

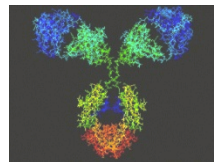


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Opposition Proceedings in the EPO: A Patent Attorney's Perspective

Fordham, New York, April 25, 2014

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A. Evidence



Evidence

- (a) hearing the parties
- (b) requests for information
- (c) production of documents
- (d) hearing of witnesses
- (e) opinions by experts
- (f) inspection
- (g) sworn statements in writing

(non-exhaustive list)

Burden of Proof

- Burden of proof rests on opponent:
may shift to patent proprietor in view of opponent's evidence.
- Decisions on the evidence presented by the parties:
on the basis of the overall balance of probabilities.
- In case of public prior use:
certainty beyond all reasonable doubt.

B.

**When to Submit the Evidence:
First and Second Instance**

First Instance Proceedings:

- Opposition proceedings governed by "EPO examines of its own motion, not restricted to what was provided by the parties" ("sua sponte")
- **T 1002/92: the relevance matters**

"... before the opposition divisions, late-filed facts, evidence and related arguments, which go beyond the 'indication of the facts, evidence and arguments' presented in the notice of opposition ... should only exceptionally be admitted into the proceedings ... if, **prima facie**, there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent in suit.,,

Second Instance Proceedings:

- **Rules of Procedure of the Boards of Appeal of the European Patent Office Article 13(1):**

“Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.”
- Boards have taken the view that appeals are solely a **legal review** of the first instance decision.
- **Thus:** it is more difficult to have new evidence and requests considered in the second instance. And: national proceedings are available!
- **Recent case law:** very restrictive, even deleting claims or new arguments based on literature on file can be problematic.

C. Experts



Experts at Oral Proceedings: G 4/95

- Submissions of experts at oral proceedings on specific legal or technical issues are possible.
- Not as a matter of right, but only with the permission of and under the discretion of the EPO.
- Permission must be requested sufficiently in advance of the oral proceedings; specify the subject-matter of the proposed oral submissions.
- The professional representative takes responsibility.

D. Claim Requests



Claims: What is the Target of the Opposition?

- Broadest reasonable interpretation of the claims.
- To be established by the Opposition Division.
- No “Markman Hearing”!

Claim Amendments

- Amendments only if occasioned by a ground for opposition.
- No broadening of the scope of protection beyond that of the granted patent.
- Requests should be submitted as soon as possible.
- In the first instance: at the latest at the deadline for filing last written submissions (especially if wording has to be taken from the description). Limited chances at oral proceedings.
- In the second instance: together with the grounds for appeal or in reply to the opponent's grounds for appeal.
- Always consider Auxiliary Requests: convergent vs. divergent.
- Risk that requests that address issues, which could have been reasonably expected, are too late if not filed immediately.



E.

