

6.4. Dispensing with further search fees

In W 36/90 and W 19/89, the board observed that where there was lack of unity in an international application, in particular if the objection was evident a posteriori, the search examiner might decide to supplement the international search with a search on the additional inventions as well as on the first invention. This was so particularly if the concepts of the inventions were very close and none of them required a search in different classification units, so that the search could be performed for all the inventions without creating too much extra work (see PCT Search Guidelines as agreed upon by the Interim Committee for Technical Cooperation at its seventh session in Geneva in October 1977, PCT/INT/5). In such a case no objection of lack of unity should be raised because charging further fees would be incompatible with the principle of equity vis-à-vis the applicant (see G 1/89, OJ 1991, 155; see also e.g. T 755/14).

According to T 806/18, where an independent claim is found to lack novelty, often a formal objection of lack of unity of invention could be envisaged between two or more groups of dependent claims. However, the search division (or the examining division reviewing a non-unity finding) should bear in mind that unity of invention under Art. 82 EPC is "merely an administrative regulation" (G 1/91, OJ 1992, 253) and should give due consideration to the advice from the Guidelines: "Lack of unity is not a ground of revocation in later proceedings. Therefore, although the objection is certainly made and amendment insisted upon in clear cases, it is neither raised nor insisted upon on the basis of a narrow, literal or academic approach. This is particularly so where the possible lack of unity does not necessitate a further search" (Guidelines – March 2022 version, F-V, 2.2; cf. Guidelines – November 2017 version, F-V.8, in force at the time of the contested decision). Hence, in determining whether to request further search fees, the search division should not adopt a purely algorithmic approach, but consider whether it would be reasonable, under the circumstances of the case and in the light of the subject-matter already searched and the prior art found, to demand additional fees for extending the search to the remaining claims.