Opposition and Appeal Proceedings at the European Patent Office
Opposition Proceedings at the EPO

**Post grant proceedings**: the opposition must be filed within **nine months** of the publication of the mention of the grant of the European patent in the European Patent Bulletin (Art. 99 EPC)

Open to **any person**

- Not the patent proprietor (G 9/93)
- Opponent acting on behalf of a third party, unless the involvement of the opponent is to be regarded as circumventing the law by abuse of process (G 3/97).

The opposition applies to the European patent in **all the Contracting States** in which the patent has effect.

**Inter partes proceedings**: Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.
Nature of Opposition Proceedings

Opposition proceedings are not essentially contentious proceedings between warring parties where the deciding body takes a neutral position (G 1/84)

Opposition proceedings in the European Patent Office are investigative in nature (Article 114(1) EPC)

Once an opponent has launched an admissible opposition he may play a completely passive role or even withdraw from the proceedings because the EPO may continue the proceedings on its own motion (Rule 84 EPC).
Grounds for opposition

An opposition may only be based on the grounds listed in the law

- Lack of patentability (Art. 100 (a) EPC)
The subject-matter of the European patent is not patentable, excepted from patentability or not fulfilling the requirements of novelty, inventive step or susceptibility for industrial application.

- Insufficiency of disclosure (Art. 100 (b) EPC)
The European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- Extended subject-matter (Art. 100 (c) EPC)
The subject-matter of the European 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.
Opposition Division

- Responsible for the examination of opposition (Article 19 EPC)

Consists of:

- **three technically qualified examiners**, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for the grant of the European patent may not be the Chairman.

- **additionally**, if the Opposition Division considers that the nature of the decision so requires (e.g. hearing of a witness), **a legally qualified examiner** who shall not have taken part in the proceedings for grant of the patent. In the event of parity of votes, the vote of the Chairman of the Opposition Division shall be decisive.
Decisions

• Revocation of the patent
  – At least one ground for opposition prejudices the maintenance of the European patent as granted (Article 101(2) EPC)
  AND/OR
  – The patent as amended does not meet the requirements of the Convention (Article 101(3)(b) EPC).

• Rejection of the opposition
  – No ground for opposition prejudices the maintenance of the European patent (Article 101(2) EPC)

• Maintenance of the Patent in amended form
  – The patent as amended meets the requirements of the Convention (Article 101(3)(a) EPC)

• Costs
  – each party bears its costs, unless the Opposition Division, for reasons of equity, orders a different apportionment of costs (Article 104(1) EPC).
Statistics

- Opposition rate: 4.7% in year 2014
  Decisions in oppositions: 2143 in year 2014
- Average duration of proceedings: 25,6 months
- Outcome of the decision:
  
  - Patent revoked: 31%
  - Opposition rejected: 31%
  - Patent upheld in amended form: 38%
Appeal Proceedings at the EPO

• Decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division may be appealed to the Boards of Appeal of the EPO. The appeal has suspensive and devolutive effect. (Art. 106 (1) EPC)

• Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right. (Art. 107 EPC)

• The notice of appeal is to be filed within 2 months from the notification of the decision. The grounds are to be filed with 4 months. (Art. 108 EPC)

• If the appeal is admissible, the Board of Appeal will examine whether the appeal is allowable. (Art. 110 EPC)
Nature of Appeal Proceedings

• The appeal procedure is a **judicial procedure**. Such procedure is less investigative than an administrative opposition procedure (G 9/91).

• In their decisions the members of the Boards are not bound by any instructions and comply only with the provisions of the Convention.

Boards of Appeal

Technical Board:

• Two technically qualified members and one legally qualified member
  – for appeals from a decision of an Examining Division or an Opposition Division, when the decision was taken by a Division consisting of less than four members (Article 21(3)(a) EPC)

• Three technically and two legally qualified members
  – when the decision was taken by a Division consisting of four members, or when the Board of Appeal considers that the nature of the appeal so requires (Article 21(3)(b) EPC)

Legal Board:

• Three legally qualified members
  – for appeals from decisions of the Receiving Section or the Legal Division (Article 21(2) EPC), or
  – the Examining Division when the decision does not concern the refusal of a European patent application or the grant, limitation or revocation of a European patent (e.g. decision on a request for re-establishment of rights) (Article 21(3)(c) EPC)

There are (in 2015) **28 Technical** Boards and **1 Legal** Board
Enlarged Board of Appeal

- **Referral** of a question to the Enlarged Board of Appeal in order to ensure uniform application of the law, or if a point of law of fundamental importance arises (Article 112 EPC):
  - by a **Board of Appeal** during proceedings on a case and either of its own motion or following a request from a party to the appeal, or
  - by the **President of the European Patent Office** where two Boards of Appeal have given different decisions on that question
- Five legally and two technically qualified members (Article 22(2) EPC)
- Participation of external legally qualified members (national judges)
- Three decisions in 2015 and 2 cases pending

- **Petition for review** by the Enlarged Board of Appeal (Article 112a EPC):
  - by a party to appeal proceedings adversely affected by the decision of the Board of Appeal only in particular circumstances, e.g. if a fundamental violation of Article 113 EPC (right to be heard) occurred
- Three (two legal, one technical) or five members (four legal, one technical)
## Statistics

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<th>2014</th>
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<td>21 (21)</td>
<td>23 (17)</td>
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<td>23 (25)</td>
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<td>Examination</td>
<td>996 (1110)</td>
<td>1200 (1013)</td>
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<td>1358 (1190)</td>
<td>1315 (1124)</td>
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<td><strong>Length of proceedings:</strong></td>
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<td>Average length (months)</td>
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Structural reform of the EPO Boards of Appeal

- At the 143rd meeting on 25-26 March 2015 the Administrative Council (AC) of the EPO gave its general support to the reform of the BOA (CA/16/15)

- Reform of the BOA to be carried out within the existing legal framework of the EPC

- The reform aims to increase:
  - the organisational and managerial autonomy of the BOA
  - the perception of independence of the BOA (Article 23 EPC)
  - the efficiency of the BOA

- Areas of implementation:
  - Institutional framework
  - Human resources
  - Premises

- User consultation took place from 30.04.2015 to 30.06.2015
Structural reform of the BOA- Institutional framework

Enhancing the organisational and managerial independence of the BOA (BOA organised as a separate organisational entity within the EPO)

– New function: President of the BOA (Managerial and organisational powers delegated from the President of the EPO)

– Constitution of a BOA Committee (BOAC) (Judiciary committee, monitoring the independence and efficiency, supervising and advising the BOA on a general level)

– Powers of the AC and the President of the EPO
Thank you for your attention!

Heli Pihlajamaa
Director, Patent Law
European Patent Office, Munich
Tel: +49 (0) 89 2399 5210
email: hpihlajamaa@epo.org