

reference to **G 2/92**, this choice cannot be altered once examination of that invention has commenced. **T 736/14** held that if an applicant responds unclearly or in a misleading way to an invitation from the examining division to specify which searched invention it wishes to prosecute further, then the division has to clarify this matter, e.g. via a further communication.

6.1. Consequences of non-payment of a further search fee

In view of differing decisions **T 178/84** (OJ 1989, 157) and **T 87/88** (OJ 1993, 430), the President of the EPO referred the following point of law to the Enlarged Board of Appeal:

"Can an applicant who fails to pay further search fees for a non-unitary application when requested to do so by the search division under R. 46(1) EPC 1973 pursue that application for the subject-matter in respect of which no search fees have been paid or must he file a divisional application for it?"

In the opinion of the Enlarged Board, given in **G 2/92** (OJ 1993, 591), the application could not be pursued for subject-matter in respect of which the applicants had not paid the further search fees. Instead the applicants had to file a divisional application for that subject-matter if they wished to continue to protect it. In the view of the Enlarged Board, it was clear from the procedural system of the EPC that the invention which was to be examined for patentability had to be an invention in respect of which a search fee had been paid prior to the drawing up of the European search report. Part IV of the EPC envisaged that an application progressed after filing from the search division to the examining division. One object of R. 46 EPC 1973 was to implement this procedure by ensuring that an appropriately extensive search was completed in respect of each individual application before it was examined by the examining division. To this end, in response to an invitation from the search division to pay one or more further search fees in respect of one or more further inventions to which the application related, applicants had to pay such fees if they wished to ensure that one of the further inventions could become the subject of the claims of that application. That was the proper interpretation of R. 46(1) EPC 1973 in context. This confirmed the practice according to **T 178/84**.

In **T 319/96** the initial application lacked unity, but no further search fee was paid. The applicant had argued that, because of the international-type search (Art. 15(5)(a) PCT) carried out by the EPO (in the priority application) for the subject-matter of original claims 4 to 10, it had not forfeited its right to choose and could therefore continue pursuing this subject-matter. It had paid a search fee for each of the two inventions, and two search reports had been prepared by the Office. The board, however, stated that under R. 46(1) EPC 1973 a search fee was to be paid for each further invention if the **European** search report was to cover that invention. R. 46 EPC 1973 did not provide that a search report from another procedure could be substituted for the European search report. The board referred rather to the possibility under Art. 10(2) RFees (see now Art. 9(2) RFees) of a full or partial refund of the European search fee where the Office has prepared an earlier search report on the same subject-matter. **G 2/92** applied also in the present case because in the context of the European procedure only one search report had been drawn up after payment of only one search fee.