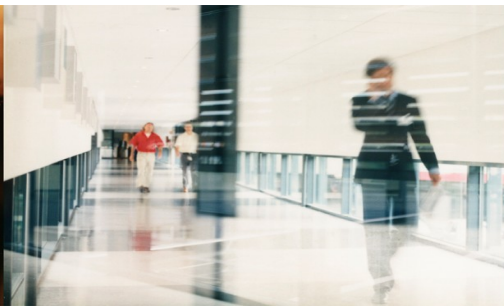


The opposition procedure and limitation and revocation procedures

Closa Daniel

Beaucé Gaëtan

26-30/11/2012





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- Introduction
- Legal framework
- Procedure
- Intervention of the assumed infringer
- Observations by third parties
- Request for limitation or revocation



Introduction

What is an opposition?

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

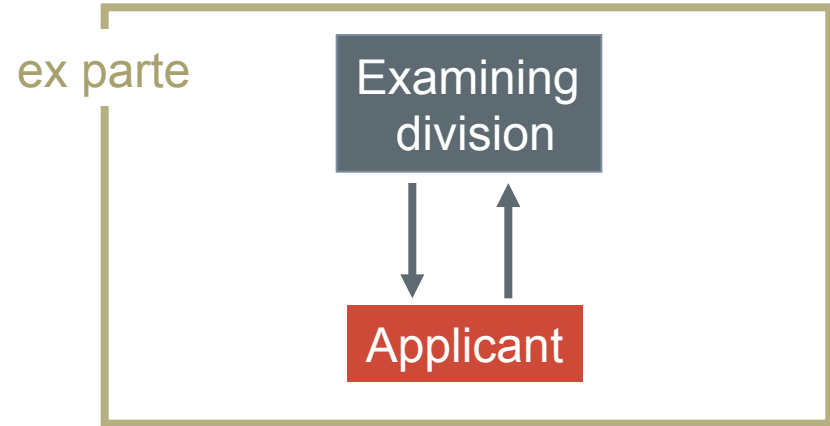
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Reasons for opposing a patent

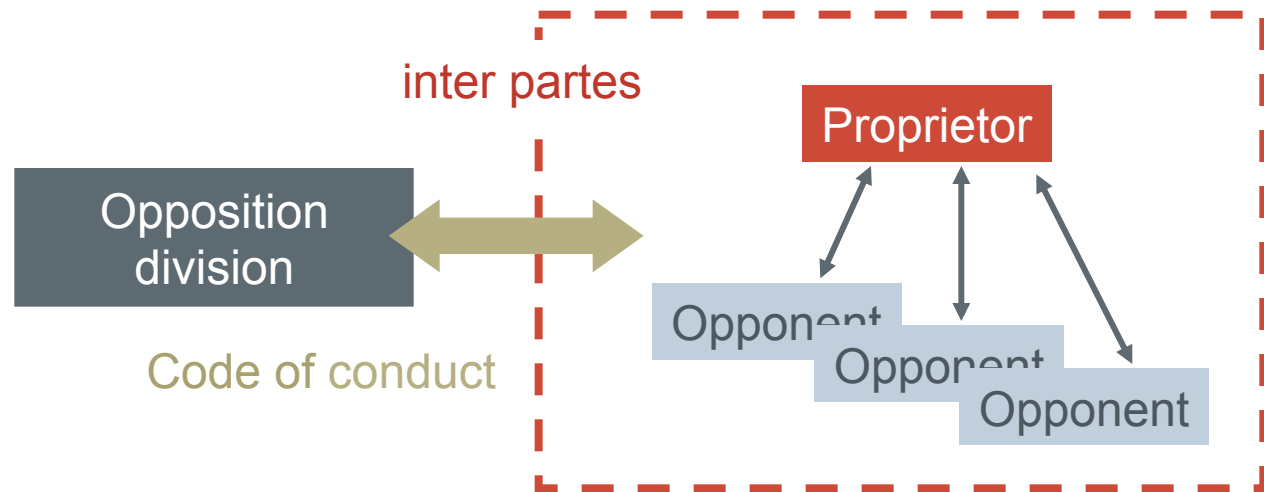
- Infringement
- Licensing/cross-licensing
- Strategy
- Patent intelligence
- Political/ethical reasons

The grant and opposition procedures compared

Procedure up to grant



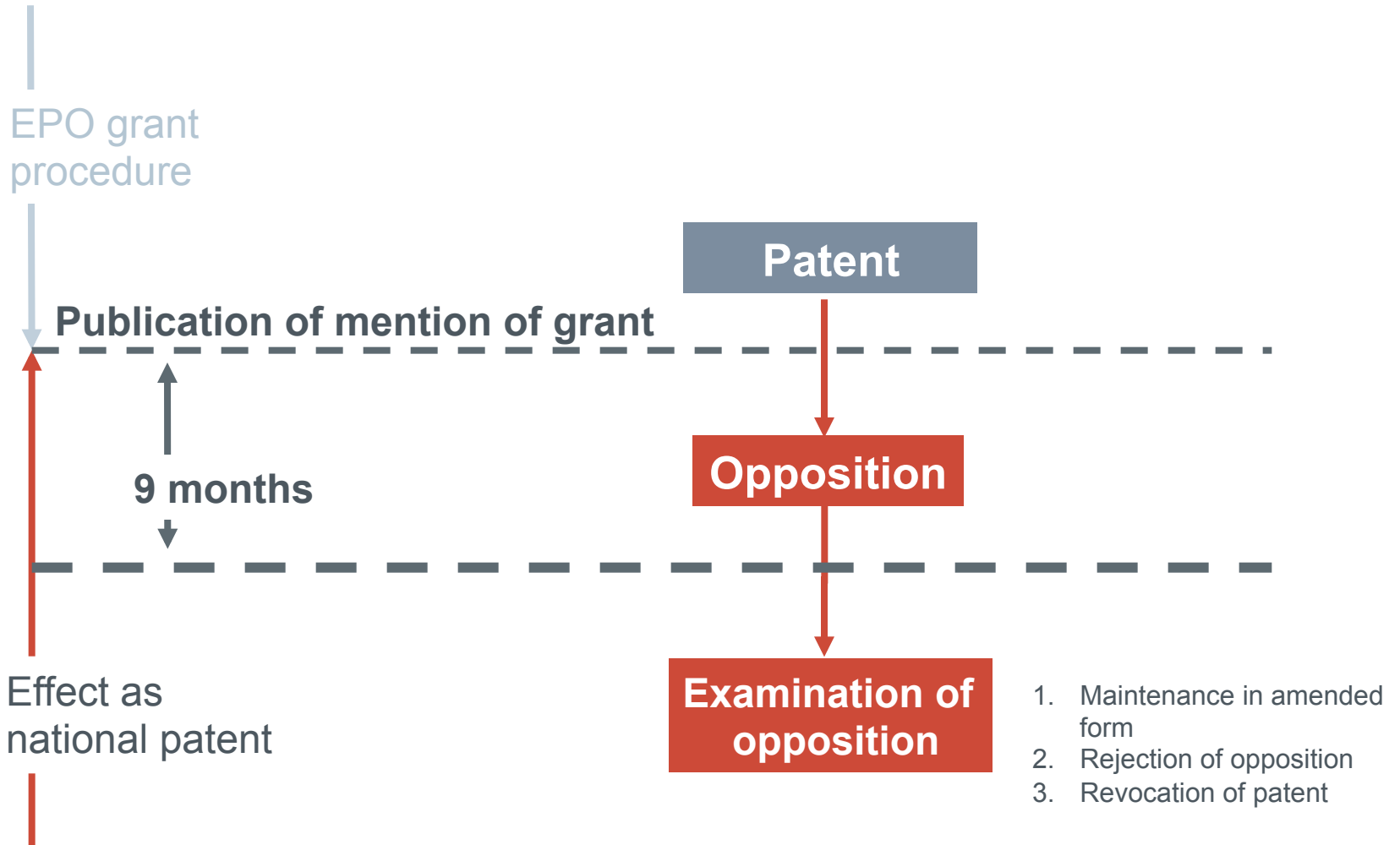
Opposition



Opposition under the EPC

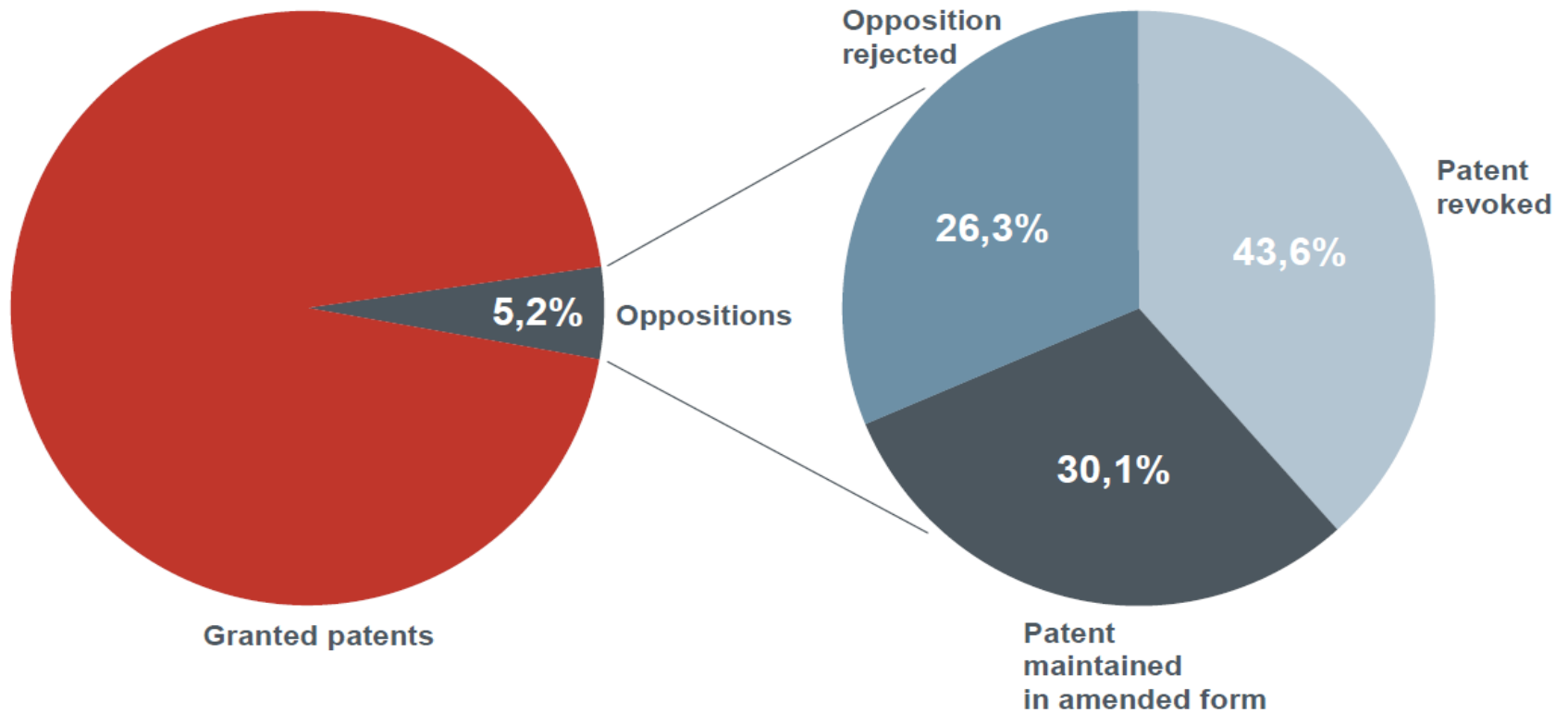
- Uniform, centralised procedure
- Allows public to limit or revoke European patents which it believes to have been wrongly granted

Opposition under the EPC: when?

