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**Datasheet for the decision  
of 17 October 2013**

**Case Number:** T 2459/12 - 3.4.03  
**Application Number:** 05753499.2  
**Publication Number:** 1770681  
**IPC:** G09G3/36, G02F1/133, G09G3/20,  
G09G3/34  
**Language of the proceedings:** EN  
**Title of invention:**  
DISPLAY DEVICE AND METHOD, RECORDING MEDIUM, AND PROGRAM  
**Applicant:**  
Sony Corporation  
**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 82, 92, 94, 112(1), 157(2)(a), 164(2)  
EPC 1973 R. 46(1), 58, 71(2), 86(2), 86(4), 112  
EPC Art. 94(3), 97(2), 123(2), 150(2), 153(2), 153(5), 153(7)  
EPC R. 36(1), 64(1), 137(5), 164(1), 164(2)  
RPBA Art. 15(1), 15(3), 15(5), 15(6)  
PCT Art. 11(3), 17(3)(a), 17(3)(b), 22(1), 27(1), 27(4), 34(3)  
(c), 45(1), R. 45bis., 45bis.6(a)(i)  
Guidelines for examination E-IX, 5.7 (Edition of 2010), E-  
VIII, 4.2, F-V, 13.2, H-II, 7.4.2  
Vienna Convention on the Law of Treaties (1986)

**Keyword:**

Applicant entitled to pursue subject-matter not covered by the European search report (no)  
Applicant entitled to have further search report drawn up (no)  
Applicability of Rule 137(5) EPC  
Referral to the Enlarged Board of Appeal (no)

**Decisions cited:**

G 0002/92, T 0178/84, T 0026/88, T 0442/95, T 0631/97,  
T 0708/00, T 1981/12

**Catchword:**

The approach to the application of Rule 164(2) EPC which is set out in the Guidelines is confirmed (point 3.9).  
Where, following the drawing up of a supplementary European search report by the EPO, an applicant files amended claims seeking protection for subject-matter which is not covered by the supplementary European search report as a result of the application of Rule 164(1) EPC, an objection under Rule 137(5) EPC should be raised (point 4.3).  
Non-compliance with Rule 137(5) EPC is a ground for refusing an application (point 5.3).  
A question regarding a point of law, the answer to which would affect only a relatively small number of applicants for a limited period of time, after which it would become obsolete, is not to be regarded as a question relating to a point of law of fundamental importance and therefore does not warrant a referral to the Enlarged Board of Appeal (point 6).



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Case Number: T 2459/12 - 3.4.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.03**  
**of 17 October 2013**

**Appellant:** Sony Corporation  
(Applicant) 1-7-1 Konan  
Minato-ku  
Tokyo 108-0075 (JP)

**Representative:** Thévenet, Jean-Bruno  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 26 June 2012 refusing European patent application No. 05753499.2 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** G. Eliasson  
**Members:** S. Ward  
T. Bokor

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the Examining Division refusing European patent application No. 05 753 499 on the grounds that the claimed subject-matter did not meet the requirements of Rule 137(5) EPC and Rule 164(2) EPC.
  
- II. The application under appeal was originally filed under international application number PCT/JP2005/011338 and published as WO2006/008903. The Japanese Patent Office acting as the International Searching Authority issued an international search report and a written opinion of the International Searching Authority, both of which covered all claims on file (claims 1-11). No objection of lack of unity of invention was raised.
  
- III. EPO Form 1200 for entry into the European phase was filed on 21 March 2006 together with the required translations; the respective fees were also paid. Claim 1 was directed to a display apparatus; claims 2 to 8 were dependent on claim 1; claim 9 was directed to a display method; claim 10 was directed to a storage medium that stores a computer-readable program for display processing; and claim 11 was directed to a program for causing a computer to perform display processing.
  
- IV. A supplementary European search report dated 16 July 2009 was drawn up according to Article 153(7) EPC. On "Sheet B" of the supplementary European search report the applicant was informed that the Search Division did not consider that the application met the requirements of unity of invention as it related to three inventions: a first invention represented by claims 1-5 and 9-11; a second invention represented by claim 6

(directly dependent on claim 1); and a third invention represented by claims 7 and 8 (both directly dependent on claim 1). The objection was that application lacked unity of invention *a posteriori* in the light of the following documents cited in the supplementary European search report:

D1: EP 1 164 566 A

D2: WO 2004/055577 A

- V. A box was crossed on the supplementary European search report next to the following text: "The present supplementary European search report has been drawn up for those parts of the European patent application which relate to the invention first mentioned in the claims (Rule 164(1) EPC)".
- VI. In a communication pursuant to Article 94(3) EPC dated 20 September 2010 the same objection of lack of unity of invention was raised. As the supplementary European search report had been drawn up only for the invention first mentioned in the claims, the applicant was "invited to limit the application to the invention covered by the supplementary search report", and was advised that "The subject-matter to be excised may be made the subject of one or more divisional applications" (paragraph 5.6).
- VII. The applicant filed a letter of response dated 30 March 2011 together with a set of amended claims (claims 1-8). In the letter it was explained that "the features of former claim 6 have been added to the independent claims". The applicant argued that this amendment was in accordance with Rule 164(2) EPC for the reason that, when an examining division considers that a Euro-PCT application lacks unity of invention, Rule 164(2) EPC

requires that the applicant be invited to limit the claims to one of the inventions covered by the supplementary European search report or the international search report. As all claims had been searched in the international phase, the amended claims corresponded to an invention covered by the international search report, and hence represented a suitable limitation according to Rule 164(2) EPC.

VIII. The Examining Division sent a further communication pursuant to Article 94(3) EPC dated 8 April 2011 in which an objection under Rule 137(5) EPC was raised against claims 1, 6 and 8. It was also argued that in cases such as the present one, Rule 164(2) EPC requires that the applicant be invited to limit the claims to one of the inventions *covered by the supplementary European search report*. Other inventions which are not covered by the supplementary European search report may not be pursued in the application, even if they are covered by the international search report or by a supplementary international search report. It was argued that this interpretation is fully consistent with the Guidelines.

IX. The applicant responded with a further letter dated 18 October 2011 accompanied by a new set of amended claims 1-7. It was argued that claim 1 (which was unamended) complies with the requirements of Rule 137(5) EPC as the subject-matter of this claim was searched by the International Searching Authority, and hence it does not contain any subject-matter which can properly be described as "unsearched". Extensive arguments were submitted in support of the applicant's interpretation of Rule 164(2) EPC.

