technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

1. A product and a process specially adapted for the manufacture of said product; or
2. A product and a process of use of said product; or
3. A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
4. A process and an apparatus or means specifically designed for carrying out the said process; or
5. A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims.

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

[58 FR 4345, Jan. 14, 1993]

§ 1.476 Determination of unity of invention before the International Searching Authority.

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in §1.475.

(b) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it shall inform the applicant accordingly and invite the payment of additional fees (note §1.445 and PCT Art. 17(3)(a) and PCT Rule 40). The applicant will be given a time period in accordance with PCT Rule 40.3 to pay the additional fees due.

(c) In the case of non-compliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned ("main invention") in the claims.

(d) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Searching Authority may raise the objection of lack of unity of invention.


§ 1.477 Protest to lack of unity of invention before the International Searching Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director’s designee. In the event that the applicant’s protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international
search report when forwarded to the
Designated Offices, may notify the
International Searching Authority to
that effect any time prior to the
issuance of the international search
report. Thereafter, such notification
should be directed to the International
Bureau (PCT Rule 40.2(c)).

[43 FR 20466, May 11, 1978. Redesignated and
amended at 52 FR 20046, May 28, 1987]

INTERNATIONAL PRELIMINARY
EXAMINATION

§ 1.480 Demand for international pre-
liminary examination.

(a) On the filing of a proper Demand
in an application for which the United
States International Preliminary Ex-
amining Authority is competent and
for which the fees have been paid, the
international application shall be the
subject of an international preliminary
examination. The preliminary examina-
tion fee (§ 1.482(a)(1)) and the han-
dling fee (§ 1.482(b)) shall be due within
the applicable time limit set forth in
PCT Rule 57.3.

(b) The Demand shall be made on a
standardized form (PCT Rule 53). Cop-
ies of the printed Demand forms are
available from the United States Pat-
ent and Trademark Office. Letters re-
questing printed Demand forms should
be marked ‘‘Mail Stop PCT.’’

(c) Withdrawal of a proper Demand
prior to the start of the international
preliminary examination will entitle
applicant to a refund of the prelimi-
nary examination fee minus the
amount of the transmittal fee set forth
in § 1.445(a)(1).

(d) The filing of a Demand shall con-
stitute the election of all Contracting
States which are designated and are
bound by Chapter II of the Treaty on
the international filing date (PCT Rule
53.7).

(e) Any Demand filed after the expi-
ration of the applicable time limit set
forth in PCT Rule 54bis.1(a) shall be
considered as if it had not been sub-
mitted (PCT Rule 54bis.1(b)).

[52 FR 20048, May 28, 1987, as amended at 53
FR 47810, Nov. 28, 1988; 58 FR 4346, Jan. 14,
1993; 63 FR 29619, June 1, 1998; 67 FR 523, Jan.
4, 2002; 68 FR 14337, Mar. 25, 2003; 68 FR 59888,
Oct. 20, 2003]

§ 1.481 Payment of international pre-
liminary examination fees.

(a) The handling and preliminary ex-
amination fees shall be paid within the
time period set in PCT Rule 57.3. The
handling fee or preliminary examination
fee payable is the handling fee or
preliminary examination fee in effect
on the date of payment.

(1) If the handling and preliminary
examination fees are not paid within
the time period set in PCT Rule 57.3,
applicant will be notified and given one
month within which to pay the defi-
cient fees plus a late payment fee equal
to the greater of:

(i) Fifty percent of the amount of the
deficient fees, but not exceeding an
amount equal to double the handling
fee;
or

(ii) An amount equal to the handling
fee (PCT Rule 58bis.2).

(2) The one-month time limit set in
this paragraph to pay deficient fees
may not be extended.

(b) If the payment needed to cover
the handling and preliminary examina-
tion fees, pursuant to paragraph (a) of
this section, is not timely made in ac-
cordance with PCT Rule 58bis.1(d), the
United States International Prelimi-
nary Examination Authority will de-
clare the Demand to be considered as if
it had not been submitted.

[63 FR 29619, June 1, 1998, as amended at 68
FR 59888, Oct. 20, 2003]

§ 1.482 International preliminary ex-
amination fees.

(a) The following fees and charges for
international preliminary examination
are established by the Director under
the authority of 35 U.S.C. 376:

(1) The following preliminary examina-
tion fee is due on filing the Demand:

(i) If an international search fee as
set forth in § 1.445(a)(2) has been paid on
the international application to the
United States Patent and Trademark
Office as an International Searching
Authority:

(A) By a micro entity

§ 1.480

§ 1.481

$1.29 ........................................ $150.00