



Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Rule 164 EPC as from 1.11.2014

Non-unity and unsearched inventions
upon entry into the European phase



Contents

New procedures under amended R. 164 apply as of 1.11.2014

- Reasons for the revision of R.164
PCT Strategy of the EPO
- Procedure under amended R.164(2)
EPO acted as (S)ISA in the international phase
- Procedure under amended R.164(1)
EPO did not act as (S)ISA in the international phase
- **Overview of new procedures:**
Notice of the EPO, OJ EPO 2014, A70

Reasons for the amendment of R. 164

- Since entry into force of EPC 2000 in 2007 users have requested reconsideration of R. 164
R.164 considered “unfair” compared to the procedure under R. 64 for Euro-direct applications
- Problem: if non-unity is found upon entry into the European phase
→ *no further searches*
- Only possibilities:
 - Filing divisional applications to obtain a search and to pursue the (further) inventions
 - Paying (all) additional search fees in the international phase, if EPO acted as (S)ISA

PCT Strategy – Equal Service Levels

- Reconsideration of R. 164 in the light of the EPO's PCT Strategy
 - Enhancing the PCT system; in particular the Euro-PCT route
 - Establish Equal Service Levels for the Euro-direct and the Euro-PCT route
- Equal Service Levels principle (“linked to” Art. 150(2) EPC)
 - Alignment of practice and procedures before the EPO under the EPC and the PCT
 - To improve the efficiency and the quality of the procedures before the EPO
 - Within the limits set by the law and with due respect to the character of the procedures

EPO acted as (S)ISA

**Non-unity and unsearched inventions
upon entry into the European Phase**

Old procedure under R. 164(2) (until 31.10.2014)

- EPO = (S)ISA → Supplementary European search report dispensed with
- Inventions not searched by the EPO in the international phase (non-payment of additional search fees)
 - Could not be pursued in the European phase in the application itself
 - Could only be pursued by filing a divisional application
- Same applied to inventions not searched by EPO acting as SISA

New procedure: invitation to pay search fees (R. 164(2) EPC)

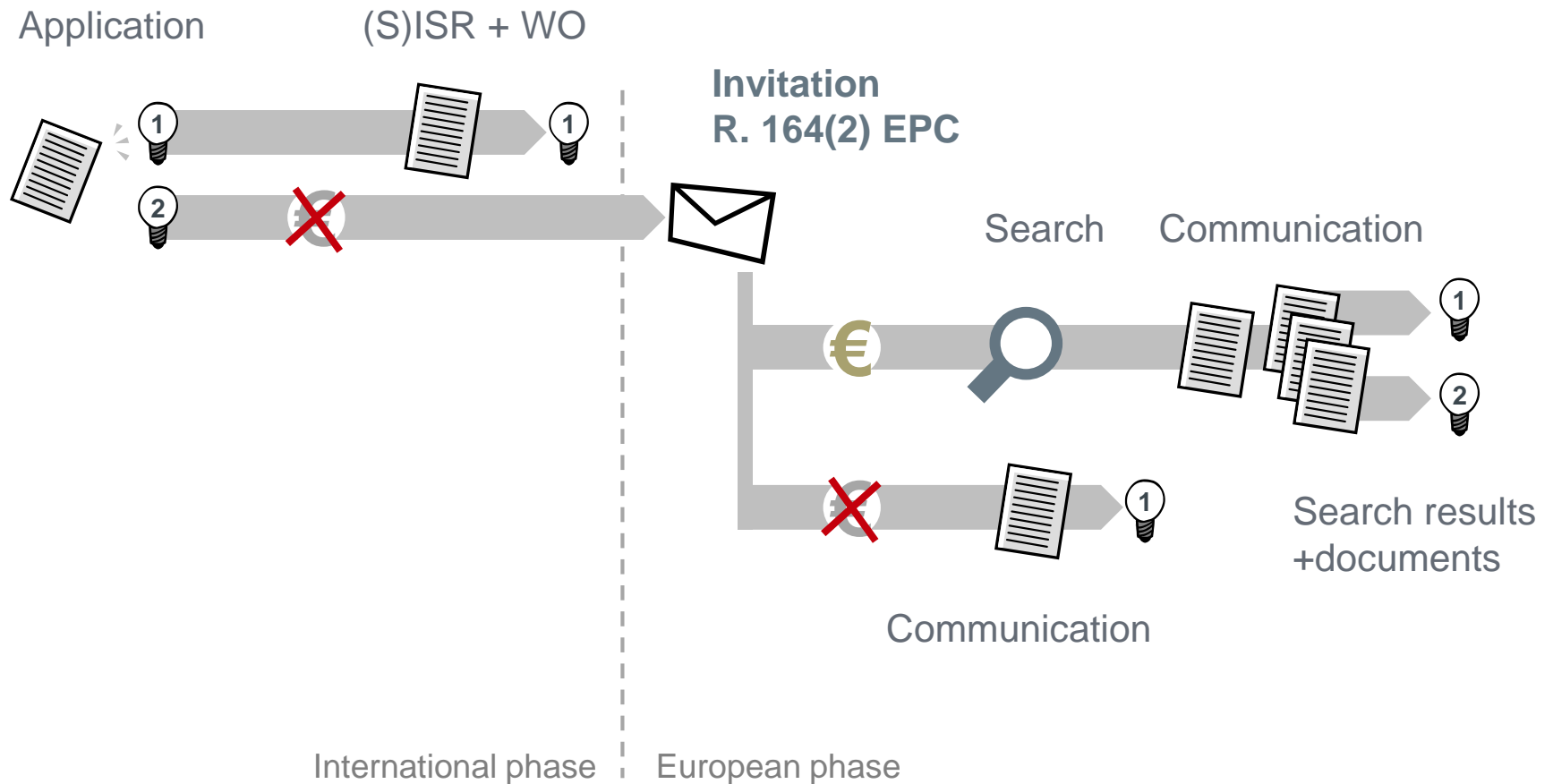
If inventions not searched by the EPO in the international phase persist in the claims in the European phase:

