

# The nuts and bolts of oppositions and appeals

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# Overview

- Preparing a notice of opposition.
- Responding to an opposition.
- Oral proceedings
- Filing an appeal – notice and grounds.

# Preparing the notice of opposition

- Stating the obvious: Don't forget the time limit of Article 99 EPC – filing just one day too late could ruin everything. Articles 121 (further processing) and 122 (re-establishment) do not apply for this deadline. And don't forget the opposition fee.
- Make sure to correctly identify the opponent.
- Request oral proceedings as an auxiliary request in case the Opposition Division does not intend to revoke the patent in view of the written proceedings.

# Attacks

- Preferably, all grounds for opposition under Article 100 should be invoked. This will give more room for maneuvering later in the proceedings (G 9/91, G 10/91).
- Keep in mind that there are two different grounds covered by Article 100(c) – namely Art. 123(2) and 76(1) (T 2233/09).
- Think outside the box concerning the invoked grounds.

# Attacks – example

- Example:

Patent claimed method for “sensoric imprinting” by administering different food portions (vegetables or fruits) to infants. Description stated that the method would result in improved health later in life.

The method claims were therefore open to attack under Article 53(c) in view of T 1635/09 (OJ EPO 2011, 542).

# Looking for the right prior art

- Obviously, some kind of prior art search should be made.
- Having identified the closest prior art for an inventive step attack, the secondary prior art document may require an additional search based on the definition of the objective technical problem.
- Often overlooked secondary prior art documents are:

If closest prior art is a sufficiently old patent application, the file history of this patent application often contains relevant statements/claim amendments.

The skilled person, according to case law (T 176/84, T 195/84), looks for solutions also in neighbouring fields. Thus, no need to restrict search to same field.

# Example

- Patent claimed pharmaceutical formulation of a certain acid sensitive proton pump inhibitor (gastric acid inhibitor). Claimed formulation was identical to that of the closest prior art, except that the claimed formulation included HPMC of a certain quality (prior art did not define the HPMC further).
- File history of closest prior art discussed the suitability of HPMC of the brand Pharmacoat in the formulation, Pharmacoat 603 and 606 being among the options.
- Evidence was provided that Pharmacoat 603 met the claimed characteristics for the HPMC.

# Example

- For the same patent, a secondary prior art document concerning a formulation of a another acid sensitive drug was identified.
- One of the examples concerned a formulation of this other acid sensitive drug having all the characteristics of the claimed formulation (Pharmacoat 603 was used in the example) and was stated to solve the objective technical problem – as formulated in general terms for acid sensitive drug molecules.
- In view of T 176/84 and T 195/84, the solution could therefore be argued to be obvious in view of this secondary document.

# Example

- The claimed invention was a selection invention from the closest prior art by selecting from two different lists.
- Review of the file history of the closest prior art (not yet granted) revealed that the applicant had made a selection from one of the two lists.
- The amended claims of the closest prior art document thus only contained one list and the patent in question therefore lacked novelty over these claims.

# Responding to an opposition

- Preparations for responding to an opposition begin, if you suspect that someone in the future might file an opposition against your application (once granted), while it is still being prosecuted.
- Opposition Divisions take Rule 80 seriously and will not let you clean up your claims during opposition if your amendments are not caused by a ground for opposition.
- Article 100 contains an exhaustive list of grounds for opposition. Most notable is that lack of clarity is not a ground for opposition. On the other hand, claim amendments introduced in the patent as granted must comply with all provisions of the EPC (G 9/91, G 10/91).

# Responding to an opposition (cont.)

- However, any attacks based on Article 84 (and new attacks under Article 123(2)) must arise out the amendment *per se*.
- Merely introducing subclaims into the independent claim is not open for an attack under Article 84 (or Article 123(2)) (T 515/04).
- Thus, if you think that you might need a fallback position with questionable clarity, make sure to include it as a subclaim in the patent as granted (if you can “sneak” it past the Examining Division). Then it cannot be attacked under Article 84 in an amended claim set (T 515/04).

# Example (T 07/07)

- Article 100(c)/123(2) was not invoked as a ground for opposition.
- The patent was maintained as granted by the Opposition Division.
- However, during appeal proceedings a (necessary) limiting feature, which was only present in the description, had to be introduced into the claims.
- The limitation was found to violate Article 123(2). Had this feature been the subject of a subclaim, the Board would have had no power to examine it without the consent of the proprietor (G 10/91).

# Example (T 639/07)

- Article 100(c)/123(2) was not raised as a ground for opposition.
- The Opposition Division raised Article 123(2) of its own motion, but eventually found no problem.
- The opponent had no comments to this issue.
- Article 100(c)/123(2) was not discussed in the grounds for appeal by the opponent/appellant, but only in a later submission.
- Article 100(c) was found to be "outside the framework of the proceedings" by the Board of Appeal.

# Responding to an opposition (cont.)

- In any event, a lesson many learn the hard way is that the real defense under Article 123(2) begins when drafting the application!
- Make sure to make your "intermediate generalisations" while drafting the application rather than when you amend it later on.
- Good explanation of "intermediate generalization" given in T 879/09, point 2.1.2 of the Reasons for the Decision.
  
- Claim 1: Composition comprising A + B
- Claim 2: Composition according to claim 1 further comprising C + D
- Amended claim 1: Composition comprising A + B + C

# Responding to an opposition (cont.)

- Be very critical to the opponent's selection of closest prior art.
- An opponent often selects the document as closest prior art which has the most technical features in common with the claim. Often this document is not directed to the same purpose or effect as the claimed invention.
- A classical approach by the opponent is then to argue that “only routine experimentation is needed to arrive at the invention”.
- Proprietor's counter argument: *Ex post facto* analysis (hindsight).
- Invest time in explaining why your document (directed to the same problem) is the closest prior art and make a thorough problem-solution argumentation

# Responding to an opposition (cont.)

- Another indication that the opponent may not have a very strong case is a relaxed attitude towards using the problem-solution approach.
- The EPO insists on using the problem-solution approach and the definition of the objective technical problem can be crucial (if e.g. the closest prior art is not in dispute).
- There is a big difference between solving the problem of “providing an alternative” and the problem of “providing an improvement”!

# Responding to an opposition (cont.)

- Read the entirety of the cited prior art documents.
  - Sometimes, the most damaging parts of prior art documents are being “kept” for the oral proceedings.
  - Sometimes you will find “teaching away” statements in the opponent’s documents that support your argument.
- Do not underestimate the strength of their arguments. If you don’t take them seriously, you cannot defend properly against them.
- If you find their arguments convincing for the main claims of the patent as granted, and if you have reasonable fallback positions, it is usually not worth it to fight for the patent as granted. Adjust your requests accordingly.

# Oral Proceedings - Summons

- Some months before the actual date a Summons is issued by the EPO.
- Rule 115(1) stipulates at least two months notice.
- I have tried as little as three months and as much as nine and half months in opposition proceedings.
- The Summons usually contains a preliminary (non-binding) opinion from the Opposition Division. Sometimes it is detailed, other times not.
- Many times an opinion will be given on formal issues and novelty, but inventive step left open. Other times, only an outline of topics to be discussed are in the preliminary opinion.

# Oral Proceedings – Studying Summons

- The points raised by the Opposition Division will be discussed, so be ready to address them.
- It should be kept in mind whether these points are best discussed in view of further evidence – perhaps requiring a further search or further data from the inventor etc.
- In my experience, if the Opposition Division has opined in favour of one of the parties, it is very difficult to change their mind!
- But, keep in mind that there is a possibility of appealing afterwards. The arguments found unconvincing by the Opposition Division may be found convincing by the Board of Appeal. For procedural reasons, it is better to develop your arguments early.

# Oral Proceedings – Preparing Written Submissions

- Deadline is usually one or two months before the oral proceedings.
- First decision is whether to keep the written submissions long or short.
- On the one hand, it can be a good idea to keep your “killer argument” in reserve, leaving the other party little time to respond.
- On the other hand, if the argument is just a little bit complex (technically and/or legally), then the Opposition Division may not understand your brilliant argument if you keep it until the oral proceedings!

# Oral Proceedings – Preparing Written Submissions (cont.)

- As **opponent**, this is a good opportunity to comment on any new requests that the patentee may have filed with the response to the notice of opposition.
- As **patentee**, if you have not already done so, this is a good moment to file as many useful requests as you can think of!
- In principle, the **patentee**'s written submissions should contain all his requests, but the Opposition Divisions can many times be persuaded to admit further requests filed after the deadline (but don't count on it!).

# Oral Proceedings – Preparing Written Submissions (cont.)

- As **opponent**, the Summons are not necessarily an invitation to file further evidence, which in principle should be filed with the notice of opposition (Rule 76(c) – T 1002/92).
- Be prepared to argue why you couldn't have filed it earlier – e.g. because you are reacting to something stated in the patentee's response or the Summons itself.
- As **patentee**, do not let the opponent file further evidence without good reason – i.e. argue why the new evidence is not relevant and/or is not responding to your response to the notice of opposition.

# Oral Proceedings – Preparing Oral Arguments

- Starting point is your written argumentation.
- The written language and the spoken language are different – you need to “translate” your written argumentation. Keep it short!
- In addition, you should address any new arguments/evidence found in the other party’s written submissions. Is it late-filed?
- If you think that the other party has submitted late-filed evidence, consider filing a letter in writing pointing this out to the Opposition Division – just in case they don’t consider it themselves.

# Oral Proceedings – Who Should Participate?

- Many times, it is possible for just one person to conduct the oral proceedings.
- However, it is always useful if someone else knows the case and can challenge your arguments.
- If more than one person participates in the oral proceedings, it is very important to assign a clear role to everybody.
- Some prefer a “master and slave” approach – where one does all the talking and the other person is there to support.
- Others prefer to divide according to topics – e.g. one takes extension of subject-matter and novelty, the other takes sufficiency of disclosure and inventive step.

# Oral Proceedings – Your Script

- Divide according to topics (typical order):

Admissibility of documents/requests.

Rule 80 (amending in response to ground for opposition).

