Europäisches Patentamt
European Patent Office
Office européen des brevets

Notice from the European Patent Office dated 1 April 2010 concerning amendment of the Guidelines for Examination in the European Patent Office

1. By decision of the President of the EPO dated 19 November 2009, the Guidelines for Examination have been amended pursuant to Article 10(2) EPC. The amendments are being published in the form of a complete "April 2010" edition of the Guidelines. These have been revised following consultation with the Standing Advisory Committee before the EPO (SACEPO). The amended Guidelines will apply as from 1 April 2010.

2. The updated Guidelines for Examination are published in all three EPO languages on the EPO website (*www.epo.org/patents/law/legal-texts/guidelines.html*) and are available for downloading free of charge. They will also be issued in paper form.

3. The English draft of these Guidelines was published on the EPO website in November 2009 in order to accommodate public interest in gaining the earliest possible access to information on the future amendments.

4. It should be noted that the "April 2010" edition of the Guidelines for Examination is the only valid official version, and supersedes the "April 2009" edition as from 1 April 2010.

Amendments to the Guidelines for Examination in the European Patent Office

5. Since the last complete new edition in December 2007, the Guidelines have been updated in view of the fee changes (see notice dated 1 April 2009, OJ EPO 2009, 336). As part of this update, Parts A - D of the "April 2009" edition were published in electronic form. Part E was not affected by these amendments.

6. The current amendments bring the Guidelines for Examination into line with the new or amended Rules 36, 57, 62a, 63, 64, 69, 70a, 135, 137 and 161 EPC, which enter into force on 1 April 2010 (see Administrative Council decisions CA/D 2/09 and CA/D 3/09 of 25 March 2009 amending the Implementing Regulations to the EPC, OJ EPO 2009, 296, 299, and the notices from the Office dated 20 August 2009, OJ EPO 2009, 481, and 15 October 2009, OJ EPO 2009, 533).

7. It should be noted that the Guidelines have not been fully revised. In one instance, where the Guidelines are still to be revised, several passages do not completely reflect current examination practice. Furthermore, once the work as regards content had been concluded, recent publications or decisions that appeared subsequently could no longer be taken into account. Thus, the relevant notice dated 14 September 2009 (OJ EPO 2009, 486), applies, for example, with respect to the filing of a certified copy of an earlier application to which reference is made, notwithstanding the relevant sections A-II, 4.1.3.1 and A-IV, 1.3.1 of the Guidelines.

8. Amendments to the new or amended rules can be found, in particular, in the following passages:

(a) Rule 36 (Divisional applications): **A-III, 14; A-IV, 1 to 1.3.3; A-VIII, 1.3; C-III, 7.10, 7.11.1 and 7.11.4; C-VI, 1.1.4, 3.4, 5.2 and 9.1.3;**

(b) Rule 62a (Applications containing a plurality of independent claims): **B-III, 3.7, 3.10 and 3.11; B-IV, 2.1; B-VIII, 4 and 5; B-X, 3.1 and 8; B-XII, 7; C-III, 3.3; C-VI, 4.7, 5.2, 5.6 and 8.2;**

(c) Rule 63 (Incomplete search): **B-IV, 1.3; B-VIII, 3 and 5; C-II, 4.9; C-III, 4.1, 5 and 6.3; C-IV, 2.2 and 4.1; C-VI, 4.7, 5.2, 5.6 and 8.2;**

(d) Rule 64 (European search report where the invention lacks unity): **B-VII, 1.2**;

(e) Rule 69 (Information about publication): **A-VI, 2.1;**

(f) Rule 70a (Response to the extended European search report): **A-V, 2.1; A-VI, 2.1, 2.4, 2.5 and 3; B-XII, 1.2, 3.3, 3.9 and 9; C-III, 6.3, 7.10; C-IV, 2.2 and 4.1; C-VI, 1.1, 1.1.1, 3.2, 3.4 and 3.5; E-IX, 5.4 and 5.7;**

(g) Rule 135 (Further processing): **A-III, 14; A-IV, 1.1.1.5; E-VIII, 2.1;**

(h) Rule 137 (Amendment of the European patent application): **B-XII, 2, 2.2 and 9; C-VI, 2.1, 3.1 to 3.3, 3.5.1, 4.1, 4.7, 4.9, 5.2, 5.6, 5.7, 9.1.4 and 14.4;**

(i) Rule 161 (Amendment of the application after entry into the European phase): **A-VI, 2.4; A-VII, 7; C-III, 7.11; C-VI, 3.5.1 and 9.4; E-IX, 4a, 5.1 and 6.3.3.**

9. Amendments were made to chapter **C-IV, 11** concerning inventive step, in which the range of board of appeal decisions cited should be particularly noted.

10. Furthermore, the following sections of the Guidelines have been updated with regard to the following topics:

(a) Electronic filing of documents: **A-II, 1.3, 3.1; A-IV, 1.3.1; A-IX, 3.2; E-IX, 2;**

(b) Filing of priority documents: **A-II, 5.4.3; A-III, 6.7; A-VII, 3.5; C-V, 3.3;**

(c) Supplementary European search report: **A-XI, 9.3.1; B-II, 4.3;**

(d) Publications on the internet: **B-III, 2.5; B-IV, 2.3; C-IV, 6.2; D-V, 3.1.3;**

(e) Postponement of oral proceedings: **E-III, 7.**

11. A number of amendments were made in the light of decisions of the Enlarged Board of Appeal and the other boards of appeal: see **C-III, 3.3, 4.2, 4.12, 4.16, 4.20 and 7.1; C-IV, 2.3.5, 4.1, 4.4, 4.8.1 and 5.4; C.VI, 5.2, 5.3.2 and 9.1.4; D-I, 4; D-V, 6.2; E-III, 7, 8.5 and 8.6; E-VI, 2 and E-X, 1.2**.

Part B

Guidelines for Search

Contents

Chapter I

Introduction

1. Purpose of Part B

Part B was drafted for, and applies to, European searches, i.e. searches performed by the EPO for European applications. In addition to these searches the Search Divisions of the EPO are called upon to carry out other types of searches (see II, 4). Searches in the context of the Patent Co-operation Treaty (PCT) are dealt with in the PCT Search and Examination Guidelines.

2. Search Division

The unit within the EPO responsible for carrying out the search and drawing up the search report for an application is a Search Division, which consists normally of one examiner. The examiner responsible for the search on a European application is also normally the first member of the Examining Division for that application. Where the invention is of a nature requiring searching in widely dispersed specialised fields, a special Search Division consisting of two, or possibly three, examiners may be formed, for example, where the "person skilled in the art" in the technical field of the application consists of more than one person (see C-IV, 11.3).

Art. 17
Art. 18

In this Part B, the term "examiner" is used to mean the examiner entrusted with the search within the Search Division which is responsible for drawing up the search report and the search opinion (see XII).

3. Search work

European searches are carried out by the Search Divisions of the EPO and may also be entrusted to the central industrial property offices of certain Contracting States. Searches in documents in languages other than the official languages of the EPO may be entrusted to certain of these offices. These guidelines apply to European searches carried out in all these places.

Art. 17
Prot. Centr. I(1) and (3)
Prot. Centr. IV(2)
Prot. Centr. V

4. The Extended European Search Report (EESR)

The Extended European Search Report (EESR) consists of two components, the European search report (see X) and the search opinion (see XII).

Art. 92
Rule 61
Rule 62

Chapter II

General

1. Search and substantive examination

The procedure through which a European patent application proceeds from the filing of the application to the grant of a patent (or the refusal of the application) comprises two separated basic stages, i.e. the search and substantive examination.

Art. 17
Art. 18

2. Objective of the search

The objective of the search is to discover the state of the art which is relevant for the purpose of determining whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step.

Rule 61(1)

The examination procedure and the preparation of the search opinion depend on the search for the knowledge of the state of the art on which assessment of the patentability of the invention is based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by issues such as unity of invention and other considerations (see III, 2, VII and VIII).

3. Search documentation

The search is carried out in in-house or external collections of documents or databases, the contents of which are systematically accessible, e.g. by means of words, classification symbols or indexing codes. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature (see Chapter IX).

4. Search report

A search report is prepared containing the results of the search, in particular by identifying the documents constituting the relevant state of the art (see X, 9).

Art. 92
Rule 61(1)

The search report serves to provide information on the relevant state of the art to the applicant, to the Examining Divisions of the EPO and, by means of its publication, to the public.

Art. 92
Art. 93(1)

The search report is accompanied by the search opinion (see XII, subject to the exceptions mentioned in XII, 8), which together with the European search report constitutes the Extended European Search Report (EESR).

4.1 European searches

The task of the Search Division is primarily to carry out searches and draw up search reports in relation to European patent applications. In

Art. 17

addition to these usual searches, the Search Divisions of the EPO may be called upon to perform various other types of searches, which are listed in the following paragraphs.

4.2 Additional European searches

At the examination stage of a European patent application an additional search may be necessary. The reasons for such an additional search may be, for example:

(i) amendment of claims so that they embrace matter not covered by the original search (see, however, C-III, 7.10, for claims not searched because of lack of unity and C-III, 7.10.1, for amendments introducing subject-matter from the description resulting in claims defining subject-matter which is not linked by a single general inventive concept to the subject-matter originally searched);

Rule 63
Art. 17(2) PCT

(ii) removal by amendment or rebuttal, during substantive examination, of the deficiencies which resulted in the issuance of an incomplete search or a declaration taking the place of a search report under Rule 63, or a declaration under Art. 17(2)(a) or (b) PCT (see Chapter VIII and C-VI, 8.2);

Rule 64
Rule 62a

(iii) reversal, by the Examining Division, of an opinion of the Search Division with respect to novelty or lack of inventive step (see III, 1.1) or on other issues (see III, 1.2), in particular lack of unity of invention (see Chapter VII), exclusions from the search (see III, 3.11 and Chapter VIII) or Rule 62a; and

(iv) limitations or imperfections in the initial search.

The Examining Division makes use of documents found in such an additional search, where they are considered relevant to the examination of the application. Where a new document is used in the examination procedure, a copy must be communicated to the applicant (Art. 113(1)).

In a similar way, an additional search may become necessary during examination of oppositions against a European patent (see D-VI, 5).

4.3 Supplementary European searches

Art. 153(2), (6) and (7)

An international (PCT) application for which the EPO acts as designated Office or elected Office and which has been accorded an international date of filing is deemed to be a European patent application. Where an international (PCT) search report is already available, this will take the place of the European search report. The Search Division will draw up a supplementary European search report or a declaration replacing it according to Rule 63 unless provided otherwise in decisions of the Administrative Council.

However, the Administrative Council decides under what conditions and to what extent the supplementary European search report is to be dispensed with. The following decisions have been taken: *Art. 153(7)*

(i) a supplementary European search report is not drawn up for international applications for which the EPO was the International Searching Authority;

(ii) a supplementary European search report is not drawn up for international applications for which the Swedish, Austrian or Spanish Patent Office was the International Searching Authority and where the international application was filed before 1 July 2005 (OJ 1/1979, 4; OJ 2/1979, 50; OJ 6-7/1979, 248; OJ 8/1995, 511);

(iii) a supplementary European search report is drawn up and the search fee reduced (OJ 11/2005, 548) for international applications for which the patent office of the USA, Japan, China, Australia, Russia or Korea was the International Searching Authority;

(iv) a supplementary European search report is drawn up and the search fee reduced for international applications for which the Swedish, Austrian or Spanish Patent Office was the International Searching Authority and where the international application was filed on or after 1 July 2005 and also where the International Searching Authority was the patent office of Finland and the international application was filed on or after 1 April 2005 or where the Nordic Patent Institute was the International Searching Authority (see OJ EPO 7/2005, 422; OJ EPO 12/2007, 642; OJ EPO 1/2008, 12).

For the applications mentioned under (iii) and (iv), the supplementary European search is carried out in all the search documentation of the EPO. It is left to the Search Division's judgment whether a limitation as to the search documents is chosen. No precise limits can at present be set to these supplementary European searches since the documentation and search practice of these International Searching Authorities have not been fully harmonised in respect of the EPO. As a general rule, the EPO should avoid any superfluous work and duplication of work and should rely on the efficiency and quality of the international searches to the largest extent possible. The EPO as designated Office requests the International Searching Authority to supply, together with the international search report, copies of the documents cited therein (Art. 20(3) PCT, see also Rule 44.3(a) PCT). When documents are cited that are not in one of the official languages of the EPO and the Search Division needs a translation into one of these languages, it should provide this itself (e.g. a patent family member in an official language of the EPO or, alternatively, an abstract of the document in an official language of the EPO,

see VI, 6.2), unless it is able to obtain it from any other source, e.g. the applicant or the International Searching Authority.

Rule 159(1)(b)
Rule 161

The European grant procedure, including the supplementary European search, is to be based on the application documents as specified by the applicant when the application enters the European phase (Rule 159(1)(b)). Alternatively, if, within a non-extendable period of one month as from notification of a communication pursuant to Rule 161(2) (see A-VII, 7), the applicant has amended the application, the application as amended serves as the basis for the supplementary European search (see also XII, 2). For procedures relating to Euro-PCT applications where no supplementary European search report is prepared by the EPO, see C-VI, 3.5.1.

4.4 International (PCT) searches

For the search practice as regards international (PCT) searches, reference is made to the PCT International Search and Preliminary Examination Guidelines.

4.5 International-type searches

Under the PCT, the EPO, as an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (Art. 15(5) PCT). These searches are by definition similar to international searches, and the same considerations apply, except where unity of invention is lacking; the procedure is then brought into line with the European procedure. This means that in case of a lack of unity in a national application subject to an international-type search, the reasons for the lack of unity are not given and a written opinion of the International Searching Authority will not be issued (Rule 43bis PCT).

4.6 Searches on national applications

Prot. Centr. I(1)(b)

The Search Divisions of the EPO also carry out searches on national applications of certain of its Contracting States. These guidelines are not necessarily fully applicable to these national searches, nor are the ways in which these searches differ from European searches specifically pointed out. However, these national searches are to a large extent identical to, or compatible with, European searches.

Chapter III

Characteristics of the search

1. The objective of the search

1.1 Opinions in relation to the search report

Rule 61(1)

As stated in II, 2, the objective of the search is to discover the relevant state of the art for the purpose of assessing novelty and inventive step. Decisions on novelty and inventive step are the province of the Examining Divisions. However, in the search opinion (if applicable, see XII, 8), the Search Division gives the applicant a reasoned opinion on whether the application and the invention to which it relates meet the requirements of the EPC, to which he can reply in the examination procedure (Art. 113(1) and XII, 9). Opinions on patentability are also implicitly expressed in the search report by the assignment of document categories as defined in X, 9.2, and are subject to review by the Examining Division at the examination stage (see II, 4.2(iii) and XII, 1.2), in particular in the light of the applicant's reply thereto (see B-XII, 9).

The assessment of patentability at the search stage can have a direct bearing on the execution of the search itself, see: III, 3.8 (search for subject-matter of dependent claims), III, 2.4 (search in analogous technical fields) and IV, 2.6 (stopping the search when only trivial matter remains).

1.2 Opinions on matters relating to the limitation of the search

Occasionally matters of substantive examination other than novelty or inventive step have a direct bearing on the execution of the search and may result in a limitation thereof; here again these opinions are subject to review by the Examining Division (see T 178/84, OJ 5/1989, 157, and T 631/97, OJ 1/2001, 13 and II, 4.2(iii) and XII, 1.2), in particular in the light of the applicant's reply to the search opinion (see B-XII, 9).

Examples are to be found in chapter VII – Unity of invention and chapter VIII – Subject-matter to be excluded from the search.

2. Scope of the search

2.1 Completeness of the search

The European search is essentially a thorough, high-quality, all-embracing search. Nevertheless, it must be realised that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any information retrieval system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds. The search should be carried out in such a manner as to reduce to a minimum the possibility of failing to discover complete

anticipations for any claims, or other highly relevant prior art. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower recall ratio can be accepted (see in this context, however, III, 2.4). For limitations of the subject-matter searched by the EPO, see VIII.

