

# Opposition Practice at the EPO

by Dr. Daniel Alge, November 1999

## 1.: The Nature of the EPO Opposition Proceedings

The post-grant opposition proceedings at the European Patent Office (EPO) are initiated at a point in time, when the European Patent (EP) has already been split into a bundle of national patent rights. The aim of the opponent is not – as in traditional pre-grant opposition – the refusal of the patent application, but the revocation of an EP as granted with effect *ex tunc* in all designated contracting states (Art. 68 EPC). Indeed, a granted EP is already enjoying the same rights as would be conferred by a national patent granted in that state. Opposition proceedings are the only exception where the EPO has a competence for the EP after grant. It should be remarked that the EPO cannot take any action in respect of a granted EP, however clear it may have become after grant that the EP is invalid, unless initiated by an admissible opposition. Otherwise (if no opposition is filed), the (national part of the) EP may only be attacked by national revocation proceedings.

Due to these facts the opposition proceedings at the EPO are regarded as being related to the concept of traditional revocation procedure. Such post-grant opposition proceedings under the EPC are therefore considered as contentious proceedings between opposite parties normally representing opposite interests (in contrast to observations filed (anonymously and free of official fees) by a third party according to Art.115 EPC; such a third party is not a party to opposition proceedings). This has also been clarified by excluding the patent proprietor from the expression „any person“ in Art. 99 EPC, so that it is not possible for the proprietor to file an opposition against his own patent (decision of the Enlarged Board of Appeal 9/93 (G9/93)): if the proprietor was an opponent, there would be no contentious proceedings. With respect to the nature of the opposition proceedings it is essential that the deciding body (the opposition division (OD) or the Board of Appeal (BoA)) takes a neutral position between the warring parties. The opposition division has therefore to be unbiased and impartial with respect to any party (G5/91).

Moreover, the right to be heard (to present comments; Art. 113 EPC) has to be carefully considered with respect to each party. It is therefore especially for opposition proceedings important to notice that a decision may not be based on facts which a party could not comment on. Finally, the opposition proceedings have neither devolutive nor suspensive effect, especially with respect to the (national) validity of the EP.

Due to this nature of the opposition proceedings, the extent to which an EP is opposed is in the sole discretion of the opponent. The initial request determines the extent of the proceedings (party disposition). If the opposition as filed only relates to parts of the patent (e.g. only to some, but not all of the independent claims), the OD may only examine these parts of the EP. The formal competence of the OD is strictly limited to these parts (G9/91).

Once initiated, the opposition proceedings, however, have merely administrative character

and the OD is enabled to investigate fully the grounds for opposition which have been both alleged and properly supported. Moreover, the OD even may on its own motion raise or consider a ground for opposition not covered by the opposition brief in cases where, prima facie, there are clear reasons to believe that such grounds are relevant and would prejudice the maintenance of the EP (Art. 114 EPC). Such ex officio examination by the OD has to be within the range of the extent of the initial request, but may also be continued even after withdrawal of the opposition by the opponent or in the event of death or legal incapacity of the opponent (R. 60(2) EPC).

The opposition proceedings are independent from examination proceedings. Therefore, documents of prior art and the content of the examination files are not automatically part of the opposition proceedings.

In opposition proceedings, each party bears its own costs. The OD may order a different apportionment of costs „for reasons of equity“ (Art. 104 EPC), e.g. if one party has caused the other additional expense, e.g. by filing evidence late, or otherwise abusing the proceedings.

The opposition is regarded as being an inseparable part of the business assets of an opponent. In the case such business assets are transferred or assigned also the opposition, which is part of them is assignable or transferable (in accordance with the principle that an accessory thing becomes part of the principal thing („accessio credit principali“; G4/88)).

## **2.: The Proceedings: From the Opposition Brief to the Final Decision**

### ***2.1.: The Opposition Brief***

Apart from the identification of the opponent (R. 55a EPC) and the number, title and proprietor of the opposed EP (R. 55b EPC), the notice of opposition has to contain a statement of the extent to which the EP is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds (Art.99 and R. 55c EPC). The statement according to R. 55c EPC establishes the legal and factual framework within which the substantive examination of the opposition in principle is conducted.

