

Oppositions at the European Patent Office

The grant of a European patent can be opposed by a third party within nine months of the date of grant. An opposition is currently the only way to challenge the validity of a European Patent centrally, for all the designated states, and a successful opposition can result in the complete revocation of the patent in all of the designated states. The opposition procedure is summarised below.

When must the opposition be filed?

A notice of opposition must be filed within a non-extendable period of nine months from the date of grant of the patent. The notice of opposition must be accompanied by a reasoned statement setting out the grounds on which the opposition is based. An official fee must also be paid within the same period.

What are the grounds of opposition?

The possible grounds of opposition are unpatentable subject-matter, lack of novelty, lack of inventive step, insufficiency of disclosure (lack of enablement) and added subject-matter (lack of basis for an amendment in the application as filed). A lack of clarity of the granted claims is not a ground for opposition.

What happens next?

Once the notice of opposition has been filed, the patent proprietor is invited by the European Patent Office (EPO) to respond to the notice of opposition by setting out the reasons why the patent should be maintained, either as granted or in amended form, and the opposition rejected.

A period of four months is generally set for this response, and extensions of time are granted only in exceptional circumstances.

Once it has been filed, the proprietor's response is communicated to the opponent(s). The grounds of opposition and the proprietor's observations are reviewed by an Examiner, who is generally the Examiner who was responsible for granting the patent. The opponent and/or the proprietor may be invited to submit further written submissions after this initial stage, but it is more usual for a summons to oral proceedings (a hearing) to issue.

With the summons to oral proceedings, the Examiner normally provides a preliminary opinion on the issues raised and the points to be discussed further at the oral proceedings. As a rule at least six months' notice of the hearing date is given and the dates may only be changed in exceptional circumstances. The deadline for filing further written submissions by either party in advance of the oral proceedings is usually at least one month before the date of the oral proceedings.

What are auxiliary requests?

It is common in opposition proceedings for the proprietor to file one or more auxiliary requests to maintain the patent in an amended version should the main request for maintenance of the patent be rejected by the EPO. Each auxiliary request usually includes a set of claims which is narrower in scope than the preceding request, in order to provide a stronger position in relation to the cited prior art. In opposition proceedings, or at any time after grant, it is not allowable to broaden the scope of a European patent.

What happens at oral proceedings?

Oral proceedings take place at the EPO in Munich or The Hague and normally last a few hours. Each party is given the opportunity to present their requests and arguments orally to an Opposition Division made up of the Examiner, a Chairman and a Minute Writer. The proceedings tend to be less formal than a court hearing and the exact procedure will depend on the issues in the particular case. At the end of the oral proceedings, in almost all cases, the Opposition Division will issue a verbal decision either to maintain the patent as granted, to maintain it in amended form, or to revoke the patent in its entirety. No detailed explanation of the decision is given at the oral proceedings, but a written decision is issued later explaining the basis for the decision.

Can the decision be appealed?

The written decision can be appealed by the opponent if the patent has been maintained or by the proprietor if the patent has been revoked. If the patent has been maintained in an amended form, both proprietor and

opponent may be able to appeal. A notice of appeal must be filed within two months of notification of the written decision and the appeal fee paid. A reasoned statement setting out the grounds of appeal must be filed within four months of notification of the written decision. All the parties to the opposition are automatically party to the appeal and the appeal procedure is generally similar to the procedure before the Opposition Division. Oral Proceedings before the Appeal Board always take place at the EPO in Munich. The Appeal Board is made up of different, more experienced Examiners than the Opposition Division, who can decide to affirm or overturn the decision of the Opposition Division. If the Appeal Board overturns a decision to revoke the patent, the opposition may be remitted to the Opposition Division for examination of any remaining grounds of opposition. If the Appeal Board revokes the patent, there is no further possibility for appeal. However, if the Appeal Board maintains the patent as granted or in amended form, validity may still be challenged in each designated state separately via the local courts.

How long does an opposition last?

Opposition proceedings at the EPO normally take about 2-3 years, with any subsequent appeal taking a further 2-3 years.

How can we help?

We have extensive experience of acting for both opponents and patent proprietors in opposition proceedings at the European Patent Office in all technical fields. If you have any questions, or would like advice on a specific case, please contact us at Dehns using the details below.



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