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**Datasheet for the decision
of 24 September 2013**

Case Number: T 1981/12 - 3.2.03
Application Number: 05856008.7
Publication Number: 1963760
IPC: F25B 41/00, F25B 49/00,
F25B 41/06
Language of the proceedings: EN

Title of invention:

High side pressure regulation for transcritical vapor
compression

Applicant:

Carrier Commercial Refrigeration, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 33(1)(b), 82, 106(1), 153(6), 153(7)
EPC R. 64(1), 137(5), 164(1), 164(2)

Relevant legal provisions (EPC 1973):

EPC Art. 177
EPC R. 46(1), 86(4), 112

Keyword:

"Subject matter searched in international phase to be
considered as searched in European phase (no)"
"Additional search (no)"
"Remittal (yes)"
"Reimbursement of appeal fee (no)"

Decisions cited:

G 0002/92, J 0003/09, T 0442/95, T 0631/97, T 0708/00,
T 0274/03, T 0915/03, T 0141/04, T 1242/04, T 0264/09,
T 1285/11, T 2495/11,

Catchword:

1. Claims whose subject matter has not been covered by a search report drawn up by the EPO will not be examined by the EPO for novelty or inventive step (Points 5.3, 5.4)

2. Where subject matter is covered by a search report drawn up by an ISA other than the EPO in the international phase but is not covered by the supplementary search report drawn up by the EPO in the European phase in the application of Rule 164(1) EPC, the subject matter is not to be regarded as covered by a search report for the purposes of Rule 164(2) EPC (Points 6,7 and 8).

3. Where on entering the European phase the application documents are considered by the EPO not to meet the requirements of unity, with the result that a supplementary European search report is drawn up on only those parts of the application which relate to the invention first mentioned in the claims (Rule 164(1) EPC), the applicant is not entitled to have a further search report drawn up to cover the other invention or inventions (Point 9).



Case Number: T 1981/12 - 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 24 September 2013

Appellant:
(Applicant)

Carrier Commercial Refrigeration, Inc.
9300 Harris Corners Parkway
Charlotte, NC 28269 (US)

Representative:

Taylor, Adam David
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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 23 April 2012
refusing European patent application No.
05856008.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: U. Krause
Members: C. Donnelly
K. Garnett

Summary of Facts and Submissions

- I. The applicant (hereafter: the appellant) appeals against the decision of the Examining Division dated 23 April 2012, refusing the European patent application No.05856008.7.
- II. The application was filed as a PCT application with the US Patent Office (US 2005/047528) on 30 December 2005. In the international search report and the international examination report issued by US Patent Office the claims were variously considered to lack either novelty or inventive step; however, no objection of lack of unity was raised, so that all claims were searched.
- III. The application entered into the European phase on 19 October 2007 with an amended set of claims.
- IV. In the supplementary European search report and the European search opinion dated 8 February 2011 the applicant was notified *inter alia* that the application was considered to lack unity *a posteriori* in the light of D1 (EP 1 462 740, considered to be novelty destroying for claim 1): six inventions were considered to be embodied in the claims as filed. The supplementary European search report had therefore been drawn up only on those parts of the application which related to the first invention, namely Claims 1 - 4, 7, 12 (applying Rule 164(1) EPC). It was said that the applicant should limit the application to the invention searched by the EPO, and that those parts of the application relating to the other inventions should be excised. The applicant was told that those parts might

be made the subject of one or more divisional applications.

V. The applicant did not take up the suggestion to limit the application and on 7 September 2011 filed a request to proceed with examination of the application, together also with a reasoned reply to the search opinion and amended claims. Claim 1 was now based on claims 1 and 4 as originally filed with the PCT application and corresponded to claims 1 and 6 as filed on entry into the European phase. It was argued *inter alia* that there was no lack of unity and that all claims, including claim 4, had been searched as part of the international search report, which is all that was required under Rule 164(2) EPC.

VI. By a communication pursuant to Article 94(3) EPC dated 11 October 2011 the applicant was notified by the Examining Division that the amendments were considered to relate to non-unitary and non-searched subject matter. Claim 1 now covered invention No. 3, which had not been covered by the supplementary European search report, since no search report had been drawn up on claim 6. The applicant had thus introduced unsearched subject matter into claim 1 and Rule 137(5) EPC was thus infringed. The Examining Division disagreed with the applicant's interpretation of Rule 164(2) EPC.

VII. In the course of further exchanges with the Examining Division the applicant filed first and second auxiliary requests.

VIII. In its decision made according to the state of the file and posted on 23 April 2012, the Examining Division

refused the application. The main request was refused on the basis that it infringed Rule 137(5) EPC. The first auxiliary request was refused for non-compliance with Article 123(2) EPC and also Rule 137(5) EPC. The second auxiliary request was refused for non-compliance with Articles 123(2) and 84 EPC.

IX. Because the applicant argues that the decision is subject to two separate substantial procedural violations, it is necessary to set out the above history in greater detail, as follows:

7 September 2011: Request to proceed with examination on basis of amended claims (see point V, above).

11 October 2011: Article 94(3) EPC Communication with Rule 137(5) objections. Rule 164(2) EPC said to be misinterpreted by the appellant.

7 November 2011: Reply to Examination Report, repeating the argument on Rule 164(2) EPC.

1 December 2011: Summons to oral proceedings with annexe. Objections in communication of 11 October 2011 maintained and considered not to be answered by reply filed on 7 November 2011

23 January 2012: Response to summons to oral proceedings. First and second auxiliary requests filed.

15 February 2012: Telephone conference with Examiner.

15 February 2012: Appellant withdraws request for oral proceedings, asks for report of telephone conference and requests decision on the basis of the file.

24 February 2012: "Result" of telephone conference on 15 February 2012 sent to appellant, recording that the objections to main request in the communications of 11 October and 1 December 2011 were maintained by the Examining Division; that there were objections to the first auxiliary request under Articles 123(2), 84 EPC and Rule 137(5) EPC (further unsearched subject matter) and to the second auxiliary request under Articles 123(2) and 84 EPC. In both these latter cases, these objections were spelt out.

23 April 2012: Decision according to the file, referring only to "communications" dated 11 October 2011 and 15 February 2012 and the reasons therein, and stating that no comments or amendments had been filed in reply to "the latest communication."

- X. On 25 May 2012 the applicant filed a notice of appeal against the decision, paid the appeal fee and also filed a statement of grounds of appeal together with a main and two auxiliary requests. The requests corresponded to the requests refused by the Examining Division. The appellant argued not only that the decision was wrong but also that it was subject to two substantial procedural violations.
- XI. In its communication sent with the invitation to oral proceedings on 28 January 2013 the Board indicated that it provisionally agreed with the decision of the

Examining Division and also commented on further aspects of the appeal.

XII. The appellant filed submissions in answer with its letter dated 10 May 2013 together with modified requests. The main request was amended to address a novelty objection raised by the Board; the first and second auxiliary requests were amended to address objections raised by the Board under Article 123(2) EPC.

XIII. Oral proceedings were held on 16 July 2013. The appellant's requests were that:

(a) The decision under appeal be set aside and a patent be granted on the basis of the main request, alternatively the first or second auxiliary requests, all as filed with the letter dated 10 May 2013. The appellant further requested that the opening words of claim 1 of the requests be amended to "A transcritical CO₂ refrigeration system ..." if this was required to overcome any objection under Article 123(2) EPC.

(b) The appeal fee be reimbursed.

