

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 5 November 2013**

**Case Number:** T 2473/12 - 3.3.09  
**Application Number:** 05780357.9  
**Publication Number:** 1788059  
**IPC:** C09J 183/00, C09J 11/06,  
G02B 6/36  
**Language of the proceedings:** EN

**Title of invention:**

Adhesive compositions for optical fibers

**Applicant:**

THE YOKOHAMA RUBBER CO., LTD.  
Mitachi, Seiko

**Headword:**

-

**Relevant legal provisions:**

EPC R. 164(2)  
Paris Convention Art. 2(1)

**Keyword:**

"Applicant entitled to pursue subject-matter not covered by  
supplementary European search report (no)"  
"Applicant entitled to have further search drawn up (no)"  
"Conflict with Paris Convention (no)"  
"Reimbursement of appeal fee (no)"

**Decisions cited:**

G 0003/92, G 0002/98, G 0002/08, J 0015/80, J 0006/05,  
T 1981/12

**Headnote:**

(1) Under Rule 164(2) EPC an applicant is not entitled to  
limit the application to an invention covered only by the

international search report and have the corresponding claims examined for patentability: T 1981/12 applied (points 3.5, 4.3 and 4.4 of the reasons).

(2) The effect of Rule 164(2) EPC whereby a national of a non-EPC contracting state may be obliged to file one or more divisional applications in order to obtain protection for subject matter not covered by the supplementary European search report does not amount to different national treatment within the meaning of Article 2(1) of the Paris Convention (point 5.4 of the reasons).

(3) Under Rule 164(2) EPC an applicant who limits the application to an invention covered by the international search report but not to one covered by the supplementary European search report is not entitled to have a further search drawn up by the EPO (point 6 of the reasons).



Case Number: T 2473/12 - 3.3.09

**DECISION**  
of the Technical Board of Appeal 3.3.09  
of 5 November 2013

**Appellant:** THE YOKOHAMA RUBBER CO., LTD.  
(Applicant 1) 36-11, Shimbashi 5-chome  
Minato-ku  
Tokyo 105-8685 (JP)

**Appellant:** Mitachi, Seiko  
(Applicant 2) 1-28-19-1-36-303 Fujimidai  
Kunitachi-shi, Tokyo 186-0003 (JP)

**Representative:** Vossius & Partner  
Siebertstraße 4  
D-81675 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 4 July 2012  
refusing European patent application  
No. 05780357.9 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** W. Sieber  
**Members:** K. Garnett  
N. Perakis

## **Summary of Facts and Submissions**

I. The applicant (hereafter: the appellant) appeals against the decision of the Examining Division refusing the Euro-PCT application No. 05780357.9. The decision was dated 21 June 2012 and posted to the appellant on 4 July 2012.

II. The PCT application was filed with the Japanese Patent Office (hereafter: JPO), whose search report covered the subject-matter of all claims. On entering the European phase, however, the Search Division considered that the claims as filed, which were the same as those filed with the PCT application, were non-unitary. In accordance with Rule 164(1) EPC, the supplementary European search report was therefore drawn up only for those parts of the application which related to the invention first mentioned in the claims, namely claims 1-4 (completely) and claim 13 (partially). The appellant was invited in the search report to restrict the application to the claims covered by the European search report and was informed that the excised matter might be made the subject of one or more divisional applications. Following a communication under Rule 70(2) EPC the appellant consented to the application being proceeded with and subsequently (on 26 February 2010) filed amended claims. These claims were not, however, restricted in the way invited; instead, claims 1 to 4 as originally filed were deleted and the claims were restricted essentially to claims 5 to 13 as originally filed. It was argued by the appellant that it was entitled to do this because these claims had been searched completely in the international phase: Rule 164(2) EPC allowed an applicant to restrict the

application to any invention covered either by the supplementary search report or the international search report. In a communication dated 4 June 2010, the Examining Division stated that the appellant was not entitled to pursue the application based on un-searched subject matter (citing Rules 137(4) and 164(1) EPC, and various paragraphs from the Guidelines for Examination). Such subject-matter could only be pursued as part of a divisional application. After further exchanges between the appellant and Examiner, the application was ultimately refused on the basis of this set of claims. The Examining Division's refusal, taken according to the state of the file, cited the various communications from the Examiner, from which it can be gathered that the essential reason for the refusal was that the applicant was not entitled to pursue an application based on unsearched subject matter, i.e., claims which had not been the subject of the European supplementary search report.

