How to Interpret EPO Search Reports
Acknowledgement Kris Loveniers
Purpose of this presentation

- view what **types** of European Search Reports (SR) exist
- see what kind of **information** can be retrieved from a SR
- view how to **quickly** retrieve the useful information
- understand how this information can be **useful** for your searches
- apply this knowledge in an **interactive workshop** to practical examples
Outline

1. Introduction

2. Where to find the European SR?

3. The different types of search reports (SR) drawn up by the EPO

4. The information to be found in SR

5. Practical examples

6. Conclusions
Why is a SR useful?

**BoA:**
The search is an essential element of the grant procedure, being designed to identify prior art relevant to the application. The intention is to make it possible to determine, on the basis of the documents mentioned in the search report, whether and to what extent the invention is patentable (...).

It is also important for applicants, giving them a basis for deciding whether to continue prosecuting their applications and have them examined.

Lastly, it is also important for the public and especially for competitors, enabling them to gain an idea of the scope of any protection that might be granted.
Why is a SR useful?

- **novelty search:**
  - suppose before filing you find an interesting application
  - how to get a quick overview of similar applications
  - adjust claims before filing

- **FTO search:**
  - suppose you find a relevant application before product release
  - how to get a quick overview of existing similar patents
  - avoid infringement costs

- **invalidity search:**
  - suppose you find an interesting application in case of injunction
  - how to get a quick overview for possibly even more relevant docs
Does the EPO always issue a SR?

Yes!

**Article 92 EPC**
The European Patent Office shall, in accordance with the Implementing Regulations, draw up and publish a European search report in respect of the European patent application on the basis of the claims, with due regard to the description and any drawings.
Does an EPO SR always mention prior art?

No ...

Exceptional declaration of "No Search", Rule 63 EPC (see further)
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Where to find the European Search Report?

As an Annex to the **A1 publication** of the patent application
Where to find the European Search Report?

In the A3 publication of the patent application
Where to find the European Search Report?

As the **A4 publication** in case of a supplementary SR (see further)

![Supplementary Partial European Search Report](image)
Where to find the European Search Report?

Not:

- in the **A2 publication** of the patent application
  - = European patent application published **without** European SR (SR not available at the publication date)

- in the **B publication**
  - = publication of the **granted** patent specification

(see also [http://www.epo.org/searching/essentials/definitions.html](http://www.epo.org/searching/essentials/definitions.html))
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The different types of EPO SRs

1. European Search Reports

2. International search reports under the PCT

3. Supplementary European Search Reports

4. International-type search reports

5. Search reports drawn up on behalf of national offices
1. European Search Reports

Patent applications directly filed at the EPO
2. International search reports under the PCT

- Some patent applications are filed under the **Patent Cooperation Treaty (PCT)**
- Why?
  - world-wide unified filing procedure
  - lower fees and translation costs
  - possibility to delay as much as possible the national or regional procedures
- Only gives an opinion on the patentability, does not lead to a grant
- Published by WIPO
2. International search reports under the PCT

An Applicant can elect the EPO to perform the search for a PCT application.

WO 2(05/07502)

INTERNATIONAL SEARCH REPORT

A. CLASSIFICATION OF SUBJECT MATTER
IPC 7 A61N/00 A61B17/22 G10K15/04

Name and mailing address of the ISA
European Patent Office, P.B. 5818 Patentien 2
NL - 2280 HV Hilvijk
Tel. (+31-70) 340-2040, Fax: 31 6516 epo.nl

INTERNATIONAL SEARCH REPORT

1) 1999/07502 A (EGER, INC; TALISH, ROGER; J; ROSE, EMILY; KENG, M; WRIGHT, FR) 29 October 1998 (1998-10-29)
page 14, line 1 - page 16, line 2; figures 1, 6

column 4, line 37 - column 4, line 15;
figure 3, lines 35-47; figure 6

3) JP 4 621 350 A (RICHARD WOLF GmbH) 10 April 1999 (1999-04-10)
close in the application
the whole document

European Patent Office

18
3. Supplementary European Search Reports

An international (PCT) application

- that now goes into the regional, European phase but
- where the EPO did not do the search in the international phase
  (search done by e.g. USPTO, JPO, ... instead)

But the documents of the other search authority can be very relevant as well!!
4. International-type search reports

Under the PCT, the EPO may be entrusted to carry out "international-type searches" for national patent applications.

