

Opposition systems

European Patent Office

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.¹ The proprietor of the patent is not entitled to file an opposition,² although he may request limitation of his patent under EPC Article 105a.

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.³ Once the notice of intervention has been filed in good time and in due form, the intervention is to be treated as an opposition.

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.⁴

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.⁵

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 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.

According to Article 101 of the EPC, if the opposition is admissible,⁶ 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, the notice of opposition 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 the opponent(s) who are given the opportunity to respond within a specified period.⁷

¹ Article 99 EPC.

² G 9/93 (OJ 12/1994,891).

³ Article 105 EPC.

⁴ Rule 76 of the Implementing Regulation to the EPC.

⁵ Article 19 EPC.

⁶ Rule 77 of the Implementing Regulation to the EPC provides grounds for a rejection of the opposition as inadmissible.

⁷ Rule 79 of the Implementing Regulation to Part V of the EPC.

During the opposition, oral proceedings may take place at the instance of the EPO or at the request of any party to the proceedings.⁸ The oral proceedings are held before the Opposition Division itself.⁹ They are generally public unless the Opposition Division decides otherwise in particular cases.¹⁰

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.¹¹ 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.¹²

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.¹³

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.¹⁴

A petition for review by the Enlarged Board of Appeal of a decision of a Board of Appeal may only be filed on the grounds specified by Article 112a(2) of the EPC.

In cases where an infringement or revocation action in respect of a European patent is pending before the Unified Patent Court or the competent authority of a contracting state, a party to the opposition proceedings may request accelerated processing. The request may be filed at any time. It must be filed in written reasoned form. In addition, the EPO will also accelerate the processing of the opposition if it is informed by the Unified Patent Court, the national court or the competent authority of a contracting state that infringement or revocation actions are pending (OJ EPO 2023, A99).

The specific acceleration measures adopted depend on when the EPO is notified of parallel court proceedings:

(i) If the EPO is notified during the opposition period: after the period expires, the proprietor will be invited to comment on the opposition within three months, the summons will be issued within two months of receipt of the proprietor's reply, summoning the parties at minimum notice (Rule 115(1) EPC);

(ii) If the EPO is notified after expiry of the opposition period but before the proprietor's reply to the opposition: the summons to oral proceedings will be issued within two months of receipt of the proprietor's reply. The parties will be summoned at minimum notice (Rule 115(1) EPC);

(iii) After the proprietor has replied but before the summons has been issued: the summons

⁸ Article 116(1) EPC.

⁹ Article 19 EPC.

¹⁰ 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).

¹¹ Article 19 EPC.

¹² Article 101 EPC.

¹³ Article 106 EPC.

¹⁴ Article 108 EPC.

to oral proceedings will be issued within two months of receipt of the information on parallel proceedings. The parties will be summoned at minimum notice (Rule 115(1) EPC);

(iv) After the summons has been sent oral proceedings are rescheduled to the earliest possible date (provided that the time saving is significant);

(v) After the decision has been pronounced: the decision and the minutes will be issued within one month¹⁵.

Parties with a legitimate interest may ask the boards of appeal to deal with their appeals rapidly. This option is also available to the courts and competent authorities of the contracting states (see Art. 10 Rules of Procedure of the Boards of Appeal, OJ EPO 2019, A63, as amended by OJ EPO 2021, A19). Information on the possibility of accelerating processing before the boards of appeal can be found on the EPO website¹⁶.

¹⁵ *Guidelines for Examination in the EPO, E-VIII, 5*

¹⁶ *Guidelines for Examination in the EPO, E-VIII, 6*