



# Oppositions at the European Patent Office – A Cruel Tool...

By Pernille Winding Gojkovic & Claus Elmeros, HØIBERG A/S

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*Although the grant of a European patent is a success – you shouldn't celebrate until the nine month opposition period is over: Opposing a European Patent can be an extremely efficient way of removing or limiting dominating rights in a centralized and efficient manner.*

## Deadlines

The date of the publication of mention of grant, i.e. the date of grant of a European patent, determines a series of deadlines. The deadline for filing an opposition against the patent is one of them, and this deadline expires nine months from grant. It is very common that oppositions are filed at the last moment. Why? Because already three months from grant the patent must be validated in the EPC contracting states for which protection is sought. In other words, within three months the patentee must translate and pay a number of fees – all of which may be lost if the patent is revoked in opposition. Filing the opposition at the last moment is a way of harassing a competitor financially. On average 5% of all European Patents are opposed.

## Procedure

The Opposition procedure runs according to a tight script with the following steps:

- Filing of the notice and grounds for opposition by the Opponent
- Reply to the opposition by the Patentee
- Summons to oral Proceedings and EPO's preliminary opinion
- Filing written submissions responsive to the EPO opinion by both Opponent and Patentee

- Oral proceedings at the EPO ending with the EPO's decision

Each of these steps is outlined below as they usually occur. The typical duration from expiry of the opposition period to the EPO gives a decision on the opposition is about two years.

## Notice and Grounds of Opposition

The notice of opposition, the grounds for filing the opposition – and the required fee – must all be filed no later than nine months from the grant of the patent. The permissible grounds for opposition are:

- Content of patent extends beyond content of application as filed
- Insufficient disclosure
- Non-statutory subject-matter
- Lack of novelty
- Lack of Inventive step

All grounds should be raised – even if the basis is slightly flimsy; if the ground is not raised it may be difficult to introduce the subject later during proceedings (unless the claims are amended). Be careful not to contradict yourself when arguing insufficiency of disclosure and inventive step – it is the same fictional person of skill who either cannot find the subject-matter clearly demonstrated or who clearly can find that the subject-matter of the patent is obvious in view of the prior art. Evidence, such as prior art, may be filed and may be efficient; declarations from experts on the other hand carry only little weight with the EPO.

Note that an opposition may be filed by a straw man and the actual aggressor may never need to reveal himself – which is why oppositions may be used as a

tool during license negotiations. Although beware: the EPO may continue the opposition procedure in their own right even if the opposition is withdrawn!

### **Reply**

The Patentee must reply to the notice of opposition within a time frame given by the EPO. The deadline may be extended once for a few months, no more. The reply should address all the issues raised and no more. Unless a truly damaging piece of prior art has been cited there is usually no need at this stage to file amended claims.

### **Summons**

The Opposition Division at the EPO studies the material and issues both a summons for oral proceedings which sets the date, time and venue for the oral proceedings to be held and a preliminary and non-binding opinion. The Opinion is rarely very helpful in indicating what the Opposition Division sees as the main points to be discussed, however it can reveal any misunderstandings the EPO may have in relation to the forwarded material.

Usually a four month notice is given by the Opposition Division for the date of the oral proceedings. It requires factual reasons and evidence to change the set date. The proceedings can be held at any of EPOs offices in Berlin, the Haag or Munich, with the technical field of the patent usually being the deciding factor: Life science is dealt with in the Haag or Munich and mechanical or software related inventions are dealt with in Berlin or Munich.

Finally the summons also sets the date for the written submissions to be filed.

### **Written Submissions**

The written submission is the last chance to forward arguments and additional evidence to the EPO for both the Opponent and the Patentee. Any later filed material the EPO may refuse to take into consideration. Therefore the written submissions should present the best possible case for achieving the desired result. The written submission must address all the issues raised by the EPO – and any additional issues raised by either the Opponent or Patentee. The written submission may provide new facts and evidence – but be careful not to contradict

any facts already put forward or to shift the balance of the legal arguments too much. For the Patentee sets of amended claims can be forwarded, as a matter of tactics or precautionary; these are referred to as “requests”.

If you are the Opponent the requests must be scrutinized carefully in preparation for the Oral proceedings: One of the easiest ways to have a request refused is if the patentee makes unallowable amendments to the claims – remember the EPO requires near verbatim basis for any claim amendments!

### **Oral Proceedings**

Finally the date arrives for the oral proceedings – and you better be ready! A decision will be given on the day.

The Opposition Division is comprised by at least three representatives from the EPO: the first examiner, who typically was handling the case until grant; the Chairman, a senior EPO examiner; and the second examiner, who is delegated with the task of taking the minutes of the proceedings. All three EPO representatives are examiners educated within the technical field of the invention.

The Chairman initiates the proceedings by stating the purpose of the oral proceedings, gives a summary of the events leading up to the proceedings, and decides which party speaks first. The issues are dealt with in a predetermined sequence and for each point a decision is given by the EPO before the next issue is addressed. The very formalized procedure is made to ensure that all parties have the opportunity to be heard by the EPO.

The issues are taken in the below order for each set of requests. In other words, if e.g. the granted claims are found to lack novelty, the examination of the first auxiliary request starts back at point 1.

1. Art 123(2) – Extension of subject-matter
2. A83 – Sufficiency of disclosure
3. A52 (A54) – Novelty
4. A52 (A56) – Inventive step / Obviousness

Typically during opposition proceedings the opponent(s) speaks first, followed by the patentee. The Opposition Division (OD) may interrupt with questions at any time. When the Chairman is satisfied all have been heard, the proceedings are interrupted

and the patentee and the opponent(s) are literally sent out the door while the OD deliberates. Thus the oral proceedings are a mixture of very focused and intense discussions interrupted by breaks of intermittent length where the parties either are busy preparing the next round of attack and defense or are slouching in the few available and uncomfortable chairs.

The oral proceedings are done, when they are done. In other words they may be brief and last as little as half an hour or drag on until late evening with everyone missing their flights and requiring last minute hotel bookings. It is advisable to bring food and snacks for the day.

At the end of the day the OD pronounces one of three verdicts: the Patent is revoked, upheld in amended form, or the opposition is dismissed. The verdict is final, there is no further discussion and within a few months the minutes of the proceedings and the decision is issued. The decision can only be altered by filing an appeal in a separate set of proceedings.

### Conclusion

On [average](#) 30% of the opposed patents are revoked, 40% are upheld in amended form and in about 30% of the cases the opposition is dismissed. In other words, whether you are the Opponent or the Patentee, you have a good chance of success.

At HØIBERG A/S we handle oppositions both for our direct clients, for our foreign associates and as opposition specialists, opposition cases are transferred to us. We have extensive experience with opposition work and will be happy to assist you and your clients with any questions you may have.



### Pernille Winding Gojkovic

CEO, Partner, European Patent Attorney

Contact information:

T: +45 3332 0337

[pwg@hoiberg.com](mailto:pwg@hoiberg.com)

[Learn more about Pernille Winding Gojkovic](#)



### Claus Elmeros

Partner, European Patent & Design Attorney

Contact information:

T: +45 3332 0337

[cel@hoiberg.com](mailto:cel@hoiberg.com)

[Learn more about Claus Elmeros here.](#)