

8. Reference documents

See ISPE Guidelines 4.26.

Where the reference document relates to the background art, it may be in the application as originally filed or introduced at a later date (see GL/PCT-EPO F-II, 4.3, and GL/PCT-EPO H-II, 2.2.5).

Incorporation of essential matter or essential features at a later date is, however, subject to the restrictions set out in GL/PCT-EPO H-II, 2.2.1. It may be that the examiner has requested the applicant to furnish the document referred to, in order to be able to carry out a meaningful search (see ISPE Guidelines 15.37).

9. "Reach-through" claims

Section F-III, 9, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

10. Sufficiency of disclosure and Rule 20.5(e)

The application may contain sheets stamped "Not to be considered (R. 20.5(e) or 20.7)". This means that these sheets were not allowed by the receiving Office (for formal or substantive reasons) and the applicant has withdrawn those parts in order to avoid re-dating of the application. Such sheets thus do not form part of the application documents and should be ignored for search and examination.

In this case, the examiner must carefully evaluate whether the invention is still sufficiently disclosed without relying on the technical information contained in the withdrawn missing parts. Should the examiner reach the conclusion that the requirements of Art. 5 are not satisfied, a corresponding objection is raised. See also GL/PCT-EPO F-III, 3 to GL/PCT-EPO F-III, 5.

11. Sufficiency of disclosure and clarity

An ambiguity in the claims may lead to an insufficiency objection. However, ambiguity also relates to the scope of the claims, i.e. Art. 6 (see GL/PCT-EPO F-IV, 4). Normally, therefore, an ambiguity in a claim will lead to an objection under Art. 5 only if the whole scope of the claim is affected, in the sense that it is impossible to carry out at all the invention defined therein. Otherwise an objection under Art. 6 is appropriate. GL/ISPE 4.12, 5.58

In particular, where a claim contains an ill-defined ("unclear", "ambiguous") parameter (see also GL/PCT-EPO F-IV, 4.11) and where, as a consequence, the skilled person would not know whether he was working within or outside of the scope of the claim, this, by itself, is not a reason to deny sufficiency of disclosure as required by Art. 5. Nor is such a lack of clear definition necessarily a matter for objection under Art. 6 only. What is decisive for establishing insufficiency within the meaning of Art. 5 is whether the parameter, in the specific case, is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures necessary to solve the problem underlying the application at issue.