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GUIDELINES FOR SEARCHES UNDER THE PCT

Report prepared by the International Bureau

Introduction

1. Since the international search under the PCT will be carried out by several International Searching Authorities, "the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their [search] reports" (Article 56(3)(ii) PCT) is needed in order to ensure a successful implementation of such a decentralized system of international search. The Treaty itself and the Regulations thereunder contain a number of provisions aimed at achieving that uniformity of search and search results and the Administrative Instructions will add some more. Moreover, the provision referred to above entrusts the Committee for Technical Cooperation to be established under Article 56, among other things, with the task of contributing to the securing of the said uniformity, this mainly, since the provisions contained in the Treaty and the Regulations were not considered to be sufficient for that purpose.
2. It was, of course, neither possible nor desirable for the Treaty or the legal texts established under it to go into the details of the organization of documentation, working methods of the searcher and other details of search practice.
3. For that purpose, the Committee for Technical Cooperation under Article 56 PCT will eventually have to establish guidelines for searching under the PCT. Since such guidelines should be available from the beginning of the actual implementation of the PCT, a draft should be prepared by the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee") which would require, hopefully, only formal discussion and approval. Such a draft should greatly facilitate the preparations of the prospective International Searching Authorities for their task.

EPO Guidelines for Searches

4. The Interim Committee's attention is drawn to a document recently issued in the framework of the Interim Committee of the European Patent Organization (EPO), the "Draft Guidelines for the Searches to be carried out under the European Patent Convention" of July 8, 1975 (hereinafter referred to as "EPO Guidelines"). This document, which has been prepared by Working Party II of the EPO Interim Committee and copy of which is annexed to this document, has now been submitted to all delegations on the said EPO Committee and to the observer organizations for comments. WIPO, as one of the observer organizations, has also been invited to present its comments. On the basis of the comments received, it is intended to establish a final version of the EPO Guidelines early next year.

5. The EPO Guidelines contain a very detailed description of the practice to be followed for the search procedure relating to European patent applications. Since the future European Patent Office is to be considered as a prospective International Searching Authority under the PCT, an effort has been made both in elaborating the European Patent Convention (EPC) and the legal texts thereunder, and in preparing the EPO Guidelines to ensure that the requirements of the PCT and the future EPO procedure with respect to search and search report are identical or at least compatible. This has been achieved thanks in part to the active cooperation of the International Bureau of WIPO to a very large extent. The EPO Guidelines also contain references to the relevant provisions of the PCT.

6. For these reasons, it is suggested to use the present draft of the EPO Guidelines as a basis for elaborating the PCT Guidelines to the widest extent possible.

7. In order to facilitate an appropriate decision of the Interim Committee at its forthcoming session and the work of the International Bureau, both with respect to the observations it is called upon to present on the EPO Guidelines and with respect to the elaboration of draft PCT Guidelines, observations, if any, on the use for PCT purposes of the attached EPC Guidelines would be appreciated. Such observations, which are particularly expected from prospective PCT Searching Authorities outside the framework of the EPO, could, if they reach the International Bureau by October 15, be used for the purpose of the observations referred to above on the EPO Guidelines and be distributed to the Interim Committee at its next session.

Differences between the EPC and PCT to be taken into account in connection with the Guidelines

8. The EPO Guidelines in their version attached to this document are in almost every respect fully compatible with the PCT. Nevertheless, in some cases, legal differences exist between the PCT and the EPC, and they would, in any case, require different solutions. In order to facilitate the preparation of further discussions of this question, the International Bureau attempts, in the following part of this document, to enumerate such differences, provided they are not only of minor importance or of mere drafting nature.

Objective of the Search

9. According to the EPO Guidelines, Chapter III, page 9, item 1.1, the search examiners in the EPO are, under certain circumstances, called upon to form provisional opinions for the purpose of assessing novelty and inventive step. Since the PCT makes no such provision, the PCT Guidelines should exclude this possibility.

Procedure Prior to Searching

10. The EPO Guidelines, Chapter IV, page 26, item 1.3, provide that in a situation where documents cited in a patent application are not accessible to the EPO Search Division, the Search Division will postpone the search and request the applicant to provide a copy of the document. Such procedure is not available under the PCT.

Search Strategy

11. The EPO Guidelines, Chapter IV, page 32, item 2.8, leave a certain flexibility to the individual search examiner. For example, the search examiner can end the search when documents have been discovered which indicate a clear lack of novelty, or when a reasonable chance of finding relevant documents is no longer proportional to the effort required.

Unity of Invention

12. Under the search system of the EPC as reflected in the EPO Guidelines, Chapter VII, page 48, item 2, several EPO search reports are established in the case of lack of unity of invention. Under Rule 43.7 of the PCT, only a single search report is issued in such case.

Amendments

13. The EPO Guidelines, Chapter X-Y, page 59, item Y.1, permit the applicant to amend the description, drawings and claims after receipt of the EPO search report. Under Article 19(1) of the PCT, the applicant can, at that stage, only amend the claims, but may make a statement indicating the possible impact of the amendments on the description and the drawings.

14. The Interim Committee is invited to make suggestions as to the elaboration of draft PCT Guidelines on Search and on possible comments by WIPO to EPO on the draft EPO Search Guidelines.

[Annex follows]

PCT/TCO/V/12

Annex

INTERIM COMMITTEE
of the European Patent Organisation

- Secretariat -

Brussels, July 8, 1975
CI/52/75

DRAFT GUIDELINES FOR THE SEARCHES
TO BE CARRIED OUT UNDER THE EUROPEAN PATENT CONVENTION

Annex

INTERIM COMMITTEE
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Brussels, July 8, 1975
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DRAFT GUIDELINES
FOR THE SEARCHES TO BE CARRIED OUT
UNDER THE EUROPEAN PATENT CONVENTION

Cover Note

The enclosed draft Guidelines for the searches to be carried out under the European Patent Convention, which have been prepared by Working Party II, are being distributed to all the delegations on the Interim Committee and to the observer organisations for consultation. Chapters on search documentation and on the search report will be added to these draft Guidelines at a later stage.

The draft Guidelines for substantive examination have already been submitted to the same delegations and organisations under reference CI/44/75. The draft Guidelines for formalities examination will follow shortly, and the draft Guidelines for opposition later this year.

The delegations and observer organisations are requested, in order to enable Working Party II to give due consideration to their comments on the enclosed draft, to submit these comments in writing to the Secretariat by:

- (a) 1 October 1975, in the case of the delegations on the Interim Committee;
- (b) 1 November 1975, in all three languages of the Interim Committee, in the case of the observer organisations.

The subsequent procedure in respect of the enclosed draft will be the same as that announced in respect of the draft Guidelines for substantive examination.

DRAFT GUIDELINES FOR THE SEARCHES TO BE CARRIED OUT
UNDER THE EUROPEAN PATENT CONVENTION

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CHAPTER I

INTRODUCTION

1. These Guidelines were elaborated by Working Party II of the Interim Committee during its 1974 and 1975 sessions, in consultation with and with agreement from Working Party III as regards matters of common interest. They were then accepted (...with minor amendments...) by the Interim Committee in its meeting of
2. The President of the European Patent Office in his decision of has adopted these Guidelines (... with minor amendments ...) as internal administrative instructions and guidance for the public in accordance with Article 10, paragraph 2(a) of the Convention.
3. These Guidelines constitute elaborations and clarifications of the provisions of the Convention and its Implementing Regulations, and the relevant Articles and Rules are indicated in the margin. Similarly Guidelines were also elaborated for the formalities examination, the substantive examination and the opposition procedure; where appropriate, references to these other Guidelines have been placed in the margin. (These References are to be added later).
4. In order to ensure uniform practice the Search Divisions are bound to adhere to these Guidelines to the extent that they are not amended or revoked by the President, in particular as a consequence of decisions of the European Patent Office, or overruled by the Enlarged Board of Appeal.

Nevertheless, the application of the Guidelines to, and the interpretation thereof in respect of, individual European patent applications is the responsibility of the Search Divisions, and it may be necessary for search examiners to depart from the general instructions given here in exceptional cases.

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5. These Guidelines were drafted for, and apply to, European searches, i.e. searches performed by the European Patent Office for European applications. In addition to these searches the Search Divisions of the European Patent Office will be called upon to carry out other types of searches (see III, 4). It is intended that these Guidelines should apply to these other types of searches to the largest extent possible, and any deviations from these Guidelines applying to these other searches will be indicated where appropriate and will be summarised in III, 4.4.
6. Special mention is made of international (PCT) searches carried out by the European Patent Office acting as an International Searching Authority under the Patent Cooperation Treaty. Since the requirements of that Treaty and the European Patent Convention with respect to the search and search report are to a very large extent identical or at least compatible, when elaborating these Guidelines the opportunity was taken to make them applicable also to PCT searches to the largest extent possible. References to the relevant Articles and Rules of the PCT are included in these Guidelines in the appropriate places.
7. The Search Divisions of the European Patent Office will take over the task of the International Patent Institute (IIB) with respect to the searching of national applications of its Member 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. Nevertheless it is to be expected that at least for those Member States of the IIB which are also party to the EPC, these national searches will to a large extent be identical with, or compatible with, European searches.
8. European searches will be carried out in the Search Divisions of the Search Service in the branch at The Hague and in the sub-office thereof in Berlin, 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 European Patent Office may be carried out in the sub-office in Rome or may also be entrusted to certain national patent offices. These Search Guidelines apply to the European searches carried out in all these places.

CHAPTER II

GENERAL

- Art. 17, 18
1. The procedure through which a European patent application proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two clearly separated basic stages, i.e. the search and the substantive examination.
2. The objective of the search is to discover the prior 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, (PCT Art. 15(2), Rule 33.1(a)).
- Rule 44(1)
3. The search is essentially a documentary search in a document collection that is systematically arranged (or otherwise systematically accessible) according to the subject-matter contents of the documents. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature.
4. A search report will be prepared containing the results of the search, in particular by identifying the documents constituting the relevant prior art (PCT Art. 16(1), Rule 43.5).
- Art. 17, 92
Rule 44(1)
5. The search report serves to provide information on the relevant prior art to the applicant, to the public and to the Examining Divisions of the European Patent Office (PCT Art. 18(2), Art. 21(3), Art. 33(6), Rule 62.1(b)).
- Art. 92(2), 93
6. Since the search will be carried out and the search report will be prepared mainly by the Search Divisions in the branch of the European Patent Office in The Hague, and the examination will be carried out mainly by the Examining Divisions of the European Patent Office in Munich, the separation of the two steps is geographical as well as procedural.

