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# EPO Patent Awareness Seminar WIPLA, September 2007

## Opposition and Appeal

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# Program

Opposition  
Organisational aspects of Appeal  
The Nature of Appeals  
Procedural Details  
Outcomes of Appeal  
Latest Developments





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# Opposition

Opposition

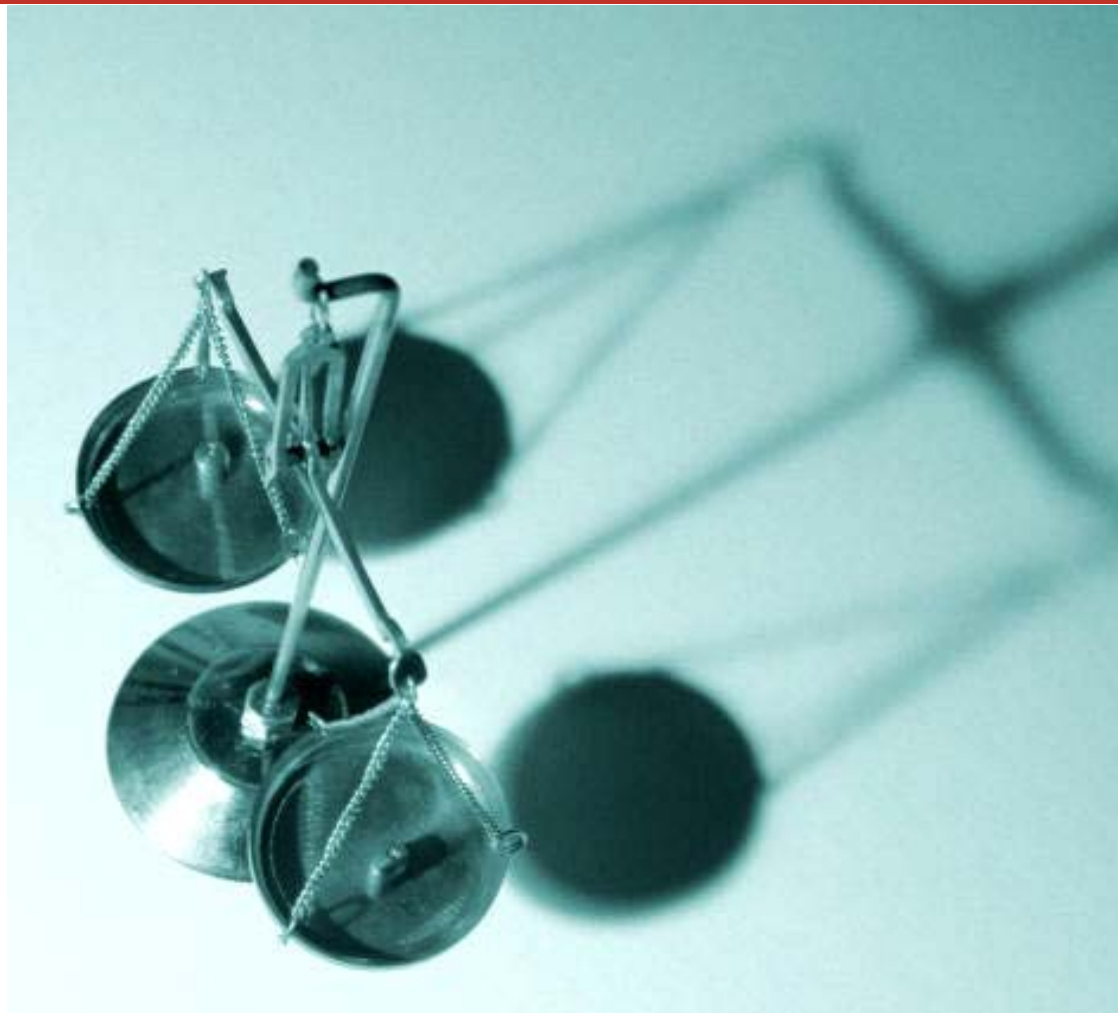
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# Opposition procedure

