



# IMPLEMENTATION OF ADOPTED COMMON PRACTICES

Paweł Biały  
Head of Mechanical Division  
Patent Office of the Republic of Poland

# Claim drafting and structure

## The practice at the PPO

Common practice regarding „Claim drafting and structure” is almost in line with Polish law and practice at the PPO.

There are differences between:

- a definition of dependent claim,
- charging fees for claims,
- providing a list or overview of units.

Most of aspects of the common practice are reflected in Polish law:

- Act of 30 June 2000 Industrial Property Law (further „IPL”),
- Regulation of the Prime Minister of 17 September 2001 on filing and processing of patent and utility model applications (further „Regulation”),
- Regulation of the Council of Ministries of 2 March 2004 amending the Regulation on fees relating to the protection of inventions... (further „Regulation on fees”).



## Clarity, conciseness and support for claims in the description.

Common practice	PPO practice
The claims are clear and concise and are fully supported by the description.	The same. See art. 33 (3 <sup>1</sup> ) IPL
The definition of the matter for which protection is sought is in terms of the technical features of the invention.	The same. See art. 33 (3) IPL

## Form and content of claims

Common practice	PPO practice
<p>Whenever appropriate, claims contain:</p> <ul style="list-style-type: none"><li>(i) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art,</li><li>(ii) a characterising portion, preceded by the words "characterised in that", "characterised by", "wherein the improvement comprises," or any other words to the same effect, stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.</li></ul>	<p>The same. See §8(1) Regulation</p>
<p>The claims are typed or printed, without prejudice to more liberal requirements for the purpose of obtaining a filing date.</p>	<p>The same. See Annex 1 section 15 of Regulation. Note: hand-written claims – if legible – are accepted for granting filing date and for preparing search report and written opinion.</p>

## Limit on the number of independent claims per category.

Common practice	PPO practice
<p>Without prejudice to the requirement of unity of invention, a patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:</p> <ul style="list-style-type: none"> <li>(a) a plurality of interrelated products,</li> <li>(b) different uses of a product or apparatus,</li> <li>(c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.</li> </ul>	<ul style="list-style-type: none"> <li>(a) – The same, in practice, see Inventor's guide 2023, chapter 10.1</li> <li>(b) The same, in practice, see Inventor's guide 2023, chapter 4.1.7</li> <li>(c) The same, see §15(2) Regulation</li> </ul> <div data-bbox="1488 865 1777 1267" data-label="Image"> <p>The image shows the cover of a publication titled 'Poradnik wynalazcy' (Inventor's Guide). The cover is white with a red header and footer. The title is in white text on a red background. Below the title, there are icons of a flask and a smartphone. The footer contains the text 'PROCEDURY ZGŁOSZENIOWE W SYSTEMIE krajowym • europejskim • międzynarodowym'.</p> </div>

## Requirements for dependent claims

Common practice	PPO practice
<p>Any claim which includes all the features of one or more other claims ("dependent claim") does so by a reference, if possible at the beginning, to the other claim or claims and then states the additional features claimed.</p>	<p>Different. See art. 33(4) IPL, §8(3) &amp; §8(5) Regulation. Dependent claims are „to present various elaborations of the invention or to specify the features indicated the independent claim or of another dependent claim” [art. 33(4)] instead of giving [any] „additional features”.</p>
<p>All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, are grouped together to the extent and in the most practical way possible.</p>	<p>The same, in practice. Partly art. 33(4<sup>1</sup>) IPL &amp; §8(4) Regulation. General rule of consistency also applies.</p>

## Number of claims.

<b>Common practice</b>	<b>PPO practice</b>
The number of the claims is reasonable in consideration of the nature of the invention claimed.	The same. Partly §7(3) Regulation. General rule of consistency applies.
The applicant is to pay a fee if they exceed a certain number of claims, which is to be determined by the national Offices in accordance with the applicable national law.	Different, see Regulation on fees. Applicant is to pay a fee if they exceed a certain number of [unitary] inventions (usually independent claims)

## Applications containing drawings: reference signs linking the claims to the drawings ("reference signs"). Tables

Common practice	PPO practice
<p>Where the patent application contains drawings, the technical features mentioned in the claims are preferably followed by the reference signs relating to those features. When used, the reference signs must preferably be placed between parentheses. If including reference signs does not particularly facilitate quicker understanding of a claim, they should not be included. These reference signs are not to be construed as limiting the claim.</p>	<p>The same. See §8(8) Regulation</p>
<p>Any claim may contain tables only if the subject-matter of the claim makes the use of tables desirable.</p>	<p>The same. See Annex 1 section 21 of Regulation.</p>



## Values and units

Common practice	PPO practice
<p>Values are expressed in units conforming to international standards, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement must also be expressed in units conforming to international standards. Only the technical terms, formulae, signs and symbols generally accepted in the field in question must be used.</p>	<p>The same. See §12 Regulation: „The terminology and the signs shall be (...) in accordance with the existing legal provisions and common practice.”</p>
<p>Offices are to provide a list or overview of units recognised in international standards and complying with national requirements.</p>	<p>Different. PPO do not provide the list. BUT: The §12 Regulation sends to existing legal provisions. In PL legal units are covered by: Regulation on legal units of measurement (Dz.U. 2020 poz. 1024)</p>



PATENT OFFICE  
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OF POLAND

## Implementation and impact

Translation in Polish of common practices regarding claims is published on the PPO website:

<https://uprp.gov.pl/pl/konwergencja/patenty/program-konwergencji-praktyk-procedur-patentowych-realizowany-w-ramach-planu-strategicznego-europejskiej-organizacji-patentowej-sp2023>

PPO's alignment with the common practise is only partial.