European Patent Office
5. Search reports drawn up on behalf of national offices

EPO can carry out searches on *national applications* for certain of its contracting states

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**Table:**

<table>
<thead>
<tr>
<th>Category</th>
<th>Citation of the document with indication, in case of need, of the parties concerned</th>
<th>Revendication concerned</th>
<th>Classification of the demand (IPC)</th>
</tr>
</thead>
<tbody>
<tr>
<td>X</td>
<td>WO 2004/066807 A (VARIAN MEDICAL SYSTEMS TECHNOLOGIES TNC)</td>
<td>1,2</td>
<td></td>
</tr>
</tbody>
</table>
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Content of the European SR

Rule 61 EPC

1. The European search report shall mention those documents, available to the European Patent Office at the time of drawing up the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.

2. Each citation shall be referred to the claims to which it relates. Where appropriate, relevant parts of the documents cited shall be identified.

3. The European search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing.
Content of the European SR

Rule 61 EPC
4. Any document which refers to an oral disclosure, a use or any other means of disclosure which took place before the date of filing of the European patent application shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.
5. The European search report shall be drawn up in the language of the proceedings.
6. The European search report shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.
The information to be found in SR

In other words:

- the (passages of) the most relevant documents
- the claims for which these documents are relevant
- the type of these documents (e.g. on time or too late)
- a classification of the subject-matter of the application
Relevant docs for specific claims

US 6 044 297 A (SHELDON TODD J [US] ET AL)
28 March 2000 (2000-03-28)
column 3, line 58 - column 5, line 61
column 3, line 33 - column 17, line 61
column 21, lines 1-43

paragraphs [0068] - [0083]; figures 5-6

1,3-10,
12-17,
43-58

1,3-9,
11,16-17
2
In an European SR, documents can be identified as:

- **X**: novelty (/ I.S.)
- **Y**: inventive step
- **A**: technological background
- **P**: intermediate doc
- **E**: published after filing date
- **D**: cited in the application
- **T**: underlying theory
- **O**: non-written disclosure
- **L**: other reasons
- **&**: corresponding doc

**Documents Considered to be Relevant**

<table>
<thead>
<tr>
<th>Category</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>X</td>
<td>Temporal integration of electrical stimulation of auditory nuclei in normal-hearing and hearing-impaired rat.</td>
</tr>
<tr>
<td>Y</td>
<td></td>
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<tr>
<td>A</td>
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<td>&amp;</td>
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</tbody>
</table>

**References**


*The whole document...*
"X" documents

Documents which are prejudicial to either
- the novelty (Art. 54 EPC), or
- inventive step (Art. 56 EPC) when considered in isolation
  (i.e. + common knowledge)

[Image of a document marked with 'X']

US 2004/092786 A1 (ZAIDER MARCO ET AL) 1,2
* alinéas [0013] - [0018] *
* alinéas [0092] - [0105] *
"Y" documents

Documents which when taken in combination with (an)other document(s) of the same category, deprive the claimed invention of an inventive step (Art. 56 EPC)

- **WO 90/02581 A (SIEMENS ELEMA AB [SE])**
  - 22 March 1990 (1990-03-22)
  - page 4, line 6 - page 5, line 16
  - page 8, line 33 - page 10, line 21; figure 3b
  - page 12, line 4 - page 15, line 14;
  - figures 4,6a

- **US 5 383 913 A (SCHIFF STEVEN M [US])**
  - column 8, lines 35-61; figure 7
"&" documents

Document member of the same family as other cited doc e.g. referring to an abstract of a cited document when the abstract alone is not enough; usually for less accessible languages.
"A" documents

- Documents giving the general state of the art and not considered prejudicial to the patentability of the claimed invention
- "D" documents: cited in the application