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- A notice opposition must be filed within 9 months of the publication of the patent (Article 99 EPC)
- It can be filed by anyone else (G 9/93)  
Reference should be made to limitation / revocation procedure (EPC 2000)
- Opposition is an independent procedure to examination
- It is an inter partes procedure; examination is ex parte

# Notice of opposition (Rule 55 EPC)

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- The notice of opposition must include:
  - **Name** and address of the opponent, and state of residence
  - **Number**, title & proprietor of patent opposed
  - **Extent to which the patent is opposed**
  - **Grounds for opposition**
  - **Indication of facts, evidence and arguments**
  - If appointed, the name and address of the representative



# Grounds for opposition (Article 100 EPC)

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- a) The subject-matter is not patentable  
(Articles 52 to 57 EPC)
- b) The invention is not sufficiently disclosed (Articles 83 EPC)
- c) The subject-matter extends beyond the application as  
originally filed  
(Articles 123 (2) and 76(1) EPC)



**Neither lack of unity nor lack of clarity  
are grounds for opposition**

# The opposition division

## (Article 19 EPC)

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- **First Member**  
entrusted with examination
- **Second Member**  
takes minutes in  
oral proceedings
- **Chairman**  
retains overall responsibility
- **(Legally qualified Member)**  
legal issues, admissibility,  
evidence from witnesses and  
minutes



Only one of the division may have  
taken part in the examination  
procedure (not the chairman)



# Examination of the Opposition (Article 101 EPC)

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- Notice of Opposition (G 9, 10/91)
- **Admissibility**  
(Rule 56, cf. Article 99(1), Rule 1(1), Rule 55(c) EPC)
- Initial submissions by the parties
  - Notice(s) of Opposition
  - Observations from patentee (Rule 57 (1) EPC)
- Official communication
  - To all parties (Rule 58 (1) EPC)
  - Respecting the parties' requests
- Oral Proceedings (Article 116 EPC)
- Decision

# Public Prior Use

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## Burden of proof: "Up to the Hilt" (T 472/92)

- Who
- What
- How
- When

- Witnesses may be called to provide confirmation of the evidence **already given** not the quality of evidence
- "Hilt" only applies if evidence is in the hands of the opponent
- Can theoretically be in national court

# Oral Proceedings

## (Article 116 EPC)

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- Submissions (Rule 71a EPC)
- Preparation
- The Proceedings itself
  - Representation
  - Requests
  - Grounds for opposition
  - Presentation of argumentation (Article 113 (1) EPC)
  - Interruption of proceedings
  - Confirmation of requests
  - **The** decision, given orally (Article 116 (4) EPC)
- Written confirmation of decision  
and minutes (Rule 76 EPC)

# The Decision and The Minutes

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- Decision
  - Facts and Submissions
  - Maintained requests
  - Reason for the Decision
  - Right to appeal (period runs as of notification of written decision)
- Minutes
  - Formal details: date, parties, division,
  - Substantive argumentation of all requests
  - Provided to the parties "as soon as possible"

# Possible outcomes

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Patentee    Opponent

Patent revoked  
(Article 102(1) EPC)



Opposition rejected  
(Article 102(2) EPC)



Patent maintained (amended)  
(Article 102(3) EPC)



The Decision (☹️/😊) can be appealed (Article 106 EPC)



