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Unity of Invention in Japan

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Introduction

The requirements for unity of invention are met when the invention described in each claim of an application is associated with a particular invention (specific invention) in a relation prescribed under any one subparagraph of the Patent Law section 37 (Inventions satisfying such conditions are hereafter referred to as " related inventions").

The term "specified invention" herein stands for an invention described in particular claim, in a patent application containing two or more claims.

A single patent application may contain no more than one specified invention, the reason for which is to preclude infinite expansion of the scope of unity of invention by serially linking the relationship between specified and related inventions.

The Japanese Patent Law as follows;

Section 37

Where there are two or more inventions, they may be the subject of a patent application in the same request provided that these inventions are of an invention claimed in one claim (hereinafter referred to as "the specified invention") and of another or other inventions having the relationship as indicated below with respect to such specified invention:

(i) inventions of which the industrial applicability and the problem to be solved are the same as those of the specified invention;
(ii) inventions of which the industrial applicability and the substantial part of the features stated in the claim are the same as those of the specified invention;
(iii) where the specified invention relates to a product, inventions of process of manufacturing the product, inventions of process of using the product, inventions of process used for handling the product, inventions of machines, instruments, equipments or other things used for manufacturing the product, inventions of products solely utilizing the specific properties of the product, or inventions of things used for handling the product;
(iv) where the specified invention relates to a process, inventions of machines, instruments, equipments or other things used directly in the working of the specified invention;
(v) inventions having a relationship as provided for in the Cabinet Order.

1. Requirements for Unity of Application

(1) Meaning of the term of "unity of application"

"Unity of application" refers to the scope of inventions that could be filed for patent in a single application.

(2) Purport of requirements for unity of application

The provision concerning unity of application (Patent Law section 37) is designed to provide for convenience of applicants, third parties and the Patent Office, by allowing two or more inventions which are technically closely interrelated to be filed for patent in a single application. In other words, the requirements for unity of application prescribe cases where two or more inventions which could also be separately filed for patent, may be filed in a single application.

(3) Principle of requirements for unity of application

Requirements for unity of application are met when the invention defined in each claim of an application is associated with a specified invention in a relation prescribed under any one subparagraph of Patent Law section 37. (inventions satisfying such conditions are hereafter referred to as "related inventions.") The term "specified invention" herein stands for an invention described in a particular claim, in a patent application containing two or more claims. (See "2.3").

A single patent application may contain no more than one specified invention, the reason for which is to preclude infinite expansion of the scope of unity of application by serially linking the relationships between specified and related inventions.

1.1 Relationship under Section 37(i)

Patent Law section 37(i) provides for unity of application between specified invention and related inventions for which the industrial fields of application and the problems to be solved are both the same.

Specified and related inventions falling under this relationship must be expressed in the same category, i.e. "product and product" or "process and process."

(Note) The following examples of cases falling under Patent Law section 37(i) may also fall under section 37(ii).

1.1.1 Same Industrial Field of Application

By "industrial field of application" is meant the technical field to which the invention belongs, and technical fields directly associated with said field. "Same industrial field of application" refers to cases wherein the specified and related inventions share a common "industrial field of application," which may be typified as follows:

(1) When the technical fields of the specified and related inventions are identical

(2) When the technical fields of the specified and related inventions overlap one another

(3) When the technical fields of the specified and related inventions have direct technical interrelationship

In applying Ministerial Ordinance under Section 36(iv), when, as in the invention developed based on a new idea completely different from the prior art, it is considered that the existing technical field to which the invention pertains is not envisaged, the description of the new technical field developed by the invention may be enough and the description of the existing technical field must not be mandatory. Thus, in this case, the new technical field and the technical field bearing a direct relationship to the field thereof shall be deemed as the field of industrial application under Section 37.

(1) When technical fields are identical

When the technical fields for the specified and related inventions are identical, their industrial fields of application are considered to be the same.

(Example 1)

Specified invention:

Automatic transmission using fluid coupling.

Related invention: 1

Automatic transmission using metallic belt.

