

A guide to hearings at the European Patent Office

Preparing for Opposition

The grant of a European patent by the European Patent Office (“EPO”) is a major step in the protection of an invention. However, it is not the final step. A granted European patent may be opposed if a third party launches opposition proceedings within a nine month period starting from the grant date of the patent.

European opposition and appeal proceedings not only allow you to oppose or defend a European patent, but they also offer an opportunity to resolve validity conflicts, establish the strength of a patent, or challenge and limit another party’s rights.

The filing of an opposition may be conducted either on a one-off basis or as part of a general strategy of intellectual property management and enforcement.

A major advantage of filing an opposition, compared to pre-grant third party observations, is that the opponent becomes a party to the proceedings. This means that the opponent will be able to play a part, including attending oral proceedings, in the decision regarding whether the patent should be upheld.

Another advantage is that it is possible to attack a patent in all the designated European states with a single action, and so avoid costly country-by-country invalidity actions.

Since an opposition can also be filed without naming the interested opposing party, it may be particularly useful if you wish to oppose one of your customer’s or supplier’s patents on an anonymous basis.

Time, effort and money can be saved

The ongoing monitoring of the activities of competitors at the EPO is very important to be able to take early action. A well planned patent monitoring programme is a cost-effective way of enabling you to review the prosecution of your competitors’ European patent applications, take the appropriate action at an early stage, and build your case well within the set time limits.

Whether you are defending your patent or opposing someone else’s, if the proceedings are well-prepared and conducted promptly, the chances of success increase, while a substantial amount of time, effort and money is saved. Undoubtedly, proper management of the process offers you a competitive advantage.

Once proceedings are under way, the process must be reviewed regularly and all persons involved should be identified and kept informed. This saves time, avoids unnecessary work and errors, and ensures that all time limits are met.

For more information on the effective management of opposition and appeal proceedings, second opinions, additional input to proceedings already under way, or establishing a third party patent monitoring service, contact Michael Marchant (michael.marchant@murgitroyd.com) or Laura Fè (laura.fe@murgitroyd.com).

The Procedure

1) The nine month period to file a Notice of Opposition - Within nine months from the date of grant of a European patent, any person can file a Notice of Opposition.

2) Any person is entitled to file an opposition - An opposition can be filed by “any person”, which means that it can also be anonymous. A so-called “straw man” opposition usually involves a person opposing on behalf of somebody else – so that the identity of the real opponent remains a secret. A straw man opposition cannot be used to oppose one’s own patent.

3) Grounds for opposition - The grounds for opposition are defined in the European Patent Convention. Typically, an opponent might allege that the invention is not new, is not inventive, or is not sufficiently described in the patent to enable a skilled person to carry out the invention. Another common ground is that the patent was amended in a way that does not have a basis in the application as originally filed.

4) Contents of Notice of Opposition - The Notice of Opposition must include all the desired grounds of opposition and cite all the evidence. It is difficult to introduce further grounds and evidence at a later stage in the proceedings.

5) Duration of opposition proceedings - The opposition proceedings typically last from two to four years.

6) Written and oral opposition proceedings - The opposition proceedings are initially conducted in writing, but any party to the proceedings has the right to request oral proceedings. This will take the form of a hearing held with members of the EPO, either via videoconference or on-site in Munich or The Hague, at the end of the written procedure.

7) Opposition decision - A decision by the Opposition Division of the EPO will be issued in writing or, in cases where oral proceedings have been requested, at the end of the hearing as a brief verbal decision, followed by a more detailed decision in writing. There are three possible outcomes of an opposition: 1. the opposition is rejected and the patent maintained unamended; 2. the patent is maintained but in an amended form; 3. the patent is revoked in its entirety.

8) End of the opposition proceedings - When the decision is issued the opposition proceedings come to an end.

9) The two month period to file a Notice of Appeal - Within two months of the date of the written decision, any party adversely affected by the decision has the right to file a Notice of Appeal (e.g. proprietor if the patent is revoked or maintained in amended form, opponent if the opposition is rejected).

10) Statement of Grounds and Evidence - The Notice of Appeal must be followed within four months of the date of the written decision by a Statement of Grounds and Evidence. Fresh evidence is not usually admitted at the appeal stage.

11) Parties involved in appeal proceedings - An appeal filed against a decision of the Opposition Division will involve both the proprietor of the patent and the opponent(s). These proceedings are inter partes.

12) Duration of the appeal proceedings - The appeal proceedings may last two years or more.

13) Written and oral appeal proceedings - Appeal proceedings are conducted in writing but any party to the proceedings can request oral proceedings. This will take the form of a hearing held in Munich at the end of the written procedure.

14) Appeal decision - A decision will be issued by the Board of Appeal. With this decision the appeal proceedings will terminate.

15) No further appeal - No further appeal is generally possible against a Board of Appeal decision, although a Petition for Review may be submitted to the Enlarged Board of Appeal in very limited circumstances.

