



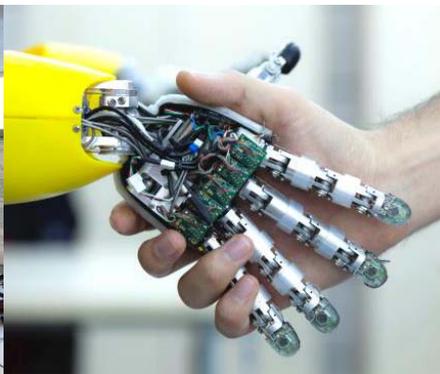
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# Oppositions at the EPO

A practical guide for a successful outcome



Sergio Arrojo Magallon



Member of the Centralized Opposition Directorate (EPO)



07.05.2018

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# Introduction and written proceedings

DOs and DON'Ts

# Opposition basics

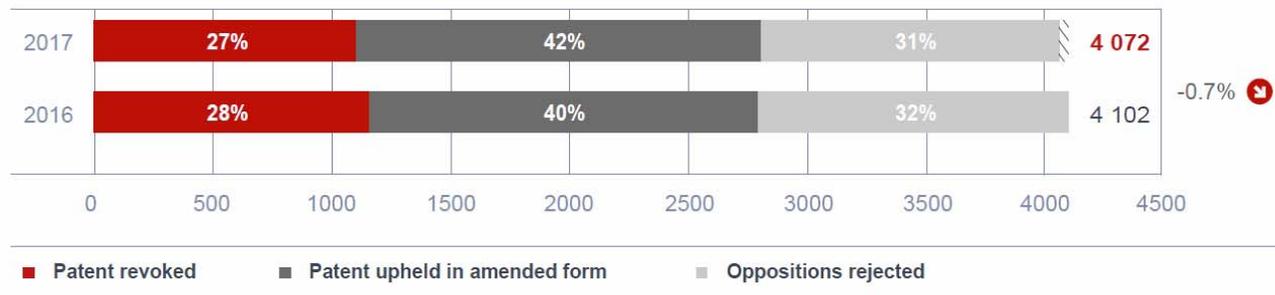
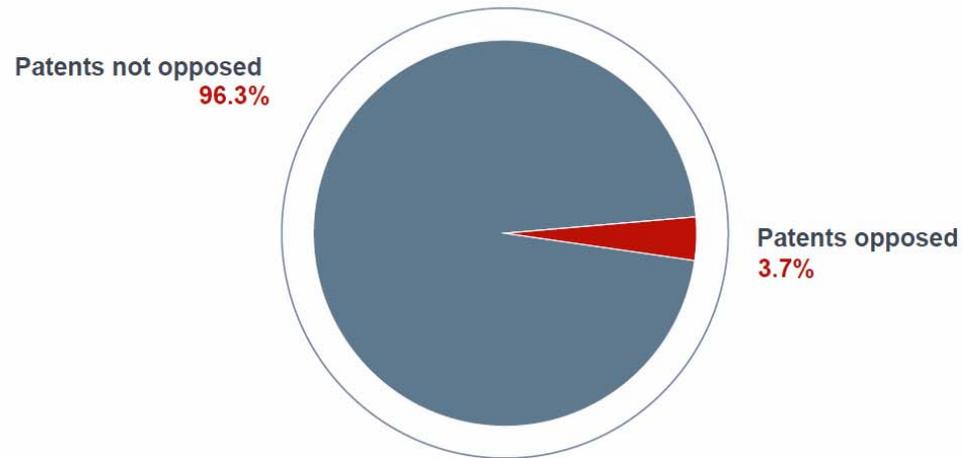
## Opposition at a glance

- Within 9 months of publication (A99 EPC).
- Extent as determined by the opponent only (G09/91).
- Examination under A101(1),(2) EPC of the patent as granted:
  - Article 100(a) EPC: Articles 52-57 EPC.
  - Article 100(b) EPC: Article 83 EPC.
  - Article 100(c) EPC: Articles 123 and 76 EPC.
  - Limited to substantiated grounds for granted patent (A76(2)(c) EPC and G10/91).
- Examination under A101(3) EPC of the amended patent:
  - Entire EPC except for A82 (G 1/91) and A84 of granted claims (G 3/14).
- EPO can object of its own motion (A114(1) EPC).

# Advantages

- **Good value:** Fee = 785 Euro.
- **Excellent quality:** at least 1st and Chair are highly experienced specialized examiners (Centralized Opposition Directorate).
- **Quick:** target of 15 months from filing of the opposition.
- **Convenient:**
  - Valid for all EPO states.
  - Might prevent subsequent litigations.
  - Might solve infringement proceedings (A105 EPC).

# Some numbers



## When to expect an opposition

- New technology and/or intense competition.
- Fields in which patents are essential.
- Small/medium number of large competitors.
- Third party observations filed.
- Broad claim granted.

Valuable patents are opposed.  
Patents opposed are generally valuable.