XIV. *The claims according to the requests.*

(a) Claim 1 according to the main request reads:

"A transcritical refrigeration system comprising:
a compressor (22) for driving a refrigerant along a
flow path (82;142) in at least a first mode of system
operation;

a first heat exchanger (24) along the flow path downstream of the compressor in the first mode; a second heat exchanger (28) along the flow path upstream of the compressor in the first mode; and a pressure regulator (88,92;148,152) in the flow path downstream of the first heat exchanger (24) and upstream of the second heat exchanger (28) in the first mode,

characterised in that the pressure regulator comprises a non-valve fixed orifice expansion device (88;148) in series with a parallel combination of a solenoid valve (90;150) and bypass conduit (86;146) including a fixed expansion device (92;152)."

(b) Claim 1 according to the first auxiliary request reads:

"A transcritical refrigeration system comprising: a compressor (22) for driving a refrigerant along a flow path (102;122;142) in at least a first mode of system operation; a first heat exchanger (24) along the flow path downstream of the compressor in the first mode; a second heat exchanger (28) along the flow path upstream of the compressor in the first mode; and a pressure regulator (108,110;124,128;148,150,152) in the flow path downstream of the first heat exchanger (24) and upstream of the second heat exchanger (28) for regulating pressure at the first heat exchanger (24) in the first mode, characterised in that the pressure regulator comprises a series combination or a parallel combination of a first fixed orifice expansion device (108;126;148) and

a solenoid valve (110;124;150) that combines aspects of a solenoid valve and a fixed expansion device."

(c) Claim 1 according to the second auxiliary request reads:

"A transcritical refrigeration system comprising:
a compressor (22) for driving a refrigerant along a flow path (102;122;142) in at least a first mode of system operation;
a first heat exchanger (24) along the flow path downstream of the compressor in the first mode;
a second heat exchanger (28) along the flow path upstream of the compressor in the first mode; and
a pressure regulator (108,110;124,128;148,150,152) in the flow path downstream of the first heat exchanger (24) and upstream of the second heat exchanger (28) for regulating pressure at the first heat exchanger (24) in the first mode,
characterised in that the pressure regulator comprises:
a first branch (104;146); and
a second branch (106;144) parallel with the first branch,
wherein a fixed orifice expansion device (108;152) is located in the first branch; and
wherein a solenoid valve (110;150) that combines aspects of a solenoid valve and a fixed expansion device is located in the second branch."

XV. After hearing argument on the appellant's main request, which centred on the interpretation of Rule 164(2) EPC, the Board indicated that it had not yet reached a conclusion on the issue but wished to continue with a discussion of the appellant's other requests. This was

done (see the minutes of the oral proceedings). The debate was then closed and the proceedings ordered to be continued in writing.

XVI. So far as relevant to the Board's decision, the appellant's arguments as set out in writing and as developed at the oral proceedings can be summarised as follows:

Main request

- (a) The appellant made clear at the oral proceedings before the Board that it did not dispute that the Examining Division's decision on lack of unity was correct. However, even given this and even assuming that the Examining Division's interpretation of Rule 164(2) EPC was correct, all of the claims as filed on entry into the European phase should nevertheless have been searched and the failure to do so was not in accordance with the EPO Guidelines on Examination. A very narrow approach had been adopted which was inconsistent with the Guidelines, since the "underlying concept" was not taken into consideration.

- (b) In the circumstances of the present case, according to the wording of Rule 164(2) EPC an applicant is entitled to pursue one invention as covered by either the international search report or the supplementary European search report. Here, the claims of all the requests were covered by the international search report.

- (c) This interpretation of the rule is supported by the *travaux préparatoires* to the rule (CA/PL 17/06). This document indicates that the rule should be interpreted as meaning that the applicant is entitled to pursue claims relating to "one invention" as per the international search report even if the later supplementary European search report raises a new lack of unity objection so that not all claims are searched in the European phase. CA/PL 17/06 does not suggest that the international search report should be ignored, with further proceedings based only on the supplementary European search report. While there may be some ambiguity about the word "or" in the rule (caused by the extraneous use of the phrase "as the case may be"), no such ambiguity is present when the rule is interpreted in accordance with CA/PL 17/06.
- (d) CA/PL 17/06 also states that the new rule does not involve any loss of rights, i.e., no loss of rights as compared to the situation under the EPC 1973. This will only be the case if an applicant is permitted to pursue claims covered by the international search report. Otherwise, the applicant will have been deprived of the right (a) to select an invention to pursue after a unity objection is raised in the European phase and (b) to have further inventions searched after a unity objection is raised, these being rights which an applicant had under the EPC 1973, even where the EPO disagreed with the International Search Authority ("ISA") about the question of unity.

- (e) More particularly, under the EPC 1973 an objection of lack of unity raised for the first time in the European phase would have resulted in a partial supplementary European search report and an invitation to pay additional fees in accordance with Rule 46(1) EPC 1973. Hence the applicant would never have been faced with an objection of lack of unity leading to unsearched claims unless the applicant had also had the opportunity of paying additional search fees. If it is correct that Rule 64(1) EPC cannot require the supplementary European search report to include an invitation to pay further search fees, the international search report must take the place of the supplementary European search report in terms of defining an invention that has been "searched" within the meaning of Rule 164(2) EPC.
- (f) CA/PL 17/06 states that the new rule will bring "the Euro-PCT procedure in line with the Euro-direct procedure." The relevant aspect of the change is the removal of the opportunity to have a further search. From this the implication is that an applicant should have a single opportunity to pay additional search fees for a Euro-PCT application, i.e., during the international search phase. Here the applicant has never had the opportunity to pay further search fees. In the Euro-direct procedure the Search Division cannot require limitation of the claims on a finding of lack of unity but must give the applicant the opportunity to pay further search fees. If the lack of unity is not uncovered during search but only by the Examining Division, then an applicant

is not prevented from pursuing claims that are considered to lack unity with the first claim. An applicant should therefore not be prevented from pursuing claims which were not the subject of a lack of unity objection in the international search report. The primary search stage for a Euro-PCT application, and identification of lack of unity, should occur in the international phase, and it is not to be repeated in the regional phase. Logically, it follows that there is not a further point at which an objection of lack of unity can be raised to prevent an applicant from pursuing an "unsearched" invention. Under Rule 164 EPC the supplementary search becomes equivalent to a part of the Euro-Direct examination procedure.

- (g) The effect of the G 2/92 (OJ EPO 1993, 591), which is explicitly referred to in CA/PL 17/06, is that in order for an applicant to be barred from pursuing subject matter that has not been searched, he should have failed to pay the relevant search fee. Where there has been no opportunity to pay additional search fees, then unsearched subject matter cannot arise. If the EPC does not permit the payment of further search fees in the European phase then it means that the opportunity to prevent an applicant from pursuing unsearched subject matter arises only in the international phase. It is inconsistent with G 2/92 and out of line with the Euro-direct route if an objection of lack of unity can be raised and the applicant barred from pursuing certain claims without the applicant having had the opportunity of having the further inventions searched.

- (h) The amendment to Rule 164(2) EPC following the introduction of international supplementary search reports confirms this interpretation. If the effect of the original wording is that the supplementary European search report had the ability to supersede the international search report, then it must be the case that any international supplementary search report would supersede the international search report, which cannot be correct, and would require the EPO to consider any international supplementary search report ahead of even a European international search report. The wording "as the case may be" can only mean that subsequent search reports may be taken into consideration in cases where they exist and not that they supersede the international search report in some way.

- (i) Under Rule 164 EPC and the *travaux préparatoires* no primacy is given to the European search report. It was the intention of the rule that the scope of searched matter should be the combined scope of both the international search report and the supplementary European search report.

