



WHITE PAPER

WHAT IS OPPOSITION?



OPPOSITION = CHALLENGING A GRANTED EUROPEAN PATENT

The grant of a European Patent Office (EPO) can be challenged centrally at the EPO by starting an opposition procedure. This procedure can be started by filling a notice of opposition within the nine months immediately following (the publication of the mention of) the grant. The notice can be filed with a view to either revoke the patent entirely, or limit its scope of protection by revoking some of the claims or altering the wording of the claims. The outcome of the opposition will apply for the European patent, i.e. for all contracting states of the European Patent Convention (EPC) where the patent is validated.

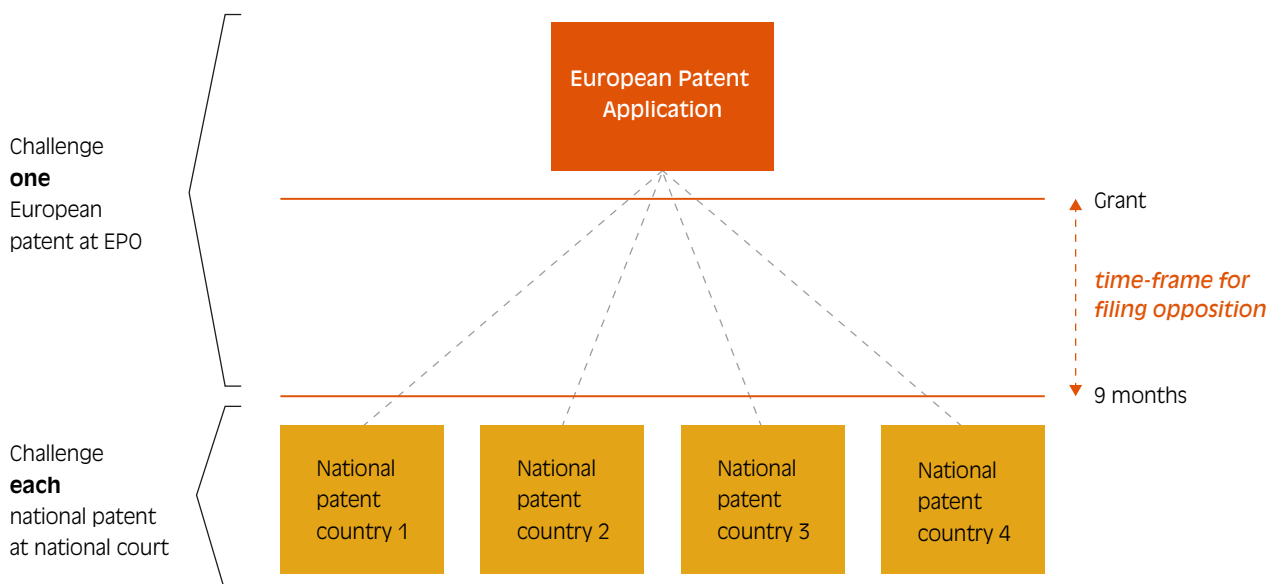
OPPOSITION IS MORE EFFICIENT THAN COURT PROCEDURES

A granted European patent can be challenged centrally at the EPO in order to have it revoked or to have its scope reduced. If the time period for filing opposition is missed, there is still the option to challenge the patent at a national court in one or more countries. However this is typically considerably more expensive than the centralized procedure at the EPO. In addition, it is typically preferred to argue in front of the technically qualified EPO staff.

THE ODDS FOR A SUCCESSFUL OPPOSITION

In opposition cases, an average of 30% of the patents are revoked, 40% are maintained in amended form, and only 30% are maintained as granted. Thus, with the success rate of the opponents being fairly high, it is of utmost importance to choose patent attorneys defending your rights that deal with these particular proceedings on a regular basis.

CENTRAL OPPOSITION VERSUS NATIONAL COURT CASES



PARTIES AT THE OPPOSITION

Once an opposition has been filed, the opposing party becomes a full party to proceedings and is thus fully involved in discussions with the EPO and the patent proprietor. Often there are multiple opposition parties. Typically the EPO will send a copy of the opposition to the patent proprietor, who is of course also a party, within a month or so of it being filed.

GROUNDINGS FOR CHALLENGING A PATENT

An exhaustive list of grounds for opposition is given in Art. 100 EPC. These grounds include:

- the claimed subject matter is:
 - not new,
 - not inventive,
 - falls within a category excluded from being a patentable invention,
- the invention is not sufficiently disclosed,
- the content of the granted patent extends beyond the content of the original application.

The grounds are identical to the patentability provisions applied in the Examination procedure, save for the unity requirement (Art. 82 EPC) and the requirements under Art. 84 EPC (clarity and support by the description). Nevertheless, Art. 84 EPC plays a role in opposition proceedings if objections to either clarity or support arise from the amendments to the granted patent. Furthermore, clarity or support of one of the features used for defining the claimed subject matter may be taken into account in the examination of novelty or sufficient disclosure.

OPPOSITION PROCEDURE

The notice of opposition includes a written reasoned statement of the grounds for opposition.

A further communication from the EPO to the patent proprietor will soon follow, setting a four month term for the proprietor to respond. If the proprietor files amendments, the opponent is given an opportunity to comment on the amendments in writing. The next stage in the procedure can vary, but in many instances it involves a communication being issued by the EPO that sets a date for a hearing or "oral proceedings". Several months before oral proceedings, the opposition division issues a summons along with a communication listing the crucial issues to be discussed at the hearing. The summons also sets a date for submitting final observations and amendments (usually 1-2 months before the hearing) after which additionally filed facts, evidence and/or amended claims may be disregarded. Therefore, it is not advisable to hold back decisive information until the hearing.

ORAL HEARING

At the hearing, the grounds for opposition at issue are usually dealt with one by one, and after all parties have been heard on each point, a decision is generally made by the opposition division. The written decision, which triggers the deadlines for appeal of the decision, is normally shared with the parties within 1-4 months after the hearing.

WWW.NLO.EU/EN/OPPOSITION



EUROPEAN PATENT AND
TRADEMARK ATTORNEYS

www.nlo.eu

Correspondence

P.O. Box 29720, 2502 LS The Hague,
The Netherlands, T +31 (0)70 331 25 00

Patents:

F +31 (0)800 023 49 37
E patents@nlo.eu

Trademarks:

F +31 (0)800 026 00 74
E trademarks@nlo.eu

Amsterdam
office

Ede
office

Eindhoven
office

Ghent
office

The Hague
office