

Learning path for patent administrators

Opposition procedure: EPAC - intermediate level

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Introduction

This publication, "Opposition procedure, EPAC - intermediate level", is part of the "Learning path for patent administrators" series is edited and published by the European Patent Academy. The series is intended for patent administrators who are taking part in training and certifications organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include: general aspects of the patent system; the European patent system and the European patent granting procedure; the International Patent System (PCT) and the PCT procedure; European and international publications; filing a European patent application and filing an international application; the formalities during the European and during the international search; the formalities during the European examination and during the international preliminary examination; the formalities during the appeal procedure after refusal (EPC), during the opposition procedure (EPC); national validation (EPC); entry into national/regional phases and entry into the European phase (PCT).

Each chapter focuses on one topic at entry, intermediate or advanced level, as appropriate. The series will be revised annually to ensure it remains up to date.

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All references to natural persons are to be understood as applying to all genders.

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1. Learning objectives

Participants in this course will learn:

- about the definition of the opposition
- who may file an opposition
- how to file an opposition
- about the opposition fees
- about the possible outcomes of opposition proceedings

2. Filing a notice of an opposition

Within nine months of mention of the grant in the European Patent Bulletin, anybody (except the proprietor) can ask the EPO to overturn its decision to grant, based on reasons of patentability, insufficient disclosure and/or subject-matter added beyond the content of the application as "originally" filed.

The window for filing an opposition closes after nine months for reasons of legal certainty and fairness.

Special scenario after expiry of the opposition period: intervention

A third party may intervene after expiry of the opposition period (nine months) in pending opposition proceedings or opposition appeal proceedings if that third party proves to be involved in infringement proceedings relating to the opposed patent.

An intervention found to have been validly filed and admissible will be treated as an opposition.

All general requirements for the valid filing and admissibility of an opposition also apply to an intervention.

Legal references:

Art. 99, 100, 105 EPC

GL D-I 5

3. Who may file a notice of opposition?

Any person may file an opposition against a granted patent except the patent proprietor.

Proprietors cannot oppose their own patent but may request revocation or limitation.

Oppositions are filed by:

- economic competitors as a precautionary measure against a potential competitor or in reaction to a patent infringement
- interested persons or organisations (e.g. an NGO), for ethical reasons

Representation

The representative may be the same for several opponents but not for both the proprietor and an opponent.

There cannot be one representative for two competitors (conflict of interest, arguing against themselves).

Multiple opponents

Multiple opponents may file their opposition to the same patent. In principle there is no limit to the number of opponents. Each opponent has to be registered.

Some technical fields (e.g. biotechnology) are areas of major public interest and/or high competition. Patents in some sectors are often challenged by more than one opponent.

Joint opponents

An opposition may be filed by joint opponents. Consequently, only one opposition fee is due. Joint opponents must have one common representative (they act as one party. If there is no common representative, the EPO will appoint one *ex officio*).

Multiple opponents cannot act separately or without the consent of the other joint opponents.

Straw man

A straw man in opposition is a person who files the opposition in their own name but is acting on behalf of another unnamed person. Sometimes an opponent has reasons for hiding their identity from the proprietor.

Straw men are accepted by the EPO unless proved to be abusive (i.e. opponent acts in the proprietor's interest).

Third-party observations in opposition

Any third party (except the proprietor or an opponent) may present observations concerning the patentability of the invention. A third party is not a party to the proceedings. Third-party observations may be anonymous.

Legal references:

Art. 99, 105a, 115, 133 EPC

Rule 114, 151(1) EPC

CLB IV.C.2.1.4, 2.1.6, 2.1.7

4. Opposition: what, where and how to file?

The opposition procedure:

- is a post-grant procedure
- is initiated by a member of the public
- is a contentious procedure between the proprietor and at least one opponent
- allows opponents to challenge the validity of granted patents
- is *inter partes* – the EPO must guarantee impartiality and equal treatment of all parties

All parties must be given the right to be heard and all must have an equal opportunity to react.

The owner of a patent is its "proprietor(s)". An "opponent" is a party who disputes the EPO's decision to grant. An EPO opposition division (OD) considers the opponent's arguments and gives the proprietor the opportunity to defend their patent against the opponent's objections.

To guarantee the impartiality of the proceedings, the OD is not allowed to have direct contact with any of the parties.

A new opposition has to be filed in writing (preferably using EPO [Form 2300](#)):

- by post
- by fax
- online or
- delivered in person

The EPO's filing offices are located in Munich, The Hague, Berlin.

Basic requirements are:

- fee payment
- reasons (grounds on which the opposition is based)
- evidence (cited documents)

Without the evidence or reasons why the evidence is prejudicial, there is no opposition case.

