of invention, or amounting to a claim for an invention distinct from that claimed in preceding claims, is considered objectionable with no regard to single general inventive concept.

Such objections are generally raised on independent claims. Objections relating to the subject matter of independent claims may be overcome by making such claims dependent on preceding claims of the same category if possible. However, if the applicant prefers to maintain independent claims, the Patent Office allows up to three of them, with typically one independent claim in each claim category, provided the technical relationship is sufficiently justified. If the applicant fails to justify the technical relationship of the claims as one invention, and is also unable to make it dependent on the preceding claims, such claims are required either to be deleted or claimed in divisional applications.

The Patents (Amendment) Ordinance, 2002 added a sub-section 8 to Section 15 of the Patents Ordinance, 2000, which states that a chemical product intended for use in agriculture or medicine shall relate to a single chemical product only, excluding its derivatives and salts. Accordingly, where the invention is defined by a general chemical structural formula, the sub-generic class and species claimed shall share a common structure and properties to satisfy the requirement of one invention only.

Derivatives and salts cannot be claimed in the same application under Section 15(8), but derivatives and salts, provided there is a material and

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novel improvement in the claim, may be claimed as a separate invention or, where applicable, as a divisional application. The section is silent about protection of derivatives and salts with no material and novel improvement from the main compound’s claim. This is a matter of concern to the applicants, as in the absence of any explanation, preparation of derivatives and salts by third parties may not be regarded as infringement.

The ‘one invention only’ concept not including a group of inventions so linked as to form a single general inventive concept is also a matter of concern among patent applicants as it substantially limits the scope of protection. It is important to applicants to protect their inventions, along with a group of inventions so linked as to form a single general inventive concept, in one application, as it may not be a cost-effective option to file a number of divisional applications. This may particularly become necessary for chemical and pharmaceutical products in order to avoid risk of use of the invention by third parties without infringing the patent, which can cause substantial financial losses to the patentees.

Innovative pharmaceutical companies are concerned with the situation and are demanding restoration of Section 13(3) of the Patents Ordinance, 2000 to include the wording “or to a group of inventions so linked as to form a single general inventive concept”.

We hope that the government of Pakistan will take the necessary action in the near future to amend the law in view of the concerns of those seeking patent protection in Pakistan, to promote strong patent provisions in conformity with international practices and to harmonise the law with other systems around the world. ■

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