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7. There are not facilities for systematic searching by the Examining Divisions, other than for conflicting European applications (see V, 4). The Examining Divisions are, therefore, dependent on the work of the Search Divisions for their knowledge of the state of the art on which assessments of the patentability of the invention will be based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by economic considerations (see III, 2).
8. In order to be able to inform the Examining Division of the documents necessary to decide on patentability, the search examiner must be familiar with the basic requirements of examination, especially with respect to novelty, inventive step, unity of invention, and subjects excluded from patentability either specifically or because of lack of industrial applicability (see Chapters V to VIII). On the other hand, a certain amount of feed-back to the Search Division of the consequences of the search, in particular the actions taken by the applicant and the Examining Division as a result of the search report, is necessary in order to obtain searches well adapted to the needs of the examination.
- Art. 17 9. The unit responsible for carrying out the search and drawing up the search report for an application is a Search Division, which consists normally of one search examiner. In exceptional cases, 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.

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CHAPTER III

CHARACTERISTICS OF THE SEARCH

1. The objective of the search

Rule 44(1)

1.1 As stated in II, 2, the objective of the search is to discover relevant prior 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 many instances provisional opinions on these issues must be formed by the Search Division in order to enable an effective search to be carried out. Such provisional opinions will be subject to review by the Examining Division at the examination stage.

1.2 Examples are to be found in paragraphs III, 3.9 - Search for subject-matter of dependent claims, III, 2.5 to 2.7 - Search in analogous art, IV, 2.8 - Stopping search when only trivial matter remains, VII, 9 - Lack of unity a posteriori.

1.3 Occasionally the Search Division will have to form provisional opinions on matters of substantive examination other than novelty or inventive step, in order to be able to proceed with the search or to decide to restrict the search; here again these opinions are subject to review by the Examining Division.

1.4 Examples are to be found in Chapter VII - Unity of invention and Chapter VIII - Subject-matter excluded from patentability and obscurities etc. preventing a meaningful search.

2. Scope of the search

2.1 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 classification system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds.

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The examiner should therefore organise his search effort and utilise his search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as complete anticipations for any claims. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower retrieval ratio can be accepted.

2.2 The PCT stipulates in Article 15, paragraph 4, that the International Searching Authority performing the search shall endeavour to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the PCT Regulations. Since the European Patent Office is expected to become an International Searching Authority (PCT, Article 16, paragraph 1, specifically refers to this possibility), and it is clearly desirable for European and international searches to be fully compatible, the above definition of the scope of the search should be regarded as also applicable to the European searches.

2.3 This implies first of all that the Search Division in searching an application will, in principle, consult all documents in the relevant classification units of the search files, irrespective of their language or age, or of the type of document. Nevertheless the search examiner should for reasons of economy exercise his judgment, based on his knowledge of the technology in question and of the documentation involved, to omit sections in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time

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CHAPTER III

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.

2.4 The question whether certain categories of documents that are of special relevance to the European patent system, and that do not form part of the PCT minimum documentation, such as patent documents of the Scandinavian countries, if included in the search files, will have to be consulted for international searches performed by the Search Service of the EPO, and conversely: whether certain categories of documents that are of special relevance to the PCT, e.g. patent documents of certain countries not contracting to the European patent system, will have to be consulted for European searches, is left open until the matter of the extent of the search documentation of the Search Service of the EPO has been dealt with.

2.5 The search shall be carried out on the basis of the search files which may contain material pertinent to the invention (PCT, Rule 33.2(a)). It should first cover all directly relevant technical fields, and may then have to be extended to analogous fields (PCT Rule 33.2 (b)), 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 initial fields.

2.6 The question of which arts are, in any given case, to be regarded as analogous shall be considered in the light of what appears to be the necessary essential function or use of the invention and not only the specific functions expressly indicated in the application (PCT Rule 33.2 (c)).

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2.7 The decision to extend the search to fields not mentioned in the application must be left to the judgment of the search 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 over-riding principle in determining the extension of the search in analogous fields should be whether it is probable that a reasonable objection that there is lack of inventive step could be established on the basis of what is likely to be found by the search in these fields.

3. The subject of the search

Art. 92(1)
Art. 69(1), 84

3.1 The search should be directed to the invention defined by the claims, as interpreted with due regard to the description and drawings (if any), since this determines the extent of the protection which will be conferred by the European patent if granted (PCT Article 15, paragraph 3, Rule 33.3(a)).

Prot.
Art. 69

3.2 This implies that in the search special emphasis should be directed to the inventive concept underlying the invention to which the claims are directed (PCT Rule 33.3(a)). Consequently 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.

3.3 As a consequence the search should usually embrace also subject-matter that is generally recognised as equivalent to that which is specified in the claims. This applies to the claimed subject-matter as a whole, and also to its individual features (PCT Rule 33.2(d)). For example, if the claim specifies a cable clamp having a certain construction, the search should embrace pipe and similar clamps likely to have the specified construction. Likewise, if the claim is directed to an article consisting of several parts which are defined by their function and/or structure, and the claim stipulates that certain parts are welded together, the search should also embrace alternative methods of connecting such as glueing or riveting, unless it is clear that welding possesses particular advantages required for the invention.

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Rule 86(1)

3.4 Since the applicant may not amend the claims before receiving the search report, the search will be directed to the claims as originally filed in the European application. Therefore, if the European application derives from an earlier international (PCT) application or national application, but has claims that are different from those of that earlier application (e.g. as a consequence of an international or national search report), the claims as filed in the European application form the basis of the European search (see III, 4.3).

Rule 31(3)

3.5 Claims that are deemed to have been abandoned for non-payment of fees must be excluded from the search.

3.6 In principle, and in so far 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 (PCT Rule 33.3(b)). 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 must necessarily include this circuit. Nevertheless, reasons of economy may make certain restrictions necessary, for example when there is a broad claim and many examples and it is not possible to foresee which will be the subject of amended claims.

Art. 84

3.7 No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they are supported by the description. For example if 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. Likewise,

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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.

Rule 29(4)

3.8 The search carried out in the classification units of the search files to be consulted for the main claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) from which they depend; therefore, where the subject-matter of the main claim is novel, that of the dependent claims will also be novel. When the patentability of the main claim is not questioned as a result of the search, there is no need to make a further search in respect of the subject-matter of the dependent claims as such. For example, in an application relating to cathode ray oscilloscope tubes, in which the main 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 search examiner should, in the search files he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. When 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 search files specifically provided for these connections.

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3.9 However, where the patentability of the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art. When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim in effect constitutes a combination claim and should be dealt with accordingly (see III, 3.10).

3.10 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 classification units for this purpose, sub-combinations, including the elements individually (e.g. AB, AC, BC and also A, B and C separately) should be searched in those units at the same time. A search in additional classification units either for subcombinations 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.

3.11 When the application contains claims of different categories, these must be included in the search, and even 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 will only be 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.

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CHAPTER III

Rule 45

3.12 The examiner should, in general, exclude from his search subjects for which no meaningful search can be made; this may result from certain subjects being excluded from patentability, or from the application being obscure (see Chapter VIII).

Rule 46

3.13 Also, when the claims of the application do not relate to one invention only, nor to a group of inventions so linked as to form a single general inventive concept, the search will normally be restricted to the invention, or so 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 separate from the search report.

3.14 In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention (see IV, 2.4). This would include:

- the preamble to the first claim, i.e. the part preceding the expression "characterised by";
- the prior state of the art which is deemed to be known in the introduction of the description of the application but not identified by specific citations;
- the general technological background of the invention (often called "general state of the art").

4. Types of searches4.1 European searches

Art. 17

The task of the Search Service is of course primarily to carry out searches and draw up search reports in relation to European patent applications. In addition to these usual searches, the Search Divisions of the European Patent Office may be called upon to perform various other types of searches, which are listed in the following paragraphs.

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4.2 Additional European searches

At the examination stage of a European application for patent an additional search may be necessary. The Examining Divisions are not equipped for this purpose other than for completion of the search for conflicting applications (see V, 4); all such search work will invariably be referred back to the Search Division, which should promptly carry out this search. The reasons for such an additional search may be for example:

- a. amendment of claims so that they embrace matter not covered by the original search;
- b. clarification of obscurities, etc. that resulted in an incomplete search under Rule 45 (see VIII, 5);
- c. reversal of a provisional opinion of the Search Division with respect to novelty (Chapter V), lack of inventive step (Chapter VI), unity of invention (Chapter VII), or exclusions from patentability (Chapter VIII);
- d. limitations or imperfections in the initial search.

Rule 45

Rule 46

The Examining Division requesting such an additional search will precisely indicate the reason for the request and the subject-matter to be searched. The Search Division will communicate an account of the additional search performed containing the results obtained, to the Examining Division; this account is not sent to the applicant nor is it published by the Search Division, since any necessary communication resulting from it will be the responsibility of the Examining Division.

4.3 Supplementary European searches

- Art. 150(3) An international (PCT) application, for which the European Patent Office acts as designated Office or elected Office shall be 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. In those cases the Search Division will draw up a supplementary European search report. However, the Administrative Council may decide under what conditions and to what extent the supplementary European search report is to be dispensed with. Details about the supplementary search and the supplementary search report
- Art. 157(1)
- Art. 157(2)(a)
- Art. 157(3)

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are to be elaborated later. It should be noted that in case of conflict the provisions of the PCT prevail over those of the EPC.

4.4 International (PCT) searches

Art. 154

When the European Patent Office acts as an International (PCT) Searching Authority in accordance with Article 15⁴ (PCT Article 16, paragraph 1) it is anticipated that the international searches it performs and the international search reports it draws up, will be identical with, or very similar to, European searches and search reports. (A list of differences will be included here later.)

4.5 International-type searches

Under the PCT, the European Patent Office, as an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (PCT Article 15, paragraph 5). These searches are by definition similar to international searches, and the same considerations will apply.

CHAPTER IVSEARCH PROCEDURE AND STRATEGY1. Procedure prior to searching

1.1 When taking up an application to be searched, the search 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. Although he need not study all details of the description and drawings, he should consider these sufficiently to identify the problem underlying the invention, the insight leading to its solution, the means essential to the solution as particularly reflected in the technical features thereof found in the claims, and the results and effects obtained.