Achieving full compliance would entail the need for amendments to Polish legislation. The modification of Polish patent law necessitates a parliamentary (governmental) process.



# Examination practice for CII and AI

## The practice at the PPO

Common practice regarding „Examination practice for computer implemented inventions and artificial intelligence ” is in line with Polish law and practice at the PPO.

In Polish law general rules relating sufficiency of disclosure and claims drafting apply as well to CII and AI inventions.

Some aspects of the common practice are reflected in the General Guidelines of the President of the Polish Patent Office (further President’s Guidelines), which are binding for examiners.



## CIIs, AI and computer programs

Common practice	PPO practice
A computer program is a set of instructions executed by programmable hardware	The same. General rules for sufficiency of disclosure apply. When the term is not defined in law or guidelines, its meaning should be established from the point of view of person skilled in the art.
A CII is an invention involving at least one feature that is implemented by a computer program	The definition of CII is also given in President's Guidelines: „A "computer-implemented invention" refers to computers, computer networks, or other programmable devices in which at least one feature is implemented by a computer program.”
AI is intelligence demonstrated by a machine, in particular producing behaviours perceived as intelligent by humans.	

## Exclusions from patentability

Common practice	PPO practice
Patent protection is available in all fields of technology, including newly emerging technologies which involve AI.	The same – see Art. 24 & 28 IPL and President's Guidelines.
Subject-matter lacking technical character is excluded from patentability.	In particular: „Patents shall be granted – regardless of the field of technology” (art. 24 IPL)
Mathematical methods, when claimed as such, lack technical character.	„shall not be regarded as inventions, provided that the application refers to the object or activity as such” (art. 28 IPL)
AI is not excluded from patentability if it provides a technical contribution.	„A computer program that, when run on a computer, produces a "further technical effect" is of a technical nature (...)"
Computer programs are not excluded from patentability if they produce a technical effect going beyond the mere implementation of instructions on a computer	(President's Guidelines)

## Contribution to technical character and/or inventive step

Common practice	PPO practice
Mixed-type inventions comprise both technical and non-technical features, the latter being features which, when taken in isolation, are excluded from patentability.	The same – see President’s Guidelines
Offices acknowledge that, in the context of an invention as a whole, such non-technical features, e.g. mathematical steps related to AI, can contribute to the technical character of the invention and thus support patentability.	The same – see President’s Guidelines: „when assessing the contribution of a mathematical method to the technical nature of the invention, it must be taken into account whether this method, in the context of the invention, produces a technical effect serving a technical purpose.”
The contribution to technical character made by mathematical methods employed by AI-related inventions is currently assessed by offices in the same way as the contribution of mathematical methods to CIs.	The same – see President’s Guidelines
In the assessment of obviousness, offices may assume that the common general knowledge of the skilled person comprises commonly known AI tools.	The same – general rules for inventive step assessment apply.

# Sufficiency of disclosure

Common practice	PPO practice
<p>Offices apply the general sufficiency of disclosure requirements to all inventions, including CII and AI-related inventions.</p>	<p>The same – see art. 49(1.2) IPL and art. 33(1) IPL. General rules for sufficiency of disclosure apply.</p>
<p>When AI relies on mathematical methods, the mathematical methods must be disclosed in sufficient detail so that the invention can be reproduced by the person skilled in the art.</p>	
<p>Where training datasets are used in machine learning algorithms and contribute to bringing about a technical effect, the characteristics of the training datasets required for reproducing this technical effect may need to be disclosed (or be common general knowledge). There is, however, generally no need to disclose specific training datasets, e.g. the ones employed by the inventors.</p>	

# Clarity of claims

Common practice	PPO practice
There is no need for mandatory formulations for "computer program" claims.	The same, there are no provisions in PL law for such formulations
If general-purpose computer hardware alone is not enough to execute all the method steps referred to by a claim to a computer program, and the claim fails to recite additional technical means necessary for performing the steps, offices may consider that the claim lacks clarity or support by the description.	The same, see art. 33(3 <sup>1</sup> ), 33(4) and 49(1.3) IPL. General rules for claims drafting apply.
The meaning and the technical character of AI-specific terms is assessed by offices in the context of the subject-matter defined in a claim as a whole.	The same, general rules for clarity apply.



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The common practice regarding CII and AI is in line with Polish patent law and practice at the PPO.





Thank you

Paweł Biały  
[Pawel.Bialy@uprp.gov.pl](mailto:Pawel.Bialy@uprp.gov.pl)