

Learning path for patent administrators

European search: EPAC - entry level

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Introduction

This publication, "European search, EPAC - entry level", is part of the "Learning path for patent administrators" series is edited and published by the European Patent Academy. The series is intended for patent administrators who are taking part in training and certifications organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include: general aspects of the patent system; the European patent system and the European patent granting procedure; the International Patent System (PCT) and the PCT procedure; European and international publications; filing a European patent application and filing an international application; the formalities during the European and during the international search; the formalities during the European examination and during the international preliminary examination; the formalities during the appeal procedure after refusal (EPC), during the opposition procedure (EPC); national validation (EPC); entry into national/regional phases and entry into the European phase (PCT).

Each chapter focuses on one topic at entry, intermediate or advanced level, as appropriate. The series will be revised annually to ensure it remains up to date.

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All references to natural persons are to be understood as applying to all genders.

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1. Learning objectives

Participants in this course will learn about:

- the extended European search report
- when the European search takes place
- the amount of the search fees
- conditions for refunds of search fees
- the different search reports issued by the EPO
- special situations during the European search
- possibilities for speeding up the procedure
- possible steps after receipt of the European search report

2. The European search

The aim of the European search is to establish whether the subject-matter in the EP application is novel and involves an inventive step in relation to the state of the art. A search report provides information on the relevant prior art to the applicant, the examining division and, by means of its publication, to the public.

The so-called search division draws up the European search report on the basis of the claims, with due regard to the description and any drawings. It mentions the prior art documents, which were taken into consideration in assessing novelty and inventive step, that were available to the EPO at the time of the search.

The search report is accompanied by a written opinion on whether the application and the invention to which it relates meet the requirements of the EPC. The non-binding opinion is not published together with the search report, but is made available to the public by way of file inspection after publication of the application.

Said opinion will not be issued to applicants who filed a request for examination, paid the examination fee and waived their right to receive the communication under Rule 70(2) EPC before the search report has been communicated to the applicant. In this situation, the applicant will instead receive a first communication from the examining division.

Legal references:

Rule 61(1) EPC

3. How are search results communicated?

For EP direct applications, including divisional applications, the EPO issues a European search report together with a European search opinion, commonly known as the "extended European search report" (EESR).

For international applications in the regional phase before the EPO (Euro-PCT applications), the EPO issues a supplementary European search report together with a European search opinion. This

kind of communication is also called EESR. Euro-PCT applications are equivalent to EP direct applications.

4. When does the European search take place?

EP direct applications

The EPO aims to deliver the EESR within six months of filing, as envisaged by the EPO Early Certainty initiative. On average, the EPO issues EESRs within five months of the filing date.

Euro-PCT applications

Where the EPO was not the ISA or SISA, the EESR will be issued within six months of the date the formal check was carried out.

Where the EPO was the ISA or SISA, no supplementary European search takes place.

Divisional applications

The EESR is issued within six months of the date of receipt of the divisional application.

Legal references:

Art. 54, 56, 57 EPC

R. 61 EPC

GL B-II, 2

5. Fees payable for the European search

The applicant must pay the filing fee, any additional fees and the search fee, as well as any claims fees where claims were filed together with the application, within one month of the date of filing.

The EPO will not send any invoices or reminders to pay these fees in due time. If the applicant fails to pay the filing and search fees in due time, the European patent application is deemed to be withdrawn.

For divisional applications, the applicant must pay the filing fee, any additional fees, the search fee and any claims fees within one month of the date of filing.

Applicants failing to pay the filing fee, additional fee(s), the search fee, the designation fee or the examination fee within the above-mentioned time limits have the right to request further processing within two months of the notification of a communication of loss of rights under Rule 112(1) EPC. To request further processing, the applicant must pay the outstanding fee(s) and the prescribed fee for further processing.

Fee amounts, payment methods and effective payment dates are governed by the Rules relating to Fees (RFees) and by measures adopted by the President of the EPO implementing certain provisions of those Rules. Guidance on fee payment is published in every issue of the Official Journal of the EPO and [on the EPO website](#).

