

# EPO relaxes its rules for further searches of Euro-PCT applications

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**On 1 November 2014 the EPO implemented an amended Rule 164 relating to searches of international applications that have entered the European phase (Euro-PCT applications). The Rule as amended allows further searches of claims of a Euro-PCT application to be carried out during the European phase if a lack of unity is found. The rule change applies to:**

- Euro-PCT applications for which the EPO was the International Searching Authority (ISA) and no Communication from the Examining Division (e.g. an Examination Report) was drawn up before 1 November 2014
- Euro-PCT applications for which the EPO was not the ISA and no supplementary European search was drawn up for before 1 November 2014



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**Therefore, it is applicable to all Euro-PCT applications entering the European phase after 1 November 2014, as well as some applications that entered the European phase much earlier.**

## Background

Previously, if a lack of unity objection was raised for an application in which the EPO was the ISA, the applicant could only pursue an invention searched during the international phase: the first invention of the claims, plus any further invention for which additional search fees were paid during the international phase. If a lack of unity objection was raised for an application where the EPO was not the ISA, the EPO would search one invention during the European phase: the invention first mentioned in the claims.

As the EPO can only examine and grant claims that have been searched, an applicant was constrained to what invention he could pursue during the European phase. Additional searching during the European phase was only possible if the applicant filed a divisional application (which can be very expensive).

The new rule change brings the further search procedure for Euro-PCT applications into line with the procedure for direct European

applications. For direct European applications, if a lack of unity is found, the EPO Searcher alerts the applicant and gives the applicant the opportunity to request one or more additional searches (on payment of a fee). Of course, to pursue more than one invention to grant it is still necessary to file a divisional application. However, for direct European applications it has been possible to know during the search procedure of the application whether any of the further inventions were patentable, and to pursue one of those inventions to grant in the application.

The amended Rule 164 procedure is as follows:

## If the EPO carried out the International Search as the ISA

On European phase entry no further search is carried out by the EPO. Instead, the EPO uses the International Search Report (ISR) that it drew up in the international phase. Soon after entry into the European phase, the applicant is given a 6-month period to make voluntary amendments and to reply to the Written Opinion of the ISR. At the end of the period, if the claims are found to lack unity and relate to unsearched subject matter, a Communication under amended Rule 164(2) EPC is issued. That Communication gives the applicant the

opportunity to pay for one or more additional searches within a fixed 2-month period. If any additional search fees are paid, the results of the further search(es) are sent to the applicant as an annex to the next Communication from the Examining Division. Any one of the searched inventions may then be pursued.

## **If the EPO was not the ISA**

On European phase entry the applicant is given a 6-month period to make voluntary amendments to the claims. After that period expires, the EPO carries out the supplementary European search. If a lack of unity is found, a partial supplementary European search report is drawn up for the first invention mentioned in the claims. At the same time the applicant is sent an invitation under Rule 164(1) EPC to pay further search fees for each unsearched invention within a fixed 2-month period. A supplementary European search report is then issued covering the first invention and any other inventions for which search fees have been paid. Any one of the searched inventions may then be pursued to grant during the examination stage.

the patentability of a second, or further, invention in a Euro-PCT application without having to file a divisional application directed to that invention. However, the applicant still does not get a choice of which invention is searched first by the EPO: it is always the first invention mentioned in the claims whether the EPO is the ISA or carries out the supplementary European search. Thus it is still important that the invention of most importance is mentioned first in the claim set that is to be searched by the EPO.

## **Summary**

The amendment of Rule 164 allows the EPO to carry out a search of more than one invention of a Euro-PCT application if it finds a lack of unity upon European phase entry. It therefore makes the search procedure more flexible. It also allows an applicant to find out about

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