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CHAPTER IV

Art. 78
Rules 26-36

Art. 53(a)
Rule 34

1.2 If the search examiner notices any formal shortcomings which have been overlooked by the Receiving Section, he should call these to the attention of the Receiving Section (or of the Examining Division in the case of an additional search requested by that Division), which will take appropriate action. Similarly, if he notes matter contrary to "*ordre public*" or morality or disparaging statements which ought to be omitted from the application as published, he should notify the Receiving Section.

1.3 Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, or as showing the state of the art, or as alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application; however, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. If 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 postpone the search and request the applicant to provide first a copy of the document.

Rule 47
Rule 33

Art. 93(2)

1.4 The examiner should then consider 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. However, if there are initial obscurities, which are cleared away in the course of the search, he may have to return to the abstract after the search is completed.

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CHAPTER IV

1.5 The examiner will then classify the application according to the International Patent Classification, and apply all classification symbols required by the rules of that classification, as regards the claimed invention as well as regards the "supplementary" and "complementary" information as defined in the Guide to the second edition of the International Classification. The examiner should classify the application before carrying out the search, with possible review after the search, for the same reasons as given in IV, 1.4 with respect to the abstract.

2. Search strategy

2.1 Having determined the subject of the invention as outlined in IV, 1.1, it may be desirable for the examiner to prepare first a written 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 Chapter VIII), and lack of unity (see VII, 1) should be borne in mind. The examiner may also have to restrict the subject of the search because of obscurities (see VIII, 5); but he should not do this if it can be avoided and he should subsequently adjust his search if such obscurities are cleared away during the search. Any restrictions of the search on these grounds should be called to the attention of the applicant in a separate communication additional to (or taking the place of) the search report.

2.2 Next the examiner should select the units of the classification (or other sections of the documentation) to be consulted for the search, both in all directly relevant fields and in analagous fields. The selection of classification units in related fields should be limited to:

.../...

CHAPTER IV

(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.

2.3 Often various search strategies are possible, and the examiner should exercise his judgment based on his experience and knowledge of the search files, to select the search strategy most appropriate to the case in hand, and establish the order in which various classification units are to be consulted accordingly. He should give precedence to the units in which the probability of finding documents is highest. Usually the main technical field of the application will be given precedence, starting with the classification units most relevant to the specific example(s) of the claimed invention.

2.4 The examiner should then carry out the search, directing his attention primarily to novelty, but also at the same time paying attention to any prior art likely to have a bearing on inventive step. He should also note any documents that may be of importance for other reasons, such as conflicting applications (see V, 4), or documents putting doubt upon the validity of any priority claimed, contributing to a better or more correct understanding of the claimed invention, or illustrating the technological background; but he should not spend 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.

2.5 The examiner should concentrate his search efforts on the classification units in which the probability of finding highly relevant documents is greatest, and in considering whether to extend the search to other areas he should always take account of the search results already obtained.

CHAPTER IV

2.6 The examiner should continuously evaluate the results of his search, and if necessary reformulate the subjects of the search accordingly. 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 judgment, taking into account results obtained, in deciding at any time during or after the systematic search, whether he should approach the search documentation in some different manner, e.g. by consulting documents cited in the description of documents produced by the search or in a list of references of such documents, or whether he should turn to documentation outside that which is available to the Search Divisions in the search files.

2.7 If no documents of a more relevant nature for assessing novelty and inventive step are available, the examiner should consider citing any documents relevant to the "technological background" of the invention (see III, 3.14), which he may have noted during the search. Generally speaking no special search effort will be undertaken for this purpose; however, the examiner may exercise his discretion here in special cases. In exceptional cases a search may be completed without any relevant document having been found.

2.8 Reasons of economy dictate that the search examiner uses his judgment 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 or inventive step 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. The search for conflicting applications should, however, always be completed to the extent that these are present in the search files.

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CHAPTER IV3. Procedure after searching

3.1 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, PCT Rule 43.5(c)). 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 search examiner should cite rather more readily in order to give the Examining Division the opportunity to consider the matter more fully.

3.2 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. Where more than one member of the same patent family is present in a search file, the search need not discover all of them nor need the search report cite all of them. 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. (This is in accordance with a decision taken by IC/PCT/TCO at its November 1974 meeting. Further details still to be elaborated).

3.3 Finally the examiner should prepare the search report, and where necessary, the internal search note (see Chapter X).

3.4 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). These should be added to the search report up to the time that preparations for its publication are completed. Thereafter, such later discovered documents should be brought to the notice of the Examining Division by means of an internal communication (compare III, 4.2).

THE STATE OF THE ART1. Prior art generally

Art. 54(1)

1.1 "An invention shall be considered to be new if it does not form part of the state of the art" (PCT Art. 33, paragraph 2).

Art. 54(2)

1.2 "The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application" (PCT Rule 33.1(a) and (b)).

1.3 It is to be noted that there is no restriction whatever with respect to the geographical place where, or the language or manner in which, the relevant information was made available to the public; also no age limit is stipulated with respect to documents containing this information.

2. Novelty

2.1 In considering novelty, the documents constituting the state of the art should be considered separately; consequently it is not permissible to combine or mosaic separate documents together.

2.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document when considered in the light of common general knowledge, including any features implicit to a person skilled in the art in what is explicitly contained in the document, e.g. a disclosure of the use of rubber takes away the novelty of the use of an elastic material.

2.3 A prior document should be construed only in the light of knowledge available at the time the document was published, and excluding any knowledge subsequently discovered.

2.4 In considering novelty it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of any generic claim embracing that disclosure. The subject of novelty is more fully considered in Chapter IV, Section 7, of the Guidelines for substantive examination.

CHAPTER V3. Prior art, - oral disclosure etc.

3.1 The PCT according to its Rule 33.1(a) and (b) recognises oral disclosure, use, exhibition, etc., as prior art only when this is substantiated by a written disclosure, which may have been published after the filing date of the application under consideration. Although the EPC does not contain a similar provision, the same practice should be followed for the European search. The cases in which the search examiner knows of an oral disclosure, etc., without a written confirmation will be very rare; and in those cases he could mention the earlier oral disclosure only in the internal search note.

4. Prior art, - conflicting applications

Art. 54(3),
Art. 56

4.1 Additionally, but only for the purpose of determining novelty, the state of the art is considered to comprise the content of European applications as filed, of which the dates of filing are prior to the filing date of the application under consideration, and which were published as European applications on or after that date (herein referred to as conflicting applications). This provision will, however, only be applied in so far as a Contracting State designated in the latter application was also designated in respect of the earlier application as published (PCT Rule 33.1(c)).

Art. 54(4)

Art. 153(1)
Art. 158(1)

4.2 The prior art also includes as conflicting applications international (PCT) applications whose dates fall within the "intervention period", designating, for the purpose of obtaining a European patent, a European State which is a contracting party to both the PCT and the EPC systems, and which is also designated in the European application under consideration.

4.3 Since the Search Division will not verify the justification of the claimed priority dates, there may be uncertainty as regards which of the two applications is the earlier one. Therefore the search for conflicting applications should be extended so as to cover all published applications filed up to one year after the filing date of the application under consideration.

CHAPTER V

Art. 54(3)

4.4 For published conflicting applications the "whole contents" approach is to be applied, i.e. conflict is constituted not merely by the contents of the claims, but by the whole disclosure, i.e. description, drawings (if any) and claims (but not the abstract) of the published earlier application; however, subject-matter disclaimed or stated to belong to the prior art is excluded, unless it is explicitly disclosed (see Guidelines for substantive examination, Chapter IV, 6.1).

Art. 85

4.5 Generally it will not be possible at the time of the search to make a complete search for conflicting European and international applications. This search will therefore have to be completed at the examination stage by the Examining Division which for this purpose will have available classified search files of these published applications. The Search Divisions should therefore not attempt to discover as yet unpublished conflicting applications, nor to undertake special documentation efforts to allow a search therefor; however, when the search examiner knows of such an application, he should mention it in the internal note, but he must not cite it in the search report.

Art. 139(2)

4.6 There may also be national applications of one or more States designated in the European application and coming within the "intervention period". Any of these which are present in the search files should be noted and mentioned in the search report for information (PCT Rule 33.1(c)).

5. Date of reference; filing and priority dateArt. 80, 90
Art. 54(2)

5.1 Since the Search Division is not responsible for the verification of any claimed priority date (which in the examination stage takes the place of the filing date for assessing prior art and determining precedence), 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 (similarly PCT Rule 33.1(a); for the reference date for the search with respect to conflicting applications, however, see V, 4.3).

.../...

CHAPTER V

5.2 The Search Division will therefore include documents published between the priority date or dates and the filing date of the application under consideration, and these must be identified as such in the search report. For identifying these documents when an application has more than one priority date, the oldest date is to be applied for this purpose. When deciding which documents to select for citing in the search report, the examiner will have to refer to these dates and should preferably choose any published before the date of priority. Thus for example, where there are two equally relevant documents one published before the date of priority and the other after that date but before the date of filing, he should choose the former (see IV, 3.2).

5.3 It is the responsibility of the Examining Division to check whether and to what extent the priority claim is justified; therefore the Search Division will not check whether the contents of the European application correspond to those of the priority application(s). Nevertheless, documents showing that a priority claim might not be justified (e.g. an earlier application or patent resulting therefrom, by the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned), should be drawn to the attention of the Examining Division. No special search beyond the filing date of the application 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; also sometimes the country of residence of the applicant being different from the country of the priority application may be an indication of possible lack of first filing, justifying a certain extension of the search.

5.4 When the search is extended for this purpose, it should cover the published applications filed up to one year after the filing date of the application under consideration, for the reasons given in V, 4.3.

5.5 The search will not normally take into consideration documents published after the filing date of the application. However, some extension may be necessary for specific purposes, as is apparent from V,3, V,4 and V,5.3.

5.6 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. 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.

Art. 55

5.7 Disclosures of the invention occurring no earlier than six months preceding the filing of the European patent application and due to an evident abuse in relation to the applicant or his legal predecessor, or due to display at an officially recognised international exhibition, should not be taken into consideration in determining novelty. 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 this case too the reference date for the search will be the filing date of the application (see V, 5.1). Since the matter of abuse will generally only be raised after the transmission of the search report, and the disclosure at an exhibition involves the question of identity between the displayed and claimed invention, both matters are better resolved by the Examining Division.

Rule 23

6. Contents of prior art disclosure

6.1 As a general rule the Search Division will select for citation only documents which are present in its search files or which it has access to in some other manner; in that way no doubt will exist about the contents of the documents cited, since the search examiner will generally have physically inspected each document cited.

