



PATENT OFFICE OF THE
REPUBLIC OF POLAND

Implementation of adopted common practices: designation of inventor and examination of unity of invention

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PATENT OFFICE OF THE
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Workshop programme

Moderator: Paweł Biały, PPO

10.00 Welcome address and presentation of the workshop goals

*Patrycja Czubkowska, PPO and
Michael Fröhlich, EPO*

10.15 Background to the convergence of practice programme

Michael Fröhlich, EPO

10.30 Examination of unity of invention – proceedings of the working group and common practice adopted

Stefan Luginbühl, Katja Eberle, EPO

10.45 Impact and implementation by the PPO

Paweł Biały, PPO

11.00 Questions and answers

Paweł Biały, PPO

11.15 Designation of inventor – proceedings of the working group and common practice adopted

Philipp Römer, EPO

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12.00 Wrap-up

Paweł Biały, PPO

12.10 End of the workshop



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Examination of unity of invention in the PPO

- Common practice regarding „Examination of unity of invention ” is in line with Polish law and long-term practice of the PPO.
- Legal basis:
 - Act of 30 June 2000 Industrial Property Law (PWP): Art. 34, 39, 39¹, 42(2), 47(3)
 - Regulation of the Prime Minister of 17 September 2001 on filing and processing of patent and utility model applications” §15, 26, 29(3a), 30
- Polish law is harmonized with PCT standard (Rule 13(1) and (2) PCT)
- Polish examiners follow “*Inventor's guide*”¹ (not legally binding), EPO and WIPO/PCT practices



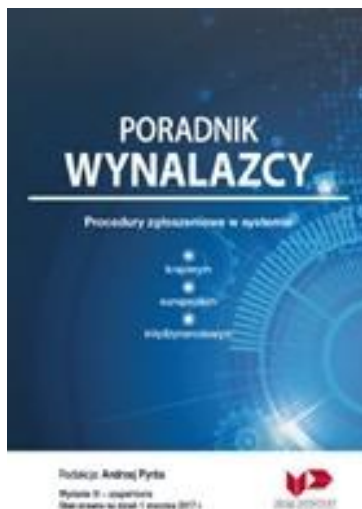
¹ A. Pyrża et al. “Poradnik wynalazcy” [Inventor's guide], 3rd edition, PPO, Warsaw 2017, pages 63, 155-157



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Examination of unity of invention in the PPO

- Information to be provided when raising a non-unity objection by PPO [see Act of 14 June 1960 The Code of Administrative Procedure (KPA), especially §124]
- Introduction to the objection
 - Statement of the legal basis for the objection, invoking a specific legal provision (**see KPA**)
 - Identification of the different groups of inventions, including, where possible, the numbering of the groups and an indication of the claims belonging to each of these groups (**see PWP art. 42(2) and PPO order template**)

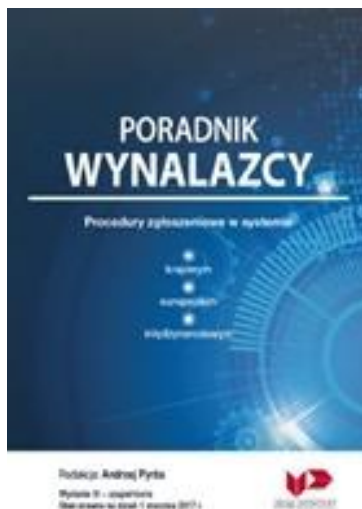




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Examination of unity of invention in the PPO

- Grounds for the objection (**see Inventor's guide**)
 - Identification of the common matter between the different groups of inventions or, if appropriate, a statement on the lack thereof
 - If common matter has been identified, a comparison with the prior art which explains why the features identified as part of the common matter do not constitute a contribution over the prior art.; if prior art is relied upon, identifies that prior art
 - Analysis of the remaining technical features which are not part of the identified common matter. Explanation of why there is no unifying technical relationship among the groups of inventions, if applicable by identifying the differences between the remaining technical features considering the technical effects achieved or the technical problems solved by these remaining features
- Conclusion
 - The concluding statement explaining that lack of unity has been found may be supplemented, where appropriate, with information on any procedural consequences of this result at the procedural stage in question (**see KPA and PPO order template**)





