

# Oppositions at the EPO

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presented by  
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FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

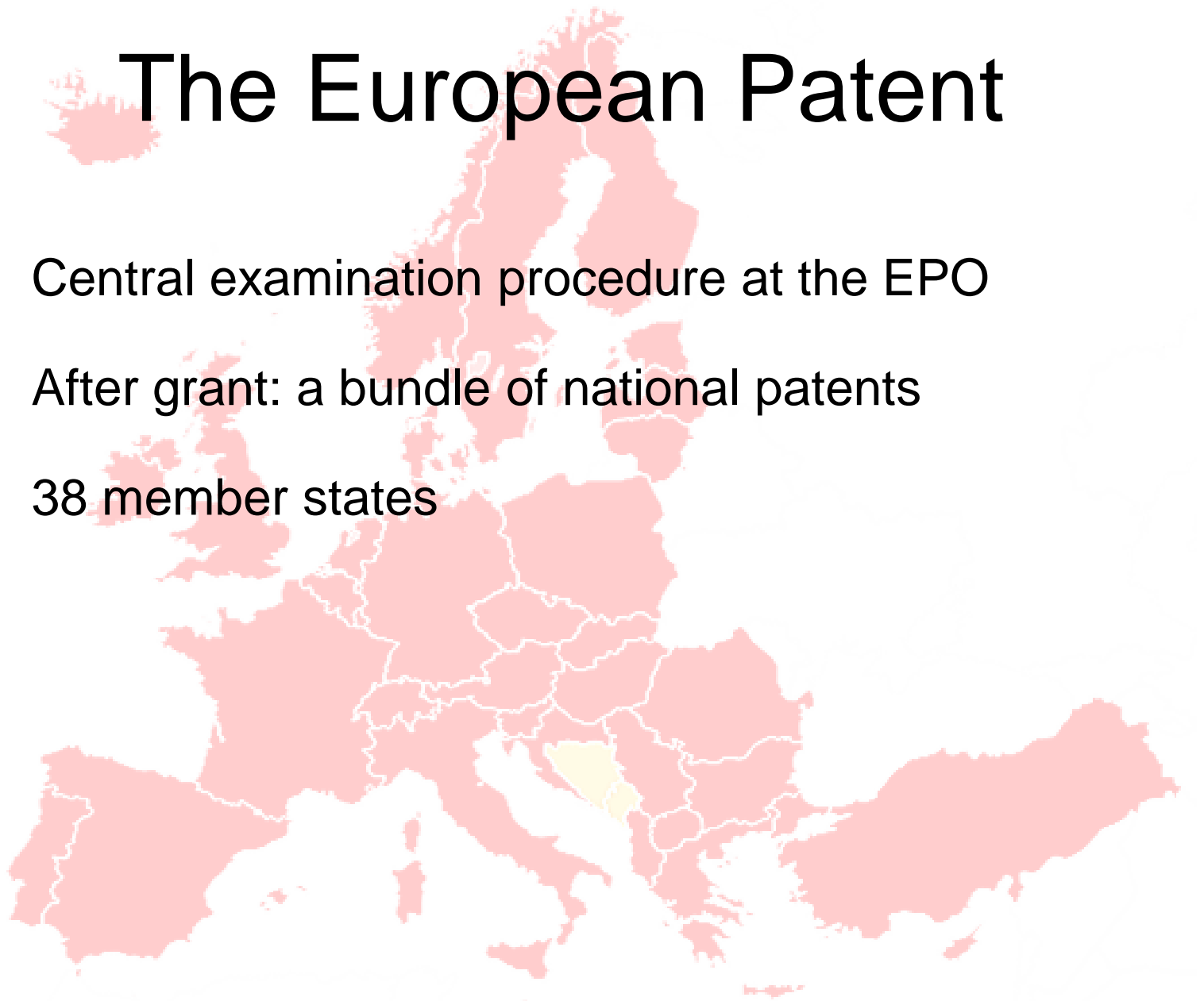
INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION  
VON PATENTANWÄLTEN



# The European Patent

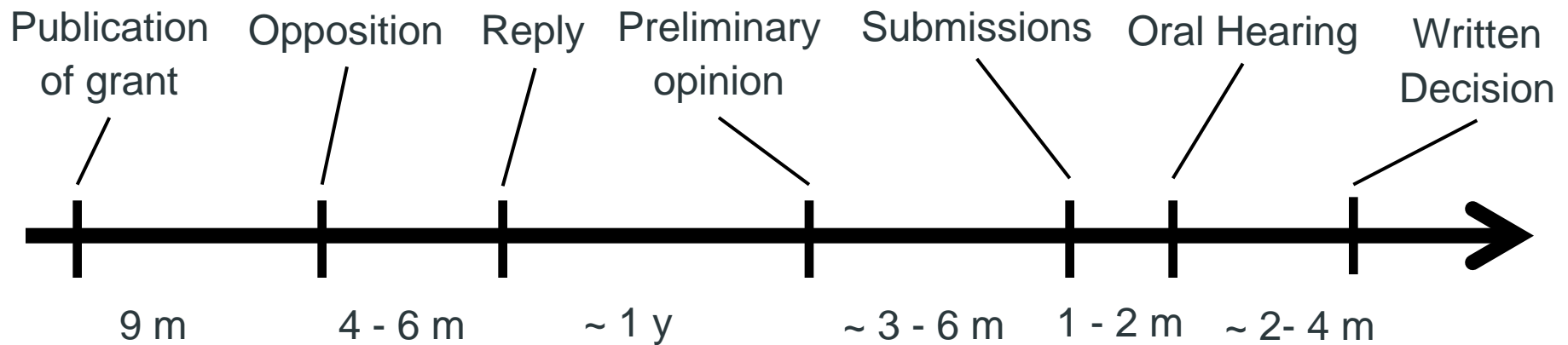
- Central examination procedure at the EPO
- After grant: a bundle of national patents
- 38 member states