Both inventions belong to the same technical field of "automatic transmissions."

Hence, their industrial fields of application are the same.

(Note) The examples presented are hypothetical examples designed to facilitate understanding. Assumption is made that the inventions presented in the examples are not identical to one another. The same applies hereafter.

(2) When technical fields overlap

When the technical fields of the specified and related inventions are related to each other as generic and specific concepts, and hence overlap one another, their industrial fields of application are considered to be the same.

(Example 2)

Specified invention:

Magnetic recording medium coated with a double layer of magnetic substances X and Y.

Related invention:

Floppy disc comprising a magnetic disc coated with a double layer of magnetic substances X and Y, and contained in a jacket of certain construction.

The technical fields of both inventions are “magnetic recording medium” and “floppy disk,” respectively, and have the relationship of a generic and a more specific concept, thus the technical fields are overlapping with each other. Therefore, the field of industrial application of both inventions is deemed to be the same.

(3) When technical fields have direct technical relationship

The following examples are the cases where “the technical fields technically have a direct relationship to each other.” In this case, the fields of industrial application of both inventions are the same.

(Example 3)

Specified invention:

Driving means for automatic doors powered by linear motor.

Related invention:

Automatic door of certain construction provided with driving means powered by linear motor.

These inventions each belong to the technical fields of “driving means” and “automatic doom. ” Since it is mentioned in the first claim that the driving means is intended for use in the field of automatic doors, the technical fields of the two inventions have direct technical interrelationship, and hence their industrial fields of application are considered to be the same.

(Note) The technical fields of two inventions may be found to have direct technical interrelationship, by describing the inventions as in the present example, though application to automatic doors of the driving means of the specified invention may not immediately be considered as being appropriate, supposing there had been no mention of application to automatic doors of the driving means of the specified invention.

(Example 4)

Specified invention:

Fiber A (incombustible fiber) composed of certain substances.

Related invention:

Nonflammable curtain made of fiber A composed of certain substances.

The two inventions each belong to the technical fields of “fiber A” and “nonflammable curtains, ” wherein the application of technology related to fiber A to the field of nonflammable curtains is considered quite appropriate. The technical fields for the two inventions therefore have direct technical interrelationship, and their industrial fields of application are considered to be the same.

(Example 5)

Specified invention:

Bolt provided with male thread of certain configuration.

Related invention:
Nut provided with female thread of certain configuration.

The two inventions each belong to the technical fields of "bolts" and "nuts," whereas bolts and nuts are commonly used in combination. The technical fields of the two inventions therefore have direct technical interrelationship, and hence their industrial fields of application are considered to be the same.

1.1.2 Same Problems to be Solved by Inventions

By "problems to be solved by the invention" is meant problems having been unsolved prior to application which the invention is intended to solve. The problem to be solved therefore must be objectively grasped from the description in the entire specification in relation to prior arts.

In application of Ministerial Ordinance under Section 36(4), on the other hand, the "problem to be solved" is deemed to be those by the claimed invention regardless of whether the problem had been unsolved or not by the time of filing the application, and this constitutes a difference between "problem to be solved" under Section 37(i) and that of Ministerial Ordinance mentioned above. Furthermore, in application of above-mentioned Ministerial Ordinance, if it is recognized that the problem to be solved was not envisaged as in case of an invention developed based on a new idea completely different from the prior art or based on the discovery resulted from try and error, the description of the problem to be solved is not mandatory. In this case, however, unless the unsolved technical problem to be solved by the invention as of the filing can be conceived based on the entire description of the specification and drawings taking into consideration the common general knowledge as of the filing, it is deemed that there is no relationship under Section 37(i) due to the lack of a problem to be solved.

"Same problems to be solved by the inventions" refers to problems to be solved that are common to the specified and related inventions. Cases where one or more of the problems to be solved by the inventions are identical, or where they overlap, fall under this condition.

(Example 6)
Specified invention:
Electroconductive ceramic composed of silicone nitride and titanium carbide.
Related invention:
Electroconductive ceramic composed of silicone nitride and titanium nitride.