- **Invitation to pay a search fee for each unsearched invention**
Within time limit of 2 months (R. 164(2)(a))
- Invitation sent before a "normal" communication (GL C-III, 2.3)
- Based on the claims on file upon expiry of R. 161(1) EPC time limit (GL C-III, 2.3)
- No invitation if:
 - All inventions claimed but not searched in international phase are deleted before
 - All inventions claimed were searched in the international phase

Search fees paid under Rule 164(2) EPC (1)

- EPO **searches** inventions paid for
- Search results issued as an **annex**:
 - R. 164(2)(b)
 - to “normal” examination communication – R. 71(1)(2) **or**
 - to invitation to approve text for grant – R. 71(3)
- **Cited documents** accompany above communication

Payment of a search fee under R. 164(2)



Search fees paid under Rule 164(2) EPC (2)

The communication under Rule 164(2)(b) provides:

- Objections to all inventions claimed that have been searched by the EPO either in international or European phase (GL C-III, 2.3)
- Request to delete all inventions in the claims which were not searched in the international or European phase (R. 164(2)(c), GL C-III, 2.3)
- Unity objection, where applicable, with request to select a searched invention, by deleting the others (R. 164(2)(c), GL C-III, 2.3)
- An exception (“lex specialis”) to R. 137(3) EPC allowing (further) amendments to the application (GL H-II, 2.3)