The scope of the international search is defined in Art. 15(4) PCT stipulating that the International Searching Authority must endeavour to discover as much of the relevant prior art as its facilities permit and must, in any case, consult the documentation specified in the PCT Regulations (Rule 34 PCT). It follows from this definition ("as its facilities permit") that the scope of an international search shall be equivalent to a European search. International and European searches shall thus be fully compatible. In accordance therewith, if the EPO carried out the international search, no supplementary European search report need be drawn up and the international search report made by the EPO takes unconditionally the place of the European search report (Art. 153(6) EPC, OJ EPO 1979, 4, see also II, 4.3).

2.2 Effectiveness and efficiency of the search

The effectiveness and efficiency of any search for relevant documents (Rule 61(1)) depend on the degree of order which is available in, or which can be applied to, the collection of documents to be searched, the order allowing the examiner to determine sections of the documentation to be consulted. The basic components for creating order in a collection of documents are words, classification units, indexing codes or bibliographical links between documents by commonly cited documents. The order may have a permanent character, as with indexing words, classification symbols or indexing codes, or it may be created on demand by a search strategy judiciously using the above-mentioned basic components, the outcome of which is a section of the documentation which is likely to contain material pertinent to the invention. The examiner should for reasons of economy exercise his judgement, based on his knowledge of the technology in question and of the available information retrieval systems, to omit sections of the documentation in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time when the area of technology in question began to develop. Similarly he need only consult one member of a patent family unless he has good reason to suppose that, in a particular case, there are relevant substantial differences in the content of different members of the same family (see IX, 2.6).

2.3 Special documents to be consulted

Certain categories of documents such as documents of the Scandinavian countries may be of special relevance to the European patent system, though they do not form part of the PCT minimum documentation. All these documents should be consulted for European searches, additional European searches and

international-type searches, and also for national searches unless specifically excluded in the agreement with the State concerned.

2.4 Search in analogous fields

The search is carried out in collections of documents or databases which may contain material in all those technical fields pertinent to the invention. The search strategy should determine the sections of the documentation to be consulted covering all directly relevant technical fields, and may then have to be extended to sections of the documentation covering analogous fields, but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the sections of the documentation initially consulted (see III, 3.2).

The question of which technical fields are, in any given case, to be regarded as analogous has to be considered in the light of what appears to be the essential technical contribution of the invention and not only the specific functions expressly indicated in the application.

The decision to extend the search to fields not mentioned in the application must be left to the judgement of the examiner, who should not put himself in the place of the inventor and try to imagine all the kinds of applications of the invention possible. The overriding principle in determining the extension of the search in analogous fields should be whether it is probable that a reasonable objection of lack of inventive step could be established on the basis of what is likely to be found by the search in these fields (see T 176/84, OJ 2/1986, 50, T 195/84, OJ 5/1986, 121 and C-IV, 11.8).

2.5 Search on the internet

The European search can also cover internet sources, including online technical journals, online databases or other websites. The extent of such internet searches depends on the individual case, but in some technical fields a systematic internet search will regularly be necessary. Especially in fields related to information or software technology, searches bypassing the internet will often not yield the most relevant prior art.

3. The subject of the search

3.1 Basis for the search

The search should be made on the basis of the claims, with due regard to the description and drawings (if any), (Art. 92). The claims determine the extent of the protection which will be conferred by the European patent if granted (Art. 69(1)).

Art. 92
Art. 69(1)
Rule 43(6)

3.2 Interpretation of claims

The search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings. The

Prot. Art. 69 EPC

objective of the search is to discover prior art which is relevant to novelty and/or inventive step (see II, 2). The search should be directed to what appear to be the essential features of the invention and take into account any changes in the (objective) technical problem underlying the invention which may occur during the search as a result of the retrieved prior art (see IV, 2.3 and 2.4 and C-IV, 11.5.2). In this regard it should be noted that although explicit references in the claims to features elucidated in the description are only permissible where "absolutely necessary" (Rule 43(6) – see also III, 3.5, and C-III, 4.17), claims containing such references should still be searched if these technical features are unambiguously defined by specific parts of the description.

When interpreting claims for the purpose of the search, the search will also take into consideration prior art incorporating technical features which are well known equivalents to the technical features of the claimed invention, which may undermine inventive step (see C-IV-Annex, 1.1(ii)).

3.3 Amended claims

Rule 137(1)
Rule 159(1)(b)
Rule 161

Where a European application does not derive from an earlier international application, the applicant may not amend the claims before receiving the European search report (Rule 137(1)). Consequently, in these cases, the search is directed to the claims as originally filed, in the European application, or to the set of claims filed according to Rule 57(c) or 58.

However, where a European application derives from an earlier international application, the applicant may have amended the international application in the international phase, either after receipt of the international search report (Art. 19(1) PCT) or during international preliminary examination (Art. 34(2)(b) PCT). The applicant may then specify that he wishes to enter the European phase with these or otherwise amended application documents (including claims) according to Rule 159(1)(b). Furthermore, the applicant is given the opportunity by the EPO to amend the application documents (including the claims) within a set time limit (Rule 161(2), see A-VII, 7). The application as amended serves as the basis for any supplementary European search which has to be performed pursuant to Art. 153(7) (see II, 4.3 and XII, 2).

3.4 Abandonment of claims

Rule 45(3)
Rule 162(4)

For European applications, claims that are deemed to have been abandoned for non-payment of fees must be excluded from the search. This applies both to searches to be carried out in respect of directly-filed European applications and to supplementary European searches to be carried out in respect of Euro-PCT applications entering the European phase (see II, 4.3).

3.5 Anticipation of amendments to claims

In principle, and insofar as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (see, however, VII, 1.3, in case of lack of unity). For example, where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search should include this circuit.

3.6 Broad claims

Art. 83
Art. 84

No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they relate to matter which is sufficiently disclosed in the application (Art. 83), and are supported by the description (Art. 84). If, for example, in an application relating to and describing in detail an automatic telephone exchange, the claims are directed to an automatic communication switching centre, the search should not be extended to automatic telegraph exchanges, data switching centres etc. merely because of the broad wording of the claim, but only if it is probable that such an extended search could produce a document on the basis of which a reasonable objection as regards lack of novelty or inventive step could be established. Likewise, if a claim is directed to a process for manufacturing an "impedance element" but the description and drawings relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance element could be manufactured by the process of the invention, extension of the search to embrace, say, manufacture of capacitors would not normally be justified. If the main claim relates to the chemical treatment of a substrate, whereas it appears from the description or all the examples that the problem to be solved is solely dependent on the nature of natural leather, it is clear that the search should not be extended to the fields of plastics, fabrics or glass. Similarly, if the description and drawings are directed to a lock with a safety cylinder whereas the claims refer to a device allowing the indexation of the angular position of a first element with respect to two other rotating elements, then the search should be limited to locks. In exceptional cases where the lack of disclosure or support is such as to render a meaningful search over the **whole** of the scope of the claim(s) impossible, application of the procedure for an incomplete search or a declaration taking the place of a search report under Rule 63 may be appropriate (see VIII, 3).

3.7 Independent and dependent claims

Rule 43(4)

The search carried out in sections of the documentation to be consulted for the independent claim(s) must include all dependent claims (for cases not complying with Rule 43(2), see B-VIII, 4). Dependent claims should be interpreted as being restricted by all features of the claim(s) upon which they depend. Therefore, where the subject-matter of an independent claim is novel, that of its

dependent claims will also be novel. When the patentability of the subject-matter of the independent claim is not questioned as a result of the search, there is no need to make a further search or cite documents in respect of the subject-matter of the dependent claims as such (see, however, II, 4.2(iii) and XII, 1.2). For example, in an application relating to cathode ray oscilloscope tubes, in which the independent claim is directed to specific means along the edge of the front of the tube for illuminating the screen and a dependent claim is directed to a specific connection between the front and the main part of the tube, the examiner should, in the sections of the documentation he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. If, after this search, the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further sections of the documentation which are likely to contain material pertinent to or specifically provided for these connections. If in an application dealing with a pharmaceutical composition for treating nail infections the patentability of the subject-matter of the independent claim relating to specific combinations of the active ingredients is not questioned as a result of the search, there is no need to continue the search for dependent claims dealing with the use of a specific volatile organic solvent as a carrier in the composition.

3.8 Search on dependent claims

However, where the patentability of the subject-matter of the independent claim is questioned, it may be necessary for assessing whether the subject-matter of the dependent claim as such is novel and involves an inventive step to continue the search in other sections of the documentation, e.g. in one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art. However, if a handbook or other document showing that a feature is generally known can be found rapidly, it should be cited (see C-IV, 11.8(iii)). When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the independent claim), the dependent claim is to be considered in combination with the features in the independent claim and should be dealt with accordingly (see C-III, 3.4).

3.9 Combination of elements in a claim

For claims characterised by a combination of elements (e.g. A, B and C) the search should be directed towards the combination. However, when searching sections of the documentation for this purpose, sub-combinations, including the elements individually (e.g. A and B, A and C, B and C, and also A, B and C separately) should be searched in those sections at the same time. A search in additional sections of the documentation either for sub-combinations or for individual elements of the combination should only be performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

3.10 Different categories

When the application contains claims of different categories, all these must be included in the search (for cases not complying with Rule 43(2), see B-VIII, 4). However, if a product claim clearly seems to be both new and non-obvious, the examiner should make no special effort to search claims for a process which inevitably results in the manufacture of that product or for use of the product (cf. C-III, 3.8 and C-IV, 11.12). When the application contains only claims of one category, it may be desirable to include other categories in the search. For example, generally, i.e. except when the application contains indications to the contrary, one may assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products are only searched when they form the subject of one or more claims; but the final products will always have to be searched, except when they are evidently known.

3.11 Subject-matter excluded from search

Rule 63
Rule 62a

The examiner may exclude certain subject-matter from his search. These exclusions may result from certain subject-matter not complying with the provisions of the EPC relating to exclusions from patentability or to susceptibility to industrial application (see VIII, 1 and 2). They may also arise where the application does not comply with the provisions of the EPC to such an extent that a meaningful search is impossible for some or all of the claims, or for a part of a claim, for other reasons (see VIII, 3) or where the application does not comply with Rule 43(2) (see B-VIII, 4).

3.12 Lack of unity

Rule 64

Also, when the claims of the application do not relate to one invention only, nor to a group of inventions linked so as to form a single general inventive concept, the search will normally be restricted to the invention or the linked group of inventions first mentioned in the claims (see Chapter VII). Restriction of the search for the above reasons will be notified to the applicant in a communication accompanying the partial search report (see VII, 1.2).

3.13 Technological background

In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention. This would include:

– the preamble to the first claim, i.e. the part preceding the expression "characterised by" or "characterised in that";

– the state of the art which in the introduction of the description of the application is said to be known, but not identified by specific citations;

– the general technological background of the invention (often called "general state of the art").

Chapter IV

Search procedure and strategy

1. Procedure prior to searching

1.1 Analysis of the application

When taking up an application to be searched, the examiner should first consider the application in order to determine the subject of the claimed invention taking account of the guidance given in III, 3. For this purpose he should make a critical analysis of the claims in the light of the description and drawings. He should in particular consider the content of the claims, description and drawings sufficiently to identify the problem underlying the invention, the inventive concept leading to its solution, the features essential to the solution as found in the claims and the results and effects obtained (see, however, III, 3.5). Furthermore, where technical features which are not present in the claims are indicated in the description as essential for the solution of the stated problem, these features should be included in the search (see C-III, 4.3(ii) and T 32/82, OJ 8/1984, 354).

1.2 Formal deficiencies

The search is carried out in parallel with the formalities examination. If the examiner notices any formal shortcomings which have been overlooked by the Receiving Section, he calls these, by means of an internal communication, to the attention of the Receiving Section (or of the Examining Division in the case of an additional search requested by that Division) which takes appropriate action. However, the examiner should not repeat the tasks of the Receiving Section and should not undertake any time-consuming enquiries into these matters. Such deficiencies which the examiner might notice include:

Art. 90(1)
Art. 92
Art. 78
Art. 53(a)
Rules 30 to 34, 40 to 50 and 55 to 58

(i) physical deficiencies of the application (see A-III, 3.2), including:

Art. 90(3)
Rule 57

(a) no paper and/or no electronic sequence listing (Rule 30(1) and Special edition No. 3, OJ EPO 2007, C.1);

(b) incorrect sequence and/or positioning of page numbering and/or failure to use Arabic numerals in page numbering (Rule 49(6));

(c) presence of drawings in the description and/or claims (Rule 49(9));

(d) presence of erasures and/or alterations in the application documents, such that the authenticity of the content and/or the requirements for good reproduction are jeopardised (Rule 49(12));

Art. 53(a)
Rule 48(1)(a) and (b)

(ii) presence of prohibited matter in the application:

(a) which is contrary to "ordre public" (see A-III, 8.1, C-II, 7.2 and C-IV, 4.1 to 4.3); or

(b) constituting disparaging statements (see A-III, 8.2). Note, however, that fair comment as referred to in C-II, 7.3 is permitted;

Rules 31 to 33

(iii) failure to comply with the provisions relating to the deposition of biological material (see A-IV, 4), in particular with regard to the correct identification in the application of the depository institution and accession number of the biological material assigned to the deposited material by the depository institution (Rule 31(1)(c), see G 2/93, OJ 5/1995, 275 and A-IV, 4.2).

(iv) failure to correctly identify the application as a divisional application within the meaning of Art. 76(1) (see A-IV, 1.3.2, Rule 41(2)(e)).

1.3 Documents cited in the application

Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, as showing the state of the art, or as giving alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application (see, however, IV, 2.4). However, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. In the exceptional case that the application cites a document that is not published or otherwise not accessible to the Search Division and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, the Search Division should apply the procedure under Rule 63 and invite the applicant to either submit the document or indicate the subject-matter to be searched (see B-VIII, 3). If no copy of the document is received within the time limit according to Rule 63(1) and the applicant is unable to convince the Search Division in a timely response to the Rule 63(1) invitation that the document is not essential to facilitate a meaningful search, an incomplete search report or, where applicable, a declaration replacing the search report under Rule 63 is prepared (see B-VIII, 3.2). This incomplete search report or declaration will be issued giving the following grounds:

(i) the non-availability of the document rendered the invention insufficiently disclosed within the meaning of Art. 83; and

(ii) the insufficient disclosure mentioned in (i) existed to such a degree that a meaningful search was not possible on at least part of the claimed invention (see VIII, 3).

It should also be noted that where the applicant furnishes the document after the search report and the search opinion (if applicable, see XII, 8) have been prepared, an additional search on that subject-matter originally excluded from the search may be carried out due to the correction of the deficiency which led to the incomplete search (see C-VI, 8.2). However, applicants must be aware that such later furnished information can only be taken into account for sufficiency of disclosure pursuant to Art. 83 under certain circumstances (see C-II, 4.17).

1.4 Abstract; official classification; title of the invention; publication

Rule 66
Rule 47
Rule 68(1)

The examiner should then consider the abstract (together with the title of the invention and the figure, if any, of the drawings to be published with the abstract) in relation to the requirements laid down in the Implementing Regulations (see Chapter XI). Since the abstract should relate to the application as filed, the examiner should consider it and determine its definitive content before carrying out the search, in order to avoid being inadvertently influenced by the results of the search. If publication of the application is due before the search report is drawn up (A2 publication), the examiner has to establish the official classification of the application much earlier than he carries out the search (see V, 4); he examines then at the same time the abstract for the purpose of publication. This examination of the abstract does not go beyond ensuring that it relates to the application concerned and that no conflict exists with the title of the invention or with the classification of the application. Information in relation to the abstract, the title of the invention and the figure, if any, of the drawings to be published with the abstract is transmitted to the applicant in the communication accompanying the search report, in the case of an A1 publication. If the search report is published separately (A3 publication), this information is not given in the communication. The examiner also translates the title of the invention into the two other official languages.

2. Search strategy

2.1 Subject of the search; restrictions

Rule 63
Rule 62a

Having determined the subject of the invention as outlined in IV, 1.1, it may be desirable for the examiner to prepare first a search statement, defining the subject of his search as precisely as possible. In many instances one or more of the claims may themselves serve this purpose, but they may have to be generalised in order to cover all aspects and embodiments of the invention. At this time, the considerations relating to subjects excluded from patentability (see VIII, 1 and 2) and to lack of unity of invention (see VII, 1.1) should be borne in mind. The examiner may also have to restrict the search because the requirements of the EPC are not met to such an extent that a meaningful search is impossible (see VIII, 3) or because the application does not comply with Rule 43(2) (see the procedure defined in B-VIII, 4). Any such restrictions to the search must be

indicated in the search report or declaration taking the place of the search report under Rule 63 or Rule 62a. The declaration should indicate the reasons for any restrictions under Rule 63 (see X, 8(iii)). The declaration or the incomplete search report is considered, for the purposes of subsequent proceedings, as the search report.

