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Guidelines for the identification of publications under Sec. 43 of the Patent Law

(Search Guidelines)

of 2 September 2009

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1. Preliminary remark

These Search Guidelines aim at ensuring the uniform treatment of search requests under Sec. 43 Patent Law at the German Patent and Trade Mark Office (DPMA) with due regard to equal principles.

These Guidelines shall supersede the Guidelines of 31 March 1999 (*Blatt für Patent-, Muster- und Zeichenwesen* 1999, p. 201 et seq.).

2. Search request

The German Patent and Trade Mark Office shall, upon request, identify those publications to be taken into consideration in assessing the patentability of the invention in respect of which an application has been filed (Sec. 43(1) sentence 1, Patent Law).

The request may be filed by the applicant or by any other person. The request must be filed in writing. Any person who has neither a domicile, a seat nor an establishment in Germany may file an effective search request only if he appoints a patent attorney, an attorney-at-law or a permit holder, authorised under Sec. 160 of the law on patent attorneys (PAO) in conjunction with Sec. 178 of the law on patent attorneys (PatAnwO) (in the version in force until 31 August 2009), in Germany as his representative. (Sec. 43(2), sentence 3, Sec. 25 Patent Law). Reference is made to Sec. 25(2) Patent Law concerning

representatives who are nationals of a member state of the European Union or another contracting state of the Agreement on the European Economic Area. A fee as prescribed by the Patent Costs Law shall be paid together with the request; if the fee is not paid, the request shall be deemed withdrawn pursuant to Sec. 6(2) Patent Costs Law.

If the request is filed in connection with an application for a patent of addition, the applicant is invited to file the request also for the application of the main patent (Sec. 43(2), sentence 4, Patent Law). If in spite of the invitation of the German Patent and Trade Mark Office no request is filed, the application for the patent of addition shall be regarded as an application for an independent patent (Sec. 43(2), sentence 4, Patent Law). This also applies if the request in connection with the application of addition is filed by another person.

The request shall be deemed not to have been filed if a request for examination or search has already been filed (Sec. 43(4) and (5) Patent Law). The applicant shall be notified of the filing of the request by a person other than the applicant (Sec. 43(3), sentence 2, Patent Law); likewise, the applicant and the other person shall be notified if this request is subsequently found to be ineffective. (Sec. 43(6) Patent Law).

The search request presupposes a pending application. It may be submitted at the time of filing the application. If the search request under Sec. 43 of the Patent Law is filed before or at the same time as the examination request under Sec. 44 of the Patent Law, the publications to be considered for the assessment of patentability of the filed invention shall, at first, be ascertained and communicated to the applicant and, if applicable, to the other person. Then, the examination procedure shall begin (Sec. 44(3), sentence 1, Patent Law). The examining section shall deviate from this way of proceeding if there are clues that a separate search under Sec. 43 Patent Law is not desired.

* Official Gazette

3. Formal handling of the search request

The effectiveness of the search request received shall be examined. The competent section also takes action to have the communications sent to the applicant and, if the request has been filed by any other person, to the latter, and arranges for publication of the fact that a search request has been received in the Patent Gazette. However, the publication in the Patent Gazette shall not take place before the publication of the mention under Sec. 32(5) Patent Law (possibility of file inspection; Sec. 43(3), sentence 1, Patent Law). After statement of the effectiveness of the search request, the file is transmitted to the examining section competent for the main class which shall carry out the search.

After receipt of the file, the examining section checks whether it is competent for this case. If it considers itself not being competent, it takes immediate action to determine the examination section competent for the main class.

The examining section that has been determined to be competent is responsible for carrying out the search. To the extent required it will also add any missing related classes on the relevant form.

During the search procedure there is no direct correspondence between examining section and applicant or any other person filing the request.

Searches under Sec. 43 Patent Law are performed by the competent examining sections of the DPMA, without undue delay, within the scope of the volume and in the chronological order of receipt. The examining sections are advised to carry out the searches so as to make the search result available to the requester in time before the expiry of the priority year, if possible. Searches can be performed out of turn if a well-founded request for accelerated processing has been filed. As a rule, a request for accelerated processing is well-founded if regular processing would appear likely to cause considerable disadvantages to the requester.

Under Sec. 43(3), sentence 3, of the Patent Law, any person is authorised to inform the German Patent and Trade Mark Office of publications which might adversely affect the grant of a patent. Copies of such documents shall be communicated promptly to the applicant and, when a search procedure is pending, to the examining section too. These publications will only be included in the communication on the publications to be considered for assessing patentability if the examining section in charge deems these publications to be of relevance.

4. Subject matter of the search

The search covers the subject matter that ought to be protected according to the patent claims. The description and the drawings shall be considered for the interpretation of the claims.

If there are several versions of the claims, the search shall be based on the version last filed that the competent examining section considers to be admissible within the meaning of Sec. 38 Patent Law.