## Outcome of oppositions at the EPO (2002)

Opposition

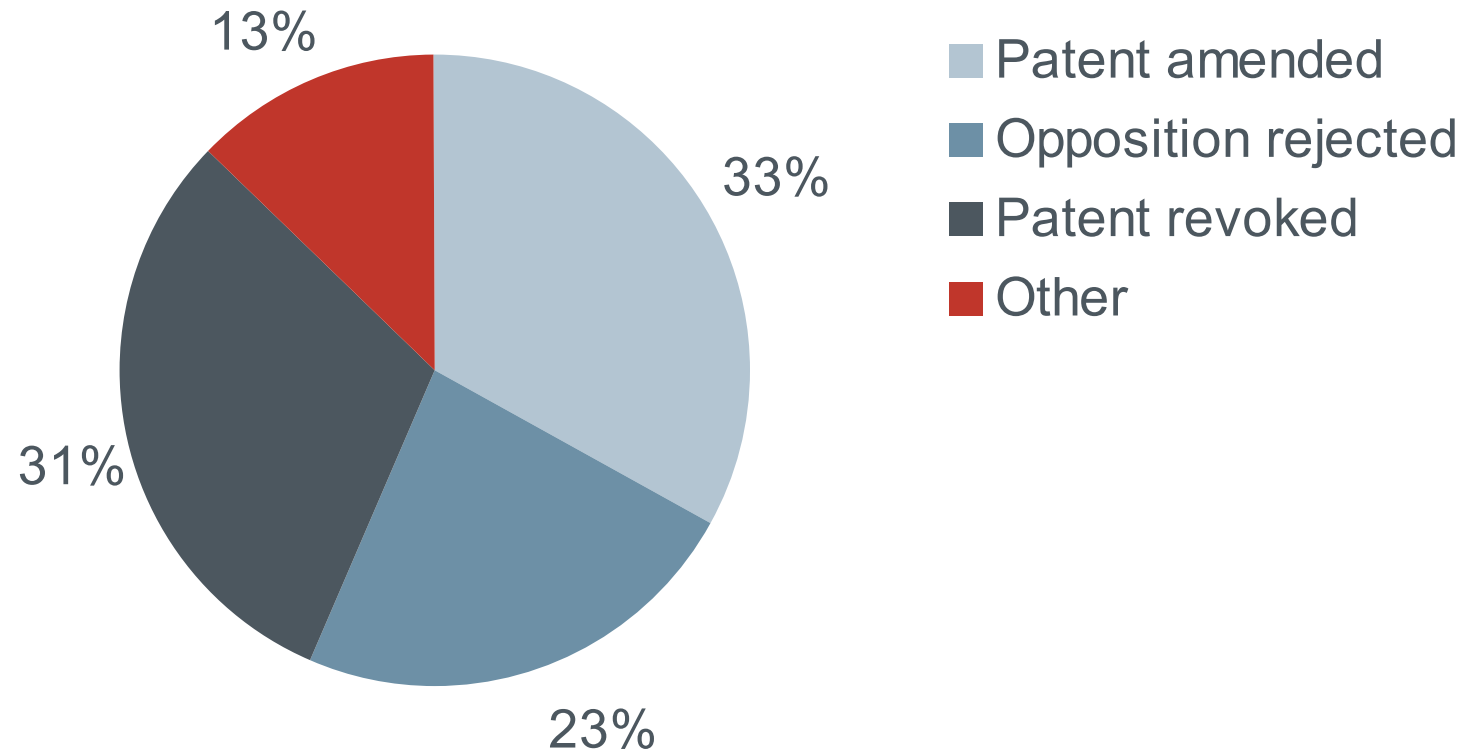
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# Organisational aspects of Appeal

