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## **PCT and EPO Search Fees; Unity of Invention**

### **What is a Search in the context of patent prosecution?**

Searches are conducted by Patent Offices searching for “prior art” that is relevant for the allowability of a patent application, that is whether a patent application is rejected or whether a patent is granted. “Prior art” is a legal term, meaning that for getting a patent granted, a combination of technical features claimed in a patent claim of a patent application needs to distinguish over the prior art, also called the “novelty” requirement, and needs to be inventive over the prior art, also called “inventive step” requirement, in the United States called “non-obviousness” requirement. There are some variances between patent laws as to what counts as prior art and what doesn’t, but in any case, the patentability requirements of novelty and inventive step are measured against the prior art.

### **What is a Search Report?**

In many jurisdictions, the result of the search is reported in a specific format as a separate search report, correlating the features claimed in the patent claims to the prior art that has been found in the search. Such prior art can have many forms, but the most common type of prior art are documents that were published prior to the filing date of a patent application, or if a priority was validly claimed, prior to the priority date of the patent application. The most commonly cited documents are patent application publications or scientific articles published prior to the filing or priority date, but also other prior art documents are sometimes cited as prior art, such as brochures, Youtube video clips or text books. The search report typically lists the relevant text passages of

these prior art documents and lists for which particular claims these text passages may be relevant.

### What are the “Unity of Invention” and other limitations of a Search?

It is apparent that searching for and correlating prior art to specific combinations of technical features as claimed in patent claims requires tedious work by an Examiner. Although search fees need to be paid by the Applicant of a patent application, this work is typically subsidized by Patent Offices by other fee income such as for example renewal fees. Understandably, Patent Offices need to limit the search to one invention per search fee. This limitation is typically known as the “Unity of Invention” requirement. Although slightly different, U.S. patent law provides for a similar requirement named “Restriction Requirement”. On top of the Unity of Invention requirement, Patent Offices may apply additional search limitations, such as the “Conciseness Requirement” essentially limiting the search to one independent claim per claim category apparatus or method and their dependent claims; may raise indefiniteness rejections, for instance excluding multiple dependent claims from the search or claims that are not clear; or may exclude inventions in certain International Patent Classification classes (IPC classes) from the search, such as patent applications claiming business methods. There are relatively significant variances as to what combinations of technical features as defined in patent claims a respective Patent Office agrees to search or refuses to search.

### What is the procedural consequence of a limited search?

In a nutshell, what hasn't been searched cannot be examined, and what cannot be examined will not be granted as a patent. This leads to the question, when encountering search limitations, what are the available remedies to get all subject matter searched for which a granted patent is sought? Part 2 on Search Fees in the PCT phase and before the EPO will discuss various options for remedies that may fix search limitations.

## Remedies that may fix search limitations

After Part 1 on Search Fees in the PCT phase and before the EPO discussed the scenarios that may result in a limited search, this Part 2 discusses potential remedies after having encountered a limited search. Although it may be expensive and sometimes cost-prohibitive for the Applicant to fix the problem of a limited search, the good thing is that it at least can be fixed in most instances. Depending on which Patent Office and in which specific proceedings the search limitations happened (e.g. National/Regional patent prosecution compared to International Phase), typical remedies are:

- 1) Limit the claims to the searched subject matter
- 2) Pay additional search fees
- 3) File amended claims with entry into a national/regional phase based on PCT
- 4) File a Divisional Patent Application

### 1) Limit the claims to the searched subject matter

Other than generating some minor costs for some claim amendments, this is the most cost effective way to react on search limitations. When having several sets of claims each having an independent claim and dependent claims, it is a good preventive measure to list the claim set(s) first in the numerical sequence that is/are believed to be the most relevant. In many instances, Patent Offices just search the first set or sets of claims in the numerical sequence and raise their rejection of searching other claim sets just after having carried out the partial search for only one or some of the claim sets and sending the “partial” Search Report. In other words, no invitation to choose a certain claim set is provided prior to performing the partial search when a Patent Office determines that the Unity of Invention requirement is not fulfilled. If the claim searched in the partial search are not the most important claims, getting the more desired claim set searched is at that point either impossible in the same proceedings or requires paying additional search fees, should such latter option be available.