III. The appellant filed a notice of appeal on 14 September 2012 and paid the appeal fee on the same day. A statement of the grounds of appeal was filed on 6 November 2012. On 21 May 2013 the Board sent a communication to the appellant annexed to a summons to oral proceedings setting out its provisional views. The appellant filed submissions in response on 29 August 2013. In a communication sent by fax on 26 September 2013 the Board drew the attention of the appellant to the decision in T 1981/12. Oral proceedings took place on 2 October 2013, at the end of which the debate was closed and the proceedings were ordered to be continued in writing.

IV. By letter dated 8 October 2013, and thus after the debate had been closed, the appellant filed further submissions.

V. The submissions of the appellant in the written phase of the proceedings and as supplemented at the oral proceedings can be summarised as follows:

(a) The Examining Division's construction of Article 164(2) EPC was wrong because it is not in line with the actual wording of Article 164(2) EPC. This wording says expressly that in circumstances such as the present the applicant is to be invited "to limit the application to one invention covered by the international search report ... or the supplementary European search report." An applicant has the choice of which invention to pursue so long as it was either searched in the international phase or in the European phase. It is not permissible for the EPO to act as legislator and construe the rule in a different sense or to add further limitations or restrictions to it. The appellant accepts that the EPO cannot be required to examine an application for patentability on the basis of claims which have not been searched by the EPO. Nevertheless, in circumstances such as these the EPO should have done what it does in other cases, for example where the Examining Division considers that the Search Division's view on unity was wrong, and simply direct that a further search report be drawn up. CA/PL 17/06, page 444 (hereafter simply: CA/PL 17/06) makes it clear that the legislator was acting under the assumption that if the

application was non-unitary then this would be recognised by the ISA in the international phase and not for the first time by the EPO in the national phase. The present situation appears to have been overlooked, which is why no additional search or search fee has been expressly provided for. If the application had been filed as a Euro-direct application the applicant would have had the opportunity to have a search report drawn up in respect of the other inventions (Rule 64(1) EPC) and to choose which invention to pursue in the application. If the application had been filed as a PCT application and the lack of unity had been raised in the international phase, the applicant could have rearranged its claims on entering the European phase. The present situation has not arisen as the result of any fault of the applicant and such a result cannot have been intended.

- (b) The Examining Division's construction also does not conform to the intention of the legislator when new Rule 164(2) EPC was drawn up. CA/PL 17/06 makes it clear that the Euro-PCT application may be pursued on the basis of either the subject matter covered by the international search report or the supplementary European search report. CA/PL 17/06 also emphasizes that the Euro-PCT application is being brought into line with the Euro-direct procedure.
- (c) The Examining Division's construction is in contradiction with the equal treatment provision of Article 2(1) of the Paris Convention. This construction means that applicants from a country

which is not a member state of the EPC are treated less favourably than applicants from a country which is a member state of the EPC: in circumstances such as the present non-EPC state applicants must file one or more divisional applications if they wish to obtain protection for other inventions. This involves further costs, delay and loss of rights. This result can only be avoided if the EPO is obliged to conduct a further search, free of charge to the applicant.

- (d) The Examining Division's construction contravenes basic legal principles of the EPO. When entering the European phase, the appellant was unaware that an objection of lack of unity might be raised. It would be an undue burden and contrary to the principle of good faith if the applicant were forced to incur the costs of a divisional application in circumstances such as the present.

VI. The appellant also argued that the decision of the Examining Division was subject to a substantial procedural violation, essentially because no account was taken of the appellant's argument based on the Paris Convention.

VII. The appellant requests that:

- (a) The decision under appeal be set aside;
- (b) The case be remitted to the Examining Division so that the patentability of the set of claims filed on 26 February 2010 be assessed; and
- (c) The appeal fee be reimbursed.



## Reasons for the Decision

1. The appeal is admissible.

2. *General considerations*

2.1 The appeal is concerned with the proper interpretation and application of Rule 164(2) EPC. In its current version Rule 164 EPC as a whole 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.

(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."