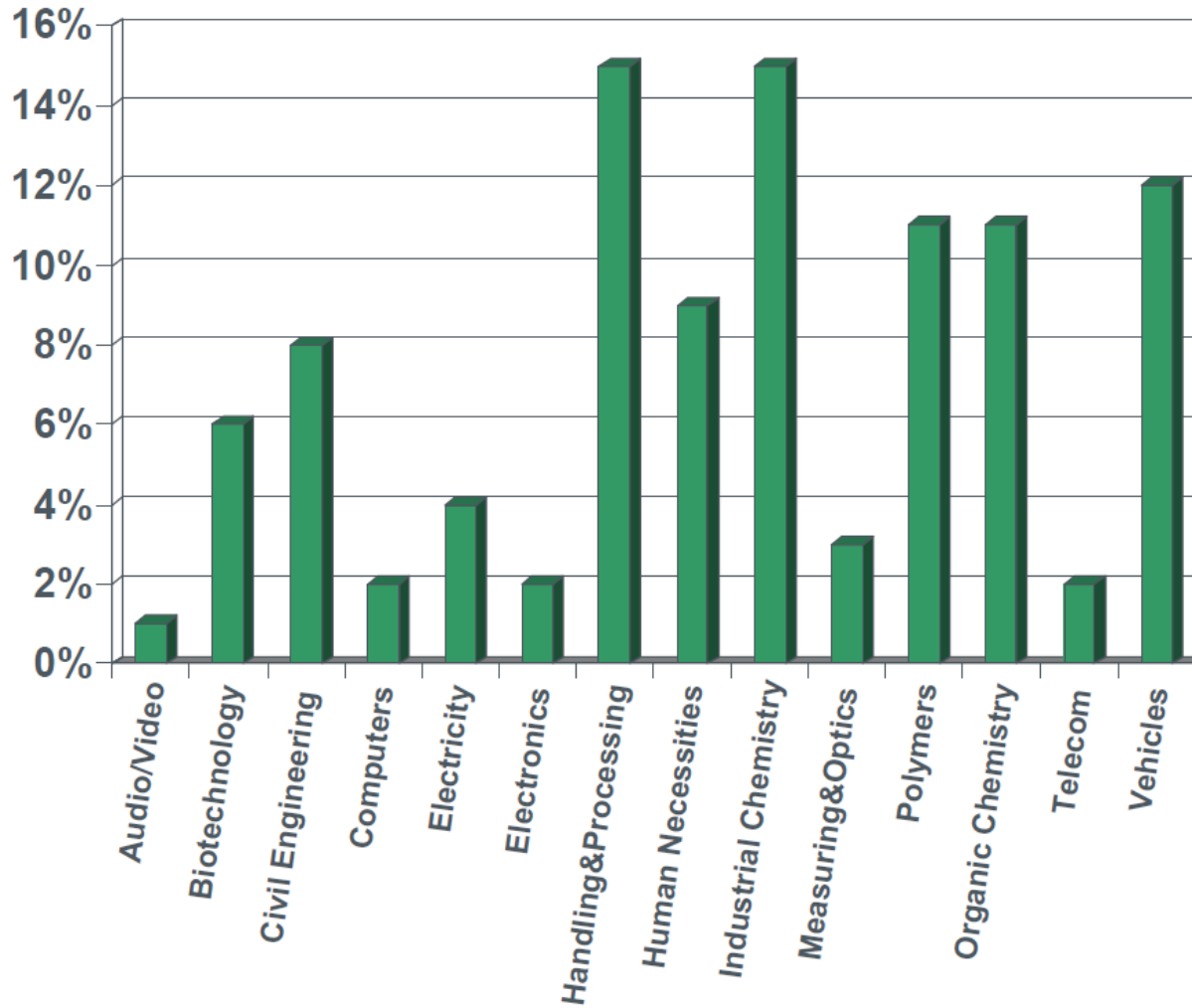


Oppositions in 2010

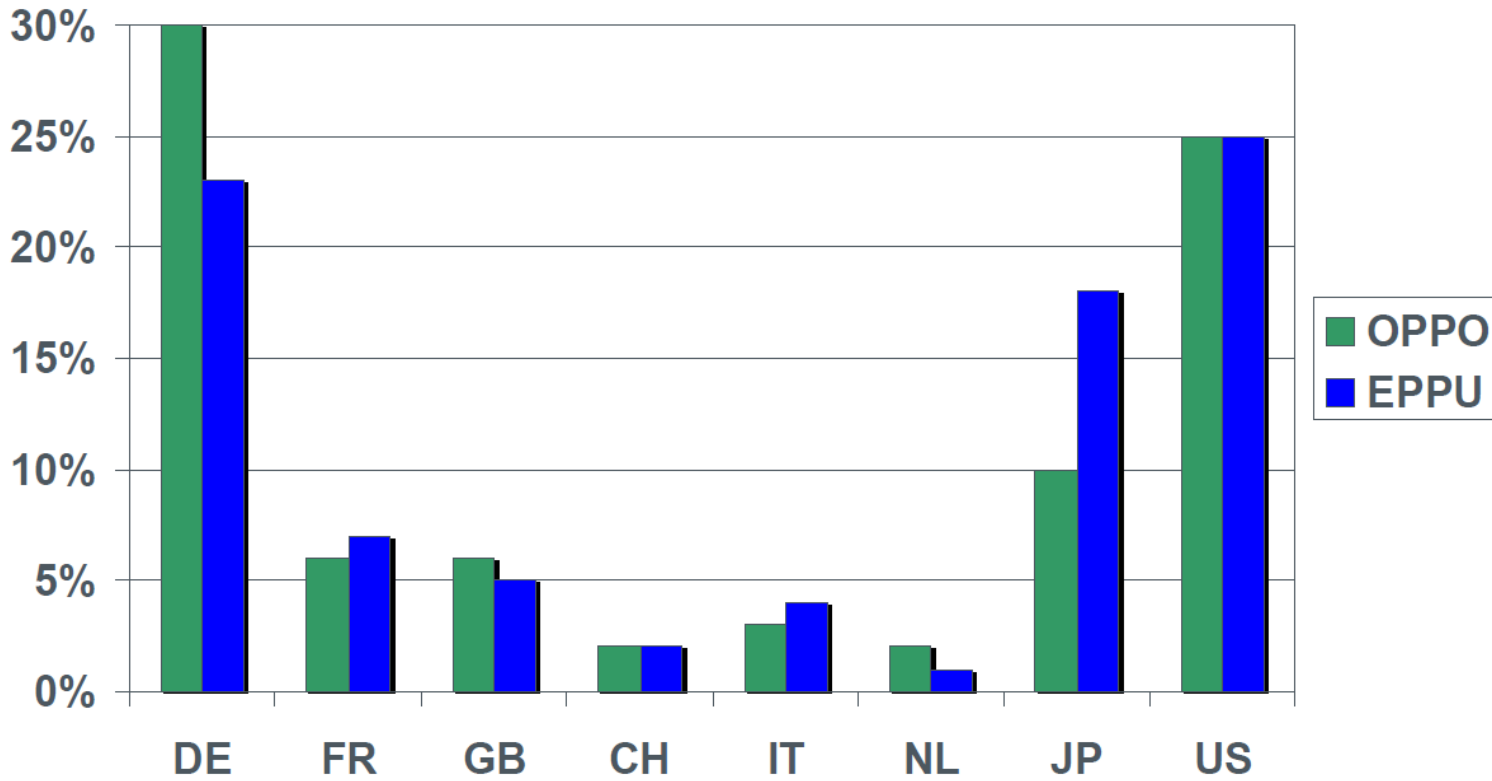
- 58 100 European patents granted
- 5.2% opposed
- Over one-third of all opposed patents revoked