2.2 Formulating a search strategy

Next the examiner should start the search process by formulating a search strategy, i.e. a plan consisting of a series of search statements expressing the subject of the search, resulting in sections of the documentation to be consulted for the search. In its initial phase, a search strategy will contain one or more combinations of the basic components mentioned in III, 2.2. The search process should be interactive and iterative in the sense that the examiner should reformulate his initial search statement(s) according to the usefulness of the information retrieved (see III, 1.1; IV, 2.4 and IV, 2.6). When using classification units, the examiner should select the classification units to be consulted for the search, both in all directly relevant fields and in analogous fields. The selection of the classification units in related fields should be limited to:

(i) higher subdivisions allowing searching by abstraction (generalisation) inasmuch as this is justified from a technical viewpoint; and

(ii) parallel subdivisions, bearing in mind the fact that the fields in question will become increasingly unrelated.

When the examiner is in doubt about the appropriate fields in which to conduct his search, he may request advice from the appropriate directorate of Principal Directorate Tools.

Usually various search strategies are possible, and the examiner should exercise his judgement, based on his experience and knowledge of the available search tools, to select the search strategy most appropriate to the case in hand. He should give precedence to search strategies yielding sections of the documentation in which the probability of finding relevant documents is highest. Usually the main technical field of the application will be given precedence, starting with the basic components (see III, 2.2) most relevant to the specific example(s) and preferred embodiments of the claimed invention.

2.3 Carrying out the search; types of documents

The examiner should then carry out the search, directing his attention to documents relevant for novelty and inventive step.

He should also note any documents that may be of importance for other reasons, such as:

(i) conflicting documents (see VI, 4) which are:

(a) published European applications under Art. 54(3) (see C-IV, 7.1 and 7.1.1);

(b) published international applications under Art. 54(3) and Art. 153(3) and (5) (see C-IV, 7.2);

(c) published national applications of EPC Contracting States under Art. 139(2) (see C-IV, 8 and C-III, 8.4);

(d) any document published during the priority interval of the application which may be relevant under Art. 54(2) in case of a non-valid priority date.

When published within the priority interval of the application under search, these applications are cited in the search report as "P" documents (see X, 9.2(iv)); when published after the European or international filing date, they are cited in the search report as "E" documents (see X, 9.2(vi));

(ii) documents putting doubt upon the validity of any priority claimed (see VI, 3 and C-V, 1.4.1), which are cited in the search report as "L" documents (see X, 9.2(viii)(a));

(iii) documents contributing to a better or more correct understanding of the claimed invention, which are cited in the search report as "T" documents (see X, 9.2(v));

(iv) documents illustrating the technological background, which are cited in the search report as "A" documents (see X, 9.2(ii));

(v) European patent applications having the same filing or priority date as the application in respect of which the search is carried out, from the same applicant and relating to the same invention and therefore relevant to the issue of double patenting (see C-IV, 7.4), which are cited in the search report as "L" documents (see X, 9.2(viii)(c));

(vi) documents indicating or establishing the publication date of a document drawn from the internet (see C-IV, 6.2), which are cited in the search report as "L" documents (see B-X, 9.2(viii)(b)); and

(vii) documents retrieved from the internet which do not have any publication date but which the examiner nonetheless wants to cite to inform the applicant or third parties (cf. C-IV, 6.2.4), which are also cited as "L" documents (see B-X, 9.2(viii)).

However, he should not spend a significant amount of time in searching for these documents, nor in the consideration of such matters unless there is a special reason for doing so in a particular case (see VI, 5.3 and XII, 4).

The examiner should concentrate his search efforts on the use of search strategies yielding sections of the documentation in which the probability of finding highly relevant documents is greatest, and, in considering whether to extend the search to other less relevant sections of the documentation, he should always take account of the search results already obtained.

2.4 Reformulation of the subject of the search

The examiner should continuously evaluate the results of his search, and if necessary reformulate the subject of the search accordingly. For example, the selection of the classification units to be searched or the order of searching them may also require alteration during the search as a consequence of intermediate results obtained. The examiner should also use his judgement, taking into account results obtained, in deciding at any time during the systematic search whether he should approach the search documentation in some different manner, e.g. by consulting:

(i) documents cited in relevant documents produced by the search, for example cited in the description or search report of a patent document; or

(ii) documents citing a relevant document produced by the search,

or whether he should turn to documentation outside that which is available to the Search Divisions in-house (see Chapter IX). When searching external document collections for material in relation to unpublished subject-matter using other than secure connections, like the Internet, the examiner should be extremely careful when formulating search strategies so as not to unwittingly reveal confidential material – i.e. any part of the unpublished patent application.

2.5 Closest prior art and its effects on the search

It may happen that the examiner does not find any documents published before the earliest priority date which prejudice the novelty or the inventive step of the claimed invention. In such cases, the examiner should, whenever possible, cite in the search report at least that prior art found in the course of search which discloses a solution to the same problem as that underlying the claimed invention (wherein this problem may change depending on the prior art retrieved (C-IV, 11.5.2) and wherein the known solution is technically the closest to the claimed solution ("closest prior art"). Such prior art is to be cited as an "A" document in the search report (see X, 9.2(ii)).

If such a document cannot be found, the examiner should cite as the closest prior art a document which solves a problem closely related to the problem underlying the claimed invention and wherein the solution is technically most similar to that of the application under search.

Where the examiner retrieves documents which are incidentally prejudicial to the novelty of the claimed invention (to be cited as "X") but which do not affect the inventive step thereof after appropriate amendment of the application, and does not retrieve any other documents prejudicing inventive step, the examiner should also proceed as above.

In the case of a European application derived from an international application and being subjected to a supplementary European search after entering the European phase (Art. 153(7) – see II, 4.3), it is possible that the examiner does not uncover any further relevant prior-art documents in the search over and above the documents already cited in the international search report by the International Searching Authority. In such cases, it is permissible to have no further relevant documents in the supplementary European search report (see X, 9.1.4).

2.6 End of search

Reasons of economy dictate that the examiner use his judgement to end his search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when documents have been found clearly demonstrating lack of novelty in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination, application of which features would not involve inventive step. The search for conflicting applications should, however, always be completed to the extent that these are present in the available documentation.

3. Procedure after searching

3.1 Preparation of the search report

After completion of the search, the examiner should select from the documents retrieved the ones to be cited in the report. These should always include the most relevant documents (which will be specially characterised in the report (see X, 9.2). Less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. In cases of doubt or borderline cases in relation to novelty or inventive step, the examiner should cite rather more readily in order to give the Examining Division the opportunity to consider the matter more fully (see III, 1.1).

To avoid increasing costs unnecessarily, the examiner should not cite more documents than is necessary and therefore, when there are several documents of equal relevance, the search report should not normally cite more than one of them. In any case, the search report is accompanied by an annex drawn up by computer and listing the patent documents which are available and belong to the same patent family. In selecting from these documents for citation, the examiner should pay regard to language convenience, and preferably cite (or at least note) documents in the language of the application (see X, 9.1.2).

Subsequently, the examiner prepares the search report.

3.2 Documents discovered after completion of the search

It may happen occasionally, that after completion of a search report, the Search Division discovers further relevant documents (e.g. in a later search for a related application). Copies of these documents should be sent with a note to the Receiving Section, which, depending upon the stage of procedure reached, will proceed under one of the following three variants. These documents should be added to the search report up to the time that preparations for its publication are completed. Up to the filing of a request for examination, such later discovered documents should be communicated to the applicant in an addition to the search report and this information will be published. Thereafter, such documents may be used in examination.

3.3 Errors in the search report

When a material error is found to be present in a search report prior to publication thereof, a new search report will be drawn up which supersedes the preceding one. Where the search report has already been sent to the applicant according to Rule 65, but has not yet been published, the error should immediately be notified to the applicant. When a serious error is noted following publication of the search report, a corrigendum is published in the European Patent Bulletin, and the applicant and the Examining Division should be informed accordingly. If the error comprises the transmission of an incorrect document as a citation, the correct document should be sent.

Chapter V

Preclassification (routing) and official classification of European patent applications

1. Definitions

By "preclassification" is meant a first stage of routing, for purposes of internal handling, whereby the subject of the claimed invention (or the invention first claimed, if there is more than one) is broadly identified by means of the appropriate classification symbols. By "official classification" is meant the assigning of the appropriate classification symbols identifying the technical subject of the claimed invention (or of the subjects of each of the claimed inventions, if there is more than one), such identification being as precise and comprehensive as the classification permits. In addition, non-obligatory classification or indexation symbols may be attributed to any additional information contained in the document to be classified, which should be identified according to the Guide to the International Patent Classification ("IPC") published by WIPO (see also the WIPO website). The official classification of the European patent application is performed by the examiner, using the classification symbols contained in the rules of the IPC for the inventions as claimed ("Obligatory Classification"). He can also assign appropriate classification symbols and/or indexing codes to any additional information ("Non-Obligatory Classification") as defined in the Guide to the IPC in force at the time.

2. Preclassification (routing)

In order for an application to be allotted to the competent directorate, a preclassification must be made. The level of classification at this stage should be as general as practicable on the basis of a quick and cursory scrutiny of the document (e.g. the title and independent claim or claims). On the other hand, the level should be specific enough to avoid the need for any intermediate stage of preclassification before allocation to the competent directorate. The most appropriate level in the light of these considerations is usually that of the sub-class. Only rarely, when the sub-class is exceptionally large or heterogeneous and spread over different directorates, is preclassification to a main ("00") or sub-group necessary. This classification should be indicated by the use of the appropriate symbols in a space to be provided on the dossier.

The preclassification required for this first allocation should be made on the basis of the independent claims. If this results in preclassification in more than one sub-class, then whichever of these seems to be the most relevant to the claimed invention (or the invention first claimed, if there is lack of unity of invention) should be

selected. This is the preclassification which should be indicated on the dossier.

In most cases no further classification is required to enable applications to be allotted to the Search Divisions within a directorate, but, where it is necessary, it falls within the authority of the examiner in charge of the field to arrange for such allotment in an expedient manner.

3. Incorrect preclassification

If, on reaching the directorate, an application has been found to be incorrectly preclassified and thus inappropriately allocated, it is reclassified and re-allocated by the directorate receiving it, the indication on the dossier being appropriately amended. Normally this is done by mutual agreement with the directorate to which it is proposed to re-allocate it. However, cases arise over which there is disagreement or uncertainty regarding classification boundaries, or where the directorate dealing with the case is uncertain as to its correct classification, and in such instances the directorate having the case should not spend time in trying to resolve the matter, but should consult the classification specialists in Principal Directorate Tools and, if necessary, refer the case to them.

4. Official classification of the application

The official classification of the European patent application is performed by the examiner as described above in V, 1. Preferably, this should be done when he has studied the content of the application in order to carry out the search. However, if publication of the application is due before the search report is drawn up, it is necessary for the examiner to study the application sufficiently to determine the official classification at this earlier stage (see X, 5).

If the official classification of the application is in more than one sub-class, or more than one main ("00") group within a sub-class, then all such classifications should be assigned. The classification of the invention as claimed should be distinguished from any additional classification and/or indexing code. In addition, where it is necessary to assign more than one symbol for the invention itself, the symbol which in the examiner's opinion most adequately identifies it, or, when this presents difficulties, the symbol which identifies the invention for which most information is given, should be indicated first, e.g. in order to facilitate subsequent allocation of the applications.

The classification should be determined without taking into consideration the probable content of the application after any amendment, since this classification should relate to the disclosure in the published application, i.e. the application as filed. If, however, the examiner's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search (e.g. as a result of prior art found or because of clarification of apparent obscurities), he should amend the classification accordingly,

if the preparations for publication have not at that stage been completed.

5. Classification of late-published search reports

Where the search report is not available in time for publication of the application, and is therefore published separately, and the examiner finds it necessary to amend the original classification for the reasons given in V, 4, last paragraph, he should state the amended classification on the search report, indicating that it constitutes the official classification in place of that published on the application (which thus becomes merely the "classification for publication"). Such amendment of the classification should not be made unless the examiner is quite certain that it is necessary.

Where a European patent application is classified and published without the European search report (A2 publication), the European search report is prepared and published separately after publication of the application (A3 publication). It may happen that the IPC is amended in the period between publication of the European application (A2 publication) and the separate publication of the search report (A3 publication). In this case, the examiner must use for the search report that version of the IPC which was in force when the application was published.

6. Classification when the scope of the invention is not clear (e.g. a partial search)

When the scope of the invention is not clear, the classification has to be based on what appears to be the invention insofar as this can be understood. It is then necessary to amend it if obscurities are removed by the search, as discussed in V, 4, last paragraph.

7. Classification in cases of a lack of unity of invention

Where objection of lack of unity of invention arises, all inventions must be classified, since all will be disclosed in the published application. Each invention claimed is to be classified as set out in paragraphs V, 4 to 6.

8. Verification of official classification

As a general rule, applications will not be systematically scrutinised after leaving the Search Division in order to verify the correctness of the official classification assigned by the examiner. The Office may, however, institute such sampling check procedures as are deemed necessary to ensure correctness and uniformity in the application of the IPC. It is, of course, for the director to arrange for such checks as he considers necessary, having regard to the experience of his examiners, before the applications leave his directorate.

Chapter VI

The state of the art

1. General

The general considerations relating to the state of the art and patentability, especially with regard to the determination of novelty and inventive step, are set out in C-IV.

2. State of the art – oral disclosure, etc.

According to Rule 33.1(a) and (b) PCT, oral disclosure, use, exhibition, etc. are recognised as prior art only when this is substantiated by a written disclosure. In contrast, according to Art. 54 EPC, a public oral description, use, etc. is considered as prior art. However, the examiner, in carrying out a European search, should cite an oral description, etc. as prior art only if he has available a written confirmation or is otherwise convinced that the facts can be proved. Such references to oral disclosure, prior public use, disclosure by sale, etc. are more usually brought up by opponents in opposition proceedings (see D-V, 3).

3. Priority

If the claimed priority dates cannot be verified at this stage, uncertainty will exist as regards their validity and the search for conflicting applications should be extended so as to cover all published applications with an earliest claimed priority date up to the filing date (not the claimed priority date(s)) of the application under consideration (see IV, 2.3 and XII, 4).

4. Conflicting applications

4.1 Potentially conflicting European and international applications

Generally, where the search is concluded less than eighteen months after the European or international filing date of the application (the filing date according to Art. 80 and not its claimed priority date(s)), it will not be possible at the time of the search to make a complete search for potentially conflicting European and international applications. This search therefore has to be completed at the examination stage by the Examining Division (see C-VI, 8.1). *Art. 54(3)*

4.2 National earlier rights

There may also be national applications of one or more States designated in the European application of which the dates of filing are prior to the filing or priority date of the European application, and which were published as national applications or patents on or after that date. Although such applications are not a bar to the grant of a European patent, but only a ground for revocation in the Contracting State(s) concerned, they may be of importance to the applicant (see C-III, 8.4). Therefore, any of these which are present in the *Art. 139(2)*

documentation are noted and mentioned in the search report for information (see X, 9.2(vi)). However, no special search effort should be made for this purpose (see IV, 2.3).

5. Date of reference for documents cited in the search report; filing and priority date

5.1 Verification of claimed priority date(s)

Art. 80
Rule 40
Art. 90(3)
Art. 54(2)

Where the validity of the priority claim cannot be verified at the search stage (see XII, 4), the basic reference date for the search must be taken as the date of filing of the European application as accorded by the Receiving Section. (For the reference date for the search with respect to conflicting applications, see, however, VI, 3).

5.2 Intermediate documents

The Search Division takes into account documents published between the earliest priority date and the filing date of the application under consideration, and these documents are identified as such in the search report (see X, 9.2(iv)). For identifying these documents when an application has more than one priority date, the oldest date is to be applied. When deciding which documents to select for citing in the search report, the examiner refers to these dates and should preferably choose any published before the date of priority. Thus, for example, where there are two documents, one published before the date of priority and the other after that date but before the date of filing, but otherwise equally relevant, he should choose the former (see IV, 3.1, 2nd paragraph).