Refund of fees

In principle, validly paid fees are not refunded except where specifically provided for. There are two conditions for a fee payment to be fully valid:

1. the payment must relate to proceedings that are pending **and**
2. the date of payment must be on or after the due date

The search fee paid for a European search is refunded in full if the European patent application is withdrawn, refused or deemed to be withdrawn before the EPO has started the European search.

The European search fee is refunded in full or in part if the European search report can be based on an earlier search report already prepared by the EPO on a national, European or international application whose priority is claimed or, in the case of divisional applications, where the search report can be based on an earlier search report prepared by the EPO on the parent application.

A refund of the search fee can be requested by marking the corresponding box in section 40 of the request for grant form.

If the applicant instructed the EPO to do so, refunds will be credited to an EPO deposit account. Alternatively, applicants will be invited to [claim refunds via the EPO website](#), specifying a bank account to be credited.

Search fees for a supplementary European search

If a supplementary European search has to be carried out, the European search fee must be paid within 31 months from priority.

Reduction of the search fee

Where the ISR or SISR was drawn up by a European ISA, the fee for a supplementary European search is reduced by a fixed amount, which is currently (July 2022) EUR 1 185.00. The ISAs in question are:

- Austrian Patent Office (ISA/AT)
- Spanish Patent and Trademark Office (ISA/ES)
- Finnish Patent and Registration Office (ISA/FI)
- Swedish Intellectual Property Office (ISA/SE)
- Turkish Patent and Trademark Office (ISA/TR)
- Nordic Patent Institute (ISA/VN) or
- Visegrad Patent Institute (ISA/VX)

Please note: the reduction only applies to the search fee paid in accordance with [Rule 159\(1\)\(e\) EPC](#). Further search fees paid under [Rule 164\(1\) EPC](#) are not reduced and always have to be paid in full.

Where an ISA or SISA other than the ones mentioned above was selected, no reduction of the supplementary European search fee applies.

Refund of the supplementary European search fee

If the supplementary European search report is based on an earlier search report drawn up by the EPO, or if the application claims the priority of a previous application for which a search was carried out by the EPO, (part of) the fee paid for the supplementary European search may be refunded.

The level of the refund depends on the type of earlier search and the extent to which the EPO benefitted from the earlier search report when carrying out the supplementary European search.

If the search fee is not paid in due time, the Euro-PCT application will be deemed to be withdrawn and the EPO informs the applicant of this in a communication under Rules 112(1) and 160(2) EPC.

If, within two months of the notification of this communication, the applicant requests further processing, said loss of rights can be undone. This is subject to payment of the missing supplementary European search fee, together with a further processing fee amounting to 50% of the search fee.

Legal references:

Articles 9-12 RFees

Article 153(7) EPC

6. Special situations during the European search

Clarification request

If, during the European search, claims are found to either contain a plurality of independent claims and/or unsearchable/unclear subject-matter, the EPO will issue a communication under Rule 62a EPC (multiple independent claims) and/or Rule 63 EPC (complex application) inviting the applicant to overcome the deficiency by furnishing a statement indicating the claims or the subject-matter on which the search is to be carried out. Such a deficiency could be that:

- the subject-matter is not disclosed in a manner sufficiently clear and complete
- the claims
 - do not define the matter for which protection is sought
 - are not clear, concise or supported by the description

The form used for this is EPO Form 1056a. The period for response is two months, which is not extendable. The means of redress if that time limit is missed is a request for re-establishment of rights.

In exceptional cases, a telephone consultation may take place if the applicant phones the examiner after issuance of EPO Form 1056a. This consultation should normally be limited to formal issues concerning the content of the invitation and the course of action to be taken by the applicant. It is not intended to give the applicant the right to a detailed discussion on substantive matters.

If the applicant does not respond to EPO Form 1056a or if the applicant's statement is not sufficient to overcome the deficiency, the EPO will issue a partial European search report indicating which claims could be searched only partially or not at all. In the worst case scenario, the EPO may issue a declaration that no meaningful search can be carried out.

