

In T 2289/09 the appellant had argued that since it was accepted practice that amendment in a divisional application could be based on subject-matter searched in the parent application, it should also be accepted that subject-matter that had been searched in a divisional was considered searched subject-matter generally and could thus form the basis for amendment in a parent. These circumstances were not explicitly excluded in G 2/92 (OJ 1993, 591). The board disagreed. The Enlarged Board had stated in G 2/92 that when an applicant failed to pay the requested search fees, that subject-matter could not be pursued in the application for which the search was carried out, and furthermore that "the invention which is to be examined ... must be an invention in respect of which a search fee has been paid prior to the drawing up of the European search report". This statement had significance beyond the reasons given in G 2/92. When an applicant for a divisional application sought the benefit of an earlier search, he still had to pay the search fees (R 36(3) EPC). These were then refunded, conditional on the fulfilment of certain criteria (see decision of the President of the EPO pursuant to Art. 9(2) RFees, OJ SE 1/2010), namely if the EPO benefited from the earlier search report. There was no provision that would permit the EPO to proceed with search activities, including the examination of the claims in question and their scope, when no search fees were paid for a given part of an application, and also none that would entitle the examining division to request the payment of further search fees for the purpose of examining the usefulness of the earlier search on the divisional application.

In T 631/97 (OJ 2001, 13) the board held that R 46(1) EPC 1973 on its proper interpretation does not prohibit a review by the examining division of the search division's opinion on lack of unity where further search fees are not paid. A narrow interpretation of R 46(1) EPC 1973 whereby the finding of lack of unity by the search division is considered as final where the additional search fees are not paid would deprive the applicant of an opportunity to dispute that finding during the examination proceedings and would also unjustifiably restrict the power of the examining division on the question of unity to the subject-matter for which search fees were paid. Thus the board did not share the view held in T 1109/96. The board found the above interpretation of R 46(1) EPC 1973 to be in agreement with that of the Enlarged Board in G 2/92, and the examination procedure as set out in the Guidelines also to be in line with G 2/92. It noted furthermore, with reference to R 112 EPC 1973, that the practice of search and examination of international applications where the EPO was elected or designated Office was consistent with the above view. This decision was followed in T 708/00 (OJ 2004, 160) – also referred to in this chapter II.B.6.3.

## 6.2. Euro-PCT applications

An applicant may pay additional search fees in the international phase if invited to do so by the ISA under Art. 17(3)(a) PCT. Once the application has entered the European phase, R 164 EPC, as in force from 1.11.2014, allows applicants to obtain, upon payment of a (further) search fee, a search of any invention claimed which was not searched by the EPO in the international phase. Applicants may choose any invention searched by the EPO either in the international phase, in the procedure for supplementary search or in the procedure under R 164 EPC as a basis for further prosecution of the European phase (see notice of 10 June 2014, OJ 2014, A70, also for the transitional regime).