

CA/91/13

Orig.: en

Munich, 27.09.2013

SUBJECT: Amendments to the Implementing Regulations to the EPC regarding unity of invention and further searches for Euro-PCT applications (Rules 164 and 135 EPC)

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: 1. Administrative Council (for decision)
2. Committee on Patent Law (for information)

SUMMARY

It is proposed to amend the procedures under Rule 164 EPC, which apply upon entry into the European phase, to ensure that all applicants, irrespective of the chosen route (Euro-direct or Euro-PCT) and International Searching Authority (EPO or another ISA), benefit from equal rights regarding the further prosecution of their application, especially in case of non-unity. This will give more flexibility to users and bring practice into line with the principle of equal service levels between the EP and PCT procedures at the EPO.

The present document is based on CA/PL 9/13, which was broadly supported at the 43rd meeting of the Committee on Patent Law. As set out in more detail in the document, the users have given strong support to the proposal.

Minor adjustments to the text of CA/PL 9/13 were made and some further explanations added.

TABLE OF CONTENTS

Subject	Page
PART I	1
I. STRATEGIC/OPERATIONAL	1
II. RECOMMENDATION	1
III. MAJORITY NEEDED	1
IV. CONTEXT	1
V. ARGUMENTS	3
A. PROPOSED (AMENDMENT OF) RULE 164(1) EPC - EPO DID NOT ACT AS THE (S)ISA	3
B. PROPOSED (AMENDMENT OF) RULE 164(2), (3), (4) EPC – EPO ACTED AS THE (S)ISA	5
C. PROPOSED RULE 164(2) EPC – CONCEPT AND BACKGROUND	6
D. PROPOSED RULE 164(2) EPC - ELEMENTS OF THE PROCEDURE	7
E. PROPOSED RULE 164(2) EPC - DECLARATION UNDER ARTICLE 17(2)(A) PCT	8
F. PROPOSED RULE 164(3) EPC	9
G. PROPOSED RULE 164(4) EPC	9
H. PROPOSED RULE 164(5) EPC – INVITATION CONSIDERED NOT TO BE JUSTIFIED	10
I. CONSEQUENTIAL AMENDMENTS	10
a) Rule 135 EPC (Further processing)	10
b) Article 2(1), item 2, of the Rules relating to Fees	11
J. TRANSITIONAL REGIME	12
K. ENTRY INTO FORCE	12
L. CONSULTATION	12
a) Consultation of users	12
b) Committee on Patent Law	12
M. FINANCIAL IMPLICATIONS	13

VI.	LEGAL BASIS	13
VII.	DOCUMENTS CITED	14
VIII.	RECOMMENDATION FOR PUBLICATION	14
	PART II	14

PART I

I. **STRATEGIC/OPERATIONAL**

1. Strategic

II. **RECOMMENDATION**

2. The Administrative Council is requested to approve the draft decision in Part II.

III. **MAJORITY NEEDED**

3. Three quarters.

IV. **CONTEXT**

4. The requirement of unity of invention prescribes that the application relates to one invention only or to a group of inventions so linked as to form a single general inventive concept (Rule 13.1 PCT, Article 82 EPC). As a consequence, in cases of non-unity, the search is performed only with respect to one invention or group of inventions so linked as to form a single general inventive concept. Applicants may generally pay additional search fees to extend the search to any further invention of their choice. However, there are discrepancies in practice between the EP and PCT procedures which have adverse consequences on the rights of PCT applicants.
5. In proceedings before the EPO acting as International Searching Authority (ISA), applicants may, in the event of a non-unity objection, pay additional search fees under Rule 40 PCT to extend the international search to any additional invention(s). Since applicants who selected the EPO as ISA must pursue their application in the European phase on the basis of claims which have been searched by the EPO (Rule 164 EPC), non-payment of additional search fees during the international phase implies that applicants must file divisional applications after entry into the European phase if they wish to pursue any additional invention(s).
6. There are three drawbacks to this practice:
 - First, unlike Euro-PCT applicants, Euro-direct applicants may pay further search fees in case of non-unity and select any searched invention of their choice for further prosecution (Rule 64(1) EPC).

