



OPPOSITION STRATEGIES

THE EPO, GERMANY AND UK COMPARED



MURGITROYD

DATE: 20 MAY 2015
LOCATION: GLASGOW



INTRODUCTION

The European patent opposition procedure is well established. There is a comprehensive set of guidelines and a considerable body of case law which sets out what can and can't be achieved during the opposition procedure.

The German Patent Office also has an opposition procedure which can be used for German patents obtained through the national route.

The UKIPO does not have an opposition procedure.

But....



INTRODUCTION

Can the UK revocation process be used instead of an opposition procedure for European patents, at least in the UK?

What are the pros and cons?

Can the German nullity process be used instead of an opposition procedure for German and EP (DE) patents?

How do the different processes compare?



OUTLINE

- m: A summary of the European patent opposition procedure
- m: Comparison of German and EPO opposition procedures
- m: Comparison of UK revocation and EPO opposition procedures
- m: Checklist



EPO OPPOSITION

- m: Highly structured and regulated process
- m: Strict deadlines
- m: Can last for two to three years or more
- m: Decision can be appealed - appeal procedure can last another two to three years or more.



EPO - GROUNDS FOR OPPOSITION

m: Not patentable - Art.100(a) EPC

- Not new
- Not inventive
- Excluded subject matter

m: Lack of sufficiency - Art.100(b) EPC

- Invention is not sufficiently described in the patent to enable a skilled person to carry out the invention.

m: Added subject-matter - Art.100(c) EPC

- Subject matter of granted patent extends beyond content of application as filed



EP - NOVELTY & INVENTIVE STEP

- m: All evidence and arguments must be filed with the Notice of Opposition, or at least indicated
- m: Late filed evidence may not be considered unless it is extremely relevant
- m: Complete prior art searches (see below)
- m: Inspect prosecution files of corresponding patent applications in all relevant territories
- m: Investigate prior use or prior public disclosure of the invention (see below)



EPO - PRIOR PUBLIC USE

- m: Identify WHAT was disclosed, WHEN, WHERE, TO WHOM, HOW
- m: Identify evidence to support all these facts – photographs, contemporary documents, delivery correspondence
- m: Identify witnesses if necessary
- m: Prepare witness statements and get them sworn
- m: Offer hearing of witnesses if appropriate
- m: Evidence CAN be filed later, but it is always more cost effective to file it with opposition



EPO - PRIOR ART DOCUMENTS

- m: Carry out patent searches
- m: Extend searches to cover academic journals, trade brochures, magazines, web disclosures
- m: Consider evidence for web disclosures – e.g. sworn statement from author or webmaster, contemporary hard copies, Way Back Machine
- m: Text books for “common general knowledge”



EPO - PROCEDURE

- m: File opposition within 9 months of date of grant of patent
- m: At end of opposition period EPO sets patentee deadline for response
- m: 4 months, extendible to 6 months, for response
- m: Patentee may present counter-arguments and/or file amendments
- m: EPO issues summons to oral proceedings, usually 2 to 3 years after filing opposition



EPO - ORAL PROCEEDINGS

- m: Summons to EPO (usually Munich or The Hague)
- m: Summons may include non-binding opinion
- m: Summons may set out issues to be discussed
- m: Hearing before opposition division of 3 examiners (or 3 examiners plus legal member if witness to be heard or if there are complex legal issues)
- m: Chairman of opposition division runs the hearing and decides the order in which matters are to be discussed



EPO ORAL PROCEEDINGS – TIPS FOR OPPONENT

- m: Know your prior art documents in detail
- m: In novelty attacks, cite the precise location of each feature
- m: Use the problem-solution approach wherever possible for inventive step attacks
- m: Examine any amendments very carefully
- m: Do amendments lead to an “intermediate generalisation”?
- m: Consider the use of flip charts for sketches in the hearing