CHAPTER V

6.2 However, 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 contents with another document which the examiner has inspected. For example, instead of the document published before the filing date in an inconvenient language and selected for citation, the search examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in a more convenient language and possibly published after the filing date; also the Search Division may assume that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Also the examiner should assume that the contents of a report of an oral presentation are in agreement with that presentation (any comments or explanations should be in the internal search note).

6.3 Before citing documents in a language with which he is not familiar, the search examiner should satisfy himself 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).

7. Matters of doubt in the state of the art

7.1 Since decisions with respect to novelty are not the responsibility of the Search Divisions but of the Examining Divisions, 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 whatever doubt may exist and should not cite the documents concerned in the report unless the doubt is removed or very little doubt remains; additional documents providing evidence in the matters of doubt may be cited. Comments on these documents, as well as citation of documents for which greater doubt remains, should be made in the internal search note.

CHAPTER VI

INVENTIVE STEP

Art. 56

1. "An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art" (PCT Art. 33(1), Rule 33.1(a)).
2. In evaluating inventive step the Examining Divisions will have to consider this in relation to all aspects of the claimed invention, such as the underlying problem (whether explicitly stated in the application or implied), the insight upon which the solution relies, the means constituting the solution, and the effect or results obtained. Therefore, the search will take all these aspects into consideration.
3. European applications of earlier filing date but published on or after the date of filing of the application under consideration are not to be considered when assessing inventive step (but only when assessing novelty).

Art. 54(3),
Art. 56

(Further sections explaining the concept of inventive step in greater detail to the extent that this is useful for the purpose of searching, will be extracted from the Guidelines for Substantive Examination that are under preparation by Working Party III, in consultation with that Working Party).

CHAPTER VII

UNITY OF INVENTION

Art. 82

1. "The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept" (PCT Rule 13.1). If the Search Division considers that the application does not comply with the requirement of unity of invention, it must search, and draw up the search report for, those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims (PCT Art. 17(3)(a)).

Rule 46(1)

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2. The Search Division will inform the applicant of the lack of unity of invention in a communication separate from the search report. The other invention(s) or group(s) of inventions will be searched and separate search reports therefor will be prepared, only if the applicant pays the additional fees. These payments must take place within a period to be set by the Search Division, which may not be less than two weeks and may not be more than six weeks.
- Rule 46(1) (PCT Art. 17(3)(a) and Rule 40.3)
3. At the examination stage the applicant may contest the allegation of non-unity and request a refund of the additional fee(s) paid. If the Examination Division finds the protest justified the fee(s) will be refunded. (compare PCT Rule 40.2(c)).
- Rule 46(2)
4. From the preceding paragraph it is clear that the decision with respect to unity of invention rests with the Examining Division. 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 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-classification units.
5. As indicated in VII, 1 the basic criterion for unity of invention is the presence of a common inventive concept. Consequently, the mere fact that an application contains several independent claims of the same category or claims of different categories is in itself no ground for objection of lack of unity of invention.
- Rule 29(2)
6. Rule 30 particularly specifies certain combinations of different categories that should not be objected to on the grounds of lack of unity:
- Rule 30

.../...

- "(a) *in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product; or*
- (b) *in addition to an independent claim for a process, an independent claim for an apparatus or means specifically designed for carrying out the process; or*
- (c) *in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for an apparatus or means specifically designed for carrying out the process."*

(similarly PCT Rule 13.2). Other combinations may be acceptable provided there is a common inventive concept.

(Further guidance with respect to the application of the criteria for unity of invention in specific situations will be extracted from the Guidelines for Substantive Examination under preparation by Working Party III, in consultation with that Working Party).

7. Lack of unity of invention may also exist within a single claim, where the claim contains alternatives which are not linked by a single general inventive concept, and the objection should be raised.
8. Objection of lack of unity does not normally arise because a claim contains a number of individual features in combination even if these are unrelated (see III, 3.10). Likewise no objection of lack of unity should be made with respect to a dependent claim and the claim from which it depends (see III, 3.8 and 3.9).
9. Lack of unity of invention may be directly evident "*a priori*", i.e. before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*", i.e. after taking the prior art into consideration, e.g. a document discovered in the search shows that there is lack of

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novelty or inventive step in a main claim, leaving two or more dependent claims without a common inventive concept. In the latter case the Search Division may raise the objection of lack of unity and restrict the search to the invention (or group of inventions) first mentioned in these dependent claims, disregarding "trivial" claims as in III, 3.9.

10. Where the search examiner finds a situation of lack of unity of invention to exist, reasons of economy may make it advisable to search the additional invention(s) together with the invention mentioned first in the claims, in the classification units consulted for the latter invention if this takes little or no additional search effort. If objection of lack of unity is raised, the results of the search for the additional invention(s) may not be made part of the search report, but must be kept for a later additional search report if this is requested and once the additional fees are paid. The search for such additional invention(s) will then have to be completed in any further classification units which may be relevant.
11. Occasionally in cases of lack of unity, especially "*a posteriori*", the examiner will be able to make a complete search for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. In those cases, the search for the additional invention(s) should be completed together with that for the invention first mentioned. All results should then be included in a single search report, and no objection of lack of unity should be raised.

.../...

- Art. 157(2)(a) 12. When in a supplementary European search following an international (PCT) search a problem of unity of invention arises, the Search Division should avoid whenever possible deviations from the position taken by the International Search Authority in the international search report, except where the claims have been changed, or the interpretation of the rules regarding unity of invention was clearly incorrect. It should be borne in mind that in case of conflict, e.g. because certain differences in the provisions relating to claims of different categories in EPC Rule 30 and PCT Rule 13(2), the provisions of the PCT prevail. When as a result of the supplementary search lack of unity "*a posteriori*" is found to exist, the Search Divisions should act accordingly (see par. VII-9).
- Art. 150(2)

CHAPTER VIIISUBJECTS TO BE EXCLUDED FROM THE SEARCH

- Art. 52(2) to (4) 53(b) 1. Article 52 specifies certain subjects which are not to be regarded as patentable inventions, whilst Article 53 specifically excludes certain matter from patentability (PCT Art. 17(2)(a)(i), Rule 39.1). The search files need not, and in general do not, contain such subject-matter, so that a meaningful search therefor is not possible and a declaration to that effect takes the place of the search report (PCT Art. 17(2)(a)).
- (Rule 45) 2. This situation may also occur for part of the claims, in which case a partial search is made, and the partial search report is then supplemented with a declaration.
- Art. 52(1) 3. Although a decision on these matters rests with the Examining Division, nevertheless, provisional opinions on these matters must be sometimes formed by the Search Division, which will thus have to consider the requirements for patentability other than novelty and inventive step. In particular it may be necessary to consider any of the following questions:

.../...

- Art. 52(2) (i) whether a claimed invention belongs to the categories excluded from being regarded as patentable inventions in Article 52, paragraph 2, i.e.
- "(a) discoveries, scientific theories and mathematical methods;*
- (b) aesthetic creations;*
- (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;*
- (d) presentations of information";*
- or
- Art. 52(4) (ii) whether the invention is susceptible of industrial application having regard to Article 52, paragraph 4, i.e. whether it is a method for treatment of the human or animal body by surgery or therapy, or a diagnostic method practised on the human or animal body. It should be noted, however, that products, in particular substances or compositions, for use in any of these methods, are not excluded from patentability, provided the use of the product for any such method is not comprised in the state of the art; consequently after the search has discovered one such use, no further search is necessary to establish whether the exact use claimed is novel;
- or
- Art. 54(5) (iii) whether the subject-matter is excepted from patentability having regard to Article 53, sub-paragraph (b), i.e. *"plant or animal varieties or essentially biological processes for the production of plants or animals"* (note however that this exception does not apply to micro-biological processes or the products thereof) (PCT Rule 39.1).
- Art. 53(b)

Rule 45

- 4. In cases of doubt the Search Division should carry out the search to the extent that this is possible in the available documentation.
- 5. A further situation where a meaningful search is not possible or only partially possible, and where a declaration to this effect may take the place of or supplement the search report, may result from the application containing obscurities, inconsistencies or contradictions to the extent that it is impossible to arrive at a reasonable conclusion as to the scope of the claimed invention. The Search Division in these cases may not suspend the search, ask for clarification, and after receipt thereof continue the search, but should make a meaningful search to the extent that this is possible. When later clarifications are received, these will be considered by the Examining Division (which then may request the Search Division to perform an additional search, see III, 4.2).

CHAPTER IX. - SEARCH DOCUMENTATION)
)
) to be included
) later
)
CHAPTER X. - SEARCH REPORT)

CHAPTER X - Y

Effect of Search Report

- Y.1 After receipt of the search report the applicant may amend the description, the drawings and (in particular) the claims (similarly PCT Art. 19 (1)).
- Rule 86(2)
- Also if the request for examination was made before the issue of the search report, the applicant will be invited to confirm the request.
- Art. 96(1)
- Y.2 After publication of the application and the search report third parties may file observations which will be taken into consideration by the Examining Division at the examination stage.
- Art. 115
- Art. 95

.../...

Y.3 After publication of the search report and filing (or confirmation) of a request for examination, the Examining Division will examine the application, basing its assessment of novelty and inventive step upon the prior art mentioned in the search report. This is dealt with in the Guidelines for Substantive Examination (PCT Art. 33(6), Rule 62.1(b)).

Art. 96(2)

Rule 44(1)

CHAPTER XITHE ABSTRACT

Rule 47

1. The search examiner has the task of determining the definitive content of the abstract which is initially supplied by the applicant, and which will subsequently be published with the application or later. In doing this he should consider the abstract in relation to the application as filed (see IV, 1.4) (PCT Rule 38.2(b); Rule 48.2(b)(iii)).

Rule 49

2. 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 (PCT Rule 8.3).