- (j) Alternatively, if the Examining Division's interpretation of Rule 164 EPC is correct then in order for there not to be any loss of rights it is necessary that the partial supplementary European search report include an invitation to pay additional search fees. This would simply require Rule 64(1) EPC to be applied in the same way as Rule 46(1) EPC 1973 was applied in the past. There

was no change in wording when Rule 46(1) EPC 1973 was transposed into Rule 64(1) EPC and no indication in the *travaux préparatoires* that a change in practice was intended.

First Auxiliary Request

- (k) The appellant accepted that if its arguments in respect of the main request failed, such that this request was not allowable, then the same followed for the first auxiliary request.

Second Auxiliary Request

- (l) The issues relating to Rules 137(5) and 164 EPC which arise in relation to the main and first auxiliary requests do not apply to the second auxiliary request, since all the claims of this request were searched on entry into the European phase. As to the objection which had been raised against this request under Article 123(2) EPC, this had been overcome by the amendments to claim 1 filed with letter of 10 May 2013. As to the objection which had been raised under Article 84 EPC, the claim (also as now amended) was clear for the skilled person.

Request for reimbursement of the appeal fee

- (m) The first complaint is that a substantial procedural violation was committed because the decision was not sufficiently reasoned. The decision, which was based on the state of the file, refers to the "communications" dated 11 October

2011 and 15 February 2012 and the reasons therein, and states that no comments or amendments had been filed in reply to "the latest communication." There was no communication of 15 February 2012 (only a telephone conversation between the representative and the examiner) so the only relevant communication was that of 11 October 2011, i.e., the first examination report. Reasoned replies had been made to this (on 7 November 2011 and 23 January 2012), but this reasoning is not referred to in the decision, in particular the arguments based on the *travaux préparatoires* and the amendment to Rule 164(2) EPC (see points XVI(c) - (h), above). A decision on state of the file using Form 2061 was not appropriate in this case to deal with the appellant's arguments or to make it clear to the appellant and the Board what the reasons were.

- (n) The second complaint is that even if the decision can generously be interpreted to include the communication of 1 December 2011 and the report of the telephone conference dated 24 February 2012, these documents make no reference to the appellant's submissions based on the amendment to Rule 164 EPC which were raised on the letter of 23 January 2012.

Reasons for the decision

1. The appeal is admissible.

2. *The main and first auxiliary requests - introductory matters*
 - 2.1 Although the appellant has criticised the reasoning of Examining Division's decision in various respects, the grounds for the refusal of the application are reasonably clear. On entering the European phase the Search Division took the view that the application was non-unitary. Pursuant to Rule 164(1) EPC the supplementary European search report which was drawn up therefore covered only those parts of the application which related to claims 1 to 4, 7 and 12, i.e., corresponding to the first invention claimed. Consistently with Rule 164 EPC, no invitation was issued to pay further search fees. Claim 1 of the final version of the main request before the Examining Division corresponded to claims 1 and 6 as filed on entry into the European phase. This claim was considered by the Examining Division to relate to non-unitary and unsearched subject matter. It therefore infringed Rule 137(5) EPC. The auxiliary requests suffered from the same and additional objections (see point VIII, above). The application as a whole was therefore refused under Article 97(2) EPC.

 - 2.2 So far as concerns the Rule 164(2) point, claim 1 of the main request now before the Board of Appeal does not differ in any relevant respect to the claim 1 of the main request before the Examining Division. Before the Board the appellant did not dispute that claim 1 of

this request related to unsearched subject matter in the sense that it related to matter not covered by the supplementary European search report. Nor did the appellant dispute that the claims related to non-unitary subject matter. The same was true of the first auxiliary request.

3. *Extent of the supplementary European search*

3.1 Before turning to the main issue in the appeal it is convenient to deal with one of the appellant's subsidiary arguments. This was that the Guidelines for Examination were not followed by the EPO when conducting the search. It was argued that even if the claims were non-unitary, all claims should nevertheless have been searched since the Guidelines provided that:

"Although lack of unity may arise *a posteriori* as well as *a priori*, it should be remembered that lack of unity is not a ground for revocation in later proceedings. Therefore, although the objection should certainly be made and amendment insisted upon in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. This is particularly so where the possible lack of unity does not necessitate a further search. ...".

(Citing the earlier version of the Guidelines at C-III, 7.7; For the current version, see the Guidelines, B-VII, 2.2).

3.2 However, the actions of the Search Division are not subject to appeal: see Article 106(1) EPC and T 2495/11, points 2.1 and 2.2 of the reasons. If an applicant

considers that the view taken by the Search Division on lack of unity is wrong and the Examining Division takes the same view as the Search Division, an applicant can challenge this, if necessary by way of an appeal. If this challenge succeeds, then a further search will be carried out without a further search fee being charged. see G 2/92, point 2 of the reasons, J 3/09, point 3.5.2 of the reasons and T 2495/11, points 2.1 and 2.2 of the reasons. In the present case, however, the Examining Division's view on lack of unity was not challenged before either the Examining Division or the Board. The argument is therefore rejected.

4. *The Rule 164(2) point: introduction*

4.1 It is doubtful that Rule 137(5) EPC could be an appropriate basis for refusing an application based on these requests. The rule provides:

"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. ...".

4.2 It has been pointed out that Rule 137(5) EPC (previously Rule 86(4) EPC 1973) only has the status of an administrative provision in the context of search and grant procedures: see T 708/00 (OJ EPO 2004, 160), point 6 of the reasons. An amendment which does not comply with the rule is therefore inadmissible: T 442/95, point 6 of the reasons. If the applicant's only request for grant is based on such amended claims

there will be no admissible request for grant and the application will be refused.

- 4.3 More to the point, however, is the fact that in the present case the amended claims, even if they may relate to "unsearched subject-matter" (a matter hotly disputed by the appellant), had not been combined with the originally claimed invention to form a single general inventive concept: they were part of the original claimed subject matter on entry into the European phase.
- 4.4 The underlying purpose of the rule is explained in CA/12/94 Rev. 1 of 17 October 1994, "Amendment of the EPC, the Implementing Regulations and the Rules relating to Fees", pages 16 and 17, and the Notice of 1 June 1995 published in OJ EPO 1995, pages 409 and particularly 420, 421 concerning the introduction of the Rule 86(4) EPC 1973 (which subsequently became Rule 137(5) EPC). These documents and also subsequent decisions of the Boards of Appeal point out that the purpose of the rule is to stop applicants switching to unsearched subject matter in the reply to the first communication from the examiner (thereby getting several searches and examinations for the price of one). The rule is thus intended to prevent amendments of the application which circumvent the principle that a search fee must always be paid for an invention presented for examination (T 274/03, point 4 of the reasons). It therefore provides the means to stop applicants, in reply to the first communication, dropping existing claims, replacing them by switching to unsearched and non-unitary subject-matter extracted from the description, i.e., claiming different subject-

matter in sequence rather than simultaneously (T 274/03, point 4 of the reasons, T 915/03, point 3 of the reasons, T 1285/11, point 2 of the reasons). The rule therefore does not apply where a lack of unity arises within a group of simultaneously claimed inventions (T 915/03, point 3 of the reasons).

