

the invitation will be withdrawn ('unless' in R.62a(2)) and a new search made.

If the applicant does not convince the examiner and he does not restrict the claims as requested, the application may be refused under Art.97(2).

Subject-matter covered by claims not searched on account of R.62a(1) may not be used for amending claims (R.137(5)). Protection for such subject-matter can only be obtained by filing a divisional application.

R. 63 Incomplete search

Amended by decision of the Administrative Council of 25.03.2009 and entering into force on 01.04.2010. Amended R.63 applies to applications for which the search report or the supplementary search report is drawn up on or after 01.04.2010. (OJ2009, 299)

The provision for applications where the search report is drawn up before 01.04.2010 has been set out in the notes below.

Implementation of Art.84 and Art.92

EPC 1973: R.45

1 Transitional provision

For applications for which the search report or the supplementary search report is drawn up before 01.04.2010 R.63 as valid before 01.04.2010 continues to be valid:

R.63 If the European Patent Office considers that the European patent application does not comply with this Convention to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed, it shall either issue a reasoned declaration to that effect or, as far as is practicable, draw up a partial search report. The declaration or the partial report shall be considered, for the purposes of subsequent proceedings, as the European search report.

Under the previous law the EPO determines whether it draws up a partial search report or no search report without consulting the applicant. During the following substantive examination the applicant can clarify the invention and the EPO may carry out an additional search. Unsearched subject-matter can still be used for amending the claims.

The new law requires in the case of unsearchable subject-matter that the EPO invite the applicant during the search stage to indicate the subject-matter to be searched; additional searches during the substantive examination will be exceptions. Unsearched subject-matter may not be used anymore for amending the claims. The grounds for drawing up a partial search report or no search report have not changed.

The purpose of the amendment of R.63 is to induce applicants to comply with the clarity requirement of Art.84 already at the search stage and to avoid additional searches during the substantive examination.

2 Unsearchable subject-matter

R.63 provides an exception to the EPO's obligation to carry out a search for each application. The EPO will not search claims that are not properly drafted or relate to unpatentable subject-matter. In such cases it will invite the applicant to indicate the subject-matter to be searched. If the applicant does not respond or the indicated subject-matter does not overcome the deficiency, the EPO will issue a partial search report or a declaration that no search could be carried out. Unsearched subject-matter cannot be used anymore for amending the claims.

R. 63(1) If the European Patent Office considers that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched.

1 Reasons for incomplete search

According to R.63 the search division will not search applications or parts thereof that do not comply with the requirements of the EPC to such an extent that no meaningful search can be made. Important requirements are that the subject-matter must have technical character (Art.52(2)), not be excluded from patentability (Art.53) and be sufficiently clear and complete (Art.83), and that the claims are clear, concise and supported by the description, and are susceptible of industrial application (Art.57). Non-compliance may also occur for only some of the claims or for part of a claim (B-VIII,1). The above considerations are similar to those set out in R.39.1 PCT, which are regarded as applicable to searches under the EPC (B-VIII,1).

The Search Division determines what is or is not ‘meaningful’ as a question of fact (B-VIII,3). According to the Guidelines a search would not be ‘meaningful’ and need not be carried out if it would not serve any useful purpose, for example for any possible future prosecution of the application (B-VIII,3; see also OJ 2000, 228 section B-VIII,4-6). However, T1242/04 objected to this interpretation and held that R.63 relates only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination (see hn.I, r.8.5).

R.63 constitutes an exception to the EPO’s obligation to carry out a search as an essential element of the grant procedure and as such must be interpreted narrowly (T1242/04 r.8.2). Hence, a declaration under R.63 may be issued only in exceptional cases in which the claimed subject-matter, i.e. the entire set of claims including all independent and dependent claims, clearly has no technical character (T1242/04 hn.II).

The deficiency may relate to an entire set of claims, some of the claims or part of a claim (B-VIII,1).

1.1 SUBJECT-MATTER LACKING TECHNICAL CHARACTER UNDER ART.52(2) AND (3)

The search division will not search subject-matter excluded from patentability because the subject-matter lacks technical character (Art.52(2), (3)).

Hence, a claim merely relating to no more than a method of doing business will not be searched. A declaration under R.63 to this effect will take the place of the search report. Where the claimed subject matter involves technical means, a search report or partial search report will be issued. When the technical means are so conventional that they were widely available to everyone at the date of filing and no documentary evidence is considered required because of their notoriety, the search report will state so and will not cite a document. (Not. EPO, OJ 2007, 592)

1.2 SUBJECT-MATTER EXCLUDED FROM PATENTABILITY UNDER ART.53

The EPO will not search subject-matter excluded from patentability because its commercial exploitation contravenes morality (Art.53(a)), it relates to a plant or animal variety or a biological method for the production of plants or animals (Art.53(b)), or it relates to a method for medical treatment or diagnosis (Art.53(c)).

A claim relating to a medical method should be searched in the case that the determining technical feature is the effect of a substance, which can be searched (B-VIII,2).

1.3 SUBJECT-MATTER NOT COMPLYING WITH ART.83 AND 84

Important requirements are those for sufficiency of disclosure (Art.83), clarity and conciseness of the claims and support by the description (Art.84) (see also OJ 2000, 228). Non-compliance with Art.83 and 84 often occurs as a direct result of the applicant's drafting style. The following four examples clarify the problems posed by this non-compliance.

A broad claim supported by a limited disclosure covering a small part of the scope of the claim may lack support and sufficient disclosure. Such a claim may be searched only on the basis of the narrower, disclosed invention or even disclosed examples (B-III,3.6; B-VIII,3(i)). The searcher may base his search on what he considers to be the extent to which the claims are defensible in a subsequent substantive examination.