# Drafting and amendments

What NOT to do

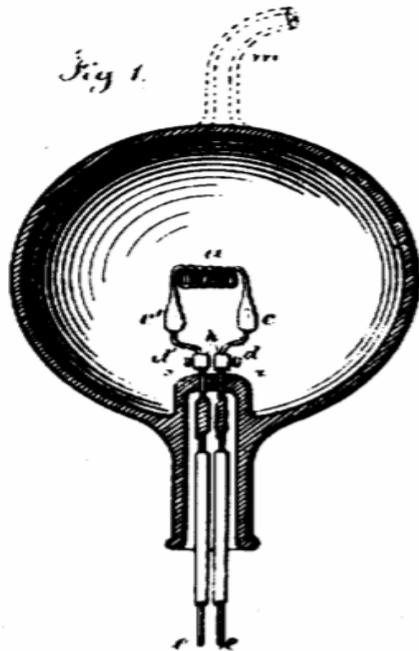
## Sufficiency of disclosure A100(b)/A83 EPC

- The European patent **application** shall disclose **the invention** in a manner sufficiently clear and complete for it to be carried out by a **person skilled in the art**.

*It is not the purpose of the patent system to grant a monopoly for technical speculations that cannot be realised at the time of filing (T 1164/11).*

# Light Bulb

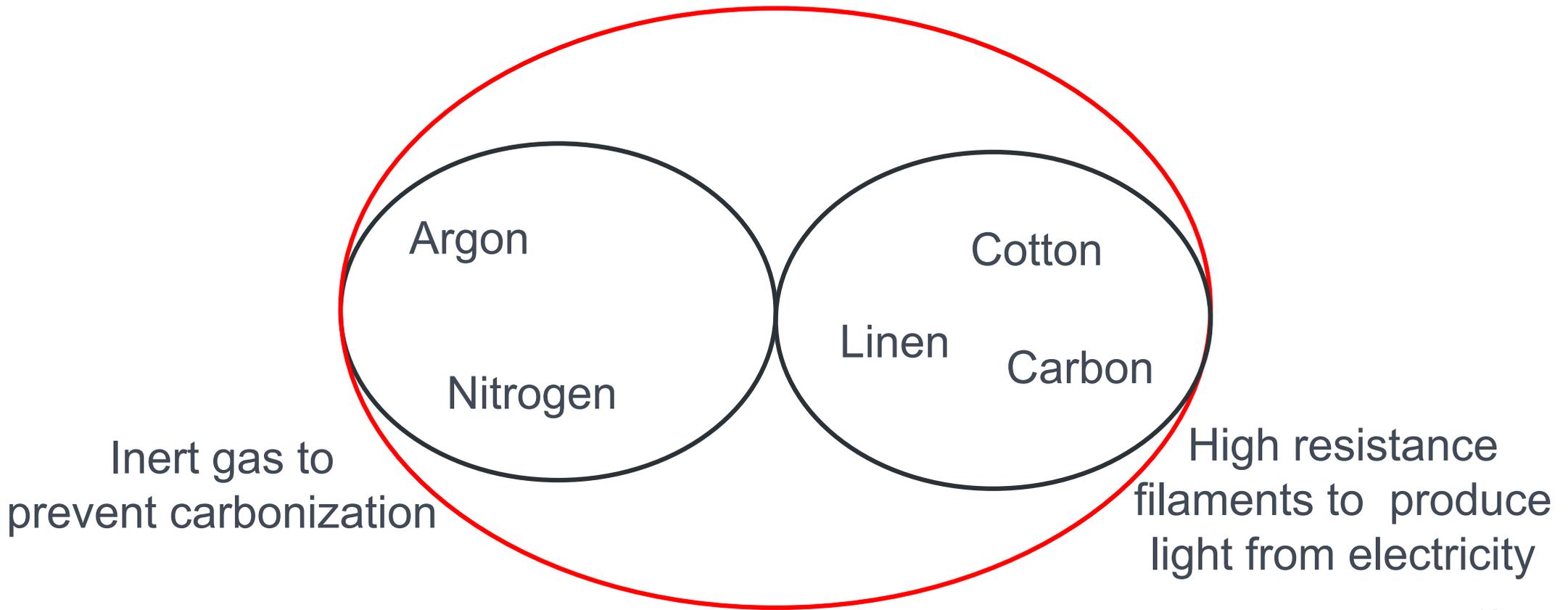
## US223898 (T. Edison, 1880)



- Lodygin and Swan had already invented bulbs:
  - High electrical consumption (Lodygin used rods).
  - Carbonization of filaments (Swan used vacuum).
- Sufficiently disclosed invention needs to answer:
  - What?: background + problem solved + key ideas.
  - How?: Embodiments, enabling realisations of ideas.

# Linking the general and the specific

Problem solved: durable light emission and low electrical consumption



## What not to do? (general)

- **General description with no enabling example**

At least one way of carrying out the invention (T292/85, T792/00).

- **Examples lacking a unifying general description**

Many examples but no general indication which allows to carry out the invention throughout the entire claimed range (T 1051/09, T435/91, T809/07, T516/99, T226/85).