- 4.5 Of course these statements must be read in the context of the facts of the particular cases. Nevertheless, in the present case the amended claims did not take matter from the description but rather were based on the claims as filed on entry into the European phase. In the words of T 264/09 at point 4.2, the claims have not been amended "such that" they relate to unsearched subject-matter which does not combine with the originally claimed invention to form a single general inventive concept. Further it is part of the appellant's complaint that it was not given the opportunity to pay further search fees following the Search Division's search report. Indeed, the problem does not arise as the result of the amendments which the applicant made after entry into the European phase but because of an objection of lack of unity which was first raised at a point when, if the Examining Division is correct, the appellant no longer had the opportunity to have non-unitary subject matter searched and where, in the further prosecution of the application, the appellant no longer had the opportunity to choose which inventions to pursue. It could only pursue the invention first mentioned in the claims filed on entry into the European phase. All other inventions could only be pursued by way of one or more divisional applications.

- 4.6 The same problem would arise on a simplified version of the facts of the present case where, for example, on entry into the European phase, two non-unitary inventions were claimed and in examination the applicant wished to restrict the application to the second and unsearched invention claimed.
- 4.7 The Board also considers that Rule 164(2) EPC, however interpreted, cannot *by itself* be a basis for refusal of the application (and indeed the Examining Division did not base its refusal on the rule). The rule is merely a procedural provision which gives an applicant the opportunity, by amending the claims, to deal with particular objections raised by the Examining Division; it does *not* expressly purport to deal with the requirements of search or patentability. The rule does not say (and does not need to say) what the consequence will be of an applicant not taking the opportunity to restrict the claims. In this respect the rule appears to operate in a different way from Rule 64(1) EPC, under which if the applicant does not pay further search fees and the Search Division's view on lack of unity is upheld by the Examining Division, unsearched subject matter may not be pursued in that application: see G 2/02 and the further explanation of the operation of the rule in T 631/97 (OJ EPO 2001, 13). Nevertheless, if the applicant does nothing and the objection of lack of unity is upheld the consequence will be that the application will be refused under Article 82 EPC.
- 4.8 It appears to the Board that the correct approach is that if the claims of the relevant request are non-unitary, and the applicant declines to limit the claims to a single invention, then the application should

simply be refused under Article 97(2) EPC on the grounds that the claims of the request do not meet the requirements of the EPC, namely Article 82 EPC. In this light the essence of the appellant's complaint is that by virtue of Rule 164(2) EPC the Examining Division should have regarded all subject matter covered by the international search report as searched. While it may have been correct, given the Examining Division's view on unity, for the appellant to have been invited to limit its claims, the appellant argues that such invitation should not have been limited to the claims relating to the single invention covered by the supplementary European search report. The appellant says that it should have been invited, and was entitled to choose which invention it wanted to pursue in the examination proceedings, including an invention covered only by the US Patent Office's search in the international phase.

5. *The context of Rule 164(2) EPC*

5.1 Before dealing with the appellant's interpretation of Rule 164(2) EPC, some points of general importance need to be made regarding the context in which the rule operates.

5.2 An application for a European patent will be refused only if the application or the invention to which it relates does not meet the requirements of the EPC (Article 97(2) EPC). Generally under the EPC, it is not expressed to be a ground for refusal of an application that claims have not been searched. In the present context, the ground for refusal of an application will usually be lack of unity (see point 4.8, above) or,

alternatively, that there is no admissible request for grant of the patent (see point 4.2, above).

5.3 Nevertheless it is a fundamental assumption under the EPC system that examination of an application will only be conducted on the basis of claims which have been appropriately searched (i.e., with due regard to the description and any drawings: Article 92 EPC). Without an appropriate search the Office does not have the necessary materials to determine whether the application meets the requirements of novelty and inventive step. As it is put in the current version of the Guidelines for Examination, Part B-II, 2:

"The objective of the search is to discover the state of the art which is relevant for the purpose of determining whether, and if so to what extent, the claimed invention for which protection is sought is new and involves an inventive step."

In G 2/92, the Enlarged Board said:

"... the invention which is to be examined for patentability must be an invention in respect of which a search fee has been paid prior to the drawing up the European search report. ... Part IV of the EPC ... envisages that an application progresses after filing from the Search Division to the Examining Division.... An object of Rule 46 EPC [1973] is to implement this procedure by ensuring that an appropriate extent of search is completed in respect of each individual application before each application is examined by the Examining Division. ...

... 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."

(See point 2 of the Reasons, emphasis added by the Board).

The general principle was underlined in T 1242/04 (OJ EPO 2007, 421), point 8.2 of the Reasons):

"The search is an essential element of the grant procedure, being designed to identify prior art relevant to the application. The intention is to make it possible to determine, on the basis of the documents mentioned in the search report, whether and to what extent the invention is patentable (see R. 44(1) EPC). Knowledge of the prior art forms the basis for examination of the application by the examining divisions. It is also important for applicants, giving them a basis for deciding whether to continue prosecuting their applications and have them examined. Lastly, it is also important for the public and especially for competitors, enabling them to gain an idea of the scope of any protection that might be granted. For that reason the legislator has also stipulated that the results of the duly performed search must be published together with the

European patent application eighteen months after the date of filing or priority (see Art. 93(2) EPC)."

There are narrow exceptions to this principle (see e.g., T 1242/04) but these are not relevant for present purposes.

- 5.4 In the case of a Euro-PCT application, the international search report under Article 18 PCT takes the place of the European search report (Article 153(6) EPC). Nevertheless it remains a fundamental principle that a supplementary European search report must generally be drawn up in respect of such an application (Article 153(7) EPC). Only where the Administrative Council has so decided may the supplementary European search report be dispensed with (Article 153(7) EPC). Currently, the decision of the Administrative Council of 28 October 2009, CA/D 11/09 (OJ EPO 2009, 594) provides for such an exception where the international search report or a supplementary international search report was drawn up by the EPO. Historically there were other exceptions, for example where the international search report was drawn up by the Austrian, Swedish or Spanish Patent Offices: see the Decision of the Administrative Council of 17 May 1979 (OJ EPO 1979, 422). These provisions can be traced back to Article 177 EPC 1973 and the Decision of the Administrative Council of 21 December 1978, CA/D 18/78 (OJ EPO 1979, 4 & 50). There are a number of historical reasons for this dilution of the principle in Article 153(6) EPC, including no doubt that other ISAs do not necessarily search in all the three languages in which the EPO searches. See also "The Granting of

European Patents" by M. Van Empel (Leyden: Sijthoff, 1975), p.289:

"... it is in fact hard to predict the quality of the international search reports which will be drawn up by the various International Searching Authorities. This quality may vary from one International Searching Authority to another, and even within the same authority it may vary according to time and to area of technology. ... PCT Member States are, therefore, left free to have the international search report checked on the national level once again and have it supplemented where necessary or desirable."

The *travaux préparatoires* to the EPC show that it was the hope that a supplementary national search would only be necessary during the initial stages of the PCT. See, e.g., BR/12 e/69, paragraph 69, BR/218/72, paragraphs 160, 162, 165, However, this hope has not yet been fulfilled.

6. *The interpretation of Rule 164 EPC*

6.1 The rule is contained in Part IX of the Implementing Regulations, implementing Part X of the EPC, which concerns international applications under the PCT, in particular those for which the EPO is the designated or elected office (Euro-PCT applications).

6.2 The current version of Rule 164(1) EPC states:

"(1) 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."

The rule is obviously not concerned with Euro-PCT applications for which no supplementary European search report has to be drawn up, i.e., with cases where the EPO was the ISA (see point 5.4, above). For those applications for which a supplementary European search report has to be drawn up, the rule operates independently of and additionally to whatever may have happened as regards unity of invention in the international phase pursuant to Article 17(3) (a) and Rule 40 PCT. In the present case a supplementary European search report was drawn up in accordance with the rule.

6.3 Rule 164(2) EPC in its current version states:

"(2) 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."