Art. 85

Rule 33(5)

3. The abstract must

Rule 33(1)

i. indicate the title of the invention,

Rule 33(2)

ii. indicate the technical field to which the invention pertains,

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 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,

CHAPTER XI

- Rule 33(2) iv. not contain statements on the alleged merits or value of the invention or its speculative application,
- Rule 33(3) v. preferably not contain more than one hundred and fifty words,
- Rule 33(4) vi. be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany the abstract. Each main feature mentioned in the abstract and illustrated by a drawing, should be followed by a reference sign in parenthesis (PCT Rule 8.1).
- Rule 33(4) 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 may select a different figure, or figures, of the drawings if he considers that they better characterise the invention (PCT Rule 8.2). In determining the definitive 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.
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[End of Document]

INTERIM COMMITTEE FOR TECHNICAL COOPERATION
~~of the European Patent Organisation~~

- Secretariat -

~~Brussels, July 8, 1975~~

~~61/52/75~~

DRAFT GUIDELINES FOR THE SEARCHES
TO BE CARRIED OUT UNDER THE ~~EUROPEAN PATENT CONVENTION~~
PATENT COOPERATION TREATY

Annex

INTERIM COMMITTEE
of the ~~European Patent Organisation~~ Patent Cooperation Treaty

- Secretariat -

Brussels, July 8, 1975

~~61/52/75~~

DRAFT GUIDELINES

FOR THE SEARCHES TO BE CARRIED OUT
UNDER THE EUROPEAN PATENT CONVENTION PATENT COOPERATION TREATY

Cover Note

~~The enclosed draft Guidelines for the searches to be carried out under the European Patent Convention, which have been prepared by Working Party II, are being distributed to all the delegations on the Interim Committee and to the observer organisations for consultation. Chapters on search documentation and on the search report will be added to these draft Guidelines at a later stage.~~

The draft Guidelines for substantive examination have already been submitted to the same delegations and organisations under reference CI/44/75. The draft Guidelines for formalities examination will follow shortly, and the draft Guidelines for opposition later ~~this year.~~

The delegations and observer organisations are requested, ~~in order to enable Working Party II to give due consideration to their comments on the enclosed draft, to submit these comments in writing to the Secretariat, by:~~

~~(a) 1 October 1975, in the case of the delegations on the Interim Committee;~~

(b) 1 November 1975, in all three languages of the Interim Committee, in the case of the observer organisations.

The subsequent procedure in respect of the enclosed draft will be the same as that announced in respect of the draft Guidelines for ~~substantive examination.~~

DRAFT GUIDELINES FOR THE SEARCHES TO BE CARRIED OUT
UNDER THE EUROPEAN PATENT CONVENTION PATENT COOPERATION TREATY

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.../...

CHAPTER I

INTRODUCTION

1. These Guidelines were elaborated by ~~Working Party II of the Interim Committee during its 1974 and 1975 sessions, in consultation with and with agreement from Working Party III~~ the ~~as regards matters of common interest. They were then accepted (with minor amendments) by the Interim Committee in its meeting of~~ Director General of WIPO ~~for Technical Cooperation~~
2. The ~~President of the European Patent Office~~ Director General of WIPO in his decision of has adopted these Guidelines (... with minor amendments ...) as internal administrative instructions and guidance for the public in accordance with ~~Article 10, paragraph 2(a) of the Convention.~~ Rule 89.2(a) of the Treaty
3. These Guidelines constitute elaborations and clarifications of the provisions of the ~~Convention and its Implementing Regulations, and the relevant Articles and Rules, are indicated in the margin.~~ Treaty Similarly, ~~a Guideline, were also elaborated for the formalities examination, the substantive examination and the opposition procedure, where appropriate, references to these other Guidelines have been placed in the margin. (These References are to be added later)~~ was
4. In order to ensure uniform practice the ~~Search Divisions are bound to adhere to these Guidelines to the extent that they are not amended or revoked by the President, in particular as a consequence of decisions of the European Patent Office, or overruled by the Enlarged Board of Appeal.~~ International Searching Authorities encouraged Director General

Nevertheless, the application of the Guidelines to, and the interpretation thereof in respect of, individual ~~European patent~~ international applications is the responsibility of the ~~Search Divisions,~~ International Searching Authorities. and it may be necessary for search examiners to depart from the general instructions given here in exceptional cases.

.../...

5. These Guidelines were drafted for, and apply to, ~~European searches, i.e. searches performed by the European Patent Office for European applications.~~ international ~~In addition to these searches the Search Divisions of the European Patent Office will be called upon to carry out other types of searches (see III, 4). It is intended that these Guidelines should apply to these other types of searches to the largest extent possible, and any deviations from these Guidelines applying to these other searches will be indicated where appropriate and will be summarised in III, 4.4.~~

6. ~~Special mention is made of international (PCT) searches carried out by the European Patent Office acting as an International Searching Authority under the Patent Cooperation Treaty. Since the requirements of that Treaty and the European Patent Convention with respect to the search and search report are to a very large extent identical or at least compatible, when elaborating these Guidelines the opportunity was taken to make them applicable also to PCT searches to the largest extent possible.~~ References to the relevant Articles and Rules of the PCT are included in these Guidelines in the appropriate places.

~~7. The Search Divisions of the European Patent Office will take over the task of the International Patent Institute (IIB) with respect to the searching of national applications of its Member 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. Nevertheless it is to be expected that at least for those Member States of the IIB which are also party to the EPC, these national searches will to a large extent be identical with, or compatible with, European searches.~~

~~Prot. Centr.
I(1)(b)~~

~~Art. 17~~

~~Prot. Centr.
I(1), I(3)
IV(2), V~~

~~8. European searches will be carried out in the Search Divisions of the Search Service in the branch at The Hague and in the sub-office thereof in Berlin, 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 European Patent Office may be carried out in the sub-office in Rome or may also be entrusted to certain national patent offices. These Search Guidelines apply to the European searches carried out in all these places.~~

CHAPTER II

GENERAL

- ~~Art. 17, 18~~ 1. The procedure through which ~~a European~~ an international ~~patent~~ application proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two clearly separated basic stages, i.e. international the search and the substantive examination. by an international, regional, or national office
- ~~Rule 44(1)~~ 2. The objective of the search is to discover the prior art which is relevant for the purpose of determining whether, and if so to what extent, the invention to which the claimed application relates is new and involves an inventive step, (PCT Art. 15(2), Rule 33.1(a)). or is not new and does or does not involve
- 3. The search is essentially a documentary search in a document collection that is properly systematically arranged (or otherwise systematically accessible), according to the for search purposes subject-matter contents of the documents. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature.
- ~~Art. 17, 92~~ ~~Rule 44(1)~~ 4. A search report will be prepared con- An international taining the results of the search, in particular by identifying the documents constituting the relevant prior art (PCT Art. 16(1), Rule 43.5).
- ~~Art. 92(2), 93~~ 5. The search report serves to provide international information on the relevant prior art to the applicant, to the public and to the if the application Examining Divisions of the European Patent Office is published Office (PCT Art. 18(2), Art. 21(3), Art. 33(6), Rule 62.1(b)). designated Offices
- 6. Since the search will be carried out and the search report will be prepared mainly international by the Search Divisions in the branch of the European Patent Office in The Hague, International Searching and the examination will be carried out Authorities mainly by the Examining Divisions of the designated Offices European Patent Office in Munich; the separation of the two steps is geographical may be as well as procedural.

CHAPTER II

7. ~~There are no facilities for systematic searching by the Examining Division, other than for conflicting European applications (see V, 4). The Examining Divisions are, therefore, dependent on the work of the Search Divisions for their knowledge of the state of the art on which assessments of the patentability of the invention will be based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by economic considerations (see III, 2).~~

In some instances, there designated Offices national Some designated Offices may International Searching Authorities their international

8. In order to be able to inform the ~~Examining Division~~ of the documents necessary to decide on patentability, the search examiner must be familiar with the basic requirements of examination, especially with respect to novelty, inventive step, unity of invention, and subjects excluded from patentability either specifically or because of lack of industrial applicability (see Chapters V to VIII). On the other hand, a certain amount of feed-back to the ~~Search Division~~ of the consequences of the search, in particular the actions taken by the applicant and the ~~Examining Division~~ as a result of the search report, ~~is necessary~~ in order to obtain searches well adapted to the needs of the examination.

designated Offices International Searching Authority designated Office may be desirable

international

~~Art. 17~~

9. The unit responsible for carrying out the search and drawing up the search report for an application is ~~a Search Division, which consists normally of one search examiner. In exceptional cases, 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.~~

international the International Searching Authority. The search itself will normally be performed by search containing the work necessary

CHAPTER IIICHARACTERISTICS OF THE SEARCH1. The objective of the search~~Rule 44(1)~~

1.1 As stated in II, 2, the objective of the search is to discover relevant prior 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 many instances designated Offices provisional opinions on these issues must be formed by the ~~Search Division~~ in order to search examiner enable an effective search to be carried out. Such provisional opinions will be subject to review by the ~~Examining Division~~ at the designated Office examination stage.

~~1.2~~ Examples are to be found in paragraphs III, 3.9 - Search for subject-matter of dependent claims, III, 2.5 to 2.7 - Search in analogous art, IV, 2.8 - Stopping search when only trivial matter remains, VII, 9 - Lack of unity a posteriori.

2 ~~1.3~~ Occasionally the ~~Search Division~~ will International Searching Authority have to form provisional opinions on matters of substantive examination other than novelty or inventive step, in order to be able to proceed with the search or to decide to restrict the search; here again these opinions are subject to review by the ~~Examining Division~~. designated Office

~~1.4~~ Examples are to be found in Chapter VII - Unity of invention and Chapter VIII - Subject-matter excluded from patentability and obscurities etc. preventing a meaningful search.

2. Scope of the search

2.1 The ~~European~~ search is essentially a international 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 classification system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds.

CHAPTER III

The examiner should therefore organise his search effort and utilise his search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as complete anticipations for any claims. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower retrieval ratio can be accepted.

2.2 The PCT stipulates in Article 15, paragraph 4, that the International Searching Authority performing the search shall endeavour to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the PCT Regulations. ~~Since the European Patent Office is expected to become an International Searching Authority (PCT, Article 16, paragraph 1, specifically refers to this possibility), and it is clearly desirable for European and international searches to be fully compatible, the above definition of the scope of the search should be regarded as also applicable to the European searches.~~

2.3 This implies first of all that the ~~Search Division~~ in searching an application will, in principle, consult all documents in the relevant classification units of the search files, irrespective of their language or age, or of the type of document. Nevertheless the search examiner should for reasons of economy exercise his judgment, based on his knowledge of the technology in question and of the documentation involved, to omit sections in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time

International
Searching Authority

CHAPTER III

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.

~~2.4 The question whether certain categories of documents that are of special relevance to the European patent system, and that do not form part of the PCT minimum documentation, such as patent documents of the Scandinavian countries, if included in the search files, will have to be consulted for international searches performed by the Search Service of the EPO, and conversely, whether certain categories of documents that are of special relevance to the PCT, e.g. patent documents of certain countries not contracting to the European patent system, will have to be consulted for European searches, is left open until the matter of the extent of the search documentation of the Search Service of the EPO has been dealt with.~~

All relevant

should

by an International Searching Authority

2.5 The search shall be carried out on the basis of the search files which may contain material pertinent to the invention (PCT, Rule 33.2(a)). It should first cover all directly relevant technical fields, and may then have to be extended to analogous fields (PCT Rule 33.2 (b)), 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 initial fields.