5.3 Doubts as to the validity of the priority claim; extension of the search

It is the responsibility of the Examining Division to check whether and to what extent the priority claim is justified. However, where intervening state of the art (see VI, 5.2)) or potential state of the art according to Art. 54(3) is revealed in the search, the Search Division should, if possible, check the validity of the priority claim (see XII, 4, and C-V, 1.2 to 1.5 and 2). Furthermore, documents showing that a priority claim might not be justified (e.g. an earlier application or patent from the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned) should be cited in the search report (see X, 9.2(viii)). However, no special search effort should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation-in-part" of an earlier application from which no priority is claimed (see IV, 2.3 and C-V, 2.4.4). Sometimes the fact that the country of residence of the applicant is different from the country of the priority application may also be an indication that it is not a first filing, justifying a certain extension of the search.

When the search is extended for this purpose, it should be directed to:

(i) published patent documents filed earlier than the claimed priority date, for example (assuming that the applicant is the same for all applications):

date:	application:	subject-matter:
01.03.98	GB1 filed	A
30.05.98	GB2 filed	A
30.05.99	EP1 filed (claiming priority of GB2)	A
10.09.99	GB1 published	A

During the search for EP1, the examiner retrieved published application GB1. GB1 may prejudice the priority claim of EP1, since it was filed earlier than GB2. Published GB1 should, therefore, be cited in the search report as an "L" document according to X, 9.2(viii)(a); or

(ii) published patent documents which claim priority from an application filed earlier than the priority date of the application being searched, for example (assuming again that the applicant is the same for all applications):

date:	application:	subject-matter:
01.03.98	GB1 filed	A
30.05.98	GB2 filed	A
01.03.99	US1 filed (claiming priority of GB1)	A
30.05.99	EP1 filed (claiming priority of GB2)	A
15.04.00	US1 published	A

The publication US1 was found during the search for EP1. GB1 may prejudice the priority of EP1, since it was filed earlier than GB2. US1, which claims GB1 as priority, should, therefore, be cited in the search report as an "L" document according to X, 9.2(viii)(a).

5.4 Documents published after the filing date

The search does not normally take into consideration documents published after the filing date of the application. However, some extension is necessary for specific purposes, as is apparent from VI, 2 to 4, and VI, 5.3.

Certain other situations may occur in which a document published after the filing date is relevant; examples are a later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or a later document showing that the reasoning or the facts underlying the invention are incorrect (see Art. 84 and C-III, 6.3). The search should not be extended for this purpose, but documents of this nature known to the examiner could be selected for citation in the report (see X, 9.2(v)).

5.5 Non-prejudicial disclosures

Art. 55(1)(a) and (b)
Rule 25

Disclosures of the invention should not be taken into consideration if they occurred no earlier than six months preceding the filing date of the European patent application (see G 3/98 and G 2/99, OJ 2/2001, 51) and if they were due to an evident abuse in relation to the applicant or his legal predecessor, or due to display at an official, or officially recognised, international exhibition. The Search Division should, nevertheless, cite in the search report any documents it has reason to believe come within one of the categories mentioned in X, 9.2(viii). In this case too the reference date for the search will be the filing date of the application (see VI, 5.1 and XII, 4). Since the matter of abuse will generally only be raised after transmission of the search report and search opinion (if applicable, see XII, 8), and disclosure at an exhibition involves the question of identity between the displayed and claimed invention, both matters are investigated by the Examining Division.

6. Contents of prior-art disclosures

6.1 General remark

As a general rule, the Search Division selects for citation only documents which are present in the search documentation or which it has access to in some other manner. In that way, no doubt exists about the contents of the documents cited, since the examiner generally has physically inspected each document cited.

6.2 Citation of documents corresponding to documents not available or not published in one of the official EPO languages

Under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of content with another document which the examiner has inspected; both documents should then be mentioned in the search report in the manner indicated at the end of X, 9.1.2. For example, instead of the document published before the filing date in a non-EPO language and selected for citation, the examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in an official EPO language and possibly published after the filing date. Also it may be assumed that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Further, it should be assumed that the

contents of a report of an oral presentation are in agreement with that presentation.

Before citing documents in a language with which he is not familiar, the examiner should make sure that the document is relevant (e.g. through translation by a colleague, through a corresponding document or abstract in a familiar language, or through a drawing or chemical formula in the document or by consulting database indexes relating to the technical content of that document (see X, 9.1.3)).

Chapter VII

Unity of invention

1. General remarks

1.1 Partial European search report

If the Search Division considers that the European application does not comply with the requirement of unity of invention (see C-III, 7), it must search it, and draw up the partial European search report under Rule 64(1), for those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims. The partial European search report is supplemented with a specification of the separate inventions. *Rule 64*

With regard to the search opinion in cases of a lack of unity of invention, see XII, 6.

When determining which invention is the invention or unitary group of inventions first mentioned in the claims, the examiner takes account of the content of the dependent claims, disregarding trivial claims (see III, 3.8).

1.2 Invitation to pay further search fees

The Search Division will inform the applicant of the lack of unity of invention in a communication accompanying the partial search report and indicate that a further search fee must be paid for each invention other than the one first mentioned in the claims, if the search is to cover these inventions as well. The payment of these fees must take place within a period of two months (Rule 64(1)). If the automatic debiting procedure is being used for the application, the applicant must inform the EPO within this period if he does not want all or any of the further inventions to be searched. Otherwise all the further search fees due will be debited automatically on the last day of the period. Searches relating to inventions for which further search fees have been paid within the fixed period receive preferential treatment from the Search Division. The search report is to be drawn up for all those parts of the patent application which relate to inventions in respect of which search fees have been paid. The search report identifies the separate inventions and indicates the subject-matter and corresponding claims (or parts of claims – see Rule 44(2)) for which a search has been made. *Rule 64(1)* *Point 6.1 AAD*

1.3 Documents relevant only to other inventions

Whilst documents relevant only to other inventions may be retrieved during the search on the invention first mentioned in the claims, these are not necessarily included in the partial European search report. Such documents must, however, be cited in the partial search report if they form the basis for a lack of unity a posteriori (see C-III, 7.6 and 7.8).

2. Procedures in cases of lack of unity

2.1 Request for refund of further search fee(s)

Rule 64(2)

At the examination stage the applicant may contest the allegation of non-unity and request a refund of one or more of the further fee(s) paid. If the Examining Division finds this to be justified, the fee(s) in question will be refunded (see, however, XII, 1.2).

2.2 Decision with respect to unity of invention

From the preceding paragraph it is clear that the decision with respect to unity of invention rests with the Examining Division (see III, 1.1). Consequently, the criteria to be applied in this respect by the Search Division should not be different from those applied by the Examining Division.

In particular, the Search Division should not raise an objection of lack of unity merely because the inventions claimed are classified in separate classification units, or merely for the purpose of restricting the search to certain sections of the documentation, for example, certain classification units (see, however, V, 7).

2.3 Complete search despite of lack of unity

Exceptionally, in cases of lack of unity, especially "a posteriori", the examiner is able to make a complete search and prepare a search opinion (where applicable - see XII, 8) for all inventions with negligible additional work and cost, in particular when the inventions are conceptually very close. In those cases, the search for the further invention(s) is completed together with that for the invention first mentioned in the claims. All results should then be included in a single search report, which raises the objection of lack of unity and identifies the different inventions. It further indicates that the Search Division did not invite the applicant to pay further search fee(s) because all claims could be searched without effort justifying such a fee. However, the search opinion (if applicable, see XII, 8) still raises the issue of unity of invention (see XII, 6).

2.4 Supplementary European search

Art. 153(7)
Rule 164(1)

When in a supplementary European search following an international (PCT) search a problem of unity of invention arises, the supplementary European search report will be based on the invention or group of inventions first mentioned in the claims serving as basis for the supplementary European search, independently of the findings of the International Searching Authority as regards unity of invention.

3. Lack of unity and Rule 62a or Rule 63

The procedures for dealing with cases which lack unity and where Rule 63 or Rule 62a applies are dealt with in B-VIII, 3.4 and B-VIII, 4.5 respectively.

Chapter VIII

Subject-matter to be excluded from the search

1. General remarks

In relation to searches carried out for European patent applications, the subject-matter listed in Rule 39.1 PCT may be considered under the EPC either not to be susceptible of industrial application (Art. 57) or, to the extent to which the European patent application relates to that subject-matter as such, to be excluded from patentability under Art. 52(2) and (3), or to constitute an exception to patentability under Art. 53(b) and (c). The claims are not searched in as far as they relate to such subject-matter (for the procedure for limiting the search according to Rule 63 see B-VIII, 3.1, B-VIII, 3.2, B-VIII, 3.3, to B-VIII, 3.4). For the specific case of compositions for use in methods of treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body, see VIII, 2, below.

Art. 52(2) and (3)
Art. 53
Art. 57
Rule 63

While a decision on these matters rests with the Examining Division, opinions on these matters are formed by the Search Division for the purpose of drafting the search opinion (if applicable, see XII, 8) and also in considering possible limitations of the search and therefore whether or not to apply the procedure provided for under Rule 63(1) (see B-VIII, 3.1, B-VIII, 3.2, B-VIII, 3.3, to B-VIII, 3.4). The Search Division has thus to consider the requirements for patentability other than novelty and inventive step, as set out in C-IV, 2 to 5.

Art. 52

The above-mentioned situations may also occur for only some of the claims or for part of a claim. In these cases, this will be indicated in the invitation according to Rule 63(1) and in any subsequent incomplete search report or the declaration taking the place of the search report under Rule 63(2).

Rule 63

2. Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body

With regard to methods for treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body (exceptions to patentability according to Art. 53(c)), it should be noted that according to Art. 54(4) products, in particular substances or compositions, for use in any of these methods, are not excluded from patentability, provided that the use of the product for **any** such method is not comprised in the state of the art (see also C-IV, 4.8). Art. 54(5) provides for the possibility of obtaining further purpose-related product protection for any further and more specific novel and inventive use in a method according to Art. 53(c). It should be noted that a claim in the form "Use of a substance or composition X

Art. 53(c)
Art. 54(4) and (5)

for the manufacture of a medicament for therapeutic application Z" ("Swiss-type" claim) may be allowable for either a first or any further "subsequent" such application (see C-IV, 4.8).

Even if a claim is drafted as a method of medical treatment and is for this reason not directed to patentable subject-matter, a meaningful search may be possible if the determining technical feature is the effect of the substance, which can be searched, and as such the procedure under Rule 63 (see B-VIII, 3.1, B-VIII, 3.2, B-VIII, 3.3, to B-VIII, 3.4) would not be necessary. If, however, specific method features are present (e.g. dosing instructions for the user, combination of pharmaceutical with physical treatment), a meaningful search may not be possible. In cases of doubt the Search Division should issue an invitation under Rule 63(1) (see B-VIII, 3.1). However, regardless of whether such claims are searched or not, the applicant's attention should be drawn in the search opinion (if applicable, see XII, 8) to the fact that such subject-matter is excluded from patentability (see XII, 3).

3. No meaningful search possible

Rule 63

An invitation under Rule 63(1) and subsequent limitation of the search under Rule 63(2) may also result from the application not meeting the relevant requirements of the EPC to such an extent that a meaningful search of the claims, or of some of the claims, or of part of a claim, is impossible. In such cases, the Search Division should apply the procedure under Rule 63 (see B-VIII, 3.1, B-VIII, 3.2, B-VIII, 3.3, to B-VIII, 3.4).

What is or is not "meaningful" is a question of fact for the Search Division to determine. Its finding may change in the light of any reply from the applicant to the invitation under Rule 63(1) (see B-VIII, 3.2). The exercise of the Search Division's discretion will depend upon the facts of the case. There are clearly cases where a search is rendered de facto impossible by the failure to meet the prescribed requirements of the EPC. But these are not the only circumstances under which Rule 63 may be invoked. The word "meaningful" should be construed reasonably.

On the one hand, the word "meaningful" should not be construed in such a way that Rule 63 is invoked simply because a search is difficult. On the other hand, it may be the case that a given claim could, theoretically, be searched completely, but that nevertheless, the Search Division comes to the conclusion, under a proper consideration of the relevant provisions of the EPC, that it would not be meaningful to do so, in the sense that it would not serve any useful purpose to do so having regard, for example, to any possible future prosecution of the application.

In other cases, it may be that the results of the search themselves would be quite meaningless.

A number of non-limiting examples will illustrate where Rule 63 may find application:

(i) claims lacking support; insufficient disclosure

One example would be the case of a broad or speculative claim supported by only a limited disclosure covering a small part of the scope of the claim. This could be the case if the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, and where a meaningful search could only be performed on the basis of the narrower, disclosed invention. This may mean a search of the specific examples. In such a case, it will often be de facto impossible to do a complete search of the whole of the claim at all, because of the broad drafting style. In other cases, a search of the whole of the claim would serve no useful purpose, as the claim would not be defensible in any subsequent examination phase. Accordingly, the procedure under Rule 63(1) may be applied (see B-VIII, 3.1, B-VIII, 3.2, B-VIII, 3.3, to B-VIII, 3.4). Here, the requirements underlying the application of Rule 63 would be those of sufficiency of disclosure and support set out in Art. 83 and 84 (see C-II, 4.9, 4.10; C-III, 6).

(ii) claims lacking conciseness

An 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 (however, for the case of multiple independent claims in the same category see B-VIII, 4). A complete search (or any search at all) may de facto be impossible, or alternatively may serve no useful purpose as the claim or claim set would be indefensible in any subsequent examination phase. Again, the application of Rule 63 and the issuing of a subsequent incomplete search report (according to the procedures defined in B-VIII, 3.1 B-VIII, 3.2 to B-VIII, 3.3) or a declaration of no search may be appropriate, on the grounds that the lack of conciseness of the claim(s) is such as to render a meaningful search impossible (see Art. 84; C-III, 5).

(iii) claims lacking clarity

An example would be where the applicant's choice of parameter to define his invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not employed the same parameter, or has employed no parameter at all. In such a case, the parameter chosen by the applicant may lack clarity (see Art. 84; C-III, 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

claim or of a part of a claim impossible, because the results of any search would be meaningless, the choice of parameter rendering a sensible comparison of the claimed invention with the prior art impossible. If so, the application of Rule 63 and the issuing of a subsequent incomplete search report (or, in exceptional cases, no search at all) under Rule 63(2) (according to the procedures defined in B-VIII, 3.1 B-VIII, 3.2 to B-VIII, 3.3) may be appropriate, 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 invitation under Rule 63(1) being taken into account in determining the subject-matter to be searched to the extent indicated in B-VIII, 3.2).

These examples are not exhaustive. The basic principle is that there should be clarity and openness both for the applicant and for third parties as to what has and what has not been searched.

The treatment of these Rule 63 cases in subsequent examination proceedings is dealt with in C-VI, 5.6.

3.1 Invitation to indicate subject-matter for search

Rule 63(1)(2)

If the EPO considers that the application does not comply with the EPC to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed (see B-VIII, 1, B-VIII, 2 and B- VIII, 3), it will invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched. The invitation will also give the reasons behind this finding and may additionally indicate the claimed subject-matter on which the Search Division considers it feasible to base a meaningful search.

3.2 Reply to the invitation under Rule 63(1)

Rule 63(2)

If the applicant replies in time to the invitation under Rule 63(1), indicating the subject-matter to be searched, and if a meaningful search based on the subject-matter that he has indicated is deemed possible by the Search Division, a search will be conducted on that subject-matter. If the applicant does not reply in time to the invitation under Rule 63(1), the Search Division will determine what to search. In either case a partial search report will be drawn up accordingly, or in exceptional cases a declaration replacing the search report. This limitation of the search has consequences in examination (see C-VI, 5.6).

If the applicant replies to the invitation under Rule 63(1) but in his reply indicates subject-matter which it is still not possible to search in full, the Search Division will determine the subject-matter to search, but will do so in a way which is consistent with the applicant's response, to the extent that this is possible, or in exceptional cases may determine that no meaningful search is possible at all.

