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## Pay your money, take your choice: More search freedom for ex-PCT applicants at the EPO

Thorsten Bausch (Hoffmann Eitle) · Thursday, November 21st, 2013

According to a recent decision of the [Administrative Council](#), from November 2014 it will be possible, by paying appropriate further search fees, to obtain searches of any claimed invention when entering the EPO Regional phase with a PCT application, regardless of which Searching Authority handled the application in the International phase. It will thus be possible to prosecute the application before the EPO on the basis of any claimed invention, regardless of whether or not that invention was searched in the International phase. It will also be possible to obtain a relatively complete picture of the art likely to be material to the EPO prosecution for all claimed inventions before a decision is taken as to which to prosecute before the EPO and which, if any, to reserve to divisional applications.

At present, the EPO substantially restricts the subject-matter on which applicants using the PCT procedure can progress their applications before the EPO. If the applicant has chosen (or been required by nationality or residence) to use the EPO for a search in the International phase of the PCT application, then only the subject-matter searched by the EPO in the International phase can form the basis of prosecution before the EPO in the Regional phase. In contrast, if the applicant has not chosen (or been eligible) to use the EPO in the International phase, the EPO will only permit the application to proceed in the EPO Regional phase on the basis of what it deems to be the invention which is “first mentioned” in the claims – and it can be hard to predict what the EPO will consider to be the first-mentioned invention. In such a case, an applicant who wishes to protect any other deemed invention, even one originally present in the claims, must file a divisional application, potentially at some significant expense. These rules are stricter than those of many other National and Regional offices, and have been criticised as unfair and needlessly restrictive.

Under the new rules, applicants entering the EPO Regional phase with subject-matter present in the claims which was not searched by the EPO in the International phase will receive an invitation to pay further search fees in respect of the unsearched subject-matter within a two-month period. The results of such a further search will be supplied in the supplementary European search report in the case of an application which was not handled by the EPO as ISA or SISA in the International phase, or with the first communication of the Examining Division in the case of an application which was handled by the EPO in the International phase.

This approach will allow subject-matter which was not searched in the International phase to be made the subject of EPO prosecution, even if the EPO handled the application in the International phase. This change will thus restore equality as between PCT applicants who must use the EPO as

ISA and those who need not. Further, if multiple inventions are present in the claims on EPO Regional phase entry, or if newly-identified prior art compels reconsideration of the number of actual, objective inventions claimed, the applicant will have a choice as to which of the claimed inventions is to be pursued before the EPO by paying the necessary further search fees.

This change will therefore provide increased flexibility in the EPO regional phase for European applicants who are required to use the EPO as ISA, as well as non-European applicants whose applications contain multiple inventions in the claims present on entry to the EPO Regional phase. However, for applications entering the EPO Regional phase before November 2014, it will remain necessary to obtain all necessary searches in the International phase and carefully to consider the ordering of the claims for entry to the EPO Regional phase to minimise the prospect of being unable to obtain protection for important subject-matter otherwise than via the divisional route.

While there is little scope for delaying the PCT timetable in the International phase for applications due to enter the EPO Regional phase before November 2014 to take advantage of the new provisions, for applicants who might have been considering entering the EPO Regional phase early, delaying entry until at least November 2014 may now yield advantages in terms of increased flexibility. Since European Regional phase entry must be completed by 31 months from priority, PCT applications with priority dates later than 1 April 2012 will be able to benefit from the new, more flexible approach.

Mark Jones

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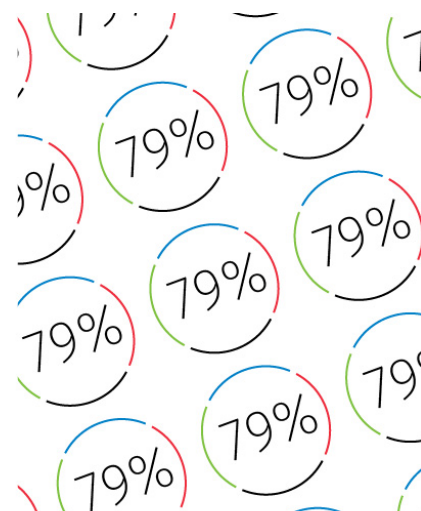
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