## What not to do? (specific)

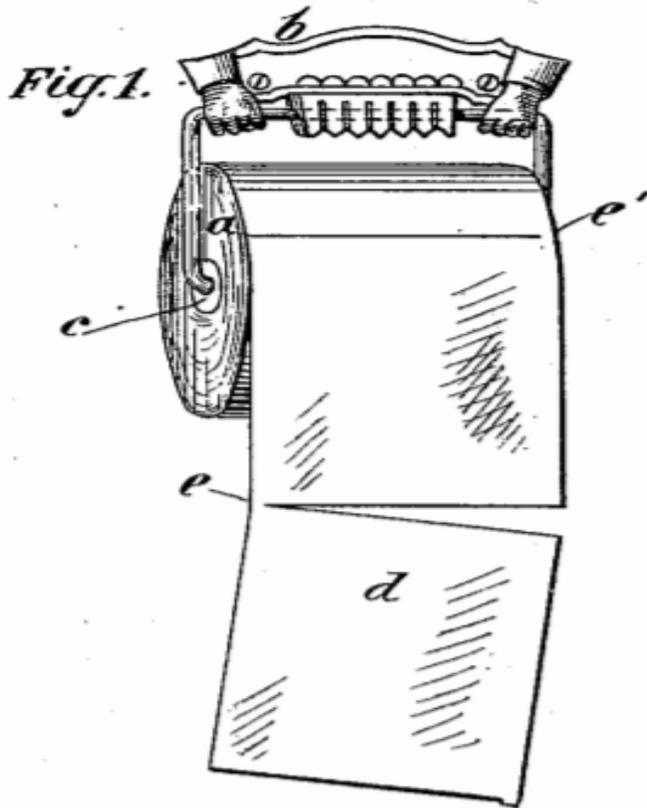
- Define unsupported effects in claim (G01/03 p.2.5; T2001/12).
- Include parameters which are unusual and/or with unclearly defined methods (T172/99, T464/05).
- Invention dependent on chance and/or with gaps to be filled with trial-error experimentation (undue burden) (T38/11, T326/04).
- (Obviously) inventions violating laws of physics.

## Extension beyond original docs. A100(c)/A123,76 EPC

- A123(2)/76 **app/patent/divisional** may not be **amended** in such a way that it (...) **extends beyond** the content of the (earlier) application as **originally filed**.
- A123(3) **patent** may not be amended in such a way as to **extend the protection** it confers.

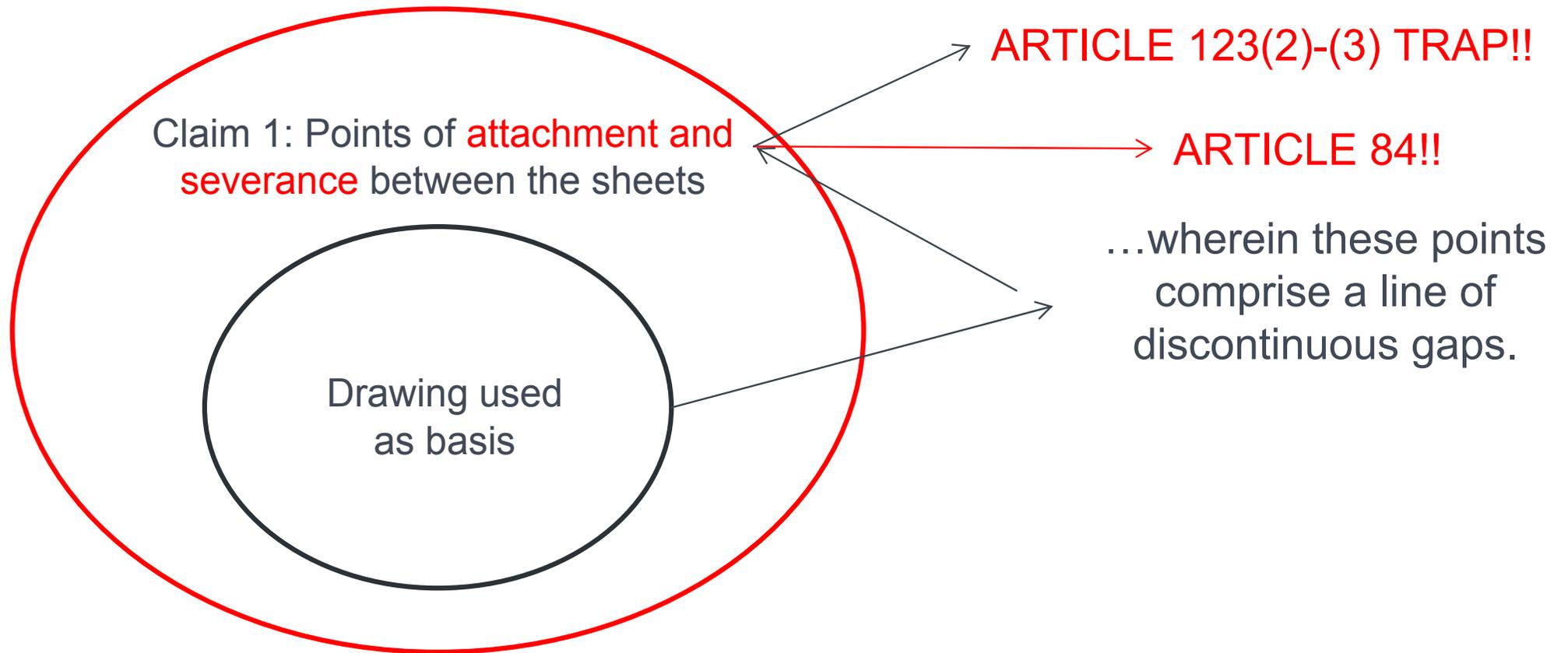
*To prevent improving position through amendments, as this would give unwarranted advantage and could damage the legal security of third parties (see **G 1/93**, OJ 1994, 541).*

