

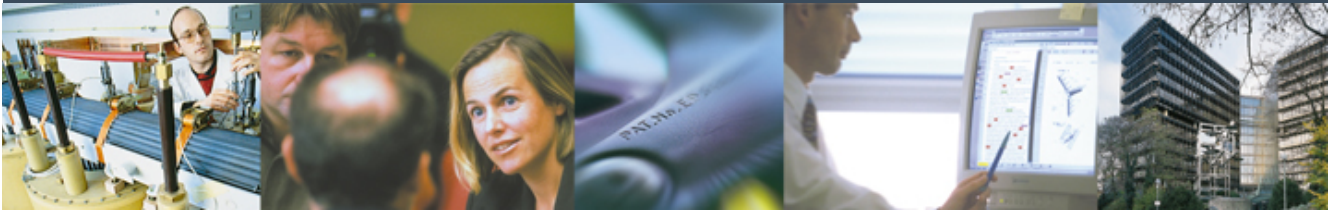


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European Patent
Office

Reasons for Doing 'No Search'

Barcelona
November 2005

Daniel Closa
Examiner
Directorate 2.2.21



Overview

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"Computers"

Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

1. The Situation We Faced
2. Various Response Strategies
3. Why 'No Search' Strategy
4. Consequences Of 'No Search'
5. Practical Implementation In The Directorates 1.2.38 And 2.2.21
6. Examples

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3



The Situation

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Situation

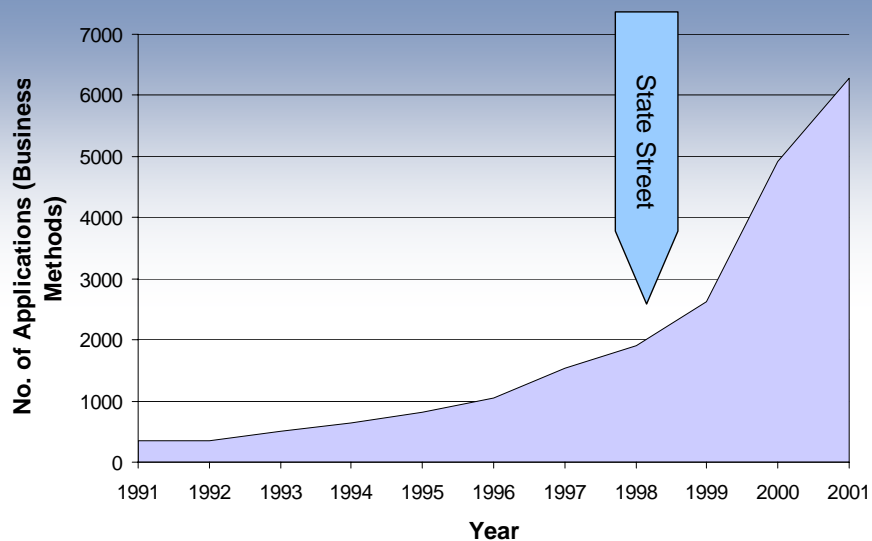
Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples



The number of applications to be searched at the EPO increased dramatically in the field of business methods.

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4



Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

The Situation

After the 'State Street' Decision in 1998 the content of the applications filed changed dramatically!

- In the US, it has become possible to get patents for applications having very little (almost no) technical content.
- The same type of applications were then filed in Europe and in particular at the EPO („If it is possible in US, why not in Europe?“).



Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

The Situation

We were overloaded with an enormous amount of applications in the search phase

and

the technical content of a majority of these applications was a priori too low to fulfil the requirements of the EPC.



Possible Strategies

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Situation

**Possible
Strategies**

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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7

a) Complete Search

We send a complete search report for all applications.

Practical problems:

- What do we search? Only the technical aspects or also the business-related aspects?
- If we search only the technical aspects, can we justify the view that our search was 'complete'?
- Where can we search the business-related aspects? Neither our classification schemes nor our databases are adapted.



Possible Strategies

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Situation

**Possible
Strategies**

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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8

More fundamental question:



"Is it of value to the public to spend a lot of resources on searching applications which will, according to the present state of the law, never result in a European patent?"

