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**Datasheet for the decision  
of 30 October 2012**

**Case Number:** T 2495/11 - 3.5.04

**Application Number:** 04747891.2

**Publication Number:** 1534002

**IPC:** H04N5/232

**Language of the proceedings:** EN

**Title of invention:**

IMAGE PICKUP APPARATUS AND SYNCHRONIZATION SIGNAL GENERATING APPARATUS

**Applicant:**

Sony Corporation

**Headword:**

**Relevant legal provisions:**

EPC Art. 92  
EPC R. 43, 61, 63 (2007), 164 (2007)  
EPC 1973 R. 67

**Keyword:**

Additional search refused on the basis of incorrect criteria

**Decisions cited:**

G 0010/93, J 0003/09, T 0708/00, T 0377/01, T 1242/04,  
T 0630/08, T 1285/11

**Catchword:**

See points 3.4 - 3.6



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Case Number: T 2495/11 - 3.5.04

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.04**  
**of 30 October 2012**

**Appellant:** Sony Corporation  
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**Representative:** Horner, David Richard  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted 21 July 2011  
refusing European patent application No.  
04747891.2 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** C. Kunzelmann  
B. Müller

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the examining division to refuse European patent application No. 04 747 891.2 under Article 97(2) of the European Patent Convention (EPC).
- II. The application was refused on the ground that each request submitted by the applicant comprised claims which had not been admitted into the examination procedure (Article 113(2) EPC).
- III. The proceedings up to the refusal of the application may be summarised as follows:

The application was filed as international application No. PCT/JP2004/010527. It comprised 17 claims and was published as WO 2005/009031 A1 together with an international search report. The international search report was established by the Japanese Patent Office in its function as International Searching Authority (Article 16 PCT) and cited five documents considered to be relevant for all the 17 claims. Subsequently the application entered into the European phase.

On 26 March 2008 the European Patent Office transmitted the supplementary European search report under Article 153(7) EPC. This supplementary (partial) European search report mentioned only documents referring to claims 1 and 2. It indicated that claims 1 and 2 had been searched completely and that claims 3 to 17 had not been searched. The reasons for the limitation of the search set out that four independent claims of overlapping scope, with claim 1 covering an extremely large number of possible image pick-up devices, were such that the claims as a whole were not

in compliance with Article 84 EPC, the non-compliance with the substantive provisions was to such an extent that a meaningful search could not be carried out and that the search was based on subject-matter that could be reasonably expected to be claimed later in the procedure. Reference was made to Rule 63 EPC.

IV. Searched claims 1 and 2 read as follows:

Claim 1

"An image pick-up device comprising:  
image signal generation means for generating an image signal of a variable frame-rate picked-up image;  
drive-and-control means for driving and controlling the image signal generation means;  
setting information generation means for generating image pick-up setting information to generate an image signal which is frame-synchronized with the image signal generated by the image signal generation means;  
and  
output means for outputting the image signal generated by the image signal generation means and the image pick-up setting information."

Claim 2

"The image pick-up device according to claim 1, wherein the output means outputs the image signal with the image pick-up setting information being inserted into a blanking interval thereof."

Non-searched dependent claim 4 reads as follows:

"The image pick-up device according to claim 1, wherein the setting information generation means makes

information of a scan line position and a pixel position of an image signal included in the image pick-up setting, said information being generated by the image signal generation means information."

Non-searched independent claim 7 reads as follows:

"An image pick-up device comprising:  
image signal generation means for generating an image signal of a variable frame-rate picked-up image; and  
drive-and-control means for receiving image pick-up setting information to generate an image signal that is frame-synchronized with the image signal of a reference variable frame-rate picked-up image, and controlling a driving operation of the image signal generation means based on this image pick-up setting information, thereby frame-synchronizing the image signal generated by the image signal generation means with the image signal of the reference variable frame-rate picked-up image."

Claims 8 to 14 are dependent on claim 7.

Non-searched independent claim 15 reads as follows:

"A synchronization-signal-generating device for supplying a synchronization signal to an image pick-up device having image signal generation means for generating an image signal of a variable frame-rate picked-up image, comprising:  
setting information generation means for generating image pick-up setting information which is used to frame-synchronize the image signal generated by the image signal generation means of the image pick-up device with a reference frame;

synchronization signal generation means for generating the synchronization signal that corresponds to the reference frame;

synchronization signal output means for outputting the generated synchronization signal with the generated image pick-up setting information being inserted thereinto; and

control means for setting the reference frame."

