

In W 17/03 the board was concerned with the investigation of technical relationships for unity. The case is summarised in the next section.

The boards have on several occasions stressed that an alleged lack of clarity in a claim cannot be used as a reason for an objection based on lack of unity (see W 31/88, OJ 1990, 134; W 7/89, W 59/90, W 9/02). In W 21/04 the board observed that according to the established case law the features of an independent claim that the ISA considered not to meet the requirements of Art. 6 PCT could not be disregarded in examining a lack of unity objection, as the IPEA had done here. See also W 8/07.

#### 4.2. Examination as to novelty and inventive step

In decision G 1/89 (OJ 1991, 155; see also opinion G 2/89, OJ 1991, 166), the Enlarged Board of Appeal ruled on the question of the ISA's power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering whether it complies with the requirement of unity of invention (see also referring decision W 12/89 (OJ 1990, 152).

If an International Searching Authority does have such power, in what circumstance does it have an obligation to carry out such a substantive examination?"

The Enlarged Board found that in accordance with normal terminology, the term "examination" or "substantive examination" referred to the activities of the authorities responsible for deciding on patentability, such as the examining division of the EPO, or the IPEA and/or the designated Office. Obviously, an ISA did not have any power to carry out such activities; it might only form a provisional opinion on novelty and inventive step for the purpose of carrying out an effective search. This opinion was in no way binding on the authorities referred to above. The same principle applied when an ISA considered that an international application did not comply with the requirement of unity of invention set forth in R. 13.1 PCT on an "a posteriori" basis. Such consideration had only the procedural effect of initiating the special procedure laid down in Art. 17 PCT and R. 40 PCT and was, therefore, not a "substantive examination" in the normal sense of that term. An assessment of whether a single general inventive concept existed was to be undertaken only in so far as this was necessary to establish whether the invention complied with the requirement of unity when implementing that procedure. Such an assessment was provisional and did not constitute a substantive examination in the sense of an examination as to patentability (see W 6/90, OJ 1991, 438).

The Enlarged Board further noted that consideration by an ISA of the requirement of unity of invention should always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Art. 17(3)(a) PCT should be made only in clear cases. In particular, in view of the fact that such consideration under the PCT was being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in borderline cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step (see W 24/90, W 23/91, W 43/91). In W 1/97 the board held that there was no such clear case where the ISA,