A large number of claims or possibilities within a claim is not concise. The large number may make it burdensome to determine the subject-matter for which protection is sought and make a complete search de facto impossible or useless in view of the indefensibility of the claims or claim (B-VIII,3(ii); see example T1873/06). See also R.62a for a restriction on the number of independent claims.

A claim defined in terms of desiderata may violate Art.83 and/or Art.84, leading to an incomplete search (OJ 2000, 228).

The definition of a claim in terms of a particular parameter may make a meaningful search impossible, e.g. because the prior art does not use the parameter; in such a case a partial search may be made for the disclosed examples or the way in which the parameter is obtained (B-VIII,3(iii)).

2 **Statement indicating subject-matter to be searched**

If the search division is of the opinion that a normal search cannot be carried out, it will invite the applicant to file a statement more clearly defining the subject-matter to be searched (R.63(1)). This statement, to be submitted before the search, should improve the quality of the search. The statement may (see CA/29/09e §12):

- indicate that part of the description, e.g. a specific embodiment, which can be used for interpreting the claims, or
- consist of an improved claims wording which would become a formal amendment to overcome the deficiency in the response to the extended European search report.

Any improvement of the claims during the substantive examination to make them searchable will very likely introduce unsearched subject-matter and will not be admissible under R.137(5). Hence, the statement filed before the search will probably limit the scope of the claims, without a possibility to enlarge the scope later-on during the substantive examination.

Any further interaction with the search examiner after filing the amendment is not provided for in the EPC and Guidelines.

R. 63(2) If the statement under paragraph 1 is not filed in due time, or if it is not sufficient to overcome the deficiency noted under paragraph 1, the European Patent Office shall either issue a reasoned declaration stating that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed or, as far as is practicable, draw up a partial search report. The reasoned declaration or the partial search report shall be considered, for the purposes of subsequent proceedings, as the European search report.

1 Procedure before search division

The applicant must file the statement indicating the subject-matter to be searched within two months from invitation (R.63(1)). Further processing is not possible according to R.135(2), to allow publication of the search report together with the application; however, re-establishment is available.

If the statement is not filed within two months from invitation or if it is not sufficient to overcome the deficiencies, the EPO will issue either a declaration that no meaningful search could be carried out or a partial search report covering only some of the subject-matter claimed. A statement may be insufficient if it refers to subject-matter without basis in the application as filed.

The declaration must be reasoned according to R.63(2), second sentence, i.e. the search division must state why it regards the claims as not searchable. The partial search report must also give the reasons for restricting the search (B-X,8(iii)). The applicant cannot contest the opinion of the search division at the search stage; however, he may argue the reasoning of the search division during the substantive examination (see R.63(3)).

If a document cited in the application appears to be essential for the search and the document is not available at the EPO, the search division will ask the applicant to file a copy of it. If the applicant fails to comply, a partial search may result or a declaration that no meaningful search could be made. (B-IV,1.3)

2 Additional searches

The search division can make an additional search report on request of the examining division because of amendments of claims (but see R.137(5)), clarification of obscurities (R.63), reversal of the provisional opinion of the search division on unity (R.64) or exclusion from patentability, or imperfections in the initial search. (B-III,3, see also B-II, 4.2 and C-VI, 8.2)

It is expected that these sections of the Guidelines will be amended in view of the amendment of R.63.

Where a R.63 declaration has been issued, it is not always necessary to carry out an additional search. An objection of lack of inventive step may be raised without documented prior art, e.g. if the claimed subject-matter is obvious from the common general knowledge. However, if the claim features do not form part of the common general knowledge and the applicant does not acknowledge them to be known, an additional search must be carried out. (T1242/04 r.9.2)

R. 63(3) When a partial search report has been drawn up, the Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified.

1 Procedure before examining division

If the search division has issued a partial search report, the examining division will invite the applicant to restrict the claims to the subject-matter searched (R.63(3)), because according to G2/92 r.2 the EPO will only examine searched subject-matter. The applicant may in response contest the restricted search. If the argument convinces the examiner, no restriction of the claims is necessary (R.63(3)) and an additional search may be carried out (B-VIII,3 last paragraph; C-VI,8.2).

If the applicant does not convince the examiner and he does not restrict the claims as requested, the application will not meet the requirements of the EPC and may be refused under Art. 97(2).

Since R.137(5) does not allow amended claims to relate to subject-matter not searched in accordance with R.63, protection for such subject-matter can only be pursued in a divisional application.

If a declaration has been issued and the applicant cannot convince the examiner, his application will not contain any searched subject-matter. In that case R.63(3) implies that he cannot maintain any claims and that the application has to be refused. The only possibility to continue appears to be the filing of a divisional application. This fate of the application for which a declaration has been issued has not yet been confirmed by the EPO.

R. 64 European search report where the invention lacks unity

Implementation of Art.82 and Art.92
EPC 1973: R.46

R. 64(1) If the European Patent Office considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial search report on those parts of the application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that, for the European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period of two months. The European search report shall be drawn up for the parts of the application relating to inventions in respect of which search fees have been paid.

Amended by decision of the Administrative Council of 25.03.2009 and entering into force on 01.04.2010 (OJ2009, 299).

Art.82 Unity of invention

1 Transitional provision

R.64(1) as valid before 01.04.2010 gave the applicant a period 'to be specified, which shall neither be shorter than two weeks nor exceed six weeks' for responding to the non-unity invitation. Extension under R.132(2) of an office period for which the EPC specifies an upper limit, such as the period of two to six weeks of R.64(1) for payment of further search fees, is possible, but the period after extension may not exceed the upper limit.

The amendment changes the period to two months, the same duration as the periods in R.62a(1) and 63(1). Amended R.64 will probably apply to invitations despatched on or after 01.04.2010.