

5.2 Exemptions from top-up search

GL/ISPE 19.15

As a general rule, a top-up search will be conducted for all the claims forming the basis for the Chapter II examination, as indicated in boxes I and III of the WO/IPER.

Rule 66.1ter

A top-up search is not conducted on:

Rule 66.1(e)

(a) subject-matter not searched by the ISA;

Art. 34(3)

(b) non-unity cases – inventions for which additional search fees were paid, but not additional examination fees;

Art. 34(4)

(c) subject-matter which, although not excluded from the search, is excluded from preliminary examination;

In addition to what is mentioned in Rule 66.1ter PCT, the top-up search may be refused or limited by the EPO as IPEA:

Art. 34(2)(b) and 19(2)

(d) where amendments contain added matter;

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(e) where there is no letter explaining the basis for amendments and/or indicating what has been amended in the application;

Rule 46.5(b) and 66.8

(f) where the EPO as ISA would not cite any documentary evidence as to the relevant state of the art (e.g. in case of "notorious knowledge" in the field of computer-implemented inventions).

Rule 70.2(c)

In case (d) above, the examiner will perform the top-up search based on either the previous set of application documents or the amended set, ignoring the added subject-matter. In case (e) above, the same applies to unsupported amendments (see GL/PCT-EPO C-III, 4).

Where a top-up search is made for some claims or part of claims, there is no indication of:

- which claims are not covered by the top-up search (this should be derivable from the indications in Sections I and III of the WO/IPER); or
- why no or only a partial top-up search has been made.

5.3 Documents newly found in the top-up search, when further objections are present

GL/ISPE 3.22

If the top-up search reveals pertinent prior art, according to present practice a WO-IPEA or a telephone consultation is the first action in Chapter II (see GL/PCT-EPO C-IV, 2.2). If a positive WO-ISA was drafted or the objections in the negative WO-ISA have been overcome by the applicant's amendments/arguments, see GL/PCT-EPO C-IV, 5.4.