## Toilet paper (S.Wheeler, 1891) US459516



Claim 1: A roll of paper for wrapping or toilet use so constructed that the **points of attachment and severance between the sheets** will be alternately out of parallel lines running through the whole body of the sheets, so that a pull upon the free end of the web will not be transmitted in a direct line through a series of sheets, but will be diverted by spaces opposite the connected points of the sheets, thereby producing a transverse strain upon the connected points sufficient to break them, substantially as described.

# The clarity trap



## What not to do?

- When drafting:
  - Use uncommon terms with no fall-back explanation/terminology.
  - “Hide“ relevant information in the examples.
  - Use rigid/unappropriate claim dependency.
- When amending:
  - Solve issues with terms, expressions or explanations not explicitly present in the specification.
  - Amend using isolated features from embodiments.
  - Delete portions of independent claims.

# Patentability

## A100(a)/A52-57 EPC

- Inventions shall be granted if they are **new, involve an inventive step and are susceptible of industrial application.**

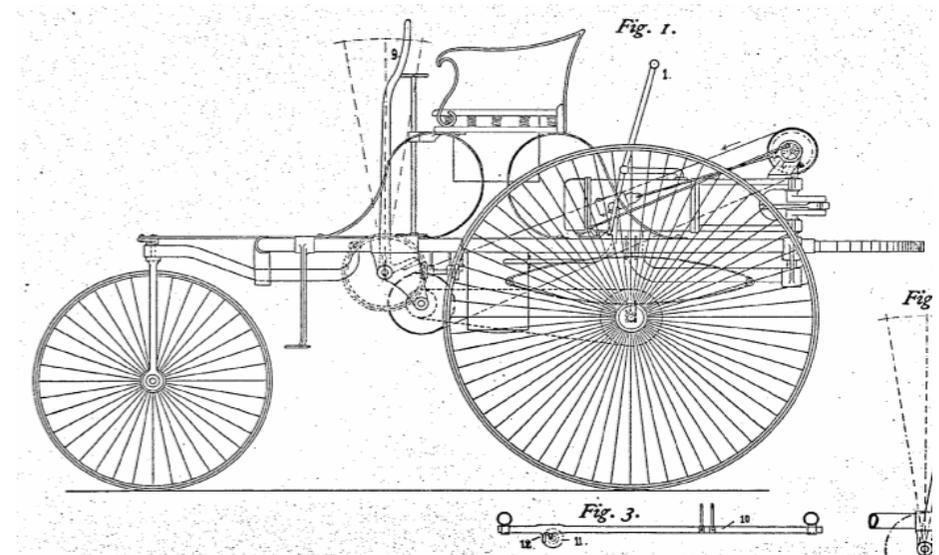
*The content and the extent of the monopoly conferred by a patent should correspond to and be justified by the technical contribution to the art (T939/92).*

# Car

## Benz & Co (DE37435C, 1886)

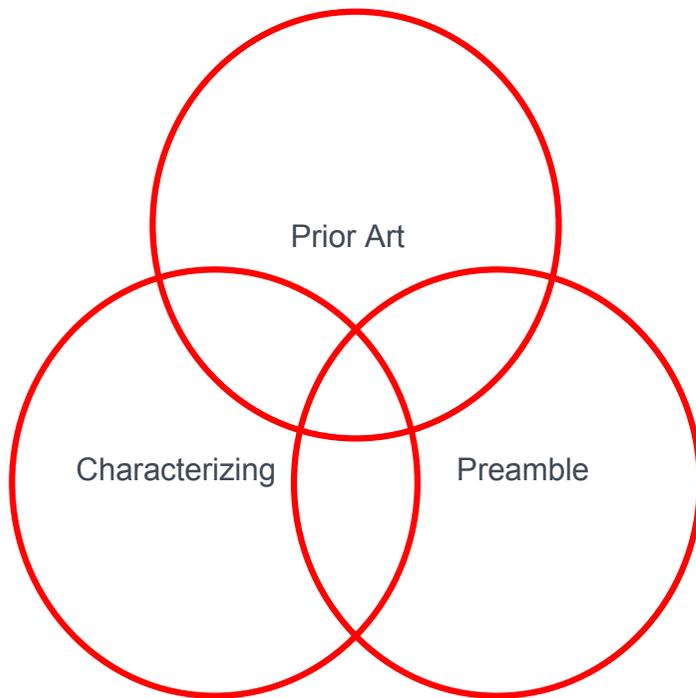
### Fall-back positions

- Preamble:
  - light wagon or small vessels for 1-4, e.g small car for 2 persons.
- Characterizing:
  - Motor: water cooled, position X1 and configuration X2.
  - Fuel: Gas such as lingroin.
  - Transmission with two gears and configuration Y
  - Brakes operated through lever with configuration Z.