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# EPO Organigramm

Opposition

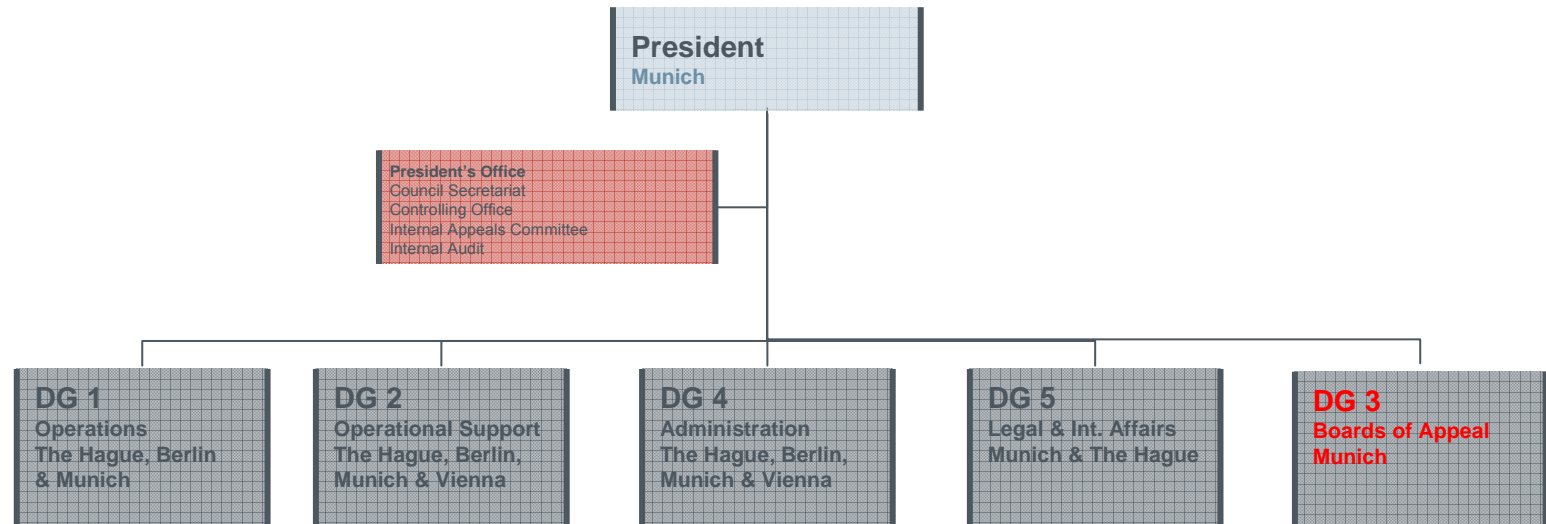
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# Directorate-General 3 Organisational Structure

Opposition

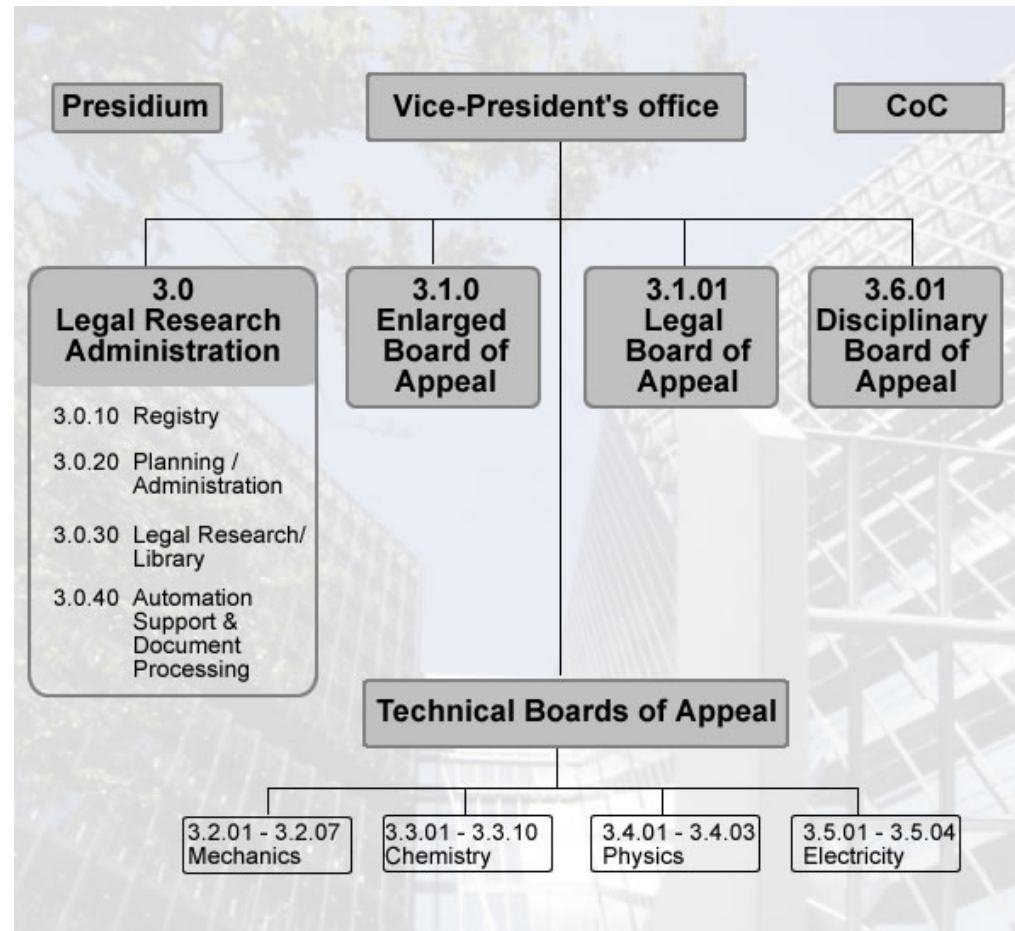
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# The Appeal process