Claim 16 is dependent on claim 15.

Non-searched independent claim 17 reads as follows:

"An image pick-up device comprising:

an image signal generation portion that generates an image signal of a variable frame-rate picked-up image;

a controller driving and controlling the image signal generation portion;

a setting information generation portion that generates image pick-up setting information to generate an image signal that is frame-synchronized with the image signal generated by the image signal generation portion; and

an output portion that outputs the image signal generated by the image signal generation portion and the image pick-up setting information."

V. In a letter dated 13 June 2008 the applicant gave reasons why he considered the limitation of the search unjustified. He also requested that a full search report covering all of the claims be reissued.

VI. The examining division issued a communication, dated 23 November 2009, pursuant to Article 94(3) EPC. In this communication the examining division opined that the limitation of the scope of the search was justified. In addition to the reasons for the

limitation of the search given in the search report, the examining division argued that claim 1 was unduly broad so that its subject-matter was not new over a conventional variable frame-rate image pick-up device and the dependent claims were not linked by a single inventive concept. Thus, if the dependent claims had been objected to for lack of unity, the searched subject-matter would have had to be limited to the first invention, i.e. claims 1 and 2.

- VII. With a letter dated 17 March 2010 the applicant replied to the communication and filed new claims 1 to 14 replacing the previous claims 1 to 17. The applicant submitted that new claim 1 included the subject-matter of previous claim 4. The applicant also reiterated the position set out in the letter dated 13 June 2008 concerning the limitation of the scope of the search.
- VIII. The examining division issued a second communication, dated 28 September 2010. It stated that new claim 1 related to unsearched subject-matter and was not unitary with the searched invention, and that it did not admit this new claim 1 under Rule 137(5) EPC.
- IX. In a reply letter dated 26 January 2011 the applicant asked "to top up the search performed by the Search Division, at the very least at this stage in proceedings to cover the subject-matter" defined by the claims dated 17 March 2010, and to examine the claims on that basis. If the examining division was not minded to perform a top-up search and examination on that basis, the applicant requested an appealable decision on the status of the file.
- X. The examining division issued a decision dated 21 July 2011 to refuse the application.

XI. The reasons for the decision under appeal may be summarised as follows:

The applicant's main request was that an additional search be carried out on all the claims as originally filed. Original claims 1 and 7 related both to a variable image pick-up device, with claim 1 directed to outputting of frame rate synchronisation signals, and claim 7 directed to setting of frame rate synchronisation signals. Because both were indispensable features for a variable frame-rate camera, the subject-matter of both these claims was not new. Secondly this subject-matter was directed to different details of an image pick-up device which were not interrelated in the sense of Rule 43(2)(a) EPC. Also original claim 15 was not related to an interrelated product in the sense of Rule 43(2)(a) EPC. Interrelated products existed independently from each other but only performed the invention when interacting with each other. Rule 43(2)(b) EPC related to different uses of a product and not to different uses of a concept. Thus claim 15 was not permissible under the exception defined in Rule 43(2)(b) EPC. Original claim 17 defined effectively the same subject-matter as claim 1 but used different terminology. This claim was rejected for lack of conciseness (Article 84 EPC). Thus it was impossible for a person skilled in the art to determine what was intended to be protected by claims which were not new and might be related to different uses of a concept. The dependent claims related to different details of the inventions. In particular the claims dependent on claim 1 were not linked by a single inventive concept because claim 1 was not new over a conventional variable frame-rate image pick-up device.



Thus, the original claims were unduly broad and claim 1 lacked essential features for carrying out the invention as understood from the description. Extending the scope of the search to all the claims as originally filed was not justified because of the lack of clarity (Article 84 EPC) of these claims.

The applicant's auxiliary request was that the claims filed with the letter dated 17 March 2010 be admitted into the examination proceedings. However, independent claim 1 filed with the letter dated 17 March 2010 was based on unsearched subject-matter, which was not unitary with the invention searched. Thus claim 1 was not admitted into the proceedings under Rule 137(5) EPC 2010 or Rule 137(4) EPC 2000. Independent claim 13 did not fall under the exceptions of Rule 43(2) EPC.

The examining division concluded that the application was refused because each request submitted by the applicant comprised claims that were not admitted (Article 113(2) EPC).

