

The basics of EPO opposition proceedings

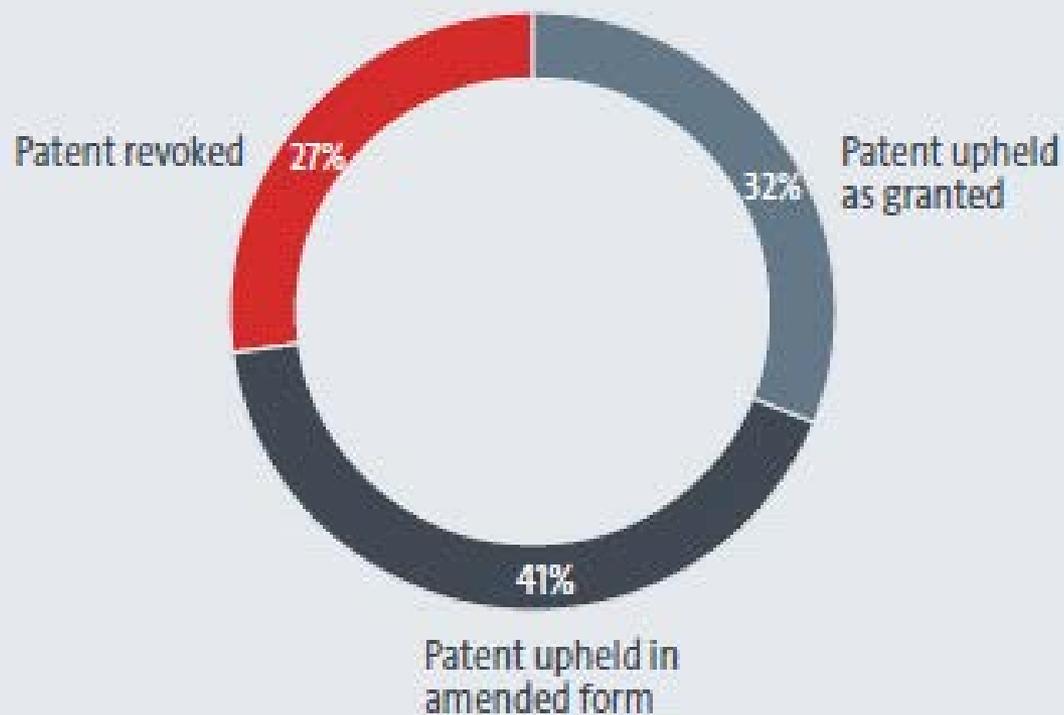
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Agenda

- Fundamentals
- The legal basis – what, when, how...
- Procedure
- Strategy as opponent
- Strategy as patentee
- Oral Proceedings
- Appeal

Why...?

Outcome of opposition decisions¹ in 2018



Fundamentals of EPO oppositions

- Central, post-grant procedure
- Allows third parties to challenge the validity of the patent
- *Inter partes* procedure – opponent is a full party to proceedings
- Written & oral procedure
 - No “discovery”
 - Hearing of witnesses – rare
- Each party (generally) bears its own costs
- Relatively cheap, fairly predictable process

The basics...Article 99(1) EPC

Within **nine months**...of the grant of the European patent...

...**any person** may give **notice** to the European Patent Office **of opposition** to that patent...

Notice of opposition shall not be deemed to have been filed until the **opposition fee** has been paid.

The basics...Article 99 EPC

Within **nine months**...of the grant of the European patent...

- No extensions, no excuses

...any **person** may give **notice** to the European Patent Office **of opposition** to that patent...

- "Legal person" or private individual
- "Strawman" oppositions possible (not anonymous)
- No requirements as to any "interest" in the patent
- No "self-opposition"

Notice of opposition shall not be deemed to have been filed until the **opposition fee** has been paid.

- **EUR 785.00**

On what grounds? Article 100 EPC

Opposition may **only** be filed on the grounds that:

- (a) the subject-matter of the European patent is **not patentable** under Articles 52 to 57;
- (b) the European patent **does not disclose the invention** in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c) the subject-matter of the European patent **extends beyond the content of the application as filed**....

"Only"

- No ownership or inventorship issues
- No infringement issues
- No other ground (e.g. clarity)
- Late-filed grounds of opposition are usually not admissible

Article 100(a)

“not patentable under Articles 52 to 57 EPC”

Article 52 = non-eligible subject matter (mental act, computer program, presentation of information...)

Article 53 = “immoral” inventions (medical methods, essentially biological processes...)

Article 54 = novelty

Article 56 = inventive step

Article 57 = industrial application

Article 100(a)

“not patentable under Articles 52 to 57 EPC”

Article 52 = non-eligible subject matter (mental act, computer program, presentation of information...)

