



Opposition Procedure at the European Patent Office

The publication of the mention of grant of a European patent marks the start of the nine month period in which it is possible to file a notice of opposition against the patent and thereby commence opposition proceedings. The post-grant opposition proceedings are completely separate to pre-grant examination proceedings.

Under the EPO streamlined opposition procedure established in 2016, the total time needed for a decision in 'straightforward' cases should be approximately 15 months from expiry of the opposition period.



Who can file an opposition?

Any person can file a notice of opposition. The Enlarged Board of Appeal at the EPO has interpreted this as meaning that it is possible to file a notice of opposition on behalf of a third party (a so-called 'straw-man' opposition) provided the opponent is not acting on behalf of the patent proprietor.

The procedure may involve multiple opponents.

All opponents, as well as the patent proprietor, become parties to the opposition proceedings.

An opponent may withdraw their opposition at any time. The consequence of this is that the opponent is no longer a party to the opposition proceedings but it does not terminate the opposition proceedings.

What does a notice of opposition consist of?

In order for a notice of opposition to be admissible, it must include certain particulars of the opponent and the European patent being opposed, as well as a statement of the extent to which the European patent is opposed and the grounds on which the opposition is based, and an indication of the facts and evidence presented in support of these grounds. A copy of the documents referred to by an opponent should also be filed. There is also an opposition official fee.

Facts and evidence filed by an opponent after the expiry of the nine month opposition period are considered 'late-filed' and should be admitted into the proceedings only if they are prima facie relevant, i.e. if they would change the envisaged decision.

The opposition division

Opposition proceedings are overseen by an opposition division consisting of three technically qualified examiners: a chairman, a primary examiner and a minute-taker. The opposition division may also choose to add a legally qualified examiner, if they consider this is required by the nature of the proceedings.

In 2018, the EPO completed some internal re-organisation into three new technology sectors reflecting changing trends in major areas of patenting activity: mobility & mechatronics; healthcare, biotechnology & chemistry; and information & communications technology. A new specialised directorate to deal with opposition procedures has been created within each of these sectors. These new opposition directorates should mean that at least the primary examiner and chairman for an opposition division will be individuals who are regularly working on oppositions and thus are more experienced in these proceedings. It is expected that this will also mean that the EPO is moving away from their previous practice whereby the primary examiner of the examining division responsible during prosecution was also the primary examiner of the opposition division.

What happens next?



Patentee reply

The notice of opposition will be communicated to the patent proprietor and an EPO formalities officer will check the opposition in order to confirm admissibility.

If several notices of opposition have been filed, the formalities officer will communicate them to the other opponents.

The formalities officer will invite the patent proprietor to file their observations concerning the opposition (including any facts and evidence in reply) and to file any amendments to the description, claims and drawings within a four month period. Amendments are allowed only if they are occasioned by grounds for opposition. A copy of the documents referred to by the patent proprietor should also be filed. A request for an extension to the four-month period will only be granted in exceptional cases.

At this point, the formalities officer will submit the file to the competent opposition directorate and the director responsible will then designate the three technical members of the competent opposition division.

It is possible for the patent proprietor to file more than one set of claims with their reply. These claim requests can be 'ranked' as a main request together with one or more numbered auxiliary requests, which are to be considered in the event that higher ranking requests are found not to be allowable. Any amendment, including a new claim request, filed after the expiry of period set for the patent proprietor to file their observations is admitted into the proceedings only at the discretion of the opposition division.

Facts and evidence filed by the patent proprietor after the expiry of period set for them to file their observations should be admitted into the proceedings only if they are *prima facie* relevant.

The proprietor's observations, and any amendments, are communicated to the opponents. This is for information only and no time limit for reply is set.



Further submissions

The opposition division examines whether the grounds for opposition prejudice the maintenance of the European patent. At this stage, the opposition division generally entrusts the examination of the opposition to one of its members (usually the primary examiner). If the opposition division considers that observations are called for in the course of the further procedure, a separate invitation is issued and a period is fixed (normally four months). However, it is unusual for the opposition division to issue such an invitation.

Uninvited further observations and evidence may be filed at any time and will be subject to an admissibility test as mentioned above.

The formalities officer will, at any stage in the procedure, immediately communicate the observations of any of the parties to the other parties for information.



Summons to oral proceedings

Oral proceedings are usually the final stage of the substantive proceedings before the opposition division.

Typically, oral proceedings are arranged at the request of one or more of the parties, although they may be arranged at the instance of the EPO where it considers them expedient. The parties are invited to oral proceedings by the issuance of a summons. Normally, in opposition proceedings, the summons is issued at least six months ahead of the day of the oral proceedings. The date set for oral proceedings can be changed only in exceptional circumstances.

In a note annexed to the summons, the opposition division lists and explains the points that in its view need to be discussed. The note generally also includes the opposition division's provisional and non-binding opinion on the matters raised in the opposition, and in particular on any amendments to the patent filed by its proprietor. At the same time, the opposition division fixes a final date (usually 1 or 2 months before the day of the oral proceeding) for filing written submissions or amendments in preparation for the oral proceedings.

The opinion generally is prepared by only one member of the opposition division. The opposition division as a whole will then consider the case in the weeks before the oral proceedings. For this reason, the provisional and non-binding opinion can change after issuance of the summons before the day of the oral proceedings.

Oral proceedings are held by videoconference or at one of the EPO offices in Munich, The Hague or Berlin. For straightforward cases, the oral proceedings will be scheduled for a single day. For more complex, multi-opponent cases, the oral proceedings may be scheduled to take place over 2 or 3 days.

Oral proceedings before the opposition divisions, including delivery of the decision, are public, although the public may be excluded from discussions of sensitive information.

Each party is given the opportunity to make their requests and to present their arguments at the oral proceedings. A party may be accompanied to the oral proceedings by a technical expert, although such a technical expert will be allowed to speak at the proceedings only in certain circumstances and under the control of the party's representative.



Decision of the opposition division

At the oral proceedings, the outcome of the opposition will be given verbally by the opposition division, although no reasoning will be provided. In the event of parity of votes, the vote of the Chairman of the opposition division is decisive.

There are three possible outcomes at the end of the proceedings before the opposition division:

- The opposition is rejected and the patent is maintained as granted,
- The patent is maintained in an amended form, in which case a new patent specification is published,
- The patent is revoked.

Following oral proceedings (usually 1-2 months), the parties receive written notification of the decision, including reasons for the decision. The decision applies to all states designated in the European patent. As with any other final decision of first-instance divisions, decisions by opposition divisions can be appealed within two months from the date of notification of the decision. More information on the EPO appeal procedure can be found [here](#).