Extension of subject-matter (Art. 123(2)/76(1)).

Clarity (if claims have been amended).

Sufficiency of disclosure.

Novelty.

Inventive step.

- Make sure you can find your notes on each topic separately and possibly in a different order!

# Oral Proceedings – Your Script (cont.)

- Write your script in a way that you can understand under pressure!
- Some use entire sentences, some use shorthand. Choose a format that suits you.
- The particular choice is of course based on experience – I do not prepare my script in the same way as I did in the beginning.

# Oral Proceedings – Documents

- Keep organized!
- I prefer the old-fashioned way of using ring binders – one for evidence on file (D1, D2 etc.) and one for each party's submissions (in chronological order).
- Some prefer to have everything on their laptop (there are power plugs in the rooms at the EPO) in order to carry less material.
- As **patentee**, don't forget to bring clean copies of the patent as granted/application as filed for possible new requests and/or adaption of the description to an allowed auxiliary request!

# Oral Proceedings – Language

- Many German and French attorneys will speak in German and French just because they can!
- Don't forget to request translation in time. Otherwise, it's on your own dime.
- My German is not perfect, but I understand it quite well. I prefer listening to the other party speaking in German rather than the translation, but this is a matter of personal taste.
- In any event, the translators at the EPO are quite good (although some more than others...).

# Oral Proceedings – Keep Your Cool

- More easily said than done!
- There is almost always an unexpected development during the oral proceedings!
- Example: On a couple of occasions I have experienced that neither the closest prior art suggested by the opponent nor the one suggested by the patentee was accepted. Instead a third closest prior art document was chosen by the Opposition Division.
- The best way to prepare for such a situation is to know all the documents well!
- And... even if the Opposition Division gets it all wrong and comes to the wrong decision, be polite and courteous. You may run into them again...! 😊

# The opposition division has decided...

- If you are “adversely affected” by the OD’s decision, it can be appealed.
- As the **opponent**, even if you (for now) can live with the patent as upheld in amended form, consider filing an appeal on account of the *reformatio in peius* principle.
- As the **patentee**, if the patent as upheld in amended form is acceptable to you, consider whether you may seem “greedy” if you attempt to get a broader patent on appeal. In general, mixing bad arguments with good ones detracts from the good arguments (sometimes “less is more”).
- However, even if you, as **patentee**, do not think that you will win the appeal, the suspensive effect of the appeal may help create valuable uncertainty with your competitors.

# Filing the notice of appeal

- Make sure to identify the appellant properly. Generally not a problem.
- No need any longer to specify the extent to which the decision is appealed (Rule 99(1) EPC 2000 vs. Rule 64 EPC 1973).

# Filing the grounds for appeal

- The most important set of rules are the Rules of Procedure of the Boards of Appeal (RPBA).

- Especially Article 12(2) RPBA:

*The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.*

- New documents should preferably directly address factual assertions by the OD.

# Filing the grounds for appeal (cont.)

- Remember that the appeal is not restarting the opposition proceedings (Article 12(2) RPBA).
- The case should therefore not be argued all over again, but the grounds should rather focus on where the OD (allegedly) got it wrong.
- The appeal could be considered a new opportunity, though, to discuss from scratch issues that are more legal in character. The boards will in some cases seize on the chance of making new case law (or simply showing the OD that they are more clever...).

# Further appeal submissions

- Article 13(1) RPBA:

*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.*

- There is every reason to take this seriously...
- This includes filing new requests as early as possible.
- In some cases, filing requests that could (or even should) have been filed in the first instance proceedings will be deemed late-filed (and not admitted).

# Oral Proceedings Before the Boards of Appeal

- Similar to those before the Opposition Division.
- However, there are also differences!
- For instance, the Boards rarely state for or against any of the parties in advance of the oral proceedings.
- You should be prepared to address all issues raised in writing during the oral proceedings.
- Earlier, some Boards have just opened up by saying: "State your case". But this is not so common any more, probably because of the possibility of requesting petition for review.
- Detail: If **patentee** is the appellant, the patentee goes first before the Board of Appeal.

# Petitions for review

- The statistics do not favour the petitioner!
- Many petitions are clearly last desperate attempts to salvage something.
- Rule 106 is very important.
- Yet many petitioners did not raise their complaint during the oral proceedings.
- They therefore claim to be surprised by the written reasons.
- This often involves arguing in some way (at least implicitly) that the factual findings of the board were wrong (contradicting evidence on file).
- That type of petition will fail!

# ”Lessons” from R 3/10

- The board of appeal decided on both novelty and inventive step, even though the parties had only presented arguments on novelty.
- In the petition itself, very little emphasis was placed on the technical side of the board’s decision. Instead, we emphasized the fundamental importance of speaking on every issue of patentability at the oral proceedings.
- This was reflected by the Enlarged Board’s reasoning. The opponents’ arguments that the claims so clearly lacked inventive step, even if novel, were dismissed.
- An ”excuse” was made on behalf of the board of appeal by the enlarged board, stating that it had been an ”unfortunate misunderstanding”. The violation was nevertheless considered fundamental.

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