The common unresolved problem prior to application of the two inventions is to provide electroconductivity to ceramics comprising silicone carbide as the main ingredient, in order to enable electrodischarge machining.

(Example 7)
Specified invention:
Electroconductive ceramic composed of silicone nitride and titanium carbide.
Related invention:

Electroconductive ceramic composed of silicone nitride and titanium nitride with ceramic fibers further added.

The problem to be solved by the specified invention is to enable electrodischarge machining, while the problem to be solved by the related invention is to enable electrodischarge machining while reinforcing the ceramic. The problems that the inventions are to solve therefore overlap, in enabling electrodischarge machining, and are common to both inventions.

1.1.3 Examples

(Example 8)

Specified invention:

Electroconductive ceramic composed of silicone nitride and titanium carbide.

Related invention:

Electroconductive ceramic composed of silicone nitride and titanium nitride.

Both inventions belong to the technical field of electroconductive ceramics, and hence share the same industrial field of application.
The problems to be solved by the inventions are also the same, as explained in 1.1.2 (Example 6). The two inventions therefore satisfy the conditions prescribed under Patent Law section 37(i).

(Example 9)

Specified invention:

Transmitter provided with time axis expander for video signals.

Related invention:

Receiver provided with time axis compressor for video signals received.

Related invention:

Transmission equipments for video signals comprising a transmitter provided with time axis expander for video signals and a receiver provided with time axis compressor for video signals received.

The inventions of this example constitute so-called subcombinations and combination. " Subcombinations" refer to inventions of equipments or subprocesses, which when combined, make up inventions of combined equipments comprising combinations of two or more equipments, or combined processes comprising combinations of two or more subprocesses (hereafter referred to as "combinations").

In this example, the specified invention relates to the technical field of transmitters for video signals, while the related inventions each relate to technical fields of receivers for video signals and transmission equipments for video signals. It is considered that combination of technology in the field of transmitters for video signals with technology in the field of receivers for video signals, or application of said technology to the field of transmission equipments for video signals, is quite appropriate, and that the industrial fields of application for these inventions are therefore the same. Meanwhile, the problem to be solved by these inventions is common, which lies in enabling transmission of video signals through a narrow frequency band. The three inventions therefore satisfy the conditions prescribed under Patent Law

section 37(i). According to the concept described above, the requirement of Patent Law section 37(i) would still be met even in the absence of the combination claim.

1.2 Relationship under Section 37(ii)

Patent Law section 37(ii) provides for unity of application between specified and related inventions for which the industrial fields of application and the substantial parts of the matters defining the inventions are both the same. Specified and related inventions falling under this relationship must be expressed in the same category, i.e. "product and product" or "process and process."

1.2.1 Same Industrial Field of Application

The determination for identity of industrial fields of application is similar to that described in "the relationship under Section 37(i) (refer to 1.1.1)."

1.2.2 Same Substantial Parts of Matters defining Inventions

The substantial parts of the matters defining the inventions in claims refer to new matter corresponding to the problems to be solved by the invention. "Same substantial parts of the matters defining the inventions in the claims" refers to cases wherein the specified inventions and related inventions share common new matter corresponding to the problems they are to solve. The identity of substantial parts here holds not only in cases where the substantial part of the matter defining the specified invention serves as the substantial part of the matters defining the related invention, but also in cases where the related invention has, as its substantial part, the entire part thereof or has, as its entire part, the substantial part thereof.

In applying Ministerial Ordinance under Section 36(iv), as in an invention developed based on a new idea completely different from the prior art or an invention developed from discoveries resulted from the trail and error, where it is recognized that the problem to be solved is not envisaged, description of the problem must not be mandatory. In this case, when the matters defining the inventions in the claims are new, the above-mentioned matters shall be deemed to be the substantial part.

1.2.3 Intermediate and Final Product

In order that an invention related to an intermediate and an invention related to a final product meet the relationship under Section 37(ii), the following requirements (a) and (b) must be satisfied.

