European Patent Opposition Proceedings
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Any European patent newly granted by an Examining Division of the European Patent Office (EPO) can be challenged to obtain its revocation, or at least its limitation. To this end, the European Patent Convention provides the possibility to file an opposition against the patent. This leads to opposition proceedings, a special inter partes procedure before the EPO, the main aspects of which are presented in this brochure.
1. Initiating opposition proceedings

Opposition proceedings may be initiated against a European patent within nine months after publication of the mention of its grant. Since no legal interest of the opponent has to be proven, an opposition may be filed by any natural or legal person. Moreover, an opposition may be filed by a “straw man”, i.e. a person having no real interest in the outcome of the proceedings but only acting for another – unknown – third person.

Oppositions are typically filed in reaction to a national patent infringement action or – since the costs are relatively low – as a precautionary means against potentially dangerous patents of competitors.

An opposition is heard in first instance by an Opposition Division of the European Patent Office in Munich or Berlin, Germany, or The Hague, Netherlands. After an opposition has been filed, the competent Opposition Division is determined in accordance with the technical field of the case. An Opposition Division generally consists of three technically qualified members with several years of experience in the examination of patents. The Division may be enlarged by a legal member if complex legal questions are to be decided. For example, for taking evidence on an alleged prior public use, a legal member is generally called upon to support the Opposition Division.

2. Grounds for revocation

A European patent may only be opposed on the grounds that:

- the subject-matter of one or more of the claims is not patentable, in particular not new or not inventive;
- the 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; and
- the subject-matter of the patent extends beyond the content of the application as filed.

Other grounds of opposition are not admissible. In particular, an opposition may not be based on the grounds that the wording of the claims lacks clarity, or that the claimed invention was “stolen” from the opponent or a third party by the patent proprietor.

The grounds of opposition must be raised by an opponent before the expiry of the opposition period. The introduction of new grounds of opposition after the expiry of the opposition period is subject to procedural restrictions. In first instance proceedings, a new ground of opposition may be examined if the Examining Division considers it as prima facie relevant.
3. **Course of first instance proceedings**

Although an opposition may be filed immediately after grant, the Opposition Division starts examination of the opposition, as a rule, only after expiration of the nine months opposition period.

The subsequent procedure may vary significantly from Division to Division and from one technological field to another. Most opposition cases may be expected to be decided in first instance within about two years. During this period, a written exchange of briefs takes place. If requested at least by one party, which is the rule, the Opposition Division summons the parties to oral proceedings. The summons includes a non-binding preliminary opinion of the Opposition Division. The preliminary opinion gives the parties an indication of the issues considered to be relevant and to be discussed during oral proceedings, or even a preliminary assessment of the case by the Opposition Division.

The Opposition Division considers the legal questions of the case and evaluates the facts on its own motion (*ex officio*). However, the Opposition Division is bound to the extent to which the patent has been opposed. For example, if the opposition attacks only certain independent claims, other independent claims of the granted patent are not to be examined.

Opponents should cite all known evidence and, in particular, all known prior art against the patent under opposition before the expiry of the opposition period. After expiration of the opposition period, the admission of new facts and evidence is subject to the discretion of the Opposition Division which is, at the first stage of the proceedings, primarily exercised on the basis of the relevance of the material. However, the discretion is exercised in a restrictive manner after the time limit has lapsed which is set in the summons to oral proceedings.
An exemplary and typical course of first instance opposition proceedings is shown in the following diagram:
The patent proprietor may defend the opposed patent in the form as granted or in a limited version. Amendments may be chosen from the whole content of the original patent application’s disclosure as long as the scope of protection is not extended beyond the granted patent’s scope of protection. Amendments of the patent need to be occasioned by a ground of opposition. This means, opposition proceedings must not be used to reformulate the claims or the description of the opposed patent for clarity or cosmetic reasons only or in order to adapt them to embodiments used by competitors.