- Second, many applicants may not wish to pay additional search fees so early in the procedure (around 16 months from the priority date), but prefer to postpone costs until after entry into the various national phases. As a result, applicants who selected the EPO as ISA but did not pay additional search fees are limited to inventions searched by the EPO as ISA. They have no other choice but to file divisional applications in the European phase in order to be able to prosecute their desired inventions. Applicants who selected another ISA are under no such constraint, as they may choose amongst their disclosed inventions upon entry into the European phase, irrespective of whether these inventions were searched by the ISA. They can prosecute the chosen invention in their Euro-PCT application, following a supplementary European search.
- Third, the current procedure does not take into consideration that, in the procedure for supplementary international search under the PCT (Rule 45bis PCT), there is no possibility to pay additional search fees. As a consequence, applicants who receive a supplementary international search report from the EPO have no other choice but to file divisional applications in the European phase for any additional invention(s).

7. In order to address the above drawbacks, it is proposed to modify the procedure under Rule 164 EPC as follows:

- First, all Euro-PCT applicants will have the right to have a search performed by the EPO on any invention claimed in the application documents which are to serve as the basis for the procedure in the European phase. This will apply irrespective of the ISA which performed the international search. As a result, applicants who selected the EPO as ISA, and for whom therefore supplementary European search is dispensed with, will likewise have the opportunity to request further searches with respect to inventions which were not searched during the international phase.
- Second, all Euro-PCT applicants will have the right to choose any invention searched by the EPO as the basis for the further prosecution of the Euro-PCT application in the European phase.

8. The proposed amendment of Rule 164 EPC will ensure that all applicants, irrespective of the chosen route (Euro-direct or Euro-PCT) and International Searching Authority (EPO or another ISA), benefit from equal rights regarding the further prosecution of their application, especially in case of non-unity. This will give more flexibility to users and bring practice into line with the principle of equal service levels between the EP and PCT procedures at the EPO..

V. **ARGUMENTS**

9. For the sake of clarity the two-part structure of Rule 164 EPC is retained. Proposed Rule 164(1) EPC provides for a procedure in which a supplementary European search must be performed (where the EPO was not the ISA). Proposed Rule 164(2) EPC applies if supplementary European search is dispensed with under Article 153(7) EPC (where the EPO was the ISA). The provisions in proposed Rule 164(3) and (4) EPC clarify some aspects of the procedure under proposed Rule 164(2) EPC. Proposed Rule 164(5) EPC provides for a refund of any search fee paid under Rule 164(1) or (2) EPC in line with Rule 64(2) EPC.

A. **PROPOSED (AMENDMENT OF) RULE 164(1) EPC - EPO DID NOT ACT AS THE (S)ISA**

**Present wording
Rule 164(1)**

(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.

**Proposed wording
Rule 164(1)**

(1) If the European Patent Office considers that the application documents which are to serve as the basis for the supplementary European search do not comply with the requirement of unity of invention, it shall:
(a) draw up a partial supplementary search report 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;
(b) inform the applicant that, for the supplementary European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period of two months; and
(c) draw up the supplementary European search report for the parts of the application relating to inventions in respect of which search fees have been paid.