EPO ORAL PROCEEDINGS – TIPS FOR PATENTEE

- m: Study the prior art documents in detail
- m: Prepare and file auxiliary requests as early as possible
- m: Use the problem-solution approach wherever possible to counter inventive step attacks
- m: Ask for a break if you need time to review new arguments or prepare amended claims



EPO - DECISION

- m: Decision is given orally at end of hearing
- m: Written decision follows, usually after 1 to 2 months
- m: Decision can be appealed by paying appeal fee within 2 months of written decision
- m: Must follow up with full statement of grounds of appeal within 4 months of written decision



EPO - APPEAL PROCEEDINGS

- m: Appeal proceedings may last 2 years or more
- m: Written procedure concluded by oral proceedings before the Board of Appeal in Munich
- m: Very strict rules on procedure – very difficult for opponent to have new evidence accepted , very difficult for patentee to have amendments accepted other than “converging” limitations
- m: Oral decision at hearing, written decision about 2 months later
- m: No further appeal possible (cf. Petition for Review)



INTER PARTES POST-GRANT PROCEDURES IN GERMANY

- m: In Germany two types of *inter partes* post-grant procedures are available:
 - m: Opposition procedure at the German Patent Office against DE-patents
 - m: Nullity action at the Federal Patent Court against DE-Patents, DE-part of EP-patents, SPCs



PROCEDURES COMPARED – GERMANY AND EPO

EPO	DE-Opposition	DE-Nullity
Subject of the proceedings:		
EP patents	DE patents	DE patents, EP(DE) patents, SPCs
Limited <i>ex officio</i> examination	<i>ex officio</i> examination	<i>ex officio</i> examination
Opposition proceedings may continue after withdrawal of opposition	Opposition proceedings continue after withdrawal of opposition	Principle of party disposition (court bound to party requests; abandonment of action possible)
Kind of proceedings / Timeline		
Administrative procedure		Court procedure
Within 9 months after grant		After opposition period/ opposition



GROUNDS / PRIOR ART COMPARED GERMANY AND EPO

EPO	DE-Opposition	DE-Nullity
Grounds		
Not patentable Lack of sufficiency Added subject-matter	Not patentable Lack of sufficiency Added subject-matter Entitlement	Not patentable Lack of sufficiency Added subject-matter Entitlement Extension of protection
Prior Art		
Everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application		
Prior EP rights (Art. 54 (3) EPC) with regard to novelty	Prior national rights (§ 3 (2) PatG) with regard to novelty	



PROCEDURES COMPARED – GERMANY AND EPO - II

EPO	DE-Opposition	DE-Nullity
Course of the proceedings		
Written proceedings	Written proceedings	Written preliminary proceedings
Oral proceedings if requested or considered pertinent	Oral proceedings if requested or considered pertinent	Oral proceedings mandatory
Appeal		
Board of Appeal	Federal Patent Court	Federal Court of Justice
Enlarged Board of Appeal	Appeal on points of law to the Federal Court of Justice	



COSTS COMPARED GERMANY AND EPO

EPO	DE-Opposition	DE-Nullity
Opposition fee EUR 775	Opposition fee EUR 200	Court fee Reimbursement (Costs depend on the amount in dispute; to be paid by the losing party)
Normally no decision on costs		Decision on costs mandatory
Appeal fee EUR 1860	Appeal fee EUR 500	Court fee Reimbursement (Costs depending on the amount in dispute; to be paid by the losing party)
Normally no decision on costs		Decision on costs mandatory



TIMESCALES COMPARED – GERMANY AND EPO

EPO	DE-Opposition	DE-Nullity
Within 9 months after grant		After end of opposition period/ opposition
2 years or more		
Appeal		
3 years or more	2 years or more	3 years or more



PROCEDURES COMPARED – UK AND EPO

- m: The UK does not have an opposition procedure
- m: However revocation proceedings can be used to challenge the validity of a third party patent
- m: Can be used for both UK and EP(UK) patents
- m: Revocation proceedings can be started in the courts or at the UKIPO
- m: Revocation proceedings cannot be continued by UKIPO or courts “of own motion”, unlike EPO opposition