The patent proprietor may defend the patent in different versions on the basis of a main request and one or more auxiliary requests. An auxiliary request is considered only under the condition that the main request or a higher ranking auxiliary request is found not to meet the requirements of the European Patent Convention. The submission of new requests is procedurally limited. Requests submitted in oral proceedings are, as a rule, not admitted unless they can be readily discussed by the panel and the opponent, or if they are a reaction to a new objection made in the oral proceedings. This means, as a rule, that primarily only small, particularly editorial amendments may be made during oral proceedings.

At the end of the oral proceedings, which typically take one sometimes two days, the Opposition Division deliberates and issues its decision, *i.e.* either a full revocation of the patent, a limitation, or the maintenance of the patent as granted. Every year, oppositions are filed against about 2,500 to 3,000 patents which corresponds to about 5% of all granted patents. From the official statistics of the European Patent Office, it appears that over the years roughly equal numbers of the opposed patents are fully revoked, maintained in amended form and maintained as granted, however with an increasing tendency of negative results.

### 4. The appeal proceedings

Any party adversely affected by the decision of the Opposition Division may appeal within a non-extendible time limit of two months after receipt of the written decision of the Opposition Division. The appeal has to be reasoned within another non-extendible time limit of two months. It is handled by a competent Technical Board of Appeal of the EPO.

Presently, there are 28 Technical Boards of Appeal plus one Legal Board of Appeal. A Technical Board of Appeal generally sits as a panel of two technically qualified members and one legal member, most having long years of experience in opposition proceedings. Under certain circumstances, in particular if the Opposition Division had four members, the Board of Appeal consists of three technical and two legal members.

According to the Rules of Procedure of the Boards of Appeal, the statement of grounds of appeal shall contain the appellant’s complete case, including all legal and technical arguments as well as any modified main and auxiliary requests.
Thereafter, the appeal procedure follows a similar course as the first instance procedure. This is illustrated in the diagram below:
In appeal proceedings, the Boards of Appeal exercise their discretion to admit new facts, evidence or requests considering the relevance of the submissions, their complexity, the current state of the proceedings and the need for procedural economy. Submissions which could have been made or have been rejected in first instance proceedings may be rejected. Late submissions, requiring the cancelling or postponement of oral proceedings can, as a rule, not be expected to be admitted.

At the average, the Technical Boards of Appeal take another two or two and a half years to hear the case, the length of proceedings substantially differing in different technical fields. In exceptional cases, in order to ensure a uniform application of the law, or if an important point of law arises, a Technical Board of Appeal may refer, on its own motion or on the request of a party, a question of law to the Enlarged Board of Appeal of the European Patent Office.

5. Procedural principles

Opposition proceedings are contradictory inter partes proceedings between one or more opponents and the patent proprietor, similar to regular court proceedings. They are governed by the European Patent Convention (EPC), by the Implementing Regulations and by the Guidelines (Part D). In addition, the appeal procedure before the Technical Boards of Appeal follows the Rules of Procedure of the Boards of Appeal. The Boards of Appeal are not bound to apply the Guidelines.

In opposition proceedings each party may use any of the three official languages of the European Patent Office, namely English, German or French. Oral proceedings are held in the language of the proceedings, which is the language in which the application resulting in the opposed patent was published by the EPO. Nevertheless, each party may express itself in any of the three official languages. To this end, interpretation between the three official languages is provided, at no extra cost for the parties, on prior request of any party. Communications from the Opposition Divisions and their final decisions are, however, always issued in the language of the proceedings.

The Opposition Divisions and Technical Boards of Appeal of the European Patent Office decide opposition cases based on their own technical expertise. Whereas the law allows the appointment of an expert, if required, the taking of evidence by appointing a technical expert is actually rarely ordered ex officio. However, the parties may present their own private experts, who may submit their opinions in writing and also, upon prior notice to the EPO, at oral proceedings.
In European opposition proceedings, a party may be represented by a professional representative admitted to practice before the European Patent Office, in particular by a European Patent Attorney.

A very important aspect of opposition proceedings is that, although the opposition may be withdrawn at any time by the opponent, such withdrawal does not necessarily terminate the opposition proceedings. The Opposition Division may continue the proceedings on its own motion and issue a decision within the framework of the original opposition. This particularity of the European opposition proceedings must be taken into account in settlement considerations between opponent and patent proprietor, since an opposed patent may still be revoked although the opponent has withdrawn his opposition and no longer participates in the proceedings. The withdrawal of the (only) appeal will, however, terminate the second instance opposition appeal proceedings.

