

Comments on the document SCP/14/5

Statistics concerning oppositions (point 16 and 74):

- Number of oppositions filed against European patents granted:
 - 2008: 2800
 - 2009: 2700
 - 2010: 2770
- Number of decisions in opposition cases which took effect
 - 2008: 1980
 - 2009: 2310
 - 2010: 2310
- Opposition rate:
 - 2008: 5,32%
 - 2009: 4,7%
 - 2010: 5,2%
- Outcome of opposition cases:

	Rejection of the Opposition	Revocation of the patent	Maintenance in amended form
2010	29%	33%	38%

Addition to point 64 regarding the intervention of the assumed infringer:

- Under certain conditions any third party who proves that proceedings for infringement of the opposed patent have been instituted against him or that the proprietor of the patent has requested him to cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent may, after the opposition period has expired, intervene in the opposition proceedings.¹ Once the notice of intervention has been filed in good time and in due form, the intervention is to be treated as an opposition.

Addition to point 113 concerning intervention:

- In order to facilitate the filing of third party observations, the EPO has launched a pilot project. As of 1 August 2011 such observations can be filed by filling out an online form on the EPO Website. The traditional means of filing (e.g. by letter or fax) will continue to be acceptable.

¹ Article 105 EPC.

61. The administrative revocation procedure may result in a decision by the Eurasian Office to revoke the Eurasian patent, to reject the notice of opposition, or to correct or amend the patent. The Eurasian patent recognized as invalid as the result of a revocation procedure, either entirely or in part, is considered void in all Contracting States as from the date of filing of the Eurasian application.³⁷

62. The decision on the opposition to the grant of a Eurasian patent is published in the Gazette of the Eurasian Office. In case the opposition resulted in the amendment of a patent, the Eurasian Office publishes the new specification of the Eurasian patent containing the description as such, the claims and the drawings as amended. In the event of an appeal being filed, no acts related to the implementation of the decision on the opposition, including the entry of changes into the Register of Eurasian patents, publication of information on the decision on the opposition in the Eurasian Office Bulletin, shall be performed until a decision is passed on the appeal.

63. An appeal against the decision in question may be lodged by any party in the opposition examination with the President of the Eurasian Office within four months of the date of dispatch of the decision. The President of the Eurasian Office examines the appeal and either orders a renewed hearing of the opposition by the board or takes a final decision on the opposition.³⁸

European Patent Office (EPO)

64. The European Patent Convention (EPC) provides a post-grant opposition. European patents granted by the EPO may be opposed by any person within nine months of the publication of the [mention of the grant](#) of the European patent in the European Patent Bulletin and upon the payment of the opposition fee.³⁹ The proprietor of the patent is not entitled to file an opposition,⁴⁰ although he may request limitation of his patent under EPC Article 105a.

65. The notice of opposition must be filed in writing and contain, *inter alia*, a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence in support of these grounds.⁴¹

66. The Opposition Division of the EPO is responsible for the examination of the opposition against any European Patent. It consists of three technically qualified examiners, and in some cases where the nature of the decision so requires, it may be enlarged by the addition of a legally qualified examiner.⁴²

67. As provided by Article 100 of the EPC, the opposition can only be based on the following grounds: the subject-matter of the patent is not patentable under Articles 52 to 57 (patentable inventions, exceptions to patentability, novelty, non-prejudicial disclosures, inventive step, industrial application); the invention is not sufficiently disclosed to allow a

³⁷ Rule 53(4) of the Patent Regulations

³⁸ Rule 53(8) of the Patent Regulations

³⁹ Article 99 EPC

⁴⁰ G 9/93 (OJ 12/1994,891)

⁴¹ Rule 76 of the Implementing Regulation to the EPC

⁴² Article 19 EPC

person skilled in the art to carry it out; and the content of the patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed.