XII. The applicant appealed and requested that the decision under appeal be set aside.

XIII. The appellant's arguments may be summarised as follows:

The search and examination had been poorly handled. The application of the provisions of the EPC had been inappropriate to the extent that at least one substantial procedural violation had occurred. Up to 2011, the desired claims had not been searched and examined despite the application having a filing date in 2004. Hence accelerated processing of the appeal was requested.

The limitation of the extent of the search under the guise of Rule 63 EPC was an incorrect application of the provisions of the EPC, and the board was requested to confirm this.

The examining division had sought to retrospectively justify the incomplete search performed by the search division, yet on the different ground of lack of unity. The search should have been performed for all claims 1 to 17 as originally filed. Article 92 EPC required the search report to be drawn up on the basis of the claims, with due regard to the description and any drawings. The invention related to the use of a synchronisation signal to synchronise the frame rates of multiple variable frame-rate image pick-up devices. Figure 1A illustrated a configuration with a "master" image pick-up device and a number of "slave" image pick-up devices. Claim 1 corresponded to such a "master" image pick-up device. Figure 1B illustrated a configuration with only "slave" image pick-up devices and a dedicated synchronisation-signal-generating device which provided the synchronisation signal to all the image pick-up devices. Claim 7 corresponded to such a "slave" image pick-up device. Claim 15 corresponded to the synchronisation-signal-generating device. Thus it was reasonable to expect the search to cover systems of multiple variable frame-rate pick-up devices which should be synchronised. The search had been unreasonably restricted in terms of the number of claims searched and the subject-matter covered by the search. Claim 17 was the direct equivalent of claim 1 with "means for" language substituted by "portion" language and did not justify an incomplete search. The board was requested to instruct that a complete search of the originally filed claims, appropriately

interpreted in the light of the description and drawings, should be performed.

The refusal of the examining division to admit the amended claims was incorrect because the subject-matter of amended claim 1 did not relate to unsearched subject-matter. The amended claim 1 comprised the subject-matter of original claims 1 and 4, and these had been searched by the International Searching Authority. Moreover a substantial procedural violation had occurred because the applicant should have been invited to limit the application to one invention covered by the international search report or the supplementary search report in application of Rule 164(2) EPC. The board was requested to confirm this understanding of Rule 164(2) EPC and to allow the applicant further opportunity to pursue the combination of originally filed claims 1 and 4 in this application.

XIV. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to a summons to oral proceedings. It indicated that it had given priority to the case. The board gave the preliminary opinion that some of the requests could not be granted because they did not have a legal basis. The board also indicated that it envisaged a remittal of the case to the department of first instance because the examining division's decision on the main request was taken on the basis of the wrong criterion.

XV. In a letter dated 25 September 2012 the appellant announced that it would not attend the oral proceedings before the board. The appellant also requested that the appeal fee be refunded. A refund was equitable and appropriate because the necessity to file the appeal

was a direct result of the failure of the examining division to redress the errors made by the search division.

XVI. The board held oral proceedings on 30 October 2012 in the appellant's absence, in application of Rule 71(2) EPC 1973 and Article 15(3) RPBA. At the end of the oral proceedings the chairman announced the board's decision.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Requests for which there is no legal basis*

The present appeal concerns the refusal of the application because the application comprised claims which were not admitted by the examining division (Article 113(2) EPC 1973; see point 27 of the decision under appeal). The **examining division** came to this decision because it did not allow the applicant's *main request* for a search on all the claims as originally filed (see point 22 of the decision under appeal) and because it did not allow the applicant's *auxiliary request* in application of Rule 137(4) EPC (the applicable version of this Rule being the one as published by the EPO in the 13th edition of the European Patent Convention, July 2007). Under these circumstances, some of the appellant's requests cannot be granted by the board because they do not have a legal basis.

- 2.1 Request for the board to confirm that the limitation of the extent of the search according to Rule 63 EPC was an incorrect application of the provisions of the EPC

The search was carried out by the search division. Also the decision to search claims 1 and 2 but not to search claims 3 to 17 (see the supplementary partial European search report, sheet C) was taken by the search division. Decisions taken by the search divisions are not open to appeal (see Article 106 (1) EPC). Furthermore the board does not see any legal basis for issuing a declaratory decision that this decision taken by the search division was correct or not.

