

posteriori". According to G. 2/89, the EPO in its function as an ISA may, pursuant to Art. 17(3)(a) PCT, request a further search fee where the international application is considered to lack unity of invention "a posteriori". The principle whereby the EPO may also find a lack of unity "a posteriori" when carrying out an international search (G. 1/89, OJ 1991, 155; G. 2/89, OJ 1991, 166) applies equally to a European search because in both cases the searches and search reports are virtually identical (see T. 87/88, OJ 1993, 430).

According to T. 94/91, Art. 82 EPC 1973 clearly provided that European patent applications must satisfy the criteria of unity of invention without any restriction. There was no difference in the EPC 1973 between "a priori" and "a posteriori" lack of unity. It was of no importance whether the non-unity appeared immediately or only in view of a document found during the search or the examination. This was also the interpretation given in the Guidelines and in G. 2/89 (OJ 1991, 166), which, although it related to PCT applications, concerned a similar procedure.

Where the search division makes a finding of non-unity, the applicant is normally informed, along with the partial search report relating to the invention, or group of inventions, first mentioned in the claims, that a further search fee must be paid for the other inventions which it wishes to be covered by the European search report (R. 64(1) EPC). Art. 17(3)(a) PCT lays down the equivalent procedure before the ISA. R. 164 EPC contains special provisions for Euro-PCT applications having entered the European phase. Relevant decisions are summarised in this chapter II.B.6. "Plurality of inventions – further search fees".

### **3.3. Assessment of lack of unity and of requests for refund of further search fees in examination proceedings**

The requirement of unity under Art. 82 EPC has to be satisfied not only by the patent application as filed but also at later stages of the patent granting procedure, i.e. before the examining division, up until grant of the patent. Under R. 64(2) EPC (R. 46(2) EPC 1973) the examining division may disagree with the search division's finding of lack of unity, and the examining division's opinion is decisive in that the latter may order the refund of any further search fee at the applicant's request (see cases below and in this chapter II.B.6). It lies within the discretion of the examining division to decide that a patent application lacks unity of invention within the meaning of Art. 82 EPC, even if the search division did not raise a similar objection (T. 178/84, OJ 1989, 157). See also T. 631/97 (OJ 2001, 13), summarised in this chapter II.B.6.1. "Consequences of non-payment of a further search fee".

In T. 544/88 (OJ 1990, 429) the board ruled that if an applicant, in response to an objection of lack of unity, filed new claims allegedly relating to an invention meeting the unity requirement, examination should be continued even if the other application documents had not been limited to the subject-matter of those claims. However, the examining division could request the applicant to bring the description and drawings into line with the valid claims (R. 27(1)(d) EPC 1973 as in force until 31.5.1991; cf. subsequent R. 27(1)(c) EPC 1973, now R. 42(1)(c) EPC) and to delete those parts of the description