Percentage of granted patents opposed, by field

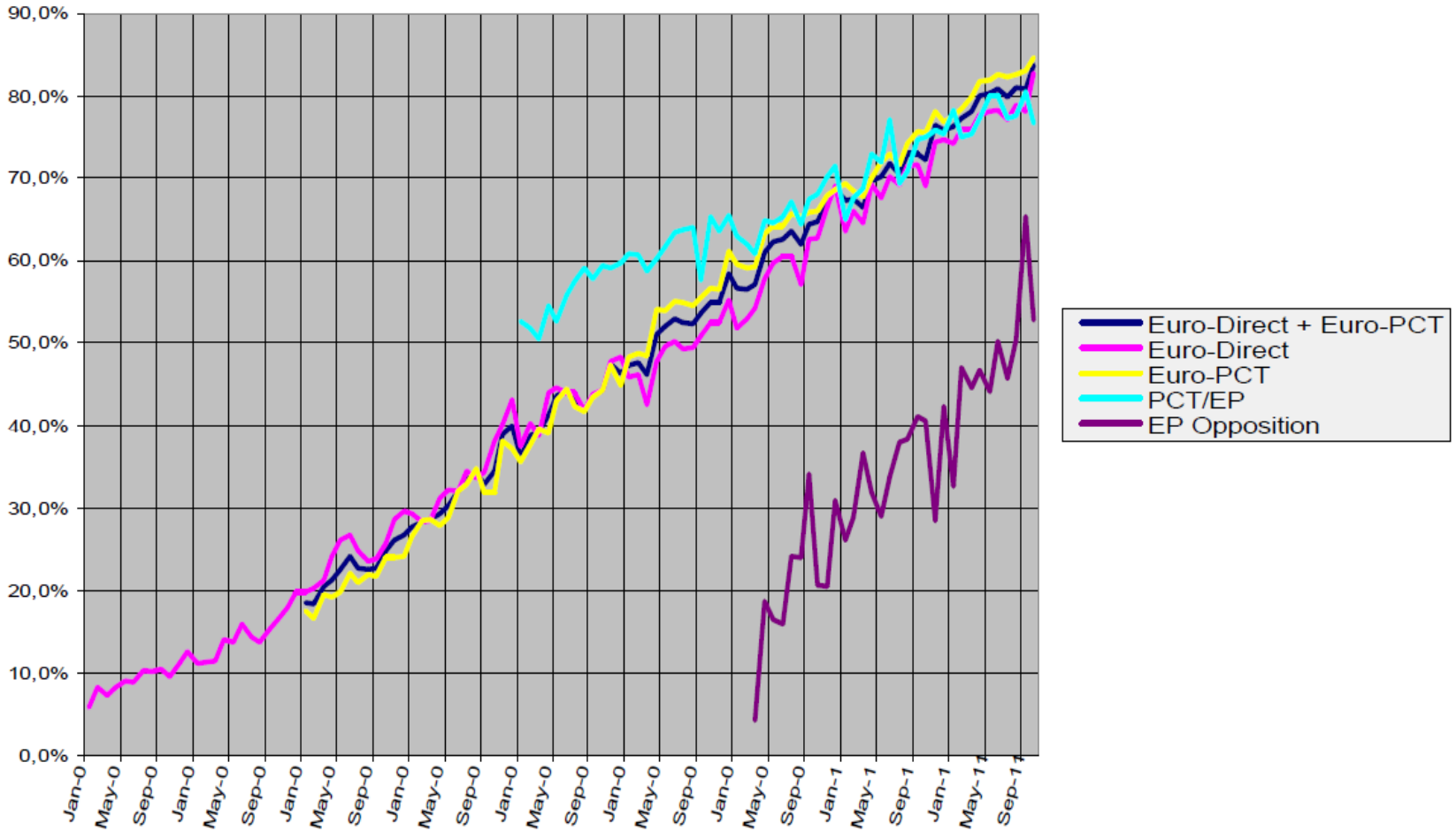


Percentage of granted patents opposed, by origin



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

Patent specification

(19)   (11) EP 1 667 897 B1

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and mention of the grant of the patent:
25.01.2012 Bulletin 2012/04

(21) Application number: 04768395.8

(22) Date of filing: 09.09.2004

(51) Int. Cl.:
B62M 1/14 (2006.01) A61G 5/02 (2006.01)

(86) International application number:
PCT/GB2004/003848

(87) International publication number:
WO 2005/025973 (24.03.2005 Gazette 2005/12)

(54) PROPULSION AID
ANTRIEBSHILFE
AUXILIAIRE DE PROPULSION

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AT BE BG CH CY CZ DE DK EE ES FI FR GB GR
HU IE IT LI LU MC NL PL PT RO SE SI SK TR

(30) Priority: 12.09.2003 GB 0521474
18.03.2004 GB 060146

(43) Date of publication of application:
14.06.2006 Bulletin 2006/24

(73) Proprietor: Pure Global Limited
Watford
Hertfordshire WD17 3DP (GB)

(72) Inventor: ORFORD, Robert, Nicholas, Charles
Watford, Hertfordshire WD17 3DP (GB)

(74) Representative: Robinson, Simon John
Barker Brethell LLP
Medina Chambers
Town Quay
Southampton
SO14 2AQ (GB)

(56) References cited:
US-A- 3 877 725 US-A- 4 354 691
US-A- 6 303 945

EP 1 667 897 B1

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).