- X. A summons to oral proceedings dated 25 November 2011 was sent to the applicant together with an annex in which the Examining Division maintained its position that "present claims 1 and 5 do not meet the requirements of Rule 137(5) EPC and Rule 164(2) EPC".
- XI. A lengthy analysis of the interpretation of Rule 137(5) EPC and Rule 164(2) EPC was set out by the applicant in a letter dated 18 May 2012. Further contacts between the applicant and the Examining Division prior to the oral proceedings were limited to essentially formal matters.
- XII. Oral proceedings were held on 18 June 2012 at which the applicant was unrepresented, as had been previously notified. The minutes show that, after deliberation of the Examining Division, the Chairman announced that the European patent application was refused, referring to "Article 97(2) EPC; Rules 137(5) and 164(2) EPC". In paragraph 1 of the Reasons in the written decision, which was sent to the applicant shortly afterwards, the Examining Division stated: "The present claims 1 and 5 do not meet the requirements of Rule 137(5) EPC and Rule 164(2) EPC. The application is therefore not allowable".
- XIII. A notice of appeal and a statement of grounds of appeal were filed, together with six annexes, which were described in the cover letter to the statement as follows:
- Annex 1 – Enlarged Board of Appeal decision G2/92  
Annex 2 – Board of Appeal decision T178/84  
Annex 3 – Board of Appeal decision T631/87 (*sic*, T631/97 was in fact annexed)

Annex 4 – Pages 256 and 257 of OJ EPO 2007, Special Edition No.5

Annex 5 – Chapter II, Section C, part 6.3; Chapter IX, Section B, part 1, and Chapter II, Section C, part 3.3.2 of "Case Law of the Boards of Appeal", 6th edition, July 2010.

Annex 6 – extract from Washington Diplomatic Conference minutes.

In the statement of grounds of appeal the applicant (now the appellant) requested the Board:

- to decide that the current interpretation of Rule 164(2) EPC 2000 applied by the Examining Division and set out in the Guidelines for Examination at the EPO is wrong,
- to rescind the refusal of the present application, and
- to remit the present application back to the Examining Division for further examination, with additional searching as required (if need be after payment of an additional search fee).

No amendments to the application documents were filed.

- XIV. Together with a summons to oral proceedings, the Board sent the appellant a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA). In summary, the Board set out the provisional view that the Examining Division had applied the provisions of Rule 164(2) EPC correctly. It was noted that the decision to refuse the application was also based on a perceived failure to comply with the requirements of Rule 137(5) EPC, and that this might also need to be discussed at oral proceedings.



The Board made reference to and annexed the following documents:

- Administrative Council document CA/PL 17/06, pages 444-445
- Official Journal 12/2009, pages 582-584
- Administrative Council document CA/166/09

XV. The appellant filed a further letter dated 16 September 2013 in which some of the points made in the annex to the summons to oral proceedings before the Board were further commented upon. New arguments "based on equitable principles" were also set out in the light of a consultation exercise organised by the EPO in which amendments to Rule 164 EPC were proposed. A copy of the consultation document was annexed.

The appellant also requested that the following questions, which were considered to relate to a point of law of fundamental importance, be referred to the Enlarged Board of Appeal:

"1. In view of the different possible meanings that can be given to the text of R164(2) EPC, does the correct interpretation of R164(2) EPC in the light of its object and purpose mean that:

a. an application within the purview of R164(2) EPC must be limited to one invention that has been searched by the EPO, or

b. the application in question may be limited to any invention covered by the international search report, or by the supplementary international search report, or by the supplementary European search report?

2. If the answer to question 1 is a. above, do equitable principles, or principles of higher law, nevertheless dictate that the application in question may be limited to any invention covered by the international search report, or by the supplementary international search report, or by the supplementary European search report?"

XVI. By letter dated 8 October 2013 the Board was informed that the appellant would not be represented at the oral proceedings.

XVII. Oral proceedings were held before the Board on 17 October 2013. The appellant was not represented, as previously notified.

XVIII. Claims 1-7 according to the sole request are identical to claims 1-7 upon which the contested decision was based. Claim 1 reads:

"A display apparatus, comprising:  
displaying means (12) for holding display of individual pixels of a screen in each period of a frame; and  
display controlling means (51) for controlling the display of the displaying means so as to time-sequentially increase brightness of the screen or time-sequentially reduce the brightness of the screen in each period of the frame;  
characterized in that there is further provided:  
motion-amount detecting means (72) for detecting an amount of motion of an image displayed,  
storing means (81) for storing a light-emission intensity that serves as a reference, and  
determining means (75) for determining, based on the stored light-emission intensity and the detected amount of motion, a characteristic value defining a

characteristic for time-sequentially increasing the brightness of the screen or time- sequentially reducing the brightness of the screen, with a constant light-emission intensity for the frame;  
and in that the display controlling means (51) is adapted to control the display of the displaying means (12) so as to time-sequentially increase the brightness of the screen or time-sequentially reduce the brightness of the screen in each period of the frame, based on the characteristic value."

XIX. The appellant argued essentially as follows:

The interpretation of Rule 164(2) EPC set out in the Guidelines and applied by the Examining Division was incorrect. The correct interpretation was that if the claims of a Euro-PCT application were directed to an invention covered by any one of an international search report, a supplementary international search report or a supplementary European search report, then no invitation under Rule 164(2) EPC should be issued, and the application should be allowed to proceed to examination on the basis of that invention.

The correctness of this interpretation of Rule 164(2) EPC could be demonstrated by reference to various arguments, which might be grouped under the following headings:

- arguments based on the text of Rule 164(2) EPC;
- arguments relating to the object and purpose of Rule 164 EPC, in particular as set out in preparatory documents; and
- arguments based on case law, and in particular on G2/92.

In addition, even if the Board were to find the interpretation of Rule 164(2) EPC given in the Guidelines to be correct, this rule should still not have been applied as it is:

- contrary to higher ranking law; and
- contrary to "equitable principles".

Rule 164(2) EPC as interpreted in the Guidelines led to European applications entering from the international phase (hereinafter: "Euro-PCT applications") being less favourably treated than European applications filed directly with the EPO (hereinafter: "Euro-direct applications"). This contravened higher ranking law and "equitable principles".

In relation to Rule 137(5) EPC, material which had been the subject of an international search but not a supplementary European search could not be regarded as "unsearched" within the meaning of this provision, and hence Rule 137(5) EPC did not apply to the present case.