Opposition

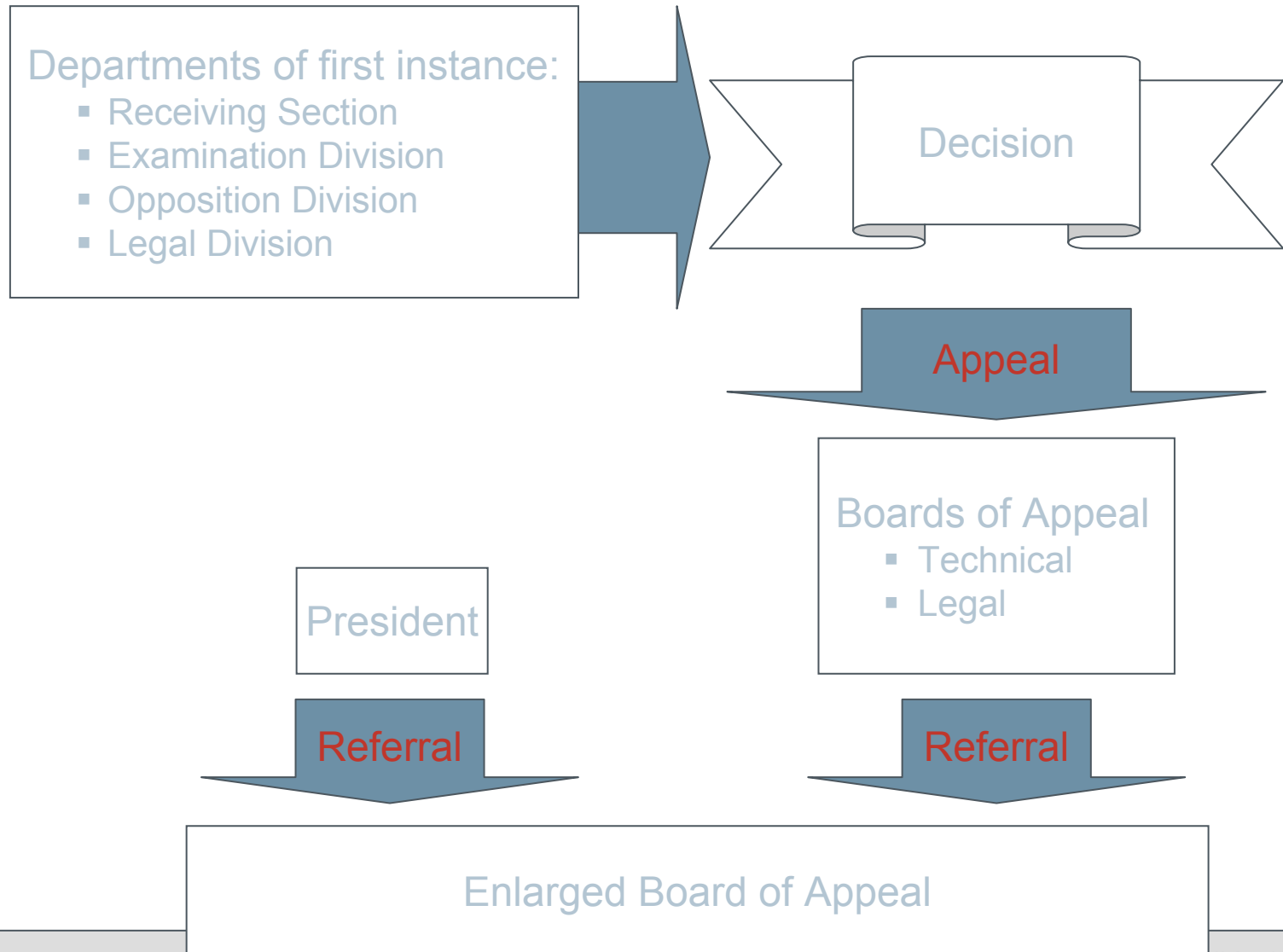
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# The Boards of Appeal