2.2 In the present case, the decision to refuse the application was made under Article 97(2) EPC according

to the state of the file. The claims which formed the subject matter of the appellant's only request consisted essentially of claims 5 to 13 as filed on entry into the European phase. Although these claims had been covered by the search report drawn up by the JPO they were not covered by the supplementary European search report. This is because the EPO, unlike the JPO, considered the application to be non-unitary and so had applied Rule 164(1) EPC. The reason for the Examining Division's subsequent refusal of the application was essentially that the applicant was not entitled to pursue an application based on subject matter not covered by the supplementary European search report.

2.3 Following filing of the amended set of claims on 26 February 2012, it was not in dispute that the application as amended met the requirements of unity. In T 1981/12 the Board considered, in somewhat similar circumstances, that the correct basis for the refusal of the application was that the applicant was not entitled to pursue an application based on subject matter not searched by the EPO (see Catchword, point 1). This is the same approach as the Examining Division took in the present case and the Board agrees with it. The appellant does not in fact dispute that this principle is correct but argues that in circumstances such as the present:

(1) Under Rule 164(2) EPC an applicant can choose to limit the application either to an invention covered by the international search report or to one covered by the supplementary European search report and have the corresponding claims examined for patentability.

(2) If it chooses to limit the application to an invention covered only by the international search report then the EPO must carry out a further search, at no expense to the applicant.

3. *The construction of Rule 164(2) EPC*

3.1 The appellant argues that the rule should be applied as it stands: the rule clearly says that where the application documents in the European phase do not meet the requirements of unity, the applicant is to be invited (and is thus entitled) to limit the application to one invention covered either by the international search report or by the supplementary European search report. This is precisely what the applicant chose to do. It is argued that there is no room or justification for reading the rule in some other way.

3.2 In fact, as already pointed out, lack of unity was no longer an issue in the examination proceedings because at the outset the appellant had filed amended claims which were indisputably unitary. The applicable part of Rule 164(2) EPC was therefore:

"Where ... protection is sought for an invention not covered by the international search report or, as the case may be, by the ... or supplementary European search report, [the examining division] shall invite the applicant to limit the application to one invention covered by the international search report ... or the supplementary European search report."

The appellant's argument nevertheless remains essentially that set out in point 3.1, above: protection is being sought for an invention covered by the international search report; there is therefore no room for any further objection.

3.3 The Board concedes that the rule can be read in this way. But the construction of a written enactment must be purposive and not literal; a provision must be construed according to the ordinary meaning of the words used, in context and in the light of its object and purpose: G 2/08 (OJ EPO 2010, 456). Not all possible literal readings will necessarily be correct. In T 1981/12 the Board considered in detail the background of the rule. The Board noted that the drafting of the rule was less than ideal, not least because in its current version it attempted to deal with three situations at the same time. Nevertheless the Board construed the rule, in a situation where the EPO was not the ISA, as excluding the possibility of an applicant being entitled to choose to limit its application to an invention covered only by the international search report (Catchword, point 2). The reasoning of that Board is not repeated but the present Board agrees with it.

3.4 The appellant criticises the reasoning in T 1981/12 as arguing from back to front: the decision starts from the conclusion that the EPO will not examine claims not covered by an EPO search report, therefore Rule 164(2) EPC must be construed as effectively excluding the possibility of claims searched only by an ISA other than the EPO playing any role in the European phase, except as part of a divisional application. The

appellant in effect argues that the rule does not have to be construed bound up in such a straightjacket. The wording of the rule can be given its literal meaning without contravening the "no search - no examination" principle once it is appreciated that the EPO should simply carry out a further supplementary European search. The ties of the straightjacket are thereby undone.

- 3.5 The argument is beguiling but the Board cannot accept it. In reality, it is concerned with the second argument of the appellant, relating to the actual intentions of the legislator and whether an applicant is entitled to a further search, and the Board deals with it in that context. The present discussion is concerned only with the interpretation of the rule as it stands when read in context. For the same reasons as the Board in T 1981/12, the present Board concludes that the ordinary construction of Rule 164(2) EPC when read in context is that, in the present factual circumstances, where protection is sought for an invention not covered by a supplementary European search report, the applicant is to be invited to limit the application to the one invention covered by the supplementary European search report. The consequence of the applicant not doing so is that the application will inevitably be refused, being based on unsearched subject matter.