- 2.2 Request for the board to instruct that a complete search of the originally filed claims, appropriately interpreted in the light of the description and drawings, should be performed

The board does not see any legal basis for reviewing the decision taken by the search division to search claims 1 and 2 but not to search claims 3 to 17 (see point 2.1 above). Furthermore the EPC does not comprise a provision empowering the board to instruct the search division to repeat the search for an application refused by the examining division, with the repeated search to be carried out using a certain interpretation of the claims.

- 2.3 Request for the board to confirm a particular understanding of Rule 164(2) EPC

Rule 164(2) EPC is applicable in a number of different circumstances (see the different occurrences of "or" in this Rule). A board may have to give an interpretation of Rule 164(2) EPC based on the facts of the particular

case, but it is not the task of the board to confirm a particular understanding of this Rule in general.

3. *Main request*

The appellant implicitly challenges the failure by the examining division to call upon the search division to carry out an additional search. Hence, in the particular circumstances of the present case, the board interprets the appellant's main request in the appeal proceedings as a request to issue a decision binding the examining division to call upon the search division to carry out an additional search.

3.1 In principle the search report contains the results of the search and has to be drawn up "on the basis of the claims, with due regard to the description and any drawings" (Article 92 EPC). The results of the search serve as a basis for substantive examination as far as novelty and inventive step are concerned (see Rule 61(1) EPC). Exceptions to this principle are given in Rules 63 and 64 EPC. In these exceptional cases, the EPO may draw up a partial search report.

3.2 The so-called "additional searches" are not specified in the EPC. However, the Guidelines for Examination in the European Patent Office, Part B, Chapter II, points 4.1 and 4.2 (versions of December 2007, April 2010 and June 2012) make clear that the primary task of the search division is to carry out searches and draw up search reports in relation to European patent applications, and that the search division may be called upon to perform various other types of searches including the additional searches (for instance in cases of limitations or imperfections in the initial search).

The Guidelines, Part C, Chapter VI, point 8.2 (versions of December 2007 and April 2010; Part C, Chapter IV, point 7.2 in the version of June 2012) specify cases in which additional searches are necessary. One case where an additional search is necessary is when "a partial search taking the place of the search report under Rule 63 has been issued at the search stage, and subsequently the deficiencies which rendered a meaningful search impossible have been corrected by amendment, or successfully refuted by the applicant" (version of December 2007).

- 3.3 In the decision under appeal the applicant's request for an additional search is dealt with under the heading "Main request" (see points 9 to 22). In the decision the examining division raises objections under "Art. 84 in combination with Rule 43(2) EPC" against the independent claims (see section 14). Furthermore it states in point 15 that the dependent claims "relate to different details of the invention/s" and that "even if claim 1 were the only independent claim, ... the dependent claims are not linked by a single inventive concept". Claim 17 is rejected for lack of conciseness because it essentially defines the same subject-matter as claim 1. Furthermore in section 16 the examining division analyses the problem underlying the invention and considers that claim 1 lacks features which, according to the examining division, are essential features for the definition of the solution to the problem solved by the invention (Article 84 EPC) and considers that the search was limited to the subject-matter of claims 1 and 2 in combination with features of the description (see also point 19). The examining division's conclusion is that the limitation of the search of claim 1 was justified.

Also the applicant's arguments are rebutted with a reference to Rule 43(2) EPC and with the argument that only image pick-up devices "supported with respect to the invention, which is related to the the [sic] problem set out in the description page 3, lines 1 - 4 are searched".

- 3.4 Thus in respect of the applicant's main request only the fact that objections which might be raised in substantive examination have led to the examining division's decision not to call upon the search division to have an additional search carried out. In the board's view this was the incorrect criterion. A meaningful search (and also a meaningful additional search) may well be possible for claims which are objectionable in substantive examination. For instance, the board agrees with the appellant's argument that for two claims which essentially define the same subject-matter (and which may be objectionable for lack of conciseness) a meaningful search is possible either for both or for none, but not for only one of them. As another example, a meaningful search may well be possible for two claims which might be objectionable under Rule 43(2) EPC. In this respect the board agrees with the finding in decision T 1242/04 (point 8.3 of the Reasons) that an assessment by the search division that the examining division will be able to reach a (negative) decision without a search in general does not allow the conclusion that a search is not meaningful and therefore unnecessary and may be refused by reference to Rule 63 EPC (Rule 45 EPC 1973). This finding also applies when the search division has carried out a search on the basis of some of the claims and considers whether to carry out the remainder of the search on the basis of the remaining claims. The search is the basis for substantive examination, not vice



versa. Moreover, search and substantive examination are different, albeit connected, activities. They should not be confused even if they are carried out largely by the same (or an overlapping group of) people. In particular, a refusal (by the search division) to search certain claims as filed should not be confused with a decision (by the examining division) not to admit these claims into the examination proceedings (see point 27 of the decision under appeal). The board also notes that in the meanwhile new Rules 62a and 63 EPC entered into force (on 1 April 2010).