5. Scope of the search

The search is designed to ascertain the state of the art as contained in publications in order to assess the patentability of the filed invention. Within the framework of the procedure according to Sec. 43 of the Patent Law, each application shall be searched only once (see no. 3). For this purpose, the examining section shall make use of the existing technical tools as well as of the sources of information thus available, if this appears to be promising and where the effort involved seems to be justified; this always includes consideration of the prior art mentioned by the applicant. In any search it is checked whether previous search results are available in other countries.

For each claim - containing other than obvious matter - the ascertained publications have to be indicated. The publications indicated by the applicant shall be taken into consideration by the examining section competent for the main class only as far as they are part of the holdings of the German Patent and Trade Mark Office. If due to the broadness of the main claim, there are too many publications to be cited, the publications shall be selected which come closest to the subject matter of the invention bearing in mind restricting features of the dependent claims.

It is sufficient if one member of any patent family is taken into account unless there are reasons to believe that essential differences as to substance will be found in the contents of individual members of the same patent family.

The search shall be ruled by the principle of "thorough but not excessive". The search shall be terminated if, in the course of the search, the examiner sees that an unjustified amount of work would be necessary to achieve a modest improvement of the already obtained search result. The search shall also be terminated if prior publications have been ascertained which contain the subject matters of all the claims in a way prejudicial as to novelty.

The reference date for the search is the filing date rather than a priority date claimed.

Subsequently published patent applications with an earlier priority (see Sec. 3(2) Patent Law) have also to be cited if they challenge the novelty of the subject matter of a patent claim and are available in the form of printed publication at the time the search is carried out. In addition, international applications under the PCT and European patent applications have to be mentioned where the Federal Republic of Germany is designated, even if the requirements of Sec 3(2), sentence 1 no. 2, Patent Law have not yet been met but still can be met.

6. Special cases

a) Search in case of unclear or incomprehensible documents

If the subject matter of the application is unsearchable due to defects in the documents, the note: "Not searchable because of..." will be entered in the search report (see no. 7).

b) Search of applications that obviously lack unity

On principle, the search under Sec. 43 Patent Law must be carried out for the entire application. If obvious lack of unity is found only in the course of the search procedure, the examination as to obvious defects under Sec. 42 Patent Law must be resumed first.

7. Search report

For the search report, the respective forms shall be used.

The following shall be indicated

a) the ascertained publications, with reference to the numbers of the claims, if applicable with explanations and references to relevant passages and drawings, if necessary for comprehension. No reference to patent claims shall be made in case of publications as to the state of the art, which cannot be attributed to any of the patent claims.

In the case of patent literature, the ascertained publications are to be cited according to the Two Letter Country Code pursuant to WIPO Standard ST. 3 (see Communication of the President of the German Patent and Trade Mark Office no. 2/98 *Blatt für Patent-, Muster- und Zeichenwesen* 1998, p. 157 to 159). According to in-office order no. 15, the kind of document and number of issue, as well as passages in books or periodicals are to be cited in such way as to ascertain unmistakably the book or periodical as well as the passage concerned. The indication should be as concise as possible. However, abbreviations which do not appear in the title of the periodical itself or which are not current shall be avoided;

b) the classification units used for the search, even when no publications could be ascertained in the search class;

c) if applicable, the databases used to perform the search;

d) the categories (relevance indicators) of the ascertained publications in capital letters pursuant to WIPO Standard ST.14. The meaning is as follows:

- X** publication which, when it is **taken alone**, challenges the novelty or the inventive step of a claimed invention
- Y** publication challenging the inventive step of a claimed invention when the document is **combined with** one or more other documents, such combination being obvious to a person skilled in the art
- A** publication defining the state of the art or the technological background
- O** publication referring to an oral disclosure, use, exhibition of other kind of disclosure
- P** publication published during the priority interval
- T** subsequently published non-colliding document concerning the theory of the filed invention and which may be useful for the better comprehension of the filed invention or indicates that the train of thoughts or statement of facts underlying the invention might be wrong
- E** earlier patent application under Sec. 3(2) of the Patent Law
- D** publication already cited in the patent application
- L** publication mentioned for special reasons, e.g. as to the publication date of a citation or in case of doubt as to priority

Besides the indication of categories further references, suggesting an examination-like evaluation of the subject matter of the application, are not allowed.

The search report shall also contain a notice that no guarantee for the completeness of the relevant publications ascertained and for the correctness of the categories can be given (Sec. 43(7), sentence 1, Patent Law).

The applicant and the requester shall receive the ascertained publications together with the search report.

If after the publication of the reference to the search report in the Patent Gazette a serious mistake (e.g. the wrong quotation of a document) is discovered on the publication of the application or patent specification among the publications considered, a rectification shall be published in the Patent Gazette. The parties concerned are informed accordingly. If on the basis of the search report a wrong publication has been dispatched, a copy of the correct one shall be forwarded.