2.6 The question of which arts are, in any given case, to be regarded as analogous shall be considered in the light of what appears to be the necessary essential function or use of the invention and not only the claimed specific functions expressly indicated in the application (PCT Rule 33.2 (c)).

2.7 The decision to extend the search to fields not mentioned in the application, must be left to the judgment of the search 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 over-riding principle in determining the extension of the search in analogous fields should be whether it is probable that a reasonable objection that there is lack of inventive step could be established on the basis of what is likely to be found by the search in these fields.

3. The subject of the search

~~Art. 92(1)~~
~~Art. 69(1), 84~~

3.1 The search should be directed to the invention defined by the claims, as interpreted with due regard to the description and drawings (if any), ~~since this determines the extent of the protection which will be conferred by the European patent if granted~~ (PCT Article 15, paragraph 3, Rule 33.3(a)).

and with particular emphasis on the inventive concept towards which the claims are directed.

~~Prot.~~
~~Art. 69~~

3.2 This implies that in the search special emphasis should be directed to the inventive concept underlying the invention to which the claims are directed (PCT Rule 33.3(a)). Consequently 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.

3.3 As a consequence the search should usually embrace also subject-matter that is generally recognised as equivalent to that which is specified in the claims. This applies to the claimed subject-matter as a whole, and also to its individual features (PCT Rule 33.2(d)). For example, if the claim specifies a cable clamp having a certain construction, the search should embrace pipe and similar clamps likely to have the specified construction. Likewise, if the claim is directed to an article consisting of several parts which are defined by their function and/or structure, and the claim stipulates that certain parts are welded together, the search should also embrace ~~alternative~~ methods of connecting such as glueing or riveting, unless it is clear that welding possesses particular advantages required for the invention.

even though, in its specifics, the invention as described is different

equivalent

CHAPTER III

~~Rule 86(1)~~

3.4 Since the applicant may not amend the claims before receiving the search report, the search will be directed to the claims as originally filed in the European application. ~~Therefore, if the European application derives from an earlier international (PCT) application or national application, but has claims that are different from those of that earlier application (e.g. as a consequence of an international or national search report), the claims as filed in the European application form the basis of the European search (see III, 4.3).~~

international

except to correct formal matters which are contrary to the Treaty and are called to applicant's attention by the receiving Office, (for example, Rule 6 and Rule 10 defects)

~~Rule 31(3)~~

3.5 Claims that are deemed to ~~have been abandoned for non-payment of fees~~ must be excluded from the search.

be drawn to inventions for which no fees have been paid

3.6 In principle, and in so far 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 (PCT Rule 33.3(b)). 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 must necessarily include this circuit. Nevertheless, reasons of economy may make certain restrictions necessary, for example when there is a broad claim and many examples and it is not possible to foresee which will be the subject of amended claims.

~~Art. 84~~

3.7 No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they are supported by the description. For example if 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. Likewise,

CHAPTER III

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.

3.8 The search carried out in the classification units of the search files to be consulted for the main claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) from which they depend, ~~therefore, where the subject matter of the main claim is~~ novel, that of the dependent claims will also be novel. When the patentability of the main claim is not questioned as a result of the search, there is no need to make a further search in respect of the subject-matter of the dependent claims as such. For example, in an application relating to cathode ray oscilloscope tubes, in which the main 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 search examiner should, in the search files he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. When 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 search files specifically ~~provided for these connections.~~

~~Rule 29(4)~~

CHAPTER III

3.9 ~~However, where the patentability of~~ the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units. No such special search should be made for features that are ~~trivial or generally known in the art.~~ When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim in effect constitutes a combination claim and should be dealt with accordingly (see III, 3.10).

3.10 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 classification units for this purpose, sub-combinations, including the elements individually (e.g. AB, AC, BC and also A, B and C separately) should be searched in those units at the same time. A search in additional classification units either for subcombinations 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.~~

3.11 When the application contains claims of different categories, these must be included in the search, and even when the application contains only claims of one category, it may be desirable to include other categories in the search. For example, generally, ~~the~~ 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 will only be 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.

.../...

CHAPTER III

3.12 The examiner should, in general, exclude from his search subjects for which no meaningful search can be made; this may result from certain subjects being excluded from patentability, or from the application being obscure (see Chapter VIII).

the search under PCT Rule 39

~~Rule 45~~

3.13 ~~Also,~~ When the claims of the application do not relate to one invention only, nor to a group of inventions so linked as to form a single general inventive concept, the search will normally be restricted to the invention, or so 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 separate from the search report.~~

and the required additional fees have not been paid within the prescribed time limit

~~Rule 46~~

3.14 In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention (see IV, 2.4). This would include:

If the additional fees have been timely paid, all inventions covered thereby must also be searched.

- the preamble to the first claim, i.e. the part preceding the expression "characterised by";
- the prior state of the art which is deemed to be known in the introduction of the description of the application but not identified by specific citations;
- the general technological background of the invention (often called "general state of the art").

4. Types of searches

~~4.1 European searches~~

~~The task of the Search Service is of course primarily to carry out searches and draw up search reports in relation to European patent applications. In addition to these usual searches, the Search Divisions of the European Patent Office may be called upon to perform various other types of searches, which are listed in the following paragraphs.~~

~~Art. 17~~

~~4.2 Additional European searches~~

At the examination stage of a European application for patent an additional search may be necessary. The Examining Divisions are not equipped for this purpose other than for completion of the search for conflicting applications (see V, 4); all such search work will invariably be referred back to the Search Division, which should promptly carry out this search. The reasons for such an additional search may be for example:

Rule 45

a. amendment of claims so that they embrace matter not covered by the original search;

b. clarification of obscurities, etc. that resulted in an incomplete search under Rule 45 (see VIII, 5);

Rule 46

c. reversal of a provisional opinion of the Search Division with respect to novelty (Chapter V), lack of inventive step (Chapter VI), unity of invention (Chapter VII), or exclusions from patentability (Chapter VIII);

d. limitations or imperfections in the initial search.

The Examining Division requesting such an additional search will precisely indicate the reason for the request and the subject-matter to be searched. The Search Division will communicate an account of the additional search performed containing the results obtained, to the Examining Division; this account is not sent to the applicant nor is it published by the Search Division, since any necessary communication resulting from it will be the responsibility of the Examining Division.

Art. 150(3)

4.3 Supplementary European searches

Art. 157(1)

Art. 157(2)(a)

Art. 157(3)

An international (PCT) application, for which the European Patent Office acts as designated Office or elected Office shall be 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. In those cases the Search Division will draw up a supplementary European search report. However, the Administrative Council may decide under what conditions and to what extent the supplementary European search report is to be dispensed with. Details about the supplementary search and the supplementary search report

CHAPTER III

~~are to be elaborated later. It should be~~
noted that in case of conflict the provisions of the PCT prevail over those of the EPC.

4.4 International (PCT) searches

When the European Patent Office acts as an International (PCT) Searching Authority in accordance with Article 154 (PCT Article 16, paragraph 1) it is anticipated that the international searches it performs and the international search reports it draws up, will be identical with, or very similar to, European searches and search reports. (A ~~list of differences will be included here later.~~)

1 4.5 International-type searches

Under the PCT, ~~the European Patent Office, as~~ an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (PCT Article 15, paragraph 5). These searches are by definition similar to international searches, and the same considerations will apply.

CHAPTER IVSEARCH PROCEDURE AND STRATEGY1. Procedure prior to searching

1.1 When taking up an application to be searched, the search 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. Although he need not study all details of the description and drawings, he should consider these sufficiently to identify the problem underlying the invention, the insight leading to its solution, the means essential to the solution as particularly reflected in the technical features thereof found in the claims, and the results and effects obtained.

CHAPTER IV

Art. 18
Rules 26-36

Art. 53(a)
Rule 34

1.2 If the search examiner notices any formal shortcomings which have been overlooked by the Receiving ~~Section~~, he should call these to the attention of the Receiving ~~Section (or of the Examining Division in the case of an additional search requested by that Division)~~, which will take appropriate action. Similarly, if he notes matter contrary to "ordre public" or morality or disparaging statements which ought to be omitted from the application as published, he should notify the ~~Receiving Section~~ applicant

Office
Office

1.3 Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, or as showing the state of the art, or as alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application; however, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. If 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 postpone the search and request the applicant to provide first a copy of the document.~~

International
Searching
Authority

International
Searching
Authority may

Rule 47
Rule 33

~~Art. 93(2)~~

1.4 The examiner should then consider the abstract in relation to the requirements ~~set 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. However, if there are initial obscurities, which are cleared away in the course of the search, he may have to return to the abstract after the search is completed.

if possible to do so within the time limits for the preparation of the international search report under the Treaty

CHAPTER IV

1.5 The examiner will then classify the application according to the International Patent Classification, ~~and apply all classification symbols required by the~~ at least the rules of that classification, as regards the claimed invention as well as regards the "supplementary" and "complementary" information as defined in the Guide to the second edition of the International Classification. The examiner should classify the application before carrying out the search, with possible review after the search, for the same reasons as given in IV, 1.4 with respect to the abstract.

2. Search strategy

2.1 Having determined the subject of the invention as outlined in IV, 1.1, it may be desirable for the examiner to prepare first a written 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 Chapter VIII), and lack of unity (see VII, 1) should be borne in mind. The examiner may also have to restrict the subject of the search because of obscurities (see VIII, 5); but he should not do this if it can be avoided and he should subsequently adjust his search if such obscurities are cleared away during the search. ~~Any restrictions of the search on these grounds should be called to the attention of the applicant in a separate communication additional to (or taking the place of) the search report.~~

2.2 Next the examiner should select the units of the classification (or other sections of the documentation) to be consulted for the search, both in all directly relevant fields and in analogous fields. ~~The selection of classification units in related fields should be limited to:~~

CHAPTER IV

- ~~(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.

2.3 Often various search strategies are possible, and the examiner should exercise his judgment based on his experience and knowledge of the search files, to select the search strategy most appropriate to the case in hand, and establish the order in which various classification units are to be consulted accordingly. He should give precedence to the units in which the probability of finding documents is highest. Usually the main technical field of the application will be given precedence, starting with the classification units most relevant to the specific example(s) of the claimed invention.