Printed by Jouve, 75001 PARIS (FR)

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Grounds for opposition

Article 100



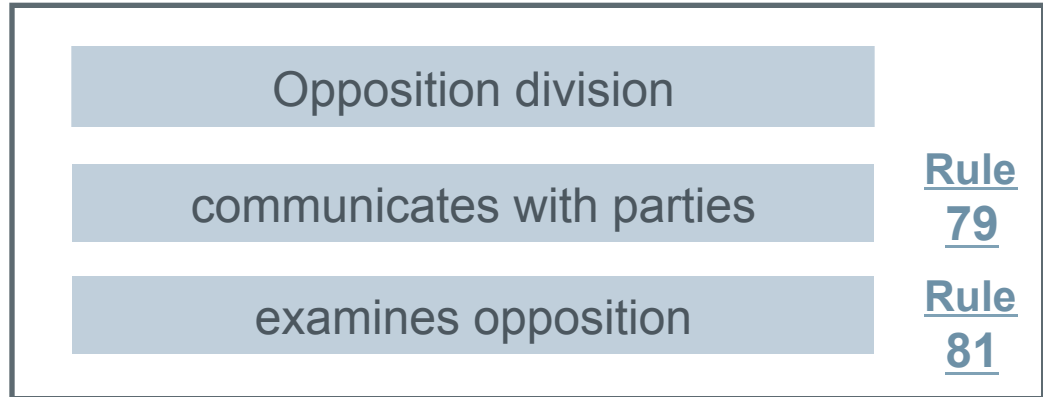
- (a)
 - Not novel
 - No inventive step
 - Not industrially applicable
 - Excluded, exceptedArt 52-57

- (b) Art 83
Insufficiently disclosed

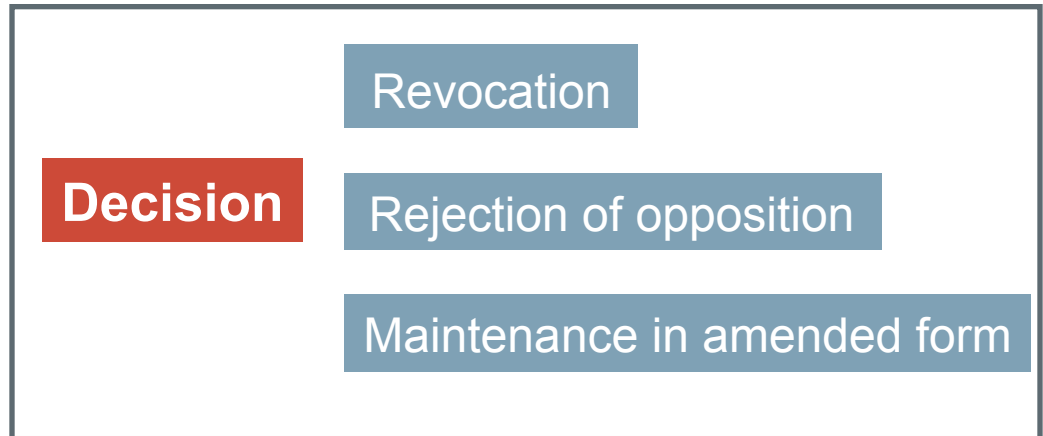
- (c) Art 123(2)
Amended beyond original disclosure

Article 101 EPC

Article 101(1)



Article 101(2)(3)