If the applicant replies in time to the invitation under Rule 63(1), he may, instead of indicating the subject-matter to be searched, simply argue why he believes that it is possible to carry out a meaningful search on all of the subject-matter claimed. If the Search Division is convinced by the applicant's argumentation, a full search report will be issued and the consequences of a limitation of the search which apply in examination will not ensue. If the Search Division is not convinced, or is only partially convinced, it will issue a partial search report and will determine which subject-matter to search or, in exceptional cases, will issue a declaration replacing the search report.

3.3 The content of the extended European search report (EESR)

The two components of the EESR, the search report (or the declaration replacing it) and the search opinion, will indicate the reasons why it was not considered possible to conduct a meaningful search in respect of some or all of the claimed subject-matter according to Rule 63 and will indicate the subject-matter which was searched, if any, as determined according to the procedures given in B-VIII, 3.2. Furthermore, the search opinion will also invite the applicant to limit his claims to subject-matter which has been searched (in order to comply with Rule 63(3)). The documents cited in the search report and referred to in the search opinion will relate only to this subject-matter. In the event that the subject-matter subject to the search complies with the requirements of the EPC (in particular in that it is novel, inventive and industrially applicable, but also satisfies the other requirements of the EPC such as clarity under Art. 84), the search opinion will still be negative, because the claims do not comply with the requirements of the EPC in respect of their full scope.

Furthermore, if in response to the invitation under Rule 63(1) the applicant disputes the finding that a meaningful search is not possible (see B-VIII, 3.2), but the Search Division is not convinced by the applicant's argumentation, it will indicate why this is the case in the search opinion, as appropriate.

3.4 Applications to which Rule 63 applies which also lack unity

Cases will arise where the application does not comply with the EPC to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of some of the subject-matter claimed (see B-VIII, 1, B-VIII, 2 and B-VIII, 3) and where the application also lacks unity of invention according to Art. 82 and Rule 44. It may be appropriate to raise only the issue of unity of invention and send an invitation under Rule 64(1) (see B-VII, 1.1 and B-VII, 1.2), for example where a large number of claims which results in a severe lack of conciseness is resolved by splitting up the claims into different inventions.

It may, however, be necessary to apply the procedures under both Rule 64(1) (invitation to pay additional search fees for inventions

other than that first mentioned in the claims) and Rule 63(1). In this case, the EPO will first send the applicant an invitation according to Rule 63(1), requesting the applicant to indicate the subject-matter to be searched. In cases where the lack of unity is already apparent before any clarification is received from the applicant, this invitation would also identify the first invention mentioned in the claims and the claims which relate to this invention, either in full or in part, and would invite the applicant to clarify what to search in respect of this invention first mentioned in the claims.

After expiry of the time limit according to Rule 63(1), the subject-matter, if any, to be searched in respect of the first invention will be determined according to the procedures specified in B-VIII, 3.2. A partial search report (or exceptionally a declaration replacing it) will then be prepared on the invention first mentioned in the claims. This will be sent to the applicant along with an invitation to pay additional search fees under Rule 64(1) in respect of the other inventions. Where appropriate, this invitation under Rule 64(1) may also include an invitation according to Rule 63(1), inviting the applicant to clarify the subject-matter to be searched in respect of any additional inventions for which the applicant subsequently pays additional search fees.

Rule 164(1)

For Euro-PCT supplementary European search reports, where these exceptional conditions apply, the procedure will be as above, with the exception that instead of a Rule 64 invitation being sent, the applicant is sent a partial supplementary European search report drawn up on those parts of the application which relate to the invention, or group of inventions within the meaning of Art. 82, first mentioned in the claims. The subject-matter to be searched in respect of the invention, or group of inventions within the meaning of Art. 82, first mentioned in the claims is determined as explained in B-VIII, 3.2.

4. More than one independent claim per category (Rule 62a)

4.1 Invitation to indicate which independent claim to search

Rule 62a(1)

If the European Patent Office considers that the claims as filed do not comply with Rule 43(2) (see C-III, 3.2), it will invite the applicant to indicate, within a period of two months, claims complying with Rule 43(2) on the basis of which the search is to be carried out.

4.2 Reply to the invitation under Rule 62a(1)

If the applicant replies to the invitation under Rule 62a(1), indicating an independent claim in a particular category which he wishes the EPO to search, the EPO will conduct the search based on this claim. If the applicant fails to provide such an indication in due time, the search will be carried out on the basis of the first claim in each category. In either case a search report will be drawn up accordingly. This limitation of the search has consequences in examination (see C-VI 5.6).

In reply to this invitation, the applicant may also indicate more than one independent claim in the same category for search, where these fall within the exceptions provided for in Rule 43(2) (see C-III, 3.2). However, if the applicant does so, but the EPO finds that the claims indicated do not fall within the exceptions provided for in Rule 43(2), only the independent claim with the lowest number indicated by the applicant will be searched. For example, if an application contains independent product claims 1, 10 and 15, an invitation under Rule 62a(1) is sent and the applicant contends in his reply that independent product claims 10 and 15 fall within the exceptions provided for in Rule 43(2) and indicates that these two claims are to be searched, but the Search Division does not agree, then only claim 10 will be searched.

In any timely response to the invitation under Rule 62a(1), the applicant may, instead of indicating the independent claim or claims to be searched, simply argue why he believes that the claims comply with Rule 43(2) (i.e. why the plurality of independent claims in the same category fall within one or more of the exceptions provided for in Rule 43(2)). If the Search Division is convinced by the applicant's argumentation, a search report will be issued on the basis of all the claims, and the consequences of a limitation of the search which apply in examination will not ensue. If the Search Division is not convinced, it will issue a search report for which the search will be conducted based on the first independent claim in that category.

4.3 The content of the extended European search report (EESR)

The search opinion will invite the applicant to limit the application to claims which have been searched (Rule 62a(2)). Furthermore, if in response to the invitation under Rule 62a(1) the applicant disputes the finding under Rule 43(2) (see B-VIII, 4.2), but the Search Division is not convinced by the applicant's argumentation, it will indicate why this is the case in the search opinion, as appropriate.

4.4 Cases under Rule 62a where claims fees are not paid

If an independent claim has been deemed to be abandoned under Rule 45(3) or Rule 162(4) as a result of the non-payment of claims fees (see A-III, 9), the applicant cannot indicate this claim for search in response to the invitation under Rule 62a(1), because no search is conducted on such a claim (see B-III, 3.4). The indication of such a claim by the applicant in response to the invitation under Rule 62a(1) will be ignored by the EPO, which will then apply Rule 62a(1), last sentence, and will search the first independent claim in the category in question for which claims fees have been paid.

If all independent claims in the category in question have been deemed to be abandoned for failure to pay claims fees, no invitation under Rule 62a(1) will be sent in respect of these claims and none of them will be subject to a search.

4.5 Applications to which Rule 62a applies which also lack unity

Cases will arise where the application does not comply with Rule 43(2) (see B-VIII, 4.1 and C-III, 3.2) and the application also lacks unity of invention according to Art. 82 and Rule 44. It may be appropriate to raise only the issue of unity of invention and send an invitation under Rule 64(1) (see B-VII, 1.1 and B-VII, 1.2).

It may, however, be necessary to apply the procedures under both Rule 64(1) (invitation to pay additional search fees for inventions other that the first mentioned in the claims) and Rule 62a(1). In this case, the EPO will first send the applicant an invitation according to Rule 62a(1), requesting him to indicate the independent claims to be searched.

In cases where the lack of unity is already apparent when the invitation under Rule 62a(1) is sent, it will also identify the first invention mentioned in the claims and the claims which relate to this invention, either in full or in part, and will invite the applicant to indicate which claims to search in respect of this invention first mentioned in the claims. After expiry of the time limit according to Rule 62a(1), the claims to be searched in respect of the first invention will be determined according to the procedures specified in B-VIII, 4.2. A partial search report will then be prepared on the invention first mentioned in the claims. This will be sent to the applicant along with an invitation to pay additional search fees under Rule 64(1) in respect of the other inventions. Where appropriate, this invitation under Rule 64(1) may also include an invitation according to Rule 62a(1), requesting the applicant to clarify the claims to be searched in respect of any additional inventions for which he subsequently pays additional search fees.

Conversely, it may also happen that after an invitation is sent according to Rule 62a(1) in respect of all claims, the claims which satisfy Rule 43(2) and which are subject to a search (as determined according to the procedures given in B-VIII, 4.2) are subject to an objection of lack of unity a posteriori. In such cases, an invitation to pay additional fees under Rule 64(1) will then be sent, the invitation being based only on the subject-matter of the claims determined by the applicant's response (or failure to respond) to the invitation under Rule 62a(1).

Rule 164(1)

For Euro-PCT supplementary European search reports, where these exceptional conditions apply, the procedure will be as above, with the exception that instead of being sent a Rule 64 invitation, the applicant is sent a partial supplementary European search report drawn up on those parts of the application which relate to the invention, or group of inventions within the meaning of Art. 82, first mentioned in the claims.

4.6 Treatment of dependent claims under Rule 62a

Claims depending either directly or indirectly via other dependent claims on an independent claim excluded from the search in accordance with Rule 62a(1) (see B-VIII, 4.2) are likewise excluded from the search. Conversely, if a dependent claim depends on more than one previous claim, not all of which were searched, that dependent claim will be searched only in as far as it depends on a claim or claims which were searched in accordance with Rule 62a(1).

5. Invitation under both Rule 62a(1) and Rule 63(1)

In certain cases it may be appropriate to send an invitation according to both Rule 63 (see B-VIII, 3.1) and Rule 62a(1) (see B-VIII, 4.1). This may be necessary, for example, in cases where clarifying which claim or claims to search under Rule 62a will not necessarily help to clarify what subject-matter to search because the application contains several independent claims in the same category, none or only some of which can be subject to a meaningful search in respect of their entire scope. In such cases invitations under both Rule 62a(1) and Rule 63(1) will be sent in a single communication. This single communication gives rise to the same two-month time limit for reply under both rules. In such cases, applicants wishing to respond to both invitations should do so simultaneously.

In response to this invitation under Rule 62a(1) and Rule 63(1), the applicant must not indicate independent claims (in response to the invitation under Rule 62a(1)) and subject-matter (in response to the invitation under Rule 63(1)) which are inconsistent with each other. If the applicant provides inconsistent indications, the Search Division may, depending on the circumstances, either (i) elect to search the claims indicated by the applicant according to Rule 62a(1), where necessary limiting the subject-matter searched in respect of those claims according to Rule 63(2) mutatis mutandis or (ii) elect to search the subject-matter indicated by the applicant according to Rule 63(1) and as defined in the first independent claim of a particular category which is consistent with that subject-matter according to Rule 62a(1), last sentence, mutatis mutandis.

Although sent in the same communication, the invitations under Rule 62a(1) and Rule 63(1) are still legally separate. Consequently, the applicant may also reply to only one of the invitations and not to the other. If he replies only to the Rule 62a(1) invitation, option (i) of the previous paragraph applies. If he replies only to the Rule 63(1) invitation, option (ii) of the previous paragraph applies.

Chapter IX

Search documentation

1. General

1.1 Organisation and composition of the documentation available to the Search Divisions

The basic part of the search documentation consists of a collection of patent documents systematically accessible in a manner suitable for searching. Additionally, periodicals and other publications of technical literature are put at the disposal of the examiners. This non-patent literature is accessible through in-house or external databases, some of which are arranged in the library in a manner suitable for consultation; parts thereof, such as particularly relevant articles, are selected and made available for direct access by incorporating these, or copies thereof, into the systematic documentation. The systematically accessible part of the search documentation includes the minimum documentation required for an International Searching Authority under Rules 34 and 36.1(ii) PCT and extends somewhat beyond these minimum requirements.

Furthermore, the Search Divisions at Berlin have access to the documentation of the Technical Information Centre Berlin of the German Patent and Trademark Office. This documentation is located in the same building and consists mainly of a collection of numerically arranged patent documents and of patent gazettes, a restricted collection of systematically arranged patent documents (primarily intended for use by the public), and a library collection of technical and juridical works and periodicals.

1.2 Systematic access systems

All examiners have at their disposal computer facilities for searching the search documentation. These allow, amongst other things, the use of the internal classification of the EPO (ECLA), which is based on the International Patent Classification (IPC) but comprises finer internal subdivisions. Searches can also be performed using other classification systems and/or words.

In The Hague and Berlin, in many technical fields, the systematically accessible search documentation is also arranged in paper form in a "pigeon-hole" filing system (practising multiple classification and filing where necessary) using the internal classification of the EPO.

1.3 Numerical lists

The EPO operates a computerised patent family system for documents in the search files published since 1968, which is linked with a class-inventory system (for older documents, written or typed lists are available). The family system is updated in co-operation with the national Offices on a basis of exchange of new input data. From

these systems, examiners can obtain the identification of corresponding patents of other countries ("family members") and the classification given to a given patent document.

2. Patent documents arranged for systematic access

2.1 PCT minimum documentation

The systematically accessible search documentation includes the national patent documents belonging to the PCT minimum documentation as specified in Rule 34.1(b)(i) and (c) PCT:

(i) the patents and/or published patent applications, published in or after 1920 by France, the former Reichspatentamt of Germany, Switzerland (in the French and German languages only), the United Kingdom, the Federal Republic of Germany, and the United States of America;

(ii) the utility certificates, and/or published applications therefor, issued by France;

(iii) the patents and/or published patent applications in the English, French or German language in which no priority is claimed, and the abstracts in English of the patents and/or published patent applications in the Spanish language in which no priority is claimed, as selected and made available by the national Office of certain countries, e.g. Austria, Australia, Canada and Spain;

(iv) the abstracts in English of the patents issued, and/or patent applications published, by Japan, the former Soviet Union, the Russian Federation, the Republic of Korea and the People's Republic of China, and the inventors' certificates issued by the former Soviet Union and the Russian Federation, for which abstracts in the English language are generally available.

Also included are published international (PCT) and regional (e.g. European) patent applications, patents, and inventors' certificates (Rule 34.1(b)(ii) PCT).

2.2 Other national patent documents

The search files furthermore include the following national patent documents:

(i) patents published by France, Germany or the United Kingdom before 1920;

(ii) patents and applications for patents published by the Netherlands (from 1912);

(iii) patents published by Belgium since 1926 and Luxembourg since 1946.

Note: a small part of these, published in the French or German language, and not claiming priority, is analogous to the part of the PCT minimum documentation referred to in IX, 2.1(iii) above.

2.3 Unpublished patent applications

Since the completion of the search for conflicting applications that are not published at the time of the initial search is entrusted to the Examining Divisions, the documents which can be cited in the search report do not include unpublished patent applications (see VI, 4.1).

2.4 Search reports

The official European and international (PCT) search reports are normally published together with the European and international applications and are included in the search files together with these applications. The official search reports relating to national applications, as well as unofficial search reports, are also included in these files to the extent that they are available to the public. Search reports that are not normally or not yet accessible to the public in the form of a published document are nevertheless available to the examiners included in the manual search files separately from the state of the art documents, and searching thereof is not compulsory for all applications.

2.5 Arrangements for manual search

The manual search files consist of paper copy documents held loosely in folders which are kept in pigeon-hole filing cabinets; these cabinets are located in storage rooms close to the examiners' rooms to which the folders are taken when needed for search, or in the examiners' rooms themselves.

In order to reduce the bulk of the manual search files and the amount of classification work, whenever an application is republished as such or as a granted patent, normally only one of these documents is included in the manual search files.

2.6 Patent family system

The EPO keeps a patent family system based on application data and priority data of the patent documents stored in databases of the EPO. When viewing patent documents on screen, normally only one representative document of a patent family is displayed, but links to the other members of its patent family are provided.

The practice of not including all members of a patent family in the manual search files (as accepted by WIPO) is followed extensively. With respect to patent documents published after 1968 this is done using the patent family system; for older documents this is done mainly in the context of reclassification projects, with the possibility of updating the family information in the databases accordingly. During manual searches, the examiners can make use of the patent family system to obtain the identification of other family members, which

may then be consulted via the image databases or, if necessary, in the numerical files.