Not really





Possible Strategies

- a) Complete Search
- b) Adapted Approach
- c) Partial Search Report
- d) 'Do not accept'
- e) 'No Search' Declaration



Possible Strategies

b) Adapted Approach

We perform a complete search, however beforehand, we send a letter to the applicant asking him what he considers to be the technical features to be covered by the search.

- This approach was tried by examiners in Dir. 1.2.38; 400 letters were sent, very few answers were received.
- Where an answer was received it was rarely convincing or helpful.



Possible Strategies

c) Partial Search Report

We search only the technical aspects of the application and send a partial search report (Rule 45 EPC).

Problems:

- It is not always easy to distinguish in a set of claims those features which are technical from those which are not.
- In many cases the technical content of the claims is merely directed at generic features.
- Would the applicants and the public understand what we had done?



Possible Strategies

d) 'Do not accept'

- Since 1/3/2002, the US-PCT applications in the field of business methods (G06F17/60) are retained by the USPTO and not searched/ examined by the EPO as ISA and IPEA.
- This was partly due to political pressure but also to feedback from US applicants to the USPTO.



Possible Strategies

e) 'No Search' Declaration

We do not search the applications whose technical content is a priori too low to fulfil the requirements of the EPC.

'No Search' declaration is issued as a communication under:

Rule 45 EPC

Art. 17(2) PCT and Rule 39.1 PCT.



Rule 45 EPC



"If the Search Division considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims, it shall either

- declare that **search is not possible**
- or shall, so far as is practicable, draw up a partial European search report.

The declaration and the partial report referred to shall be considered, for the purposes of subsequent proceedings, as the **European search report.**"



Why 'No Search'

The 'No Search' declaration has always been part of the EPO practice during the PCT and EP search phase (see present Guidelines B-VIII, 1-3 and former Guidelines B-VIII, 1-6).

Our intention was to send a **strong and clear signal** to applicants and other large players in patenting by issuing a considerable number of (justified) 'No Search' declarations in a consistent manner.



No Search !



Why 'No Search'

Standard clause used in the European Search Report:

The claims relate to subject matter **excluded from patentability under Art. 52(2) and (3) EPC**. Given that the claims are formulated in terms of such subject matter

or **merely specify commonplace features relating to its technological implementation, the search examiner could not establish any technical problem which might potentially have required an inventive step to overcome**. Hence it was not possible to carry out a meaningful search into the state of the art (Rule 45 EPC). See also Guidelines Part B Chapter VIII, 1-3.



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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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17

Concerning an application for which a 'No Search' declaration is to be issued, we want to send the following message:

- **Either** the subject matter of the application is excluded from patentability (according to Article 52(2) and (3) EPC);
- **Or** the technical content of the application is insufficient such that the probability of a grant being issued is very low (in view of Articles 54 or 56 EPC).



Why 'No Search'

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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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18

We adopted the 'No Search' strategy because we believe it to be the best way to send a very clear signal to the applicants and to the public that the provisions of the European patent law (i.e. EPC) differ from the US patent law.





Declaration under Rule 45 EPC

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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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19

European Patent Office

DECLARATION Application Number: EP 03 02 4846
which under Rule 45 of the European Patent Convention shall be considered, for the purposes of subsequent proceedings, as the European search report

The Search Division considers that the present application, does not comply with the provisions of the EPC to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all claims.	CLASSIFICATION OF THE APPLICATION (INCL. CL. 2)						
Reason:	G06F17/60						
<p>The claims relate to subject-matter excluded from patentability under Article 52(2) and (3) EPC. Given that the claims are formulated in terms of such subject matter or merely specify commonplace features relating to its technological implementation, the search examiner could not establish any technical problem which might potentially have required an inventive step to overcome. Hence it was not possible to carry out a meaningful search into the state of the art (Rule 45 EPC, see also Guidelines for Examination in the EPC, Part B, Chapter VIII, 1-6).</p> <p>The applicant's attention is drawn to the fact that a search may be carried out during examination following a declaration of no search under Rule 45 EPC, should the problems which led to the declaration being issued be overcome (see EPC Guideline C-VI, 8.5).</p> <p>----</p>							
2							
<table border="1"> <tr> <td>Room of search</td> <td>Exam</td> <td>Examiner</td> </tr> <tr> <td>HUNICH</td> <td>6 April 2004</td> <td>Hopper, E</td> </tr> </table>	Room of search	Exam	Examiner	HUNICH	6 April 2004	Hopper, E	
Room of search	Exam	Examiner					
HUNICH	6 April 2004	Hopper, E					