- 3.5 In the present case the appellant's arguments (see in particular page 4, paragraphs 1 to 4, of the statement of grounds of appeal) have convinced the board that the image pick-up devices and the synchronisation-signal-generating device claimed in the application as filed are defined in such terms that a search would be **meaningful** not only for claims 1 and 2, but also for the other claims. In particular the results of an additional search should provide a basis for the assessment of novelty and inventive step within the framework of substantive examination. Moreover a search (namely the international search) has been carried out for all the claims. Thus in the present case the examining division, when refusing the applicant's main request, should have given the reasons why, taking due regard to the description and drawings, the lack of compliance of the application with the EPC was such that it was **not possible** for the search division to carry out a meaningful additional search for the subject-matter of the non-searched claims 3 to 17 and also reasons why the international search, as far as it covered claims 3 to 17, was not meaningful.

3.6 Since an international search has been carried out for all the claims, the board does not see why in the present case the drawing up of a search report complying with Article 92 EPC or an additional search completing the incomplete search under Rule 63 EPC were impossible. In any case the reasons given in the decision under appeal for refusing to call upon the search division to carry out an additional search are based on the incorrect criterion that substantive objections (a lack of clarity and essential features) might be raised against these claims in the examination phase. Hence the case has to be remitted to the examining division. It is not the board's task to call upon the search division to carry out an additional search and then to carry out a full examination of the application as to patentability requirements. This is the task of the examining division (see the decision of the Enlarged Board of Appeal G 10/93, OJ EPO 1995, 172).

3.7 The board wishes to add *obiter* that the objections based on Rule 43(2) EPC given in the decision under appeal not only do not justify the refusal to call upon the search division to carry out an additional search. They would not justify the refusal of the application on the basis of the claims as originally filed, either. The reasons are as follows:

3.7.1 One objection in the decision under appeal is based on the understanding that different independent claims are only allowable if they relate to interrelated products which exist independently from each other but "only perform the invention when interacting with each other". This latter limitation cannot be taken from the wording of either Rule 43(2) (a) EPC or Rule 29(2) (a) EPC 1973 (which is almost identical and would apply in

the present case in view of the transitional provisions) or of the Guidelines, Part C, Chapter III, point 3.2. For instance, the list of examples given in the Guidelines is not exhaustive, and not all of the given examples concern cases in which the invention is only performed when products interact with each other.

3.7.2 Furthermore, Rules 43(2) EPC and Rule 29(2) EPC 1973 specify three situations in which the principle of only one independent claim in the same category does not apply, interrelated products, different uses and alternative solutions. But in the decision under appeal the last one, alternative solutions, is not discussed at all.

#### 4. *Auxiliary request*

In the appeal proceedings the auxiliary request, being the subject of the impugned decision, has been maintained in a somewhat modified form. That is, the appellant requests a "further opportunity to pursue the combination of originally filed claims 1 and 4 in this application" (see page 5 of the statement of grounds of appeal).

4.1 Since the case has to be remitted to the examining division (and thus the main request is not refused), there is no need to consider this request.

4.2 Again, however, the board wishes to add *obiter* that in its view Rule 137(4) EPC (version of 2007, which corresponds to present Rule 137(5), first sentence, EPC) was not applicable in the present case. In the board's view present Rule 137(5), first sentence, EPC should not normally be applied when an independent claim as originally filed is modified by appending to

it the features of a claim which was originally directly dependent on this independent claim (see, for instance, T 708/00, Headnote III; T 377/01, point 3.1 of the Reasons, or T 1285/11, point 2 of the Reasons). Also the instructions to examining divisions given in the Guidelines follow this view. They explain that normally a dependent claim is unitary *a priori* with the independent claim from which it directly depends and that the issue of unity *a posteriori* may arise between parallel dependent claims if the common independent claim is found not to be patentable (Guidelines Chapter C, Part III, point 7.8 in the December 2007 and April 2010 versions). The board does not see a reason why the present case might be seen as an exceptional case in which a deviation from the normal practice was justified.