6. Parallel infringement procedures

A defendant in patent infringement proceedings may intervene in pending opposition proceedings within three months from the institution of infringement proceedings. In this case, the defendant is obliged to accept the opposition proceedings in the stage they are in at the given time. However, he may introduce new grounds of opposition and submit new facts and evidence.

If there is no pending opposition procedure, the defendant in patent infringement proceedings needs to strategically consider whether an opposition within the nine-month period should be initiated (if this is still possible), or whether national invalidity proceedings are started against the national part of the patent that is enforced.

Sometimes, it is more promising to attack the national part. For example, the German Federal Patent Court, having jurisdiction for all patent invalidation proceedings against German patents and the German parts of European patents, generally applies a somewhat higher hurdle of inventive step than the European Patent Office in European opposition proceedings. However, an action for revocation in Germany is only possible if no opposition is pending at the European Patent Office. Thus, a certain risk exists that a third party may file an opposition at the end of the opposition period which would have the effect that no German nullity suit may be filed until a final decision in opposition and, as the case may be, in opposition appeal proceedings is issued by the European Patent Office. Deciding on this strategic issue generally requires – apart from a clear understanding of the pros and cons – early communication and
coordination with competitors potentially being affected by the same patent.

Parties being involved in patent infringement proceedings may request the acceleration of the opposition proceedings and of the subsequent appeal proceedings.

In Germany, patent infringement proceedings may be stayed at the request of the defendant, if the infringement court considers it to be very likely that the patent will be revoked in the opposition proceedings. The decision on a stay of the infringement proceedings is a discretionary decision of the infringement court, without any binding or prejudicial effect on the decision in the opposition proceedings (see also our firm’s brochure on Patent Infringement Proceedings).

If German patent infringement proceedings are pending, submissions in the opposition proceedings need to be coordinated with submissions in the infringement proceedings. While patent infringement proceedings need to be handled by an attorney-at-law (Rechtsanwalt), opposition proceedings are regularly handled by a European Patent Attorney who may support the attorney-at-law in the patent infringement proceedings as well. Our law firm offers both professions in one firm: Qualified attorneys experienced in both types of litigation in first and second instances, with the highest level of technical and legal qualification.

7. Costs

In European opposition proceedings, each party generally bears its own costs, including the official fees for filing the opposition or an appeal. However, an apportionment of costs may exceptionally be ordered, particularly in cases where an abuse of procedure has taken place and the adversary party had to bear superfluous costs. Such a case may, for example, arise if a party does not inform the EPO in due time that it does not intend to be represented at appointed oral proceedings.

Typical attorneys’ fees for the representation of a client in opposition proceedings at the European Patent Office range from EUR 15,000 to EUR 50,000 for each instance, depending on the technical and legal complexity of the case. Travel expenses, disbursements for translations and private experts have to be added, as well as moderate official fees for filing the opposition or the appeal.

If a European patent has been maintained in opposition proceedings in amended form, it must be re-validated in all designated states, requiring the submission of a translation of the granted patent, in which it was initially validated, if patent protection is to continue to exist in these states. This leads to further costs.
8. Effects of opposition

A decision in opposition proceedings is retroactively effective in all states where the opposed patent is valid. By contrast, national patent invalidity proceedings, which are the only option to challenge the validity of a European patent after the expiry of the opposition period (or a terminated opposition procedure) may lead to results which differ from country to country.

9. Summary

European opposition proceedings are an effective tool, both as precautionary means against the market threat of potentially dangerous patents of competitors and as a reaction to a patent infringement action. The complexity, however, of an opposition procedure and an appeal procedure, only the essentials of which have been explained above, requires an in-depth knowledge and experience in front of the Opposition Divisions and the Technical Boards of Appeal of the EPO. The European patent attorneys of our firm are regularly presenting cases in opposition proceedings, both for patentees and opponents and can therefore maximize the chances of success be it for defending or attacking a European Patent.
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