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**COMMON PITFALLS
IN OPPOSITION**

By René van Duijvenbode



As a patentee, you are pleased that your European patent application has made it to grant, and you just invested more money to validate the patent in a number of countries. That is, you indicated the European countries where you wanted the patent to have an effect. You are hopefully justified in thinking that in those countries, your technology is now protected from copycats and that the patent will help you stay one step ahead on the competition.

However, the decision of a three-member *Examining Division* of the EPC to grant you a patent is not necessarily the final say in the matter. Parties with an interest in the patented technology may want a piece of it or indeed the freedom to operate, and therefore see the patent as an obstacle blocking their way. While, in theory, you could see this as a compliment, it may still come as an unpleasant surprise that somebody objects to your patent and asserts that the EPO was incorrect in granting you a patent.

THE RULES OF OPPOSITION

National invalidation routes involving the courts are available to such parties, but often come at significant cost and the impact is generally limited to only a single jurisdiction. However, the European patent system allows for third parties to centrally oppose the patent before the EPO. The rules of opposition seem simple: any third party can – even anonymously – file an opposition to a granted patent provided the opposition is filed *within a nine-month window from the date that mention of the grant is published*. The grounds for opposition are similar to the objections that you may have faced during examination, where you had to convince the Examining Division that there was an invention in the claims. Again, your invention is under scrutiny and again, a three-member division from the EPO (the Opposition Division) will decide on the matter. Compared to national court proceedings, there are two key points: opposition before

the EPO is a *centralized* procedure, with an effect on the European patent everywhere in Europe where it has been validated. The Opposition Division that decides on the fate of your patent will be composed of *technically skilled* people.

With your patent under attack, you are bound to incur costs to defend your case. And while you as the proprietor may be confident that the EPO took the right decision in granting you a patent, there are a few aspects to consider:

First, there is no longer a positive dialogue between the applicant and the examiner, working together towards a granted patent. Instead, there now is another party presenting arguments and objections to your patent that may not have been considered in examination. The EPO cannot favour one of the parties but must remain neutral. As is the case in the granting procedure, the only role the EPO has in these opposition proceedings is to guard the rights of the general public.

Second, the opposing party may present new evidence and documents that have not previously been considered. While the technically gifted examiners from the EPO are capable of searching for relevant prior art, a party with an interest in the patent who is willing to invest in opposing it, and who is operating in the field of the patent, will have access to more, and often *more relevant*, prior art.

Third, the three members from the Opposition Division are not the same three members from the Examining Division. In fact, quite often even the first examiner handling the case and – once convinced him or herself – pleading your case with the other two members of the Examining Division, and who was willing to grant you the patent, may not be a member of the Opposition Division. This is even more likely to be the case now that the EPO is restructuring its organisation and is setting up dedicated opposition units. This division will have a fresh look at the case, and could interpret things differently than the previous examiner and the examining division.

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Common pitfalls in opposition

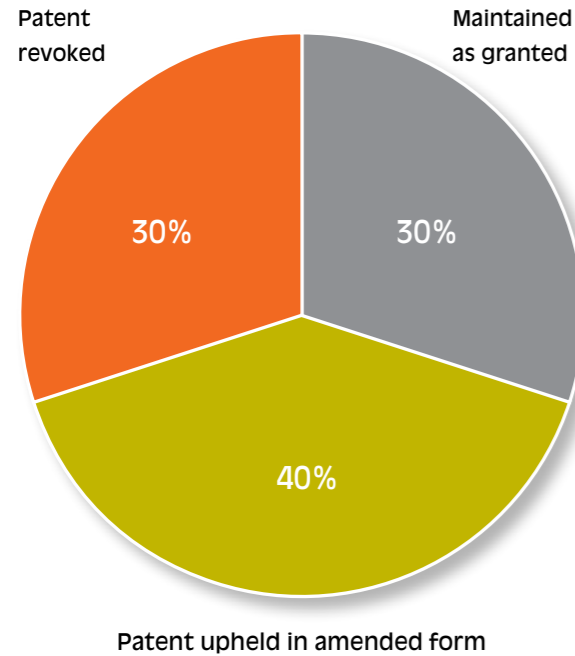
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A look at the numbers underscores that point:

Outcome of opposition decisions



Derived from: EPO Annual Reports

PITFALLS IN OPPOSITION

While the grounds may not have changed after a grant (novelty is novelty, inventive step is inventive step), there are quite a number of pitfalls in opposition proceedings that played no role in examination proceedings.

First and foremost, you must realize that, as a patentee, you can *only* lose. Once your patent is finally revoked, there is no way back. An opposing party that is not satisfied with the outcome of the opposition (i.e., because your patent was maintained, either as granted or in an amended form) may even subsequently consider going to the national courts but you cannot resort to the national courts to get your patent reinstated if it was revoked during opposition.