As regards new acquisitions, the selection of the family member to be classified and incorporated in the manual search files is as follows:

(i) all published European applications and international applications designating the EPO are incorporated in the manual search files;

(ii) the family member which is received first at the appropriate directorate, or the one of which the bibliographic data are first available at that department for inclusion in the computer file (when this is not an application as in (i) above), is incorporated in the manual search files;

(iii) whenever a choice is available because of substantially simultaneous arrival, preference is given to documents published in the English, French or German language;

(iv) whenever the first family member included in the manual search files is not in an official language, and a further family member belonging to the minimum documentation is received, that document is also included in the manual search files (in particular the first one of these if more than one is received);

(v) by way of exception, e.g. in complex technical fields, an additional family member may also be included in the manual search files when the information therein is more complete or presented in a more convenient way (e.g. US patents).

The selection of the documents incorporated in the manual search files under the family system as operated in the past, followed slightly different rules in some respects; for these documents the former situation is maintained in principle; nevertheless, whenever there is a reason to review the contents of a field, e.g. in case of reclassification, the opportunity is used to adapt the contents of the manual files to the above situation to the extent that this is practicable.

3. Non-patent literature arranged for systematic access

3.1 Periodicals, records, reports, books, etc.

The systematically accessible search documentation includes the relevant articles from the list of periodicals belonging to the minimum documentation under the PCT as established by the competent WIPO body and from other periodicals where deemed useful by the examiners. In principle, copies of the articles selected as relevant for search purposes are added to the search databases with a fictitious country code "XP", scanned for inclusion in the electronic "BNS" collection and included in the manual search files, where appropriate.

The EPO also subscribes to many further periodicals including abstract journals. Furthermore, records of conference proceedings, reports, books, etc. covering the three official languages of the EPO and the various technically important geographical areas are obtained. Individual items are selected for inclusion in the online and manual search documentation insofar as they constitute useful additions to the state of the art as mainly reflected in the systematically accessible patent documents; such items are mainly primary articles from periodicals or conference proceedings and reports.

3.2 Arrangements for manual search

Whenever copies of non-patent literature items are included in the search files, they are stored together with the patent documents with the same classification, usually in separate folders (see IX, 2.5). Since experience shows that the importance of many of these non-patent items for purposes of search decreases strongly after a few years (e.g. five years), those that have lost interest can be removed. The periodicals and other non-patent items themselves are stored in library manner and will be kept somewhat longer (e.g. 10 years) for the purpose of later consultation and copying. These items are stored together with non-patent literature kept for other purposes as indicated in IX, 5.

4. Non-patent literature arranged for library-type access

4.1 Composition

In addition to the non-patent literature mainly serving search purposes (see IX, 3), the non-patent literature arranged for library type access also comprises such literature serving primarily as sources of information and education of the examiners both as regards general and background technical information and as regards new technical developments. The EPO subscribes to more than 1000 periodicals, and has about 20 000 technical publications. Furthermore, the collection includes many reports, pamphlets, etc. Internet-based document delivery services of publishing companies are made available to examiners in the form of an Electronic Virtual Library (EVL), which can be used from the examiner's desktop computer.

4.2 Arrangement and location

The technical library of the EPO is strongly decentralised, e.g. to the level of directorates or even individual examiners in exceptional cases. One or more library and reading rooms are present in the building on most floors where examiners are located, with copying facilities close at hand. Documents are normally not to be removed from the library rooms for study, but are to be studied in the library rooms, and then if necessary to be copied for further study or use. An online catalogue is available giving a complete inventory by patent classification and giving the location of the items.

5. Search documentation at the various EPO sites

5.1 Electronic search documentation

The electronic search documentation accessible from all sites of the EPO is the same.

5.2 Search documentation in paper form

The search documentation of the Berlin sub-office in paper form shows the following main differences with respect to that at The Hague: it includes the utility models of the Federal Republic of Germany and the patent documents of Austria and the German Democratic Republic, but includes the patent documents of Belgium and Luxembourg only as from 1978 and does not include the patent documents of the Netherlands.

The maintenance of this documentation in paper form is discontinued for those technical fields where low use is made, either as a result of the increased use of electronic tools or of a concentration of the technical fields in which searches are performed (active fields).

The available non-patent literature in the Berlin sub-office at present contains subscriptions to 360 periodicals including the PCT minimum documentation list of periodicals, as well as about 21 000 books.

6. Search documentation in national offices carrying out transferred searches on behalf of the EPO

6.1 Electronic search documentation provided by the EPO

The EPO provides the national offices of its member states with access to its electronic search documentation as described in IX, 1.3 to 2.3.

For other documentation of the EPO, if delivered by commercial database providers, access can be limited, depending on the conditions of data delivery agreed between the EPO and the data provider. However, separate agreements may exist between national offices and data providers.

6.2 Additional search documentation in national patent offices

Some national patent offices have at their disposal a national documentation collection in paper or electronic form, e.g. in languages other than the official languages of the EPO. This documentation can also be used, where appropriate, for carrying out searches on behalf of the EPO.

Chapter X

Search report

1. General

The results of the search will be recorded in a search report. A number of different possible limitations of the scope of the search report exist. These are:

(i) where claims are deemed abandoned for non-payment of claims fees (Rule 45(3), see III, 3.4);

(ii) a declaration replacing the search report according to Rule 63 (see Chapter VIII);

(iii) an incomplete search report according to Rule 63 and/or Rule 62a see Chapter VIII);

(iv) a partial European search report due to a finding of a lack of unity according to Rule 64(1); and

(v) a supplementary European search report according to Art. 153(7) may be incomplete for the reasons given in (i) or (iii) or may be replaced by a declaration according to (ii) (in the case of unpaid claims fees for a supplementary European search, Rule 162(4) applies).

The search reports of types (i) - (iii), (and (v) (insofar as only (i) - (iii) apply) are transmitted to the applicant, published and serve as a basis for the examination by the Examining Division. A partial search report according to Rule 64(1) (case (iv) above), however, is only transmitted to the applicant, but is made available for inspection in the public part of the examination file according to Art. 128(4).

Rule 62(1)

Subject to the exceptions mentioned in XII, 8, European search reports and supplementary European search reports are accompanied by a search opinion, where the Search Division gives an opinion on whether the application and the invention to which it relates seem to satisfy the requirements of the EPC (see XII, 1.1). Together, the European search report or supplementary European search report and the search opinion constitute the extended European search report (EESR).

The Search Division is responsible for drawing up the European search report. It is also responsible for drafting international search reports and search reports on behalf of the industrial property offices of certain Contracting States (see X, 2 and II, 4.4 to 4.6).

This chapter contains the information which is necessary to enable the examiner to correctly prepare the search report.

A search report must contain no matter, in particular no expressions of opinion, reasoning, arguments or explanations, other than that required by the form or referred to in III, 1.1 and 1.2, or X, 9.2(viii). However, this does not apply to the search opinion (see XII, 3).

2. Different types of search reports drawn up by the EPO

The EPO will draw up the following types of search reports:

(i) European search reports (see II, 4.1);

(ii) supplementary European search reports concerning PCT applications (see II, 4.3);

(iii) international search reports under the PCT (see II, 4.4);

(iv) international-type search reports (see II, 4.5);

(v) search reports drawn up on behalf of national offices (see II, 4.6); and

(vi) search reports further to special work.

Further, in the examination procedure, accounts containing the results of additional searches are drawn up when necessary and are not published (see II, 4.2). However, the documents cited therein may be used in the examination procedure (see C-VI, 8.2).

This chapter sets out the requirements for search reports of types (i) to (iv) only, although it is the intention that all search reports drawn up by the EPO are as similar as possible.

3. Form and language of the search report

3.1 Form

The standard search report is prepared by the examiner and contains a main page to be used for all searches for recording the important features of the search, such as:

(i) the application number;

(ii) the classification of the application;

(iii) the fields searched;

(iv) the relevant documents revealed by the search; and

(v) the name of the examiner who executed the search,

as well as supplemental sheet A and, in certain cases, also supplemental sheet B.

Supplemental sheet A is to be used for indicating approval or modifications of the title, the abstract as submitted by the applicant, and the figure to be published with the abstract and for giving the translation of the title into the two other official languages (see X, 7).

Supplemental sheet B is to be completed where there are restrictions on the search, i.e. when claims incurring fees are not searched due to non-payment of claims fees (see III, 3.4), when unity of invention is lacking (see Chapter VII), when a meaningful search is not possible such that the search report is an incomplete one or is completely replaced by a declaration according to Rule 63 (see VIII, 3) or when the search is limited according to Rule 62a (see B-VIII, 4).

Dates appearing in the report should be expressed according to the WIPO standard ST. 2.

3.2 Language

The search report or the declaration accompanying or replacing it according to Rule 63 should be drawn up in the language of the proceedings. *Art. 14(3)* *Rule 61(5)*

4. Identification of the patent application and type of search report

On the main page and supplemental sheets, the European patent application is identified by its filing number.

The type of the search report is indicated in the report.

In case of a joint publication of the application and the search report, the main page of the report is marked A1 (WIPO Standard ST. 16). If publication of the application is due before the search, the main page is marked A2 (WIPO Standard ST. 16). The subsequent search report is established on a new main page which is marked A3 (WIPO Standard ST. 16). Where the search report is a supplementary European search report in respect of an international application, this search report is established on a new main page marked A4 (WIPO Standard ST. 16). *Art. 153(7)*

5. Classification of the patent application

The main page of the report gives the official classification symbol(s) for the European patent application in accordance with V, 4.

If the application is to be published before the search report is prepared (A2 publication, see X, 4), the examiner prepares supplemental sheet A before the publication of the application. In such cases, supplemental sheet A will contain all of the requisite information indicated in X, 7, and also the official classification of the application (in cases where the application lacks unity, see V, 7).

When subsequently the search report is established (A3 publication, see X, 4), the official classification of the application is repeated on

the separately published search report. Where the examiner has modified the official classification (i.e. the official classification as given in the A2 published application differs from that given on the later published A3 search report – see V, 4), it is this amended classification which will appear on the later published A3 search report (see V, 5).

6. Areas of technology searched

Although the EPC does not require the European search report to identify the areas of technology searched, this information is included in the report in the form of a list of IPC symbols up to the sub-class level.

Where the search report is entirely or partly based on a previous search made for an application relating to a cognate subject, the sections of the documentation consulted for this previous search are also identified in the report as having been consulted for the application in question. This is done by indicating the appropriate IPC symbols.

7. Title, abstract and figure(s) to be published with the abstract (as indicated on supplemental sheet A)

Supplemental sheet A is prepared by the examiner before publication of the application, regardless of whether this is with the search report (A1 publication) or without it (A2 publication). The information contained in supplemental sheet A is needed for the publication of the application.

On supplemental sheet A, the examiner indicates:

Rule 47(1)
Rule 66

(i) approval or amendment of the text of the abstract , the content of which is communicated to the applicant according to Rule 66 (see Chapter XI and A-III, 10);

In exceptional cases, the examiner may change the abstract after the search has been carried out. However, if this is done after the application has been published A2, supplemental sheet A is not reissued;

Rule 41(2)(b)

(ii) approval or amendment of the title of the invention (see A-III, 7);

Rule 47(4)

(iii) approval, modification or abolition of the selection of the figure which is to accompany the abstract (see XI, 3(vi) and XI, 4); and

Art. 14(7)(a)

(iv) the translation of the title of the European application into the two other official languages.

The European Patent Bulletin is published in all three official languages of the EPO according to Art. 14(7)(a) and contains the

entries made in the Register of European Patents, which, according to Rule 143(1)(c), must contain the title of the invention. Consequently, the title is required in all three official languages of the EPC.

The above applies equally to applications published with the search report (A1 publication) and those published without it (A2 publication). In the case of an A2 publication, supplemental sheet A further contains the official classification of the application (see X, 5). In case of an A1 publication, the official classification appears only on the search report (Rule 61(6)).

Supplemental sheet A also indicates the nature of the publication to which it relates (A1 or A2).

In the case of a supplementary European search report in respect of an international application, supplemental sheet A should be marked A4. The examiner does not determine the title, abstract or figure to be published with the abstract, since these have already been determined by the International Searching Authority according to Rules 37.2, 38.2(a) and 8.2 PCT, respectively.

8. Restriction of the subject of the search

In the following cases, the search report, the declaration replacing it, or the incomplete or partial search report will indicate whether the subject of the search was restricted and which claims have or have not been searched:

(i) claims above the number of fifteen for which no additional fee has been paid (see III, 3.4). The claims not searched are identified. This only applies to European and supplementary European search reports; *Rule 45(1) and (3)* *Rule 162(1) and (4)*

(ii) lack of unity of invention (see VII). The different inventions must be mentioned by indicating their subject-matter and the claims relating thereto (in part or in full; see Rule 44(2). For the partial search report (see VII, 1.1), an indication is made that it has been established for the invention first mentioned in the claims. This applies to a priori lack of unity and to a posteriori lack of unity. For the search report which will be drawn up for all those inventions in respect of which search fees have been paid, the different inventions (and corresponding claims in full or in part) which have been searched are indicated in the search report; *Rule 64(1)*

Rule 63
Art. 52(2)
Art. 53

(iii) claims in respect of which a meaningful search cannot or only an incomplete search can be carried out (see VIII). A declaration is made either:

(a) that a meaningful search has not been possible on the basis of all claims (this declaration replaces the search report); or

(b) that a meaningful search has not been possible for one or more of the claims in part or in full. In this case, the claims concerned are mentioned in the declaration accompanying the incomplete search report.

In both cases (a) and (b), the reasons for not carrying out or restricting the search should be indicated (for example: subject-matter not patentable; insufficiently clear claims);

Rule 62a

(iv) claims in respect of which a search was not carried out due to non-compliance with Rule 43(2) (see B-VIII, 4.2).

9. Documents noted in the search

9.1 Identification of documents in the search report

9.1.1 Bibliographic elements

All documents cited in the search report must be identified unambiguously by indicating the necessary bibliographic elements. All citations in the search report should comply with WIPO Standard ST. 14 (Recommendation for the inclusion of references cited in patent documents), WIPO Standard ST. 3 (Two-letter codes) and ST. 16 (Standard code for identification of different kinds of patent documents). This does not exclude deviations in those special cases where strict adherence, whilst not necessary for the clear and easy identification of a document, would require considerable extra cost and effort.

9.1.2 "Corresponding documents"

The examiner will often be confronted by the existence of "corresponding" documents (see VI, 6.2), that is to say documents which have the same or substantially the same technical content. These usually fall into one of two groups, namely patent documents from a patent family and abstracts:

(i) patent documents in the same patent family

These are patent documents from the same country or from different countries, and which share at least one claimed priority.

If a cited patent document belongs to a patent family, the examiner need not cite all the members of the family which are known or accessible to him, since these are already mentioned in the annex to

the search report. However, he may mention one or more members in addition to the one cited (see IV, 3.1). Such documents should be identified by the Office of origin, type and number of document, and preceded by the sign ampersand (&). There are a number of possible reasons why the examiner may wish to draw attention in the search report to more than one document in the same patent family, including the following:

(a) one document of the patent family is published before the earliest priority date of the application, but is published in a non-EPO language, whereas a different member of the same patent family is published in an EPO language (see Art. 14(1)), but after the earliest priority date of the application.

Example:

A European application claims a priority of 3 September 1999. In the search on this application, a relevant document – WO 99 12395 A – is found. This document is published in Japanese on 11 March 1999 – in time to constitute prior art according to Art. 54(2). There also exists the European family member published in an English translation according to Art. 153(4) on 1 March 2000 – too late to constitute prior art according to Art. 54(2), but cited in the search report as an "&" document of the Japanese-language WO publication and sent to the applicant (see X, 11.3). It will be used in examination of the application to interpret the content of the Japanese language WO publication (see C-IV, 5.4). In the search report, these documents would be cited as follows (for the mentioning of the claims to which the cited documents relate, here claims 1-10, see X, 9.3):

X	WO 99 12395 A (SEKI SHUNICHI; KIGUCHI HIROSHI (JP); SEIKO EPOSON CORP (JP)) 11 March 1999 (1999-03-11) * figure 1 * & EP 0 982 974 (SEIKO EPSON CORP) 1 March 2000 (2000-03-01) * figure 1 * * claim 1 *	1-10

(b) different documents in the same patent family each containing relevant technical subject-matter not present in the other family members;

(c) where a family member is cited in the application in a non-EPO language and there exists another family

member in an EPO language, where these are both published before the earliest priority date.