10. Under current Rule 164(1) EPC, if the application documents do not comply with the requirement of unity of invention a supplementary European search report is drawn up on those parts of the application which relate to the invention first mentioned in the claims. Any further invention can be prosecuted by filing a divisional application only. This means that currently for Euro-PCT applications - unlike the procedure under Rule 64 EPC - an invitation to pay further search fees is not issued and further searches are not performed.
11. The proposed amendment of Rule 164(1) EPC will put Euro-PCT users on the same footing as Euro-direct users: both groups will (then), after having received the EPO's opinion on unity of invention, be entitled to have further searches performed upon payment of the search fee(s). Furthermore, both groups will be entitled to select, from among all inventions in the application documents which were searched by the EPO, the invention to be prosecuted in the European grant procedure for the (parent) application.
12. In line with the aim of having the same procedures in place for both categories of applications, proposed Rule 164(1) EPC follows, where possible, the wording of Rule 64 EPC. In proposed Rule 164(1) EPC the three elements of the procedure, regulated in the three sentences of Rule 64(1) EPC, are reflected in three separate paragraphs (a), (b) and (c) so as to improve the readability of the provision and the clarity of the procedure.
13. Since the basis of the supplementary European search, i.e. the application documents to be searched, may, after amendments have been made to the application, differ from the documents as originally filed (contrary to the procedure for search of a Euro-direct application), the wording of proposed Rule 164(1) EPC differs from Rule 64 EPC in this respect. This is expressed by the use of the wording "... *the application documents which are to serve as the basis for the supplementary European search ...*".
14. Other EPC provisions, for instance Rules 62a and 63 EPC, will be applicable in the procedure under proposed Rule 164(1) EPC as for any supplementary European search.
15. Proposed Rule 164(1) EPC takes precedence over Rule 64(1) EPC. This follows from the wording and role of proposed Rule 164(1) EPC as implementing rule to Article 153 EPC. The right to a refund in line with Rule 64(2) EPC is provided for in proposed Rule 164(5) EPC, so that the precedence of proposed Rule 164 EPC over Rule 64 EPC is complete (see also under F).

B. PROPOSED (AMENDMENT OF) RULE 164(2), (3), (4) EPC – EPO ACTED AS THE (S)ISA

**Present wording
Rule 164(2)**

(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.

**Proposed wording
Rule 164(2)-(4)**

(2) If the supplementary European search report is dispensed with and the Examining Division considers that in the application documents which are to serve as the basis for examination an invention, or a group of inventions within the meaning of Article 82, is claimed which was not searched by the European Patent Office in its capacity as International Searching Authority or Authority specified for supplementary international search, the Examining Division shall:

(a) inform the applicant that a search will be performed in respect of any such invention for which a search fee is paid within a period of two months;

(b) issue the results of any search performed in accordance with paragraph (a) together with:

- a communication under Article 94, paragraph 3, and Rule 71, paragraphs 1 and 2, in which it shall give the applicant the opportunity to comment on these results and to amend the description, claims and drawings, or**
- a communication under Rule 71, paragraph 3, and**

(c) where appropriate, in the communication issued under paragraph (b), invite the applicant to limit the application to one invention, or group of inventions within the meaning of Article 82, for which a search report was drawn up by the European Patent Office in its capacity either as International Searching Authority or as Authority specified for supplementary international search, or for which a search was performed in accordance with the procedure under paragraph (a).

(3) In the procedure under paragraph 2(a), Rules 62a and 63 shall apply mutatis mutandis.

(4) Rule 62 and Rule 70, paragraph 2, shall not apply to the results of any search performed in accordance with paragraph 2.

C. PROPOSED RULE 164(2) EPC – CONCEPT AND BACKGROUND

16. Upon expiry of the six-month time limit set in the communication under Rule 161/162 EPC, the examining division will under proposed Rule 164(2) EPC assess the application documents and issue an invitation to pay further search fees for any claimed invention in the application documents which are to serve as the basis for examination and for which no (additional) search fee has been paid to the EPO, where it has acted as the (S)ISA. The focus is on whether examination is requested for a non-searched invention, not on whether the application documents to be assessed by the examining division comply with the requirement of unity of invention. The reasons for this are twofold:
17. The application documents as amended may contain claims directed to a non-searched invention in other situations, not only where the application documents do not meet the requirement of unity of invention. For instance, the amended application may contain just one invention, but it may be an invention that was claimed but not searched by the EPO as (S)ISA in the international phase. If in this case a (further) search is not (also) offered, it would be an incentive not to amend the application upon entry into the European phase in such a way as to meet the requirement of unity of invention. Furthermore, it may be that as a result of amendments being made, an invention is claimed that was not claimed at the time the EPO performed the search in the international phase and for which consequently no search was performed by the EPO as (S)ISA. In both cases the EPO would be prepared to search the invention if a supplementary European search under Article 153(7) EPC were to be performed. Therefore, a search should also be offered if the EPO acted as the (S)ISA in the international phase for the application concerned.