4. *The intention of the legislator: CA/PL 17/06*

- 4.1 The Board nevertheless concedes that the literal wording of the rule is ambiguous and therefore it is appropriate to look at the *travaux préparatoires* to the

rule, particularly if this helps to establish its intent and purpose.

4.2 The principal relevant material is CA/PL 17/06. This concerned the original version of Rule 164 EPC, before it was amended to take account of supplementary international search reports. The document states:

"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.

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)

- 4.3 The significance of CA/PL 17/06 in the interpretation of Rule 164(2) EPC was also considered by the Board in T 1981/12. It was concluded that it did not give any great assistance in interpreting the rule. The Board agrees with the general conclusions expressed there (points 7 and 8 of the reasons) and does not repeat them here. As regards the appellant's particular arguments, the Board does not agree that CA/PL 17/06 makes it clear that the Euro-PCT application may be pursued on the basis of either the subject matter covered by the international search report or the supplementary European search report. The critical wording ("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 ... ") is simply a compression of the wording in the rule and to the extent that the rule is ambiguous or difficult to construe, the same ambiguity or difficulty of construction is present in CA/PL 17/06.

4.4 As to the statement that the new rule would "bring the Euro-PCT procedure in line with the Euro-direct procedure", the present Board can accept, as did the Board in T 1981/12, that this is puzzling. The aspects of the two procedures which it seems are to be brought into line are those whereby: (a) a Euro-direct applicant can have non-unitary subject matter searched on payment of further search fees (Rule 64(1) EPC) and (b) a PCT applicant can, in the international phase, have non-unitary subject matter searched on payment of further search fees (Article 17(3)(a) PCT). It must be borne in mind, however, that this passage comes immediately after the statement that "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" (the Board's emphasis). Moreover, the framers of this document appear to have been concentrating on dealing with the problems which had arisen under Rule 112 EPC 1973 (see point 1 of the document, quoted above) and in this context the remarks about bringing the Euro-PCT procedure into line with the Euro-direct procedure are perfectly comprehensible (for an explanation of this rule, see T 1981/12, point 7.4(b) of the reasons). The Board can accept, as submitted by the appellant, that it may have been overlooked that the EPO may take a different view on unity than the ISA and that this situation was therefore not considered. However, the Board does not know for certain and has to take the rule as it finds it. The Board cannot itself legislate for a different version of the rule which may operate more fairly for the applicant.



5. *The Paris Convention*

5.1 The appellant relies on Article 2 of the Paris Convention ("PC"), headed "National Treatment for Nationals of Countries of the Union", which article provides:

"(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with."

In this context a "national" is to be understood as applying to a purely legal entity but recognised as a "national" where application of the Paris Convention is sought, for example a company such as the appellant which is incorporated under the laws of Japan or has its principal place of business there. See Bodenhausen, "Guide to the Application of the Paris Convention", page 28.

5.2 The appellant points out (correctly) that a national of a contracting state to the EPC ("a Euro-applicant") would have been entitled, either via a Euro-direct application or via a Euro-PCT application, to have all claims searched by the EPO as part of a single application and would not have been forced, as the

appellant has been, to file a divisional application if it wishes to achieve this result. The appellant argues that this means it is put to much greater cost, delay and loss of rights (because of the delay) than a Euro-applicant if the appellant wishes to obtain the same protection. The appellant says that the effect of the construction given to Rule 164(2) EPC by the Examining Division is that the appellant, as a Japanese national, does not have the same advantages or the same protection under the EPC as Euro-applicants. It argues that this differential treatment is an infringement of its rights within Article 2(1) PC, for which it does not have the same legal remedy as a Euro-applicant. It says that the only way to resolve this contradiction is to apply the literal wording of Rule 164(2) EPC (as in point 3.1 above).

- 5.3 The EPO is not a party to the Paris Convention and is thus not directly or formally bound by it: G 2/98 (OJ EPO OJ 2001, 413), point 4 of the reasons, J 15/80 (OJ EPO 1981, 213), point 5 of the reasons. Further, Article 2(1) PC is not one of the provisions of the Paris Convention which is expressly implemented by the EPC (compare the provisions on priority, to which effect is given by Articles 87 to 89 EPC). Nevertheless the EPC constitutes, according to its preamble, a special agreement within the meaning of Article 19 PC, this article providing that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of the Paris Convention. In the light of this the Board will assume, without

deciding, that the EPC should if possible be construed so as not to contravene Article 2(1) PC.