2.4 The examiner should then carry out the search, directing his attention primarily to novelty, but also at the same time paying attention to any prior art likely to have a bearing on inventive step. He should also note any documents that may be of importance for other reasons, such as ~~conflicting applications (see V, 4)~~, or documents putting doubt upon the validity of any priority claimed, contributing to a better or more correct understanding of the claimed invention, or illustrating the technological background; but he should not spend 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.

2.5 The examiner should concentrate his search efforts on the classification units in which the probability of finding highly relevant documents is greatest, and in considering whether to extend the search to other areas. He should always take account of the search results already obtained.

CHAPTER IV

2.6 The examiner should continuously evaluate the results of his search, and if necessary reformulate the subjects of the search accordingly. 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 judgment, taking into account results obtained, in deciding at any time during or after the systematic search, whether he should approach the search documentation in some different manner, e.g. by consulting documents cited in the description of documents produced by the search or in a list of references of such documents, or whether he should turn to documentation outside that which is available ~~to the Search Divisions~~ in the search files.

2.7 If no documents of a more relevant nature for assessing novelty and inventive step are available, the examiner should consider citing any documents relevant to the "technological background" of the invention (see III, 3.14), which he may have noted during the search. Generally speaking no special search effort will be undertaken for this purpose; however, the examiner may exercise his discretion here in special cases. In exceptional cases a search may be completed without any relevant document having been found.

2.8 Reasons of economy dictate that the search examiner uses his judgment 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 or inventive step 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. ~~The search for conflicting applications should, however, always be completed to the extent that these are present in the search files.~~

CHAPTER IV

3. Procedure after searching

3.1 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, PCT Rule 43.5(c)). 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 search examiner should ~~cite rather more readily~~ in order to give make citations the ~~Examining Division~~ the opportunity to designated Offices consider the matter more fully.

3.2 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. Where more than one member of the same patent family is present in a search file, the search need not discover all of them nor need the search report cite all of them. 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. ~~(This is in accordance with a decision taken by IC/PCT/TCO at its November 1974 meeting. Further details still to be elaborated).~~

3.3 Finally the examiner should prepare the search report, ~~and where necessary, the internal search note.~~ (see Chapter X).

3.4 It may happen occasionally, that after completion of a search report, the ~~Search Division~~ discovers further relevant International Searching Authority documents (e.g. in a later search for a related application). These should be added to the search report up to the time that preparations for its publication are completed. Thereafter, such later discovered documents should be brought to the notice of the ~~Examining Division~~ by designated Office means of an internal communication ~~(compare III, 4.2).~~ via the International Bureau

THE STATE OF THE ART

1. Prior art generally

~~Art. 54(1)~~ 1.1 ~~An invention shall be considered to be new if it does not form part of the state of the art~~ (PCT Art. 33, paragraph 2). A claimed novel

1.2 ~~The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application~~ (PCT Rule 33.1(a) and (b)). prior art as defined in the Regulations

~~Art. 54(2)~~ 1.3 It is to be noted that there is no restriction whatever with respect to the geographical place where, or the language or manner in which, the relevant information was made available to the public; also no age limit is stipulated with respect to documents containing this information. international

2. Novelty

2.1 In considering novelty, the documents constituting the state of the art should be considered separately; consequently it is not permissible to combine or mosaic separate documents together.

2.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document when considered in the light of common general knowledge, including any features implicit to a person skilled in the art in what is explicitly contained in the document, e.g. a disclosure of the use of rubber takes away the novelty of the use of an elastic material.

2.3 A prior document should be construed only in the light of knowledge available at the time the document was published, and excluding any knowledge subsequently discovered.

2.4 In considering novelty it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of any generic claim embracing that disclosure. ~~The subject of novelty is more fully considered in Chapter IV, Section 7, of the Guidelines for substantive examination.~~

CHAPTER V

3. Prior art, - oral disclosure etc.

3.1 The PCT according to its Rule 33.1(a) and (b) recognises oral disclosure, use, exhibition, etc., as prior art only when this is substantiated by a written disclosure, which may have been published after the filing date of the application under consideration. ~~Although the EPC does not contain a similar provision, the same practice should be followed for the European search. The cases in which the search examiner knows of an oral disclosure, etc., without a written confirmation will be very rare, and in those cases he could mention the earlier oral disclosure only in the internal search note.~~

4. Prior art, - conflicting applications

Art. 54(3),
Art. 56

~~4.1 Additionally, but only for the purpose of determining novelty, the state of the art is considered to comprise the content of European applications as filed, of which the dates of filing are prior to the filing date of the application under consideration, and which were published as European applications on or after that date (herein referred to as conflicting applications). This provision will, however, only be applied in so far as a Contracting State designated in the latter application was also designated in respect of the earlier application as published (PCT Rule 33.1(c)).~~

Art. 54(4)

Art. 153(1)
Art. 158(1)

4.2 The prior art also includes as conflicting applications international (PCT) applications whose dates fall within the "intervention period", designating, for the purpose of obtaining a European patent, a European State which is a contracting party to both the PCT and the EPC systems, and which is also designated in the European application under consideration.

4.3 Since the Search Division will not verify the justification of the claimed priority dates, there may be uncertainty as regards which of the two applications is the earlier one. Therefore the search for conflicting applications should be extended so as to cover all published applications filed up to one year after the filing date of the application under consideration.

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Art. 54(3)

Art. 85

~~4.4 For published conflicting applications the "whole contents" approach is to be applied, i.e. conflict is constituted not merely by the contents of the claims, but by the whole disclosure, i.e. description, drawings (if any) and claims (but not the abstract) of the published earlier application; however, subject-matter disclaimed or stated to belong to the prior art is excluded, unless it is explicitly disclosed (see Guidelines for substantive examination, Chapter IV, 6.1).~~

4.5 Generally it will not be possible at the time of the search to make a complete search for conflicting European and international applications. This search will therefore have to be completed at the examination stage by the Examining Division which for this purpose will have available classified search files of these published applications. The Search Divisions should therefore not attempt to discover as yet unpublished conflicting applications, nor to undertake special documentation efforts to allow a search therefor; however, when the search examiner knows of such an application, he should mention it in the internal note, but he must not cite it in the search report.

~~Art. 33(2)~~

~~4.6 There may also be national applications of one or more States designated in the European application and coming within the "intervention period". Any of these which are present in the search files should be noted and mentioned in the search report for information (PCT Rule 33.1(c)).~~

5. Date of reference; filing and priority date

5.1 Since the ~~Search Division~~ is not responsible for the verification of any claimed priority date (which in the examination stage takes the place of the filing date for assessing prior art and determining precedence), the basic reference date for the search must be taken as the date of filing of the ~~European~~ international application as accorded by the Receiving ~~Section (similarly PCT Rule 33.1(a)) for the reference date for the search with respect to conflicting applications, however, see V, 4.3).~~

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Art. 80, 90

Art. 54(2)

CHAPTER V

5.2 The ~~Search Division~~ will therefore include documents published between the priority date or dates and the filing date of the application under consideration, and these must be identified as such in the search report. For identifying these documents when an application has more than one priority date, the oldest date is to be applied for this purpose. When deciding which documents to select for citing in the search report, the examiner will have to refer to these dates and should preferably choose any published before the date of priority. Thus for example, where there are two equally relevant documents one published before the date of priority and the other after that date but before the date of filing, he should choose the former (see IV, 3.2).

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5.3 It is the responsibility of the ~~Examining Division~~ designated Office to check whether and to what extent the priority claim is justified; therefore the ~~Search Division~~ will not check whether the contents of the ~~European~~ application correspond to those of the priority application(s). Nevertheless, documents showing that a priority claim might not be justified (e.g. an earlier application or patent resulting therefrom, by the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned), should be drawn to the attention of the ~~Examining Division~~. No special search beyond the filing date of the application 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; also sometimes the country of residence of the applicant being different from the country of the priority application may be an indication of possible lack of first filing, justifying a certain extension of the search.

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~~5.4 When the search is extended for this purpose, it should cover the published applications filed up to one year after the filing date of the application under consideration, for the reasons given in V,~~

~~4.3.~~

~~5.5~~ The search will not normally take
 5.4 into consideration documents published
 after the filing date of the application.
 However, some extension may be necessary
 for specific purposes, as is apparent from
 V, 3, ~~V, 4~~ and V, ~~5, 3~~

4.3.

5.5 ~~5.6~~ 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. 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.

~~Art. 55~~

~~5.7 Disclosures of the invention~~
 occurring no earlier than six months
 preceding the filing of the European patent
 application and due to an evident abuse in
 relation to the applicant or his legal
 predecessor, or due to display at an
 officially recognised international
 exhibition, should not be taken into
 consideration in determining novelty. 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 this case too the
 reference date for the search will be the
 filing date of the application (see V,
 5.1). Since the matter of abuse will
 generally only be raised after the
 transmission of the search report, and the
 disclosure at an exhibition involves the
 question of identity between the displayed
 and claimed invention, both matters are
~~better resolved by the Examining Division.~~

~~Rule 23~~

6. Contents of prior art disclosure

6.1 As a general rule the ~~Search Division~~
 will select for citation only documents
 which are present in its search files or
 which it has access to in some other
 manner; in that way no doubt will exist
 about the contents of the documents cited,
 since the search examiner will generally
 have physically inspected each document
 cited.

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CHAPTER V

6.2 However, 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 contents with another document which the examiner has inspected. _____ and cited

For example, instead of the document published before the filing date in an inconvenient language and selected for citation, the search examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in a more convenient language and possibly published after the filing date; also the ~~Search Division~~ International Searching Authority may assume that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Also the examiner should assume that the contents of a report of an oral presentation are in agreement with that presentation ~~(any comments or explanations should be in the internal search note).~~

6.3 Before citing documents in a language with which he is not familiar, the search examiner should satisfy himself 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).

7. Matters of doubt in the state of the art

7.1 Since decisions with respect to novelty are not the responsibility of the ~~Search Divisions~~ but of the ~~Examining Divisions~~, the ~~Search Divisions~~ International Searching Authority designated Offices International Searching Authorities 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~~ International Searching Authority should try to remove whatever doubt may exist and should ~~not~~ cite the documents concerned in the report unless the doubt is removed or very little doubt remains; additional documents providing evidence in the matters of doubt may be cited. Comments on these documents, as well as citation of documents for which greater doubt remains, should be made in the ~~internal search note~~ _____ report citation page

CHAPTER VI

INVENTIVE STEP

1. ~~An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.~~ (PCT Art. 33(4), 3 at the pre-scribed relevant date).
~~Rule 33.1(a).~~
2. In evaluating inventive step the Examining designated Office ~~Divisions~~ will have to consider this in relation to all aspects of the claimed invention, such as the underlying problem (whether explicitly stated in the application or implied), the insight upon which the solution relies, the means constituting the solution, and the effect or results obtained. Therefore, the search will take all these aspects into consideration.