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Examination of unity of invention PPO order template

POSTANOWIENIE

Na podstawie art. 42 ust. 2, art. 34 w związku z art. 39 ustawy z dnia 30 czerwca 2000r. Prawo własności przemysłowej (t.j. Dz.U. z 2021 r. poz. 324) w związku z dokonaniem w dniu _____ zgłoszenia wynalazku oznaczonego nr P _____ Urząd Patentowy RP

wzywa zgłaszającego. do:

1. Dokonania oddzielnego zgłoszenia wynalazku - oddzielnych zgłoszeń wynalazków* dotyczącego - dotyczących*:

2. Uiszczenia opłaty jednorazowej za zgłoszenie - zgłoszenia* wymienione w punkcie 1 postanowienia.

w terminiemiesiący od dnia doręczenia postanowienia.

Uzasadnienie

Jeżeli zgłoszenie - zgłoszenia* wydzielone nie wpłyną w wyznaczonym terminie Urząd Patentowy RP uzna, że zgłoszenie pierwotne dotyczy wynalazku określonego na pierwszym miejscu w zastrzeżeniach patentowych oraz innych wynalazków spełniających wymóg jednolitości, a pozostałe wynalazki - za wycofane przez zgłaszającego.

Na niniejsze postanowienie stronie przysługuje wniosek o ponowne rozpatrzenie sprawy przez Urząd Patentowy RP w terminie jednego miesiąca od dnia jego doręczenia. Jeżeli strona nie chce skorzystać z prawa do wniesienia wniosku o ponowne rozpatrzenie sprawy, może wnieść za pośrednictwem Urzędu skargę do Wojewódzkiego Sądu Administracyjnego w Warszawie w terminie 30 dni od dnia doręczenia stronie postanowienia. Strona może ubiegać się na podstawie przepisów ustawy Prawo o postępowaniu przed sądami administracyjnymi o zwolnienie od kosztów sądowych albo o przyznanie prawa pomocy.

- Legal basis
- Groups of inventions
- Place for grounds
- Procedural consequences



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Examination of unity of invention Comments

- Lack of unity can be raised during two phases of the procedure: search (in written opinion) and substantive examination (in order).
- In practice PPO understands „corresponding features” as features which achieve the same technical effect or solve the same technical problem (like in EPO).
- In PPO „Prior art at hand” is the entire state of the art.
- It is possible for a lack of unity of invention to exist within a single claim, if there are alternatives in the independent claim.
- Assessment of unity in case of a combination of claims of different categories is covered by Regulation §15.
- In practice unity in case of 1) intermediate and final products and 2) Markush groupings is determined in the view of Annex B to the PCT Administrative Instructions (see Inventor’s guide).



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Examination of unity of invention Comments

- In the case where the patent application does not comply with the requirement of unity of the invention, PPO carries out a prior art search and further examination of the invention, which is in the first place in claims and of the other inventions, which fulfil the requirement of unity.
- In (unwritten) practice examiners in PPO may not pursue unity objections if no additional search is needed or examiner is able to examine other inventions without undue burden.
- During substantive examination PPO issues an order calling on the applicant to file divisional applications. The order has to fulfill the requirements of §124 KPA. PPO has the special template of this order.
- At every stage of the procedure the applicant can file divisional applications herself/himself.



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Examination of unity of invention Comments

- In the answer to the order the applicant can: submit a request for re-examination of the matter (by another patent examiner) or lodge a complaint with an administrative court.
- In order to carry out the prior art search for non-unitary subject matter the applicant must file a divisional application(s). There is no possibility to pay additional fee for extended search in parent application.
- In the PPO, the order calling to file divisional applications is sent in less than 1% of patent applications.