Extended European Search Report

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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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20

Beschreibungsprotokoll (Anlage) Communications Minutes (Annex) Notification Process-verbal (Annex)

Blatt / Sheet: 1/48 Anmelde-Nr. / Application No.: 03 024 846.2

The examination is being carried out on the following application documents:

Text for the Contracting States:
AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HU IE IT LU MC NL PT RO SE SI SK TR LI

Description, pages:
1-29 as originally filed

Claims, No.:
1-29 as originally filed

Drawings, sheets:
1/7-7/7 as originally filed

1. Article 52(2) EPC

1.1 Independent Method Claim

a. Independent method claim 1 is

b.

EPC Form 2004/01 (EPC)



Consequences of 'No Search'

For the applicant:

- A 'No Search' declaration **is not a loss of rights**. He can still enter the examination phase or the regional phase, amend the claims and/ or argue we should do a search during substantive examination.
- If he convinces us that a search has to be done, then documents are cited according to Guidelines C-VI, 8.7. He does not have to pay for a supplementary search, nor is an additional Search Report formally issued.



Consequences of the 'No Search'

Practical results:

- The message was understood in many cases; 50% of the EP 'No Search' files do not proceed to substantive examination.
- In cases where examination is requested, often a quick decision is desired.
- The USPTO processes now the vast majority of US-PCT in the field.



Practical Implementation

All new search files are checked on arrival and classified either as a 'Search' file or a 'No Search' file by the examiners in the field as a group to ensure harmonisation.

All the 'No Search' files are equally distributed in the directorates.

When an examiner receives such a 'No Search' file he takes the final decision on whether to issue a declaration under Rule 45 EPC.



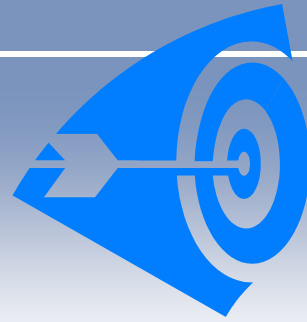
Practical Implementation

The following criteria are used taking into account not only the claims, but also the description and the drawings:

- Are there any technical aspects at all?
- Are the technical aspects of the case merely generically described?
- Is there any a priori technical problem/ solution apparent?
- Is there a clear need for a document in order to refuse?



Practical Implementation



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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

**Practical
Implementation**

Examples

The goal is...

TO GRANT PATENTS when justified
TO REFUSE EFFICIENTLY when not

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25



Statistics

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Situation

Possible
Strategies

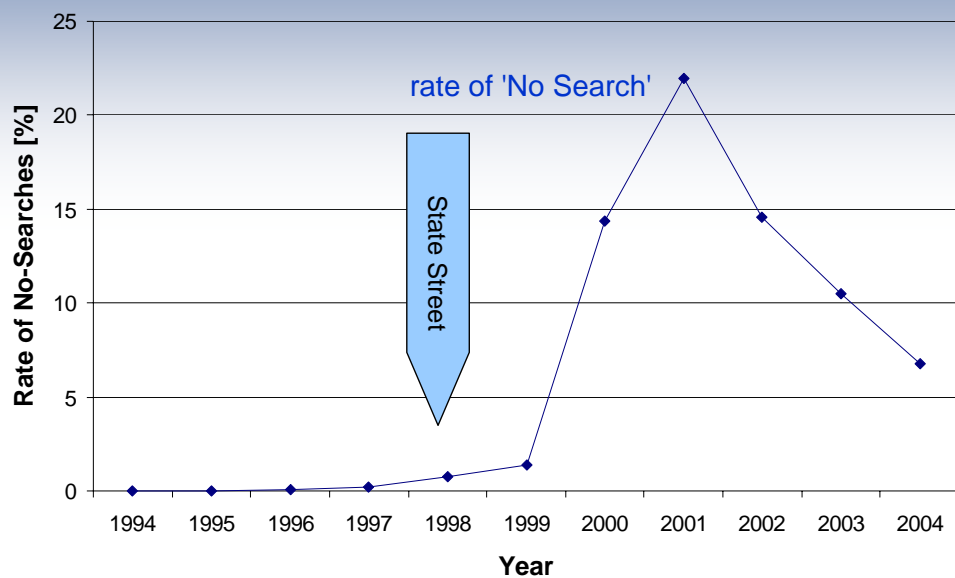
Why 'No Search'
Strategy

Consequences

**Practical
Implementation**

Examples

Rate = number of 'No Search' / the total number of applications



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26



Statistics

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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

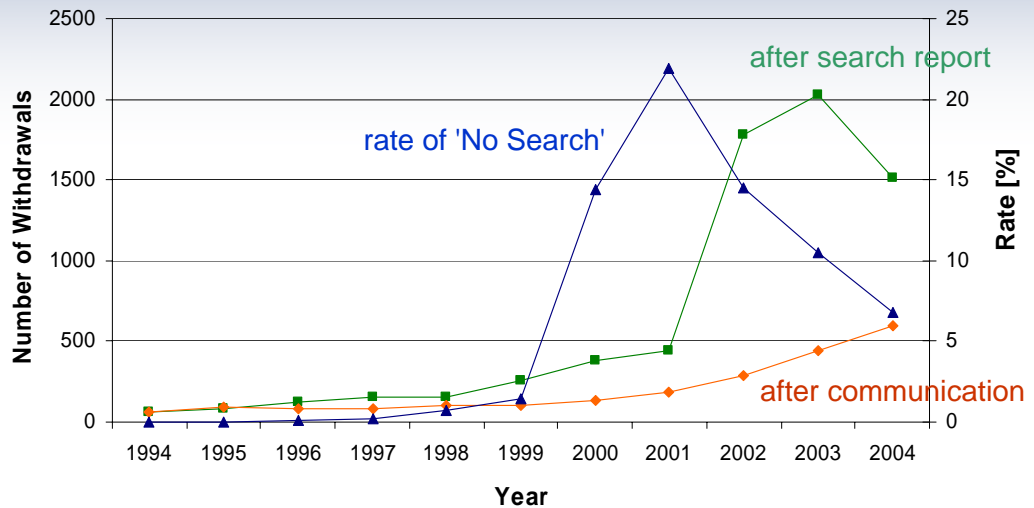
Practical
Implementation

Examples

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27

Number of withdrawals after 'No Search' and after written communication



Examples (1), G06F17/60 - Business Methods

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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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28

Method for purchasing and payment of goods and services, preferably audio and/ or video data provided on a provider's platform in a computer network, like the Internet, comprising the steps:

- taking a customer's order for goods and services, preferably an order for audio and/or video data files;
- providing a download of ordered goods and services, preferably of audio and/or video data files, for the customer; and
- debiting a mobile telephone account of the customer.



Examples (2), G07F17/32 - Gaming Machines

A method of **operating a game of chance** comprising the steps of:

- designating a specified event having a plurality of possible outcomes;
- conducting an auctioning session, said auctioning session comprising receiving bids from a plurality of associated players, wherein each bid comprises a value wager and a bet outcome,
- specifying a particular outcome in respect of the specified event, and
- terminating said auctioning session after a random interval of time.



Examples (3), G06F17/60 - Business Methods

A system for controlling Internet Web page advertising, comprising:

- means for a user to request a specific World Wide Web (Web) page on the Internet;
- means for initially displaying an advertising page occupying the full browser window display, prior to said user desired Web page is displayed;
- and means for subsequently displaying said user requested Web page absent any advertisement



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Situation

Possible
Strategies

Why 'No Search'
Strategy

Consequences

Practical
Implementation

Examples

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Questions ?