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INTELLECTUAL PROPERTY LAW FIRM

10 tips for oppositions and the inevitable oral proceedings

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Background and Experience

Work

Patent examiner at the European Patent Office in The Hague for nearly 10 years.
In-house counsel at GE Healthcare in the UK and Sweden for 8 years.
Private practice 12 years.

Education

B.Sc. in Engineering with French from the University of Bath, UK

IP specific experience

Drafting, prosecuting patent applications. Oral proceedings before the Swedish Patent Office and the European Patent Office. Oppositions and appeals for European patents. Freedom-to-operate evaluations. IP due-diligence. Patent portfolio management. Setting up and managing invention disclosure systems. Former lecturer at the Swedish Patent Office and at the Swedish IP Academy.

Peer nominated Awards

Managing Intellectual Property Magazine “IP Star” 2014, 2015
Intellectual Asset Management Magazine “Patent 1000” 2013, 2014, 2015

Oppositions and oral proceedings

European patent system

- One patent application
- One language (DE, FR or GB)
- One European Patent attorney
- One set of rules (EPC)
(EPC = European Patent Convention)
- One set of fees
- One opposition procedure

5% of all granted European patents are opposed!

Yours could be next!



What is an opposition?

- Method to get patent revoked or limited
- Can be filed by anyone
- File within 9 months of date of grant
- Official Opposition Fee 775 Euros
- Use EPO form 2300 “Notice of opposition”
- File grounds for opposition at the same time
- Can use any official language
- <http://www.epo.org/searching/free/register.html>



Notice of opposition to a European patent

I. Patent opposed

Patent No.

Application No.

Date of mention of the grant in the European Patent Bulletin (Art. 97(3), Art. 96(1) EPC)

Title of the invention

II. Proprietor of the patent first named in the patent specification

Opponent's or representative's reference (max. 15 keystrokes)

III. Opponent

Name

Address

State of residence or of principal place of business

Nationality

Telephone/Fax

Multiple opponents (see additional sheet)

IV. Authorisation

1. Representative (name only one representative or name of association of representatives to whom notification is to be made)

Address of place of business

Telephone/Fax

Additional representative(s) on additional sheet/see authorisation

Opponent's reference

Opposition procedure

- File opposition (EPO checks opposition admissible)
- Opposition sent to patentee (4 month due date)
- Patentee responds -copy sent to opponent (4 month due date)
- “Opposition Division” = 3 examiners – usually one who granted the patent and two other examiners
- Repeat written procedure or attend oral proceedings or EPO “Opposition Division” takes decision
- If one party requests oral proceedings then EPO must arrange oral proceedings. Most likely!

- Final decision taken on the day of the oral proceedings!

- Decision can be appealed (Appeal fee 1860 Euros)



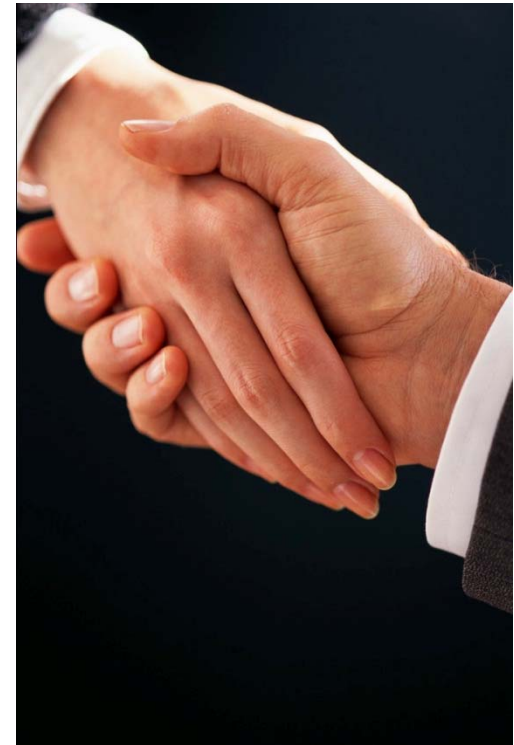
Oppositions and oral proceedings

1. Motivation

Who is "buying" the opposition?

Why file an opposition?

Alternatives: (cross-)licence, negotiate, design around



Oppositions and oral proceedings

1. Motivation

Manage expectations!

Patent maintained 35%

Patent revoked 30 %

Patent maintained in amended form (limited) 35%

Don't be a "Scotty"!

Overly pessimistic is as bad as overly optimistic.