### **Reasons for the Decision**

1. The appeal is admissible.
2. As announced in advance, the duly summoned appellant did not attend the oral proceedings. According to Rule 71(2) EPC 1973, the proceedings could however continue without the appellant. In accordance with Article 15(3)

RPBA, the board relied for its decision only on the appellant's written submissions. The Board was in a position to decide at the conclusion of the oral proceedings, since the case was ready for decision (Article 15(5) and (6) RPBA), and the voluntary absence of the appellant was not a reason for delaying a decision (Article 15(3) RPBA).

3. Rule 164 EPC

3.1 It has never been contested that Rule 164 EPC (and not the corresponding provision of EPC 1973) applies in the present case. A first version of Rule 164 was introduced in EPC 2000, and a second version came into effect on 1 April 2010 (see OJ 12/2009 582-584). The supplementary European search report (dated 16 July 2009) was therefore drawn up while the first version was in force and the application was refused after the second version had come into force. However, the second version differs from the first only in that the second paragraph contains a reference to "the supplementary international search report", which has no relevance for the present case.

The text of Rule 164(1) EPC is as follows:

- "Where the European Patent Office considers that the application documents which are to serve as the basis for the supplementary European search do not meet the requirements for unity of invention, a supplementary European search report shall be drawn up on those parts of the application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims".

In such a case, therefore, there is no invitation to pay further search fees and no option to have a second or subsequent invention searched, either in place of, or in addition to, the invention (or group of inventions) first mentioned in the claims.

The text of Rule 164(2) EPC (second version, in force since 1 April 2010) is as follows:

- "Where the examining division finds that the application documents on which the European grant procedure is to be based do not meet the requirements of unity of invention, or protection is sought for an invention not covered by the international search report or, as the case may be, by the supplementary international search report or supplementary European search report, it shall invite the applicant to limit the application to one invention covered by the international search report, the supplementary international search report or the supplementary European search report".

3.2 In the contested decision (point 1, Reasons for the Decision) it is stated that "The present claims 1 and 5 do not meet the requirements of Rule 137(5) EPC and Rule 164(2) EPC. The application is therefore not allowable".

In relation to Rule 164(2) EPC, the appellant does not dispute that claim 1 of the application as refused includes subject matter which, while covered by the international search, is not covered by the supplementary European search.

It is also not disputed that the Examining Division applied the provisions of Rule 164(2) EPC (and indeed Rule 164(1) EPC) in a manner which is in conformity with the Guidelines. In this respect the Examining Division cited E-IX, 5.7 of the Guidelines (edition of 2010), which corresponds to E-VIII, 4.2 of the current edition of the Guidelines (June 2012). Further support for the Examining Division's interpretation may be found in F-V, 13.2 (second paragraph) and H-II, 7.4.2 of the current Guidelines.

3.3 According to the Guidelines, Rule 164(2) EPC is to be interpreted as meaning that, if a supplementary European search report has been established, and the examining division finds that protection is sought for an invention not covered by the supplementary European search report, then it shall invite the applicant to limit the application to one invention *covered by the supplementary European search report*. This may be clearly derived from, for example, paragraph H-II, 7.4.2 of the current Guidelines which states:

- "Where the EPO performs a supplementary search on an application which is considered to lack unity, the applicant will not be invited to pay additional fees, but the supplementary search report will be established for the first invention only. The application must be limited to the invention searched in the supplementary search."

As a consequence, the applicant may not prosecute a second or subsequent invention in the application, and is obliged to file one or more divisional applications if protection is to be sought for these inventions.

The appellant, while accepting that this is indeed the interpretation set out in the Guidelines, nevertheless argues that this interpretation is wrong. The arguments advanced by the appellant in support of this conclusion will now be examined in detail.

### 3.4 Analysis of the text of Rule 164(2) EPC

3.4.1 The appellant questions in particular the meaning of the phrase "as the case may be" (*gegebenenfalls, le cas échéant*) in Rule 164(2) EPC. The Examining Division took the view that this phrase "clearly indicates that if a supplementary search report has been drawn up, the applicant shall be invited to limit the application to one invention covered by the supplementary European search report".

The appellant contends that the phrase "as the case may be" simply acknowledges that in some Euro-PCT cases, in addition to the international search report, an invention may be covered by a supplementary international search report or a supplementary European search report. This provision is therefore to be read as meaning that if an invention is not covered by *any one* of the these search reports, then the examining division shall invite the applicant to limit the application to one invention covered by *at least one* of them. Since there was no dispute that the subject-matter which the appellant wished to pursue in the application had been searched in the international phase, no invitation under Rule 164(2) EPC was warranted.

3.4.2 In the opinion of the Board, neither of these interpretations is manifestly inconsistent with the literal wording of Rule 164(2) EPC. In other words, the



phrase "as the case may be" is sufficiently vague that it is not possible to choose between the two interpretations on the basis of the text alone. The Board therefore agrees with the appellant that further analysis is required, taking due account of the principles of the Vienna Convention on the Interpretation of Treaties.

3.5 The object and purpose of Rule 164 EPC and the preparatory documents

3.5.1 An explanation of the reasoning behind the introduction of Rule 164 EPC is given in the Administrative Council document CA/PL 17/06, pages 444-445, the text of which is almost identical to that reproduced in Annex 4 submitted by the appellant.

From this document it is clear that an aim of the new Rule was to simplify the procedure and to eliminate the many practical problems which had arisen under the previous Rule 112 EPC 1973. The simplification introduced in Rule 164(1) EPC essentially restricts the opportunity to have multiple inventions searched within the framework of one application to the international phase only.

As far as the basis for examination is concerned, the document goes on to say:

- "The EPO believes that the principle should be that examination should only be carried out on inventions covered either by the international search report or by the supplementary search report, in line with G 2/92."

This does not appear to the Board to be particularly helpful in the present case, as it is still not unambiguously clear whether the "or" is intended to be inclusive, or whether it signifies two separate cases.

3.5.2 The document CA/PL 17/06 is not, however, the only preparatory document relating to Rule 164 EPC. If the preparatory documents are to be consulted, as suggested by the appellant, then clearly the entire legislative history of the provision should be taken into account.

3.5.3 Rule 164 EPC was further modified in decision CA/D 20/09 (OJ 12/2009 582-584), following a proposal to the legislator made in document CA/166/09. This modification which entered into force on 1 April 2010, was made to take into account the introduction of the (voluntary) supplementary international search report in Rule 45bis PCT, and the proposal in document CA/57/09 to dispense with the establishment of a supplementary European search report in cases where the EPO has drawn up a supplementary international search report.