# Patentability

## Selden vs. Ford (US)



- Selden, inventor and patent attorney, fought a patent battle with H.Ford.
- Selden filed for a patent in 1879 (US549160) which provided a rather general protection for a car with a Brayton engine but with limited additional information or alternatives (i.e. fall-back positions).
- After 8 years of litigation, Ford won the last instance because:
  - Selden’s car was only based on a Brayton engine and not on Otto engine (like the Ford-T).
- H.Ford would famously declare:  
***"It is perfectly safe to say that George Selden has never advanced the automobile industry in a single particular...and it would perhaps be further advanced than it is now if he had never been born." H.Ford***

## What not to do?

- Use shallow fall-back positions.
- Fall-back positions only for the preamble or the characterizing part.
- Fail to explain problem/s being solved by each fall-back position.

# Notice of Opposition

What to do

# Notice of opposition

## V. Opposition is filed against

[Redacted]

- claim(s) No(s).

## VI. Grounds for opposition:

Opposition is based on the following grounds:

(a) the subject-matter of the European patent opposed

is not patentable (Art. 100(a) EPC) because:

- it is not new (Art. 52(1); Art. 54 EPC)
- it does not involve an inventive step (Art. 52(1); Art. 56 EPC)
- patentability is excluded on other grounds, i.e. Article

(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b) EPC; see Art. 83 EPC).

(c) the subject-matter of the patent opposed extends beyond the content of the application/of the earlier application as filed (Art. 100(c) EPC, see Art. 123(2) EPC).

## VII. Facts (Rule 76(2)(c) EPC)

presented in support of the opposition are submitted herewith on a separate sheet (annex 1)

[Redacted]

Opposition limited by the extent (G9/91)

Art.

Division not obliged to deal with unsubstantiated grounds under Rule 76(2)(c) EPC (G10/91)

# Argumentation, facts and evidences

- Substantiation under Rule 76(2)(c) EPC
  - all grounds are unsubstantiated=oppo inadmissible (R77(1) EPC).
  - Unsubstantiated grounds might be disregarded (G10/91).
  - Minimum requirements: it must be understandable what is being objected and why (merits of objection are irrelevant) (GL D-IV).
- Object everything... which you can reasonably object.
- Try to object all dependent claims.
- Documents, not too many, not too few...
- Always request Oral Proceedings!

## Article 100(b) EPC

- Broad claim defining a specific effect/function
  - Effect plausible throughout the whole claimed range?
  - Scope encompasses non-workable examples?
- Parameters?
  - Unusual?, determination method present?, consistent results?
  - Required for carrying out invention?
- Information gap?
  - Trial and error required?, undue burden?
  - Only reproducible by chance?

## Article 100(c) EPC

- Amendments taken from description?
  - Attack intermediate generalisation.
- Changes in terminology?, added explanations?
  - Look for embodiments encompassed now and excluded then.
- Changes in claim dependency?
  - Attack but beware of H-IV 2.2, 3. parag. (not excessive focus on structure).

## Article 100(a)-54 EPC

- General points
  - Use general/unusual terms to broaden scope.
  - Use lack of clarity to broaden scope (also useful for A56).
- New evidence
  - Parallel proceedings from family members or related applications.
  - Search similar app. from same inventor/applicant.
- Existing evidence
  - Check actions of Examination Division (e.g. unexpected change of mind).

## Article 100(a)-56 EPC

- Always use problem-solution approach!
- CPA:
  - Similar problem solved.
  - Structure (preamble) rather than characterizing features.
  - Ideally use 1-2 alternative CPAs.
- Problem being solved:
  - Add step “does claim 1 successfully solve the problem?”.
  - Reformulate problem.
  - Never use “no problem solved“, use “find alternative“ instead.
  - Use multilayer argument: “even if...“. (when strong).

# Reply from Patentee

How to respond

# Counter-argumentation

- Avoid extensive answers for unreasonable/weak objections.
- Multilayered arguments (when strong).
- File auxiliary requests to get a preliminary opinion.
- Question admissibility of grounds and evidences (R76(2)(c) EPC).
- Always request Oral Proceedings!

## Article 100(b) EPC

- Use “hidden A84 EPC objection“ argument.
- Use entire application, focus on embodiments/examples.
- Use general knowledge and conventional trial and error to fill gaps.
- Remember Opponent must demonstrate that the information gap requires inventive skills or undue burden to be filled (high standard).

## Article 100(c) EPC

- Use technical effects or argument “not necessarily linked“ to overcome intermediate generalization.
- Use Skilled Person knowledge to broaden the scope of originally filed information.
- Use Skilled Person knowledge to link added/modified terms to originally filed information.

## Article 100(a)-54 EPC

- Use skilled person/description to narrow scope of features.
- Read functional features and effects narrowly (if needed).
- Try to restrict the scope with implicit features in the preamble.

## Article 100(a)-56 EPC

- Use problem-solution approach!
- Best alternatives:
  - Minor difference in preamble: ideal for incidental anticipations.
  - Minor difference in characterizing part: ideal for shallow prior art.
  - Minor difference + linked effect/function: ideal when problem/effect of prior art is not the same.