The notice of opposition may be filed in any of the official languages of the EPO (German, English or French) or in a national official language according to Art. 14(4) EPC. In the latter case a 20 % reduction of the opposition fee is possible.

#### **2.1.1. The Opponent**

The opponent may be any person, except the proprietor (G9/93). A prerequisite for an admissible opposition is that the opponent is clearly identifiable (R. 55a EPC) within the opposition term. Errors in the name or address may be corrected if the identity of the opponent is sufficiently defined in the opposition brief. It is even possible to file an opposition on behalf of a third party, if this is not connected with a

circumvention of the law by abuse of process. Such a circumvention of the law arises e.g. if the opponent is acting on behalf of the patentee or on behalf of a client in the context of activities wherein the lack of appropriate representation is given (G 3/97).

If more than one opponent is present, each opponent is an independent party in opposition proceedings and the different notices of opposition as well as all other communications are communicated to all parties.

### 2.1.2. The Opposed Patent

The opposed patent has to be sufficiently identified in the opposition brief (R. 55b EPC). Errors in the number or the title of the EP or in the name of the patentee are correctable if the EP is clearly identifiable by the information in the opposition brief.

### 2.1.3. The Extent, Grounds, Facts, Evidence and Arguments on which the Opposition is Based

According to R. 55c EPC, the notice of opposition has to contain a statement on the extent to which the EP is opposed as well as the grounds on which the opposition is based. As outlined above, the definition of the extent in the opposition brief defines the formal area of competence wherein the OD is allowed to act, whereas the grounds for opposition as raised by the opponent concern the procedural principles to be applied in the opposition proceedings (G9/91).

The possible grounds for opposition are defined in Art. 100 EPC:

- Art. 100a EPC: the EP lacks novelty (Art.54 EPC), lacks inventive step (Art. 56), lacks industrial applicability (Art. 52(4) and 57 EPC), is not a patentable invention (Art.52(2) EPC), is excepted from patentability (Art. 53 EPC); although these grounds are summarised under Art. 100a EPC, all these grounds are regarded as individual grounds (G 1/95);
- Art. 100b EPC: the EP does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 83 EPC);
- Art. 100c EPC: the subject matter of the EP extends beyond the content of the (first) application as filed (Art. 123(2) EPC).

This list of grounds is complete, other grounds (e.g. especially lack of clarity (Art. 84 EPC), lack of unity (Art. 82 EPC), prior national rights (Art. 139 EPC) or fraud with respect to the EPO (see: US law)) are no grounds for opposition. Although there are some decisions of the BoA of the EPO in which both, Art. 84 and Art. 83 EPC, are seen as relevant aspects under Art. 100b EPC, this practice is currently limited to cases, where essential elements of an invention are missing in the granted claims.

There is no duty for the OD for an obligatory review of all grounds. Although the OD may of its own motion raise a new ground (Art. 114 EPC), this is only allowed for the OD if there are – prima facie - clear reasons that such grounds are relevant.

In addition to the grounds for opposition, each of these grounds has to be substantiated in the opposition brief with facts, evidence and arguments. These facts,

evidence and arguments have to be presented in a way that they are understandable and may be examined by the OD and the proprietor. Otherwise, the opposition is rejected as inadmissible. Examples of inadmissible substantiation have been decided to be: a general statement that the EP is not novel or not inventive with respect to the documents cited in the European search report; the citation of only prior national rights as prior art; relying on a 200 page document without identification of relevant passages.

If prior public use (in the context of novelty and inventive step) is raised as a ground for opposition, sufficient substantiation has to include: the date of prior use, the exact subject matter which has been used and the circumstances of such prior use.