(a) An intermediate and a final product have the same substantial structural element. (i) The new fundamental form in chemical structure of the intermediate is common to that of the final product; or

(ii) The chemical structures of both products are technically closely related to each other.

(b) The intermediate and the final product are technically related to each other, in other words, the final product is manufactured directly from the

intermediate, or manufactured through a small number of the other new intermediates including the same substantial structural element.

When either the requirement of (a)(i) or (a)(ii) is met, the requirement of the sameness of the substantial part of the matters defining the inventions in claims under Section 37(ii) is satisfied with. When the requirement of (b) is met, the requirement of the sameness of the field of industrial application is satisfied with.

Even when the structure is unclear, the intermediate and the final product may meet the relationship under Section 37(ii). For example, the intermediate with clear structure and the final product with unclear structure, or the intermediate with unclear structure and the final product with unclear structure may meet the relationship under Section 37(ii). In this case, in order to meet the relationship under Section 37(ii), there must be sufficient evidence showing that the structures of the intermediate and the final product are technically closely related to each other, for example, to such a degree that the intermediate includes the same substantial component as that of the final product, or the intermediate incorporates the substantial component into the final product.

In cases where the individual intermediates used in different processes to manufacture one final product include the same substantial component, the inventions related to the final product and the individual intermediates can be included in one application since both the field of industrial application and the substantial part of the matters defining the inventions in claims are the same.

In cases where the intermediate and the final product are defined in claims so as to comprise a compound group, the respective intermediate compounds must correspond to one of the final products defined in the claims. However, since some of the final products may not have a corresponding intermediate compound, the two groups do not necessarily correspond to each other.

The showing that the intermediate has the other effects or exhibits other activity in addition to being used to manufacture the final product does not affect the judgment on Section 37(ii).

1.2.4 Examples

(Example 1)

Specified invention:

Polymeric compound A (transparent substance with improved oxygen barrier characteristics).

Related invention:

Food packaging container composed of polymeric compound A.

The specified invention relates to the field of transparent substance with oxygen barrier characteristics, while the related invention relates to the field of food packaging containers. Application of technology in the field of transparent substances with oxygen barrier characteristics to the field of food packaging containers is found to be quite appropriate, and hence the industrial

fields of application for these two inventions are the same. Meanwhile, the related invention has, as the substantial pat of its matters defining the invention, polymeric compound A which is also the novel matters of the specified invention, and the substantial pats of the two inventions are therefore the same.

In conclusion the two inventions satisfy the conditions prescribed under Patent Law section 37(ii).

1.3 Relationship under Section 37(iii)

Patent Law section 37(iii) provides for unity of application between the specified invention of a "product" and related inventions of "processes for manufacturing said product, processes for using said product, processes for handling said product, machines, instruments, equipments or other means for producing said product, products solely utilizing specific properties of said product, or products for handling said product."

1.3.1 Processes for Manufacturing the Product, and Machines, Instruments, Equipments or Other Things for Manufacturing the Product

The processes or means pertaining to related inventions are those which, on their own merits, cause the raw material or work to be transformed into a product pertaining to the specified invention.

"Other things" of "machines, instruments, equipments or other things" are not limited to "equipments and the like," and include all of other things that act on other materials etc. such as a catalyst or microorganism to change them into the given product.

Furthermore, unity of application shall be recognized if the "processes for manufacturing..." or " machines, instruments, equipments or other things for manufacturing ... " are suited to producing the product of the specified invention, even if the same processes or means could be used in producing products other than that of specified invention.

(Example 1)

Specified invention:

Substance A.

Related invention:

Catalyst X for producing substance A.

Although catalyst X of the related invention does not fall under "equipments and the like," it does fall under "other thing."

(Example 2)

Specified invention:

Foundation pile provided with a bulbous enlargement at its base.

Related invention:

Process for the formation of bulbous enlargement wherein a cavity is formed in the ground using explosives, into which cavity concrete is poured.

The related invention of a process for forming a bulbous enlargement is suited to producing the foundation pile of the specified invention.

