The opposition procedure and limitation and revocation procedures

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26-30/11/2012
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Introduction
What is an opposition?

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- Allows public to challenge grant of patent it considers to have been wrongly granted
- May result in limitation or revocation of patent
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- Infringement
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Procedure up to grant

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Applicant

Opposition division

Proprietor

Opponent

Opponent

Opponent

Code of conduct

inter partes

ex parte
Opposition under the EPC

- Uniform, centralised procedure
- Allows public to limit or revoke European patents which it believes to have been wrongly granted
Opposition under the EPC: when?

- EPO grant procedure
- Publication of mention of grant
- 9 months
- Effect as national patent
- Patent
- Opposition
- Examination of opposition
  1. Maintenance in amended form
  2. Rejection of opposition
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Oppositions in 2010

- 58,100 European patents granted
- 5.2% opposed
- Over one-third of all opposed patents revoked
Percentage of granted patents opposed, by field
Percentage of granted patents opposed, by origin

- DE: OPPO 30%, EPPU 25%
- FR: OPPO 5%, EPPU 3%
- GB: OPPO 5%, EPPU 3%
- CH: OPPO 2%, EPPU 1%
- IT: OPPO 2%, EPPU 1%
- NL: OPPO 1%, EPPU 0.5%
- JP: OPPO 20%, EPPU 15%
- US: OPPO 25%, EPPU 20%
Oppositions filed online

Development of Online Filing
(January 2003 - October 2011)
Legal framework
Legal framework

EPC

Opposition procedure
  Articles 99-101, 103-105  Rules 75-86

Opposition division
  Article 19

Common provisions
  Articles 113-117  Rules 115-124
Note: Within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office of opposition to that patent, in accordance with the Implementing Regulations. Notice of opposition shall not be deemed to have been filed until the opposition fee has been paid. (Art. 99(1) European Patent Convention).
## Grounds for opposition

| Article 100 | (a) Not novel  |
| Art 52-57  | (a) No inventive step |
| Art 52-57  | (a) Not industrially applicable |
| Art 52-57  | (a) Excluded, excepted |
| (b) Insufficiently disclosed | Art 83 |
| (c) Amended beyond original disclosure | Art 123(2) |

**NOT** lack of clarity or unity
Article 101 EPC

Article 101(1)
- Opposition division
- Communicates with parties
- Examines opposition

Article 101(2)(3)
- Decision
  - Revocation
  - Rejection of opposition
  - Maintenance in amended form

Rule 79
Rule 81
Procedure
Filing an opposition

- Any person* may file an opposition
- Within 9 months of publication of mention of grant
- Written reasoned statement required
- Fee to be paid

- Parties
  - proprietor
  - opponent

* G 3/97: except proprietor
Overview of procedure after filing

- Formalities stage
- Allocation to an opposition division
- Examination and communications
- Decision

Art. 101(2) and (3)
**Formalities stage**

Receipt of notice of opposition

- **R. 79(1)**

Deemed filed

- Copies to proprietor
  - fee in time Art.99(1)
  - fax confirmed
  - signatures
  - translations
  - representative

Admissible?

- no
  - Inadmissible
  - not within 9 months
  - insufficient identification
  - no statement of extent R. 76(2)(c)
  - no grounds R. 76(2)(c)
  - no facts/evidence/arguments R. 76(2)(c)

Allocation to opposition division

Guidelines D-IV
The notice of opposition

• Must meet the requirements of Art. 99(1) and Rule 76

• Core issues: what and why? Rule 76(2)(c)

• The notice of opposition shall contain:

  • (c) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds
Rule 76(2)(c)

- **Extent:** What is opposed? The entire patent or only parts or embodiments thereof? All the claims, or just some of them?

- **Grounds:** Opponent must cite at least one of the grounds under Art. 100, if only implicitly (T 653/99).

- **Indication:** The "indication" as a whole must serve to **substantiate** the attack/attacks mounted.

  - This makes the issue of **substantiation** a central and important element of any opposition and one that requires careful consideration and attention.
  - What is required is a **clear and coherent** presentation of the case made, enabling the proprietor and the opposition division to understand the objections without undue burden and on an objective basis, and hence to be in a position to respond.
Facts/arguments/evidence

- Facts and evidence filed late during opposition proceedings are only exceptionally admitted if *prima facie* relevant.
- Opponent must indicate which part of the documents opposition is based on.
- Opposition based on prior use: Notice of opposition must indicate *when, where, what* and *how*. Detailed evidence of prior use may be filed later.
- Evidence can be produced after expiry of the opposition period.
The opposition division

- Art 19

- Chairman
  - Conducts oral proceedings
  - Has the casting vote

- 1st member
  - Does groundwork
  - Issues communications
  - Takes decision

- 2nd member
  - Takes minutes

- Legal member
  - Hears witnesses

If necessary:

- No more than one member - NOT chairman - may have been involved in procedure up to grant.
**Procedure: general provisions**

**Art. 113(1)**

right to be heard

Basis for decision: only on grounds a party has had opportunity to comment on

**extent of examination**

not restricted to facts/arguments/evidence of parties (own motion)

Late submissions may be disregarded

**Art. 114**

**Art. 116**

oral proceedings

at request of parties

public before opposition division
The examination stage

Admissible?

Substantive examination

- Route 1
- Route 2
- Route 3

Communication to parties

Oral proceedings

Decision

Art. 113(1)
Amendments

Proprietor may amend claims but only to address grounds for opposition.

Amendments must comply with the EPC

- Arts. 52-57
- Art. 84
- Art. 123(2)
- Art. 123(3)

The right to amend should not be used to tidy up and improve the disclosure of the patent (T 127/85).
Final stage

Decision

Revocation

Revocation

Rejection of opposition

Final

Opponent

Proprietor

Art. 101(2)(3)

Maintenance in amended form

Interlocutory

Proprietor/opponent

Art. 106

Appeal

Art. 104

Apportionment of costs

Printing fee and translation Rule 82(2)
Oral proceedings

Article 116

Rule 115
• Summons
• Non-appearance

Rule 116
• Invitation
• Final date for submissions

Rule 124
• Minutes

Rule 4
• Language

Taking of evidence
Conduct of oral proceedings

Preparation
- Authorisations
- Late submissions
- Language requests
- Parties attending

Oral proceedings
- Opening
- Main phase
- Decision

Code of conduct

Minutes

Rule 111

Notification of decision
Intervention of the assumed infringer
Article 105

(1) Any third party may, in accordance with the Implementing Regulations, intervene in opposition proceedings after the opposition period has expired, if the third party proves that

(a) proceedings for infringement of the same patent have been instituted against him, or

(b) following a request of the proprietor of the patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent.

(2) An admissible intervention shall be treated as an opposition.

→ The intervener acquires the status and rights of an ‘normal' opponent.
Observations by third parties
Article 115 EPC

- Third party may not be a party to the proceedings.

- Observations possible at all times before the EPO, but only have effect if proceedings are pending.

- They are added to the file [public under Art. 128(4)] and are taken into account by the opposition division (in opposition proceedings).
Request for limitation or revocation
Article 105a-c

- A central administrative procedure introduced with EPC 2000.

- Open to the proprietor at any time after the grant of the patent. Pending opposition proceedings take precedence - Art. 105a(2).

- The limitation or revocation will take effect ex tunc, i.e. from the outset - Art. 68.

- The procedure is ex parte and designed for rapid processing by the EPO (< 2 months).

- Must include amended claims that are limited in scope, but patentability of the resulting patent will not be examined.

- Solves the problem of non-permitted "self-opposition" (G 9/93).
Thank you for your kind attention