6.4 The drafting of Rule 164(2) EPC is not ideal. To understand it, it is easier to start from the version of the rule as originally enacted (Decision of the Administrative Council of 7 December 2006: OJ EPO 2007, Special Edition No. 1, p. 89). This provided that:

"(2) 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 search report, it shall invite the applicant to limit the application to one invention covered by the international search report or the supplementary European search report."

It is not in any dispute that the expression "the supplementary search report" means "the supplementary European search report". This is made explicit in the current version of the rule.

6.5 Part of the difficulty is that the rule attempts at one and the same time to deal with three different and potentially overlapping situations arising in examination proceedings. Thus it deals with cases where the Examining Division finds that:

(a) The application documents on which the European grant procedure is to be based do not meet the requirements of unity of invention;

or

(b) Protection is sought for an invention not covered by the international search report;

or, as the case may be,

(c) Protection is sought for an invention not covered by the supplementary European search report.

Thus, unlike Rule 164(1) EPC, the rule covers not only the case where there is a supplementary European search report (as in the present case, because the EPO was not the ISA) but also the case where there is no such report (because the EPO was the ISA). The expression "as the case may be" appears to be intended to deal with these two alternative possibilities; the Board disagrees with the appellant's submission that it can be regarded as extraneous.

When any of these different situations arises the Examining Division is to invite the applicant to limit the application to one invention. Obviously the rule must be read applying a certain amount of common sense. Thus, if protection is sought for an invention not covered by the international search report, but which was covered by the supplementary European search report (because, for example, the Search Division of the EPO takes a different view on unity from the ISA) it makes no sense to read the rule as requiring the application to be limited to one invention covered by the international search report.

- 6.6 The appellant was not very specific as to precisely how the rule should be applied in the present case. One way of putting it would be that the application documents for the European grant procedure were found not to meet the requirements of unity the applicant should have been invited to limit the application to one invention covered either by the international search report or the supplementary European search report; the second possible way is that given that protection was being sought for an invention not covered by the supplementary European search report, the applicant should have been invited to limit the application to one invention covered either by the international search report or the supplementary European search report.
- 6.7 The Board can accept that linguistically these are possible interpretations of the rule. However, the Board does not consider that either is correct. It would mean that in both cases the rule had introduced an exception to the principle, discussed in point 5.4 above, that an application which has not been appropriately searched by the EPO will not be examined by the EPO. Such an exception could only have been introduced by the Administrative Council in exercise of its powers under Article 153(7) EPC. In the exercise of such powers the Administrative Council is normally careful to recite the power itself, e.g., "Having regard to the European Patent Convention, and in particular Article 153(7) thereof ...". See, e.g., CA/D 11/09 (OJ EPO 2009, 594), referred to in point 5.4, above. Of course the Administrative Council also has power under Article 33(1)(c) EPC to amend the Implementing Regulations, and Article 164(2) EPC was

part of the amendments to the Implementing Regulations made by the Administrative Council on 7 December 2006 in exercise of that power. However, in making these amendments the Administrative Council was again careful to recite the power under which the amendments were being made, i.e. "Having regard to the European Patent Convention (EPC), and in particular Article 33(1)(b) thereof ...". See Decision CA/D 20/09 (OJ EPO 2007, Special Edition No. 1, page 89). This decision makes no reference to the power under Article 153(7) EPC and, given the significance of the power, it would be surprising, to say the least, if the Administrative Council were to have purported to have exercised it, *sub silentio* and without consultation. The Board has already noted that Rule 164(2) EPC is merely procedural in nature (see point 4.7, above) and again it would be surprising if its effect was to alter what is to be regarded as searched subject matter, an issue which goes to the ability of the EPO to examine an application for patentable subject matter.

6.8 The Board considers that applying common sense the correct interpretation of the rule, taking the three different (and potentially overlapping) situations referred to in point 6.5 above in turn, is that:

(a) If the application documents on which the European grant procedure is to be based do not meet the requirements of unity of invention, the applicant is to be invited, in the case where there is no supplementary European search report, to limit the application to one invention covered by the international search report;

If, on the other hand, in such a case there is also a supplementary European search report, the applicant is to be invited to limit the application to one invention covered by that report.

(b) If, where there is no supplementary European search report, protection is sought for an invention not covered by the international search report, the applicant is to be invited to limit the application to one invention covered by that report.

(c) If, where there is a supplementary European search report, protection is sought for an invention not covered by that report, the applicant is to be invited to limit the application to one invention covered by that report.

This interpretation maintains the principle that an application which has not been appropriately searched by the EPO will not be examined by the EPO.

7. *Article 164(2) EPC: the travaux préparatoires*

7.1 The argument of the appellant is not merely that its interpretation of the rule is the natural and therefore the correct reading of the rule, but also that the *travaux préparatoires* to the rule lead one to the same conclusion.

7.2 To understand the *travaux préparatoires* and the effect of Rule 164 EPC fully it is first necessary to consider the position as it was before the EPC 2000 came into force.

7.3 So far as concerned a Euro-direct application, Rule 46(1) EPC 1973 (equivalent to Rule 64(1) EPC) provided:

"If the Search Division considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial European search report on those parts of the European patent application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that if the European search report is to cover the other inventions, a further search fee must be paid, for each invention involved, within a period to be fixed by the Search Division which must not be shorter than two weeks and must not exceed six weeks. The Search Division shall draw up the European search report for those parts of the European patent application which relate to inventions in respect of which search fees have been paid."

7.4 As regards Euro-PCT applications, there were various possibilities on entering the European phase. For the purposes of the present case it is only necessary to consider two of them:

(a) If no objection of lack of unity had been raised in the international phase but, a supplementary European search being required, such an objection was raised by the Search Division on entering the European phase, Rule 46(1) EPC 1973 would have been applied. See the Guidelines for Examination, June 2005 version, C-III, 7.11.2. Thus a search report would have been drawn up

on those parts of the application which related to the invention first mentioned in the claims and the applicant would have been told, in effect, that if further search fees were paid the other inventions would also be searched. (Indeed this was generally the position where a supplementary European search report was required, whatever had happened in the international phase).

(b) Where lack of unity was raised in the international phase by the ISA, the applicant would have had the opportunity to pay further search fees and have all matter searched there (Article 17(3)(a) PCT). If the applicant did not do so, then, if no supplementary European search was required, the position was governed by Rule 112 EPC 1973:

"If only a part of the international application has been searched by the International Searching Authority because that Authority considered that the application did not comply with the requirement of unity of invention, and the applicant did not pay all additional fees according to Article 17, paragraph 3(a), of the Cooperation Treaty within the prescribed time limit, the European Patent Office shall consider whether the application complies with the requirement of unity of invention. If the European Patent Office considers that this is not the case, it shall inform the applicant that a European search report can be obtained in respect of those parts of the international application which have not been searched if a search fee is paid for each invention involved ... The Search Division shall draw up a European search report for those parts of the

international application which relate to inventions in respect of which search fees have been paid.

Rule 46, paragraph 2, shall apply *mutatis mutandis*."

Although the rule did not expressly say so, it clearly only applied in a case where no supplementary search report was required (for example because the EPO was the ISA) and this is how the rule was interpreted by the Office: see the Guidelines for Examination, June 2005 version, Part E-IX, 5.7. The rule was needed since otherwise in these circumstances there was no route whereby non-searched subject matter could be searched on entering the European phase.

