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Opposition Proceedings
before the EPO



Introduction

Within the first nine months after grant, European patents can be attacked with an opposition before the European Patent Office (EPO). Opposition proceedings are ex parte proceedings before an opposition division of the EPO, in which the patent proprietor and the opponents are parties to the proceedings.

The filing of an opposition is a powerful weapon to attack European patents. It allows an attack on a European patent in a centralised

procedure before the EPO before the patent dissolves into national property rights in the validation states, which must then be individually attacked in each validation state in national invalidity proceedings.

This brochure is intended to provide an overview of the European opposition proceedings and the most relevant aspects of the proceedings for both patentees and opponents.

Formal Requirements

1

The grant of a European Patent may be opposed by any third party. No geographical restrictions, and virtually no restrictions with regard to the identity of the opposing party are imposed (the patentee herself cannot file an opposition against his own patent). If the opponent neither has his residence nor principal place of business in a Contracting State of the EPC, he has to be represented by a professional representative before the EPO.

2

The opponent may be a natural person or an entity. It is irrelevant whether the opponent is affected by the patent in any way. If the opposing party wishes to keep their actual identity secret, the opposition may be filed via a straw man.

3

The opposition must be filed in due time within nine months of the publication of the mention of grant of the European patent and must contain information on the identity of the opponent and the grounds for opposition. After the opposition has been filed in due time and a corresponding opposition fee has been paid, the opposition is examined with regard to formal requirements. If the formal requirements are met, the opposition proceedings are initiated.

Course of the Proceedings

Opposition proceedings before the EPO are predominantly written proceedings which end with oral proceedings in which the opposition division announces a decision with regard to the maintenance or revocation of the patent. The proceedings have been continuously streamlined and rationalised in order to ensure a speedy and predictable course of the proceedings. The average duration of opposition proceedings is currently just a little over 18 months from the end of the opposition period.

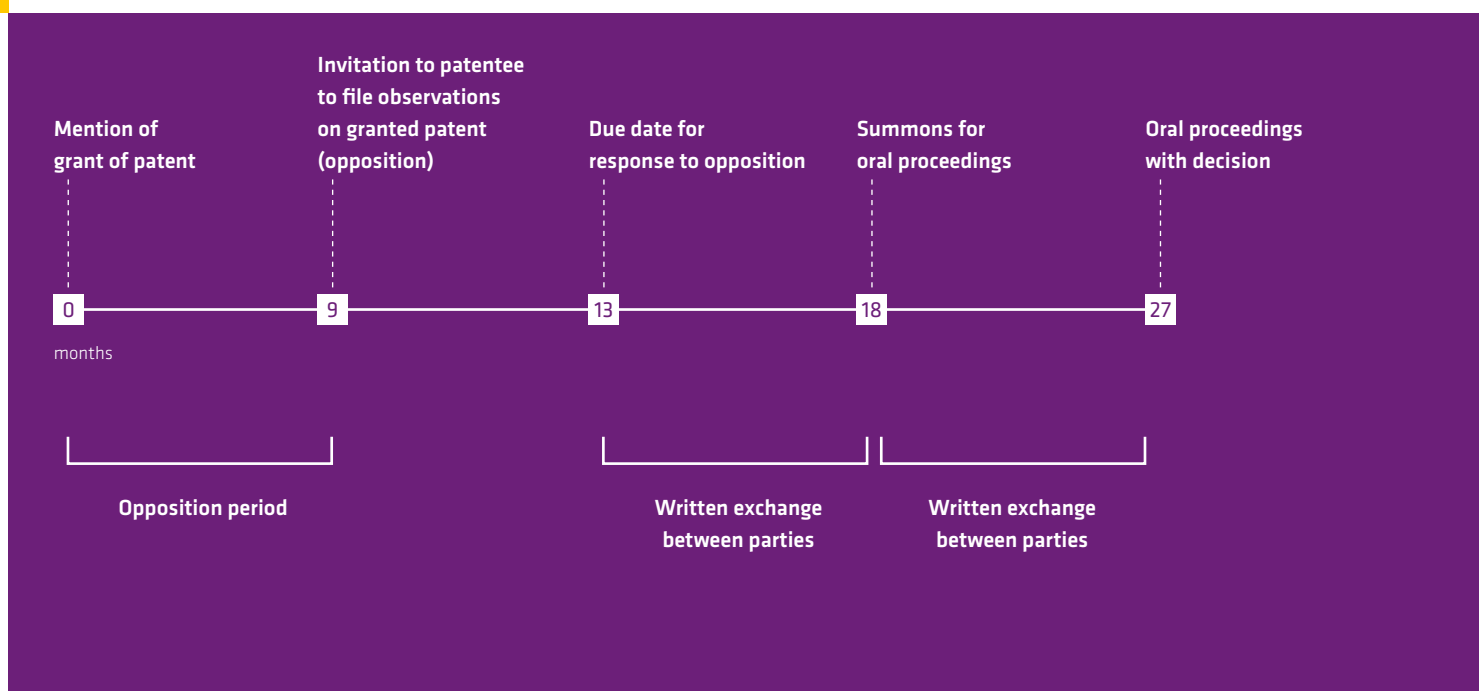
The opposition must be filed within nine months of the publication of the mention of grant of the patent. At the end of this opposition period, the patent proprietor is invited to submit written comments on the opponents' objections. A period of four months is set for this purpose, which may be extended only in exceptional and well-founded cases.