Oppositions may only be filed on the following grounds:

- subject-matter of the patent is not patentable under [Art. 52-57 EPC](#)
- subject-matter of the patent extends beyond the content of the application as filed ([Art. 123\(2\) EPC](#))
- the patent does not disclose the invention in a manner that is sufficiently clear and complete ([Art. 83 EPC](#))

Deficiencies

In the case of deficiencies, some must be remedied within the opposition period, others may be remedied within a time limit set by the EPO.

There are also different legal consequences:

- documents not filed are not taken into account
- opposition deemed not to have been filed
- opposition declared inadmissible

To determine whether an opposition is deemed to have been filed, the following questions must be answered affirmatively.

- Was the fee paid in full and on time?
- Is the opposition duly signed?
- Has an authorisation been filed (if required)?
- If the opponent is not established in an EPC contracting state, has a professional representative been appointed?
- If the opposition is filed in a language other than English/French/German:
 - is the opponent entitled to file a notice of opposition in another language?
 - has a translation been filed within one month?

To determine whether an opposition is admissible, the following requirements must be met.

- The opposition must be filed in writing.
- The opposition must be filed in one of the official languages.
- The patent should be clearly identifiable.
- A statement should be filed as to the extent to which the patent is opposed.
- There should be a statement of grounds.
- An indication of facts, evidence and arguments should be given.
- If the opponent is not established in an EPC state, a professional representative must be appointed.
- The name, address and nationality of the opponent must be given.
- The patent number, title and proprietor's name must be given.
- The name and address of the representative must be given.
- All documents should be typed/printed with a 2.5 cm left-hand margin.

Exclusion from file inspection in opposition proceedings

Normally, all documents filed during the opposition procedure are public. However, documents can be excluded from file inspection at the request of a party. Some documents are excluded by the EPO *ex officio* (e.g. medical certificates).

Accelerated processing of oppositions

In cases where an infringement action in respect of a European patent is pending before a national court 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 national court or competent authority of a contracting state that infringement actions are pending.

Communication under Rule 79 EPC

The proprietor must be given the chance to comment on an opposition. An opponent must be informed about any other opponents, where applicable.

A reply from the proprietor is not mandatory. The proprietor can choose whether or not to defend the patent.

Request to extend time limits

An extension of a time limit will only be granted in exceptional cases. Such extensions are restricted and allowable only for serious reasons (i.e. illness, change of representative, experiments). Non-substantiated requests or requests filed after expiry of the time limit concerned will be rejected immediately.

Oral proceedings in opposition

Oral proceedings in opposition take place either at the instance of the EPO or at the request of any party to the proceedings. They are public.

Since a decision of the EPO may only be based on arguments, grounds or evidence on which the parties have had an opportunity to present their comments, oral proceedings have to take place

before a decision can be taken if the parties likely to be adversely affected by that decision have requested such proceedings.

With the summons to attend oral proceedings, the opposition division sets a final date under Rule 116 EPC for making submissions or filing amendments (usually two months before the date of oral proceedings). The time limit under Rule 116(1) EPC is not extendable. New facts and evidence presented after the final date under Rule 116 EPC do not have to be considered.

Any summoned party may request postponement of oral proceedings by submitting a well-reasoned request.

In reply to the summons to attend oral proceedings the parties may file a variety of submissions, e.g.:

- substantive replies in view of the preliminary opinion
- new evidence/documents
- auxiliary requests (proprietor)
- requests for interpretation
- requests for postponement of oral proceedings
- statements of non-attendance or withdrawal of request for oral proceedings
- contact details for videoconference
- requests for hearing a witness

The EPO is obliged to forward submissions of a party to all other parties in the proceedings. The submissions are forwarded by registered mail. Submissions filed two weeks or less before the oral proceedings are to be forwarded to the other parties additionally via email to ensure that all parties are informed in time about each other's submissions.

Pending opposition proceedings

Opposition proceedings start on the date of filing of the first notice of opposition and are closed when a decision has been pronounced at oral proceedings or, in written proceedings, when the decision has been handed over to the EPO's internal postal service.

Revocation upon request

The proprietor can file a request for their patent to be revoked at any time during pending opposition proceedings. This request does not have to be reasoned and is not subject to a fee. If no opposition proceedings are pending, the proprietor can only request revocation according to Art. 105a EPC, which is subject to the payment of a fee.

Revocation may be requested because the proprietor has lost interest in the patent for economic reasons (the patent is no longer meaningful or does not bring any benefits) or they may have signed a contract with the opponent to sell their patent or their company.

Withdrawal of opposition

A request for withdrawal of an opposition can be filed at any stage of the proceedings. The request must be clear, unambiguous and unconditional. The opponent will no longer be a party to the proceedings. The statement is binding and irrevocable unless retracted on the same day.