<table>
<thead>
<tr>
<th>A</th>
<th>Document</th>
<th>Date</th>
<th>Pages</th>
</tr>
</thead>
<tbody>
<tr>
<td>A</td>
<td>WO 95/03086 A (SIEMENS PACESETTER [US])</td>
<td>2 février 1995 (1995-02-02)</td>
<td>1-6</td>
</tr>
<tr>
<td>A</td>
<td>* page 3, ligne 18 - page 7, ligne 26 *</td>
<td></td>
<td></td>
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<tr>
<td>A</td>
<td>* page 11, ligne 13-29 *</td>
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<tr>
<td>A</td>
<td>* page 35, ligne 33 - page 38, ligne 25 *</td>
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<td>A</td>
<td>* page 3, ligne 1 - page 7, ligne 31 *</td>
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<td>A</td>
<td>* page 12, ligne 25-35 *</td>
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<tr>
<td>A</td>
<td>* page 16, ligne 3-25 *</td>
<td></td>
<td></td>
</tr>
<tr>
<td>A</td>
<td>* page 18, ligne 21 - page 21, ligne 11; revendications 30-36; figure 4 *</td>
<td></td>
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<tr>
<td>A</td>
<td>* page 2, ligne 22 - page 5, ligne 34 *</td>
<td></td>
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<tr>
<td>A</td>
<td>* page 19, ligne 3 - page 20, ligne 30 *</td>
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<tr>
<td>A</td>
<td>* colonne 2, ligne 57 - colonne 3, ligne 53 *</td>
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<tr>
<td>A</td>
<td>* abrégé *</td>
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</table>

Information in SR
"P" documents

- Documents published after the priority date but before the date of filing of the application

- Can become relevant e.g. if the claimed priority date proves not to be valid
"E" documents

Documents published after the filing date of the application but
- with filing or priority date prior to the filing date of application and
- containing novelty destroying subject-matter

Can become relevant for novelty (Art. 54(3) EPC)
"T" documents

T for theoretical background
- published too late but
- giving a good explanation of the underlying theory
- showing that reasoning in application is incorrect

<table>
<thead>
<tr>
<th>DOCUMENTS CONSIDERED TO BE RELEVANT</th>
</tr>
</thead>
<tbody>
<tr>
<td>Category</td>
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</table>

But, in the technical field of transmissions, it is a generally accepted understanding (cf. documents D1-D2) that "positive-fit continuously variable transmission" are not possible. Since the application does not disclose any details how the gear teeth have to be designed to provide a continuously variable transmission with cogwheels and simultaneously with a positive fit, a skilled person is not able to carry out such a transmission (Art. 83 EPC).
"O" documents

O for oral disclosure

- both date of oral disclosure and the date of publication of the written report should be mentioned.

**DOCUMENTS CONSIDERED TO BE RELEVANT**

<table>
<thead>
<tr>
<th>Category</th>
<th>Citation of document with indication, where appropriate, of relevant passages</th>
<th>Relevant to claim</th>
</tr>
</thead>
</table>

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"L" documents
cited for other reasons, e.g.

- for throwing doubts on a priority claim of the application being searched
- for establishing the publication date of other citations in the SR

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ANONYMOUS: "THUI TGA1200 SERIES" INTERNET ARTICLE
Retrieved from ti URL: http://www.ti df-brochure/gen-
Brochure with te: function generat
Thurlby Thandar: the whole documen
In particular the specifications relating
to models TGA12102 and TGA12104.

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"& 'Online! XP002361615 Retrieved from the Internet:
7/1.html>
Retrieved by web.archive.com with date of Feb 22, 2005. Shows that models TGA12102
and TGA12104 already were made public at February 2005 (see table, most left
column).
Classes

Classification of the Application
- **IPC** subgroup level (e.g. A61B5/1473)
- shows both *invention* information and *additional* information

Technical fields searched
- provides an indication of where the examiner has performed the search
- subclass level of the **IPC** (e.g. A61B)
- might be interesting e.g. for features of a dependent claim
Partial search reports

- Sometimes not all the claims are searched, e.g. in case of:
  - non-payment of claim fees
  - too many independent claims (Rule 62a EPC)
  - a meaningful search is not possible (Rule 63 EPC)
  - lacking unity of invention (Rule 64 EPC)

- Such search reports are called "partial SR".