Article 53 = “immoral” inventions (medical methods, essentially biological processes...)

Article 54 = novelty

Article 56 = inventive step

Article 57 = industrial application

Article 100(b)

“the European patent does not disclose the invention”

- Presupposition that the patent is sufficiently disclosed
- To overturn a European Patent on this ground usually requires “serious **doubts**, substantiated by **verifiable facts**” from the opponent
- Balance between “sufficiency of disclosure” and “clarity”
 - clarity is not a ground of opposition

Article 100(c)

“the subject-matter of the European patent extends beyond the content of the application as filed....”

- Extremely strict criteria in Europe

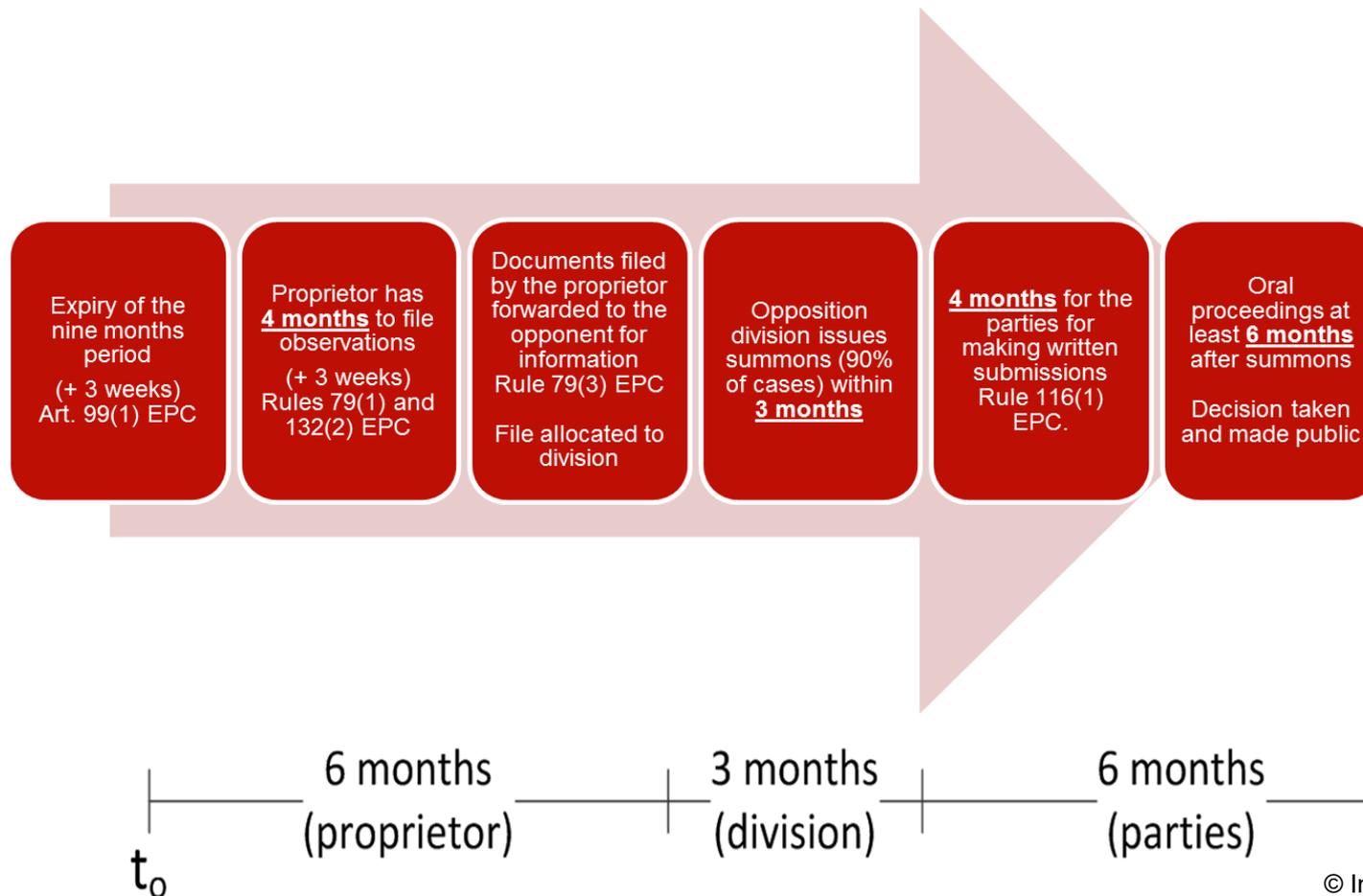
Counterpart in Article 123(3) EPC:

- *The European patent may not be amended in such a way as to extend the protection it confers.*
- Article 123(2)-123(3) trap...