~~Art. 56~~

~~3. European applications of earlier filing date but published on or after the date of filing of the application under consideration are not to be considered when assessing inventive step (but only when assessing novelty).~~

Art. 54(3),
~~Art. 56~~

~~(Further sections explaining the concept of inventive step in greater detail to the extent that this is useful for the purpose of searching, will be extracted from the Guidelines for Substantive Examination that are under preparation by Working Party III, in consultation with that Working Party).~~

CHAPTER VII

UNITY OF INVENTION

1. ~~The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept~~ (PCT Rule 13.1). international
If the Search Division considers that the application does not comply with the requirement of unity of invention, it must International Searching Authority search, and draw up the search report for, those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims (PCT Art. 17(3)(a)). and those parts of the application which relate to inventions for which additional fees have been paid

~~Art. 82~~

~~Rule 46(1)~~

.../...

CHAPTER VII

2. ~~The Search Division will inform the applicant of the lack of unity of invention in a communication separate from the search report. The other invention(s) or group(s) of inventions will be searched and separate search reports therefor will be prepared, only if the applicant pays the additional fees. These payments must take place within a period to be set by the Search Division, which may not be less than two weeks and may not be more than six weeks.~~ International Searching Authority

~~Rule 46(1)~~

(PCT Art. 17(3)(a) and Rule 40.3)

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3. ~~At the examination stage~~ The applicant may protest ~~contest~~ the allegation of non-unity and request a refund of the additional fee(s) paid. If the ~~Examination Division~~ finds the protest justified the fee(s) will be refunded. (compare PCT Rule 40.2(c)). or that the amount of the additional fee is excessive International Searching Authority

~~Rule 46(2)~~

4. From the preceding paragraph it is clear that the decision with respect to unity of invention rests with the ~~Examining Division~~. 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 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 classification units. International Searching Authority

5. As indicated in VII, 1 the basic criterion for unity of invention is the presence of a common inventive concept. Consequently, the mere fact that an application contains several independent claims of the same category or claims of different categories is in itself no ground for objection of lack of unity of invention. related under Rules 13.2 and 13.3

~~Rule 29(2)~~

6. ~~Rule 30~~ particularly specifies certain combinations of different categories that should not be objected to on the grounds of lack of unity: 13

~~Rule 30~~

- ~~(a) in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product; or~~
- (b) in addition to an independent claim for a process, an independent claim for an apparatus or means specifically designed for carrying out the process; or
- (c) in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for an apparatus or means specifically designed for carrying out the process."

(similarly PCT Rule 13.2). Other combinations may be acceptable provided there is a common inventive concept.

(Further guidance with respect to the application of the criteria for unity of invention in specific situations will be extracted from the Guidelines for Substantive Examination under preparation by Working Party III, in consultation with that Working Party).

7. Lack of unity of invention may also exist within a single claim where the claim contains alternatives which are not linked by a single general inventive concept, and the objection should be raised.

as to lack of unity

8. Objection of lack of unity does not normally arise because a claim contains a number of individual features in combination even if these are unrelated (see III, 3.10).
~~Likewise no objection of lack of unity should be made with respect to a dependent claim and the claim from which it depends (see III, 3.8 and 3.9).~~

9. Lack of unity of invention may be directly evident "a priori", i.e. before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking the prior art into consideration, e.g. a document discovered in the search shows that there is lack of

CHAPTER VII

novelty ~~or inventive step~~ in a main claim, leaving two or more dependent claims without a common inventive concept. In ~~the latter case the Search Division~~ may raise the objection of lack of unity and ~~restrict~~ the search to the invention (or group of inventions) first mentioned in these dependent claims, ~~disregarding "trivial" claims as in III, 3.9.~~

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limit

if no additional search fee is paid

10. Where the search examiner finds a situation of lack of unity of invention to exist, reasons of economy may make it advisable to search the additional invention(s) together with the invention mentioned first in the claims, in the classification units consulted for the latter invention if this takes little or no additional search effort. ~~If objection of lack of unity is raised, the results of the search for the additional invention(s) may not be made part of the search report, but must be kept for a later additional search report if this is requested and once the additional fees are paid.~~ The search for such additional invention(s) will then have to be completed in any further classification units which may be relevant.

11. Occasionally in cases of lack of unity, especially "a posteriori", the examiner will be able to make a complete search for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. In those cases, the search for the additional invention(s) should be completed together with that for the invention first mentioned. All results should then be included in a single search report, and no objection of lack of unity should ordinarily be raised.

CHAPTER VIII

~~12. When in a supplementary European search~~
 Art. 157(2)(a) following an international (PCT) search a problem of unity of invention arises, the Search Division should avoid whenever possible deviations from the position taken by the International Search Authority in the international search report, except where the claims have been changed, or the interpretation of the rules regarding unity of invention was clearly incorrect. It should be borne in mind that in case of conflict, e.g. because certain differences in the provisions relating to claims of different categories in EPC Rule 30 and PCT Rule 13(2), the provisions of the PCT prevail. When as a result of the supplementary search lack of unity "a posteriori" is found to exist, the Search Divisions should act accordingly (see par. VII 9).

Art. 150(2)

CHAPTER VIIISUBJECTS TO BE EXCLUDED FROM THE SEARCH

1. ~~Article 52 specifies certain subjects which are not to be regarded as patentable inventions, whilst Article 53 specifically excludes certain matter from patentability (PCT Art. 17(2)(a)(i), Rule 39.1).~~ Rule 39. need not be searched. The search files need not, and in general do not, contain many situations such subject-matter, so that a meaningful search therefor is not possible and a declaration to that effect takes the place of the search report (PCT Art. 17(2)(a)).
- Art. 52(2) to (4) 53(b)
- ~~(Rule 45)~~
2. This situation may also occur for part of the claims, in which case a partial search is made, and the partial search report is then supplemented with a declaration.
- ~~3. Although a decision on these matters rests with the Examining Division, nevertheless, provisional opinions on these matters must be sometimes formed by the Search Division, which will thus have to consider the requirements for patentability other than novelty and inventive step. In particular it may be necessary to consider any of the following questions:~~
- Art. 52(1)

Art. 52(2)

(1) whether a claimed invention belongs to the categories excluded from being regarded as patentable inventions in Article 52, paragraph 2, i.e.

"(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information";

or

Art. 52(4)

(ii) whether the invention is susceptible of industrial application having regard to Article 52, paragraph 4, i.e. whether it is a method for treatment of the human or animal body by surgery or therapy, or a diagnostic method practised on the human or animal body. It should be noted, however, that products, in particular substances or compositions, for use in any of these methods, are not excluded from patentability, provided the use of the product for any such method is not comprised in the state of the art; consequently after the search has discovered one such use, no further search is necessary to establish whether the exact use claimed is novel;

or

Art. 54(5)

(iii) whether the subject-matter is excepted from patentability having regard to Article 53, sub-paragraph (b), i.e.

Art. 53(b)

"plant or animal varieties or essentially biological processes for the production of plants or animals" (note however that this exception does not apply to micro-biological processes or the products thereof) (PCT Rule 39.1).

~~Rule 45~~

3 ⁴ In cases of doubt the ~~Search Division~~ should carry out the search to the extent that this is possible in the available documentation.

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4 ⁵ A further situation where a meaningful search is not possible or only partially possible, and where a declaration to this effect may take the place of or supplement the search report, may result from the application containing obscurities, inconsistencies or contradictions to the extent that it is impossible to arrive at a reasonable conclusion as to the scope of the claimed invention. The ~~Search Division~~ in these cases may not suspend the search, ask for clarification, and after receipt thereof continue the search, but should make a meaningful search to the extent that this is possible. ~~When later clarifications are received, these will be considered by the Examining Division (which then may request the Search Division to perform an additional search, see III, 4.2).~~

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PCT Art. 17(2) (a)(ii).

CHAPTER IX. - SEARCH DOCUMENTATION)

) to be included
) later

(Cite Rules 34 and 36)

CHAPTER X. - SEARCH REPORT)

CHAPTER X - Y

Effect of Search Report

Y.1 After receipt of the search report the applicant may amend the ~~description, the drawings and (in particular) the claims~~ (similarly PCT Art. 19 (1)).

~~Rule 86(2)~~

before the International Bureau

~~Also if the request for examination was made before the issue of the search report, the applicant will be invited to confirm the request.~~

~~Art. 96(1)~~

~~Y.2 After publication of the application and the search report third parties may file observations which will be taken into consideration by the Examining Division at the examination stage.~~

Art. 115

Art. 95

The amendments can not go beyond the disclosure of the international application as filed.

~~1.3 After publication of the search report and filing (or confirmation) of a request for examination, the Examining Division will examine the application, basing its assessment of novelty and inventive step upon the prior art mentioned in the search report. This is dealt with in the Guidelines for Substantive Examination (PCT Art. 33(6), Rule 44(1) Rule 62.1(b))~~

Art. 96(2)
Rule 44(1)

CHAPTER XI

THE ABSTRACT

~~Rule 47~~

~~Rule 49~~

Art. 85
Rule 33(5)

1. The search examiner has the task of determining the definitive content of the abstract which is initially supplied by the applicant, and which will subsequently be published with the application or later. In doing this he should consider the abstract in relation to the application as filed (see IV, 1.4) (PCT Rule 38.2(b); ~~Rule 48.2(b)(iii)~~).

2. 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 (PCT Rule 8.3).

assisting the scientist, engineer or researcher in international

3. The abstract must

~~Rule 33(1)~~

Rule 33(2)

- ~~i. indicate the title of the invention,~~
- ii. indicate the technical field to which the invention pertains,
- 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 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,

meet the requirements of Rule 8.

CHAPTER XI

- ~~iv. not contain statements on the alleged merits or value of the invention or its speculative application,~~
- Rule 33(2)
- v. preferably not contain more than one hundred and fifty words,
- Rule 33(3)
- vi. be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany the abstract. Each main feature mentioned in the abstract and illustrated by a drawing, should be followed by a reference sign in parenthesis (PCT Rule 8.1).
- Rule 33(4)

~~Rule 33(4)~~

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 may select a different figure, or figures, of the drawings if he considers that they better characterise the invention, (PCT Rule 8.2). In determining the definitive 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.

Rule 8

and note it in the search report

[End of Document]