The opponent(s) may reply in writing to the patentee's observations. Depending on the number of opponents and the complexity of the case, the opposition division issues a summons for oral proceedings after one or two rounds of written exchanges between the parties. The date of the hearing is usually set seven to nine months after the summons.

The summons usually comprises a non-binding statement of the Opposition Division concerning their preliminary opinion with regard to the case. This opinion usually causes at least one of the parties to submit further written statements including amendments to the patent (patentee) and/or additional arguments (patentee, opponent). Such submissions may in turn lead to a further round of written exchanges between the parties. The opposition division therefore sets a deadline for the submission of written statements in the summons for oral proceedings, which is usually two months before the date of the oral proceedings.

At the oral proceedings the parties are given the opportunity to present their arguments on the grounds of opposition and to defend the patent. At the end of the oral proceedings, a final decision is issued by the opposition division.

After termination of the opposition proceedings an appeal against the decision of the opposition division can be filed. The course of the appeal proceedings is similar to that of the first instance opposition proceedings: after a first one or two rounds of exchange of written statements between the opponent and the patent proprietor, the Board of Appeal usually issues a summons to oral proceedings and a preliminary opinion. The EPO aims to conclude appeal proceedings within 30 months.





Costs

The opposition fee, which must be paid in due time with the filing of the opposition, is 815 €. No further official fees are due during in the further course of the opposition proceedings.

In opposition proceedings before the EPO, each party bears their own costs, irrespective of the outcome of the opposition proceedings. There is no provision for the losing party to be ordered to pay costs, as, for example, in German civil court proceedings.

The total cost of conducting opposition proceedings depends largely on the complexity of the case (including the number of oppositions filed). The complexity of the teaching of the challenged patent plays just as much a role as the question whether an obvious prior use is to be asserted.

If you have relevant prior art which can serve as a basis for an attack on a granted European patent and which you can make available to your European lawyers, the costs for the entire opposition proceedings at first instance will normally lie between 15,000 € and 25,000 €.

Grounds for Opposition

It is possible to oppose the grant of a European Patent only via the Grounds of Opposition elaborated in Art. 100 EPC:

- a the subject-matter of the European patent is not patentable under Articles 52 to 57 EPC (in particular not novel and/or inventive);**
- 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.**

Lack of Clarity of the claims in the patent is not a ground for opposition. Amendments to the patent that are filed during the opposition proceedings may be examined for clarity under certain circumstances.

An opposition should be based on facts and evidence which support the grounds of opposition. This applies in particular to the grounds of opposition for lack of novelty and inventive step, which must be supported by appropriate evidence of the known prior art.

There is no restriction as to the form of the evidence submitted. The only condition is that it must have been available to the public before the earliest priority date of the patent against which opposition is filed.

As evidence, for example, the following may be submitted:

- Pre-published patent applications, irrespective of their original language;
- Pre-published scientific or technical literature, which was freely available;
- Newspaper or magazine articles;
- Previous prior use of products anywhere in the world.



Novelty may also be opposed on the basis of an obvious prior use of the invention. An alleged obvious prior use must be sufficiently substantiated for a successful attack on a patent. Examples of evidence of obvious prior use are:

- Sales receipts;
- actual products which are submitted for inspection by the Opposition Division;
- proof of tours of facilities and what was on display;
- proof of the disclosure of products and/or technical details on exhibitions or conferences;
- proof that a prior use product was exhibited and demonstrated at trade fairs;
- sworn statements in writing from company representatives indicating what was sold or available;
- offering the testimony of witnesses or parties.