Amendments to the application are not allowed at this stage.

Later, when the examining division takes over, it will invite the applicant to delete the unsearched subject-matter from the application unless it finds that the objection was unjustified.

Subject-matter excluded from the European search

According to Art. 52 EPC, the following will not be regarded as inventions:

- discoveries, scientific theories and mathematical methods
- aesthetic creations
- schemes, rules and methods for performing mental acts, playing games or doing business and programs for computers
- presentations of information

According to Art. 53(c) EPC, European patents will not be granted in respect of:

- methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body

Declaration under Rule 63 EPC

If the search division finds that the application does not comply with the provisions of the EPC to such an extent that it is not possible to carry out a meaningful search, it will issue a declaration under Rule 63 EPC (declaration).

The declaration states that no search report is established and contains a clear reasoning as to why it is not possible to carry out a meaningful search. The applicant may file a response to the European search opinion that is issued together with the declaration. If that response overcomes the objections raised in the declaration, the examining division will carry out an additional search (see EPC Guidelines C-IV, 7.2. (ii)). The declaration does not set a time limit as no action is required from the applicant.

Lack of unity of invention

If the search division considers that the application does not comply with the requirement of unity of invention, it draws up a partial European search report on those parts which relate to the invention first mentioned in the claims. The EPO issues an invitation to pay further search fees. It contains:

- the number of further inventions found
- the amount payable for each further invention
- a reasoned statement as to why the EPO considers that there is lack of unity of invention
- a provisional opinion on the patentability of the invention first mentioned in the claims

If the European search report is to cover the other inventions, the applicant must pay a further search fee in respect of each of them within a non-extendable period of two months.

The provisional opinion is for information only. A reply addressing the points raised in the provisional opinion is not required and is not taken into account when the EESR is issued.

If the applicant does not respond to this invitation, and if the examining division considers the search division's objection justified, the application proceeds in respect of the invention for which the partial European search report has been drawn up. If the applicant pays further search fees, the European search report is drawn up for those inventions for which further search fees have been paid.

The applicant may also file divisional applications for unsearched subject-matter.

Any further search fees paid will be refunded, on the applicant's request, if the examining division finds that the search division's findings concerning lack of unity of invention were not justified.

Legal references:

Rule 63 EPC

7. Positive or negative opinion in the EESR

If the application seems to meet all the requirements of the EPC, the EESR will include a standard clause expressing a positive opinion that the application meets the requirements and is likely to result in the grant of a patent.

If the application does not seem to meet the requirements of the EPC, the EPO issues a negative opinion, which will serve as the basis for the communication under Art. 94(3) and Rule 71(1) EPC to be issued at a later stage.

For applicants paying the examination fee before search and filing a waiver indicating that they want to receive a communication under Rule 70a EPC, the European search opinion will be issued separately as a first communication from the examining division but very soon after the European search report.

Legal references:

R. 62, 70a EPC

8. Accelerating the search procedure: PACE

Applicants who want their applications processed rapidly may benefit from the programme for accelerated prosecution of European patent applications (PACE).

In July 2014, the EPO launched the Early Certainty from Search initiative (ECfS), according to which the EPO would strive to issue EESRs within a short time. For European patent applications filed on or after 1 July 2014 and international applications, where the EPO was not the ISA or SISA, entering the European phase, that time is within six months from the applicable date. This means that a PACE request is not needed for these applications. For more information please see OJ EPO 2015, A93.

Therefore in practice a PACE request during the search procedure is only applicable to European patent applications filed before 1 July 2014 and claiming priority.

The applicant can also, for example, simply waive their right to the invitation to confirm the request for examination in the request for grant form. In that case, when the applicant receives the EESR, the application simply moves on in the procedure and the examining division takes over.

A PACE request should be filed online using EPO Form 1005. This can only be done once. The request must be signed by an authorised person. PACE requests may only be filed for one application at a time.

Legal references:

OJ EPO 2010, 352

9. Accelerating the search procedure: PPH

Another option open to applicants wishing to speed up the search procedure is the Patent Prosecution Highway programme (PPH).