Publication

All details of opposition and appeal proceedings, including grounds and evidence as well as our defence and the final decision, will be made available to the public. Any opposition oral proceedings are open to the public. Thus, even if you do not oppose a competitor's patent yourself, you can monitor the opposition and appeal process and attend oral proceedings. It is possible to set up automatic email alerts of any events happening in the opposition and appeal process, using the EPO's "Register Alert" service, and to view all the documents on-line.

Representation

A company from outside Europe must be represented at opposition and appeal proceedings by a European Patent Attorney or legal practitioner in one of the EPO member states, for example a solicitor or barrister. However, it is important that the person conducting the proceedings is familiar with the European opposition and appeal process, while possessing all the technical skills and experience necessary to put a case across effectively appropriate to the requirements of the EPO forums. At Murgitroyd, your attorney is skilled at advocating for their clients, whether attacking or defending a patent.

What to do if your patent is opposed?

If your patent is opposed, bear the following in mind at the stages listed below.

Initial stage

The EPO will notify us quickly after a Notice of Opposition is filed against your patent. If no notices are filed within the nine month period, you will be informed accordingly soon after the end of the nine month period. If your patent is opposed, it is advisable to take action if you wish to maintain the patent. Opposition against the same patent can be filed by more than one party, but all oppositions will be dealt with together in a single procedure.

After the EPO sends us a copy of the opposition, they will then check the notice to ensure that it complies with formal requirements.

If the formal requirements are met, responsibility falls to the Opposition Division, made up of three examiners, only one of whom may have been involved in the Examining Division which granted the patent. The Opposition Division will invite us, within a limited period of time, to compile a response in the form of observations. The period is typically four months.

Responding to the notice of opposition

Despite the time pressure, we must submit within the allocated time all the facts, evidence and arguments which should be considered in support of your patent.

It may be appropriate to seek amendment of the claims of your patent.

Our response will be forwarded to the opponent(s), who can then comment on our defence. We will have a further opportunity to react to their comments.

Evidence filed late may not be considered. It is therefore vital that our initial response and reaction to comments are thorough and include all documents, expert opinions and written sworn statements upon which you wish to rely (even if we opt for oral proceedings, see below). To achieve effective management of this crucial stage of the process, your Murgitroyd attorney will be able to highlight exactly what type and format of evidence will be helpful to support our case.

Likewise, amendments to the claims filed late may not be accepted. It is therefore very important as proprietor to submit auxiliary requests to cover all reasonable fall-back positions within the deadlines set by the EPO.

Oral Proceedings

Oral proceedings can provide an opportunity for us as your representative to argue your case in person. Sometimes arguments can be made more clearly in a face to face presentation. Requesting oral proceedings prevents the Opposition Division from issuing an early adverse written decision.

Oral proceedings are now primarily held by videoconference unless there are particular complexities to the case which the Opposition Division deems more appropriate for an on-site hearing in Munich or The Hague. The Opposition Division will not hold oral proceedings by videoconference if the proceedings require the taking of evidence by hearing witnesses, parties or experts or by inspection, or if there are other serious reasons for not doing so.

Appeal

We can appeal against the decision on your behalf if it goes against us.

Checklist before responding to a Notice of Opposition

If your patent is opposed and we have to respond to a Notice of Opposition, check the following in preparation for our response. Your attorney at Murgitroyd is skilled at guiding you through these points.

Assess the strength of the opponent's case

Issues to consider: The relevance of the prior art cited by the opponent and other prior art known to you (check publication dates of any cited material).

Evaluate amendments to limit the scope of claims

Issues to consider: What reduced scope of claims would be acceptable? What basis is there in the application as originally filed for useful amendments?

Amendments to the claims filed late may not be accepted. It is therefore very important as proprietor to consider auxiliary requests as fall-back positions. The number of auxiliary requests should however remain relatively limited and a convergent approach should be adopted.

Although clarity is not a ground for opposition per se, the patent must satisfy all the articles and rules of the European Patent Convention after the claims have been amended. Any amended claim should also be reviewed to determine if it has an acceptable scope.

Undertake searches/experimentation

Issues to consider: Evidence and arguments cannot usually be introduced at a later stage. This is the last opportunity to conduct comparative testing or undertake the preparation of other evidence. Collecting or producing new data may be a lengthy process. It is therefore essential to evaluate the need for such data promptly.

Research history of invention and/or alleged prior use

Issues to consider: If the opponent has cited prior use or prior public disclosure of the invention as prior art, check the actual circumstances. Was the disclosure really public? Did it actually occur under terms of confidentiality?

Identify expert witness

Issues to consider: Are witnesses required to counteract a witness proposed by the opponent? Are any witnesses required to counter claims of prior use or prior public disclosure? Note: The EPO is generally reluctant to place too much weight on witness statements relating to what the “person skilled in the art” would do or think. However it will usually take at face value any witness statements about “prior use”, unless these are challenged by other evidence and/or witness statements.

