

# DEUTSCHES PATENT- UND MARKENAMT

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## Guidelines for the Search under Section 43 of the Patent Act

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### (Search Guidelines)<sup>1</sup>

of 1 April 2014 (*Blatt für PMZ* (official gazette) 2014, issue 5, p. 153 et seqq.)

#### Contents

1. Preliminary remark
2. Search request
3. Formal handling of the search request
4. Subject matter of the search
5. Scope and carrying out of the search
6. Search report

### 1. Preliminary remark

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

These guidelines shall supersede the guidelines of 2 September 2009 (*Blatt für PMZ* 2009, p. 361 et seqq.).

### 2. Search request

The DPMA shall, upon request, identify the state of the art to be taken into consideration in assessing the patentability of the application's subject matter and preliminarily assess the protectability of the invention in respect of which an application has been filed according to Sections 1 to 5 of the Patent Act and whether the application meets the requirements of Section 34(3) to (5) of the Patent Act (Sec. 43(1), first sentence, Patent Act).

The request may be made by the applicant only. The request must be filed in writing. Any person who has neither a domicile nor a seat nor an establishment in Germany may file a valid search request only upon appointment of a patent attorney or a lawyer (Sec. 43(2), third sentence in conjunction with Sec. 25(1) Patent Act). Under certain conditions, a patent agent (*Patentassessor*), that is, a person who passed the patent attorney examination at the DPMA

and is employed at a company. (Sec. 155(1) no. 2 and (2) Patent Attorney Regulations (*Patentanwaltsordnung*)) or a permit holder, authorised under Section 160 of the Patent Attorney Regulations in conjunction with Section 178 of the Patent Attorney Regulations (in the version valid until 31 August 2009), may act as representative. Reference is made to Section 25(2) of the Patent Act governing representation by nationals of a member state of the European Union or another contracting state of the Agreement on the European Economic Area.

The fee of 300 euros pursuant to no. 311 200 of the annex to Section 2(1) of the Patent Costs Act (*Patentkostengesetz*) is to be paid within three months from filing the request. If the fee is not paid, not paid in full or not paid within the prescribed time limit, the request shall be deemed withdrawn pursuant to Section 6(2) of the Patent Costs Act.

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; if the applicant fails to do so even after being invited, the application of the patent of addition shall be deemed an application for an independent patent (Sec. 147(3) Patent Act in conjunction with Sec. 43(2), fourth sentence, Patent Act in the version valid until 1 April 2014). With effect from 1 April 2014, the Act Revising Certain Provisions of Patent Law and Other Acts in the Field of Industrial Property Protection (*Gesetz zur Novellierung patentrechtlicher Vorschriften und anderer Gesetze des gewerblichen Rechtsschutzes*) of 19 October 2013 (Federal Law Gazette<sup>2</sup> I p. 3830), the provisions concerning applications of addition and patents of addition were annulled in the Patent Act. However, due to the transitional arrangement of Section 147(3) of the Patent Act, Section 43(2), fourth sentence, of the Patent Act in its version valid until 1 April 2014 still applies in the cases mentioned therein.

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 Act).

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<sup>1</sup> *Rechercherichtlinien*

<sup>2</sup> *Bundesgesetzblatt* (BGBl)

The search request presupposes a pending application. It may be submitted at the time of filing the application.

If the search request pursuant to Section 43 of the Patent Act is filed before or at the same time as the examination request pursuant to Section 44 of the Patent Act, search pursuant to Section 43 of the Patent Act shall be carried out first, and then it shall be preliminarily assessed whether the invention in respect of which an application has been filed is protectable according to Sections 1 to 5 of the Patent Act and whether the application meets the requirements of Section 34(3) to (5) of the Patent Act. The applicant shall be notified of the result. Then, the examination procedure shall begin (Sec. 44(3), first sentence, Patent Act).

### 3. Formal handling of the search request

The search request filed shall be checked for validity. The competent section also takes action to have the communications sent to the applicant and arranges for publication of the fact that a search request has been received in the Patent Gazette (*Patentblatt*). However, the publication in the Patent Gazette shall not take place before the publication of the reference under Section 32(5) of the Patent Act to the possibility of file inspection (Sec. 43(3), first sentence, Patent Act). After establishment of the validity of the search request, the file shall be transmitted to the examining section competent for the main class to 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 examining section competent for the main class.