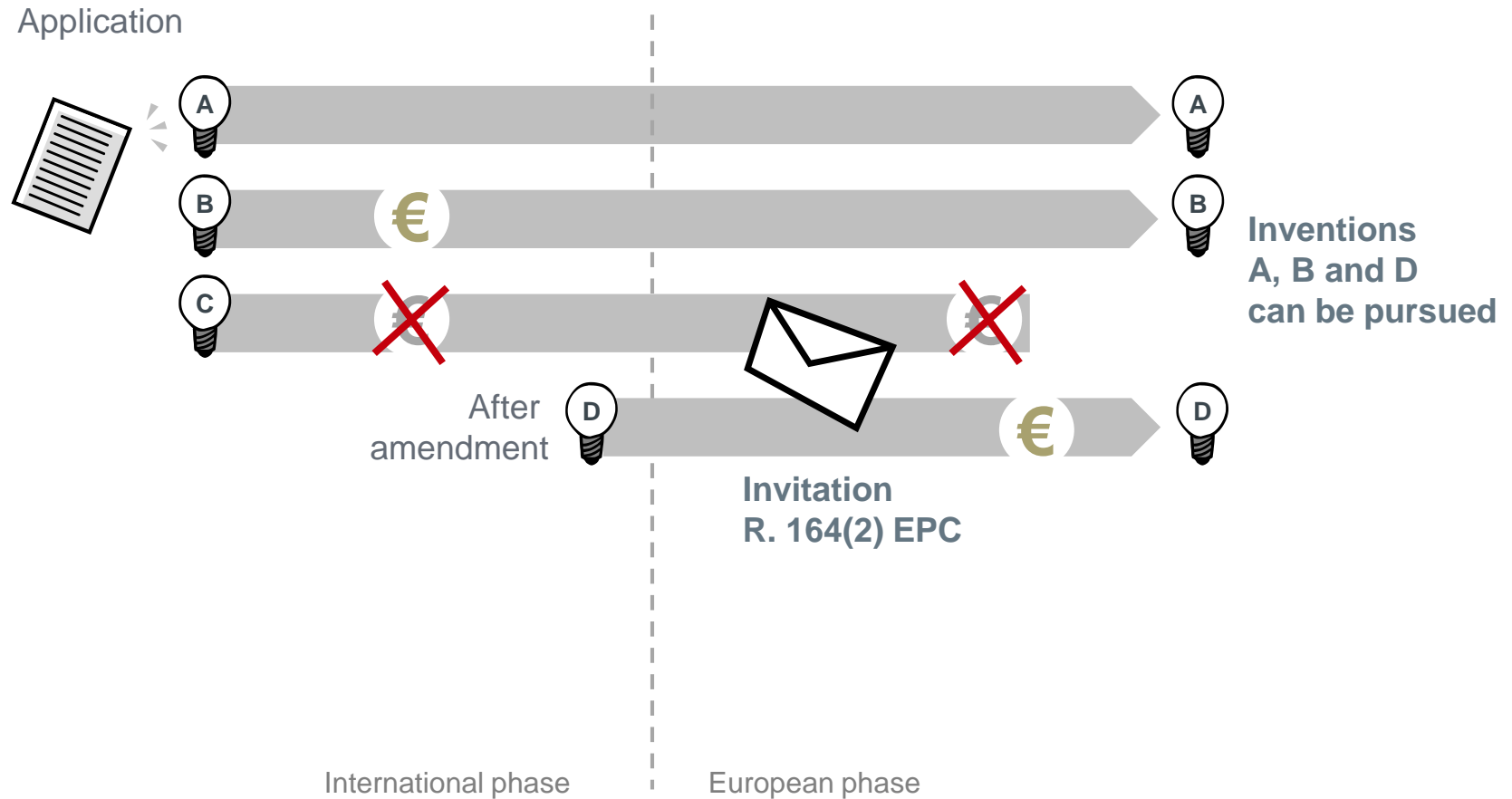
Special cases where an invitation is issued

- For unsearched inventions from a **cascade** found by the EPO in the international phase (GL C-III, 2.3)
- For an invention **imported from the description** (GL F-IV, 13.1(iv))
Only if imported into the claims before expiry of R. 161(1) time limit
- Invitation based on main request (GL C-III, 2.3) - **no invitation for inventions in auxiliary requests**
- Claims suffering a **severe lack of clarity** (Art. 84)
 - EPO sends a normal communication raising clarity (R. 71(1),(2))
 - Clarified claims filed, revealing an unsearched invention
 - No invitation under R. 164(2) is issued (GL C-III, 2.3)