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Examination of unity of invention Implementation and impact

- Translation in Polish of common practices 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>
- Translation of common practice regarding „Examination of unity of invention” is planned to be introduced into the next edition of „Inventor’s guide” and „PPO president’s guidelines” (PPO official guidelines).



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Examination of unity of invention

- Questions and answers





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- Legal basis:
 - Act of 30 June 2000 Industrial Property Law (PWP): Art. 8 (1.iii), 11, 20, 32
 - Regulation of the Prime Minister of 17 September 2001 on filing and processing of patent and utility model applications: §5(1); 23(1), 39
 - Regulation of the Prime Minister of 12 January 2017 on registers kept by the Patent Office of the Republic of Poland: §8





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Designation of inventor in the PPO

- In PPO:
- inventors are not formally notified by patent offices about their designation in a patent application; inventors can instead obtain information about their designation from the applicant, through inspection of the patent register or Bulletins (BUP, WUP) or via e-Search database;
- family name, given name(s), country and place of residence are entered in the patent register, Bulletins and e-Search database. Additional information about inventors' full addresses is not published in the patent register.
- Inventors have the right to waive their right to be mentioned.



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Designation of inventor in the PPO

Example: PL238015B1

Patent register

C		Nazwisko i imię twórcy wynalazku oraz jego miejsce zamieszkania (miejscowość, kraj)
	1	LUBERA STANISŁAW, Kolbuszowa, Polska

Bulletins BUP, WUP

A1 (21) **425927** (22) 2018 06 14

(51) *F24H 1/26* (2006.01)

F24H 1/36 (2006.01)

F23B 80/04 (2006.01)

(71) Z.P.U.H. DREW-MET SPÓŁKA CYWILNA LUBERA MARIA
& LUBERA STANISŁAW, Kolbuszowa

(72) LUBERA STANISŁAW

(54) Kocioł centralnego ogrzewania

(B1) (11) **238015** (41) 2019 12 16

(51) *F24H 1/26* (2006.01)

F24H 1/36 (2006.01)

F23B 80/04 (2006.01)

(21) **425927** (22) 2018 06 14

(72) LUBERA STANISŁAW, Kolbuszowa (PL)

(73) DREWMET STANISŁAW LUBERA SPÓŁKA KOMANDYTOWA,
Kolbuszowa (PL)

(54) Kocioł centralnego ogrzewania

e-Search database

Numer zgłoszenia	P.425927	Numer prawa wyłącznego	Pat.238015
Nazwa/Tytuł	Kocioł centralnego ogrzewania	Status	Prawo w mocy
Data zgłoszenia	2018-06-14	Zgłaszający/Uprawniony	DREWMET STANISŁAW LUBERA SPÓŁKA KOMANDYTOWA, Kolbuszowa, PL
Klasyfikacja MKP	F24H 1/26 F24H 1/36 F23B 80/04	Twórca/Twórcy	STANISŁAW LUBERA, Kolbuszowa, PL



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Designation of inventor Comments

- The inventor should be designated in the request. If the inventor is not designated in the request, PPO calls the applicant to furnish the data about the inventor. The same procedure applies to her/his address and the grounds on which the applicant's right to a patent is based.
- PPO considers inventor as a third party of the patent procedure. Third party does not have to be informed about GDPR. Therefore PPO does not inform the inventor about designation.
- Full address (including street, house and flat number and zip code) is not published in any way by PPO.
- Full address is also not accessible for third parties by file inspection (file inspection is limited only to description, claims, drawings and abstract)



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Designation of inventor Comments

- PWP art. 8 says that the inventor has a right to be mentioned (it is not an obligation). If the inventor has the right to be mentioned, the inventor also has possibility to waive her/his right. This declaration should be filed in a form of a written request signed by the inventor. The declaration has to be filed before publication of the application.
- There is no possibility to request non-publication of specific information only, e.g. city and country of residence.



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Designation of inventor Implementation and impact

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Designation of inventor

- Questions and answers





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Thank you

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