Procedure

Filing an opposition

Article 99

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

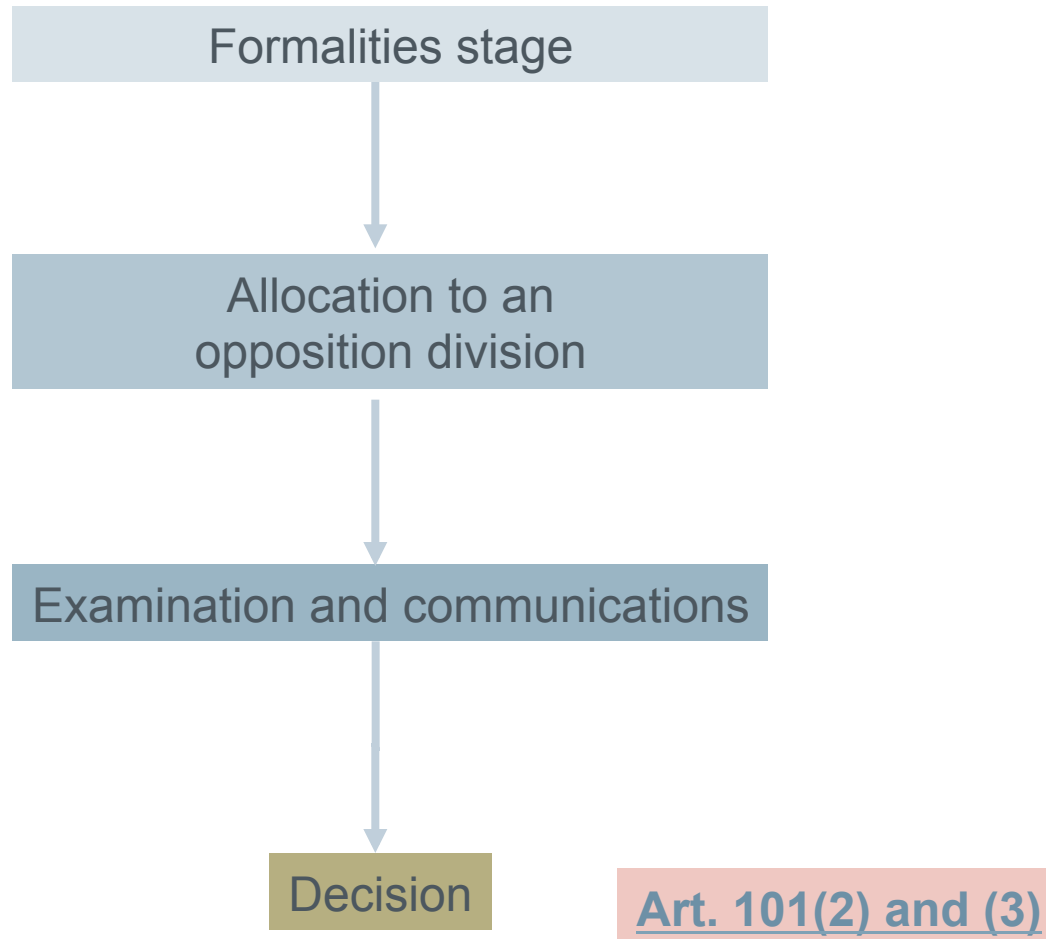
- Parties

proprietor

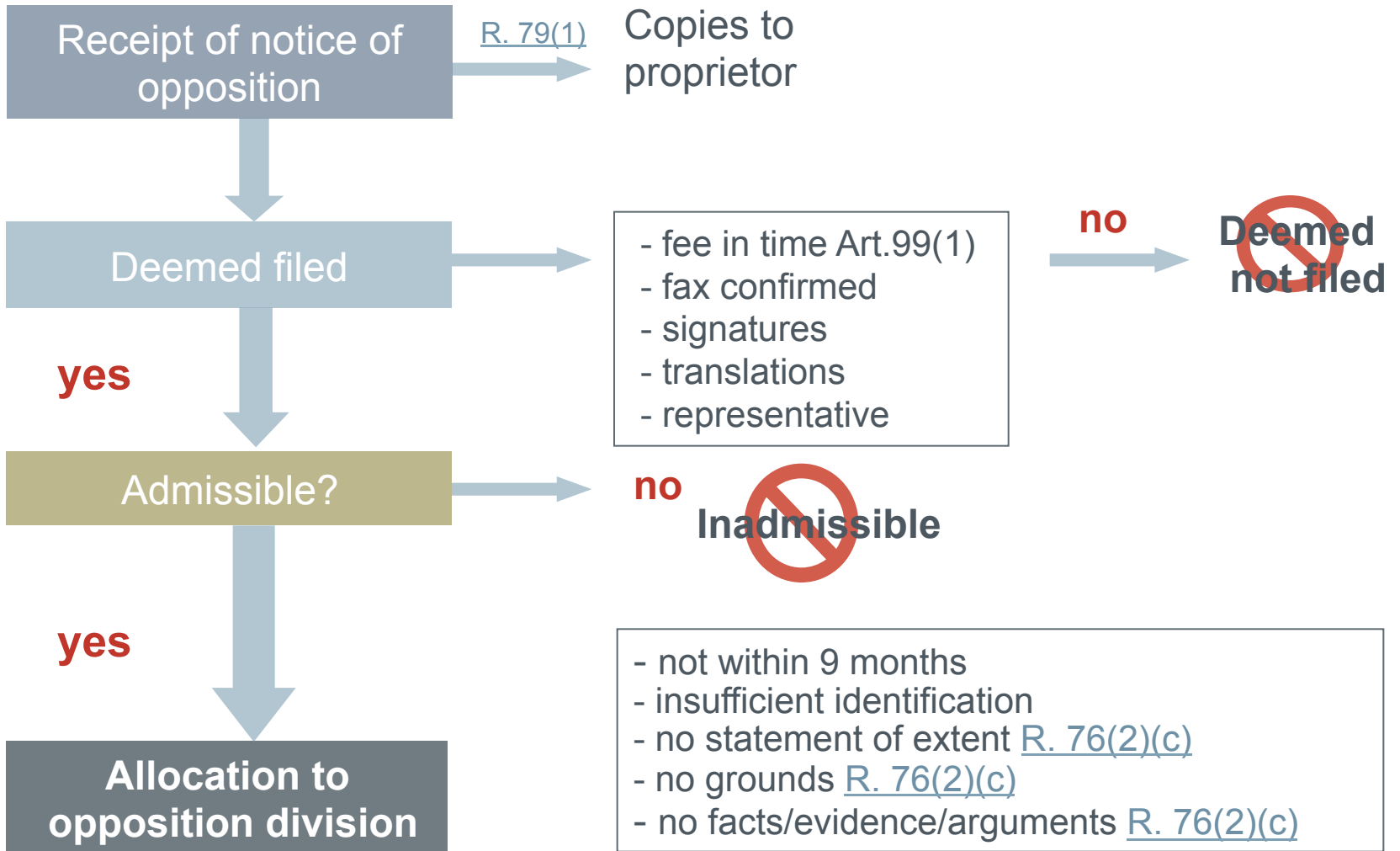
opponent

* G 3/97: except proprietor

Overview of procedure after filing



Formalities stage



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

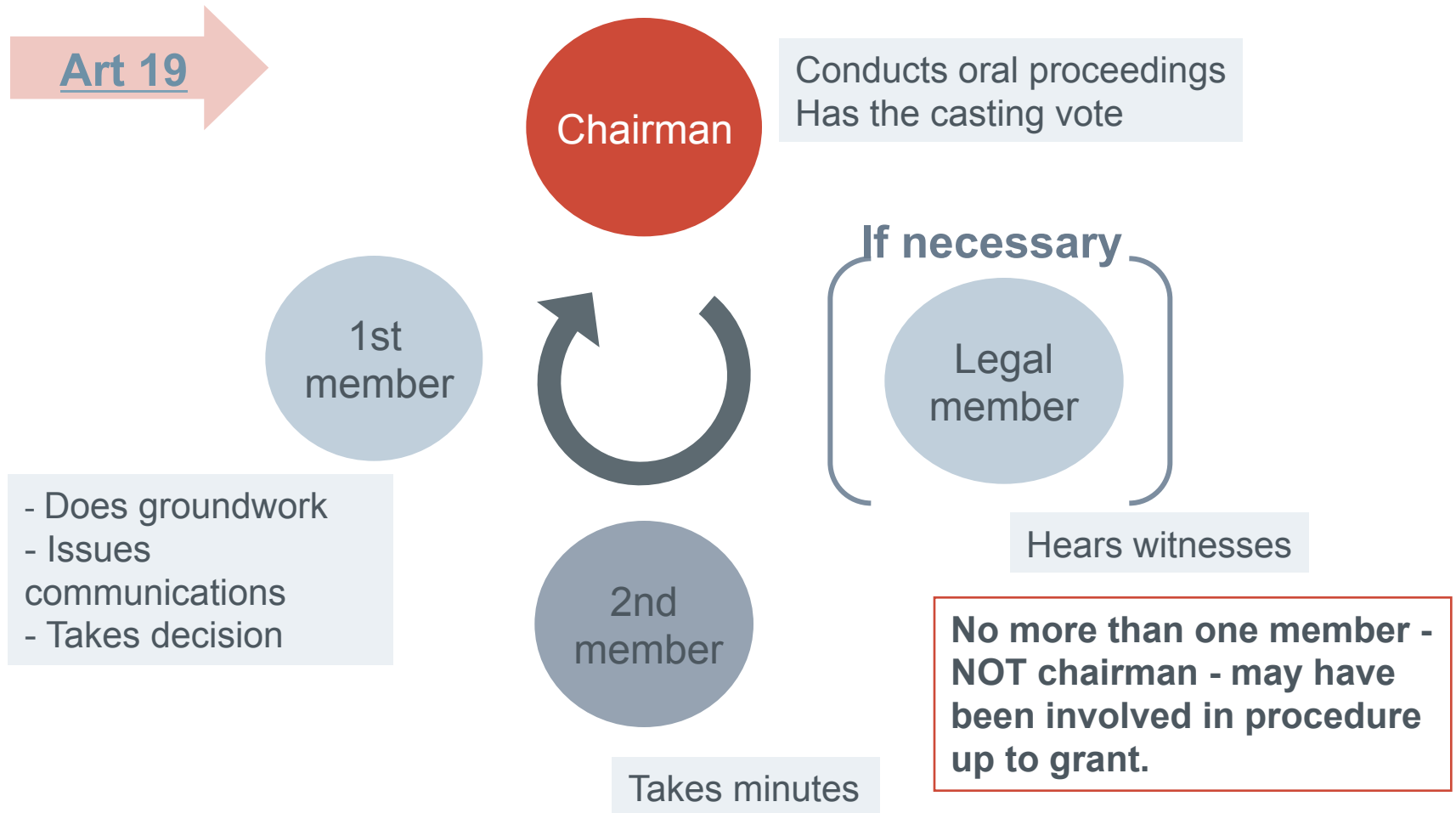
Rule 76(2)(c)