7.5 Rule 112 EPC 1973 was considered not to operate very satisfactorily. Some of these reasons why are set out in the *travaux préparatoires* to the original version of the rule, the only relevant document of which the Board is aware being CA/PL 17/06 (See OJ EPO 2007, Special Edition 5, page 256). This states as follows:

"1. Many practical problems have arisen within the framework of current Rule 112 EPC. The rule does not address all possible scenarios, e.g. not the situation where non-unity is only introduced by amendments filed on entry into the European phase. Also the case where after amendment on entry into the European phase the application is unitary, but nevertheless relates to an invention not searched, is not covered. Especially in the situation where there is no supplementary [European] search and Rule 112 has to be applied by the examining division, there is no straightforward procedure. Applicants consider a Rule 112 communication as a first communication by

the examining division and respond by e.g. contesting the findings or filing further amendments. This causes considerable delays."

(Word in square brackets added by the Board)

7.6 While this statement refers to the problems with Rule 112 EPC 1973, it should be noted that Rule 164 EPC is in fact concerned with a much broader range of circumstances (see points 6.2 and 6.5, above). As regards the new Rule 164, CA/PL 17/06 continues:

"2. 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 [European] search report, in line with G 2/92 (OJ EPO 1993, 591). Under the proposal, the procedure will be simplified and the opportunity to have multiple inventions searched within the framework of one application will be limited to the international phase. On entry into the European phase, non-unitary subject matter should be deleted.

3. The proposal does not involve any loss of rights for the applicant. The result is just that the applicant will have to use the appropriate way of having any further inventions searched and examined by filing divisional applications. This will bring the Euro-PCT procedure in line with the Euro-direct procedure."

(Word in square brackets added by the Board)

- 7.7 As with Rule 164(2) EPC itself, the statement in point 2 ("examination should only be carried out on inventions covered either by the international search report or by the supplementary [European] search report") is dealing with two situations at the same time, i.e., both with the case where there is a supplementary European search report and where there is not. The Board does not consider that it is possible to obtain from this very compressed form of wording any very clear guidance as to the construction of the rule in addition to what can be understood from reading the rule by itself. The rule is already expressed in a compressed form and this further summary does not take the matter any further.
- 7.8 As to the reference in CA/PL 17/06 to G 2/92, this seems inappropriate since G 2/92 was not concerned with Euro-PCT applications or thus with international or supplementary European search reports but only with the search in European proceedings. In this the Board agrees with the statement in Singer/Stauder (Teschemacher) "The European Patent Convention", Sixth Edition, Article 82, point 31, n.73.
- 7.9 To the extent that the statement in CA/PL 17/06 can be taken as confirming that examination should only be carried out in respect of inventions which have been the subject of a search by the EPO, whether the international search or the supplementary European search, this is at least consistent with G 2/92.
- 7.10 The appellant relies heavily on the statement in CA/PL 17/06: "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 [European] search report ..." (emphasis added by the appellant). The appellant argues that when compared with the wording of the rule itself ("it shall invite the applicant to limit the application to one invention covered by the international search report or the supplementary [European] search report") it is made clear that the invitation must be made in respect of either report, so that an applicant can in effect choose which search is to be the relevant one. The Board does not agree. The additional word "either" in CA/PL 17/06 does not add anything to the meaning. Certainly, to the extent that the text of Rule 164(2) EPC is ambiguous, the word does not it makes it unambiguous in the sense for which the appellant argues.

- 7.11 The appellant also argues that since CA/PL 17/06 states that the new rule will not involve any loss of rights (as compared to those under EPC 1973) the appellant must be permitted to pursue claims covered by the international search report. However, this statement in CA/PL 17/06 is immediately followed by the explanation of what is to be understood by it: an applicant will be able to have any further inventions searched and examined by filing one or more divisional applications. The Board accepts that the rule change means that the appellant's position is procedurally less advantageous than it would have been under the EPC 1973 (see points 7.3 and 7.4, above). There has therefore been a loss of procedural rights and such loss may have potentially serious financial consequences for applicants. Nevertheless the framers of the rule and of CA/PL 17/06 appear to have considered that provided there was no

loss of the right to have separate inventions searched and examined, albeit only by way of a divisional application, this was sufficient to avoid any loss of rights. CA/PL 17/06 does not promise any more than this, and certainly not that an applicant's procedural rights will remain the same as before.

7.12 The appellant further relies on the statement in CA/PL 17/06 that the new rule will bring "the Euro-PCT procedure in line with the Euro-direct procedure" and argues that the implication is that an applicant should have a single opportunity to pay additional search fees for a Euro-PCT application, i.e., during the international search phase. While the Board can accept that this statement is puzzling, the fact is that the Euro-PCT procedure is not the same as the Euro-direct procedure. These words must also be read together with the preceding statement that there will be no loss of rights because of the possibility of filing divisional applications.

7.13 The appellant also relies on the statement in CA/PL 17/06 that the practice under the new rule will be in line with G 2/92. It is argued that effect of the G 2/92 is that in order to be barred from pursuing subject matter that has not been searched, an applicant should have failed to pay a relevant search fee. If an applicant has not been asked or had the opportunity to pay a search fee in respect of particular subject matter then it cannot be regarded as unsearched. This is to turn G 2/92 on its head. G 2/92 was concerned with the case where an applicant has been invited by the Search Division to pay further search fees under Rule 46(1) EPC 1973 (now Rule 64(1) EPC) but had

declined to do so. In these circumstances the Enlarged Board decided that the applicant could not pursue subject matter in respect of which no search fees had been paid and must file a divisional application if protection for such subject matter was wanted (see the Headnote). It does not follow from this that subject matter in respect of which no search fees have been requested can somehow be regarded as searched. Whether an applicant should be given the opportunity to pay further search fees is a separate issue (see point 9, below).

8. *The amendment to Rule 164(2) EPC*

8.1 The appellant further relies on the amendment to Rule 164(2) EPC which came into effect on 1 April 2010. This amendment was one of a number of changes to the EPC following the introduction of the availability from the EPO of supplementary international search reports ("SISRs") pursuant to Rule 45*bis* PCT. The changes enable applicants to request a search during the international phase from as many participating ISAs as they wish so as to minimise the risk of new prior art being uncovered after entry into the national phase. It enables them, for example, to take account of particular expertise certain ISAs may have in certain languages: see CA/56/09, point 4. As part of the implementation of the change, the Administrative Council decided, again with specific reference to its powers under Article 153(7) EPC (see point 6.7, above), that a supplementary European search report should be dispensed with not only where the international search report has been drawn up by the EPO but also where an SISR has been drawn up by the EPO. See Decision

CA/D 11/09 of 28 October 2009 (OJ EPO 2009, 594). The reason is self evident: as with an international search report, where the EPO has drawn up an SISR such a search is sufficient for the purposes of examination in the European phase.

8.2 As part of these changes, the text of Rule 164(2) EPC was amended as set out at point 6.3, above: see the decision of the Administrative Council CA/D 20/09 of 27 October 2009 (OJ EPO 2009, 582). The amendment was necessary because the supplementary European search report was now to be dispensed with in the circumstances described above: see CA/166/09, point 5. The expression "as the case may be" in the Board's view again reflects the fact that now there may or may not be either an SISR or an supplementary European search report; it will depend on the circumstances.

8.3 It is argued by the appellant that if the effect of the original wording of Rule 164(2) EPC is that the supplementary European search report had the ability to supersede the international search report, then it must be the case that any SISR would supersede the international search report, something which cannot be correct, and would require the EPO to consider any SISR ahead of even a European international search report. The wording "as the case may be" can only mean that subsequent search reports may be taken into consideration in cases where they exist and not they supersede the international search report in some way.

