Patentability of inventions in the field of food industry: search and examination practice at the EPO

Introduction

• The search and examination phases within the patent grant procedure at the EPO

• Search & examination: legal basis, practical aspects

• Implications for applications in field of food industry
Overview  grant procedure

The procedure begins when an application for a European patent is filed with the EPO.

Once the application complies with the filing requirements, it enters the search phase, where:
\( \text{a search for prior art is performed} \)
\( \text{a search report and a written opinion are issued} \)

In the examination phase all the substantive issues relating to the application are assessed and the contents of the application are shaped into a form in which the patent can be granted ... or the application refused.

The European patent grant procedure at a glance

- **Applicant**
  - European patent application
  - Filing and formalities check
  - Search and search report together with preliminary opinion on patentability
  - Substantive examination
  - Grant of European patent
  - Publication of application and search report
  - Online access to application file and legal status information
  - Observations by third parties possible (Art. 115 EPC)

- **EPO**
  - Withdrawal of application
  - Validation in designated states
  - Limitation or revocation proceedings
  - Opposition proceedings
  - Appeal

- **Public domain**
  - Publication of patent specification
  - Opposition by a third party

- **Timeline**
  - 18 months
  - Approx. 3 to 5 years
  - 9 months
Search/Examining Divisions

- **Article 17 EPC** – Search Divisions shall be responsible for drawing up European Search Reports (see Article 92 EPC)

- **Article 18 EPC** – Examining Divisions shall be responsible for the examination of European Patent Applications

- Historically, the Hague searched, Munich examined. Since 1989, BEST (bringing examination an search together), all actions now carried out at both sites.

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**The search phase**

- Applicant
- Filing and formalities examination
- Examination
- Substantive examination
- Grant of a European patent
- Review
  - Observations by third parties possible (Article 115 EPC)
- Publication of the patent specification
- Opposition proceedings
- Appellate proceedings
- Limitation or revocation proceedings
- Validation in the designated states
Search

**Purpose of the search** (Art. 92 EPC)

- To discover the state of the art at the relevant date.
- To prepare for substantive examination and to determine whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step.

**Search documentation**

- Internal and external documents
- Patent and non-patent literature

Search phase

- The outcome of the search phase is:
  - a search report listing the relevant prior art (Art. 92, R. 61 EPC)
  - an opinion on whether the application and the invention to which it relates meet the requirements of the EPC (R. 62 (1) EPC)

- The combination of these two documents is known as the extended European search report (R. 62 EPC).
European search report

The search report includes the citations of relevant documents. Categories are assigned (X, Y, ...) to indicate the relevance and type of citation.

The opinion provides a written analysis of the patentability of the application, based on the cited documents.

Search

- What? - Article 92 EPC: based on the claims, with due regard to the description and any drawings.
- Where?
  - Over 140 Internal Databases (e.g. FSTA, Biosis, etc.)
  - External Databases (e.g. Chemabs, CABAetc.)
  - Search engines (e.g. Google, etc.)
  - Sequence searching via EMBL
In-house Documentation

- World's largest collection of patent and non-patent literature documents, containing more than 540 million records in over 130 databases and updated daily
- Online access to more than 6,000 journals via the EPO Virtual Library
- New tools and services such as machine translation to extend the range of easily accessible information

http://worldwide.espacenet.com/
**The examination phase**

- **Applicant**
  - European patent application
  - Filing and formalities examination

- **European Patent Office**
  - Search and search report together with a preliminary opinion on patentability
  - Observation by third parties (Article 115 EPC)
  - Publication of the application and search report

- **Public**
  - Limitation or revocation proceedings
  - Appeal proceedings
  - Opposition proceedings

- **Substantive examination**

  - For an application to be granted, all the requirements of the EPC must be met (Art. 97 EPC).

  - The applicant may request examination up to six months after the mention of publication of the search report (R. 70 EPC).
The examining division

- The examining division consists of three members (Art. 18 EPC).
- Each decision is the responsibility of the division as a whole.
- Examination is an ex-parte procedure in which only the applicant is involved.
  - Third parties may only submit observations

Substantive examination

- Substantive examination mainly deals with how the invention is disclosed and defined:
  - Clear definition of the protection sought (Art. 84 EPC).
  - Sufficient disclosure of the invention (Art. 83 EPC).
  - Unity of invention (Art. 82 EPC).

- A patent may be granted for an invention which
  - is new (Art. 54 EPC),
  - involves an inventive step (Art. 56 EPC),
  - has industrial applicability (Art. 57 EPC),
  - ... and is not excluded from patentability (Art. 52-53 EPC).
Substantive examination

• These requirements are examined using the cited prior art as documentation to back up the arguments.

• All objections raised must be reasoned and supported by evidence.

• Examination cannot therefore take place until after the search phase has been completed.

Substantive examination

• Applicants and examiners exchange written communications stating their objections, arguments and amendments.

• The applicant must always be given the right to be heard (Art. 113 EPC). There can be no decision based on objections which have not been discussed.
Final outcome

- The application meets the requirements of the EPC:
  + translation of the claims
  + payment of grant and publishing fees

  → grant

  – Opposition period begins
  – Administration goes over to the national offices (+ "Validation")

- The application does not meet the requirements of the EPC:

  → refusal

  – Adverse decision may be appealed.

Publication of the European patent

- Granted European patents are published after the examination procedure.
  – These documents are known as B publications (Art. 98 EPC).

- Publication of the specification informs the public and
  – defines the granted exclusive right (Art. 64 EPC)
  – enables the opposition procedure (Art. 99 EPC)
Thank you!