The competent examining section is responsible for carrying out the search. To the extent required, it will also add any missing related classes.

Searches under Section 43 of the Patent Act are performed, without undue delay, in the chronological order of receipt taking into account the workload of the respective examining section. 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. Upon a well-founded request for accelerated processing, the order of the requests to be processed may be adjusted. 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 Section 43(3), second sentence, of the Patent Act, any person is authorised to provide information on the state of the art to the DPMA of publications which might adversely affect the grant of a patent. Such documents shall be communicated promptly to the applicant and, when a search procedure is pending, to the examining section too. This state of the art shall be included in the search report if it is deemed relevant by the competent examining section.

### 4. Subject matter of the search

The search covers the subject matter(s) to be protected by a patent according to the patent claims.

If the examining section determines – upon a search request – that the application does not meet the requirement of Section 34(5) of the Patent Act (lack of unity), it shall carry out a search for the part of the application referring to the invention or group of inventions described first in the patent claims so linked as to form a single general inventive concept (Sec. 43(6) Patent Act). The search report shall include a reference to the lack of unity. The numbers of the claims whose subject matters lack unity as well as the numbers of the claims for whose subject matters a search was carried out shall be indicated (part D, section 7 of the search report).

If a search on the whole subject matter in respect of which an application has been filed or on parts of the subject matter in respect of which an application has been filed cannot be carried out due to defects in the documents filed, this shall be included in the search report giving the respective claim numbers (part D, section 8 of the search report).

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 Section 38 of the Patent Act.

### 5. Scope and carrying out of the search

The search shall determine the state of the art in a way that it can be used as a basis for preliminarily assessing the protectability of the invention in respect of which an application has been filed. Within the framework of the procedure according to Section 43 of the Patent Act, each application shall be searched only once. 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 useful and where the effort involved seems to be justified; this always includes consideration of the state of the art mentioned by the applicant. In any search, it is checked to the extent possible whether previous search results are available in other countries.

For each patent claim that does not only contain commonly known facts, the determined state of the art has to be indicated. The documents indicated by the applicant shall be taken into consideration by the examining section competent for the main class – if needed, the applicant shall be requested to provide the documents. If due to the broadness of the main claim, the state of the art to be cited is too broad, the state of the art shall be selected which comes closest to the subject matter of the invention taking into account restricting features of the dependent claims. The description and the drawings shall be considered for the interpretation of the claims.

When citing patent documents (publications), it is sufficient if one member of each 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 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 reference date for the search is the filing date rather than a priority date claimed.

Subsequently published patent applications with an earlier priority (Sec. 3(2) Patent Act) have also to be cited if they challenge the novelty of the subject matter of a patent claim and are available to the public at the time the search is carried out. In addition, international applications under the Patent Cooperation Treaty (PCT) where the DPMA is the designated office have to be mentioned as well as European patent applications where the Federal Republic of Germany has been designated, even if the requirements of Section 3(2), first sentence, no. 2, of the Patent Act have not yet been met but still can be met.

Internet sources including online technical journals, online databases and other websites can also be used for a search. However, it shall be made sure that the contents of yet unpublished applications are not made available to the public in error in full or in part by using search terms or combinations of search terms. It is the responsibility of each examining section to choose search terms by which a search can be carried out in a reasonable way that does not lead to a breach of the obligation to maintain secrecy with regard to unpublished applications. This means, for example, that only single keywords that do not disclose the subject matter in respect of which an application has been filed may be used as search terms; strings consisting of multiple search terms or even whole passages from a claim may not be used.

In case of database searches, a report about the complete procedure of the search containing the selected databases as well as the search terms used shall be prepared. The report shall be included as an electronic document in the file.

## 6. Search report

The search report shall contain the following information:

### A. Classification of the subject matter in respect of which an application has been filed under the International Patent Classification (IPC)

### B. Fields and tools used for the search (e.g. databases)

All classification units and search tools used for the search shall be indicated, even if it was not possible to determine the state of the art in the class the search was carried out for.