Although these changes are not relevant *per se* to the present application, for which no supplementary international search report was established or even possible, the preparatory document CA/166/09 provides further insight into the thinking of the legislator in relation to the general object and purpose of Rule 164 EPC.

In particular, it is noted in point 8 of the document CA/166/09 that in the case of a lack of unity of invention, the EPO will only establish a supplementary international search report for the invention first mentioned in the claims (Rule 45bis.6(a)(i) PCT).

The consequences of these changes for Rule 164(2) EPC are explained in CA/166/09 (point 8) as follows:

- *"In line with the principle that the EPO will only examine inventions it has searched, a consequential amendment to Rule 164(2) EPC is necessary, obliging the applicant to limit his application to the invention covered by the supplementary international search report."* (Emphasis added.)

It is therefore explicitly acknowledged that, at least in the case where the EPO has drawn up a supplementary *international* search report, the intention of the legislator was that "as the case may be" in Rule 164(2) EPC should be interpreted as meaning that the applicant must limit his application to the one invention covered by the supplementary international search report (established by the EPO).

This being the case, it is difficult to imagine that the legislator had a different meaning in mind for "as the case may be" in relation to the supplementary *European* search report. Hence, a consistent interpretation would require that where a supplementary European search report has been established, the applicant must limit his application to the invention covered by the supplementary European search report.

The "principle" explicitly stated in CA/166/09 (point 8) that the EPO will only examine inventions it has searched is, of course, subject to the specific exception provided in Article 153(7) EPC, which gives the Administrative Council the discretion to dispense with a supplementary European search report. Currently

this discretion is only made use of in the case where an international search report or supplementary international search report has been drawn up by the EPO (OJ 2012, 212, paragraph 3(a)).

In the past limited use was made of the discretion to dispense with a supplementary European search report when the international search report was established by certain other International Searching Authorities (see B-II, 4.3.1). However, no such exception applied to the present case, for which a supplementary European search report was required and established. The basic principle expressed in CA/166/09 that the EPO only examines inventions it has searched therefore appears to be applicable to the present case.

- 3.5.4 A further chapter in the history of Rule 164 EPC began with the consultation document drawn up by the EPO, which the appellant annexed to the letter dated 16 September 2013. In this document, various disadvantages associated with the Rule 164 EPC were explained, and a proposal for amendment was set out.

Following this exercise, a proposal document (CA/PL 9/13) was submitted to the Committee on Patent Law for an opinion, which resulted in a proposal (CA/91/13) for amendment of the rule being submitted to the Administrative Council for a decision. This document also set out the perceived "drawbacks" to the operation of Rule 164 EPC. At its 137th meeting on 16 October 2013, the Administrative Council decided to adopt the proposal (see document CA/D 17/13). The new version of Rule 164 EPC will enter into force on 1 November 2014.

In the document CA/91/13, one of the reasons for the proposed amendment to Rule 164 EPC was explained in the following terms:

- "Under current Rule 164(1) EPC, if the application documents do not comply with the requirement of unity of invention a supplementary European search report is drawn up on those parts of the application which relate to the invention first mentioned in the claims. *Any further invention can be prosecuted by filing a divisional application only.*" (Point 10; emphasis added by the Board.)

Under point 11 of CA/91/13 it is explained that, according to the proposed amendment, this will no longer be the case, which "will put Euro-PCT users on the same footing as Euro-direct users".

This whole exercise, from consultation to final adoption of the amendments, leaves no room for doubt that the legislator's own interpretation of the operation of Rule 164 EPC is one in which the disadvantages of which the appellant complains do indeed arise, thus making an amendment of the rule necessary.

The appellant's position that Rule 164 EPC should be interpreted in a manner which does not entail such disadvantages is therefore not credible. If this were the case, then Rule 164 EPC would need no further amendment. Clearly the legislator does not share this view.

### 3.6 Arguments based on G2/92

3.6.1 The appellant bases a number of arguments on the opinion of the Enlarged Board of Appeal in case G 2/92, the headnote of which reads as follows:

- "An applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division under Rule 46(1) EPC cannot pursue that application for the subject-matter in respect of which no search fees have been paid. Such an applicant must file a divisional application in respect of such subject-matter if he wishes to seek protection for it."

3.6.2 The appellant argues that G 2/92 should be applied to Euro-PCT applications in relation to invitations for an additional search fee in the *international* phase, and the prohibition of G 2/92 therefore applies to an applicant who has failed to pay a requested further *international* search fee. However, if the relevant further international search fee *has* been paid, or if (as in the present case) no such further international search fee was ever requested, then no further prohibition according to G 2/92 is justified, and no invitation under Rule 164(2) EPC is appropriate.

The appellant recognizes that this may result in examination of an invention not covered by the supplementary European search report (if non-unity is raised at this stage), but argues that this is also consistent with G 2/92, as this opinion does not express "any preference for an EP search as opposed to some other kind of search".

3.6.3 The Board is entirely unpersuaded by these lines of argument.

Firstly, it is worth recalling that under EPC 1973 (which was in force when opinion G 2/92 was written), essentially the same procedure was followed for both Euro-direct applications and Euro-PCT applications found to lack unity of invention.

In particular, where an objection of lack of unity of invention was raised either in the European search report drawn up in accordance with Article 92 EPC 1973 (for a Euro-direct application), or in the supplementary European search report drawn up in accordance with Article 157(2) (a) EPC 1973 (for a Euro-PCT application), an invitation under Rule 46(1) EPC 1973 was issued (see Guidelines, edition of June 2005, B-VII, 2.4). In either case, if the applicant declined to pay a further search fee *when invited to do so by the EPO*, the procedure set out in opinion G 2/92 applied.

The same procedure applies under EPC 2000 for Euro-direct applications following an invitation under Rule 64(1) EPC.

However, the introduction of Rule 164 EPC changed the picture entirely for Euro-PCT applications, as Rule 164(1) EPC specifically excludes any invitation under Rule 64(1) EPC (corresponding to Rule 46(1) EPC 1973).

Opinion G 2/92 is concerned solely with the procedure following an invitation "*by the Search Division*" to pay further search fees. It is not concerned with the consequences of invitations made during the international phase, nor with questions of procedure in a case such as the present one in which no such

invitation was issued by the EPO, or even possible as a result of the operation of Rule 164 EPC.

Hence the appellant's suggestion that the Enlarged Board intended that opinions expressed in G 2/92 should cover the case of non-payment of further international search fees following an invitation by the International Searching Authority under Article 17(3) (a) PCT lacks any support in the text of the opinion and is, in the view of the Board, manifestly wrong.