Oppositions and oral proceedings

2. Resources

- Time

- Money

OR

- Just file and forget



Oppositions and oral proceedings

3. Only 3 grounds for opposition! (Article 100 EPC)

- a) Lack of novelty, inventive step
- b) Incomplete or unclear disclosure
- c) Added subject-matter



Oppositions and oral proceedings

4. Do your homework

One chance to file documents – at the beginning!

Look everywhere

Be imaginative



Oppositions and oral proceedings

5. Prepare your case

Use all three grounds in the Notice of Opposition

Step 1. New subject matter.

Step 2. Attack novelty and inventive step

Step 3. Find a feature in the application which is unclear or lacking.



Oppositions and oral proceedings

6. Public prior use

Prove beyond doubt.

File affidavits

Use exact claim terminology to the letter!

Offer witnesses



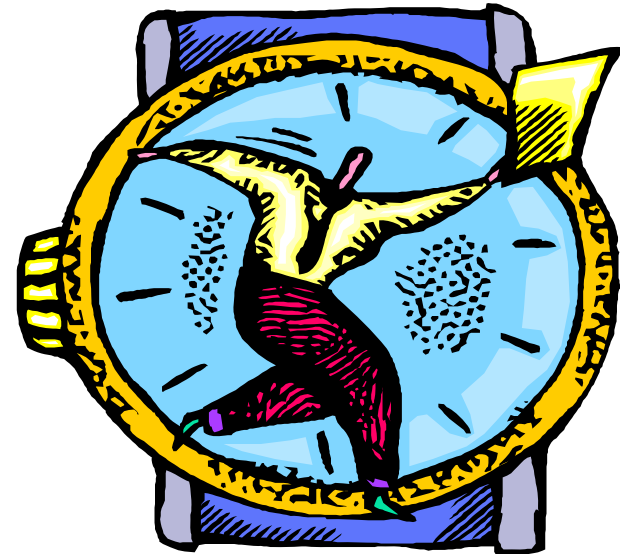
Oppositions and oral proceedings

7. File but don't forget

Keep the case in the back of your mind

File new documents as soon as possible.

Such late filed documents must be prima facie (“at first glance”) relevant.



Oppositions and oral proceedings

8. Responding to the other party

Be impressed, then suspicious ,then annoyed

Check all quoted case law/guidelines.

Refute all other party's comments.



Oppositions and oral proceedings

9. Oral proceedings

In Munich or The Hague – usually less than 1 day.

Free simultaneous translation into English, French or German provided by the EPO.

Preparation, preparation, preparation.

Useful for client to attend but NOT speak



Oppositions and oral proceedings

9. Oral proceedings

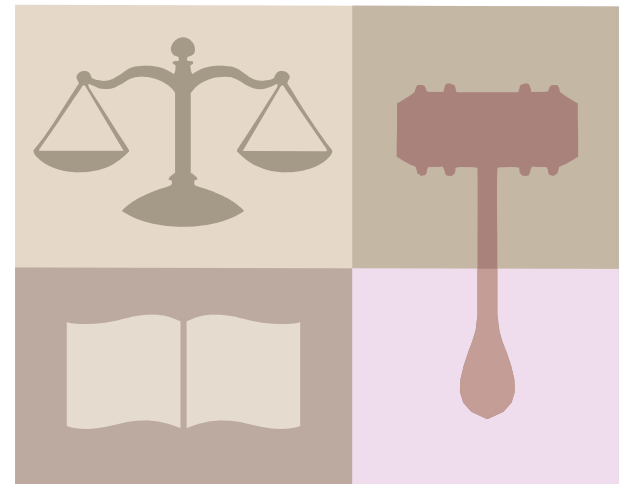
Don't be kind or fair to the other party

Repetition of arguments

Understand what the EPO wants/is saying

If you disagree then get it noted in the minutes

Ask for an adjournment whenever necessary



Oppositions and oral proceedings

10. Prepare for the unexpected

Surprise attacks occur:

New documents

New arguments

Surprise help:

EPO can raise issues “of its own motion”



Oppositions and oral proceedings

11. Bonus no. 1

Things can go wrong!

Check translations

Check correct version of document filed

File auxiliary requests

Your motto should be:

”PPPPP” = Prior preparation prevents poor performance!!!



Oppositions and oral proceedings

12. Bonus no. 2

Practical advice for OP in Munich

S-Bahn – S1 and S8 from the airport
Around 21 Euros for 5 people

Hotel Admiral – Kohlstrasse.
Opposite EPO main building and
6 minutes by metro from other buildings

Have coins for the coffee machine and sweets
for energy





Be prepared!

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