### C. Result of determining the state of the art

The determined state of the art with reference to the respective numbers of the claims, if applicable with explanations and references to relevant passages and drawings, shall be listed **in a table**, if necessary for comprehension. No reference to patent claims shall be made in case of state of the art which cannot be attributed to any of the patent claims.

Publications are to be cited according to the two-letter country code pursuant to WIPO Standard

ST.3 (see *Mitteilung des Präsidenten des Deutschen Patent- und Markenamts Nr. 2/98<sup>3</sup>, Blatt für PMZ* 1998, pp. 157 to 159). The numbers and kind codes of the publications shall be indicated too. According to **in-office order no. 15**, non-patent literature such as passages in books or periodicals is to be cited in such a way as to ascertain unequivocally the book or periodical as well as the passages concerned.

The categories (relevance indicators) of the determined state of the art shall be indicated in capital letters pursuant to WIPO Standard ST.14. The codes are defined as follows:

X	citation which, <b>when it is taken alone</b> , challenges the novelty or the inventive step of a claimed invention
Y	citation challenging the inventive step of a claimed invention when the document is combined with one or more such documents, such combination being obvious to a person skilled in the art
A	document defining the technological background
O	document referring to an oral disclosure, use, exhibition or other kind of disclosure
P	state of the art published during the priority interval
T	subsequently published non-colliding state of the art concerning the theory of the invention in respect of which an application has been filed and which may be useful for the better comprehension of the invention in respect of which an application has been filed or indicates that the train of thoughts or statement of facts underlying the invention might be wrong
E	earlier patent application under Section 3(2) of the Patent Act
D	state of the art already cited in the patent application (so-called "self-citation") and also deemed relevant by the examining section
L	document mentioned for special reasons, for example, in order to prove the publication date of a citation taken into account or in case of doubt as to priority

In case of state of the art that is non-patent literature of which printing and copying may be restricted, such documents may not be integrated into the electronic case file for copyright reasons. Therefore, it must be made sure to record such documents in the DPMA's non-patent literature archive and to include citations with the full bibliographic data as well as archive identification numbers of the documents in the electronic case file.

<sup>3</sup> Notice of the President of the German Patent and Trade Mark Office no. 2/98

**D. Preliminary assessment whether the invention in respect of which an application has been filed is protectable according to Sections 1 to 5 of the Patent Act and whether the application meets the requirements of Section 34(3) to (5) of the Patent Act**

For the preliminary assessment according to Section 43(1), first sentence, of the Patent Act, the electronic form provided for this purpose shall be used. It may not be altered. It shall be made sure that the preliminary assessment according to Section 43(1), first sentence, of the Patent Act is complete and includes statements on all relevant criteria of protectability according to Sections 1 to 5 of the Patent Act and on the requirements of Section 34(3) to (5) of the Patent Act. Therefore, assessment shall be regularly subject to sections 1 to 7, in special cases, also to section 8 of the form.

Some possible defects of an application (e.g. lack of novelty or non-assessability of novelty) may require a statement of reasons to be inserted in the free-text field in the form. This statement of reasons shall always be sound and reasonable but may be short and limited to the most essential facts.

If the examining section deems certain defects not included in sections 1 to 7 to be relevant, they may be mentioned in section 8.

If non-patent literature of which printing and copying may be restricted is cited as relevant, the applicant shall be informed in section 8 that such state of the art may not be transmitted annexed to the search report but will be transmitted separately by post.

It shall be noted that non-selection of a form field referring to a defect means that such a defect does not exist after preliminary assessment.

At the end of the search report, the date of conclusion of the search shall be indicated (automatic indication in the electronic form) as well as a notice that no guarantee for the completeness of the state of the art determined and for the correctness of the categories can be given (Sec. 43(7), first sentence, Patent Act).

The applicant shall receive the state of the art determined together with the search report. Only non-patent literature of which printing and copying may be restricted is transmitted separately by post.

Cited non-patent literature is only available to the public as a reference within the scope of online file inspection.

If, after the publication of the reference to the search report in the Patent Gazette, a serious mistake relating to the state of the art cited (e.g. a wrong reference to a publication) is discovered on the publication of the application or patent specification, a rectification shall be published in the Patent Gazette. The applicant shall be notified of this. If, on the basis of the search report, a wrong document has been dispatched, the correct one shall be forwarded.