- 5.4 It is not necessary for the Board to reach any conclusion as to whether the matter of which the appellant complains falls within the ambit of the expressions "the same protection" or the "same legal remedy" in Article 2(1) PC. This is because the Board does not accept the appellant's core submission that it is exposed to any differential treatment under the EPC by reason of its nationality. Thus the different treatment in question arises because the international search report in this case was drawn up by an office other than the EPO, a matter over which the EPO has no control. The reasons for this different treatment are set out in detail in T 1981/12 and are not repeated here but briefly it is because a search drawn up by an office other than the EPO is not considered sufficient to enable the EPO to examine an application for patentability. There is nothing in the Paris Convention (or indeed in the PCT) which requires a national patent office to accept searches drawn up by other national patent offices as a basis for its own examination. The different procedural position in which the appellant finds itself, in particular requiring it to file a divisional application if it wishes to pursue subject matter not covered by the supplementary European search report, is in effect the EPO's answer to how to deal with this particular situation. While the Board accepts that the reason why the search was drawn up by the JPO rather than the EPO is to do with the appellant's nationality, this factor was not itself relevant in the application of Rule 164 EPC to the present application.

5.5 In J 6/05 it was pointed out that the restrictions in the EPC on the language of filing may favour some applicants over others but that such restrictions did not amount to a legally critical discrimination: see point 8.3 of the reasons. The point is not precisely the same as in the present case but illustrates that not all adverse effects arising out of national characteristics amount to differential national treatment under Article 2(1) PC.

5.6 The appellant's further submissions on the Paris Convention in its letter dated 8 October 2013 were filed after the debate had been closed, and are thus inadmissible. The Board has nevertheless taken note of them ex officio but they do not cause the Board to change its conclusions on this point.

6. *Entitlement to a (further) search*

The argument of the appellant that in the present case the EPO should simply carry out a further search at no expense to the applicant was also considered by the Board in T 1981/12 and rejected (point 9 the reasons). The present Board again agrees with that conclusion: Rule 164(1) EPC and CA/PL 17/06 make it clear that this is not an option. Moreover, the argument of the appellant, beguiling as it is, is not without further serious objections. In essence it requires the Board to fill in the gaps in the rule which the appellant argues exist because the present situation was overlooked. No doubt in the present case the matter would be straightforward: the further search report would only be required to cover one additional invention. But it is not fanciful to consider that there may be cases

where the finding of lack of unity by the EPO would result in there being 10, 100 or even more separate inventions, each of which the applicant could require the EPO to search at no cost to the applicant. It cannot be presumed that this is what the legislator intended. Further, if the submission were correct, it is not clear in what circumstances the EPO would be required to draw up a search to cover the further inventions: would this have to be done automatically as part of the supplementary European search report or only on request, by way of an additional supplementary European search report? These types of consideration illustrate the dangers of the Board in going further in construing a rule than is justified and in effect purporting to legislate itself.

7. *Contrary to legal principles before the EPO*

7.1 The appellant says that it was unaware that an objection of lack of unity might be raised on entering the European phase. It argues that it would be an undue burden and contrary to the principle of good faith if the applicant were forced to incur the costs of a divisional application in circumstances such as the present.

7.2 The short answer to this is that nothing which the EPO did in its communications with the appellant could have led the appellant to believe that Rule 164(2) EPC had the meaning for which the appellant argues. Quite the contrary. The appellant did not identify any other relevant principle of good faith which might be relevant and the Board knows of none.

8. The appeal must therefore be dismissed. The Board notes that Rule 164 EPC has now been changed but this cannot affect the decision in the present case. See CA/D 17/13, Article 3.
  
9. Since the appeal is to be dismissed the request for reimbursement of the appeal fee must also be refused (Rule 103(1)(a) EPC).

### **Order**

#### **For these reasons it is decided that:**

1. The appeal is dismissed.
  
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Canueto Carbajo

W. Sieber