Second, it cannot be stressed enough, as mentioned before, that the EPO will no longer be favourable to you as the applicant; that listening ear is gone. The opposing party will be keen to bring weak spots or gaps in your argumentation to the division's attention. More than before, your patent attorney needs a critical eye to identify and fix those weak spots and gaps, and to anticipate the opposing party's objections.

Meanwhile, perhaps the trickiest aspect of all is a situation in which it becomes clear that the new evidence may force you to amend the case. You can see that your claims are no longer novel, or indeed that the division can be expected to look at it that way. In this case, as in the examination phase, you resort to limiting your claims. However, this time the opposing party will try to stop you from succeeding. The opposing party will question whether the amendments shift the scope of your patent, whether they indeed can be found in combination with the other features in the original application, and whether or not these are clear.

Over the years the EPO has become stricter. Timelines in written proceedings have been shortened because the EPO wants to deal more efficiently with opposition proceedings. But this efficiency comes at a price for the patentee. While back in 2007 the patentee was given multiple opportunities to limit and defend its claims, nowadays there is the – unspoken – rule of thumb that the division will allow the patentee only a single opportunity to amend its case per ground of opposition.

In addition, it no longer allows for small steps in subsequent written rounds. Where in the old days the patentee could still wait and see how the EPO responded to the opposition, it must now already present the amendments addressing the objections early on in the proceedings. Anything presented later may not be admitted. Almost without exception, a limitation taken from the specification presented at the hearing *will not be admitted* into the proceedings. Still, we have not seen the end of this practice of stricter adherence to the interpretation of the procedural law, and recently we observed that also limitations taken from the granted, dependent claims filed only at the hearing for the first time could be scrutinized just for late timing.

OPPOSITION: A DIFFERENT GAME

In a nutshell, if you as the patentee are dragged into opposition proceedings, you should be aware that the dynamics of 'the game' have changed. There is no more room for dialogue, no listening ear (in fact, quite the opposite) and no more patience. Given that you just invested a lot of resources in obtaining a patent, including expensive validations, you should be confident that your attorney is fit to deal with these new circumstances.

We at NLO have seen opposition proceedings become stricter over the years, and are experienced in navigating this changed landscape. We have a team dedicated to oppositions which has performed approximately 10-20 oppositions or opposition-appeal hearings annually, per attorney, over the last ten years. They have defended both patentees and opposing parties. With that vast experience we appreciate the extent of objections and the strategy of filing amendments. We are able to make a clear and pragmatic distinction between those objections and amendments which are bound to advance the client's case, and those that may formally make sense but do not work in practice. This means we have also grown more (cost-)efficient in preparing our cases, as well as better able to manage expectations.

At NLO, we believe that our value lies not only in the number of "wins" we can provide but also in the realistic and honest dialogue we engage in with our clients, helping them to forecast the direction and outcome of any proceedings they find themselves involved in. After

all, whether an amended patent means winning or losing can be very subjective, and is not in the least determined by the strength of the cold facts and evidence. First and foremost, our clients are satisfied with the benefits of predicting the proceedings and filtering out which arguments and amendments are worth pursuing.

We would like you to benefit from our experience by optimizing your defence, whilst minimizing and predicting costs.

Of course timelines are also important. Nowadays, the patentee is already expected to present its case, including possible amendments, four months after notification of the opposition. Up to 2016 it was still possible to get a two-month extension. However since then, we have seen such requests for extension rejected – with almost no exceptions – all with the aim of accelerating the proceedings. We thus encourage you to seek contact with us at your earliest convenience so we can jointly explore how we can help you present your strongest case.

Recent experience has taught us that the summons to attend oral proceedings is likely to be issued within one to four months after you filed your written reply to the notice of opposition. Should you wish to negotiate a deal with the opposing party, we recommend that you contact the opposing party at an early stage, while still drafting your response. The earlier the better, particularly since the Opposition Division has the power and discretion to continue proceedings of its own motion to safeguard the rights of the public, even when parties have settled and the opposition has been withdrawn.

Again, we at NLO can help you think about licensing options and conditions, and can even draft licensing agreements customized to your specific needs. There is no time to waste. In order to terminate opposition proceedings and demotivate the Opposition Division to continue the proceedings, time is of the essence.

ABOUT THE AUTHOR



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René van Duijvenbode provides a full service to large and medium-sized chemical companies, including food multinationals. His daily activities involve the full spectrum of patent drafting, prosecution, freedom-to-operate opinions and litigation. Over the years, his daily practice has shifted towards clients' representation in post-grant opposition proceedings. Corporate counsel greatly value his service, as evidenced by his receipt of a Client Choice Award for intellectual property (patents) in 2015. He enjoys representing both opponents and patentees in hearings before the Opposition Division and the Boards of Appeal at the European Patent Office, acting in about 15 to 20 opposition and appeal hearings annually.

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