(Example 3)

Specified invention:

Clutch of specific construction

Related invention:

Process of manufacturing friction clutch of specific construction

The process of manufacturing the friction clutch of the related invention is suitable for manufacturing the clutch of the specified invention.

1.3.2 Process of using the Product and Product for Exclusively Using the Specific Characteristic of the Product

"Processes of using the product" refers to processes utilizing the characteristics or functions of the product, while "products for exclusively using the specific characteristic of the product" refers to products for exclusively using the attribute of a certain product. The invention of a process of using a "product" to manufacture "another product," in cases where it is extremely appropriate that the "product" is used for manufacturing "another product" in view of the characteristic and function of the "product", can be included in an invention of a process for using the characteristic and function of the "product".

(Example 4)

Specified Invention:

Substance A.

Related invention:

Process for killing insects using substance A.

(Example 5)

Specified Invention:

Substance A.

Related invention:

Insecticide composed of substance A. Specified invention: Substance A

(Example 6)

Specified invention:

Compound A (useful as the intermediate of compound B)

Related invention:

Process of manufacturing compound B by reacting compound A with another compound Related invention:

Process of manufacturing compound A

The relation between the specified invention and the first related invention is the so called process of manufacturing an intermediate and a final product.

Compound A is mainly used for the material of compound B of the first related invention. Manufacture of compound B by reacting compound A of the specified invention with another compound is extremely appropriate in view of the characteristic and function of compound A. The process of the first related invention is the process of using the characteristic and function of compound A of the specified invention. Thus, both inventions correspond to a product and a process for using the product. The second related invention corresponds to a process of manufacturing compound A of the specified invention. Three inventions in this example meet the requirements for unity of application.

(Example 7)

Specified invention:

A recombinant microorganism including DNA X

Related invention:

DNA X

Related invention:

Process of manufacturing polypeptide A by culturing recombinant microorganism including DNA X

The first related invention bears the relationship under Section 37(i) and (ii) with respect to the specified invention. Use of the recombinant micro-organism of the specified invention for manufacturing polypeptide A is extremely appropriate in view of polypeptide A producing function of the recombinant microorganism. The second related invention is a process of using the characteristic and function of the recombinant microorganism of the specified invention. Thus, both inventions correspond to a product and process of using the product. Three inventions, of this example, meet the requirements for unity of application.

(Example 8)

Specified invention:

Fuel burner A provided with a fuel inlet in the direction tangent to a mixing chamber Related invention:

Process of manufacturing carbon black including a step for allowing a fuel to flow in the direction tangent to a mixing chamber of fuel burner A

Related invention:

Process of manufacturing fuel burner A including a step for forming a fuel inlet in the direction tangent to a mixing chamber

The fuel burner A of the specified invention is suitable for efficiently manufacturing carbon black. It is extremely appropriate that the fuel burner A is used for manufacturing carbon black. The process of the first related invention is a process of using the function of the fuel burner A of the specified invention. Thus, both inventions correspond to a product and process of using the product. The second related invention corresponds to a process of manufacturing the fuel burner A of the specified invention. Three inventions in this example meet the requirements for unity of application.

1.3.3 Handling Process for the Product, and Product for Handling the Product

"Handling a product" refers to the maintenance and/or extraction of the function of the product, by externally acting on the product, in principle without causing change to the essence of the product. Transportation and storage of the product, for example, fall under this category.

Unity of application shall be recognized if the "handling process for the product" or "product for handling the product" of the related invention is suited to handling the product of the specified invention, even if the same process or product could also be applied to handling products other than the product of specified invention.

(Example 9)

Specified invention:

Prefabricated house of certain construction.

Related invention:

Process for storing and transporting prefabricated houses of certain construction.

The storage and transportation process of the related invention maintains and extracts the function of the prefabricated house of the specified invention. The two inventions therefore relate to a product and a process for handling said product.

(Example 10)

Specified Invention:

Unstable chemical compound A.

Related invention:

Storage means for unstable chemical compound A.

The storage means of the related invention is for the maintenance of the functions of substance A of the specified invention. The two inventions therefore relate to a product and a product for handling the same.