8.4 The Board does not agree. Although the amendment makes the rule yet more complicated since it now deals with the further possibility of there being an SISR drawn up

by the EPO, it cannot be taken to have made a fundamental departure from the way in which the previous version of the rule operated or to affect the underlying general principle that in the European phase only applications which have been appropriately searched by the EPO will be examined for patentability. As explained above, the rule change was made in the context of the exercise of the Administrative Council's powers under Article 153(7) EPC, i.e., dispensing with the need for a supplementary European search where an international search (of whichever kind) has been drawn up by the EPO.

8.5 Indeed, the *travaux préparatoires* to the rule change not only confirm this but also confirm the Board's interpretation of the original rule. Thus the proposal for the change in the rule (CA/166/09) states, at point 8:

"In the case of a lack of unity of invention, an SISR will only be established for the invention first mentioned in the claims (Rule 45bis.6(a)(i) PCT). There is no opportunity for the applicant to have further inventions searched against the payment of additional search fees. 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 SISR."

(Emphasis added by the Board)

Indeed, on the basis of the appellant's arguments, it is hard to understand it was said that the obligation

was to limit the application to the invention covered by the SISR, rather than to the international search report or the SISR.

8.6 Generally, the Board cannot agree with those aspects of the appellant's arguments here and elsewhere (see points XVI(c), (h) and (i), above) which are concerned with whether the international search report should be "ignored", with further proceedings to be based only the supplementary European search report, or whether the supplementary search report "supersedes" the international search report or an SISR. Where a supplementary European search report is required, all search reports are potentially equally relevant for the purposes of examination in the European phase.

9. *A right to a further search.*

9.1 The appellant argues in the alternative that if its construction of Rule 164(1) EPC is wrong then it must be entitled to a invitation from the EPO to pay a further search fee and thus to have the EPO search the claims not covered by the (first) supplementary European search report. Otherwise, it is argued, it will have suffered a loss of rights, contrary to what is said in CA/PL 17/06. This right to a further search is said to be available under Rule 64(1) EPC.

9.2 The Board has already noted that this statement about no loss of rights was made in the context of it also being said that an applicant can always pursue unsearched matter by way of one or more divisional applications.

9.3 Additional searches may sometimes be necessary during examination or opposition proceedings (see the Guidelines for Examination B-II, 4.2) but Rule 164(1) EPC has ruled out the possibility of such further search in the present circumstances, in contrast to the position under Rule 64(1) EPC. CA/PL 17/06 makes the position clear when it states, in point 2:

"Under the proposal, the procedure will be simplified and the opportunity to have multiple inventions searched within the framework of one application will be limited to the international phase. On entry into the European phase, non-unitary subject matter should be deleted."

(Emphasis added by the Board)

The Board therefore rejects this argument.

10. *Rule 164 EPC: possible conflict with the PCT and articles of the EPC*

10.1 The interpretation given to Rule 164 EPC by the Board means that applicants who file a PCT application with an office other than the EPO may be at a procedural disadvantage in the European phase compared with applicants who file the international application with the EPO (and Euro-direct applicants). This disadvantage arises not out of Rule 164(2) EPC but rather out of the application of Rule 164(1) EPC, which, the Board has held in point 9.3, above, prevents claims relating to more than one invention being searched in the European phase. Although the appellant did not advance any such argument, the Board has nevertheless considered whether, in the appellant's favour and having regard to

Article 164(2) EPC, Rule 164 EPC is compatible with the EPC or the PCT.

10.2 The following provisions appear relevant:

(a) Article 150(2) EPC

This article provides that international applications filed under the PCT may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of the PCT and its Regulations are to be applied, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT or its Regulations are to prevail. These provisions are the same as those in Article 150(2) EPC 1973.

(b) Article 153(2) EPC

This article provides that 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 (a Euro-PCT application), shall be equivalent to a regular European application. The article replaces Article 150(3) EPC 1973, according to which an international application, for which the European Patent Office acts as designated Office or elected Office, was to be deemed to be a European patent application. As part of the *travaux préparatoires* to Article 153(2) EPC it was explained that the new article "governed, in addition to Article 11(3) PCT, the conditions under which an international application has the effect of a European application, and clarifies the principle deriving from Article 150(3) EPC 1973." (See OJ EPO, 2007, Special edition No. 4, and MR/2/00). Article 11(3) PCT provides that:

"Subject to Article 64(4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) [which concern the essentially formal requirements for being accorded a filing date] and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State."

The principle deriving from Article 150(3) EPC 1973 was explained in Singer/Stauder (Busse) "The European Patent Convention", Third (English) Edition (2003), Volume 2, Article 150, note 20, as follows:

"The provision set out in [Article 150(3) EPC 1973] is primarily directed towards the treatment of the international application after the end of the international phase. The application must then be examined for patentability on the same way as a European application." (Emphasis by the Board).

(c) Article 153(5) EPC

This article provides that a Euro-PCT application is to be treated as a European patent application and shall be considered as comprised in the state of the art under Article 54, paragraph 3, if the conditions laid down in paragraph 3 or 4 and in the Implementing Regulations are fulfilled. This Article was new in the EPC 2000 and was explained in the *travaux préparatoires*

(See OJ EPO, 2007, Special edition No. 4, page 186, and Preparatory Document MR/2/00) as follows:

"New Article 153(5) EPC clarifies the conditions for entry into the European phase, referring expressly to new paragraphs 3 and 4 and to the Implementing Regulations, where these conditions are specified (see Rule 159 EPC 2000). This is now combined with the stipulation, taken from Article 158(1), second sentence, EPC 1973, that a Euro-PCT application shall only be considered as comprised in the state of the art under Article 54(3) EPC if the conditions in question are fulfilled."

In Visser "The Annotated European Patent Convention", H. Tell, 20th Edition, (2012), the author states:

"Since the Travaux Préparatoires EPC 2000 state that this provision gives the conditions for entry into the European phase and those for considering a Euro-PCT application as a European prior right, it must be concluded that the word 'treated' refers to 'processed' and 'examined' in the sense of Art. 23 PCT. Since this processing and examining is independent of the publication of the Euro-PCT dealt with by Art. 153(3) and (4), the reference to these two paragraphs in Art. 153(5) should pertain to the conditions for the European right only. The conditions for entry into the European phase are provided in R. 159(1)."

In Singer/Stauder (Hesper) "The European Patent Convention", Sixth Edition (2012), Volume 2, Article 153, notes 191 and 192, the following comment

is made (the Board's own translation of the German text):

"191. The meaning of the first part of Art. 153(5) EPC "The Euro-PCT application shall be treated as a European patent application ... if the conditions laid down in the Implementing Regulations are fulfilled" is unclear. In any event no meaning should be read into this passage which is not in accord with the principle embodied in Art 11(3) PCT in connection with 153(2) EPC, whereby a Euro-PCT application [*sic - an international application?*] is equivalent to a Euro-PCT application as from the filing date of the international application.

192. The sense of this requirement can be better understood if it is borne in mind that no substantive alteration of the provisions in Art. 158 EPC 1973 was intended and that the reference to the Implementing Regulations replaces the two requirements for entry into the European phase laid down in Art. 158(2) EPC 1973 - the payment of the national fee and the filing of a translation according to Arts 22 and 39 PCT. As a result of its [*i.e. Art. 158 EPC 1973's*] replacement by Art 158(2) EPC (2000) without any incorporation of further conditions into the Implementing Regulations, the special status and the original role of the actions envisaged by Arts 22 and 39 PCT for the commencement of the European phase is no longer apparent in the EPC system."

(Comment in italics by the Board.)

(d) Article 27(1) PCT

This article provides that:

"No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations."

