European Patent Opposition Proceedings

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IP Brochure

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.

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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 filed in reaction to national patent infringement actions. However, due to the relatively low costs, the majority of oppositions are filed 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, Germany, or The Hague, Netherlands – rarely also in Berlin. 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 novel or not inventive;
- the patent does not disclose the invetion 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 certain 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 proceeding

First instance opposition proceedings were streamlined with new rules taking effect on July 1, 2016. After expiry of the opposition period, the EPO sets a four-months deadline for proprietor to respond to the opposition(s). If considered necessary, the parties are invited to submit further replies within a specified time limit.

Most opposition cases may be expected to be decided in first instance in less than 18 months. During this period, the 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, theadmission 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:

Patent Proprietor	Publication of European Patent				Proprietor files first response with amendments
Opposing Party/ Patent Office		Filing of opposition	Expiration of opposition period	Opposition division sets extendable deadline for response of proprietor	
	Oct 26, 2022	July 25, 2023	July 26, 2023	Sept 1, 2023	Jan 10, 2024
			YEAR 1		

Patent Proprietor			Proprietor files final response brief including auxiliary request	
Opposing Party/ Patent Office	Opponent files response brief to reply of proprietor	Opposition division summons for oral proceedings including an preliminary opinion		Oral proceedings take place; patent is maintained in amended form
	Feb 12, 2024	Mar 20, 2024	Nov 14, 2024	Jan 15, 2025
	YEAR 2			

The patent proprietor may defend the opposed patent 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 or 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. Due to the COVID-19 pandemic, oral proceedings will be held exclusively by video conference until at least December 31, 2022.

Every year, oppositions are filed against about 4.000 patents which corresponds to about 4% 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 time limit of two months after receipt of the written decision of the Opposition Division. The appellant has an additional two months to submit their reasoning. The time limits are not extendible. The appeal 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, particularly 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. In particular, the appeal must deal with the appealed decision and may be rejected as inadmissible if that is not the case.

Afterwards, the course of the appeal proceedings are similar to that of the first-instance proceedings. They are illustrated in the diagrams below.

Patent Proprietor			Proprietor files appeal	Proprietor files appeal reasoning including auxiliary requests	
Opposing Party/ Patent Office	Oral proceedings take place; patent is maintained in amended form	Decision of the opposition division is sent to the parties			Opponent files first reply brief
	Jan 15, 2024	Feb 11, 2024	Apr 15, 2024	June 21, 2024	Oct 20, 2024
YEAR 2			YEAR 3		

Patent Proprietor	Proprietor files response brief to the reply of opponent			Proprietor files second response brief in reaction to brief of opponent	
Opposing Party/ Patent Office		Board of appeal summons to oral proceedings	Opponend files a second response brief		Oral proceedings take place; patent is maintained as granted
	Feb 15, 2025	June 16, 2025	Nov 20, 2025	Dec 16, 2025	Jan 16, 2026

YEAR 4

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. It would therefore be wrong to regard the proceedings before the Opposition Division only as a trial run for the appeal proceedings. Patent proprietors and opponents would therefore be well advised to bring all their pleas in law and defense before the first instance. The Boards of Appeal are becoming increasingly strict in their tendency to see themselves first and foremost as reviewing bodies and, accordingly, to reject arguments that would put the case on a new footing. This applies in the same way to new versions of claims as to new state of the art or other evidence.

On 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. While 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 proceed- ings is that, although the opponent may withdraw the opposition at any time, 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 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 their 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, they 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 should be 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 is rendered in opposition and, as the case may be, in opposition appeal proceedings 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 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 IP 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, 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.

If a European patent has been maintained in opposition proceedings in amended form, it must be revalidated 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 regularly present 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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