5. *Request for refund of the appeal fee*

5.1 It is Rule 67 EPC 1973 that applies to the present case and not the corresponding Rule 103(1)(a) EPC 2000 (see T 630/08, at point 1, citing J 3/08 (OJ EPO 2009, 170), point 3 and J 10/07 (OJ EPO 2008, 567), point 7).

Rule 67 EPC 1973, sentence 1, reads: "The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation."

5.2 The appellant submitted that the refusal of the application without giving the applicant the opportunity to limit the application to the subject-matter of the combination of original claims 1 and 4

constituted a substantial procedural violation, namely a breach of Rule 164(2) EPC.

5.3 Rules 164(1) and (2) EPC are headed "Consideration of unity by the European Patent Office". Rule 164(2) EPC concerns the case where the **examining division** finds (in examination proceedings after entry into the European phase) that protection is sought for an invention not covered by the search report, in particular in the case of lack of unity of the claimed invention(s). Also the explanatory notes on Rule 164 EPC given in OJ EPO, Special edition 5/2007 (see pages 256 and 257 in the English version), make clear that Rules 164(1) and (2) EPC replaced Rule 112 EPC 1973 so that the procedure to be applied was simplified and the opportunity to have multiple inventions searched within the framework of one application was limited to the international phase. On entry into the European phase, non-unitary subject-matter should be deleted. This is consistent with the view taken in previous decisions of the boards of appeal (see, for instance, T 1285/11, point 3.1 of the Reasons and J 3/09, points 3.5.6 and 3.5.7).

5.4 In the present case, unity of the invention was not disputed in the international phase. In the European phase the search division did not raise an objection as to lack of unity (Article 82 EPC 1973) either. Instead the search division raised an objection as to lack of clarity and conciseness (Article 84 EPC 1973). The search division performed an incomplete search and consequently referred to Rule 63 EPC (not Rule 64 EPC) in the supplementary partial European search report.

5.5 Also the **examining division** did not raise an objection under Article 82 EPC. The sentences "[t]hat is, if claim 1 was the only independent claim, given that claim 1 is not new over a conventional variable frame-rate image pickup device, the dependent claims are not linked by a single inventive concept. Even if it was allowable to object the claims for lack of unity, the subject-matter searched has to be limited to the first invention mentioned in the claims, ie. claim 2" in point 5.5 of the communication dated 23 November 2009 are in the board's view not a reasoned objection under Article 82 EPC 1973 in substantive examination. Instead the board considers that they reflect the examining division's view that a lack of unity objection could have been raised at the search stage. This is confirmed in the decision under appeal, point 15, which states that "if the dependent claims had been objected to for lack of unity, the searched subject-matter had to be limited to the first invention mentioned in the claims, ie. claims 1 and 2". Furthermore, the statement in point 4 of the decision under appeal that lack of unity "was one reason for restricting the search to claims 1 and 2" is contrary to the facts as they appear from the file.

5.6 In view of the above the board considers that the search division applied the correct Rule (Rule 63 EPC). The examining division subsequently confirmed the finding of the search division (see section 6 of the communication dated 23 November 2009). In this situation, Rule 164(2) EPC does not oblige the examining division to invite the applicant to limit the application to one invention. Therefore the board considers that Rule 164(2) EPC was not violated.

- 5.7 A different question is whether Rule 63 EPC was properly applied. However, as indicated in point 2.1 above the board does not see any legal basis allowing the board to review (and eventually set aside) the search division's decision to search claims 1 and 2 but not to search claims 3 to 17.
- 5.8 There remains the question whether the decision of the **examining division** not to call upon the search division to have an additional search carried out constituted a substantial procedural violation.
- 5.9 The examining division is responsible for the examination of the European patent applications (see Article 18 EPC). This examination may require, as in the present case, a judgment whether an additional search is necessary. In the present case, this judgment of the examining division was erroneous (see points 3.4 to 3.6 above). However, even though this error of judgment had procedural consequences and finally made the appeal necessary, it nevertheless does not constitute a **procedural** violation. The appellant's argument that the necessity to file the appeal was a direct result of the failure of the examining division to redress the errors made by the search division does not lead to a different conclusion because the failure in question was exactly the error of judgment discussed above.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



L. Fernández Gómez

F. Edlinger

Decision electronically authenticated