18. Furthermore, it is noted that in the procedure before a SISA no further searches can be obtained, since the possibility to have more than one invention searched in that procedure is not provided for in the PCT (Rule 45*bis*.6 PCT). This means that, if the EPO acts as SISA, applicants have no way of paying the EPO further search fees and, therefore, they are, upon entry into the European phase, at present bound to the single invention searched by the EPO as SISA in the international phase. Proposed Rule 164(2) EPC would eliminate this consequence of filing a SIS request with the EPO.
19. In proposed Rule 164(2) EPC the term “supplementary European search” is not used because that term is reserved for searches performed under Article 153(7) EPC.
20. The procedure in proposed Rule 164(2) EPC is independent of the application of Rule 161(1) EPC (mandatory reply). If any invention is (still) claimed in the application documents that are to serve as the basis for examination in the European phase and a negative WO-ISA/IPER was drawn up in respect of that invention, there is no reason not to require a reply thereto. For instance, if the applicant has amended the application documents before expiry of the time limit set in the invitation under Rule 161/162 EPC by either deleting the invention for which a negative WO-ISA/IPER has been drawn up or by addressing the objections raised in the WO-ISA/IPER in respect of that invention, he has fulfilled the obligation to reply under Rule 161 EPC.

D. PROPOSED RULE 164(2) EPC - ELEMENTS OF THE PROCEDURE

21. Since the application is within the competence of the examining division, and in accordance with Rule 62(1) EPC (“unless ...”), the results of the search are to be annexed to a communication under Article 94(3), and Rule 71(1) and (2), or Rule 71(3) EPC. Therefore, no search opinion under Rule 62(1) EPC will accompany the results of any further search performed under proposed Rule 164(2) EPC (see also under E).
22. It is important that the public is informed of the results of any search performed under proposed Rule 164(2) EPC so as to provide transparency. Therefore, and in view of efficient internal processing, this information should be easily accessible and retrievable. The most suitable format is to be established at a later stage but could be the format of a European search report entitled “Search report under Rule 164(2) EPC”. The issuance of any search report under proposed Rule 164(2) EPC will be made retrievable via the European Patent Register.

23. Paragraph (b) of proposed Rule 164(2) EPC provides for a right to amend the application in response to the results of any further search under proposed Rule 164(2) EPC. This right to amend the application documents once after receipt of the result of any search under proposed Rule 164(2) EPC is to be regarded as a limited exception to Rule 137(3) EPC for the purpose of amending the application in view of the outcome of the procedure under proposed Rule 164(2) EPC. The provision is inspired by Rule 137(2) EPC, allowing the applicant to amend the description, claims and drawings in response to the search results received. In the communication by which the search results are communicated the applicant is (also) invited to bring the application into line with the requirement of Article 82 EPC and any further relevant requirement under the EPC that is to be complied with.
24. For further prosecution, the applicant may choose any invention which has been searched by the EPO either as (S)ISA or as designated/elected Office under proposed Rule 164(2) EPC. In other words, as regards the invention to be prosecuted in the European phase, the applicant's choice would not be limited by the inventions searched by the EPO in the international phase.
25. It follows from proposed Rule 164(2)(b) and (c) EPC that the special procedure under proposed Rule 164(2) EPC ends upon expiry of the time limit set in the communication issued under paragraph (b).
26. If search fees are not paid in due time under proposed Rule 164(2) EPC, a communication under Article 94(3), and Rule 71(1) and (2), or Rule 71(3) EPC will be issued and – in accordance with standard practice – the examining division will require deletion of any non-searched subject-matter (EPO Guidelines H-II, 6 and 7, and C-III, 3.1.1-3.1.2).