- **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



Procedure: general provisions

Art. 113(1)

right to be heard

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

Art. 114

extent of examination

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

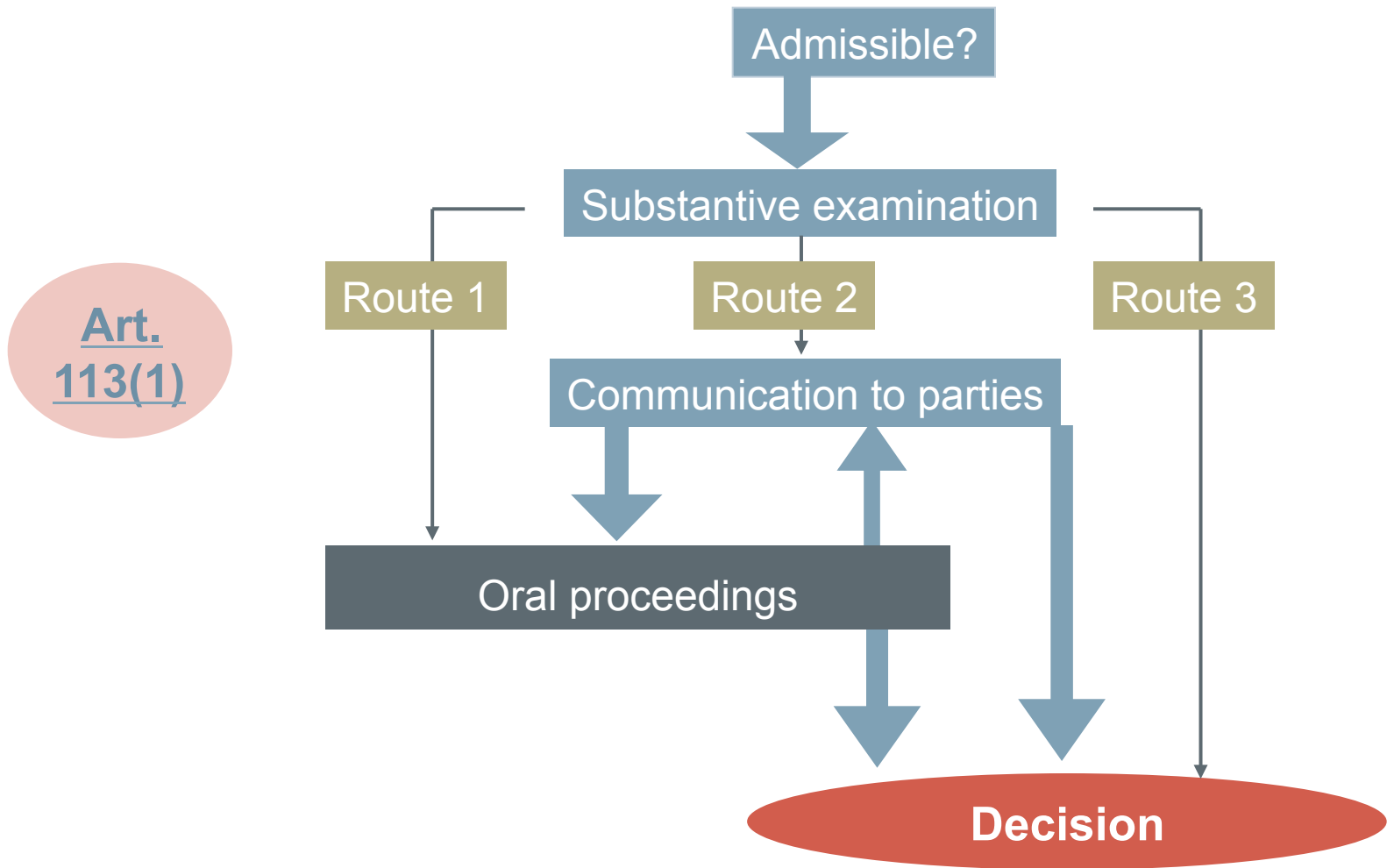
Late submissions may be disregarded

Art. 116

oral proceedings

at request of parties
public before opposition division

The examination stage



Art.
113(1)

