

The following decisions concerning the former version of R. 164 EPC are still relevant.

In J 3/09, the Legal Board of Appeal confirmed in respect of R. 164 EPC (as then in force) that although the procedure on entry of an application into the European phase where the EPO had acted as the ISA changed with the coming into force of EPC 2000, the responsibility for establishing whether or not the application met the requirements of unity of invention still ultimately rested with the examining division, and the opinion of the EPO acting as the ISA on lack of unity was not final or binding on the examining division. The board observed that the practice of the examining division in this respect remained as before, noting in particular that to the extent that an objection of non-unity raised by the ISA turned out to be unjustified, the applicant was entitled to have the whole subject-matter of his unitary invention searched. The board in T 1285/11 followed this reasoning, adding that the fact that the applicant did not pay further search fees or protest fees in the international phase could not be seen as a tacit agreement with the findings of non-unity of the ISA.

For further decisions concerned with the interpretation and application of R. 164 EPC as in force until 31.10.2014), see the 9th edition of this book, II.B.6.2.

### **6.3. Applicability of Rule 64, (former) Rule 164(2) EPC or Rule 137(5) EPC**

In T 708/00 (OJ 2004, 160) the board pointed out, with reference to preparatory document CA/12/94 cited in the notice from the EPO in OJ 1995, 409, that the purpose of R. 86(4) EPC 1973 (R. 137(5) EPC) was to deal with the situation arising when amended claims relating to unsearched subject-matter were filed in response to the examiner's first communication. It did not apply when the applicant had not paid the search fee in respect of a non-unitary invention in spite of being invited to do so under R. 46(1) EPC 1973 (R. 64(1) EPC), cf. also G 2/92, OJ 1993, 591. These two rules were complementary in nature.

In T 1285/11 (mentioned above), in which no further search fees had been paid in response to the ISA's non-unity objection, the examining division refused the application on the basis of R. 137(5) EPC as well as former R. 164(2) EPC. Referring to T 708/00 (OJ 2004, 160), the aforementioned notice and the Guidelines, the board found that R. 137(5) EPC was not contravened because the subject-matter of the amended claims had already been present in the claims as originally filed. Concerning former R. 164(2) EPC, the board was satisfied that, prima facie, there was a feature that could be regarded as constituting a "special technical feature" (R. 44(1) EPC) establishing unity between "invention 1" and "invention 2" in accordance with Art. 82 EPC. The decision was set aside and the application was remitted for further prosecution.

Reference is also made to chapter IV.B.5. "Amendments relating to unsearched subject-matter – R. 137(5) EPC".