E. PROPOSED RULE 164(2) EPC - DECLARATION UNDER ARTICLE 17(2)(A) PCT

27. If the EPO as (S)ISA issued a declaration of no search under Article 17(2)(a) PCT (very rare cases), this declaration takes the place of the European search report as any international search report (Article 153(6) EPC). Further, in case the EPO acted as ISA in the international phase, no supplementary European search is performed upon entry into the European phase, because dispensation under Article 153(7) EPC applies. Accordingly, if an application enters the European phase with a declaration of no search drawn up by the EPO as ISA the application is considered to have been searched and examination of the application will start upon expiry of the time limit under Rule 161 EPC without (first) a supplementary European search report being drawn up.

28. In that case, if upon expiry of the time limit under Rule 161 EPC (the claims of) the (amended) application has (have) been sufficiently clarified to allow a search to be carried out, the examining division performs an additional search which is covered by the international search fee paid, on condition that (the claims of) the (amended) application documents that serve as the basis for the procedure in the European phase concern the invention for which the declaration of no search was established. If, however, one or more inventions are claimed that are different from the invention for which the EPO established a declaration of no search, the procedure under proposed Rule 164 EPC will apply in respect of these other inventions and the applicant will be invited to pay any fee due under proposed Rule 164 EPC if he wishes such inventions to be searched.

F. PROPOSED RULE 164(3) EPC

29. If (further) searches are to be performed under proposed Rule 164(2) EPC, Rules 62a and 63 EPC are applicable (*mutatis mutandis*) as to any (supplementary) European search. For reasons of clarity this is explicitly stated in proposed Rule 164(3) EPC.

G. PROPOSED RULE 164(4) EPC

30. If an invention is claimed for which no search was performed by the EPO in the international phase, the procedure under proposed Rule 164(2) EPC may be qualified as a "search incident" during examination. The fact that such an incident takes place after the start of examination has no effect on the competence of the examining division (Rule 10(2),(3) EPC). Pursuant to Article 153(6) EPC the term "European search report" in Rule 70(2) EPC is to be understood as "international search report" (ISR) if the EPO acted as (S)ISA in the international phase. For reasons of clarity, and with reference to the complexity of the law, proposed Rule 164(4) EPC explicitly states that Rule 70(2) EPC does not apply in respect of search results issued together with a communication in accordance with the procedure under proposed Rule 164(2) EPC.
31. Since the search results are issued together with a communication of the examining division, a search opinion must not be drawn up. For reasons of clarity it is, therefore, confirmed in proposed Rule 164(4) EPC that Rule 62 EPC does not apply.

H. PROPOSED RULE 164(5) EPC – INVITATION CONSIDERED NOT TO BE JUSTIFIED

**Present wording
Rule 164**

**Proposed wording
Rule 164(5)**

(5) Any fee paid under paragraphs 1 or 2 shall be refunded if the applicant requests a refund and the Examining Division finds that the communication under paragraphs 1(b) or 2(a) was not justified.

32. If after any search under proposed Rule 164 EPC has been performed the examining division considers the invitation to pay a search fee under Rule 164(1) or (2) EPC to be (in part) unjustified, (the rationale of) Rule 64(2) EPC is to be applied. Rule 164 EPC has a *lex specialis* character in relation to Rule 64 EPC. Furthermore, a lack of sufficient justification may be established in respect of searches carried out under proposed Rule 164(1) and (2) EPC. For these two reasons proposed Rule 164(5) EPC provides a legal basis for a refund as provided for under Rule 64(2) EPC. The same applied under Rule 112 EPC 1973, stating in its last sentence: “Rule 46, paragraph 2, [EPC 1973] shall apply mutatis mutandis”.

I. CONSEQUENTIAL AMENDMENTS

a) Rule 135 EPC (Further processing)

33. In accordance with Rule 64 EPC it is proposed that the time limit under proposed Rule 164(1) and (2) EPC should be added to the list of exclusions from further processing in Rule 135(2) EPC.