1.4 Relationship under Section 37(iv)

Patent Law section 37(iv) provides for unity of application between a specified invention pertaining to a "process" and related inventions pertaining to "machines, instruments, equipments or other things" directly used in working of the invention of the process."

1.4.1 Machines, Instruments, Equipments or Other Things Directly Used in the Working of Invention of Process

It is sufficient for the means of related inventions to be used directly in carrying out the process of the specified invention. In addition to machines, instruments and equipments, other things including catalysts, microorganisms, materials and matters to be processed are allowed to become related inventions. (See 1.3.1)

Unity of application shall be recognized even if the product of the related inventions could also be applied to carrying out processes other than the process of the specified invention, if they are suited to carrying out the process of the specified invention.

(Example 1)

Specified invention:

Process for producing antibiotic A by cultivating microorganism X.

Related invention:

Microorganism X.

Although microorganism X of the related invention does not fall under "equipments and the like" for carrying out the process of the specified invention, it does fall under "other things."

(Example 2)

Specified invention: Process for producing concrete products wherein ice granules are mixed into the cement together with aggregate, and then poured into molds.

Related invention:

Equipments of certain construction provided with an ice crushing unit and a mixing unit for mixing the crushed ice with cement and aggregate.

The equipments of the related invention comprising an ice crushing unit and a mixing unit is suited to carrying out the process of the specified invention for producing concrete products.

(Example 3)

Specified invention:

Method for measuring water depth comprising certain procedures.

Related Invention:

Distance measuring equipment of certain construction.

The equipment of the related invention is suited to measuring water depth, though it could be applied to making other forms of measurements also.

(Example 4)

Specified invention:

Process of preparing final product Z by oxidizing intermediate A

Related invention:

Process of preparing final product Z by reacting compound X and compound Y to prepare intermediate A and oxidizing the intermediate A

Related invention:

Intermediate A

The first related invention bears the relationships under Section 37(i) and (ii) with respect to the specified invention. The intermediate of the second related invention does not correspond to "apparatuses" directly used in

working of the preparing method of the specified invention, but corresponds to "other things." Three inventions of this example meet the requirements for unity of application.

1.5 Relationship under Section 37(v)

Section 37(v) of Patent Law is a provision left to Cabinet Order. Specifically, it recognizes unity of application for related inventions satisfying the provisions of Patent Law section 37(iii) or (iv) in relation to other related inventions, claimed in the Scope of Claims, which in turn satisfy the provisions of Patent Law section 37(i) or (ii) in relation to a specified invention. (Section 2 of Enforcement Orders for Patent Law)

In the above-mentioned case, if neither invention having one of the relationships under Section 37(i) or (ii) with respect to the specified invention is not stated in claims, the application does not comply with the requirement under Section 37.

(Example 1)

In relation to the specified invention of final product A, the invention of intermediate B falls under Patent Law section 37(ii), whereas the invention of process for producing intermediate B falls under Patent Law section 37(iii) in relation to the invention of intermediate B. The process for producing intermediate B therefore satisfies the provision of Patent Law section 37(v).

1.5.1 Product, Improved Product, and Process of Manufacturing the Improved Product

When the invention of improvement satisfies the provision of Patent Law section 37(i) or (ii) in relation to the specified invention of product, unity of application shall be recognized also for the invention of process for manufacturing said improved product, since the improved product and the process for manufacturing said improved product satisfy the provision of Patent Law 37(iii) (product and process for producing said product).

(Example 2)

Specified invention:

Spectacle frame made of titanium alloy.

Related invention:

Spectacle frame made of nitride coated titanium alloy.

Related invention:

Process for producing spectacle frames wherein titanium alloy is formed in one piece. Related invention:

Process for producing spectacle frames wherein titanium alloy is formed in one piece, and then deposited with nitride by vacuum evaporation.

In relation to the specified invention, the first and second related inventions satisfy the provisions of Patent Law section 37(ii) and (iii) respectively. The third related invention relates to a process for manufacturing the

product of the first related invention, and hence satisfies the provision of Patent Law section 37(v) in relation to the specified invention.