68. According to Article 101 of the EPC, if the opposition is admissible,⁴³ the Opposition Division shall examine whether at least one ground for opposition under Article 100 prejudices the maintenance of the European patent. During the examination, the Opposition Division invites the parties to file observations on communications from another party or issued by itself. In particular, ~~after~~ the notice of opposition is ~~granted, it is~~ forwarded to the proprietor of the patent, who may reply with observations or amendments to the description, claims and drawings within a time frame set by the Opposition Division. The observations and amendments filed by the proprietor of the patent are then forwarded by the EPO to ~~other parties to the opposition proceeding, and~~ the opponent(s) who are given the opportunity to respond within a specified period.⁴⁴

69. During the opposition, oral proceedings may take place at the ~~request~~ instance of the EPO or at the request of any party to the proceedings.⁴⁵ The oral proceedings are held before the Opposition Division itself.⁴⁶ They are generally public unless the Opposition Division decides otherwise in particular cases.⁴⁷

70. Based on all the evidence, the Opposition Division renders a decision. In the event of parity of votes, the vote of the Chairman of the Opposition Division is decisive.⁴⁸ If the Opposition Division finds that at least one ground for opposition prejudices the maintenance of the European patent, it revokes the patent. Otherwise, it rejects the opposition. If the Opposition Division concludes that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent (and the invention to which it relates) meets the requirements of the EPC, it decides to maintain the patent as amended after certain formal requirements have been fulfilled. If the patent after such amendments do not meet the requirements of the EPC, the Opposition Division revokes the patent.⁴⁹

71. The opposition shall apply to the European patent in all the Contracting States in which that patent has effect. Decisions by Opposition Divisions are appealable by any party to proceedings adversely affected by the decision before the Board of Appeal of the EPO.⁵⁰

72. A notice of appeal must be filed at the EPO within two months of notification of the contested decision, and the fee for appeal must be paid. In addition, within four months of notification of the decision, a statement setting out the grounds of appeal must be filed.⁵¹

⁴³ Rule 77 of the Implementing Regulation to the EPC provides grounds for a rejection of the opposition as inadmissible

⁴⁴ Rule 79 of the Implementing Regulation to Part V of the EPC

⁴⁵ Article 116(1) EPC

⁴⁶ Article 19 EPC

⁴⁷ These are the cases where “admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings” (Article 166 EPC)

⁴⁸ Article 19 EPC

⁴⁹ Article 101 EPC

⁵⁰ Article 106 EPC

⁵¹ Article 108 EPC

European Patent Office (EPO)

112. In accordance with EPC Article 115, in proceedings before the EPO, any third party may present observations concerning the patentability of the invention to which the application or patent relates, once the publication of the European patent application was made. That person ~~may~~will not be a party to the proceedings before the EPO. No fee is required for the submission of observations.

113. Such observations shall be filed in writing in an official language of the EPO, and state the grounds on which they are based.⁸⁵ Documentary evidence and, in particular, publications submitted in support of the arguments may be filed in any language. However, the EPO may request that a translation into one of its official languages be filed; otherwise the evidence will be disregarded.⁸⁶

114. The observations made by a third party will be communicated to the applicant (or the patentee), who may comment on them.⁸⁷ If they call into question the patentability of the invention in whole or in part, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated, i.e. they must be admitted to the proceedings.⁸⁸ If the observations relate to alleged prior art available other than from a document, e.g. from use, this should be taken into account only if the alleged facts either are not disputed by the applicant (or the patentee) or are established beyond reasonable doubt.⁸⁹ Observations received after the conclusion of the proceedings will simply be added to the file.⁹⁰ Although the third party is sent acknowledgment of the receipt of his observations, the EPO does not inform him of any further action it takes in response to them.⁹¹

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⁸⁵ Rule 114(1) of the Implementing Regulations under the EPC

⁸⁶ EPO Examination Guidelines, Part E, VI.3

⁸⁷ Rule 114(2) of the Implementing Regulations under the EPC

⁸⁸ EPO Examination Guidelines, Part E, VI.3

⁸⁹ *Ibid*

⁹⁰ *Ibid*

⁹¹ *Ibid*