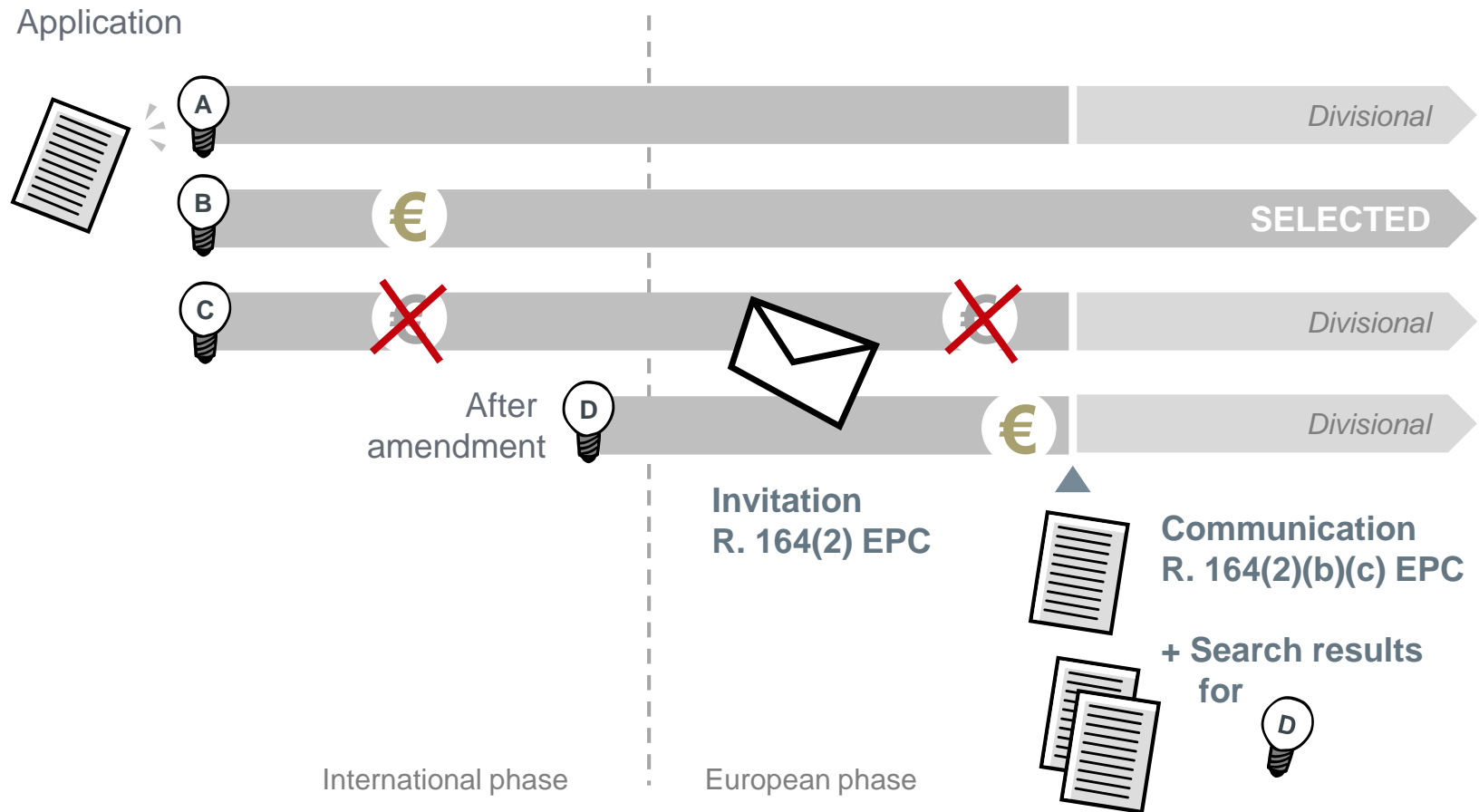
Example under new Rule 164(2) EPC

- EPO acted as ISA and non-unity found → two further inventions B and C
Additional search fee paid for invention B only (R. 40.2 PCT)
- **European phase**
 - The (amended) application documents claim inventions A, B, C plus D,
D is taken from the description
 - Dispensation with supplementary European search report => “direct” start of examination
- Invitation to pay a search fee for inventions C and D
 - Payment of search fee for invention D only
 - In the (parent) application the applicant can pursue invention A, B, or D
 - If the applicant selects invention B => inventions A, C, and D may be pursued in a divisional application

Example Rule 164(2) EPC



Example Rule 164(2) EPC



EPO did not act as (S)ISA

Non-unity in the European Phase

Old procedure (until 31.10.2014)

Lack of unity found in supplementary European search:

- Only a single invention - the first invention in the claims – was **searched**
- No invitation to pay further search fees was issued
- Thus, only the first invention in the claims could be pursued in **examination**
- All other inventions were to be deleted
But divisional applications were possible

New procedure: invitation to pay further search fees (R. 164(1) EPC)

- Supplementary European search is not dispensed with
- If the claims lack unity, the procedure is analogous to the procedure under R. 64 for a European application:
 - A partial search report on first invention is sent (R. 164(1)(a))
 - With an invitation to pay further search fees (R. 164(1)(b))
 - Partial search report is not accompanied by a an ESOP (B-XI, 5)
- Basis for the invitation are the claims on file upon expiry of period under R. 161(2)
- EPO assessment of unity requirement is independent of ISA finding (B-VII, 2.3)

Further search fees paid – Rule 164(1) EPC

- Time limit: <2 months from invitation
- No fee reductions apply to further search fees
- Supplementary European search report issued on all inventions paid for
- Accompanied by ESOP, containing:
 - all relevant objections to invention first mentioned in claims
 - all relevant objections to all other inventions searched by EPO
 - a unity objection
- Applicant must then reply to ESOP (R. 70a)
- Only inventions searched by the EPO can be pursued in examination
 - Decision G 2/92

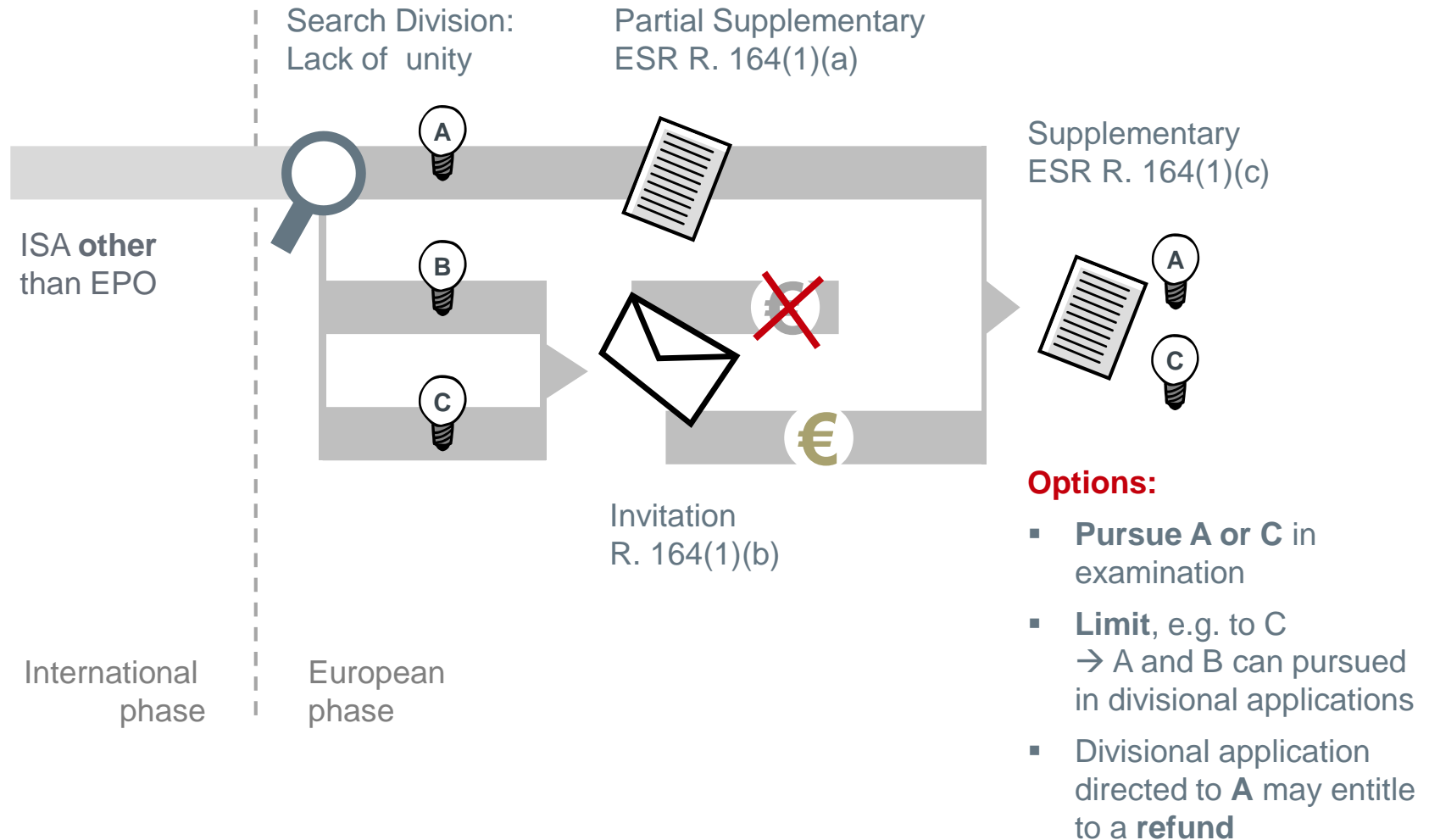
Example under new Rule 164(1) EPC (1)

- An ISA other than the EPO, e.g. the USPTO, established the ISR
- The EPO did not act as (S)ISA for the application

European phase

- The Search Division identifies a lack of unity e.g. an invention A, first mentioned in the claims, and two further inventions B and C
- A partial supplementary European search report for invention A is drawn up (R. 164(1)(a))
- It is issued together with an invitation to pay a further search fee for each of the inventions B and C (R. 164(1)(b))
- The applicant pays a further search fee for invention C
- A supplementary European search report is drawn up for inventions A and C (R. 164(1)(c))

Example under new Rule 164(1) EPC (1)



Example under new Rule 164(1) EPC (2)

Options for the applicant:

- The applicant can pursue invention A or C in examination
- If the applicant limits the application, e.g. to invention C, inventions A and B can be pursued in divisional applications
- A divisional application directed to invention A may entitle the applicant to a refund under Art. 9(2) RFees

Thank you for your attention!