2. Examination on Requirements for Unity of Application

2.1 Basic Attitude

Failure to meet the requirements for unity of application (Patent Law section 37) constitutes a reason for refusal (Patent Law section 49), but does not constitute reason for opposition (Patent Law section 55) or reason for invalidation (Patent Law section 123). This is because Patent Law section 37 is a provision established for the convenience of applicants, third parties and the Patent Office, and unlike other reasons for refusal, does not directly inflict serious damage to third parties if overlooked, as it concerns minor procedural deficiency in that the application should have been divided into two or more, rather than substantive faults in the invention.

Accordingly, considering the purport of Patent Law section 37, it would be improper to make unnecessarily strict examination on the requirements for unity of application.

2.2 Notice of Reason for Refusal

Reasons for refusal concerning unity of application would occur when two or more separate inventions do not fall under the provisions of any subparagraph under Patent Law section 37. The reasons by which the inventions do not meet the requirements shall be indicated as concretely as possible.

In such instances, suggestions should be made on the division of application if it is expected to facilitate response by the applicant, and thereby contribute to expediting accurate examination. It should be noted however, that such suggestions are not legally binding.

When a divisional application is made on claims violating requirements for unity of application as a result of notice of reasons for refusal concerning unity of application, disallowing the divisional application on grounds of identity of inventions between the original and divisional applications (against section 39) would be contrary to the purport of Patent Law section 37. Therefore, notice of reasons for refusal that may lead to such results shall not be made.

2.3 Identification of the Specified Invention

The claim corresponding to the specified invention shall be chosen to maximize the benefit to applicants, or in other words so as to recognize unity of application as broadly as possible.

When there are two or more claims in the Scope of Claims, the invention described in one of the claims would be provisionally selected as the specified invention, in relation to which examination on the requirements for unity of application is to be made. If there is found as a result of the examination any

claim which does not meet the requirements of the subparagraphs under Patent Law section 37, one of the other claims shall be selected one by one as the new provisional specified invention in relation to which examination on the requirements of unity of application is to be made.

For example, it is considered more efficient to perform examination on requirements under Patent Law section 37 by first selecting the invention described in a "product" claim as the specified invention if there is one among two or more claims, and by first selecting the invention described in a "process" claim as the specified invention if there is no "product" claim.

Normally, for inventions satisfying the requirements prescribed in Patent Law section 37 (i) or (ii), no difference should occur in the outcome of examination on requirements under Patent Law 37 whichever claim is selected as the specified invention.

2.4 Examination on Related Inventions

When the requirements for unity of application are met among inventions described in independent form, lack of unity for inventions described in dependent form is expected to be rare. Therefore, it would normally suffice to examine the relationships between specified and related inventions only for claims written in independent form.

However, attention may be necessary in cases such as claims referring to other claims expressed in different categories, as these may affect the outcome of examination on the requirements for unity of application.

2.5 Relationship between the Provisions of Section 37 and Section 36(5), and Manner of Examination

Patent Law section 37 provides that two or more separate inventions in particular relationships may be filed in a single application, whereas Patent Law section 36(5) provides that identical inventions may be described in separate claims. This implies that a claimed invention would be in violation of the requirements of Patent Law section 37 only if it is neither identical to the specified invention or another related invention, nor in compliance with the provisions of any subparagraph under Patent Law section 37. Therefore, in examination practice related to unity of application, examination as to whether each claim satisfies the requirements under Patent Law section 37 shall be made by first assuming that every claimed invention is different from one another, and then determining whether the claimed inventions that do not meet the requirements are identical to other claimed inventions.

If, as a result of such examination, a claimed invention is found to be identical to another claimed invention, its description in a single claim would be allowed under the provisions of Patent Law section 36(5). Notice of reasons for refusal on grounds of violation of the provisions under Patent Law section 37 would therefore be made only for those which are found to be different from any other claimed invention.

3. PCT Rule

4. US practice

5. SPLT

6. Summary

End of document