Amendments

Rule 80

Proprietor may amend claims

but only

to address grounds for opposition

Amendments must comply with the EPC

Arts.
52-57

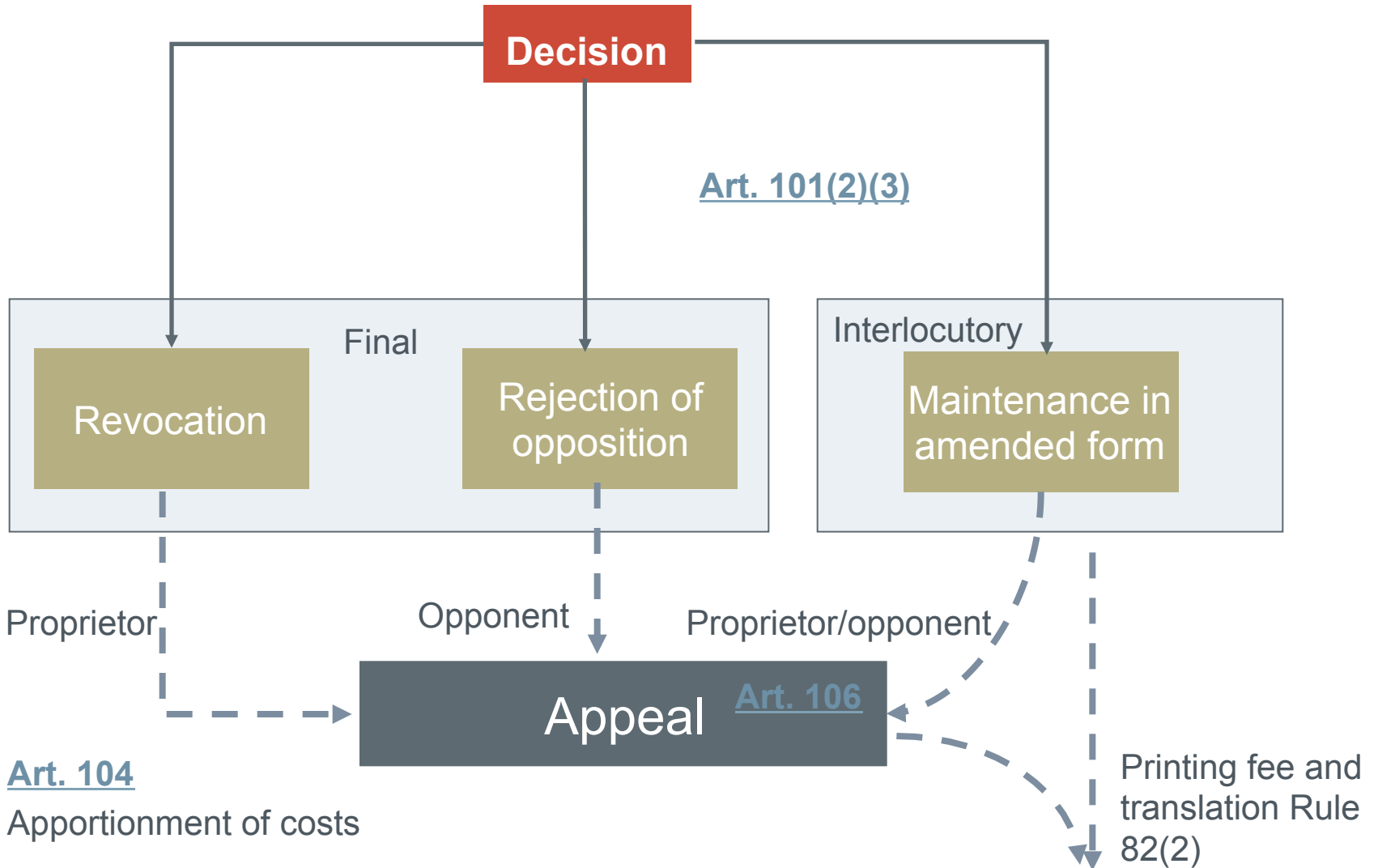
Art.
84

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



Oral proceedings

Article 116 →

Article 117

Taking of evidence

Rule 115

- Summons
- Non-appearance

Rule 116

- Invitation
- Final date for submissions

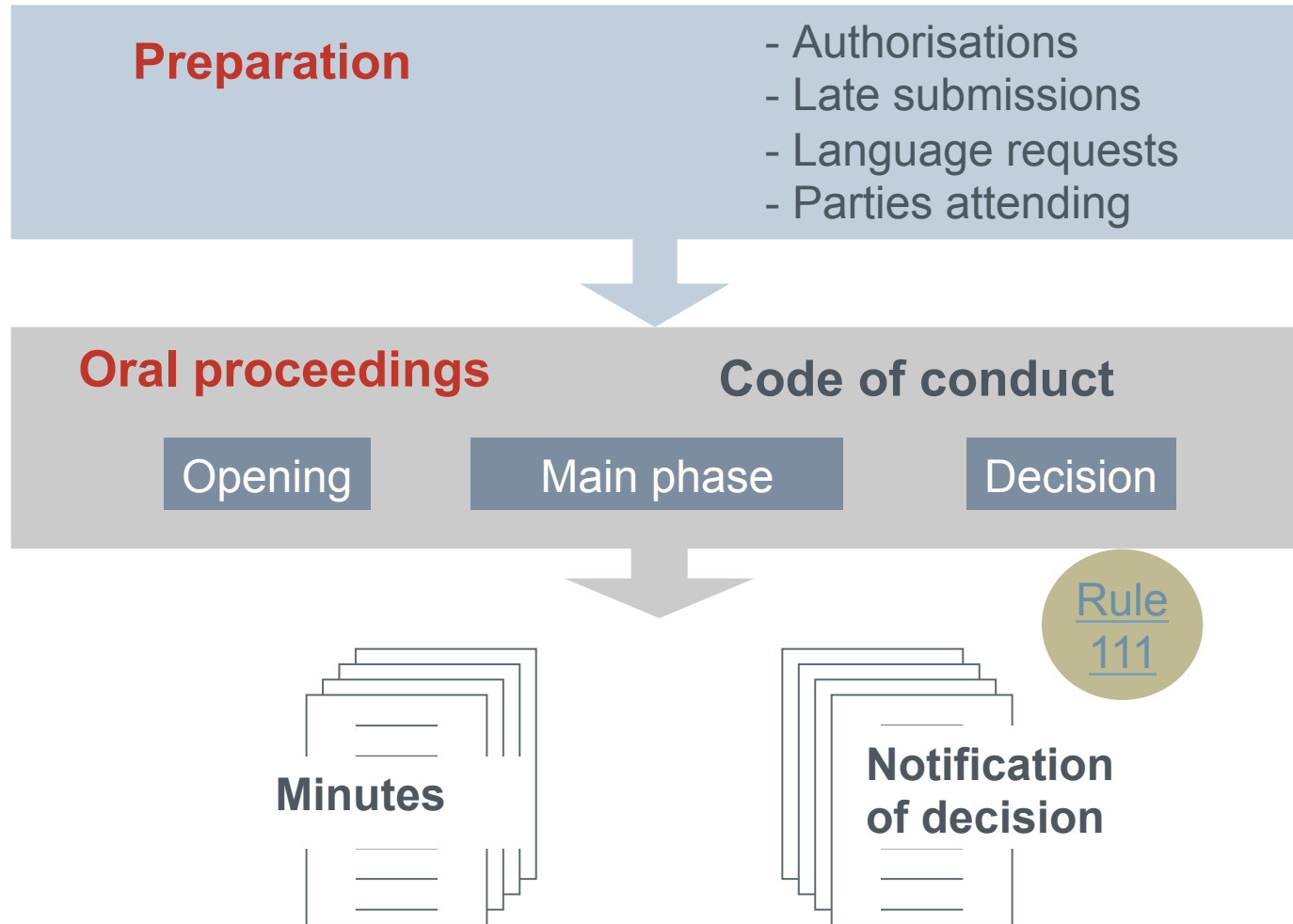
Rule 124

- Minutes

Rule 4

- Language

Conduct of oral proceedings





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

Article 115

- 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