GROUNDS COMPARED – UK AND EPO

- m: Grounds for revocation are the same as grounds for opposition:
- m: Not patentable – s. 72(1)(a) Patents Act 1977
 - Not new; Not inventive; Excluded subject matter
- m: Lack of sufficiency – s. 72(1)(c) Patents Act 1977
 - invention is not sufficiently described in the patent to enable a skilled person to carry out the invention.
- m: Added subject-matter – s. 72(1)(d) and (e) Patents Act 1977
- m: There is one additional grounds, that the patent was granted to a person not entitled to the patent – s. 72(1)(a) Patents Act 1977. Can only be raised by entitled person.



GROUNDS COMPARED – UK AND EPO - II

m: Intermediate prior art – earlier applications not published before priority date of opposed patent

m: Citable for novelty, not for inventive step

m: Includes:

- UK applications
- PCT applications entering UK national phase
- PCT applications entering EP regional phase
- EP applications

m: First two categories NOT citable in EPO opposition



COSTS COMPARED – UK AND EPO

m: UK – official fees

- GBP 50 – initiation of proceedings
- GBP 350 - continuation of proceedings (after response from patentee)
- GBP 200 – appeal fee (Patents Court)
- Nominal costs may be awarded (c. GBP 1000)

m: EPO official fees

- EUR 775 - opposition fee
- EUR 1860 - appeal fee
- No costs awarded



TIMESCALES COMPARED – UK AND EPO

- m: EPO opposition must be filed within 9 months of grant –
UK revocation - no time limit

- m: Counter-statements
 - EPO 4 months, extendible to 6 months
 - UK 6 weeks, extendible in most cases by 2 or 3 weeks

- m: Evaluation by Patent Office
 - EPO, typically 2 years or more, with summons to oral proceedings
 - UK, issue of Preliminary Evaluation and invitation to file evidence (if not in original Statement of Grounds) and agree date for hearing, typically within 1 year of filing revocation
 - UKIPO procedures allow for case management conferences, usually by telephone



EVIDENCE COMPARED – UK AND EPO

- m: If an opposition/revocation is based on published literature (patent or other) then there is little difference between the UKIPO and EPO
- m: If you are relying on evidence of prior public use, the UK procedure is more flexible. Evidence does not have to be filed until later in the proceedings.
- m: UK allows cross-examination of witnesses at the hearing. EPO does not, instead the witness is “heard” by a legal member of the opposition division.



UKIPO OPINION SERVICE – AN ALTERNATIVE TO REVOCATION?

- m: A quick, low cost alternative to revocation is to seek an opinion on validity from the UKIPO
- m: File statement and evidence, and pay fee, only GBP 200.
- m: Request for opinion is advertised
- m: Four weeks for observations, then two weeks for patentee to file response, no hearing
- m: Extensions of time usually only a few days
- m: Written opinion follows, usually about 3 months after request
- m: Can be reviewed (a sort of appeal, usually with a hearing)



CHECKLIST BEFORE FILING OPPOSITION OR REVOCATION

- m:** Why is opposition/revocation being filed?
 - Commercial issues?
 - Part of global strategy?
 - Settlement before or after filing?
- m:** What is expected from opposition/revocation?
 - Revocation of entire patent?
 - Limitation or removal of certain claims?
- m:** Have all searches been completed?
- m:** Research history of invention?
 - Did patentee disclose invention completely or in part before filing?
- m:** Experimentation required?
- m:** Expert witness required / helpful?
- m:** Where to start proceedings?
 - What is effect of national revocation?
 - Is an early decision important?



**THANK YOU
FOR LISTENING!**

Graham Murnane
Director, Patents
graham.murnane@murgitroyd.com

Dr Ben Grau
German Patent Attorney
ben.grau@murgitroyd.com

Don't forget to join us for our series of webinars hosted by Dr Sam Towlson, starting Tuesday 16 June!