In principle, the PPH allows an applicant to request accelerated patent prosecution at the EPO where a corresponding application has already been found to contain patentable/allowable claims at a PPH partner office. The programme allows partner offices to reutilise work already available and hence process applications in an accelerated manner.

Currently (July 2022), the EPO maintains PPH programmes with all IP5 Offices, i.e. JPO (Japan), KIPO (Republic of Korea), CNIPA (People's Republic of China) and the USPTO (United States). Further PPH partner offices are IPA (Australia), INPI (Brazil), CIPO (Canada), SIC (Colombia), ILPO (Israel), MyIPO (Malaysia), IMPI (Mexico), INDECOPI (Peru), IPOPHL (the Philippines), IPOS (Singapore) and SAIP (Saudi Arabia). The PPH programmes with the Eurasian Patent Organization (EAPO) and ROSPATENT (Russia) are currently suspended.

Participation in the PPH programme at the EPO is free of charge.

To participate in the PPH programme, the applicant must fulfil the following requirements:

- the European patent application must have the same earliest date (i.e. priority or filing date) as the corresponding application
- the corresponding application must have at least one claim that is patentable/allowable
- all claims in the European patent application need to have a scope that is the same as, similar to or narrower than the corresponding application

The required documents for participation in the PPH programme are:

- [EPO Form 1009](#), including the declaration of "claims correspondence"
- a copy of the latest national or PCT work product drawn up by the office of later examination
- a copy of the patentable/allowable claims and copies of the documents cited in the national work product or latest PCT work product
- translations of the above if not in an official EPO language, unless already available to the EPO

Alternatively, applicants may request the EPO to retrieve the documents and/or translations from the available dossier access system ([electronic file wrapper](#)) or [PATENTSCOPE](#).

Legal references:

[R. 70, 161, 162 EPC](#)

OJ EPO 2010, 352

10. Invitation to respond to a search opinion

Applicants will be invited to comment on the EESR and/or to correct any deficiencies noted in the opinion accompanying it within the same six-month time limit as applies to filing or confirming the request for examination (EPO Forms 1081,1082,1083,1224).

Between receipt of the EESR and the examining division's first communication, the applicant must file substantive observations on any objections raised in the EESR. It is also possible to amend the

description, claims and drawings. If the EESR was negative and the applicant fails to comply with the invitation in due time, the application will be deemed withdrawn.

If no objections were raised in the EESR, no invitation will be issued. Instead, the applicant will be informed about the possibility of filing comments or making amendments within the same period.

If the applicant has validly filed the request for examination before receiving the EESR, the Receiving Section invites applicants to indicate whether they wish to proceed further with the application within six months of the date when the European Patent Bulletin mentions the publication of the EESR, pursuant to Rule 70(2) EPC. Again, if the applicant does not respond to this invitation in due time, the application is deemed to be withdrawn. In this case, too, further processing is available.

Legal references:

R. 68, 70, 137(1) and (2) EPC

11. Amendments allowed after receiving the search report

The applicant is not allowed to amend the description, claims or drawings before issuance of the EESR.

Within the time limit for requesting examination or confirming that request, i.e. when responding to the invitation to comment on the objections raised in the EESR, the applicant may, of their own volition, amend the description, claims and drawings. In reply to such an invitation, the applicant should always indicate any amendments made and identify their basis in the application as filed.

No further amendments are allowed without the examining division's consent.

Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention to form a single general inventive concept. In deleting subject-matter from an application, the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise the subject-matter cannot be reinstated.

The application may on no account be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. This does not include the priority document. However, subsequently filed examples or statements of advantage may be considered by the EPO as evidence in support of the invention's patentability.

Such information is generally added to the part of the file that is open to public file inspection. From the date on which it is added, it forms part of the state of the art within the meaning of Article 54(2) EPC. The public is alerted to the fact that information submitted after the application was filed is not included in the specification.

Legal references:

Art. 123(2) EPC

GL H-IV, 2.1

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