## How to draft Auxiliary Requests

- Converging but...
  - Amend preamble and/or characterizing part.
  - Keep other lines of ARs in case the proceedings change.
    - To address possible formal issues (if feature A...).
    - To address substantial issues (alternative Inv. Step approach).
  - Avoid ARs with common “weak“ feature.

# Summons to Oral Proceedings

How to read them and react

## Summons to oral proceedings

- Summary of some relevant procedural events.
- Standard clauses with useful formal instructions.
- Non-binding preliminary opinion:
  - Clear tendency to extend opinion to include A56 and ARs.
  - Essential to prepare OP.
  - Non-binding but likely to be maintained unless **new** facts or arguments are presented.

## How to interpret preliminary opinion?

- Most likely opinion will be maintained on:
  - Formal issues (A100(b) and (c) EPC).
  - Interpretation of contentious features.
  - Novelty, unless complex issues are involved.
- Opinion might change:
  - For complex issues such as inventive step.
  - When new facts and evidence are introduced.
  - With a completely new (better) line of argumentation.

## Reaction to the summons

- Opponent:
  - Use opinion to focus on strongest objections during OP.
  - If new evidence available, file it (if possible) as a reaction.
  - Use opinion to reformulate objections (e.g. prob-sol approach).
- Patentee:
  - Use opinion to reformulate/add Auxiliary Requests.
  - Use opinion to reformulate objections (e.g. prob-sol approach).

# Oral Proceedings

## Preparing for oral proceedings

- Language spoken will be that of the proceedings unless otherwise agreed by all parties.
- Interpreters provided by EPO free of charge on request.
- As patentee bring editable electronic version and/or typed version of any potential request you might want/need to file.
- Postponement (e.g. due to unexpected events) only grantable under special conditions.
- Not attending?: New facts and evidences cannot be used to decide against a party not attending the OP (new arguments can be used) G04/92. Less risky not to attend for Patentee.

## The opposition division

- 3 technical members (A19 EPC):
  - 2 not present in examination proceedings.
  - Chair and 1st members of Centralized Opposition Division.
  - Chairman in examination cannot be in the division.
  - 4th legal member if required (e.g. if witnesses are present).
- Statements by the division:
  - Questions: indirect objection or suggestion (?).
  - Comments before interruptions: hints to outcome (?).

## **Interactive practical cases**

**The grey areas of legal provisions**

## Article 100(b) EPC

### Penicillin US2442141A (Moyer,1948)

- Discovered by Fleming in 1929, it was first regarded as an interesting lab curiosity. In 1939 Florey and Chain started investigating its potential as a therapy. The problem to be solved at that stage was to produce penicillin at large scale. In 1948 Moyer came up with a method which dramatically increased yield by contacting **lactose (L)** with **corn-steeping liquor (C)**.
- Patents need to specify features decisive in overcoming an existing prejudice (T 419/12).

## Claim 1

- Method to produce penicillin.
- Contacting A with B.
- Ratio A/B of 0.1-1.
- A = generalised term for L.
- B = generalised term for C.
- Production  $>X$  g/day of penicillin.

## Description

- Contacting C and L dramatically increases production of penicillin vs. State of the Art.
- Examples with C/L ratios of 0.1-1 producing  $>X$  g/day of penicillin.

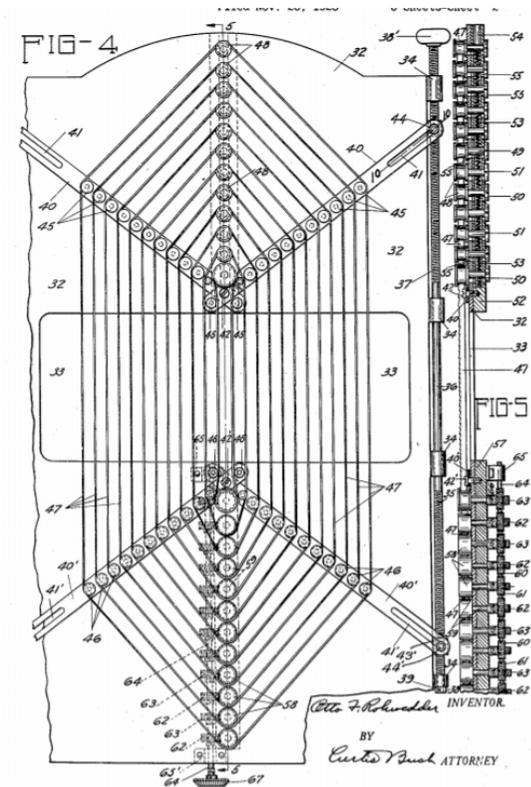
- Are the features C (corn-steeping liquor) and L (lactose) essential?
- Is this an issue under A84 only or also under A83?
- Is “Ratio A/B“ clear pursuant to A84?, does it comply with A83?
- What if an index Y was defined in claim 1, this index being neither common nor further described in the specification?

# Article 100(c) EPC

## Bread slicer US1867377 (Rohwedder, 1932)

*“You want the greatest thing, the greatest thing since bread came sliced” (imitation of life, REM)*

- Structural limitations in mechanics are often difficult to define without unduly limiting the scope.
- Functional definitions often raise issues under A84 or A54, and A123(2) might be offended when addressing these objections.