- **What** is actually searched and **why** the rest is not searched, can be found in Sheet B and Sheet C.
"Sheet B"

- Unity of Invention requirement: you pay us to search 1 invention - when multiple inventions: "non unity"

- First a "partial SR" is sent to the applicant - invitation to pay for the other inventions - what is searched and why: see sheet B
"Sheet B"

- Unity of Invention requirement: you pay us to search 1 invention
  - when multiple inventions: "non unity"
- First a "partial SR" is sent to the applicant
  - + invitation to pay for the other inventions
  - what is searched and why: see sheet B
After (non)payment of additional fees the final SR is issued.
"Sheet C"

Incomplete search statement when e.g. therapy/surgery/diagnostic method claims
– what and why: see sheet C.
"Sheet C"

Incomplete search statement when e.g. therapy/surgery/diagnostic method claims – what and why: see sheet C.

Claim(s) not searched: 33-70

Reason for the limitation of the search (non-patentable invention(s)):

Article 52 (4) EPC - Method for treatment of the human or animal body by surgery

Article 52 (4) EPC - Method for treatment of the human or animal body by therapy
Incomplete search statement when e.g. too many independent claims – what and why: see sheet C.

Further limitation of the search

Claim(s) completely searchable:
1-15

Claim(s) not searched:
16-45, 57-72

Reason for the limitation of the search:

In reply to the invitation to indicate the claims on which the search is to be based, the applicant failed to supply the requested indication in due time.

In his letter of 15.11.2011 he indicated the first group of claims 1, 16, 23, 41, 61 and 66 to be searched. However, this indication cannot be followed because these are all independent apparatus claims which do not meet the requirements of Rule 43(2) EPC. Thus, the search report has been drawn up on the basis of the first independent apparatus claim (Rule 62a(1) EPC): claims 1-15.

The applicant's attention is drawn to the fact that the application will be further prosecuted on the basis of subject-matter for which a search has been carried out and that the claims should be limited to that subject-matter at a later stage of the proceedings (Rule 62a(2) EPC).
Incomplete search statement when e.g. meaningful search not possible – what and why: see sheet C.

Claim(s) searched completely:
4-17,21-34

Claim(s) searched incompletely:
1-3,18-20

Consequently, the search has been carried out for those parts of the claims which appear to be clear, supported and disclosed, namely those parts relating to an IMD with its electrochemical cell having a cathode consisting of two active materials, the materials being SVO and CFx.
No Search

In extreme cases, it is unfeasible to search anything → a declaration of NO SEARCH is issued.
Extended European SR

- For
  - EP files filed as of 01/07/2005 or
  - PCT files entering the European phase as of 01/07/2005
(supplementary) European SRs are accompanied by an opinion
(ESOP)
- The ESOP together with the SR is called the extended European
search report (EESR)
- The ESOP is consistent with the Search Report but states the
found deficiencies in normal *textual language* and can go more
into *detail*
- Not published together with the SR
- But it is public and can be found e.g. in the [European Patent Register](http://www.epo.org)
Extended European SR

Rule 62 EPC
1. The European search report shall be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of this Convention, unless a communication under Rule 71, paragraph 1 or 3, can be issued.

2. The opinion under paragraph 1 shall not be published together with the search report.
3 Article 56 EPC

Furthermore, notwithstanding the above-mentioned lack of clarity, the subject-matter of claims 1-3 does not involve an inventive step within the meaning of Article 56 EPC, and the requirements of Article 52(1) EPC are therefore not met.

Document D1 discloses a transcranial electrostimulation device (the device of D1 is suitable for transcranial electrostimulation as well, see also column 1, lines 61-66) whereby (see figure 3)

the pulse generator 1, the current stabilizer 13, the amplifier 5, the current measuring instrument 8 and electrodes 9, 10 are connected sequently;

the first output of the patient’s condition block 11 is connected to the generator, and the second output is connected to the first input of the current regulator 12;

the output of the current regulator 12 is connected to the second input of the amplifier 5.

Claim 1 differs from this device in that

the second input of the current regulator 12 is connected to an output of a memory block;
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Conclusions

- When familiar with a SR, it provides you a quick way of retrieving information about other possibly very relevant documents.

- The SR is published as A1, A3 or A4.

- Different codes (X, Y, A, ...) exist to indicate the relevance of the cited documents.

- A supplementary SR means that another search authority has performed the search in the PCT phase;
  – check also the international search report.

- A partial SR means that not everything is searched;
  – for what and why, see sheets B and C.