## **2.2.: From the Opposition Brief to the Final Decision**

### 2.2.1.: Proceedings Without Oral Proceedings

The opposition brief is examined by the OD. If the OD notes

- that the brief does not contain a reasoned statement of the extent and grounds of the opposition (including facts, evidence and arguments); or
- that the opposition fee has not been timely paid (i.e. within the opposition term);

the notice of opposition is rejected as inadmissible, unless the deficiencies have been remedied before expiry of the opposition period (R. 56(1) EPC). If other formalities are not in compliance with the EPO practice, the opponent is invited to remedy these deficiencies (R. 56(2) EPC).

In the case of an admissible notice of opposition, the opposition is communicated to the proprietor of the EP. The proprietor is invited to file his observations. The proprietor may also file amendments to the claims as well as to the descriptions and the drawings (R. 57(1) and 58(2) EPC). Such amendments are only admissible if they are made with respect to one of the grounds raised in the opposition proceedings (R. 57a EPC). This observation of the patentee is communicated to the opponent. An invitation of the OD (with a fixed period to reply) is connected with such a communication, if the OD considers it expedient (as often as necessary; Art. 101(2) EPC). Otherwise, only a notice is sent to the other party (without invitation to reply). Of course, each party may file observations, even without invitation.

The OD also issues communications (to the patentee) in which the OD summarises its opinion with respect to the opposition. In such a communication the patentee may be invited to file e.g. amended claims. All such communications to the proprietor have to contain a reasoned statement which should cover all grounds against the maintenance of the EP (R. 58(3) EPC).

Then the OD revokes the patent, if it is of the opinion that the grounds for opposition prejudice the maintenance of the EP (Art. 102(1) EPC), or rejects the opposition, if it is of the opinion that the grounds for opposition are not sufficient for revocation (Art. 102(2) EPC). In the case that the EP has been amended by the patentee and the OD is of the opinion that the EP in the amended form fulfils (all) the patentability criteria of the EPC, it decides to maintain the patent as amended. This is usually done in an

interlocutory decision (separate appeal allowed). The written proceedings are closed, when the decision is handed over by the formalities section of the OD to the EPO postal service (G 12/91).

### 2.2.2.: Proceedings With Oral Proceedings

Oral proceedings have to be explicitly requested by any party in the course of the opposition proceedings prior to a decision being given, or if the OD considers it expedient. After the communication of the opposition to the proprietor and optionally after communication of the proprietor's statements or further counter or counter-counter-(ad.lib.)-statements, the parties are summoned to oral proceedings by the OD (minimum period: 2 months). When issuing the summons, the OD communicates the points which – in its opinion - need to be discussed for the purposes of the decision to be taken. Also a final date for making written submissions in preparation for the oral proceedings is fixed. If accompanying persons will attend (inventor, foreign patent attorneys, members of the patent group of the client, etc.), their names and the topic of their potential contribution should also be provided in the preparatory statements (G 4/95).

New facts and evidence presented after that date need not to be considered by the OD. Such new facts may be new claims with features contained in the description; new evidence may – apart from new prior art documents - comprise comparative results or scientific declarations.

At the begin of the oral proceedings the parties and representatives are identified and the requests are brought forward (again). The agenda of the oral proceedings is typically designed to clarify formal aspects (Art. 123(2) and enablement (Art. 83); for new claims: Art. 123(3) (extension of granted claims is forbidden) and Art. 84 (clarity of claims) also) first and to address material questions (novelty, inventive step) afterwards.

A typical oral proceedings before the OD at the EPO has the following agenda: Art. 123(2) and (3); clarity; enablement; novelty; inventive step. Each of these issues is separately decided by the OD and may not be discussed afterwards, even when overlaps between some points exist (as e.g. between enablement and clarity, between enablement and inventive step and between novelty and inventive step). Finally (if the decision should be based on amended claims), the specification also has to be brought into conformity with the amended claims.

The decision at oral proceedings is therefore a summary of a number of sub-decisions each independently made one after the other in the course of such an oral hearing. The reasons for the decisions (as well as the protocol) have to be filed afterwards (usually somewhere between 2 weeks and 3 months after the date of oral hearing) in written form to the parties. The date of this written decision is important for the period for filing appeal. Occasionally, the OD also indicates at least parts of the reasons for the decision already at the oral hearing.

