

## NEWSSTAND

### The Opposition Procedure before the European Patent Office

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In Europe, there is an Opposition procedure which can be used to challenge the validity of granted patents before the EPO. This procedure is centralised, which means that a successful challenge will be effective in all of the European contracting states covered by the granted patent. It has been estimated that Oppositions are filed against about 5% of granted European patents, which corresponds to about 3000 per year. The Opposition procedure is a well used and important tool for attacking a European patent in a cost effective manner.

#### Grounds for Challenging Validity

A European patent can be challenged on the grounds that, at least: (i) the claimed invention is not patentable (ie. it is not novel and/or inventive); (ii) the patent insufficiently describes how to perform the invention; or (iii) the granted patent contains new matter that extends beyond the scope of the filed application.

#### Preparing an Opposition

A Notice of Opposition must include a written reasoned statement indicating the facts, the evidence, and the arguments relied upon. An Opposition fee must also be paid. The Notice and fee are due within nine months of the publication of the grant of the European patent. If these requirements are not fulfilled within this time frame, then the opportunity for using the centralised Opposition procedure will be lost. The only option then is to challenge the validity of the patent nationally in one or more of the designated contracting states. This will be much more expensive and time consuming.

Importantly, the Notice of Opposition should also include in it a request for Oral Proceedings in the event that the EPO is not minded to revoke the opposed patent in its entirety. This affords the opportunity for the parties to verbally argue their case at the EPO before a decision is reached.

#### Evidence and Arguments

The likelihood of success of the Opposition will depend upon the strengths and weaknesses of the arguments that are filed in the Notice. Whilst additional arguments can be filed at a later stage, the Opposition Division may not accept such late arguments and, therefore, all of the arguments and evidence should be contained in the Notice of Opposition.

To attack the patentability of the invention, it is necessary to submit prior art documents (e.g., journal papers, patent applications, and the like) in order to argue that the alleged invention lacks novelty and/or an inventive step. Often a good source of documents is the prosecution history of corresponding applications in other countries. The patent offices of those countries might also have searched and examined the applications, which may uncover additional documents and/or arguments that have never been considered by the EPO. Internet-based searches and even searches of publicly available company materials may also be useful sources of prior art.

It is also worth carefully considering whether or not the skilled person is enabled to carry out the claimed invention. Whilst insufficiency of disclosure is always a tempting ground for opposing a patent, the EPO has placed the burden of proving this firmly on the opponent and so evidence (e.g., experimental data or supporting documents and the like) will often be required to support such arguments.

A careful review of the prosecution history may also give rise to an attack on the ground of “added matter” within the application. New matter that was not disclosed in the application as originally filed may have been inadvertently introduced into the claims during prosecution in order to secure its grant. This may now provide an invaluable hook upon which to hang an added matter attack. This objection may sometimes be incurable if the only available amendment is one which extends the scope of protection since this is not allowable under the provisions of the European Patent Convention. Thus, this ground may result in the complete revocation of the patent with no way for the patentee to cure the problem. It can therefore be a very powerful ground of attack.

### **Examination of the Opposition**

Assuming that the Opposition is admissible before the EPO, the Opposition Statement will be forwarded to the patentee for comment. An extendable term of four months is normally provided within which counter-arguments and optionally, amended claims, may be filed. The opponent will receive a copy of the patentee’s response upon which they may also comment. In fact, any number of further observations from the patentee or the opponent can be filed until such time as the Opposition Division decides that they are able to reach a decision or issue a summons to oral proceedings. This process can take between two and three years.

The summons usually includes a preliminary and non-binding opinion from the Opposition Division, which includes an indication of the issues that they consider should be discussed. The Opposition Division typically comprises three EPO examiners, one of whom is usually the examiner who dealt with the case during its prosecution.

At the Oral Proceedings, after hearing the parties’ arguments, a decision will be reached, which will be one of the following: to revoke the patent; to maintain the patent as granted; or to maintain the patent in amended form. After a few months, a written decision outlining the Opposition Division’s reasoning for their decision will be issued. This decision can be appealed to the EPO’s Board of Appeal by any of the parties adversely affected by the decision. It should be noted that it is possible to file the Opposition anonymously and/or to request acceleration of the proceedings, which may be of importance in certain situations.

### **Appeals**

A Notice of Appeal must be filed within two months of receipt of the EPO’s written decision. A fee for appeal must also be paid. A reasoned statement of the Grounds of Appeal must be filed within a further two-month period. The Board of Appeal operates independently from the Opposition Division. Unlike the largely administrative and technical procedure of the Opposition Division, the Board of Appeal tends to focus more heavily on the legal issues and is able to make new case law. This case law develops the practice and procedure of the EPO. The Board of Appeal is able to overturn or uphold a decision of the Opposition Division. If the decision is overturned, then any remaining grounds of Opposition may be remitted back to the Opposition Division for further consideration. If the Board revokes the patent, there is only a very limited opportunity for further appeal.

### **Enlarged Board of Appeal**

It is possible to file a ‘petition for review’ of the Board of Appeal’s decision to the Enlarged Board, which is the highest level of authority within the EPO. The petition for review is a relatively new provision and so the metes and bounds of its applicability have not been broadly tested thus far. It is likely, however, that this provision will only be of use in very limited circumstances – such as an abuse of procedure.

It is also possible for the Board of Appeal to remit questions on important points of law to the Enlarged Board of Appeal.

### **Conclusion**

Oppositions before the EPO have become an invaluable and relatively inexpensive tool for attacking European patents, the grant of which may, for example, interfere with a business’ plans for access to a particular technology. Furthermore, the possibility of using the Notice of Opposition before it has been filed “as a tool to reach an agreeable solution with the patentee” should also not be overlooked. Similarly, it may be possible to force negotiations with the patentee even during

the Opposition proceedings in which case the Opposition may be withdrawn during the proceedings if a settlement is reached. The offensive value of the procedure should therefore not be overlooked. The procedure also reinforces the need to maintain a watch on the patenting activities of competitors in view of the minimal nine month window within which a Notice of Opposition can be validly filed before the EPO.