## 2) Pay additional search fees

Although additional search fee payment options do not apply before all Patent Offices and in all proceedings, as of right, this option exists for International Patent Applications under the Patent Cooperation Treaty (PCT), so-called PCT-Applications, under Rule 40.1 PCT, see [http://www.wipo.int/pct/en/texts/rules/r40.htm#\\_40](http://www.wipo.int/pct/en/texts/rules/r40.htm#_40). When choosing to forego the additional search fee payment option in the International (“PCT”) phase, additional search fee options may still exist later in the national/regional phases, depending on the International Searching Authority (ISA) in the PCT phase and further depending on the national/regional phase Patent Office. For instance, if the ISA was not EP in the PCT phase, the EPO conducts a Supplementary European Search. If a Unity of Invention rejection is raised in the Supplementary European Search phase, since November 1, 2014, a Partial Supplementary European Search Report is established, covering the first set(s) of claims in numerical sequence that are found by the EPO to be in line with the Unity of Invention requirement, and an invitation to pay additional Supplementary European Search fees is sent, see Rule 164 EPC at <http://www.epo.org/law-practice/legal-texts/html/epc/2016/e/r164.html> and EPO Guidelines for Examination at [http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h\\_ii\\_7\\_4\\_2.htm](http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h_ii_7_4_2.htm). Caveat: If no Supplementary European Search is conducted in the regional phase before the EPO, for instance since the ISA was EP in the PCT phase, no additional invitation to pay additional search fees in the regional phase before the EPO is made, see for instance EPO Guidelines for Examination at [http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h\\_ii\\_7\\_4\\_1.htm](http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h_ii_7_4_1.htm). In this case it is particularly important to make sure that the claims that should be pursued in the regional phase before the EPO were searched in the PCT phase.

## 3) File amended claims with entry into a national/regional phase based on PCT

The Applicant of a PCT application is guaranteed an opportunity to amend the claims, see for instance PCT Applicant’s Guide – National Phase, paragraph 6.013

<http://www.wipo.int/pct/guide/en/gdvol2/pdf/gdvol2.pdf>. Specifically when a national phase patent office does not rely on the International Search and therefore conducts a Supplementary Search, such as the EPO conducting a Supplementary European Search in case of most (but not all!) International Searching Authorities ISA, claims can be amended prior to the Supplementary Search so that this search then covers the claims the Applicant chooses to pursue. For these claim amendments, the Applicant should stay within the scope of the original disclosure since otherwise the search might be refused for the reason of extending the content of the application beyond the content of the application as filed, in case of the EPO see for instance Article 123 (2) EPC <http://www.epo.org/law-practice/legal-texts/html/epc/2016/e/ar123.html>.

#### 4) File a Divisional Patent Application

In most jurisdictions, Divisional Applications can be filed as long as the parent application is pending, and are treated as a form of direct patent application with a respective Patent Office, claiming the priority date and the filing date of the parent application. Divisional Applications are typically limited to the disclosure of the parent application, i.e. no new matter can be added that extends beyond the disclosure of the parent application. Consequently, the claims of the Divisional Application need to stay within the scope of the original disclosure since otherwise the search might be refused for the reason of extending beyond the content of the parent application as filed. Summarizing, the Divisional Application has the same priority date and filing date and the same disclosure as the Parent Application, but other than that is typically treated as completely independent application. Consequently, a completely new procedure starts for the Divisional Application, also meaning that a new search is started for the new claims of the Divisional Application. As far as the claims of the Divisional Application are partially overlapping with the claims of a Parent Application, sometimes a partial refund of the search fee can be obtained, but in any case, the full search fee needs to be paid upfront. A partial refund is discretionary.

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Alexander Schlee is a registered German, European and US patent attorney and holds the German equivalent to a master's degree in Mechanical Engineering. He is the founder of Schlee IP International P.C. in 2007 succeeding a Los Angeles branch office he founded as a former equity partner of Viering, Jentschura & Partners in the year 2000. Among other volunteer activities he served on the State Bar of California International Law Section Executive Committee and is a former president of the Los Angeles Intellectual Property Law Association LAIPLA. Alexander Schlee assists particularly clients having strong international Intellectual Property interests, among these especially clients doing business between the United States and Germany.