



Opposition Matters 2020

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Inside the mind of the Opposition Division

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Inside the mind of the Opposition Division



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Substantive Examiner
(Search, Examination and Opposition)

1989 – Examiner - Technical Field F01B/ F02B
(internal combustion engines)

1994 – Chairman in Opposition

2002 – Analysis and presentation of Board of Appeal Decisions

2004 – BEST examiner



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Content

- The bottom line
- The file has arrived, what do I do?
- The file has arrived, what do I think?
 - Balance
 - Tactics
 - Other arguments
 - Interpretation
- So what do I do?
- When do I summon?
- When do I issue a first communication?
- Oral proceedings – who does what?
- Oral proceedings – what happens when?
- Decision time

The Bottom Line

- The EPO does not decide who wins.
- The EPO decides if the invention warrants a patent as defined by the EPC.
- The aim of opposition proceedings is that no patent leaves the EPO that should not leave the EPO.

The Bottom Line

Bear in mind that we are dealing with :

- lots of different examiners from
- lots of different countries looking at
- lots of different files dealing with
- lots of different technical subject matter prepared by
- lots of different applicants from
- lots of different countries (often) represented by
- lots of different attorneys from
- lots of different countries

The Bottom Line

- There is only one single absolutely correct answer to any question on any topic anywhere in the EPO
- "It depends"
- All that follows are most likely scenarios not cast iron facts
- Each case needs its own approach

The file has arrived, what do I do?

- Read the claims
- Read the notice of opposition to get an overview
- Read in detail with reference to cited documents
- Form a preliminary opinion
- Read the response from the proprietor
- Review the preliminary opinion
- If present, read the response from the opponent.

The file has arrived, what do I think?

- What sort of parties do I have?
- Is the procedure **balanced**?
- What sort of **tactics** are being used?

- What is missing?
 - Are the arguments clear and complete?
 - Are there any **other arguments** that arise?

- What do I need to decide before I can start deciding?
 - Admissibility?
 - **Interpretation** of terminology

Balanced

- Professional representatives on both sides
 - Usual situation
- Representative vs in-house
 - Attorney vs Engineer
 - Different styles of argument
- Representative vs single inventor
 - rare

Tactics

- Are objections under Art. 100 (b) either disguised clarity objections, or disguised "opening shots" for inventive step arguments (i.e. the skilled man knows how to do that because it's obvious).
- Do we get the feeling that something is being held back?

Other Arguments

- Neither opponent's arguments are really convincing, but a document from one opponent combines well with one from another.
- The opponent's arguments are not convincing, but another line based on the same document may be.
- The file on your desk yesterday attacks novelty.
- **Note – raising an argument does not dictate the end result!**

Interpretation

Once the interpretation is fixed, it can be used for several different attacks

- Example "controllable valve" – can a passive non-return valve be controlled, e.g. by controlling pressure differential?
- If you decide that a passive valve is not controllable and then discuss novelty (aware that all the prior art only shows simple passive non-return valves), it is immediately clear that none of the many novelty attacks are going to work.
- Bear in mind, however, that it is legitimate to allow a novelty attack to be converted into an inventive step attack if a feature is not shown.

So what do I do?

- The aim is to obtain legal certainty as effectively (i.e. soon) as possible.
- Summons
 - Usual procedure
- Write a communication
 - Game changer

When do I summon?

- Summon if the file is ready to do so, i.e:
- I am confident about likely actions of the parties 2 months before the oral proceedings.
- I am confident I can guess what the situation may be at the start of the oral proceedings.
- The objections raised are of a nature that they are sufficiently complete for the point to be discussed.
- I am confident that interpretation of terminology will not lead to excessive discussion.
- I can deal with parties not turning up.

When do I issue a communication?

- We may write a first communication if matters need clarifying prior to the file being ready for oral proceedings

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- Examples include:
 - If claim terminology needs interpretation that will seriously affect the arguments on file.

When do I issue a communication?

- We may write a first communication if matters need clarifying prior to the file being ready for oral proceedings
- Examples include:
 - If the proprietor has filed amendments that have not yet been commented on by an opponent.
 - Note if the opponent has commented on dependent claims and these have been taken for the amendment, this may suffice.
 - Bear in mind that if prior to the summons no comment has been made by the parties on amendments, the situation may arise that the first comment must appear in the decision (e.g. if the parties do not attend oral proceedings) (Art. 113).
 - It is not the task of the opposition division to raise arguments for the opponent.

When do I issue a communication?

- We may write a first communication if matters need clarifying prior to the file being ready for oral proceedings
- Examples include:
 - If some form of major reaction from the proprietor is expected, but we cannot see what it might be.
 - Bear in mind that the proprietor is obliged to file his defence at the earliest opportunity; after this, any amendments can be deemed late filed and are subject to the discretion of the division.
 - It may be worth reminding the proprietor of this as opponents can be faced with a difficult situation if unexpected reactions are filed 2 months before the oral proceedings (e.g. features taken from the description).

When do I issue a communication?

- We may write a first communication if matters need clarifying prior to the file being ready for oral proceedings
- Examples include
- If we see an argument that has not yet been raised, either based on cited documents but using arguments significantly different to those of the opponent, or from our own motion.

When do I issue a communication?

- We may write a first communication if matters need clarifying prior to the file being ready for oral proceedings
- Examples include
- If we have a document which is questionable from the point of view of publication date, or if a prior use argument is lacking evidence for a link in the chain, and we need to decide if the document or prior use is actually to be taken into account.

Oral Proceedings – who does what?

- The chairman controls
 - Guidance
 - Order
- The first examiner thinks
 - Where is a line of argument leading?
 - What might be the consequence?
 - Is a line of argument complete?
- The second examiner records
 - Who said what, when?

Oral proceedings – what happens when?

- It is perhaps logical to start with 100(b) &(c), but it is by no means compulsory
- e.g.
 - If the drawings are identical, does it matter what words are used in the claim? Look at novelty first.
 - If a term needs interpretation before you can do novelty, decide on interpretation first without looking at a claim.
- If possible continue along the line of the summons
 - Bias against currently likely winner
 - Start with the currently likely loser

Decision time

- Try to take the proceedings as far as possible so that the BoA can decide all points
 - E.g. Discuss clarity, but do not announce decision as this may change during the novelty discussion. Then announce on clarity and novelty.
- But one reason is sufficient
 - E.g. if novelty is lacking with regard to D1, there is no need to look at D2.
- Keep going until you are satisfied you can decide whether the invention warrants a patent as defined by the EPC.
 - If it does; maintain (possibly amended), if not; revoke.



Questions?