

# More EPO Rule Reversals - Additional Searches Available During European Regional Phase

October 28, 2013 | Blog | By Alison V. Haile

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Authored by Alison Haile

The European Patent Office (EPO) has announced rule changes that will provide applicants with the option to have additional searches carried out during the European regional phase of Euro-Patent Cooperation Treaty (PCT) applications.

In future, for any applications for which the EPO was not the International Searching Authority (ISA) and the supplementary European search report has not been drawn up by 1 November 2014, the EPO will issue an invitation to pay one or more additional search fees for the second and subsequent inventions identified by the examiner. An additional search report will then be drawn up for those inventions for which an additional fee has been paid and the applicant will be allowed to select the invention to be prosecuted within the application.

This is a significant improvement on the current situation, in which the search report is only drawn up in relation to the invention first mentioned in the claims and the applicant is forced into pursuing this invention or filing costly divisional applications if the subsequently mentioned inventions are of more interest. Applicants who have avoided using other ISAs, such as the [United States Patent and Trademark Office](#) (USPTO), for this reason may therefore now select the ISA of their choice without fear of restricting their future options in Europe.

The new rules will also be fairer to applicants of PCT applications for which the EPO was the ISA, as they will no longer be restricted to pursuing only subject-matter that was searched during the International phase. In future, for any applications for which the first examination report has not issued by 1 November 2014, if the claims contain unsearched subject-matter, or if there are multiple independent claims in the same category, the applicant will receive an invitation from the EPO to pay one or more additional search fees. The results of the additional search will be annexed to an examination report and if more than one invention is identified within the claims then the applicant will be invited to select one of the identified inventions for further prosecution. This means that applicants will not limit their options if they decide not to respond to an invitation from the EPO to pay additional search fees in the international phase and they will also have the opportunity to pursue any unsearched subject-matter present in the description which has subsequently become of interest.

This rule amendment therefore reverses some of the changes brought into effect by EPC2000 and should remove significant current restrictions on the subject-matter that may be pursued by an applicant during the European regional phase.

## Authors



**Alison V. Haile**