### **2.3.: Comments**

Since the requests and grounds as given in the notice of opposition define the scope to which the examination of the OD extends (Art. 114 is not very frequently applied – only in „prima facie“ - cases), it is essential to bring evidence to as many grounds as possible in the opposition brief. It is not necessary to bring all the detailed proofs already with the opposition brief or that the argumentation is already striking and convincing, however, the basis for these proofs or argumentation should already be given in the statements contained in the opposition brief.

In opposition proceedings (as well as in all other proceedings before the EPO) it is important to understand that the concept of novelty of the EPO is rather narrow. It is therefore essential for the argumentation with respect to novelty to characterise all features of a claim to be examined properly and compare all these features with a potentially novelty destroying prior art. Implicit Disclosure is only in exceptional cases accepted by the EPO.

With respect to inventive step the problem/solution approach is in more or less all cases applied, especially in oral proceedings. The OD follows the route for defining inventive step as defined in the guidelines (“Guidelines for Examination in the European Patent Office” Part C – Chapter IV: 9) very closely. (Mis-)use of this approach is therefore mandatory, at least in oral proceedings.

One of the arguments which makes the decision in most cases where inventive step has to be considered are comparative results. Comparative results, however, should be well designed in order to succeed (with respect to the closest prior art, the claim language and the alleged (unexpected) effects). Here the patentee generally is in a better position and should make use of this advantage.

The OD at the EPO consists either of three technical examiners or (in rare cases the OD is enlarged by a legally qualified examiner). The „primary“ examiner (i.e. the examiner being entrusted with the examination of the opposition) is in most cases the examiner who has been responsible for the grant of the patent. He was the one who allowed the claims now being attacked by the opponent. It is clear that this member of the OD has already a certain bias toward the invention and that at least some new facts and arguments should be brought forward by the opponent in the case this member shall be convinced by the opponent. All other members of the OD must be examiners which have not taken part during the examination proceedings: the chairman and the protocolist.

As in all patent offices, senates like the OD are composed of people having different attitudes and (often) different opinions. The examiners of the EPO, especially the older ones, have been educated in national patent offices and have in many cases kept their general attitude towards patent right also at the EPO. Although they act in line with the established rules and decisions of the EPO, certain concepts of patent law (inventive step, sufficient disclosure, claim formalities) with a different tradition in some member countries can affect the opinion of the examiners. A typical example for this is the attitude of the OD with respect to inventions with claims which are overbroad or not precise enough (and unclear) and wherein e.g. an essential feature is missing. Whereas an OD with a majority of members with an UK related legal

background („UK biased OD“) would view such a claim as invalid under consideration of clarity and enablement, an OD with a majority of members with a more German related education („DE biased OD“) would invalidate such a claim under Art. 56 EPC (lack of inventive step), because the object of the invention is not solved by the claim. It has been explicitly clarified by the Enlarged Board of Appeal that an objection to a member of an OD may not be based on nationality (G5/91). An opponent/proprietor may therefore have advantages before the OD if such circumstances are considered.

On the other hand, also the technical background of the OD members differs. Whereas the primary examiner generally is – at least with respect to his knowledge about the special field of technology – an expert in this technical field, this may or may not be the case for the two other. Another variable is whether they have a practical background in this field of technology or only a theoretical knowledge thereof. The educational (legal and technical) background of the members of the OD is – in some cases – an valuable information for designing the strategy (e.g. for presenting the subject matter of the invention in question), especially during oral proceedings.

When oral proceedings are prepared, it is important to file all new grounds, proofs, arguments, etc. early enough; of course before the time limit set in the summons. New matter filed after this time limit may be disregarded (Art. 114(2) EPC) or – if they are prima facie material – may lead to the postponement of the proceedings, which may then lead to a decision on the apportionment of costs.