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- Based in Munich, Main Building
- Administratively part of EPO but separate and independent from first instance
- 24 Technical Boards dealing with 1800 appeals/yr
  - 7 Mechanics
  - 10 Chemistry
  - 3 Physics
  - 4 Electricity
- 1 Legal Board dealing with  $\approx 30$  appeals/yr (legal issues only e.g. priority / filing)
- 1 Disciplinary Board
- The Enlarged Board
- Final instance of the EPO

# The Boards of Appeal

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Board	Appeal from:	Decision
Disciplinary	EPO Disciplinary Board <i>epi</i> Disciplinary Committee EQE Exam Board and Sec.	D
Legal	Receiving Section (Art. 91 (3) EPC) Legal Division Examining Division	J
Technical	Examining Division (Art. 97 (1) EPC) Opposition Division (Art. 102 (1)-(3) EPC)	T / W
Enlarged	Technical Board of Appeal President of EPO	G

# Enlarged Board of Appeal

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- Not a court of last resort
- But in future “petition for review”
- Ensures uniform application of EPC
- On points of law referred:
  - By a Board of Appeal - gives decision
  - By President of the EPO - gives opinion
- Its decisions are binding: “precedent”
- Equivalent to Federal Court of Appeal sitting "en banc"

# Conditions on Members

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- Independent
- Renewable 5-year term
- May not be members of the departments of first instance
- Accountable to Administrative Council
- Run by Presidium (Rule 10, EPC)
  - Committee: VP 3 + 6 Chairmen + 6 other DG 3 staff
- Operate according to Rules of Procedure (published in EPO OJ)



# Nature of Appeals

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# Key Aspects

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- Oppositions attack patents – appeals attack decisions
- G 7/91 & G 8/91 - Judicial nature of appeals: “expert courts of great persuasive authority”
- Technical Board of Appeal decision is binding on the case so far as facts are the same (Art 111(2) EPC)
- Enlarged Board decision is binding
- Suspensive effect (Art 106(1) EPC)
- Cannot appeal costs alone (Art 106(4) EPC)

# Parties to Appeal

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- The appellant(s) - anyone adversely affected
  - Patentee cannot appeal if consent withdrawn (T 961/00)
  - Patentee cannot appeal withdrawn request (T 848/00)
- The respondent(s) - parties as of right
- Intervenors - possible during appeal; G 1/94, G 3/04
- Third party objections (Article 115 EPC) - no party status
- Transfers of appeals (no different to oppositions)
  - Patentee appellant: the register rules
  - Opponent appellant: appeal must be transferred with business assets G 4/88, T 298/97
- Demise of party during appeal - loses party status - e.g. dissolved company T 353/95

# ex parte versus inter partes

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- Difference between types of appeal, depending on department of first instance:
  - **Ex parte:** Board can be proactive, raise new issues
  - **Inter partes:** Adversarial; the parties "do the work"



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# Procedural Details

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# Time line for Filing an Appeal

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**Within 2 Months**

**File Notice of Appeal  
Pay Appeal Fee**



**Within 4 Months**

**File Grounds of Appeal**



# Notice of Appeal and Fee

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- Within **two months** (Art 108 EPC):
  - Notice of appeal filed of decision containing :
    - Name and address of appellant
    - Identifying decision appealed
    - Extent to which it is challenged (Rule 64 EPC)
  - Appeal fee of €1 065 paid
- Withing **four months** (Art 108 EPC):
  - Grounds of appeal (reasoned arguments)
    - No specific content required, but must be substantiated
- **These time limits cannot be extended**