10.3 The Board does not consider that it can be extracted from any of these provisions that all Euro-PCT applicants must have identical procedural rights, whether identical to those of all other Euro-PCT applicants or Euro-direct applicants. The provisions are concerned primarily to specify the formal requirements for a PCT application to be accepted into the national phase, to provide that the filing date of such an application is to be that of the international application and that such applications are all examined for patentability on the same basis. Whether this is done in the application itself or by way of divisional applications does not appear to be dictated by the PCT.

11. *Legal texts*

11.1 So far as the Board is aware, no commentator has expressed an opinion differing from the above conclusions of the Board.

11.2 In "*Problems arising from Rule 164 EPC*" by E. A. Kennington, *epi information*, 1/2009, p.6, the author anticipates precisely the present case and reaches the same conclusions, albeit adding that the rule is

discriminatory and arbitrary in its effects and should be rewritten.

- 11.3 Singer/Stauder (Teschemacher) "The European Patent Convention", Sixth Edition, Art. 82, point 31 (the Board's own translation):

"... if the Search Division considers that the application is non-unitary, then in accordance with Rule 164(1) it will draw up the supplementary European search report only in respect of the invention first mentioned in the claims. The consequences for the substantive examination are the same as for a partial search report under Rule 64 ... While the possibility still exists, at least in the international phase, for applications for which the EPO is responsible as the ISA to obtain a search by the EPO of actual or alleged non-unitary parts through the payment of additional fees, for applications for which a supplementary search report is necessary, such a possibility is completely lost. The principal stated in the explanation to the new rule that a substantive examination should only be carried out in relation to inventions which are covered either by the international search report or the supplementary European search report, treats two different situations in the same way. The international search report drawn up by an ISA other than the EPO is neither actually nor legally a sufficient basis for proceedings before the EPO."

12. *Conclusions on main and first auxiliary requests*

12.1 The Board can accept that the position in which the appellant finds itself was apparently not taken into account when Rule 164 EPC was implemented and that it operates in a way which was probably not foreseen and may be thought to be unfair. Although this is of little comfort to the appellant, the Board notes that there is a proposal to amend the rule on the agenda of the Administrative Council for October 2013, which would appear *inter alia* to deal with the problem which the appellant has encountered, even though the proposal is not directed primarily at the point in the present case: For the text of the new rule and explanation, see CA/PL 9/13, dated 30 August 2013.

12.2 In conclusion, neither the main nor the first auxiliary request is allowable.

13. *Second auxiliary request*

13.1 In claim 1 of the second auxiliary request the alternative arrangement in claim 1 of the first auxiliary request relating to the series combination of a first fixed orifice expansion device and a solenoid valve that combines aspects of a solenoid valve and a fixed expansion device has been deleted, thereby limiting its subject-matter to a parallel combination of these components. Whereas the series combination of the first auxiliary request is based on claim 5 filed upon entry into the European phase, which was not searched, the parallel combination is based on claims 1 to 4 filed upon entry into the European phase which

were searched (see sheet B of the supplementary European search report). Thus, the above objections concerning the main and first auxiliary request do not apply.

13.2 The subject-matter of claim 1 according to the second auxiliary request broadly corresponds to that of the second auxiliary request filed with letter of 23 January 2012 to the extent that it relates to a parallel combination. The Examining Division clearly based its objections to this request under Articles 123(2) and 84 EPC (see point 14.1 below).

13.3 As regards Article 123(2) EPC, it is apparent (see point 14.1 below) that the Examining Division considered that the feature in this claim "wherein the solenoid valve (110;150) with the second fixed orifice expansion device in the valve element is located in the second branch" did not meet the requirements of Article 123(2) EPC. In the course of the appeal proceedings the appellant amended the claim to meet this objection, such that it now reads: "a solenoid valve (110;150) that combines aspects of a solenoid valve and a fixed expansion device is located in the second branch." This wording is explicitly disclosed in paragraph [0029] of the description. The claim therefore now satisfies Article 123(2) EPC.

13.4 As to Article 84 EPC, it is again apparent that the Examining Division considered that the features "first fixed orifice expansion device" and the "second fixed orifice expansion device" were undefined, rendering the claim unclear. Claim 1 of the present second auxiliary request no longer refers to a "second fixed orifice

expansion device" but still contains the feature that "a fixed orifice expansion device (108;152) is located in the first branch" and the feature "a fixed expansion device". In the Board's opinion, however, these features meet the requirements of Article 84 EPC since the skilled person is well aware of what constitutes a fixed orifice expansion device and a fixed expansion device. Furthermore, paragraph [0009], lines 30 to 31, gives examples of what is meant: "a fixed expansion device (e.g. a fixed orifice or capillary tube)".

13.5 In the course of the discussion of the appellant's request during oral proceedings, the appellant stated that it was willing to amend the opening words of claim 1 of the requests read: "A transcritical CO₂ refrigeration system ..." if this was required to overcome an objection which the Board had raised under Article 123(2) EPC. However, the Board does not consider that such an amendment is necessary and it is thus not necessary to pursue this matter further.

13.6 Thus, claim 1 of the second auxiliary request meets the requirements of Articles 123(2) and 84 EPC.

13.7 Since the Examining Division did not assess novelty or inventive step, the Board is of the view that the case should be remitted to the Examining Division under Article 111(1) EPC to allow these issues to be addressed.

Reimbursement of the appeal fee.

14. Since the decision is to be set aside and the case remitted on the basis of the second auxiliary request,

it follows that the Board deems the appeal to be allowable within the meaning of Rule 103(1)(a) EPC. However the Board does not consider it equitable to reimburse the appeal fee, for the following reasons.

- 14.1 The Board can accept the appellant's submission that the decision of the Examining Division is flawed in that it refers only to "communications" dated 11 October 2011 and 15 February 2012 (see the appellant's arguments on this at point XVI(m), above). There was in fact no communication of 15 February 2102, only a telephone conference on that day between the appellant's representative and the Examiner. As to this, it is not in dispute that the relevant details of the conversation are set out in the "Result" of the telephone conversation, which was dated 24 February 2102 and sent to the appellant's representative. This was written in the style of a communication and sets out clearly the various objections of the Examiner, as regards the main request, by reference to the previous communications of 11 October and 1 December 2011 and, as regards the auxiliary requests filed on 23 January 2012, by expressly setting out the objections to them. The Board considers that the ordinary recipient of the decision would have understood that the reference in the decision to a "communication" of 15 February 2012 was a simple mistake and was intended to be a reference to the substance of the telephone conversation of that date, the details of which are recorded in the document of 24 February 2012. The ordinary reader would not have understood the reference to be simply to the communication dated that day cancelling the oral proceedings. The ordinary reader would therefore have understood the reasons why the application had been

refused, namely for the reasons summarised in the document of 24 February 2012.

14.2 The Board can also accept the appellant's submission that the decision is flawed because, even on the Board's analysis of what the ordinary reader would have understood on receiving the decision, no reference is made to the appellant's submissions based on the amendment to Rule 164(2) EPC (see point XVI(h), above). The Board nevertheless does not consider that it would be equitable to reimburse the appeal fee for this reason alone since:

(a) This submission was just one in a series of other substantial submissions made in the letter of 23 January 2012 concerning the proper interpretation of Rule 164(2) EPC.

(b) The appeal on the Rule 164(2) EPC point has failed, this being the substantial part in the appeal.

(c) The appellant has not successfully defended any of the requests on which the decision of the Examining Division was based. The appeal has succeeded only on the basis of an amended second auxiliary request that was filed during the appeal proceedings.

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 examination on the basis of the second auxiliary request.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

P. Martorana

U. Krause