Procedure

- 9-month opposition period – opposition filed
- Patent proprietor +4 month response deadline
 - +2m extension for complex cases
 - File response with arguments and fall-back positions: “auxiliary requests”
- Summons to oral proceedings, with
 - Preliminary opinion from the EPO Opposition Division and
 - Deadline for final written submissions
- 1-day oral proceedings at the EPO in Munich/The Hague/Berlin
- Decision on the day, written decision within 6-8 weeks

Early Certainty from Opposition



“Front loading”

- Parties should submit all facts, evidence and requests at the beginning of the procedure, or at the earliest possible opportunity
- Late-filed facts or evidence may be disregarded (Art. 114(2) EPC)
 - Unless prima-facie relevant (changes the outcome of the case)
- Apportionment of costs may be applied if facts or evidence are filed at a late stage of the proceedings without good reason.

Late-filing

- Documents need to fulfill 2 criteria if they are to be admissible at a very late stage:
 1. They should be motivated (e.g. by a change in the situation)
 - e.g. the other party has filed new evidence
 - A negative preliminary opinion from the EPO is not – in itself – sufficient reason to file amendments
 2. They must be *prima facie* allowable
 - “*prima facie*” = without further investigation
 - Don't introduce more problems than you solve

Apportionment of costs

- If delaying tactics are used, or conduct is “unreasonable”
- Examples in Guidelines D-IX 1.4
 - Patent is surrendered just prior to oral proceedings – costs to opponent for preparation of oral proceedings
 - If further oral proceedings are made necessary by e.g. late filing of a relevant document, which the party had previously been aware of.
 - Late-filing of facts or evidence, which cause the other party to incur unnecessary costs

What your European counsel needs from you as Opponent

- Agree on a **budget** and a **strategy**
- Warn your European counsel **well in advance** of the 9-month time limit
 - Preparation of a strong opposition takes time and requires specialist skills and opposition experience

What your European counsel needs from you as Opponent

- Study the European file history and the cited prior art thoroughly
 - For best chances of success, always **supplement with fresh evidence**
 - **Non-patent literature** often proves useful and is generally looked on favourably by the EPO
- Consider providing **experimental data**
- Allegations of **prior public use** require substantive amounts of high-quality evidence

What your European counsel needs from you as the Proprietor

- Agree on a **budget** and a **strategy**
- Provide “fall-back” positions which would be acceptable
 - Don’t “tidy up” claim language
 - Don’t add dependent claims
 - Don’t make broadening amendments
 - Try not to use the description text as basis for amendments – use the claims
- Consider providing experimental data
- Consider a “worst-case scenario”

Oral proceedings



Oral proceedings

- A 1-day (sometimes 2-day) formal proceedings at the EPO
- 3-member panel of examiners – the opposition division
- All opponents and the patentee are invited
- Can be re-scheduled (in a limited number of situations)
- European patent attorneys represent the parties
 - If you choose not to be represented, oral proceedings will be conducted without you
 - Employees of the opponent/patentee may speak
 - Technical experts and inventors may speak
- Opposition oral proceedings are open to the public

Oral proceedings

- Discussion of the "grounds", one by one.
 - Presentation by the opponent(s)
 - Rebuttal by the patentee
 - Discussion
 - Pause for deliberation

Conduct of oral proceedings

	Main Request	1st Auxiliary Request	2nd Auxiliary Request	3rd Auxiliary Request	
Formal problems?		Yes			
Insufficient disclosure?	No				
Added subject-matter?					
Lack of novelty?					
Lack of Inventive step?					
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Conduct of oral proceedings

	Main Request	1st Auxiliary Request	2nd Auxiliary Request	3rd Auxiliary Request	Patent Revoked
Formal problems?					
Insufficient disclosure?					
Added subject-matter?					
Lack of novelty?					
Lack of Inventive step?					
	Patent Maintained				

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Appeal

- Any party “adversely effected” may file an appeal
- “*Notice of Appeal*” within 2 months of the Written Decision
- “*Grounds of Appeal*” within 4 months of the Written Decision
- + 4 month deadline for respondent to file observations
- Filing an appeal sets aside the decision of the opposition division
- 2½ - 3 year process, followed by oral proceedings before the Board of Appeal

Appeal

- Pure “review” instance
- Difficult to get new evidence and new objections admitted
- Work during opposition proceedings with one eye on the Appeal process

Questions/Discussion?