In fact, opinion G 2/92 provides no direct guidance for the procedure to be followed in the case of Euro-PCT applications for which Rule 164 EPC applies, as in this case the essential precondition for applying G 2/92, i.e. an invitation by the Search Division to pay further search fees, is absent.

The appellant's contention that G 2/92 fails to express "any preference for an EP search" is also clearly incorrect. From the reference in the headnote (and elsewhere) to a request "by the Search Division under Rule 46(1) EPC", it is clear that G 2/92 is *solely* concerned with the procedure following a finding of non-unity and an invitation to pay further search fees in a search report drawn up under the European procedure, i.e. a European search report or a supplementary European search report.

- 3.6.4 The Board nevertheless takes the view that G 2/92, even if not *directly* applicable to the present case, sets out certain principles which are relevant. In particular, under point 2 the Enlarged Board states the following:



- "But if the Search Division considers...that the application as filed relates to more than one invention contrary to Article 82 EPC, the payment by the applicant of further search fees in respect of each further invention ensures that after receipt of the European search report, the applicant may put forward in the claims of that application, by way of amendment under Rule 86(2) EPC, whichever further invention he chooses for subsequent examination by the Examining Division, provided the respective fee has been paid so that the *European* search report has been drawn up with reference to such invention." (Emphasis added.)

Hence, an applicant may, according to G 2/92, opt for examination of any invention for which a *European* search report has been drawn up.

For Euro-PCT applicants in receipt of a supplementary European search report, the reference to the "European search report" can only refer to the *supplementary* European search report: in such a case there is no other "European search report".

It is the view of the Board, therefore, that opinion G 2/92 confirms the general principle that when a supplementary European search report has been drawn up, European examination must be limited to an invention covered by the supplementary European search report. Thus G 2/92, properly interpreted, supports the interpretation of Rule 164(2) EPC set out in the Guidelines.

- 3.6.5 It is also noted that the appellant's suggestion that the Examining Division should arrange, if necessary,

for additional searches without payment of further search fees runs entirely contrary to the principle set out under point 3 of G 2/92.

3.7 Alleged conflict with higher ranking law

3.7.1 The appellant argues that even if the Examining Division's interpretation of Rule 164(2) EPC is in line with the intention of the legislator, the provisions of this rule should nevertheless not be applied as they are contrary to higher ranking law. This higher law is constituted by the articles of the EPC (which prevail in case of conflict with the implementing regulations according to Article 164(2) EPC 1973) and/or the provisions of the PCT (which prevail over those of the EPC in the application of Part X of the EPC according to Article 150(2) EPC).

In the present case, as a direct result of the operation of Rule 164 EPC, the appellant was unable to prosecute the application on the basis of the second invention mentioned in the claims as identified in the supplementary European search report. This rule does not apply to Euro-direct applicants.

The Board therefore acknowledges that, in this respect, the appellant is at a disadvantage compared with a corresponding Euro-direct applicant. As noted above, the existence of such a disadvantage has also been recognized by the Administrative Council. The question is whether this disadvantageous treatment amounts to a contravention of higher ranking law.

3.7.2 Article 153(2) EPC requires that a Euro-PCT application (i.e. an international application for which the European Patent Office is a designated or elected

Office, and which has been accorded an international date of filing) shall be equivalent to a regular European application. Furthermore, such an application shall have the effect of a regular national (or European) application (Article 11(3) PCT and Article 45(1) PCT). According to Article 153(5) EPC, the Euro-PCT application shall be treated as a European patent application, and according to Article 27(1) PCT, national law shall not require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for under the PCT.

The appellant argues that these provisions require that Euro-PCT applications should not be treated less favourably than Euro-direct applications, and in particular should not be subject to the acknowledged disadvantage referred to above.

It has never been suggested by the appellant that the application of Rule 164 EPC leads to an inequality of *substantive rights* between Euro-direct applicants and Euro-PCT applicants. In particular, Euro-direct and Euro-PCT applicants have identical possibilities to seek protection for any number of inventions comprised in the application as filed by filing divisional applications.

The appellant's argument relates to an inequality of *procedural rights*, arising from an obligation which may be imposed on Euro-PCT applicants to file a divisional application when seeking protection for a particular invention, under circumstances in which a Euro-direct applicant could have pursued the invention in the existing application. The inequality therefore relates

to the extra cost and administrative burden of having to file a divisional application.

The only substantive legal effect of Article 11(3) PCT is the obligation of the PCT member states to recognize the international application as having the effect of a national application. In the present case, it has never been disputed that the application has the potential to achieve the full legal effects of a regular European patent application. In this sense it is equivalent to a regular European patent application (Article 153(2) EPC).

Similarly, Article 27(1) PCT merely obliges the member states to accept the "form and content" of a PCT application as being sufficient for starting application proceedings in a PCT member state, i.e. a PCT member state can not invalidate the accorded filing date or otherwise refuse an application on formal grounds once the national office proceeds to examine the formalities of the application in the national phase.

It is debatable whether the objections raised under Rule 164(2) EPC in the present case relate to "the form and content" of the application in the sense of Article 27(1) PCT, or merely concern the subsequent procedure to be followed in the national phase. However, even in relation to the "form or content" of applications entering the national phase from the PCT phase, Article 27(1) PCT only prohibits national law from imposing procedural requirements which are stricter than the corresponding PCT requirements ("different from or additional to those provided for in this Treaty and the Regulations").

Article 27(1) PCT is silent on requirements for purely national applications, and does not prohibit that national applications could be accorded a more favorable procedural regime. Indeed, Article 27(4) PCT explicitly confirms that where national law provides more favourable requirements concerning the form and content of national applications, these advantages may (but need not) be applied in case of PCT-applicants.

The appellant has also raised arguments based on Article 17(3)(b) PCT and Article 34(3)(c) PCT. These provisions set out measures which may be incorporated into national law to deal with the non-payment of additional fees requested by the International Searching Authority (or, as the case may be, by the International Preliminary Examining Authority) when such requests are considered justified. No such invitations were issued in the present case, and hence these provisions are not relevant.

In fact the Board does not believe that the provisions of "higher ranking law" cited by the appellant impose any limitations on national authorities in relation to the subsequent procedure for dealing with the question of unity of invention. Nor is it considered that by virtue of Article 153(2) EPC and Article 11(3) PCT applicants are guaranteed not only equal substantive rights but also completely identical procedures, whichever of the two routes they have chosen.