# Key Points - Opposition

- Central attack
- After grant
- Time limit: 9 months
- Inter partes procedure
- First Instance: Opposition Division
- Second Instance: Board of Appeal

# Outline of the first instance Opposition Procedure



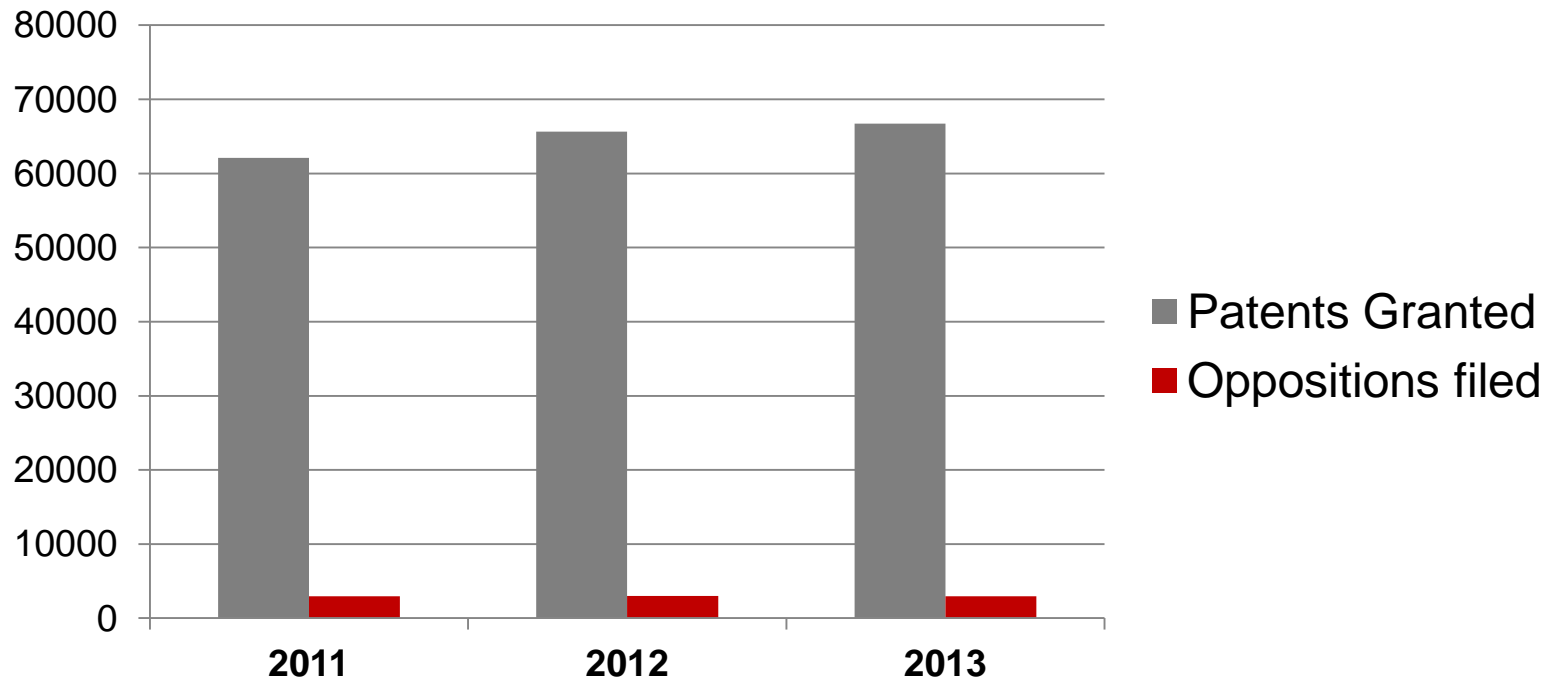
# Opposition Divison

- Usually 3 technical members, i.e. examiners from the EPO
- One examiner was usually involved in the examination procedure of the patent
- Chairman and second member not involved

# Appeal

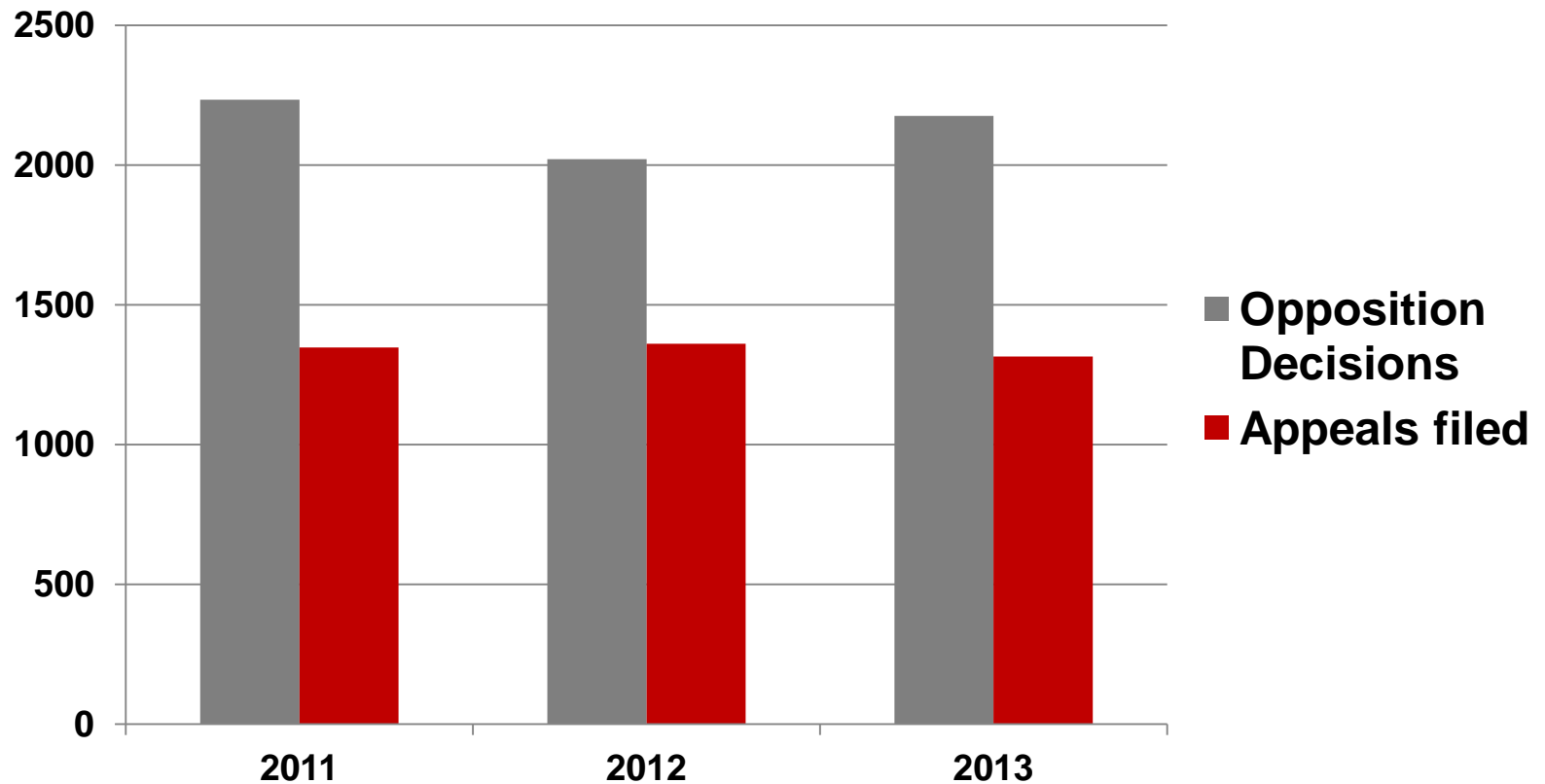
- Boards of Appeal at the EPO (usually 2 technical members, 1 legal member)
- Appeal proceedings similar to first instance proceedings (preliminary opinion / oral hearing)
- Decision of the Board of Appeal is, in practical terms, final; Further Appeal to Enlarged Board only in exceptional cases

# Patents Granted / Oppositions



Opposition rate: ~ 4,5 %

# Decisions ./ Appeals

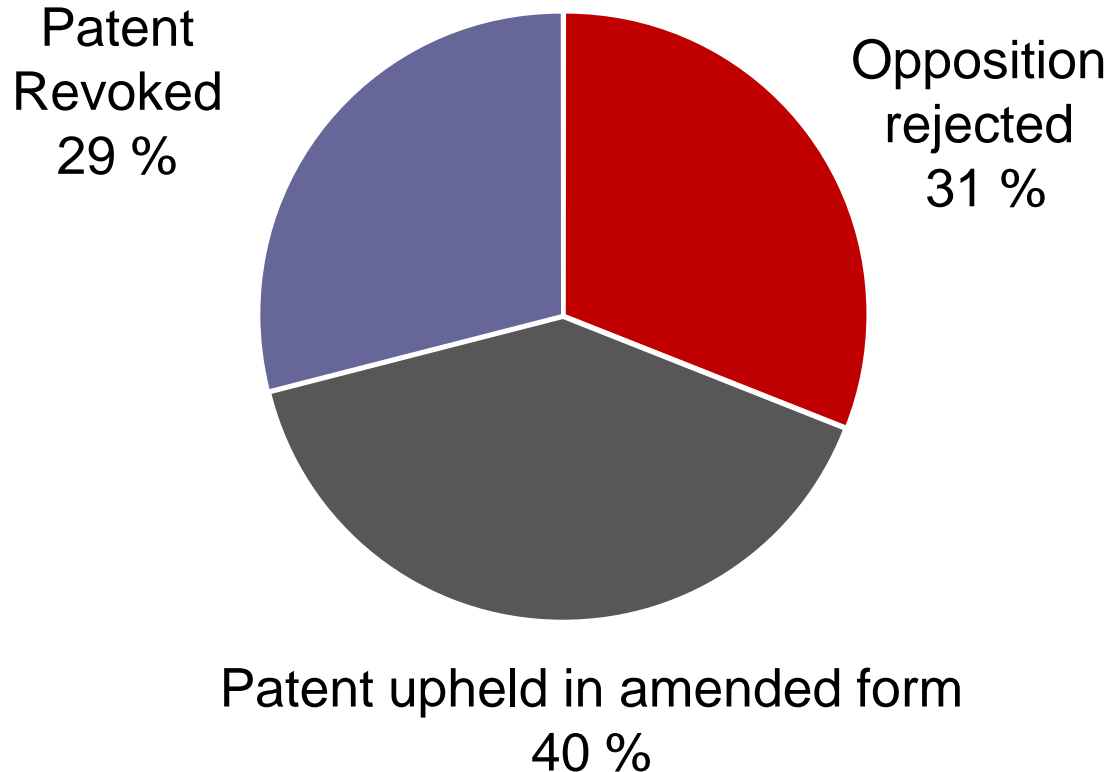


Data taken from EPO Annual Reports 2011 to 2013



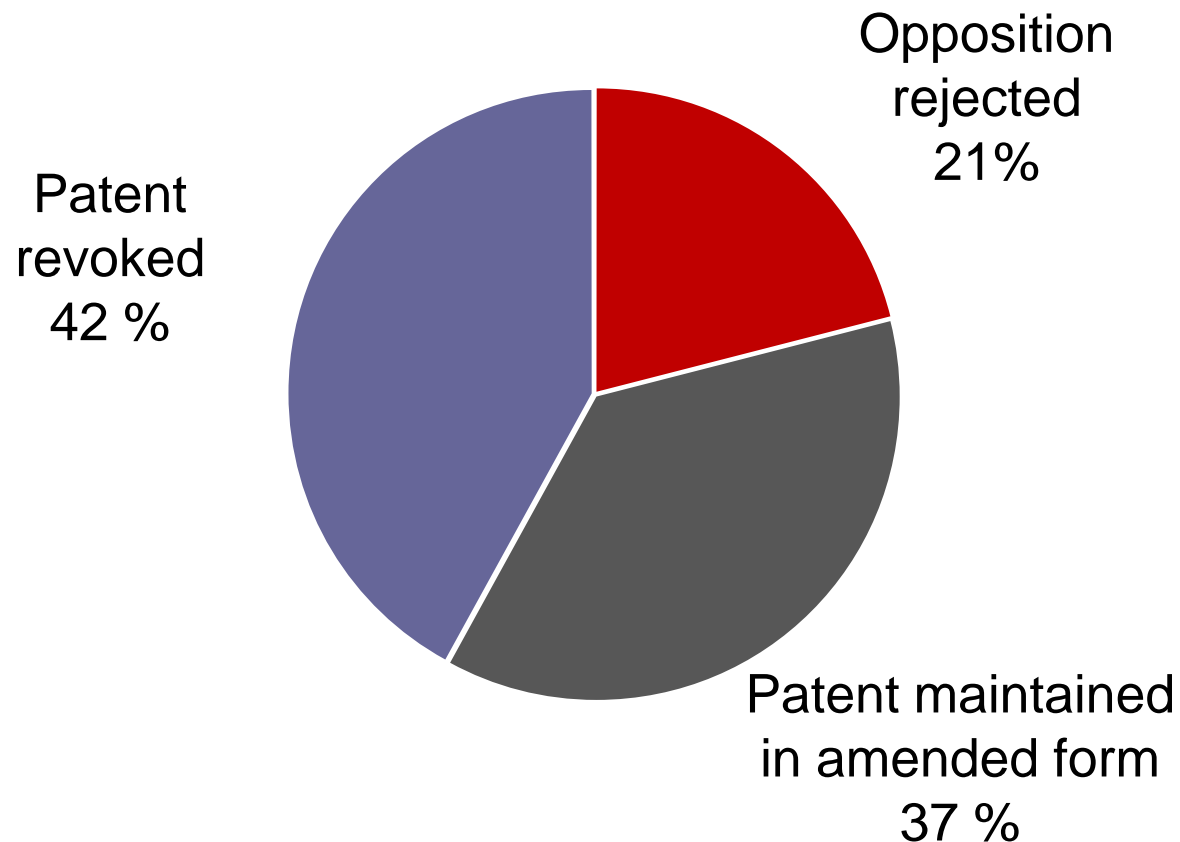
# First Instance Results

(2013)

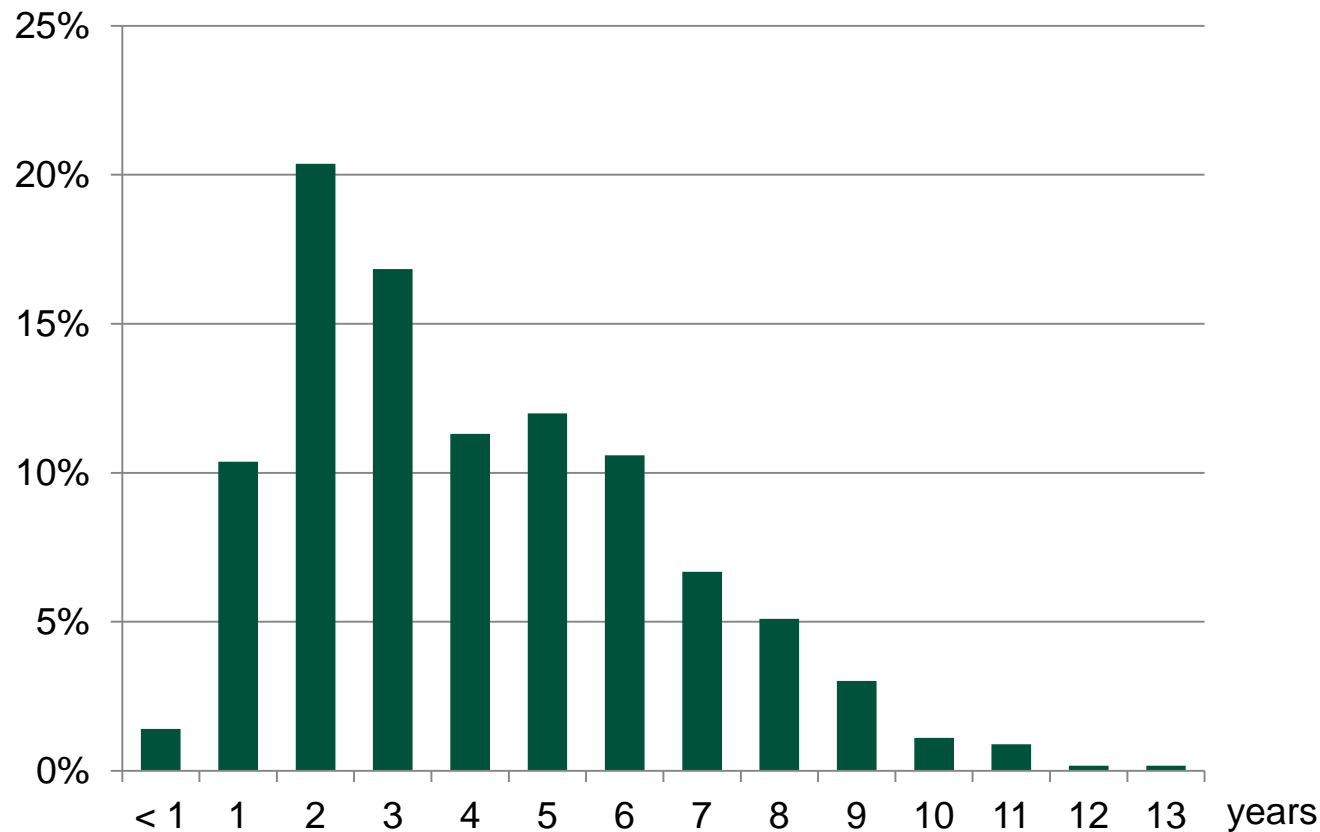


# Final Results

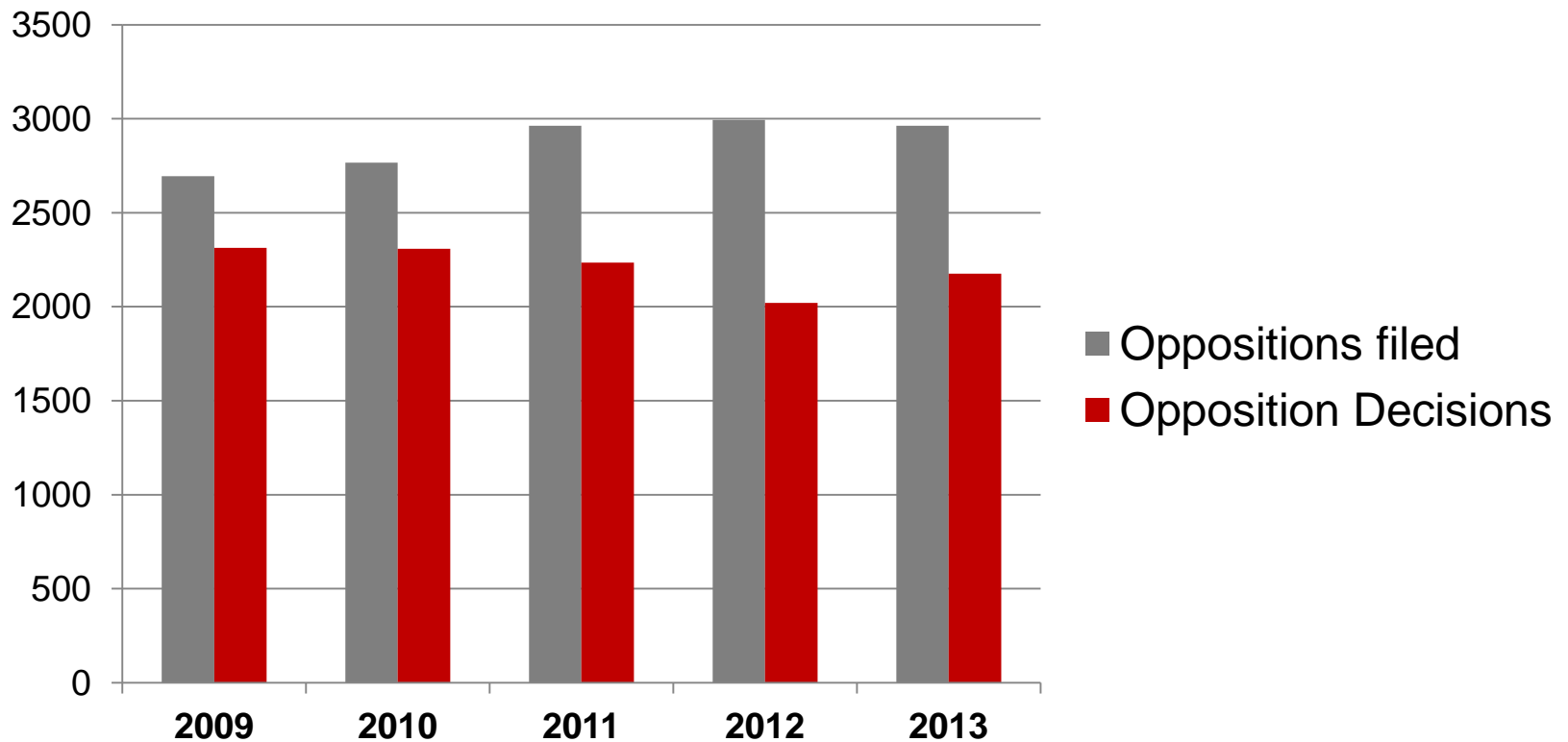
(2013)



# Time up to final decision (including appeal, 2013)



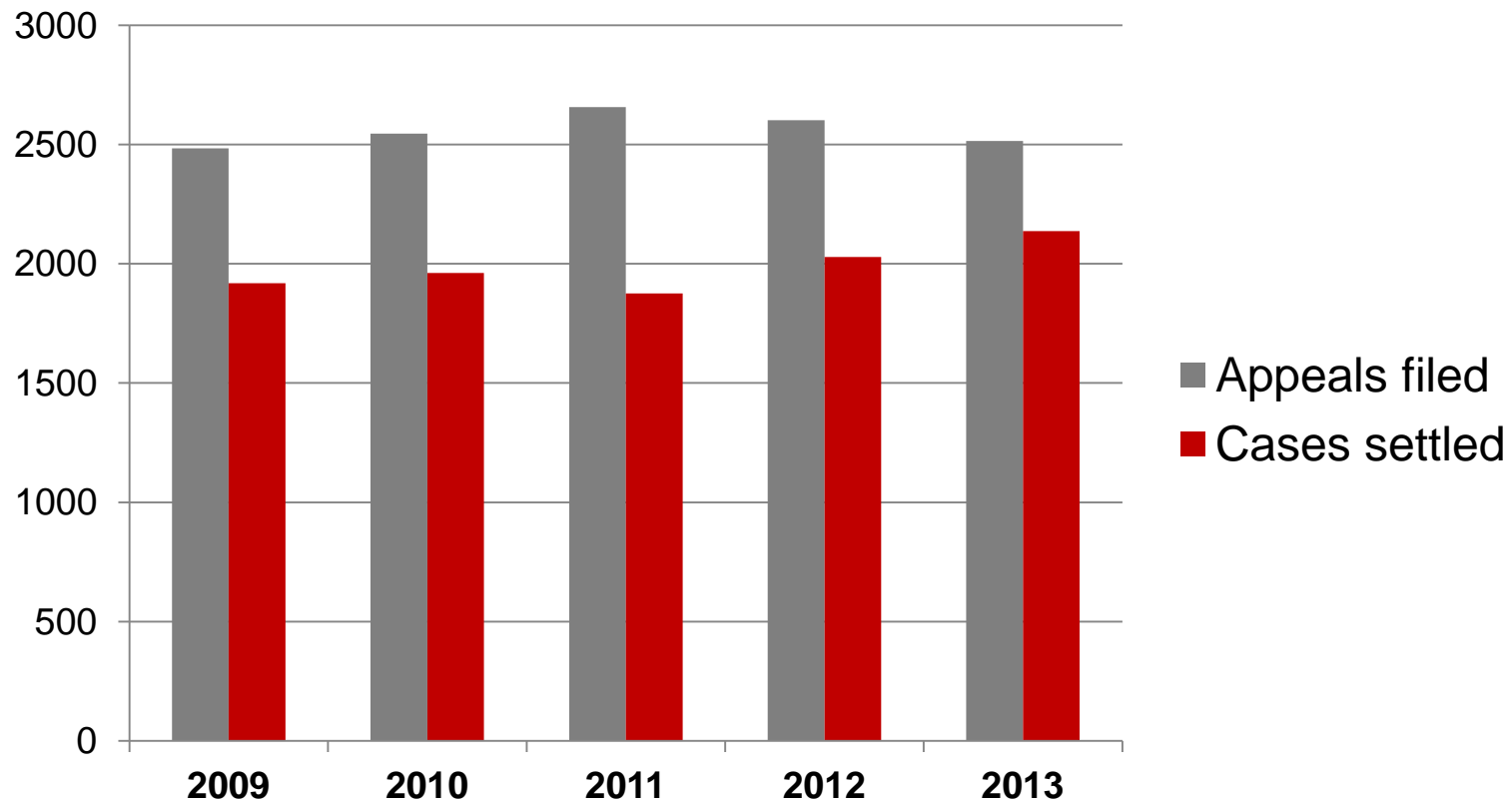
# Backlog in Oppositions



Data taken from EPO Annual Reports 2009 to 2013

# Backlog in Appeals

(total)



Data taken from EPO Annual Reports 2009 to 2013

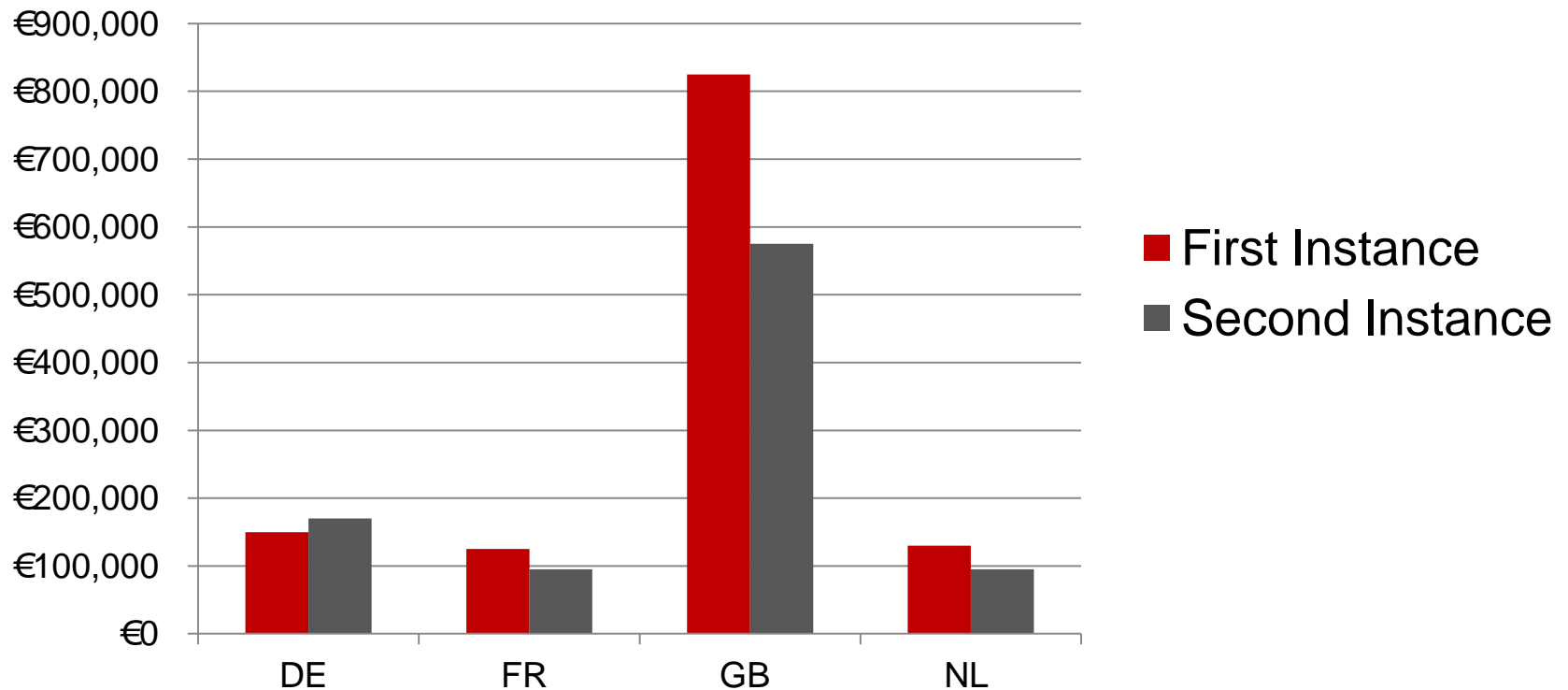
# National nullity actions: an alternative?

- A granted European Patent is a bundle of national patents
- The different national parts have to be attacked in separate, national nullity actions
- Diverging decisions, enormous costs

# Costs for an Opposition

- First Instance: Low complexity cases  
somewhere between 10 000 € and 20 000 €
- Second instance comparable to first instance
- Each party bears its own costs; no  
reimbursement

# Costs for Nullity Actions/ Litigation



Data taken from EPO 2006 EPLA Impact Assessment, averaged with respect to small and large scale cases



# Grounds for opposition I

- Patentability (novelty, inventive step, exclusions from patentability)
- Original disclosure in the application as filed
- Sufficiency of disclosure for carrying out the invention

# Grounds for opposition II

- Grounds for opposition cover all aspects of examination but for clarity and unity
- National grounds for nullity correspond largely to grounds for opposition
- Exception: Older but postpublished national patents are a matter of national law

# Amendments

- Allowed as long as they do not extend the scope of protection
- Can be taken both from the claims and the description
- Strict standards with respect to original disclosure and clarity

# Defense Strategy

- Opposition Division will revoke the patent if any independent claim within a claim set is not allowable
- Dependent claims are not examined on their merits
- Defense: Auxiliary Requests comprising further limitations to the independent claims

# Late filing in the First Instance

- Opponent: Everything that is filed after the end of the opposition period might not be admitted into the proceedings
- Applicant: New claims are usually admitted if filed within the time limit set in preparation of oral proceedings before the Opposition Division
- Opposition Division can enter new grounds for opposition on its own motion

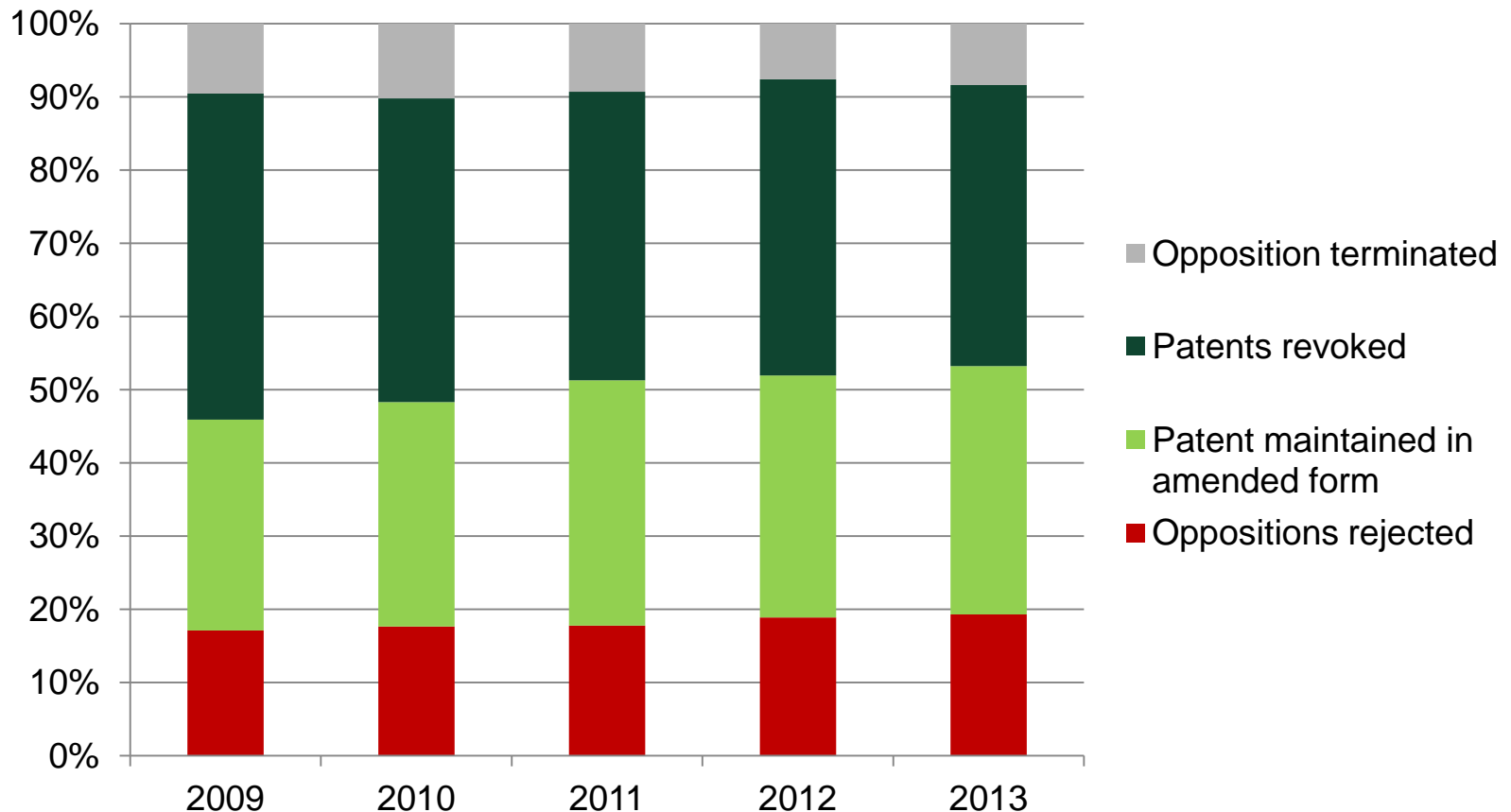
# Late filing in the Appeal

- Documents/Arguments/Claims
  - filed after the time limit for the substantiation of the appeal (appellant) or after the time limit for the reply to the appeal (defendant) or
  - that could have been filed before
- might not be admitted into the proceedings
- Standards are getting stricter

# Oral Proceedings

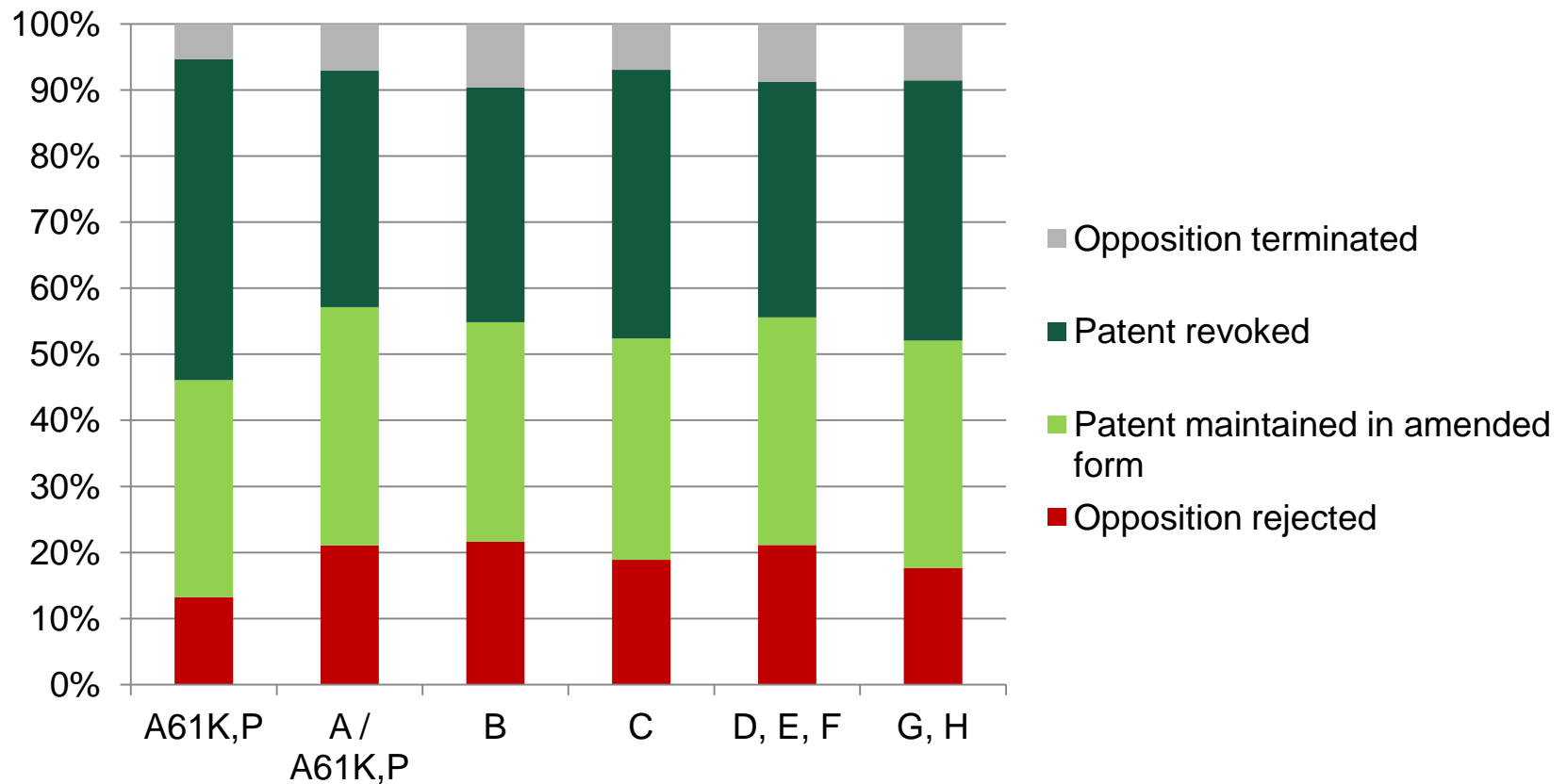
- Nearly always requested
- Decision usually taken step by step: Original Disclosure, Clarity, Novelty, Inventive step
- Final decision is taken at the end of the hearing
- Usually one day, no expert hearings

# Results over the past 5 years

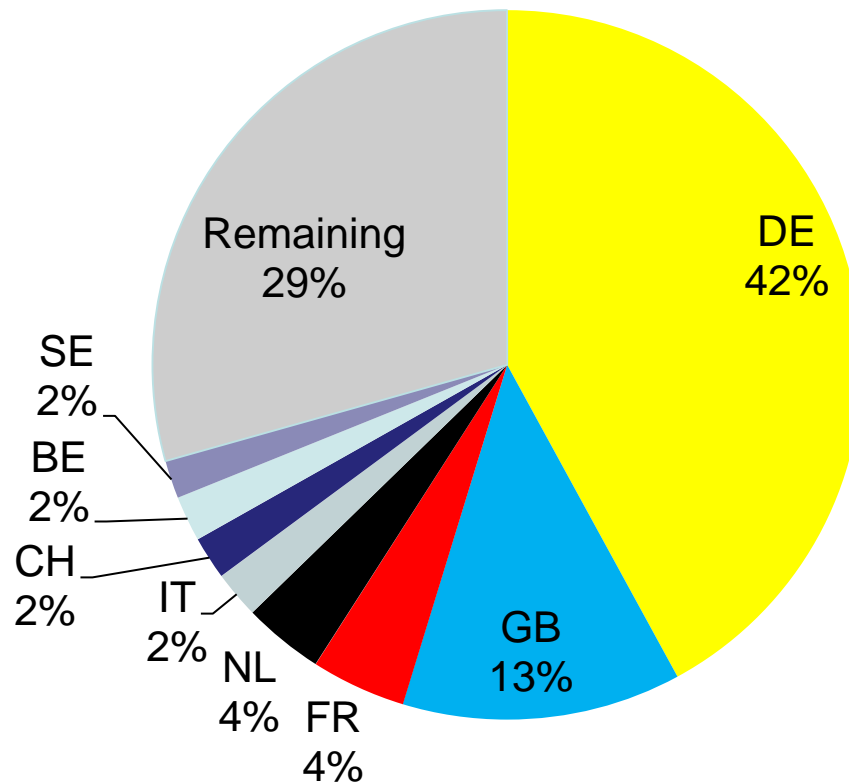




# Results by IPC class (2013)



# Nationality of Representatives (2013)



Thank You!

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