## Application as originally filed

- Claim 1: Bread slicer
  - Parallel cutting moving bands
  - Cutting in a direction perpendicular to the extension of the bands.
- Embodiment:
  - bands with blades made of an appropriate material such as steel or cheaper iron alloys.
  - Cast iron is a cheaper iron alloy but is not mentioned in the application.

## Examination

- Objections:
  - Clarity of cutting bands: how do they cut?
  - Novelty with D1: wood cutter with same mechanism. Invention: bottom tray for sawdust
- Amendments as granted:
  - Long bands with metal blades.
  - with no bottom tray.

## Amendments to comply with clarity

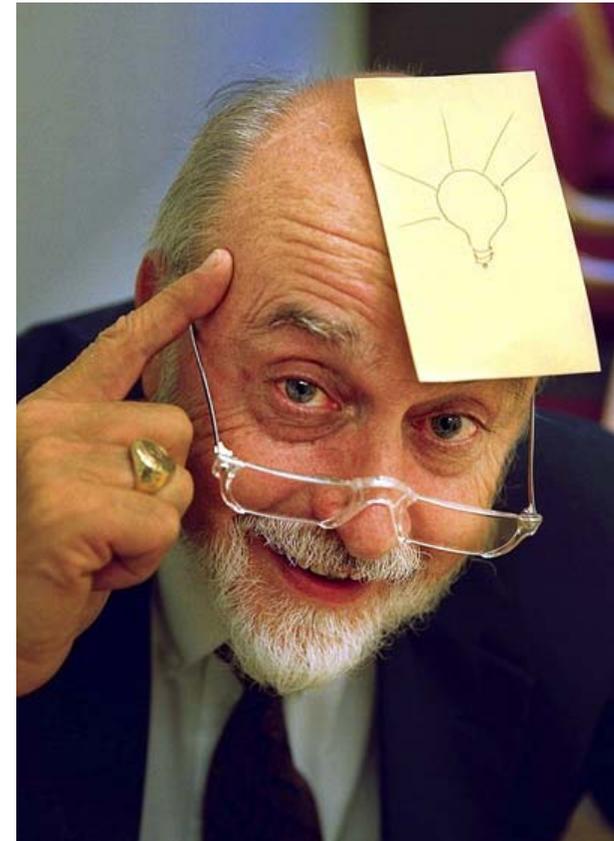
- “Long“ not originally disclosed, can it be deleted without offending A123(3)?
- Does the feature “metal“ violate A123(2)?
- Could we omit blade material under 123(2)?, and under 123(3)?
- Could metal be substituted by steel or cast iron without offending A123?
- How could an opponent use this argumentation for patentability issues?

## Amendments to establish novelty with respect to D1?

- Is disclaimer of undisclosed feature “bottom tray“ allowable under A123(2)?
- Would it be allowable if document D1 was a bread slicer? and if 54(3)?
- Would it establish inventive step?

## Article 100(a) EPC Post-it US5194299A (3M, 1986)

- In 1968, Dr. Silver was trying to develop a very strong adhesive for 3M and ended up developing the exact opposite: a weak adhesive that never seemed to dry (US3857731A). But some years after, his colleague Dr. Arthur Fry...



# Fall-back positions

- Claim1 = Paper sheet characterized by adhesive coating providing a re-positioning function.
- Preamble
  - Papers glued to one another.
  - Paper towels/napkins
- Characterizing part
  - Re-positioning parameters (e.g. can be re-positioned for 10 days)
  - Adhesive: Type A (the original 3M invention).
  - Adhesive coating parameters (e.g. thickness and/or position).

## Prior Art

- D1: Reusable paper lid with an adhesive coating band arranged to open and close the food container several times for a long time. Adhesive A proposed as alternative.
- D2: Sheets of office paper fixed to one another by an adhesive coating. Adhesive might remain sticky in the short term.
- D3: Napkins attached to one another with an adhesive coating which is not sticky after detaching.

# Preamble

- C1. Paper sheet characterized by re-positioning function.
  - Paper towels/napkins.
  - Papers glued to one another.
- CPA?
- Novel?
- Problem-Solution
  - Problem solved?
  - Successfully solved?, Reformulation?
  - Obvious?
- D1: Reusable paper lid with an adhesive coating band arranged to open and close the food container several times for a long time. Adhesive A proposed as alternative.
- D2: Sheets of office paper fixed to one another by an adhesive coating. Adhesive might remain sticky in the short term.
- D3: Napkins which are attached to one another with an adhesive coating which is not sticky after detaching.

# Characterizing part

- C1. Paper sheet characterized by re-positioning function.
  - Re-positioning parameters.
  - Adhesive coating parameters.
  - Adhesive: Type A.
- CPA?
- Novel?
- Problem-Solution
  - Problem solved?
  - Successfully solved?, Reformulation?
  - Obvious?
- D1: Reusable paper lid with an adhesive coating band arranged to open and close the food container several times for a long time. Adhesive A proposed as alternative.
- D2: Sheets of office paper fixed to one another by an adhesive coating. Adhesive might remain sticky in the short term.
- D3: Napkins which are attached to one another with an adhesive coating which is not sticky after detaching.