Example:

Y	WO9001867 A (WIDEGREN LARS (SE)) 8 March 1990 (1990-03-08) * claim 1 *	1-10
D,Y	& SE461824 B (WIDEGREN LARS (SE)) 2 April 1990 (1990-04-02)	1-10

The fact that the applicant has already cited the relevant SE document in the application, which is a family member of the relevant WO document, means that the applicant has already satisfied the requirement that he mention in the description the state of the art (Rule 42(1)(b)). It is of value to the Examining Division that this be made known in the search report (see C-II, 4.3).

(ii) abstracts of documents (see VI, 6.2)

These are provided by one of a number of database providers (for example Chemical Abstracts, Derwent or Patent Abstracts of Japan) and may relate to many different types of disclosure such as patent documents, journal articles, PhD theses, books etc. The abstract provides a summary of the most important aspects of the technical content of the original document. Most abstracts cited are in the English language. In all cases where an abstract is cited in the search report, the examiner must input the original document to which the abstract relates after the "&" sign.

Example:

Y	PATENT ABSTRACTS OF JAPAN vol. 002, no 148 (C-030) 9 December 1978 (1978-12-09) & JP 53 113730 A (TOSHIBA CORP) 4 October 1978 (1978-10-04) * abstract *	1-10

The examiner may choose to cite the abstract (in which case the original document must be cited as an "&" document) rather than cite the original document for one of a number of reasons. These reasons include: the original document is not easily available to the examiner

(for example, retrieval of PhD theses); or the original document is in a non-EPO language and no other corresponding document exists (for example, a Japanese patent document with no family members, or a journal article in Russian).

9.1.3 Languages of the documents cited

Frequently, members of the same patent family are published in a number of different languages. Consequently, the examiner has a choice regarding the language of the document which is cited in the search report. If the relevant technical content does not differ between the various family members and they are all published before the earliest priority date of the application, then all of the members of the family are of equal relevance to the application. In such cases, the examiner should choose the document to be cited by virtue of its language of publication and according to the following list, the most preferred language being given first:

(1) an official language of the EPO (i.e. English, French or German (Art. 14(1));

(2) an official language of a Contracting State of the EPC according to Art. 14(4) (see A-VIII, 1.1). Such documents can usually be read by a colleague if the examiner in question is not familiar with this language (see VI, 6.2);

(3) a language other than any of those of the Contracting States of the EPC.

In the cases (2) and (3), the examiner might consider citing an abstract in an official language of the EPO, instead of the original document.

9.1.4 Supplementary European search report

In the case of a supplementary European search report according to Art. 153(7), it is also permissible under certain circumstances to have no documents at all cited on the supplementary European search report (see IV, 2.5). In such cases, the expression "No further relevant documents disclosed" will appear in the search report. However, in such cases, the search opinion (if applicable, see XII, 8) will give an opinion on the patentability of the claimed invention over the state of the art cited in the International Search Report (XII, 1.1).

9.2 Categories of documents (X, Y, P, A, D, etc.)

All documents cited in the search report are identified by placing a particular letter in the first column of the citation sheets. Where needed, combinations of different categories are possible. The following letters are used:

(i) particularly relevant documents

Art. 52(1)
Art. 54
Art. 56

Where a document cited in the European search report is particularly relevant, it should be indicated by the letter "X" or "Y". Category "X" is applicable where a document is such that **when taken alone**, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step.

Art. 52(1)
Art. 56

Category "Y" is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents of the same category, such combination being obvious to a person skilled in the art. However, if a document (a so-called "primary document") explicitly refers to another document as providing more detailed information on certain features (see C-IV, 7.1) and the combination of these documents is considered particularly relevant, the primary document should be indicated by the letter "X", i.e. not "Y", and the document referred to should be indicated as "X" or "L" as appropriate;

(ii) documents defining the state of the art and not prejudicing novelty or inventive step

Where a document cited in the European search report represents state of the art not prejudicial to the novelty or inventive step of the claimed invention, it should be indicated by the letter "A" (see, however, III, 1.1);

(iii) documents which refer to a non-written disclosure

Rule 61(4)

Where a document cited in the search report refers to a non-written disclosure, the letter "O" should be entered (see VI, 2). Examples of such disclosures include conference proceedings. In cases where the oral disclosure took place at an officially recognised exhibition (Art. 55(1)(b)), see VI, 5.5. The document category "O" is always accompanied by a symbol indicating the relevance of the document according to (i) or (ii), for example: "O, X"; "O, Y"; or "O, A";

(iv) intermediate documents

Rule 61(3)

Documents published on dates falling between the date of filing of the application being examined and the date of priority claimed, or the earliest priority if there is more than one (see VI, 5.2 and XII, 4), should be denoted by the letter "P". The letter "P" should also be given to a document published on the very day of the earliest date of priority of the patent application under consideration. The document category "P" is always accompanied by a symbol indicating the relevance of the document according to (i) or (ii), for example: "P, X"; "P, Y"; or "P, A";

(v) documents relating to the theory or principle underlying the invention

Where a document cited in the search report may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it should be indicated by the letter "T";

(vi) potentially conflicting patent documents

Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date – see VI, 3 and XII, 4) but published later than that date and the content of which would constitute prior art relevant to novelty (Art. 54(1)) should be indicated by the letter "E". Where the patent document and the application searched have the same date (see C-IV, 7.4), the patent document should also be identified by the letter "E". An exception is made for patent documents based on the claimed priority under consideration; these documents should not be cited;

Art. 54(3)
Art. 139(2)

(vii) documents cited in the application

When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, these should be denoted by the letter "D" (see IV, 1.3);

Rule 42(1)(b)

(viii) documents cited for other reasons

Where in the search report any document is cited for reasons (in particular as evidence – see XII, 5) other than those referred to in the foregoing paragraphs, for example:

Art. 117(1)(c)

(a) a document which may throw doubt on a priority claim (see VI, 5.3);

(b) a document which establishes the publication date of another citation (see XII, 5); or

(c) a document relevant to the issue of double patenting (see IV, 2.3(v), and C-IV, 7.4),

such document should be indicated by the letter "L". Brief reasons for citing the document should be given. The citation of documents of this type need not be linked to any of the claims. However, where the evidence which they provide relates only to certain claims (for example the "L" document cited in the search report may invalidate the priority claim in respect of

certain claims only), then the citation of the document should be linked to those claims, in the manner indicated in X, 9.3.

9.3 Relationship between documents and claims

Rule 61(2)

Each document cited in the search report should be accompanied by an indication of the claims to which it relates, unless the document is indicated by category letter "L" (see X, 9.2(viii)). One and the same document may be indicated by different categories with respect to different claims, wherein each category is associated with particular claims. For example:

X	WO9001867 A (WIDEGREN LARS (SE)) 8 March 1990 (1990-03-08)	1
Y	* column 3, line 27 - line 43; figure 1 *	2-5
A	* figure 2 *	6-10

The above example means that the cited document discloses subject-matter which prejudices the novelty or inventive step of the subject-matter of claim 1 and the inventive step of the subject-matter of claims 2 to 5, when combined with another document cited in the search report, and that it represents non-prejudicial state of the art for the subject-matter of claims 6 to 10. The passages or figures are not necessarily relevant to the claims and the category indicated on the same line.

Furthermore, each independent claim should be mentioned in the search report at least once in relation to at least one document published before the earliest priority date (unless the independent claim in question is excluded from the search by virtue of a restriction of the subject of the search mentioned in X, 8) (see IV, 2.5).

10. Authentication and dates

The date on which the search report was drawn up is indicated in the report. This date should be that of the drafting of the report by the examiner who carried out the search.

The name of the examiner must appear on the search report.

11. Copies to be attached to the search report

11.1 General remarks

Rule 65

The search report is sent to the applicant and transmitted to the Examining Division. In both cases, the report must be accompanied by copies of all documents cited (see also IV, 3.3), except those documents appearing in the search report after the "&" symbol, which are not designated for copying and communication to the applicant (see X, 11.3).

These cited documents are used to assess the patentability of the claimed invention (see XII, 3) both in the search opinion (if applicable, see XII, 8) and in the examination procedure.

11.2 Electronic version of document cited

In the case of a patent document, a complete copy is supplied even if the patent is bulky.

In cases where part or all of the document is published only by electronic means (see Rule 68(2) and OJ 7/2000, 367), an electronic version of at least those parts of the document not available in paper form will be made available to the applicant. This must be done in such a way that the applicant is provided with the whole document either in a combination of paper and electronic forms or in electronic form only.

11.3 Patent family members; the "&" sign

In the case of patent families, only a copy of the member of the family actually cited is normally supplied. The other members are mentioned in an annex systematically produced by the computer for information only (see X, 9.1.2). However, in certain circumstances one or more further patent documents in the same patent family may be mentioned on the search report after the "&" sign (see X, 9.1.2(i)). In these cases, the examiner may designate that a patent document appearing after the "&" sign is also copied and forwarded to the applicant (this document will then also be included in the examination file and may be referred to in the search opinion, if applicable, see XII, 8).

11.4 Reviews or books

In the case of a review or a book, copies should be made of the title page and the relevant pages of the publication concerned.

11.5 Summaries, extracts or abstracts

Where a document cited is a summary, extract or abstract of another document, published separately, a copy of the summary, extract or abstract is forwarded to the applicant along with the report.

If, however, the Search Division considers that the entire document is required, that document must be cited and a copy must be attached to the report (see X, 9.1.2(ii)). In the case of a reference obtained by an online search for which neither the printed version from the database (e.g. COMPDX, PAPERCHEM2 and NTIS) nor the original article is available at the EPO at the time of drafting the search report, the print-out is added to the file in lieu of the original. This may also be done where the printed form of the abstract is available, but where there is no difference in the relevant technical content between the abstract derived from the database print-out and the printed version thereof.

12. Transmittal of the search report and search opinion (if applicable)

Rule 65
Rule 61(1)

The EPO forwards the search report, the search opinion (if applicable, see XII, 8) and copies of all cited documents to the applicant, see X, 11.1), including those documents appearing after the "&" sign and designated to be copied and sent to the applicant (see X, 11.3).

Chapter XI

The abstract

1. Purpose of the abstract

The application must contain an abstract. The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and any drawings. *Rule 57(d)* *Rule 47(5)*

2. Definitive content

The abstract is initially supplied by the applicant. The examiner has the task of determining its definitive content, which will normally be published with the application. In doing this, he should consider the abstract in relation to the application as filed (see IV, 1.4). If the search report is published later than the application, the abstract, published with the application will be the one resulting from the examination referred to in IV, 1.4, third sentence. *Rule 66* *Rule 68*

In determining the definitive content, the examiner should take into consideration that the abstract is merely for use as technical information and in particular must not be used for the purpose of interpreting the scope of the protection sought. The abstract should be so drafted that it constitutes an efficient instrument for purposes of searching in the particular technical field and should in particular make it possible to assess whether there is need for consulting the European patent application itself. *Art. 85* *Rule 47(5)*

3. Content of the abstract

The abstract must:

(i) indicate the title of the invention *Rule 47(1)*

(ii) indicate the technical field to which the invention pertains; *Rule 47(2)*

(iii) contain a concise summary of the disclosure as contained in the description, claims and drawings, which must be so drafted as to allow a clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use of the invention and, where applicable, it should contain the chemical formula which, among those contained in the application, best characterises the invention; *Rule 47(2)*

(iv) **not** contain statements on the alleged merits or value of the invention or its speculative application; *Rule 47(2)*

(v) preferably not contain more than one hundred and fifty words; and *Rule 47(3)*

(vi) be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany *Rule 47(4)*

the abstract. Each main feature mentioned in the abstract and illustrated by a drawing, should be followed by a reference sign in parenthesis.

4. Figure accompanying the abstract

Rule 47(4)

The examiner should consider not only the text of the abstract but also the selection of the figures for publication with it. He should alter the text to the extent that this may be necessary in order to meet the requirements set out in XI, 3. He will select a different figure, or figures, of the drawings if he considers that they better characterise the inventions.

The examiner may prevent the publication of any drawing with the abstract, where none of the drawings present in the application is useful for the understanding of the abstract. This can be done even when the applicant has requested that a particular drawing or drawings be published with the abstract according to Rule 47(4).

In determining the content of the abstract, the examiner should concentrate on conciseness and clarity, and refrain from introducing alterations merely for the purpose of embellishing the language (see X, 7).

5. Checklist

In considering the abstract, the examiner should check it against the General Guidelines for the Preparation of Abstracts of Patent Documents, using the checklist contained WIPO Standard ST. 12, the relevant parts of which are annexed to this Chapter.

6. Transmittal of the abstract to the applicant

Rule 66

The content of the abstract is transmitted to the applicant together with the search report (see X, 7(i)).

Chapter XI – Annex
Checklist for considering the abstract (see XI, 5)

In the following checklist, the abstractor should, after having studied the disclosure to be abstracted, place a check in the second column after the applicable terms listed in the first column. The requirements listed in the third column corresponding to the checked items of the first column should be borne in mind by the abstractor as he prepares his abstract. Finally, the abstractor may compare his finished abstract with the checked requirements and place a corresponding checkmark in the fourth column if he is satisfied that the requirements have been met.

If the invention is a(n)	Check here	The abstract should deal with:	If so, check here
Article		its identity, use; construction, organization, method of manufacture	
Chemical compound		its identity (structure if appropriate); method of preparation, properties, uses	
Mixture		its nature, properties, use; essential ingredients (identity, function); proportion of ingredients, if significant; preparation	
Machine, apparatus, system		its nature, use; construction, organization; operation	
Process or operation		its nature and characterizing features; material and conditions employed; product, if significant; nature of and relationship between the steps, if more than one	
If the disclosure involves alternatives		the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative	

Total number of words less than 250:…..... in range 50-150: ……...

Ref: Standards – ST. 12/A, April 1994

Original: Handbook on Industrial Property Information and Documentation, Publication N° 208(E), 1998, WIPO, Geneva (CH).

Chapter XII

The search opinion

1. Search opinion is part of the EESR

The extended European search report (EESR) is made up of two components: *Rule 62(1)*

(i) the European search report or the supplementary European search report (see Chapter X)

(ii) the search opinion

1.1 The search opinion

For European applications filed as of 1 July 2005 and international applications filed as of that date entering the European phase, European search reports and supplementary European search reports will be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of the EPC.

The above applies except in the cases referred to in XII, 8.

The findings of the search opinion must be consistent with the document categories assigned in the search report and must also be consistent with any other issues raised in the search report, such as lack of unity of invention or limitation of the search.

1.2 Position of the Examining Division

The Examining Division will consider both the objections raised in the search opinion and the applicant's response thereto (see B-XII, 9) when examining the application further. It may change the position adopted in the search opinion after receiving arguments, amendments and other submissions from the applicant in response to the search opinion or subsequently in examination proceedings. The position may also alter, irrespective of the applicant's submissions, where the top-up search could not be completed when the search was performed and Art. 54(3) state of the art is found in a top-up search by the Examining Division or further state of the art is brought to the attention of the Examining Division by the applicant or by means of observations according to Art. 115 (see also IV, 3.2, C-VI, 8.2 and 8.3).

The Examining Division may also reverse the findings of the search opinion for reasons other than those above (see III, 1.1), however, such cases should be exceptional.

2. Basis of the search opinion

Where the application is a European application not derived from an International application, the applicant cannot amend his application *Art. 123(1)* *Rule 137(1)*

before the search report has been communicated to him. Consequently, in these cases, the search opinion will always relate to the application documents as originally filed. Furthermore, any reply filed by the applicant in response to an invitation according to Rule 63(1) (see B-VIII, 3.4) will also be taken into consideration when drawing up the search opinion.

Rule 161(2)
Rule 159(1)(b)
Art. 19 PCT
Art. 34(2)(b) PCT

However, where the application under consideration derives from an International application and is subject to a supplementary European search according to Art. 153(7) (see II, 4.3), the applicant will have had the opportunity to amend his application both in the International phase and also upon entry into the European phase. The search opinion will then be based on the application documents constituting the latest filed request from the applicant (this may involve the cancellation of amendments previously filed and consequent reversion in part or in full to an earlier set of application documents). The supplementary European search report is also based on these application documents (see II, 4.3 and III, 3.3).