The onus of proof of prior use lies with the opponent. Depending on the facts and circumstances of the case, one of two levels or standards of proof will be applied:

- If the evidence to prove obvious prior use is available to both the patentee and the opponent, the opposition division will assess what has in all probability happened ("balance of probabilities").
- In cases of obvious prior use in which only the opponent has access to the evidence (for example, because the opponent himself has performed the prior use of the invention), the stricter standard of proof of "up to the hilt" or of seamless proof is applied.

In order to successfully claim an obvious prior use, the evidence of obvious prior use should be as seamless as possible, showing all circumstances of the alleged prior use (What? When? Where? How? To whom?).

All facts and evidence on which the opposition is based should be introduced into the proceedings as early as possible - ideally as early as the filing of the opposition. The later facts and evidence are submitted, the greater the likelihood that the opposition division will reject them as late-filed. In this respect, the opposition divisions apply a strict standard in order to maintain procedural economy.

Defense Strategies of the Patentee

After expiry of the opposition period, the patentee is invited to file observations on the oppositions filed. In doing so, the patentee may present arguments against the opponents' claims. However, if at least one ground of opposition is substantiated, the patentee may have no choice but to amend the granted claims to overcome the substantiated objections.

Claim amendments may be filed in the form of a series of auxiliary requests which are examined by the opposition division in the order indicated by the patentee. This ensures that the scope of protection of the patent is limited only as far as necessary.

The possible amendments of claims are not limited to the combination of granted claims. Amendments may be based on the entire disclosure of the patent. However, such amendments must result in claims which meet all the requirements of the EPC (except the requirement of unity).

It should be noted that amended claims are examined in opposition proceedings for the requirement of clarity (Article 84 EPC) if features from the description are included in the amended claims, although lack of clarity is not a ground for opposition.

On the patentee's side, it should also be noted that amendments to granted claims in opposition proceedings are subject to further restrictions which do not apply in the application proceedings prior to grant. These additional restrictions may create unavoidable traps for the patent proprietor which cannot be remedied in the opposition proceedings and may lead to an inevitable revocation of the grant of the challenged patent.

If the subject-matter of the granted claims extends beyond the content of the underlying application as originally filed, it may be necessary to amend the claims in order to bring the claims into line with the content of the underlying application (Art. 123(2) EPC). At the same time, amendments to claims once granted must not result in an extension of the scope of the patent (Art. 123(3) EPC).

In some cases, this may mean that the patent cannot be amended without infringing either of these two provisions. It is therefore important to ensure that the granted claims do not lead the patentee into the inescapable trap in opposition proceedings as described above.



The strict rules on late filing in opposition proceedings also apply to the patentee. If it is not promising to defend the patent as granted, amendments of the claims should be filed as early as possible in the proceedings, since late filed amendments may be rejected as late-filed.

According to the case law of the Boards of Appeal, amendments to the patent filed as a direct and immediate reaction to an amended opinion of the Opposition Division must be taken into account and cannot be rejected as late-filed (T 0754/16). This applies in particular to requests filed at the oral proceedings if the Opposition Division deviates from a preliminary opinion which was issued before the oral proceedings and found at least some of the claims already filed in the proceedings to be patentable.

In summary, amendments to claims should be filed at the latest in response to the invitation to the oral proceedings if the opposition division, in its preliminary opinion, comes to the conclusion that the patent as granted cannot be maintained.

On the part of the patentee it should also be noted that the amended Rules of Procedure of the Boards of Appeal, which entered into force on 1 January 2020, make it considerably more difficult to introduce new amendments of claims into the proceedings in the appeal instance. On the patentee's side, therefore, all amendments of claims which are in principle suitable for a defense of the patent should be introduced into the proceedings already in the opposition proceedings at first instance.



Summary

Opposition proceedings before the European Patent Office represent a well-established route for initiating a centralised action against the grant of a European patent before separate nullity actions would have to be brought against each national part of the European patent.

The centralised attack before the EPO is also advantageous with regard to the incurred costs, since the costs of separate nullity actions in the countries where the European patent is validated exceed the costs of the centralised opposition proceeding before the EPO many times over.

Successfully defending a European patent in opposition proceedings before the EPO significantly increases its value and strengthens its legal effect in potential infringement proceedings.

The opposition proceedings before the EPO have recently been considerably streamlined both for first and second instance. It is therefore essential for both the opponent and the patentee to present arguments, evidence and claim amendments as early as possible during the proceedings in order to avoid rejections for late-filing. At the same time, the streamlining of the procedures yields an efficient and well predictable course of the proceedings, which in the first instance usually leads to a decision on maintenance or revocation of the patent already approximately 18 months after the end of the opposition period.

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