Facts or evidence which are presented at the oral proceedings for the first time are – in most cases – not considered, except e.g. documents which are short enough to consider within 5 or 10 minutes and e.g. clearly take away novelty of a claim; or additional proofs (or addition to proofs) which are short, clear and assist in the argumentation already on file. Moreover, it is rarely accepted by the OD that the proprietor files a new claim set which is based on a feature which is taken from the description and is not already claimed in a subclaim. New (auxiliary) claims therefore should also be filed with a preparatory statement well before the oral proceedings, if these claims contain new features only being present in the description.

In oral proceedings, accompanying persons (scientists, inventors,..) may play an important role, because the OD often pays much attention to expert presentation. In order to be helpful in amplifying a certain way of argumentation, the comments of an accompanying person should be in line with this argumentation. Since these persons do not often have a thorough understanding of the legal concepts behind novelty, inventive step,..., it is important to prepare them well for such oral proceedings, if they should play an active role. It is helpful, when a scientist, especially the inventor, knows about the crucial questions and – at least to a certain extent – the way how these questions are legally addressed by the OD. Apart from the technical and the legal background of the accompanying person, also the personality should be considered, especially in view of the structure of the OD.

It is important to name these accompanying persons in the preparatory statement to the oral proceedings and to announce their topic, because otherwise the OD can decide that such an expert is not heard. In rare cases, experts have been declined to talk at oral proceedings, because no topic was announced in the preparatory statement.

In opposition proceedings, especially in oral hearings before the OD it is important to avoid complicated argumentation. Simplification should be made as much as possible. Indeed also the problem-solution approach is a reductionistic simplification scheme. Indeed, complicated argumentation (e.g. to use more than 3 documents to prove lack of inventive step, presenting practical evidence that an invention does not work or a complex discussion to support a prejudice in the art) hardly leads to an acceptance of this argumentation. Moreover it seems to be a general attitude of ODs that the reference of a party to decisions of the BoA, which is regarded as relevant by the party, is not paid much attention to.

Before turning to the connection of national infringement proceedings with EPO opposition, it has to be emphasised that opposition proceedings at the EPO are frequently also initiated to clarify unclear claims. Although lack of clarity (Art. 84 EPC) is not a ground for opposition, questions of clarity of a claim can also be addressed when a document of the prior art is discussed in opposition proceedings. Statements and declarations of the proprietor with respect to the scope or the interpretation of a claim are (at least when these statements are written down in the decision or in the minutes) helpful and may even make a thorough nation-by-nation analysis with respect to claim language/doctrine of equivalence unnecessary. Such clarifications also need some kind of assistance from the OD (or the BoA). However, since the senates of the EPO often are not interested at all in problems which are associated with the enforcement of an EP, this aspect is not always easy to address.

### **3.: National Infringement Proceedings vs. EPO Opposition Proceedings**

National infringement proceedings and opposition proceedings at the EPO are independent proceedings. However, there are important connections as far as the validity of a patent in infringement proceedings is concerned and a parallel opposition proceedings is initiated or pending before the EPO. If infringement proceedings have been instituted against a third party, this party may intervene in pending opposition proceedings after the opposition period has expired (Art. 105 EPC). Such an assumed infringer has to file a notice of intervention and pay the opposition fee within three months of the date on which the infringement proceedings were instituted. The intervener may file new grounds, facts and arguments in this notice of intervention; he is not bound to the extent and the grounds already brought forward in the proceedings.

National revocation proceedings may be initiated before specialised senates associated with the patent office (Germany, Austria), before specialised courts (the Netherlands) or before ordinary (civil) courts. In Denmark and in Ireland it seems to be possible to choose between the revocation at the patent office and the revocation at court whereas in the United Kingdom, France, Switzerland, the Netherlands, Italy, Spain, Belgium, Finland and Cyprus nullification of a patent is only possible in (civil) court proceedings.

Often national revocation proceedings (either filed separately or within the context of infringement proceedings) are initiated at a point of time when opposition

proceedings (even between the same parties) are still pending. Although there are some issues of invalidity which are not within the power of the EPO to decide (prior national rights, patent granted to a non-entitled person, problems with extension of the patent due to individual amendments under national law), the essential facts and arguments may often be identical in EPO and national proceedings. The question then is how a national revocation/infringement board deals with such parallel EPO proceedings. Indeed there are a variety of possibilities which are realised by the contracting states: In Germany, it is prohibited by law to file national revocation proceedings against an EP. Infringement proceedings are stayed depending on the court's own opinion of the likelihood of the opposition succeeding. In Austria, proceedings for contestation of a EP has to be interrupted ex officio insofar as an opposition proceedings concerning the same matter is pending at the EPO. If a final decision of the EPO is issued, the national proceedings have to be stopped upon request or ex officio. Also in France, the court will normally order a stay of national proceedings. In Switzerland, Ireland, Denmark, Finland and the Netherlands, a stay may be ordered, however especially in Switzerland and in the Netherlands the circumstance of the case are considered first. In the United Kingdom, Belgium, Spain and Italy national proceedings are unlikely to stay.

Early initiation of infringement proceedings during (or even before) pending opposition proceedings at the EPO is – also in view of a high likelihood of staying – always recommendable when actions of alleged infringers may become statute barred. The limitation periods vary in the EPC member countries: 3 years in Austria, France and Germany; 5 years in Belgium, Denmark, Greece, Italy, Spain and Sweden; 6 years in Ireland and in the United Kingdom; 1 to 10 years in Switzerland; no statute of limitations in Luxembourg; in the Netherlands, damages are claimable only from the period commencing 30 days after a writ has been served on the alleged infringer. In some countries there is also room for the concept of an „innocent infringer“ who was not aware of the patent in issue (DK, FR, NL, ES, SE, IE and UK).

Moreover for interlocutory and preliminary injunctions the question of validity of the patent may not be a crucial point. There is of course a risk for the plaintiff who obtained and enforced a preliminary injunction against an alleged infringer, if the patent is revoked in EPO opposition proceedings.

The availability of cross-border jurisdiction and enforcement according to the Brussels (or Lugano) Enforcement Convention (BEC) seems to be in principle accepted in most EPC member countries (except UK; see: referral to the ECJ in *Fort Dodge v. Akzo Nobel* (GB)) as being possible also for infringement actions, at least if the defendant is sued at its domicile (Art.2 BEC), however, according to Art. 16(4) of this Convention any question of validity of patents is mandatorily a matter solely for the national courts of the State in which registration has, or is deemed to have, taken place. A new Article introduced into the Protocol to the BEC in 1978 provided a concurrent jurisdiction for opposition proceedings at the EPO, which indeed would have been excluded by this Protocol as well as by Art. 16(4) BEC.

It is clear that harmonisation with respect to civil court proceedings in the EPC member states are only possible in the context of general harmonisation of civil law or practice, however, especially questions like “to stay or not to stay” or the role and acceptance of decisions of opposition proceedings at the EPO do not seem to be connected with unresolvable general law practice.

**Abbreviations used:**

EPO: European Patent Office  
EP: European Patent  
EPC: European Patent Convention  
G./...: Decision of the Enlarged Board of Appeal  
OD: Opposition Division  
BoA: Board of Appeal  
Art.: Article  
R.: Rule (of the Implementing Regulations to the EPC)  
BEC: Brussels Convention on Jurisdiction and Enforcement of Judgements  
ECJ: European Court of Justice  
OJ: Official Journal of the EPO  
FSR: Fleet Street Report

**Decisions:**

G9/93: OJ 1994, 891  
G5/91: OJ 1992, 617  
G9/91: OJ 1993, 408  
G4/88: OJ 1989, 480  
G3/97: OJ 1999, 245  
G1/95: OJ 1996, 615  
G12/91: OJ 1994, 285  
G4/95: OJ 1996, 412  
Fort Dodge v. Akzo Nobel: FSR 1998, 222