Where the search opinion and supplementary European search report are based on such amendments but Rule 137(4) has not been satisfied (see C-VI, 5.7), a communication according to Rule 137(4) (see C-VI, 5.7.1) cannot be sent at this stage (before preparation of the search opinion) because the application is not yet under the responsibility of the Examining Division (see C-VI, 1.1). However, once the Examining Division has assumed responsibility for the application, it may send such a communication, provided that the amendments in question have not been withdrawn or superseded (see C-VI, 5.7.1) and only where the application is of one of the types mentioned in C-VI, 5.7.4.

2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT

If the Receiving Section decided not to re-date the application under Rule 56(2) or (5), but the search examiner is of the opinion that the subsequently filed missing parts are not "completely contained" in the priority document and/or the requirements of Rule 56(3) are not fulfilled, he should carry out the search also taking into account prior art which might become relevant for assessing novelty and inventive step of the subject-matter claimed if the application were re-dated pursuant to Rule 56(2) or (5). The search opinion must include a warning that the application seems not to fulfil the requirements laid down in Rule 56 for maintaining the accorded date of filing, a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the Examining Division. If appropriate, the search opinion may also include comments about the effect of re-dating on the priority claim and/or the status of the prior art documents cited in the search report.

The procedure for a Euro-PCT application is similar to that set out above. If when carrying out a supplementary European search the examiner finds that the subsequently filed missing parts are not "completely contained" in the priority document, despite the fact that the Receiving Office did not re-date the application under Rule 20.5(d) PCT, the search opinion must include a warning that the application seems not to comply with the requirements of Rule 20.6 PCT (Rule 82ter.1(c) PCT), a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the examining division.

However, if the application has been re-dated by the Receiving Section or receiving Office, but the search examiner has reasons to believe that the application meets the requirements of Rule 56(3) (or Rule 20.6 PCT), he must indicate in the search opinion that decisions given by the Receiving Section (or the receiving Office) may be reconsidered at a later stage by the Examining Division, except where the latter is bound by a decision of the Board of Appeal.

2.2 Applications containing claims filed after the accorded date of filing

Where the application documents contain one or more claims filed after the accorded date of filing (Rules 40(1), 57(c) and 58), the search examiner is required to examine whether or not the one or more claims fulfil the requirements of Art. 123(2) in the light of the technical content of the application documents filed at the accorded date of filing. If the claims do not meet the requirements of Art. 123(2), the search (if possible) will be based on the embodiments disclosed in the application documents as filed. This should be indicated in the search opinion together with a reasoned explanation as to why the search is incomplete. In extreme cases a declaration of no search under Rule 63 may need to be issued (see B-VIII, 3.1 to B-VIII, 3.2, B-VIII, 3.3, B-VIII, 3.4 for details of the procedure).

Where the search opinion and search report are based on late-filed claims but Rule 137(4) has not been satisfied (see C-VI, 5.7), a communication according to Rule 137(4) (see C-VI, 5.7.1) cannot be sent at this stage (before preparation of the search opinion) because the application is not yet under the responsibility of the Examining Division (see C-VI, 1.1). However, once the Examining Division has assumed responsibility for the application, it may send such a communication, provided that the late-filed claims have not been superseded (see C-VI, 5.7.1) and only where the application is of one of the types mentioned in C-VI, 5.7.4.

3. Analysis of the application and content of the search opinion

Where it is held that the application and/or the invention to which it relates does not satisfy the requirements of the EPC, then corresponding objections are raised in the search opinion.

The search opinion should, as a general rule, cover all objections to the application (but see XII, 3.4). These objections may relate to substantive matters (e.g. the subject-matter of the application is not patentable) or to formal matters (e.g. failure to comply with one or more of the requirements specified in Rules 41 to 43, 46, 48, 49 and 50) or to both.

Art. 53(c) Where claims relating to a method of treatment of the human or animal body or methods of diagnosis practiced on the human or animal body have been searched because their reformulation into an allowable format can be envisaged at the time of the search (see VIII, 2), the search opinion should, nonetheless, object to these claims as relating to subject-matter which is excluded from patentability.

3.1 The examiner's dossier

Rule 62 The examiner's first step is to study the description, drawings (if any) and the claims of the application. In carrying out his task, the examiner will have access to the documents making up the European application and a complete history of the proceedings up to the start of search. However, the priority documents together with any translations may not yet be available at this stage (see XII, 4).

3.2 Reasoned objections

For each objection the search opinion should indicate the part of the application which is deficient and the requirement of the EPC which is not met, either by referring to specific Articles or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent. For example, where prior art is cited and only part of a cited document is relevant, the particular passage relied upon should be identified. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the independent claim or claims, and if, consequently, there is lack of unity between dependent claims (see C-III, 7.8), the applicant should be informed of this situation (see C-VI, 5.2(i)). Substantive matters should normally be set out first. The search opinion should be drafted in such a manner as to facilitate later examination of the amended application and, in particular, to avoid the need for extensive rereading (see C-VI, 4.2).

3.3 Comments and amendments in response to the search opinion

Subject to certain exceptions, the applicant is required to respond to the search opinion (see XII, 9).

3.4 Extent of first analysis

It is emphasised that the first sentence of XII, 3 only sets out the general rule. There may be cases in which the application is generally deficient. In these cases the examiner should not carry out a detailed analysis, but should send a search opinion to the applicant informing him of this fact, mentioning the major deficiencies and saying that

when the application enters the examination stage, further examination will be deferred until these have been removed by amendment. There may be other cases in which, although a meaningful analysis is possible, a fundamental objection arises, e.g. it is clear that certain claims lack novelty and that the statement of claim will have to be drastically recast, or there are substantial amendments (International applications entering the European phase - see XII, 2) which are not allowable either because they introduce new matter not present in the application as filed (Art. 123(2)), or they introduce other deficiencies (e.g. the amendment makes the claims unclear - Art. 84). In such cases, it may be more appropriate to deal with this objection before making a detailed analysis; if, e.g. the claims need recasting, it may be pointless to raise objections to the clarity of some dependent claims or to a passage in the description which may have to be amended or even deleted in examination proceedings as a consequence. However, if there are other major objections these should be dealt with. Generally, the examiner should seek to make the maximum impact in the search opinion with the broad aim of facilitating as efficient a decision making process as possible in later examination proceedings.

3.5 Contribution to the known art

Rule 42(1)(c)

When analysing the application, the examiner should concentrate on trying to understand what contribution the invention as defined in the claims adds to the known art. This should normally be sufficiently clear from the application as filed. If it is not, an objection should be raised in the search opinion (see C-II, 4.5); but the examiner should not raise an objection of this kind unless he is convinced it is necessary, since to do so might result in the applicant introducing additional subject-matter and thus offending against Art. 123(2) (see C-VI, 5.3 to C-VI, 5.3.11).

3.6 EPC requirements

Although the examiner must bear in mind all the requirements of the EPC, the requirements which are most likely to require attention in the majority of cases are, in particular: sufficiency of disclosure (see C-II, 4); clarity and support in the description, especially of the independent claims (see C-III, 4 and 6); novelty (see C-IV, 9); and inventive step (see C-IV, 11).

3.7 Examiner's approach

The examiner should not require or suggest amendments merely because he thinks they will improve the wording of the description or claims. A pedantic approach is undesirable; what is important is that the meaning of the description and claims should be clear. Also, while any serious inconsistencies between the claims and the description as filed should be objected to (see C-III, 4.3), if the claims appear to require substantial amendment, adaptation of the description to the amended claims is better left until the final form of at least the main claims has been settled in examination proceedings.

3.8 Making suggestions

It must be emphasised that it is not part of the duty of an examiner to require the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and he should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of the EPC. However, it may sometimes be useful if the examiner suggests at least in general terms an acceptable form of amendment, but if he does so he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered in examination proceedings.

3.9 Positive opinion

After the analysis referred to in XII, 3.1 to XII, 3.8 has been made, the Search Division may come to the conclusion that the application and the invention to which it relates both satisfy the requirements of the EPC. In this case the search opinion contains a statement giving a general positive opinion on the application documents. However, where it is not possible to conclude the search for all potentially conflicting applications according to Art. 54(3) at the time of the search (see VI, 4.1), a top-up search will have to be carried out in the examination procedure. (see C-VI, 8.1) and subsequently objections according to Art. 54(3) will be raised if appropriate.

Where minor amendments of the application documents would be necessary for the application to proceed to grant, a positive search opinion can still be issued. Thereafter, subject to no prior art according to Art. 54(3) being found in any subsequent top-up search, the Rule 71(3) communication can then be issued in examination proceedings, with those minor amendments being made by the Examining Division according to C-VI, 14.1.

In the above cases, the applicant is not required to respond to the search opinion (see B-XII, 9).

4. Priority claim and the search opinion

When it is not possible to check the validity of the priority claim at the search stage, because:

(i) the search is carried out before the date on which the priority document must be supplied (up to 16 months from the earliest claimed priority - Rule 53(1)

(ii) a translation of the priority document is required but not available to the Search Division at the time of drafting the search opinion (Rule 53(3) and C-V, 3.4)

then, for the purposes of drafting the search opinion, the priority claim will usually be assumed to be valid.

However, if an assessment of the validity of the priority claim is necessary as a result of intermediate prior art or potential state of the art according to Art. 54(3), and evidence is already available undermining the validity of the priority claim, then this should be brought up in the search opinion. For example, where the priority document is available at the time of drafting the search opinion and technical features of the claims are not present in the priority document, this may even be possible where a translation is required, but the examiner is familiar with the language of the priority document (see also VI, 5.3).

5. Matters of doubt in the state of the art

Since decisions with respect to novelty are not the responsibility of the Search Divisions but of the Examining Divisions (see III, 1.1), the Search Divisions should not discard documents because of doubt as regards for example the exact date of publication or public availability, or the exact contents of an oral disclosure, exhibition, etc. to which such documents may refer. The Search Division should try to remove any doubt that may exist but should nevertheless always cite the documents concerned in the search report. Additional documents providing evidence in the matters in doubt may be cited (see X, 9.2(viii)).

Any indication in a document of the date of its publication should be accepted as correct unless sound reasons for contesting this are given, e.g. by the Search Division, showing earlier publication, or in examination proceedings by the applicant, showing later publication. If the indicated date of publication is insufficiently precise (e.g. because only a month or year is given) to establish whether publication was before the reference date for the search, the Search Division should endeavour to establish the exact date with sufficient precision for the purpose. A date of receipt at the EPO stamped on the document, or a reference in another document, which must then be cited (see X, 9.2(viii)), may be of assistance in this respect. In the preparation of the search opinion and during substantive examination, the public availability of a document may be investigated (see C-IV, 6.1).

6. Unity in relation to the search opinion

Where the Search Division finds that the claimed invention does not meet the requirement of unity of invention (Art. 82 and Rule 44(1) and (2)), the Search Division sends the applicant an invitation to pay additional search fees and the partial search report relating to the invention or unitary group of inventions first mentioned in the claims (see VII, 1.1, 1.2 and 1.3 and Rule 64(1)). The invitation and partial search report are not accompanied by a search opinion.

After the time limit for payment of the additional search fees has expired, (Rule 64(1)) the applicant is sent a search report relating to the invention or unitary group of inventions first mentioned in the claims and all other claimed inventions or unitary groups of inventions

in respect of which additional search fees have been paid. This is accompanied by a search opinion containing:

(i) the reasoning behind the lack of unity

(ii) an opinion on the first invention or unitary group of inventions mentioned in the claims

(iii) an opinion on all inventions or unitary groups of inventions in respect of which additional search fees have been paid

The above applies only to European search reports. For supplementary European search reports on Euro-PCT applications lacking unity of invention, a partial search report is issued directly on the invention first mentioned in the claims only (Rule 164(1) - see B-VII, 2.4).

7. The search opinion in cases of a limitation of the search

Any argumentation and objections presented in the search opinion must be consistent with limitations of the search and the reasons therefor. This applies to limitations for reasons of non-patentability (e.g. business methods - Art. 52(2)(c), see VIII, 1), for reasons of severe deficiencies prejudicing a meaningful search (Rule 63, see VIII, 3) or due to a contravention of Rule 43(2) (Rule 62a, see B-VIII, 4). In these cases, the search opinion will also contain the information indicated in B-VIII, 3.3 and B-VIII, 4.3.

8. No search opinion is issued

Where the applicant has filed the request for examination according to Rule 70(1) before the search report has been communicated to him and has waived the right to receive the communication under Rule 70(2) (see C-VI, 1.1.2), the despatch of the search report to the applicant causes the application to enter the competence of the Examining Division (Art. 18(1) and Rule 10(2)).

In this case, where the application contains deficiencies, the Examining Division will issue a communication according to Art. 94(3) in place of the search opinion. Failure to respond to this communication results in deemed withdrawal of the application according to Art. 94(4) (see C-VI, 3.7).

If the application is ready for grant, the procedure is as follows:

(i) Where the search for conflicting applications according to Art. 54(3) was complete:

The Examining Division will issue a communication according to Rule 71(3)

(ii) Where the search for conflicting applications according to Art. 54(3) was not complete:

The applicant is informed that the application is in order for grant, on condition that no state of the art according to Art. 54(3) is found to exist when the top-up search is completed (see XII, 3.9). This is purely for information and no response from the applicant is required.

9. Reaction to the extended European search report (EESR)

The applicant is required to respond to the search opinion within the time limit for filing the request for examination provided for under Rule 70(1) (see C-VI, 1.1). *Rule 70a(1)*

If, however, the applicant filed the request for examination before the search report and the search opinion were transmitted to him (according to Art. 94(1) this also requires payment of the examination fee), he is sent a communication according to Rule 70(2) requesting him to indicate whether he wishes to proceed further with the application within a period to be specified (see C-VI, 1.1.1). In these cases, the applicant must respond to the search opinion within the time period set under Rule 70(2). This always applies to Euro-PCT applications subject to preparation of the supplementary European search report and search opinion (see B-II, 4.3 and A-VII, 5.3), except where the applicant has waived the communication according to Rule 70(2) (see C-VI, 1.1.2), in which case the procedure under B-XII, 8 applies. *Rule 70a(2)*

Failure to respond to the search opinion within the applicable period results in the application being deemed to be withdrawn, and the applicant is notified accordingly. In response to this communication of a loss of rights, the applicant can request further processing in accordance with Art. 121 and Rule 135. *Rule 70a(3)* *Rule 112(1)*

There is, however, no requirement for the applicant to respond to the European or supplementary European search report where this was drawn up before 1 April 2010, where it is not accompanied by a search opinion (see B-XII, 1.1 for applications for which a search opinion is prepared) or where the search opinion was positive (see B-XII, 3.9). However, in these cases, the applicant may still respond to the search report according to Rule 137(2) if he so wishes. In such cases, the applicant is encouraged to respond to the search report before the application enters the examination stage (see C-VI, 1.1).

The applicant responds to the search opinion by filing amended application documents according to Rule 137(2) (see C-VI, 3.2) (where amended claims are filed before publication, see A-VI, 1.3, paragraph 2) and/or by filing his observations on the objections raised in the search opinion, either in addition to, or in place of, such amendments. Such amendments and/or observations will only be examined by the Examining Division if the application enters the

examination stage. Likewise, telephone conversations and personal interviews can only take place after the application has entered the examination stage. The examiner must not consent to these earlier.

Procedural requests, such as a request for a personal interview (see T 861/03) or for oral proceedings, do not constitute a valid reply where these are made without comment on any of the objections raised in the search opinion. In cases where such a request is the only response to the search opinion on expiry of the applicable time limit, the application is deemed to be withdrawn according to Rule 70a(3).

For applications for which a search opinion was prepared but where the search report was drawn up before 1 April 2010, if the applicant does not reply to the search opinion and the application enters the examination stage (see C-VI, 1.1 and C-VI, 1.1.1), a communication referring to the search opinion and setting a time limit for reply will be issued by the Examining Division as the first communication under Art. 94(3) (see C-VI, 3.5). Failure to respond to this communication in due time will result in the application being deemed withdrawn according to Art. 94(4).

Where the applicant files amendments in response to the search opinion, if Rule 137(4) is not complied with (see C-VI, 5.7), a communication according to Rule 137(4) (see C-VI, 5.7.1) may be sent in respect of these amendments only after the application has passed to the responsibility of the Examining Division (see C-VI, 1.1) and only where the application is of one of the types mentioned in C-VI, 5.7.4.