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Learning path for patent examiners

Final steps:
Intermediate level

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Introduction

This publication, "Final steps, Intermediate level", is part of the "Learning path for patent examiners" series edited and published by the European Patent Academy. The series is intended for patent examiners at national patent offices who are taking part in training organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include novelty, inventive step, clarity, unity of invention, sufficiency of disclosure, amendments and search. Also addressed are patenting issues specific to certain technical fields:

- patentability exceptions and exclusions in biotechnology
- assessment of novelty, inventive step, clarity, sufficiency of disclosure and unity of invention for chemical inventions
- the patentability of computer-implemented inventions, business methods, game rules, mathematics and its applications, presentations of information, graphical user interfaces and programs for computers
- claim formulation for computer-implemented inventions

Each publication focuses on one topic at entry, intermediate or advanced level. The explanations and examples are based on the European Patent Convention, the Guidelines for Examination in the EPO and selected decisions of the EPO's boards of appeal. References are made to the Patent Cooperation Treaty and its Regulations whenever appropriate.

The series will be revised annually to ensure it remains up to date.

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1. Learning objectives

Participants to this course will learn:

- The meaning of the search check list
- The meaning of search efficiency
- The definition of indicators of search completeness
- The definition of incomplete search

2. The search checklist: when to stop searching

For reasons of efficiency, the search division uses its judgement to end its search when the probability of discovering further relevant prior art becomes extremely low in relation to the effort needed. Therefore, before stopping a "complete search" and writing the written opinion (extended European search report), examiners should ask themselves the following questions:

- Have all the necessary steps been performed?
- Have the claims been analysed and the core invention identified?
- Have all immediately relevant documents been identified and retrieved?
- Has the technical background been understood?
- Have the documents cited in the description been consulted?
- Have the appropriate classification symbols (classes) been identified and used?
- Have suitable synonyms and keywords been applied?
- Are there any patent family members which have been searched by other patent offices and has use been made of these existing search results?

If the answer to all these questions is "Yes" then the search can be stopped, the search report drawn up and the written opinion prepared. The search may also be stopped when documents have been found that demonstrate lack of novelty in the entirety of the subject-matter of the claimed invention, apart from features which are trivial or common general knowledge in the field under examination, the application of which would not involve an inventive step.

However, even if no relevant documents have been found after extensive searching, examiners can still stop the search in the following situations:

- All the obvious places (and a few non-obvious places) have been searched.
- There are no more viable strategies.
- Time has run out.
- The same documents keep appearing.
- Good documents were found but they were published too late.
- The results are not getting any better and no better prior art is being found despite strategy refinements.
- An experienced examiner would stop searching at that point.

Legal references:
GL B-IV, 2.6

3. Indicators of completeness of the search

The following are indicators that a search is complete:

- Search queries using different approaches lead to the same or similar documents.
- Further changes to the search strategy result in more noise in the result set.

On the other hand, the following indicators suggest that a search is still incomplete:

- Despite having already been published, neither the application itself nor any family members appear in the result set.
- The queries used generate small result sets (probably because the queries are too specific).

Legal references:
GL B-IV, 2.6

4. Incomplete search (clarity aspects)

The procedures for dealing with cases which lack unity and where Rule 63 or Rule 62a EPC applies are dealt with in the Guidelines (GL) B-VIII, 3.4 and B-VIII, 4.5, respectively. Moreover, when the claims of the application do not relate to one invention only, or to a group of inventions linked to form a single general inventive concept, the search will normally be restricted to the invention or the linked group of inventions mentioned first in the claims (see GL B-VII and F-V, 3.4). The applicant must be notified of the restriction of the search for the above reasons in a communication accompanying the partial search report (see GL B-VII, 1.2).

Apart from the above situations, which have already been discussed in detail, serious clarity issues may also make a meaningful search impossible. In these cases, the search division applies the procedure under Rule 63 EPC (see GL B-VIII, 3.1 to B-VIII, 3.4; OJ EPO 2009, 533). The following examples illustrate where Rule 63 EPC may be applied.

Examples

Claims lacking support in disclosure of application

One example would be a claim so broadly formulated that its scope is speculative, i.e. not supported by the disclosure of the application. In this case, the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, and a meaningful search can only be performed on the basis of the invention disclosed in the examples.

Accordingly, the procedure under Rule 63(1) EPC may be applied (see GL B-VIII, 3.1 to B-VIII, 3.4). The requirements underpinning the application of Rule 63 EPC would be those of sufficiency of disclosure and support, as set out in Articles 83 and 84 EPC (see GL F-III, 1 and F-III, 2, and F-IV, 6). The search division must bear in mind that the requirements under Articles 83 and 84 EPC concerning sufficiency of disclosure and support are to be considered in relation to the person skilled in the art.

Claims lacking conciseness

One example would be where there are so many claims, or so many possibilities within a claim, that it becomes unduly burdensome to determine the matter for which protection is sought (for multiple

independent claims in the same category, see GL B-VIII, 4). A complete search (or any search at all) may be *de facto* impossible.

Again, it may be appropriate to apply Rule 63 EPC and issue a subsequent incomplete search report (in line with the procedures stated in GL B-VIII, 3.1 to B-VIII, 3.3) or a declaration of no search, on the grounds that the lack of conciseness of the claim(s) is such as to render a meaningful search impossible (see Article 84 EPC; GL F-IV, 5).

Claim lacking clarity due to parameters

One example would be where the applicant's choice of parameter to define the invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not used the same parameter or has used no parameter at all. In this case, the parameter chosen by the applicant may lack clarity (see Article 84 EPC; GL F-IV, 4.11).

It may be that the lack of clarity of the parameter is such as to render a meaningful search of the claims (or of a part of a claim) impossible because the choice of parameter makes it impossible to compare the claimed invention with the prior art. If so, it may be appropriate to apply Rule 63 EPC and issue a subsequent incomplete search report under Rule 63(2) EPC (in line with the procedures stated in GL B-VIII, 3.1 to B-VIII, 3.3), the search possibly being restricted to the worked examples, as far as they can be understood, or to the way in which the desired parameter is obtained. Any response from the applicant to the Rule 63(1) invitation will be taken into account in determining the subject-matter to be searched to the extent indicated in GL B-VIII, 3.2.

Claims contravening Article 76 or Article 123 (2) EPC

Rule 63 EPC may also be applicable to claims containing added subject-matter in the following cases (see GL B-VIII, 6):

- claims in divisional applications contravening Article 76 EPC
- applications for which the claims were filed after the filing date and which contravene Article 123(2) EPC
- Euro-PCT applications for which amended claims were filed as a basis for the supplementary European search and which contravene Article 123(2) EPC

These examples are not exhaustive (see also GL B-VIII, 6). The basic principle is that there needs to be clarity and openness, for both the applicant and third parties, as to what has and what has not been searched.

Legal references:
GL B-VIII, 3; B-VIII, 5 GL B-XI, 7

5. Beyond the course

You can deepen what you have learned during this course with the following further readings:

- Guidelines for Examination in the European Patent Office, Part B: Guidelines for Search
- WIPO, PCT International Search and Preliminary Examination Guidelines

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