Legal references:

Art. 52-57, 83, 99, 100, 101, 105a, 105b, 113, 116, 123 EPC

Rule 2, 70, 76, 77, 79, 84, 144 EPC

GL D-X, GL E-VIII, 1.6, XI

OJ EPO 4/2008, 221-222, 1994, 482 (T.789/89), 1997, 363 (T.798/93)

5. Opposition fees

The amount of the opposition fee is specified in the Rules relating to Fees under the EPC. The fee must be paid before expiry of the time limit for opposition.

An opposition filed jointly by two or more persons is admissible on payment of only one opposition fee.

If the opposition fee or a sufficient part thereof has not been paid within the opposition period, the opposition is deemed not to have been filed.

However, if the opposition fee has been paid within the opposition period apart from a small amount (e.g. deducted as bank charges), the formalities officer examines whether the amount lacking can be overlooked where this is justified. If the formalities officer concludes that the amount lacking can be overlooked, the opposition fee is deemed to have been paid and there is no deficiency.

Apart from opposition fees, each party to the proceedings must bear the costs it has incurred. However, the opposition division may, for reasons of equity, order a different apportionment of such costs, which may have been incurred during the taking of evidence, in oral proceedings or under other circumstances. Reasons of equity will require an opposition division to decide on issuing an order to apportion costs when the costs arise in whole or in part as a result of the conduct of one party which is not in keeping with the care required to ensure proper protection of the rights involved, in other words when the costs are culpably incurred as a result of irresponsible or even malicious actions.

Legal references:

Art. 99, 104 EPC

Rule 88 EPC

Art. 2 Rules relating to Fees

GL D-III, 2, IX

OJ EPO 2002, 347 (G.3/99)

6. Outcome of the opposition procedure

The opposition division will analyse the grounds and evidence brought forward by the opponent(s) and the patent proprietor's counterarguments in accordance with the criteria laid down in Art. 100 EPC.

After all parties have had sufficient opportunity to present their arguments, the opposition division will decide on the fate of the patent.

The European patent can be:

- maintained (opposition(s) rejected)
- maintained in amended form
- revoked

There are three types of decision following substantive examination by the opposition division:

1. revocation of patent: Art. 101(2) EPC or Art. 101(3)(b) EPC
→ European patent is revoked with retroactive effect
2. interlocutory decision: Art. 101(3) EPC
→ European patent is maintained in amended form
3. rejection of opposition: Art. 101(2) EPC
→ European patent is maintained unamended

The outcome of the opposition procedure before the EPO has effect for all national patents based on the European patent in the EPC contracting states.

Decisions may only be based on grounds or evidence on which the parties concerned have had the opportunity to comment. They must be signed by all members of the opposition division (including the legal member, if appointed).

Decisions are taken by the opposition division jointly in a majority vote (in the event of parity of votes, the vote of the chairperson is decisive). They cannot be cancelled or declared invalid but are open to appeal for a party adversely affected. If the appeal is deemed to be filed and admissible, the previous decision is suspended until the final decision of the board of appeal.

An EPO decision is binding.

Opposition proceedings are closed once a decision concerning the fate of the patent becomes final.

Opposition proceedings may result in the following decisions concerning the fate of a patent:

- revocation of the patent for substantive reasons
- revocation of the patent at the proprietor's request
- revocation of the patent under Rule 82(2) and (3) EPC
- rejection of opposition for substantive reasons
- rejection of the only opposition as deemed not to have been filed
- rejection of the only opposition as inadmissible
- discontinuation after withdrawal of the only opponent
- maintenance of the patent in amended form
- discontinuation after lapse of all national patents

A decision becomes final when it is announced during oral proceedings or handed over to the internal EPO mail service (in written proceedings).

Substantive observations of the parties or third parties will no longer be taken into account from the date opposition proceedings are closed.

Even when opposition proceedings are closed, the procedure is not terminated as some formalities are still required.

Revocation of the patent and rejection of the opposition terminate the opposition procedure. Revocation of the patent leads to the patent being deemed as having never existed *ex tunc*.

Rejection of the opposition leads to maintenance of the non-amended patent.

The interlocutory decision to maintain the patent in amended form only terminates the substantive examination phase but does not terminate the opposition procedure.

Before the final decision can be dispatched, the proprietor has to complete several formalities (file a translation of claims, pay fees, file clean copies of application documents with handwritten amendments).

A well-functioning opposition procedure increases trust in the legal certainty of European patents. Proprietors are able to obtain justified protection for the invention, and opponents are able to get an unjustified scope of protection changed.

Oppositions can give direct feedback on the quality of the work done in the previous stages of proceedings, as well as provide more information that was not available to the EPO at the time of grant.

Legal references:

Art. 99, 100, 101, 106, 113 EPC

Rule 81 EPC

GL D-II, 6, V, VIII, 1.1, 1.2, 1.3

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