# Interlocutory Revision

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- Intended to speed up procedure
- In ex parte proceedings only (also opposition without opponent)
- Handled by first instance:
  - Receiving Section (DG 2)
  - Legal Division (DG 5)
  - Examining/Opposition Division (DG 1)
- Short time for action
- Used often enough?
- Appeal must be admissible and well-founded
- **Obligatory**

# EPO's discretion

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- In proceedings before it, the European Patent Office shall examine the facts of its own motion; it shall not be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought (Art 114 (1) EPC)

**admit**

- The European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned (Art 114 (2) EPC)

**don't  
admit**

# Appeal Procedure

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- **Admissibility check**
  - Minimum contents of notice
  - Not a new case - T 1007/95
  - Appeal from a final decision - "appeals against appeals" not possible - G 1/97
  - Not just a costs appeal
  - Adversely affected party
  - Examination – first instance procedure followed
  - Opposition admissibility also checked
- Principle of “party disposition”: requests must be clear
- Often oral proceedings (formal hearing)
- **Decision** (Article 111 EPC)

# Relevant Decisions

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Decision	Summary
T 220/83	Evidence unrelated to decision under appeal: <b>inadmissible</b>
T 213/85	Opposition insufficiently substantiated: appeal disputes patentability: <b>inadmissible</b>
T 644/97	No new case on appeal: <b>admissible</b>
T 733/98	Grounds confined to supporting new claims: <b>inadmissible</b>
T 500/97	"the decision was wrong; I repeat my arguments below": <b>inadmissible</b> - Read together with notice of appeal
T 7/81	Identifying case and stating intention to appeal sufficient
J 16/94	Cannot appeal as auxiliary request
T 460/95	Must show an explicit and unequivocal intention to attack an appealable decision

# The Ex Officio principle -

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- Same approach as first instance  
(Art 111(1) EPC)

*"The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed*

*or*

*remit the case to that department for further prosecution."*

# The Party Disposition principle – Judicial nature of appeals

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- G 7/81, G 8/81 - If the only appellant/opponent withdraws appeal, **the proceedings end**
  - G 2/91 even if there are other non-appealing opponents
  - G 8/93 even if the Board of Appeal considers the patent questionable
- If one of multiple opponents withdraws - **continues**
- Patentee's sole appeal – **end**
- If patentee and opponent(s) both appealed - **other appeal(s) continue(s)**

# The Party Disposition principle – Judicial nature of appeals

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- Appeal withdrawn
  - Intervention **not possible** (T 517/97)
  - Ancillary issues **possible** (T 41/82)
  - ie withdrawal does not effect costs
- Board of Appeal can consider non-attacked claims dependent on attacked claims (G 9/91)
- no "reformatio in peius" a sole appellant should not be put in a worse position, post appeal (G 9/92, G 4/93, G1/99)

# Cross-appeals not allowed - no "reformatio in peius"

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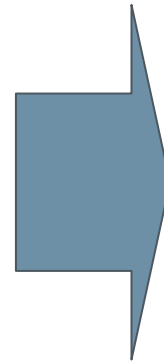
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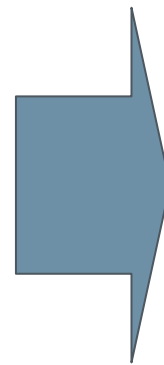
Latest Developments

Opponent appeals  
**Patentee doesn't**



- Patentee** can:
- **only** defend amended claims
  - **cannot** go back to granted claims

Patentee appeals  
**Opponent doesn't**



- Opponent** :
- **must** accept amended claims
  - **cannot** pursue revocation

Bearing in mind the strict time limits applied to appeals procedures the simple message is:  
Get it filed!

