

## Changes to searches on applications entering Europe via the PCT

As of 1st November 2014, the EPO is changing the way it searches PCT applications entering the European regional phase which are considered to relate to more than one invention. These changes will result in increased flexibility for the applicant and should help to reduce the likelihood of encountering unexpected costs.

### The current state of affairs

A European patent application is allowed to relate to a single invention, or to group of inventions linked by a "single general inventive concept" only. Applications relating to multiple inventions that contravene this requirement are said to "lack unity", and must be amended.

For applications filed directly at the European Patent Office (EPO) that are found to lack unity, a search report is issued for the invention **first mentioned** in the claims. An option is then given to pay additional fees to search the remaining inventions, meaning that ultimately the applicant is given the choice of which invention to proceed with.

For international (PCT) applications where the EPO is the international searching authority (ISA) and where a lack of unity is found, the same option to pay additional search fees is given in the international phase.

For PCT applications entering the European regional phase (Euro-PCT), if the **ISA is the EPO** and no additional search fees were paid during the

international stage, the applicant is forced to limit the application to the first invention searched during the international phase.

For Euro-PCT applications where the **ISA is not the EPO**, the EPO will carry out a supplementary search. If a lack of unity is found, this search will be limited to the first invention only. No option is provided to pay for searches on the remaining inventions.

Depending on the drafting style and filing strategy of the applicant, it is not unusual for PCT applications to be considered to lack unity by the EPO. The often formulaic way in which the EPO divides an application into different inventions, together with the fact that the commercial value of different claims can change, even over the lifetime of a PCT application, mean that the first invention mentioned in the claims may no longer represent the key commercial embodiment. At present, if the invention of greatest commercial interest in a Euro-PCT application is covered by claims which have not been searched, it is necessary to file a divisional application. This involves a significant

cost. While there is the opportunity to argue that a lack of unity objection is unfounded, in practice, it is very difficult to overcome such an objection once it has been raised.

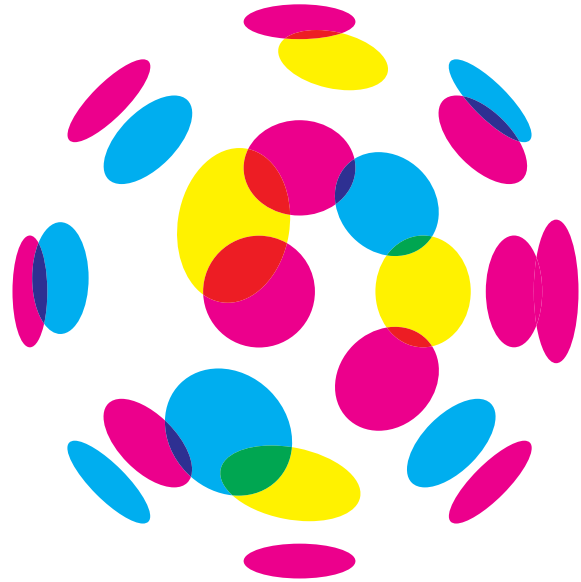
This current state of affairs is widely seen as unfair to Euro-PCT applicants.

### The new rules

On **1st November 2014**, the European Patent Convention is being amended to level the playing field for all applicants.

For **all** applications found to lack unity during the European search, the EPO will:

- issue a partial search report based on the invention (or linked group of inventions) **first mentioned** in the claims
- issue a communication detailing what it considers the other invention(s) to be
- invite the applicant, within a period of two months, to pay additional fee(s) to search the further invention(s)



- upon receipt of additional fee(s), issue an extended search report based on the invention(s) for which a fee was paid

This includes Euro-PCT applications where the ISA is the EPO which include inventions not yet searched. This can occur if a lack-of-unity objection was raised in the international phase by the EPO, but additional search fees were not paid at that time and so the international search report relates only to the first invention. In this situation, the EPO will also allow for additional search fees to be paid following entry into the European regional phase.

This is a change which will be welcomed by many. It will give the applicant **increased flexibility** during the search phase of a Euro-PCT application, and mean that an unexpected finding of lack of unity by the EPO can be easily managed by the payment of additional search fees. The need to pre emptively amend an application prior to EP regional phase entry is lessened, thereby delaying the point at which the applicant will need to select a single invention upon which to base their European patent application. As a consequence of the change, the applicant will always be given an opportunity to redirect a Euro-PCT towards the invention of greatest interest. This reduces the likelihood of the need to file unexpected divisional applications, in turn increasing certainty over future costs.

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## Need advice?

For more information, please contact [email@carpmaels.com](mailto:email@carpmaels.com).

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