Differences of procedure are already inherent in, for example, the time limit for the entry into national phase (Article 22(1) PCT), and such non-identical procedures inevitably give rise to procedural and cost advantages and disadvantages. The concept of legal equivalence of Euro-direct and Euro-PCT applications

does not imply that a Euro-PCT applicant should never incur a greater financial burden to obtain the same protection as a Euro-direct applicant.

It has already been mentioned that the preparatory documents to the Administrative Council's decision to amend Rule 164 EPC as from 1 November 2014 explain this change as being occasioned, at least in part, by the procedural disadvantages facing Euro-PCT applicants in a case such as the present one. It is clear that these disadvantages are regarded as undesirable, and the decision to amend the Implementing Regulations is therefore a *policy decision* to try to reduce or eliminate them. There is no suggestion in the preparatory documents that the changes are required for compliance with the PCT or that the existing rules are in conflict with the PCT, and it will be apparent from the foregoing that this is also the opinion of the Board.

### 3.8 Arguments based on "equitable principles"

- 3.8.1 At the heart of the present appeal is the fact that, as a result of the operation of Rule 164 EPC, Euro-PCT applicants may be put at a disadvantage compared with Euro-PCT applicants under EPC 1973 and current Euro-direct applicants. The Board can therefore understand that the appellant feels somewhat unfairly treated.

However, even if it leads to a seemingly harsh outcome in a case such as the present one, the Board has already stated its view that the interpretation of the operation of Rule 164(2) EPC set out in the Guidelines is correct. It is consistent with the *travaux préparatoires* and with G 2/92, and is not in conflict with higher law. If the Board were to ignore the

correct interpretation of the law, and instead decide the case on what it considers fair or equitable, it would effectively be acting as a legislator.

The proper remedy for such inequitable treatment is an appropriate amendment to the EPC. The legislator has already decided to do this, and it is accepted by the appellant that the disadvantages referred to above will not arise under the amended version of Rule 164 EPC.

### 3.9 Rule 164(2) EPC: Conclusion

In the light of the above considerations, the Board judges that the Examining Division correctly applied Rule 164(2) EPC in inviting the applicant (now the appellant) to limit the application to one invention covered by the supplementary European search report.

Essentially the same conclusions concerning Rule 164(2) EPC were reached in T 1981/12 (Reasons, point 6.8(c)). In this regard, see also Singer/Stauder, *Europäisches Patentübereinkommen*, 6th edition, 2013, Article 82, note 31.

## 4. Rule 137(5) EPC

4.1 The application was refused under Article 97(2) EPC as it was considered to not to meet the requirements of two provisions of the EPC, namely Rule 164(2) and Rule 137(5) EPC. The text of Rule 137(5) is as follows:

- "Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive

concept. Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63".

#### 4.2 Applicability of Rule 137(5) EPC

The first question to be asked is whether Rule 137(5) EPC actually applies in cases such as the present one.

A thorough analysis of the functioning of Rule 86(4) EPC 1973 (which corresponds to the first sentence of Rule 137(5) EPC) was set out in T 708/00 (OJ 2004, 160), in which the "complementary roles" of Rule 86(4) EPC 1973 and Rule 46(1) EPC 1973 (corresponding to Rule 64(1) EPC) were pointed out. The following conclusion is reached in point 7 of the Reasons:

- "This means that Rule 86(4) EPC does not apply when the applicant has not paid the search fee in respect of a non-unitary invention relating to the originally filed claims in spite of being invited to do so under Rule 46(1) EPC. In this case, the application could not be examined further, and a divisional application would have to be filed if protection were sought (see the aforementioned opinion G 2/92)".

Under point 11 of T 708/00, the Board set out the appropriate reaction to an attempt by the applicant to amend the claims to cover an invention for which a search fee was invited but not paid as follows:

- "In view of the complementary nature of Rule 86(4) EPC and Rule 46(1) EPC as the latter must be interpreted according to the case law of the



Enlarged Board of Appeal, the amended claims should have been deemed inadmissible, since a further search fee was not paid in respect of the subject-matter of [an amended claim] as requested by the search division".

Two distinct and "complementary" cases are therefore identified in decision T 708/00:

- (a) cases where the originally claimed subject-matter *did not* form a single general inventive concept, with the consequence that an invitation under Rule 46(1) EPC 1973 (corresponding to Rule 64(1) EPC) was sent. If a further search fee was not paid in respect of a particular invention, then, following G2/92, this invention may not be pursued in the application and any amended claims directed to this invention should be deemed inadmissible.
  
- (b) cases where the originally claimed subject-matter *did* form a single general inventive concept, and hence all claims were searched. If amended claims are filed directed to another invention disclosed in the application (e.g. by importing material from the description) which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept, then Rule 86(4) EPC 1973 (corresponding to Rule 137(5) EPC, first sentence) applies.

The implication is that for Euro-direct applications, either Rule 64(1) EPC or Rule 137(5) EPC applies, but not both. Similarly under EPC 1973, for Euro-direct applications or Euro-PCT applications, either

Rule 46(1) EPC 1973 or Rule 86(4) EPC 1973 applied, but not both. The Board agrees with this analysis.

However, with the coming into force of Rule 164 EPC, a new possibility arose:

- (c) cases where the claimed subject-matter on which the supplementary European search report is to be based *did not* form a single general inventive concept, but for which, according to Rule 164(1) EPC, *no invitation was sent* and only the invention first mentioned in the claims was searched, with the consequence that a second or further invention may not be pursued in the application (Rule 164(2) EPC).

It must therefore be asked what the correct response of the examining division should be in the case that amended claims are filed which are directed to (or incorporate) a claimed invention which is unsearched as a result of the application of Rule 164(1) EPC?

In such a case it would clearly not be appropriate to apply the procedure outlined in case (a), above. This procedure is based on that set out in G 2/92, in which the Enlarged Board considered the case of an applicant who *had been invited to pay further search fees and chose not to*. As a result of this choice, "he cannot thereafter put forward that invention as the subject of the claims in that application" (Reasons, point 2). The provisions of Rule 164(1) EPC exclude the element of choice, and hence the preconditions for applying the approach of G2/92 do not exist in this case.

The question therefore is whether it would be appropriate to follow a procedure analogous to that of

case (b) by applying the provisions of Rule 137(5) EPC despite the fact that a lack of unity of invention has already been identified at the stage of drawing up the supplementary European search report.