See G9/92, G4/93

# New/amended case on appeal

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- Rule 71a EPC does not apply to appeals (G 6/95)
- New grounds of opposition:
  - Only if patentee agrees (G 1/95)
  - but novelty may be considered re closest prior art for inventive step (G 7/95)

# New/amended case on appeal

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- New evidence:
  - Only very exceptional... in the board's discretion, if highly relevant... likely to prejudice maintenance of the patent (**T 1002/95**)
  - Complex fresh subject matter filed at short notice before or during oral proceedings may not be admitted without any consideration of its relevance or allowability (**T 633/97**)

# New/amended case on appeal

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- New requests (patent claims)
  - Auxiliary requests not refused because new claims are not clearly allowable; refusal should be limited to exceptional cases which can be said to amount to an abuse of procedure  
**(T 577/95)**
- Amendment of claims – occasioned by grounds of opposition (Rule 57a EPC)
  - Rule 57a EPC does not entitle a patent proprietor to submit amendments of its patent at any time, without good reasons for such late filing **(T 382/97)**

# No cross-appeals - "reformatio in peius"

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- G1/99 - possible "escape routes" for non-appealing patentee - exceptionally, if the amended patent would otherwise be revoked, the patentee may be allowed to:
  - introduce one or more originally disclosed features limiting the scope of the patent as maintained;
  - if (1) is not possible, introduce one or more originally disclosed features which extend the scope of the patent as maintained, but within A 123(3);
  - if both (1) and (2) are not possible, delete the inadmissible amendment, but within A 123(3).



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# Outcomes of Appeal

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# Decisions

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- Appeal inadmissible
- Appeal dismissed
- Decision of the first instance set aside:
  - Decision on merits by Board
  - Case remitted to first instance
    - Even if both parties want final decision (T 869/98)
    - But not for same ground or ineffective evidence (T 887/98)
    - For substantial procedural violation (T 914/98)
    - For formalities after amendment

**NB: binding effect on first instance, as long as the facts remain the same**

# Further outcomes

Opposition

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Latest Developments

- Reimbursement of appeal fee
  - As appeal not filed
  - For substantial procedural violation e.g.  
T 685/94,  
T 1065/99
- Referral of point of law to Enlarged Board

# Contents of Decision

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Latest Developments

- As statement, delivered by Board
- Date it was taken
- Names of Board members
- Names of parties and representatives
- Statement of issues to be decided
- Summary of facts, and requests
- Reasons for the decision
- Board's order



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# Latest Developments

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# New Appeal Procedure: When and What?

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Latest Developments

- Effective 1 May 2003
- One chance to file complete case
- New art cited with grounds of appeal may be considered
- If no oral proceedings requested, decision may issue
- Amendment of case only at Board's discretion

# New Appeal Procedure: Why?

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- Procedural economy
- Case management
- Strict on amendment to case
- Complexity of subject-matter criterion
- Extensions and postponements need reasons
- New costs rules

# The future....

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- European Patent Appeals Court
- Organ of European Patent Organisation
- Almost certainly in Munich
- Separate president
- Requires diplomatic conference

# Information

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- Decisions are all in the internet:  
<http://legal.european-patent-office.org/dg3/updates/index.htm>
- Case Law  
[http://www.european-patent-office.org/legal/case\\_law/e/index.htm](http://www.european-patent-office.org/legal/case_law/e/index.htm)

**EPO boards of appeal decisions - monthly update**  
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[List of cases](#) of the Enlarged Board of Appeal

[List of updates to the database](#)

**2006**

- [06.06.2006](#) - 104 decision
- [15.05.2006](#) - 96 decision
- [15.05.2006](#) - 1 decision
- [20.04.2006](#) - 68 decisions
- [07.04.2006](#) - 1 decision
- [27.03.2006](#) - 69 decisions
- [26.03.2006](#) - 54 decisions
- [28.02.2006](#) - 25 decisions
- [24.02.2006](#) - 158 decisions
- [17.02.2006](#) - 42 decisions

**2005**

- [23.12.2005](#) - 51 decisions
- [20.12.2005](#) - 1 decision
- [12.12.2005](#) - 19 decisions

**Case Law  
of the Boards of Appeal  
of the European  
Patent Office**

*Fourth Edition*  
December 2001

# The Future

- Strategic Renewal Process
- EPC 2000
  - 13 December 2007
  - Revocation/Limitation Procedure
  - Petition for review
  - Filing requirements
  - Priority claim
  - Further processing
  - BEST formalised
  - PCT Non-unity protests

# Thank you for your attention

EPO Patent Awareness Seminar  
WIPLA, September 2007

Opposition and Appeal

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Dr Sven Jonda

[www.epo.org](http://www.epo.org)