# Combined

## Claim 1

- Paper towels/napkins.
  - Papers glued to one another.
  - Adhesive type A.
  - Coating parameters.
  - Functional parameters of re-positioning.
- D1: Reusable paper lid with an adhesive coating band arranged to open and close the food container several times for a long time. Adhesive A proposed as alternative.
  - D2: Sheets of office paper fixed to one another by an adhesive coating. Adhesive might remain sticky in the short term.
  - D3: Napkins which are attached to one another with an adhesive coating which is not sticky after detaching.

## ...and actual claim 1 was:

- 1. A method of making a removable and repositionable adhesive sheet product comprising spraying onto a sheet backing material a solution or dispersion of a normally tacky and pressure-sensitive adhesive, the pressure-sensitive adhesive being sufficiently adherent that, if sheet material having a continuous coating of said adhesive is applied to newsprint, it cannot be peeled away at normal removal rates without tearing or delaminating said newsprint, the adhesive islands being on the order of 0.01 to 0.15 millimeter thick, having at least one other dimension no greater than 0.02-1.5 millimeters (...) so as to achieve an adhesion to polyester film on the order of 8-80 grams per centimeter width, whereby said adhesive product can be adhered to newsprint, allowed to remain in contact therewith for two weeks at room temperature and then removed without visibly damaging the newsprint.

## General tips for Inventive Step

- CPA = most promising starting point, i.e. most similar structure and/or problem being solved, not most features in common or similar characterizing features.
- However, if doc. is nearly novelty destroying and the minor difference does not solve any specific problem, it might be a good CPA (often as a stand-alone document).
- Argument that claim does not solve problem throughout entire range is often used for A83 but is rather useful to reformulate problem in A56 argumentations (except if related tech. effect defined in claim).
- Problem-solution approach is telling a technically plausible story, mastering it is the single most powerful tool in opposition proceedings.

## Specific tips for Inventive Step

- Features not contributing to the problem being solved should be disregarded in the inventive step argumentation.
- Skilled person for A83 and A56 should be the same, so opponent can use A83 arguments from patentee for A56 discussion (T 60/89, OJ 1992, 268; T 694/92, T 187/93, T 412/93).
- If different independent problems solved by various differentiating features (juxtaposition) then it suffices to show that each of these features is obvious to demonstrate that the claim is obvious (i.e. a different document to attack each juxtaposed feature).

## Late filed submissions

- In the notice of opposition you (representative of the Opponent) objected only novelty in view of D1. Today, 2 weeks before the OP, your client tells you that they were selling devices before the priority date. These devices (PU1) are not relevant for novelty but are functionally close to the invention and could be combined with D1 to attack IS. There is no Auxiliary Request on file and D1 is clearly novelty destroying for claim 1 as granted.

– How should you proceed?

- Should you file PU1 at all?
- Use (substantiated) novelty or a (late filed) inventive step ground?
- Since it would be late filed anyway, would you wait until the OP?
- How would you order your requests?

## And what if...?

- To prove the date of PU1 you need the declaration of a witness who lives in Australia and who would not be available in such short notice for the OP, what do you do?
- During the OP you receive an email from your client with a document published before the priority date and disclosing the device of PU1.

## Late filed submissions and timing

- Submissions must always be admitted if *prima facie* relevant.
- As a general rule, the later it is filed the stricter the *prima facie* test.
- If OP is postponed due to a late filed submission apportionment of costs is likely to be ordered.
- In OP, decision cannot be reviewed once pronounced (G12/91).
- Last opportunity to make submissions is by the end of the discussion (i.e. pause made before decision is taken) (G12/91).
- Late filing and other forms of delay are generally not a good tactic.

## Written decision and appeal

Post-opposition proceedings

# The decision

- Decision must:
  - Be based on facts and evidences on which the losing party had an opportunity to comment (Article 113(1) EPC).
  - Argumentation must be based on these facts and evidences but line of argumentation might differ from those presented by the parties (e.g. the Division holds discussions behind closed doors).
  - Division must provide reasons for not following the arguments of the losing party.
  - If any of these points not complied with, there might be a substantial procedural violation which could justify the reimbursement of the appeal fee.
- If substantial procedural violation is suspected, check the minutes and request correction if needed.

## From opposition to appeal

- No fresh grounds admitted unless Patentee agrees (G10/91).
- Grounds of appeal and reply should contain the entire case (A12(2) RPBA).
- If a submission could have been presented during opposition proceedings, then the Board has discretion to disregard it (A12(4) RPBA).
- If submission is a reaction to an event occurring during the OP in opposition, then it will likely be admitted.
- After filing grounds or reply, Board might disregard any submission based on procedural economy or complexity (A13(1) RPBA).
- After summons to OP any submission which might cause an adjournment shall not be admitted (A13(3) RPBA).

## To appeal or not to appeal

- In comparison to the first instance...
  - BoA tend to regard many A83 EPC objections as hidden A84 EPC objections.
  - The BoA tend to be less strict with A123/A76 EPC objections based on intermediate generalization or claim dependency.
  - The BoA are more willing to read features in the light of the description.
  - The BoA tend to be more strict for acknowledging inventive step (e.g. disregarding differences not contributing to the problem being solved or reformulating the problem being solved conservatively).

**Thank you for your attention**

Sergio Arrojo Magallón  
sarrojo@epo.org