**Present wording
Rule 135(2)**

(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 36, paragraphs 1(a), 1(b) and 2, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 62a, 63, 64 and Rule 112, paragraph 2.

**Proposed wording
Rule 135(2)**

(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 36, paragraph 2¹, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 62a, 63, 64, Rule 112, paragraph 2, **and Rule 164, paragraphs 1 and 2.**

b) Article 2(1), item 2, of the Rules relating to Fees

34. Since proposed Rule 164(1) and (2) EPC provides a legal basis for the payment of search fees, Article 2(1), item 2, first indent, of the Rules relating to Fees needs to be amended.

**Present wording
Article 2(1)**

2. Search fee in respect of

- a European or supplementary European search on an application filed on or after 1 July 2005 (Article 78, paragraph 2, Rule 62, Rule 64, paragraph 1, Article 153, paragraph 7)

**Proposed wording
Article 2(1)**

2. Search fee in respect of

- a European or supplementary European search on an application filed on or after 1 July 2005 (Article 78, paragraph 2, Rule 62, Rule 64, paragraph 1, Article 153, paragraph 7, **Rule 164, paragraphs 1 and 2)**

¹ In CA/89/13 it is proposed to amend Rule 135(2) EPC as from 1 April 2014. Therefore, the wording of Rule 135(2) EPC proposed here is based on the proposed wording in CA/89/13.

35. In CA/85/13 it is proposed to amend Article 2 of the Rules relating to Fees as from 1 April 2014. Therefore, the amendment of the wording of Article 2(1), item 2, first indent will be part of the proposed (draft) decision in CA/85/13.

J. TRANSITIONAL REGIME

36. It is proposed that:

- proposed Rule 164(1) EPC shall apply to any application for which the supplementary European search report has not been drawn up at the date of entry into force.
- proposed Rule 164(2) EPC shall apply to any application for which the first communication under Article 94(3) EPC and Rule 71(1) and (2) EPC or, as the case may be, Rule 71(3) EPC has not been drawn up at the date of entry into force.

37. This transitional regime will allow a maximum number of applications the benefit of proposed Rule 164 EPC and, at the same time, will provide a simple and clear procedure both for the Office and for applicants.

K. ENTRY INTO FORCE

38. The proposed date of entry into force of the amendments to Rule 164 EPC and Rule 135(2) EPC is 1 November 2014.

L. CONSULTATION

a) Consultation of users

39. The proposal received strong user support at the 8th meeting of the SACEPO Working Party on Rules on 17 May 2013. This support was tacitly confirmed in the SACEPO meeting on 19 June 2013. Broad user support was also received via the online user consultation in January-February 2013.

b) Committee on Patent Law

40. The proposal was presented to the Committee on Patent Law at its 43rd meeting on 17 September 2013 under CA/PL 9/13 and got broad support.

M. FINANCIAL IMPLICATIONS

41. The direct financial impact of the present proposal will be reflected in the following three aspects.
42. Firstly, the proposal enables applicants to request in the European phase a further search being carried out for each invention mentioned in the claims which was not searched by the EPO in the international phase. A further search under proposed Rule 164 EPC requires payment of a further European search fee. Based on the experience under Rule 112 EPC 1973, it is expected that under proposed Rule 164 EPC applicants will request about 3000 to 4000 further searches per year. This will generate cash receipts from European search fees (under the new fee proposal as of 1 April 2014) estimated between € 4m and € 5m per year.
43. Secondly, about 1000 of the expected further searches under proposed Rule 164 EPC are currently performed by the EPO as ISA under Rule 40 PCT. It is expected that this conversion effect (i.e. the replacement of a search under Rule 40 PCT by a search under Rule 164 EPC) will generate lost cash receipts estimated at € 0.6m per year.
44. Thirdly, it is expected that proposed Rule 164 EPC will result in fewer divisional applications being filed, since applicants will be able to obtain a further search without having to file a divisional application first. Upon receipt of the result of the further search, they may have lost interest in filing a divisional for the invention concerned. Based on the experience under Rule 112 EPC 1973 and under the assumption that applicant behaviour will not change, it is estimated that about 400 to 500 fewer divisional applications will be filed per year. This represents lost cash receipts estimated to € 4m per year.
45. In summary, under the assumption of no significant change in applicant behaviour, the impact on the cash income of the Office as a result of the rule changes proposed is estimated to be marginal.

