

OJ 1991, 438). If the objection of lack of unity is raised a priori, the technical problem must be defined solely on the basis of the description and not of the prior art (see W 50/91, W 52/91, W 22/92, W 52/92 and T 188/04).

The powers of the EPO as ISA with regard to the assessment of unity **a posteriori**, i.e. after taking into account the prior art brought to light by the search, were clarified by the Enlarged Board of Appeal in G 1/89 (OJ 1991, 155 – referral by a board of appeal in W 12/89, OJ 1990, 152) and G 2/89 (OJ 1991, 166 – referral by the President of the EPO). The referring board asked the Enlarged Board inter alia if an ISA has the power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering under Art. 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in R. 13.1 PCT. The President of the EPO requested the Enlarged Board's opinion on whether the EPO as ISA may request a further search fee where the international application is considered to lack unity of invention a posteriori. The referred points of law were dealt with in consolidated proceedings.

The Enlarged Board noted that the procedural separation of search and (substantive) examination under the PCT, as well as under the EPC 1973, led to a certain overlapping because of the functional relationship between search and examination. Thus, although the objective of the search was in principle limited to discovering and reporting on relevant prior art for the purpose of assessing novelty and inventive step, which was ultimately the task of the examining authority (i.e. the IPEA and/or the designated Office under the PCT and the examining division under the EPC 1973), in many instances the search examiner needed to form a provisional opinion on these issues in order to carry out an effective search (for more on this aspect see also the summary in this chapter II.B.4.2.).

The Enlarged Board further noted that neither in the PCT nor in the Rules under the PCT were there provisions indicating how to decide whether an international application complies with the requirement of unity of invention. However, the PCT Search Guidelines stated that lack of unity may be directly evident "a priori", or only become apparent "a posteriori" (see now para. 10.03 PCT International Search and Preliminary Examination Guidelines as in force from 1.3.2022). They contained a direct reference to the consideration of unity by the ISA on an a posteriori basis, i.e. after an assessment of the claims with regard to novelty and inventive step in relation to the prior art. The corresponding EPO Guidelines showed that under the EPC 1973 it was also clearly foreseen that consideration of unity by the search divisions could be carried out on an a posteriori basis (i.e. formerly Guidelines, B-VII.5; cf. R. 46 EPC 1973; see now Guidelines – March 2022 version, in particular F-V.4, and R. 64 EPC). Therefore, the Guidelines had on this point to be considered as consistent with the PCT and the EPC 1973.

The Enlarged Board confirmed that the EPO when acting as an ISA and the boards of appeal when deciding on protests under Art. 17(3)(a) PCT were under an obligation to be guided by the PCT Search Guidelines (cf. Art. 2 of the then applicable agreement between the EPOrg and WIPO). Thus, in G 1/89 the Enlarged Board held that, as foreseen in these guidelines, an international application may, under Art. 17(3)(a) PCT, be considered not to comply with the requirement of unity of invention, not only "a priori" but also "a