What to do if you oppose a patent?

If you wish to oppose a patent, bear the following in mind at the stages listed below.

Initial stage

We must file a Notice of Opposition at the EPO within the nine month period. An extension of that period will not be granted. Therefore notify your attorney as early as possible if you are considering opposing a patent, so that we can also monitor the deadline.

Notice of Opposition

As all evidence and arguments must be filed with the Notice of Opposition, late evidence may not be considered unless it is extremely relevant. It is therefore important to complete prior art searches, investigate prior use or prior public disclosure of the invention, and inspect prosecution files of corresponding patent applications in all relevant territories well before the nine month time limit expires. Your Murgitroyd attorney can help with all of these aspects.

Our Notice of Opposition must be thorough and identify all documents, expert opinions and written sworn statements upon which you wish to rely (even if we opt for oral proceedings, see below). To achieve effective management of the crucial stage of the process, it is important to be guided by your attorney.

Once we have filed a Notice of Opposition, we will be notified of any other oppositions filed by other parties against the same patent. All oppositions will be dealt with together in a single procedure. If there are other opponents, it may be advisable to arrange a meeting to agree a common strategy and avoid conflicting arguments.

Proprietor's response

Once the proprietor has responded to the Notice(s) of Opposition, it is crucial to review the response with your attorney at an early stage. This gives time for us to assess the suitability of any amendments made to the claims, and to conduct further searching or to gather further evidence if required. We will have a final opportunity to submit a final counter argument in the months before the hearing is scheduled, so it is prudent to be prepared by the deadline. Anything file after the deadline may not be considered.

Oral proceedings

Oral proceedings can provide an opportunity for us as your representative to argue your case in person. Sometimes arguments can be made more clearly in a face to face presentation. Requesting oral proceedings prevents the Opposition Division from issuing an early adverse written decision.

Oral proceedings are now primarily held by videoconference unless there are particular complexities to the case which the Opposition Division deems more appropriate for an on-site hearing in Munich or The Hague. The Opposition Division will not hold oral proceedings by videoconference if the proceedings require the taking of evidence by hearing witnesses, parties or experts or by inspection, or if there are other serious reasons for not doing so.

Appeal

We can appeal on your behalf against the decision if it goes against us.

Checklist before filing a Notice of Opposition

If you are opposing a European patent and you have to file a Notice of Opposition, check the following.

Assess why an opposition should be filed

Issues to consider: Is the patent being attacked globally? What will be the effect on commercial relationships? Is it better to approach the patent proprietor and seek a confidential commercial solution, e.g. a royalty free licence? Should the opposition be filed anonymously?

Assess what is expected of the opposition

Issues to consider: Is revocation of the entire patent sought? Or just the limitation or removal of certain claims? What reduced scope of the claims would be acceptable?

Undertake searches

Issues to consider: Evidence and arguments cannot be introduced at a later stage. This is the last opportunity to complete prior art searches.

Research history of invention

Issues to consider: Investigate whether there was prior use or prior public disclosure of the invention. Carry out inspection of prosecution files of corresponding patent applications in all relevant territories.

Identify expert witnesses

Issues to consider: Which witnesses are required? Are any witnesses required to testify to a prior use or prior public disclosure? Is any experimentation required, and if so, who should do it?

Checklist before commenting on a response to a Notice of Opposition

If you are opposing a patent and wish to comment on the proprietor's response to a Notice of Opposition, check the following.

Check timetable

Issues to consider: Comments must be filed within the time limit laid down by the Opposition Division of the EPO.

Assess the need for further searches

Issues to consider: If the patent proprietor has amended the claims, it may be appropriate to conduct further searches and present additional arguments.

Assess the support and clarity of any amended claims

Issues to consider: Do the amended claims find full support in the application as filed? Although clarity is not ground for opposition per se, the patent must satisfy all articles and rules of the European Patent Convention after the claims have been amended.

Murgitroyd

Among the largest and most progressive firms of European Patent & Trade Mark Attorneys, Murgitroyd have extensive experience of working with international organisations from all industrial sectors. We have a diverse range of experienced professional staff and are able to directly represent clients from our numerous offices within Europe, as well as having a number of client liaison offices in the USA.

We assist organisations in protecting their intellectual property rights and have a reputation for providing practical, commercially relevant and technically accurate advice. We also place great emphasis on servicing our clients' needs, anticipating potential areas of difficulty and resolving problems effectively.

Our EPO Opposition and Appeal Team has a wealth of experience in EPO opposition and appeal matters. For more information, contact Michael Marchant (michael.marchant@murgitroyd.com) or Laura Fè (laura.fe@murgitroyd.com) based in our London and Munich offices respectively