

and drawings which did not refer to claimed inventions (R. 34(1)(c) EPC 1973). It would then be necessary to check in each case whether such adjustments ought to be deferred until allowable claims were submitted.

In J 24/96 (OJ 2001, 434) the board held that within the framework of R. 46 EPC 1973 it was the task of the examining divisions (and the boards of appeal) to examine whether communications of the search divisions under R. 46(1) EPC 1973 asking for further search fees were justified. R. 46(2) EPC 1973 did not, however, refer to any acts of the search divisions other than communications issued under R. 46(1) EPC 1973. It was therefore not necessary for an examining division to deal in a decision under R. 46(2) EPC 1973 with other objections raised by the applicants in connection with the search, such as that the partial search report was not drawn up in accordance with the Guidelines. The board observed that the examining divisions of course have the possibility of arranging for an additional search to be performed, if they consider a search report delivered by the search division incomplete, but that this had nothing to do with a formal decision issued under R. 46(2) EPC 1973 concerning the refund of further search fees upon request.

In T 188/00 the board pointed out that the review by the examining division under R. 46(2) EPC 1973 had to be carried out having regard only to the facts presented by the search division in its communication under R. 46(1) EPC 1973. Since in most cases objections against lack of unity were raised having regard to the prior art (i.e. a posteriori), the examining division had to base its review solely on the documents cited in the partial search report and on the specification of the different inventions drawn up by the search division, while taking into account any arguments of the applicant in support of a request for a refund. Concerning the analogous protest procedures under the PCT (R. 40.2(c) and (e) and R. 68.3(c) and (e) PCT), the boards of appeal had ruled that these reviews had to be based exclusively on the reasons given in the invitation to pay additional fees, having regard to the facts and arguments submitted by the applicants (W 4/93, OJ 1994, 939). However, in the case in hand the examining division had reasoned that the claims as filed lacked unity a posteriori as a consequence of the finding that claim 1 as filed lacked an inventive step having regard inter alia to document D4, was not cited in the partial search report. Thus the examining division had not reviewed the finding of lack of unity of invention within the meaning of R. 46(2) EPC 1973, but had carried out a fresh examination on the basis of a new document. Therefore its decision to refuse the refund of a further search fee had to be set aside for formal reasons alone; the appellant's refund request was justified. See also T 1414/18, with further references; also T 2873/19, in which the refund request was refused.

In the order of its decision on a requested refund of (further) search fees, the examining division must clearly specify the request which has been decided on, the extent to which it grants that request and orders a refund, and the outcome for any remaining parts of the request. Allowing a separate appeal against its interlocutory decision under Art. 106(2) EPC is a constitutive decision of the examining division which establishes the possibility of challenging the interlocutory decision by way of an appeal, and therefore it too should be included in the order (T 756/14).