VI. LEGAL BASIS

46. Article 33(1)(c) EPC.

VII. DOCUMENTS CITED

47. CA/PL 9/13, CA/85/13, Guidelines for Examination in the EPO (H-II, 6 and 7, and C-III, 3.1.1-3.1.2)

VIII. RECOMMENDATION FOR PUBLICATION

48. Yes

PART II

Draft

DECISION OF THE ADMINISTRATIVE COUNCIL
of [date of decision]
amending Rules 135 and 164 of the Implementing
Regulations to the European Patent Convention

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention (hereinafter referred to as "EPC") and
in particular Article 33(1)(c) thereof,

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

Article 1

The Implementing Regulations to the EPC shall be amended as follows:

1. Rule 164 shall read as follows:

"Rule 164
Unity of invention and further searches

(1) If the European Patent Office considers that the application documents which are to
serve as the basis for the supplementary European search do not comply with the
requirement of unity of invention, it shall:

(a) draw up a partial supplementary search report 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;

(b) inform the applicant that, for the supplementary European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period of two months; and

(c) draw up the supplementary European search report for the parts of the application relating to inventions in respect of which search fees have been paid.

(2) If the supplementary European search report is dispensed with and the Examining Division considers that in the application documents which are to serve as the basis for examination an invention, or a group of inventions within the meaning of Article 82, is claimed which was not searched by the European Patent Office in its capacity as International Searching Authority or Authority specified for supplementary international search, the Examining Division shall:

(a) inform the applicant that a search will be performed in respect of any such invention for which a search fee is paid within a period of two months;

(b) issue the results of any search performed in accordance with paragraph (a) together with:

- a communication under Article 94, paragraph 3, and Rule 71, paragraphs 1 and 2, in which it shall give the applicant the opportunity to comment on these results and to amend the description, claims and drawings, or

- a communication under Rule 71, paragraph 3,

and

(c) where appropriate, in the communication issued under paragraph (b), invite the applicant to limit the application to one invention, or group of inventions within the meaning of Article 82, for which a search report was drawn up by the European Patent Office in its capacity either as International Searching Authority or as Authority specified for supplementary international search, or for which a search was performed in accordance with the procedure under paragraph (a).

(3) In the procedure under paragraph 2(a), Rules 62a and 63 shall apply *mutatis mutandis*.

(4) Rule 62 and Rule 70, paragraph 2, shall not apply to the results of any search performed in accordance with paragraph 2.

(5) Any fee paid under paragraphs 1 or 2 shall be refunded if the applicant requests a refund and the Examining Division finds that the communication under paragraphs 1(b) or 2(a) was not justified."

2. Rule 135(2) shall read as follows:

"(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 36, paragraph 2, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 62a, 63, 64, Rule 112, paragraph 2, and Rule 164, paragraphs 1 and 2."

Article 2

Rules 164 and 135 EPC as amended by Article 1 of this decision shall enter into force on 1 November 2014.

Article 3

(1) Rule 164(1) EPC as amended by Article 1 of this decision shall apply to any application for which the supplementary European search report under Article 153(7) EPC has not been drawn up at the date of its entry into force.

(2) Rule 164(2) EPC as amended by Article 1 of this decision shall apply to any application for which the first communication under Article 94(3) EPC and Rule 71(1) and (2) EPC or, as the case may be, Rule 71(3) EPC has not been drawn up at the date of its entry into force.

Done at Munich, [date of decision]

For the Administrative Council
The Chairman

Jesper KONGSTAD