Conclusion



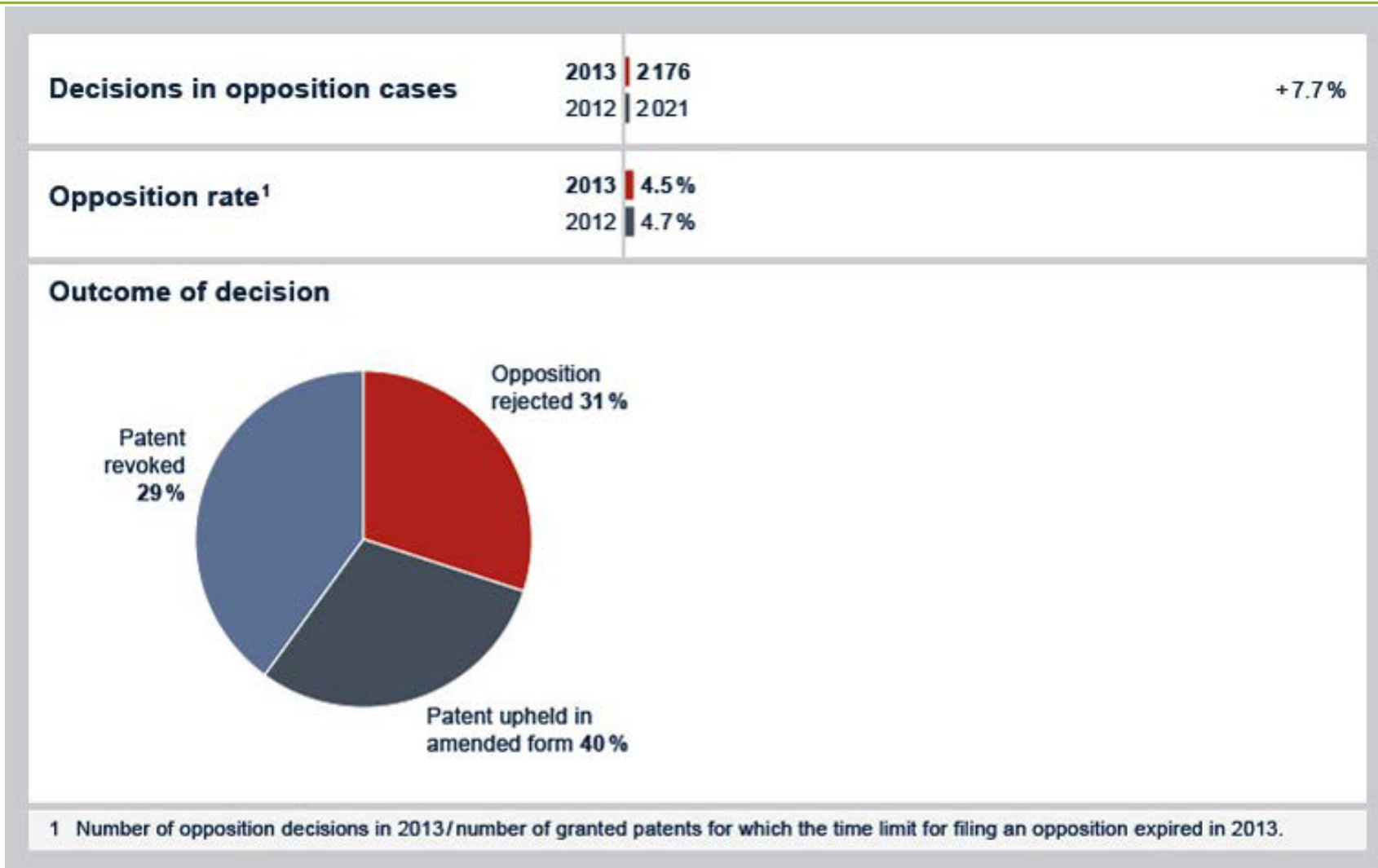
Conclusions

- Trying to anticipate the course of the opposition proceedings is of major importance.
- Evidence and amended claim requests should be submitted as early as possible.
- Finally: oppositions in the EPO do not create estoppel for concurrent (NL, UK) or subsequent (DE) nullity proceedings.

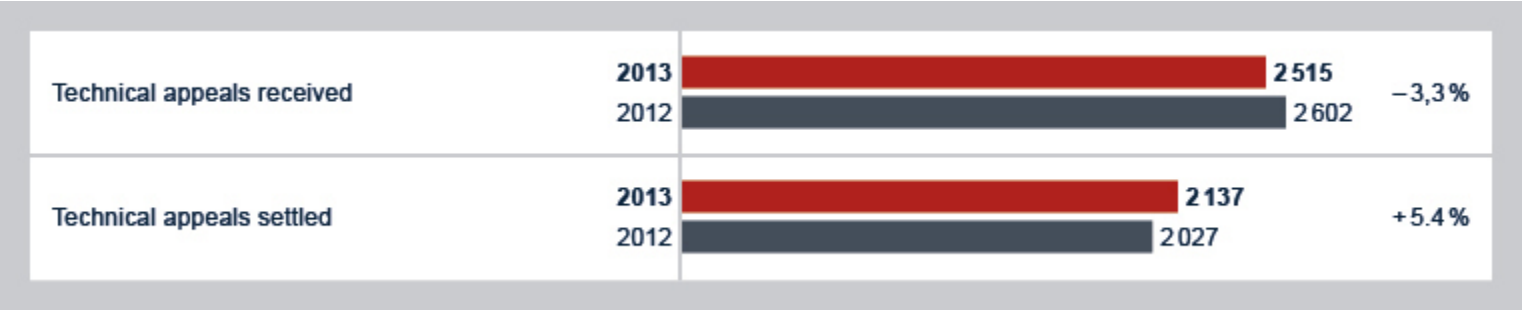
F. Statistics



Statistics I: Number and Results of Oppositions



Statistics II: Number of Appeals



Statistics III: Results of Appeal Proceedings

Overall situation in 2013	New cases	Cases settled			
		Total	Allowed (In part)	Dismissed	Settled otherwise
Legal Board of Appeal	23	25	7	11	7
Technical Board of Appeal	2 515	2 137	714	623	800
Examination procedure (ex parte)	1 200	1 013	288	302	423
Opposition procedure (inter partes)	1 315	1 124	426	321	377
Enlarged Board of Appeal	23	17			
Referrals	2	0			
Petitions for review	21	17	1	16	0
Disciplinary Board of Appeal	9	8	0	6	2
Total	2 570	2 187			



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Thank you.

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