In the decision T 708/00 the following approach to applying the provisions of Rule 86(4) EPC 1973 was developed:

- "amended claims may only be refused on the basis of this rule if the subject-matter of the claims filed originally and that of the amended claims is such that had all the claims originally been filed together, a further search fee would have been payable" (Reasons, point 8).

In effect, the Examining Division was invited to consider a *theoretical* set of claims comprising the originally filed claims plus the unsearched amended claims, and to ask whether such a set would comply with the requirements of unity of invention. If the answer was no, the provisions of Rule 86(4) EPC 1973 applied.

The Board believes that an essentially similar approach can be applied to the present case, except that here there is no requirement to resort to a theoretical set of claims, as claims covering the unsearched subject-matter were among the originally filed claims on which the supplementary European search report was based, in which the requirements of unity of invention were found not to be complied with.

The decision T 708/00 dealt with the case in which no invitation to pay a further search fee was made as the amended claims did not appear in the originally filed claims, although an invitation to pay a further search

fee *would* have been issued, and a further search fee *would* have been payable if the amended claims had been present in the originally filed claims.

The present decision is concerned with the case in which no invitation to pay a further search fee was made because it was precluded by the operation of Rule 164(1) EPC, although an invitation to pay a further search fee *would* have been issued, and a further search fee *would* have been payable under Rule 46(1) EPC 1973, which was in force at the time T 708/00 was issued.

In the view of the Board, the critical issue in deciding the procedure to be followed is *whether* the applicant has been invited to pay a further search fee, and not the particular reasons *why* an applicant was or was not thus invited.

In summary, if an applicant who files amended claims seeking protection for unsearched subject-matter has been invited to pay a further search fee for this subject-matter, then the case is dealt with according to the principles of G 2/92, as set out in paragraph (a), above. If the applicant has, *for whatever reason*, not been invited to pay a further search fee for the subject-matter, then an objection under Rule 137(5) EPC may legitimately be raised. This conclusion applies whether an invitation to pay a further search fee was not issued because the subject-matter did not appear among the originally filed claims, or because the conditions of Rule 164(1) EPC prevented it.

#### 4.3 Meaning of "unsearched subject-matter"

4.3.1 The Board is not persuaded by the appellant's argument that an invention which has been the subject of an

international search by an International Searching Authority cannot properly be described as "unsearched". What is at issue is not whether "some prior art searching has been performed", as contended by the appellant, but whether the invention is "unsearched" within the meaning of Rule 137(5) EPC, an implementing regulation which limits the choice of subject-matter which may be put forward by way of amendment for examination in the European procedure.

In discussing the requirements of Rule 164 EPC, the Board has already stated its view that, except in cases where the Administrative Council has specifically decided otherwise under Article 153(7) EPC, second sentence, it is a principle that the EPO will only examine inventions it has searched. It has been explained above why the Board concludes that this is the clear intention of the legislator, and that it may also be derived from the reasoning of the Enlarged Board in G 2/92.

It is clear, therefore, that the only interpretation of Rule 137(5) EPC which is consistent with this view is that, within the meaning of Rule 137(5) EPC, "unsearched" means "unsearched by the EPO" (at least according to the presently applicable legal framework, and acknowledging the discretion to make exceptions given to the legislator in Article 153(7) EPC, second sentence).

It has already been noted above that when a supplementary European search report is drawn up, this is the only search report issued by the EPO. In this case the term "unsearched subject-matter" within the meaning of Rule 137(5) EPC therefore means subject-

matter which has not been covered by the supplementary European search report.

It is consequently the view of the Board that where, following the drawing up of a supplementary European search report by the EPO, an applicant files amended claims seeking protection for subject-matter not covered by the supplementary European search as a result of the application of Rule 164(1) EPC, an objection under Rule 137(5) EPC should be raised.

#### 4.4 Rule 137(5) EPC applied to the present case

In the present case, the applicant was informed in the supplementary European search report that the application was considered to relate to three inventions represented respectively by claims 1-5 and 9-11 (first invention); claim 6, which was directly dependent on claim 1 (second invention); and claims 7 and 8, both directly dependent on claim 1 (third invention). The applicant filed amended claims in which claim 1 comprised the features of claims 1 and 6 as originally filed, in other words subject-matter corresponding to the second invention.

As a result, claim 1 of the application as refused by the Examining Division included subject matter which was not covered by the supplementary European search. This has never been disputed by the appellant.

Similarly, the appellant has never disputed the correctness of the finding that the claims on which the supplementary European search report was based related to three inventions which did not share a single general inventive concept, and therefore lacked unity

of invention, nor does the Board see any reason to question this finding.

Consequently, the claims as amended relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept, and hence the Examining Division was correct to raise an objection against these amendments under Rule 137(5) EPC.

5. Grounds for Refusal

5.1 The Board has stated its view that the Examining Division correctly applied the provisions Rule 164(2) EPC in inviting the applicant to limit the application to one invention covered by the supplementary European search report, and also correct to raise an objection against the amendments filed by the applicant under Rule 137(5) EPC.

However, this still leaves open the question whether either of these Rules provides a basis for refusing a European patent application according to Article 97(2) EPC.

5.2 Rule 164(2) EPC

According to Rule 164(2) EPC, where the examining division finds that the application documents fail to meet certain requirements, it shall invite the applicant to limit the application appropriately. Rule 164(2) EPC does not therefore constitute a definition of requirements to be met by a European patent application within the meaning of Article 97(2) EPC, but rather an instruction to the examining division

("it shall invite") on the procedure to be followed in cases where it considers that certain requirements have not been met.

As Rule 164(2) EPC represents a procedural instruction to the examining division, and not a requirement to be met by a European patent application, it follows that basing the refusal of the present application on Article 97(2) EPC in combination with Rule 164(2) EPC was incorrect. A similar conclusion was reached in decision T 1981/12 (*supra*, see 4.7 of the Reasons).

### 5.3 Rule 137(5) EPC

The Board notes that in decision T 1981/12 (*supra*) a doubt was also expressed whether Rule 137(5) could be an appropriate basis for refusing an application. The deciding Board in T 1981/12 concluded that, by reference to decisions T 708/00 and T 442/95, an amendment not complying with this rule was inadmissible (see 4.1 and 4.2 of the Reasons).

According to Article 97(2) EPC, a European patent application which does not meet the requirements of the EPC is refused unless "this Convention provides for a different legal consequence". Rule 137(5) EPC sets out a requirement to be met by amended claims of a European patent application, and neither in the Rule itself nor elsewhere in the EPC is any "different legal consequence" provided for the case where this requirement is not met. The Board therefore judges that a failure to meet the requirements of Rule 137(5) EPC is a ground for refusal of the application under Article 97(2) EPC.



This is also entirely consistent with the view taken in decision T 708/00. According to point 6 of the Reasons, Rule 86(4) EPC 1973 is regarded as having "the status of an administrative provision in the context of the search and grant procedures", as is "the case for the unity of invention requirement in general".

While the requirement of unity of invention set out in Article 82 EPC 1973 may properly be described as an "administrative provision in the context of the search and grant procedures", there is no question that failure to meet the requirements of this administrative provision may lead to the application being refused under Article 97(2) EPC in combination with Article 82 EPC 1973.

Rule 137(5) EPC corresponds to Rule 86(4) EPC 1973, and is therefore also an "administrative provision in the context of the search and grant procedures". Just as an application may be refused under Article 97(2) EPC in combination with Article 82 EPC, so an application may be refused under Article 97(2) EPC for failure to meet the requirements of Rule 137(5) EPC.

In this regard, Rule 137(5) EPC operates in the same manner as similarly worded provisions of the EPC. For example, Article 123(2) EPC stipulates that a European patent application "may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed".

Rule 137(5) EPC and Article 123(2) EPC both deal with amendments, and both employ precisely the same "may not" formulation.

If an examining division finds that the application documents on which the decision is to be based contain

subject-matter which extends beyond the content of the application as filed, the application will be refused under Article 97(2) EPC for failure to comply with Article 123(2) EPC. In an analogous manner, if an examining division finds that the application documents on which the decision is to be based contain amended claims which relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept, the application may be refused under Article 97(2) EPC for failure to comply with Rule 137(5) EPC.

Since the Board has already concluded that the application documents on which the contested decision was based did not satisfy the requirements of Rule 137(5) EPC, the Examining Division was correct to refuse the application under Article 97(2) EPC in combination with Rule 137(5) EPC.

6. Request for Referral to the Enlarged Board of Appeal

According to Article 112(1) EPC 1973, a board of appeal has the discretion either of its own motion or following a request from a party to the appeal to refer any question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law, or if a point of law of fundamental importance arises. If a board of appeal rejects a request, it shall give the reasons in its final decision.

A first point to be considered is whether the questions proposed for referral by the appellant, which concern the correct application of Rule 164(2) EPC, would

actually have a bearing on the outcome of the present case.

Although the Board has expressed the view that the application was properly refused on the basis of Article 97(2) EPC in combination with Rule 137(5) EPC, it can accept that, even if Rule 164(2) EPC is not a ground for refusal, in a case such as the present one the interpretation of Rule 137(5) EPC will be influenced by, and must be consistent with, the interpretation of Rule 164(2) EPC. Hence, the referred questions do have a bearing on the outcome of the case.

The appellant has not argued that a referral to the Enlarged Board of Appeal is necessary "in order to ensure uniform application of the law", nor could the Board see any justification for this. In what is considered to be the most relevant comparable case, the conclusion reached regarding the correct application of Rule 164(2) EPC was essentially the same as that of the present decision (see T 1981/12, Reasons, 6.8(c)). Even if in the present decision the applicability of Rule 137(5) EPC is seen differently (see point 5.3, sixth paragraph above), this does not affect the interpretation of Rule 164 EPC.

Instead, the appellant argues that a referral is required as the correct application of Rule 164(2) EPC is a point of law of fundamental importance, and that "this issue affects a significant number of Euro-PCT applicants".

In the decision T 26/88, referred to by the appellant, the Board rejected a request for referral to the Enlarged Board on the basis that a subsequent amendment to the Implementing Regulations (Rule 58 EPC 1973) had

been made, and that consequently "the problem which has been considered in the present Decision is likely to arise very rarely in future, and for this reason the question is in the Board's judgment not sufficiently important to justify such a referral".

The appellant's argument that a decision of the Enlarged Board of Appeal is still necessary because an amendment of Rule 164 EPC has not yet taken place, no longer holds. It was noted above that a version of Rule 164(1) EPC which the appellant accepts will remove the disadvantageous effects of the present version has been adopted by the Administrative Council (albeit only the day before this decision, and obviously after the appellant submitted its arguments). The new version will apply to any application for which a supplementary European search report has not been drawn up at the date of its entry into force on 1 November 2014.

If a referral were made, it is not reasonable to imagine that the decision of the Enlarged Board would be issued before the coming into force of the new rule. For all applications for which a supplementary European search report will be drawn up from 1 November 2014, the decision of the Enlarged Board would no longer be relevant.

It cannot therefore be accepted that there is any significant general interest in having the referred questions answered, as a decision of the Enlarged Board on this matter would affect only a relatively small number of applicants for a limited period of time, after which it would become obsolete. The referred questions do not, therefore, relate to a point of law of fundamental importance.

Furthermore, the Board has reached its decision based, at least in part, on what it believes to be the correct interpretation of opinion G 2/92, and it has no reason to believe that the Enlarged Board has modified its views on this matter in the meantime. Consequently, it is not seen that any referral is necessary in order to decide the case.

7. Comment

Although the Board has not felt able to grant any of the appellant's requests, this does not mean that it regards the complaints underlying the present appeal as being trivial or specious. Significant disadvantages do indeed exist for certain Euro-PCT applicants under the present version of Rule 164 EPC.

In the present case the appellant, in order to seek protection for the subject-matter of claim 1 as refused in the present application, was obliged to file a divisional application (published as EP 2 500 897 A) prior to the expiry of the relevant time-limit mentioned in Rule 36(1) EPC. The filing fee, designation fees and six outstanding renewal fees were duly paid, amounting to well over €5000. None of these fees would have been required if the appellant had been permitted to pursue the second invention in the present application.

While the Board can accept that this situation is regrettable, it is nevertheless a consequence of the correct application of the EPC. The fact that situations such as this will not arise under the amended version of Rule 164(1) EPC to come into force on 1 November 2013 will presumably be welcomed by the

appellant, but this development obviously comes too late to have any bearing on the present case.

It is perhaps worth pointing out, however, that the divisional application referred to above was filed at the EPO and the fees paid before the filing of the present appeal. The Board has no power to order a refund of these fees, nor any power to order a reimbursement of any other costs incurred by the appellant in the drafting and filing of the divisional application. Hence, the Board could not have remedied the material disadvantages of which the appellant complains even if it had decided differently.

## Order

### For these reasons it is decided that:

1. The request for referral of questions to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated