

*Collegio Italiano dei
Consulenti in Proprietà Industriale*

Preparing an opposition against a European patent

Milano, 7 novembre 2019

By: Paolo G. Rambelli

European Patent Attorney, Jacobacci & Partners



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE
INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS
INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN

Important points to be considered by an opponent

You or your client may wish to file an opposition against a competitor's EP

Why yes? / Why not?



Why yes?

- Consider if the patent is or will be an obstacle to your activities
- In case you are already sued for infringement during the opposition period, check if in the jurisdiction where you are sued the infringement proceedings will be stayed in case of opposition
- If you are sued after the opposition period, check if an opposition is pending so that you may intervene under Art. 105
- In deciding whether to oppose or not, consider the length of the proceedings and be prepared to the need of filing an appeal



Why not?

Take into account that in case the patent is maintained by the OD as granted or is not severely limited:

- the patent will become stronger and the risk for a preliminary injunction will increase; take into account the possibility of a «Strawman Opposition»
- objectively consider the prior art available to you and your grounds and oppose only if you have an objective chance to have the patent revoked
- explore the possibility for an agreement with the patentee



Opposition duration under «Early Certainty»:

15 months after the expiry of the opposition period

Appeal duration:

18-36 months – likely to be reduced



How to proceed

- define your extent of opposition (R 76(2)(C))
- if you oppose the patent in toto, attack not only the independent claims, but also the dependent claims
- in your opposition statement bring forward:
 - all possible grounds (possibly starting from A 100(c) and (b))
 - all facts/evidence and arguments supporting your grounds



Attack under Art. 100(c)

The attack under Art. 100 (c) will first be considered by the OD and can be lethal.

Look at the file history, at amendments submitted in any stage of the proceedings, at the priority document (and its translation, if any) to check if there is any violation of Art. 123(2).

If the application was filed in a non EPO language, check if the translation is faithful

Attack under Art. 100(b)

- Check if the requirements of Art. 83 are met over the full extent of the independent claims
- Support your Art. 83 objection with experimental evidence (if feasible)
- Remember that the burden of proof rests on the opponent; the benefit of doubt may apply to the patentee, not to the opponent



Attack under Art. 100(a)

- Apply the claim construction that would be applied by the person skilled in the art; but, in case of lack of clarity, try to apply the broadest construction (supported by evidence) to possibly facilitate your objection under Art. 100(a) (and possibly Art. 100(b))
- In arguing lack of inventive step, always apply the PSA; if the selection of the CPA is arguable, apply the PSA to all CPA candidate documents that, you can demonstrate, are equally valid starting points (cf. Guideline Part G, ch. VII, 5.1)



Attack under Art. 100(a)

- - If your attack under Art. 100(a) is based on prior use, remember that you have the burden of proof «up to the hilt» within the opposition period
- Do not adopt or rely on a delaying strategy by feeding evidence in several successive steps
- If you need to propose witnesses, they should be mentioned in the notice of opposition (although not necessarily named) and the subject-matter of their evidence should equally be mentioned
- Even though you may have a strong prior use attack, do not rely only on that and submit other facts and evidence



Prior art search

- In your search do not look only for p.a. in the specific technical field of the patent, but also for:
 - documents in neighboring fields and
 - even more general fields
- In conducting your search, try to take into account possible fall back position that may be adopted by the Patentee
- Remember that the documents in the Search Report are not considered to be of record in the OP (only the closest p.a. does)



In case of oral proceedings

- Carefully consider the provisional opinion of the OD. If the opinion is positive in your favour, do not rest on your laurels, rather, behave exactly as you would have in case it were negative
- Respect the time limit for further submissions under Rule 116
 - If you need to submit new documents or facts to the OP, be prepared to justify the late filing
 - Prepare a fall back argument, if the new documents or facts are not admitted



Opposition Procedure

Three stages of examination of the Notice of Opposition

1. Is the Notice of Opposition deemed to have been filed? (A 99)
2. Is the opposition admissible? (R 77)
3. Does the opposition affect the patent validity?



Opposition Procedure

1. Notice of Opposition deemed not to have been filed
 - non compliance with the 9 months term
 - non-payment of opposition fee (A 99(1))
 - lack of signature, not remedied within time period set by R 50(3)
 - Notice sent by fax and no confirmation copy submitted on invitation
 - authorisation not filed on EPO invitation within time limit of R 152(2)
 - non-fulfilment of the language requirements



Opposition Procedure

2. Opposition inadmissible (R 77)

2.1 Deficiencies to be remedied within opposition period (R 77(1))

Non-compliance with A 99(1)

- * identity of opponent not known (R 76(2)(a))
- * notice not filed before EPO and not received in time at the EPO from national Office
- * notice not in writing (R 86)
- * lack of a reasoned statement



Opposition Procedure

2. Opposition inadmissible (R 77)

2.1 Deficiencies to be remedied within opposition period (R 77(1))

- * Non-compliance with R 76(2)(c)
 - * no extent of opposition
 - * no grounds
 - * no facts and evidence in support of the grounds

- * Insufficient identification of the patent

Opposition Procedure

2. Opposition inadmissible (R 77)

2.2 Deficiencies to be remedied in an Office time limit (R 77(2))

e.g.: - incomplete name or address of opponent

- incomplete number, name of proprietor or title of opposed patent**
- incomplete data for the representative**
- lack of appointment of representative by Opponent who needs representation**

No further processing available



*Collegio Italiano dei
Consulenti in Proprietà Industriale*

Thank you for your attention!

Paolo Rambelli



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE
INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS
INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN