



EPO OPPOSITIONS:
TOP TIPS FOR SUCCESS

POTTERCLARKSON.COM



EPO OPPOSITIONS: TOP TIPS FOR SUCCESS

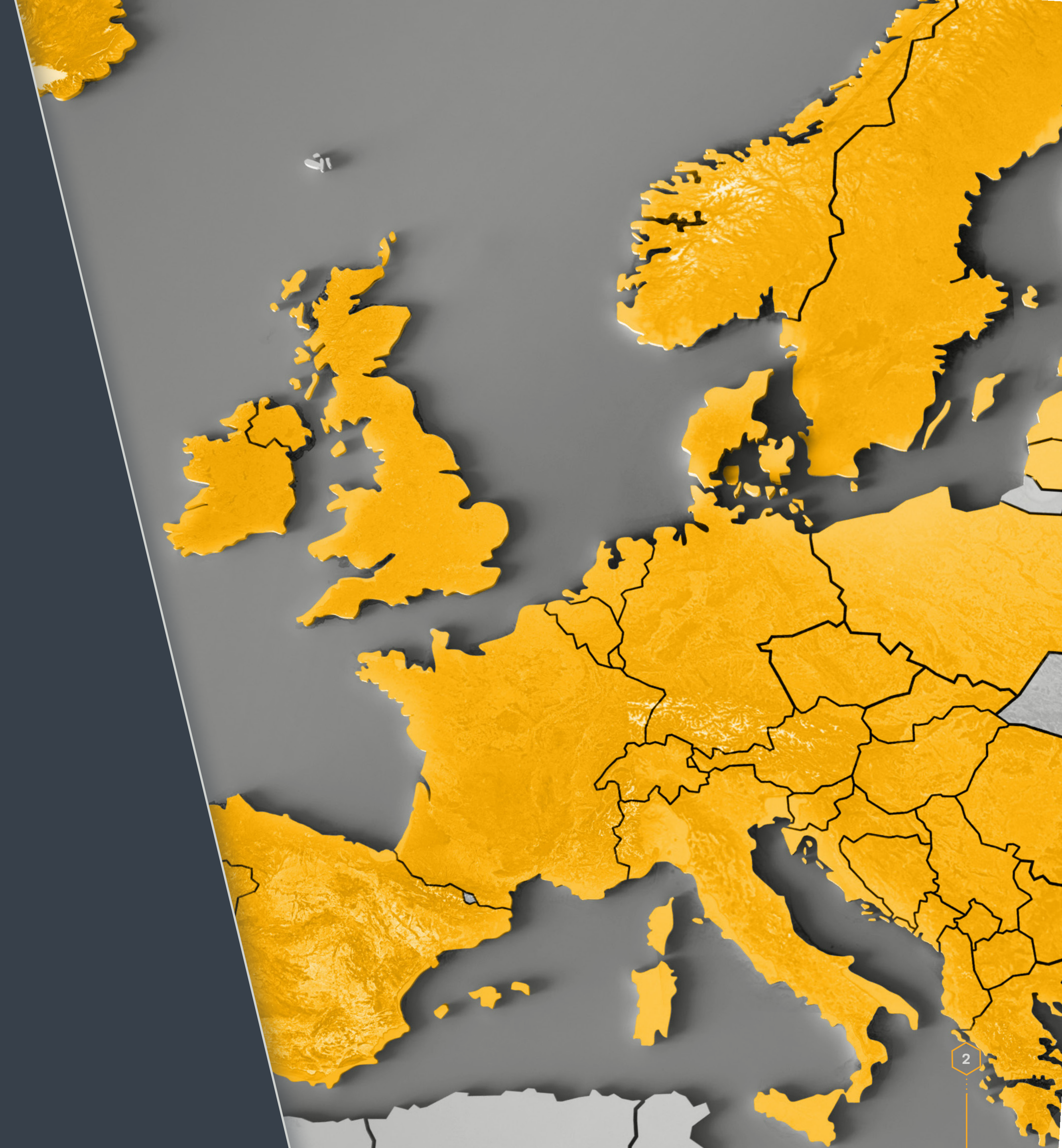
European Patent Office (EPO) Patent opposition is the legal process that allows anyone to raise their objections to the grant of a patent by the EPO.

Within Europe, one can challenge the validity of a EPO patent in all the territories where it is in force in a single action by filing an opposition against its grant on the basis of novelty, inventive step, industrial applicability, insufficiency and/or added matter. If you want to file an EPO opposition, you must initiate proceedings within nine months of the date of grant of a European patent.

The benefit of a successful opposition is simple. It could result in the complete revocation (cancellation) of a competitor patent in every state or territory covered by the patent, protecting your freedom to operate. It is therefore a cost-effective way to address infringement risk simultaneously in several markets.

These benefits need to be balanced against the disadvantages of choosing to file an EPO opposition over national litigation and/or a UPC revocation action.

The potential timeframe is an important consideration. First, there is a limited window during which to file an opposition. If this is missed, so is the opportunity to oppose. It can also take a notoriously long time to reach final decision, particularly if the first instance decision leads to an appeal by one or more parties.





As the EPO favours documentary evidence over expert testimony and witness statements, gathering of the required evidence can prove an involved and expensive process as it will need to support every fact alleged in the opposition. For example, showing there is existing prejudice against the specific technique/s involved is, by definition, subjective.

There is also the question of successfully navigating the EPO's 'problem and solution' approach for assessing inventive step. Often at least in part because the patentee will have the strongest understanding of their invention, there has long been an argument that the 'problem and solution' approach tends to favour the patentee.

Furthermore, once the opposition is lodged, the patentee typically will be given significant flexibility to amend their patent during the opposition process by filing different versions of the claimed subject matter ('claim requests') to address the various objections.

Another issue to navigate is the advent of the Unified Patent Court (UPC). Alongside the now operational UPC, it will still be possible to file an EPO opposition if desired as long as your opposition is filed within 9 months of the date of grant of the patent you wish to oppose.

However, the UPC provides an alternative revocation route for any European patents that have not been opted out. This could be an attractive option, for example if the 9-month window permitting an EPO opposition has closed. Depending on the facts of the case, a UPC revocation action might dovetail with, and/or be a good alternative to, an EPO opposition.

Revocation actions under the UPC have a much quicker procedure than EPO oppositions, but are likely to be significantly more expensive. We are already handling UPC revocations actions, and soon we will be providing updates and guidance on this, including interplay with EPO oppositions.

It is important to remember, however, that if you were to pursue revocation through the UPC, it would not affect the patent's coverage in any country not included within the UPC. This would include the UK and Spain, for example.

What is certain is that EPO oppositions remain a highly effective weapon with which to knock out any patent that could impact your business.

With so much to take into consideration, it is essential you make the right decision as to how best to use EPO patent oppositions. The critical nature of these decisions is brought into even sharper focus given the enormous commercial impact the patent you attack or defend may have on your business.

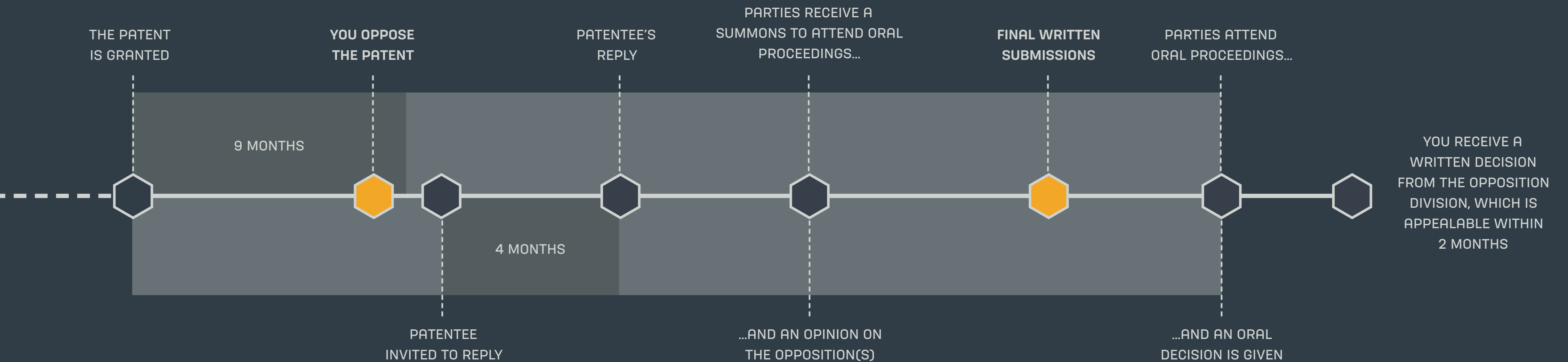
In this paper we will share some of the experience and expertise the EPO oppositions and appeals specialists in our patent team have amassed. It is experience and expertise you can use to maximise the commercial and strategic value of your patent portfolio, whether you need to oppose a competitor's patent or make sure your defence against a potential opposition is as robust as possible.

01

ATTACKING COMPETITIVE PATENTS

WHAT IS THE PROCESS WHEN YOU ARE ATTACKING A PATENT?

HOW DOES THE **PATENT OPPOSITIONS PROCESS** WORK IF **YOU ARE OPPOSING A PATENT**?



ATTACKING A PATENT. WHY, WHAT, & WHEN.

WHY SHOULD YOU ATTACK A PATENT?

A European patent is a powerful commercial weapon that can be used to prevent you maximising the commercial value of your ideas, products, and processes in up to 44 territories.

This means your competitors' patents could very well pose a significant risk to your commercial plans, either now or in the future.

However, the risks posed by a competitor's European patents can be removed or mitigated in all 44 territories in a single invalidity procedure by taking advantage of the EPO opposition system.

There are other commercial and strategic reasons for opposing a patent. These include:

- » Gaining greater clarity as to the scope of the existing patent and/or forcing your competitor to be more explicit concerning the exact scope of their patent/s.
- » Providing you with a basis to delay possible patent infringement proceedings.
- » Forcing a competitor to begin to negotiate a mutually beneficial way forward, for example by offering you the option of obtaining a licence under the patent.

WHAT DO YOU ATTACK WHEN YOU OPPOSE A PATENT?

By searching and monitoring the status of third-party European patent filings, you can identify potential issues at an early stage and formulate a strategy to mitigate risks and capitalise on the most likely commercial opportunities.

A typical action in relation to pending applications might involve:

- » Taking steps to prevent grant of a patent with relevant claims.
- » Acquiring the patent rights.
- » Negotiating a licence under favourable terms.
- » Preparing to file an opposition after the patent is granted.

In some cases, it may be necessary to conduct experiments and obtain witness testimony and/or evidence of prior use to support the invalidity arguments you want to use in your opposition.

Therefore, it is essential to identify all the relevant European patent filings as early as possible. It will give you more time to gather evidence and prepare a successful opposition case.

WHEN CAN YOU ATTACK A PATENT?

There is a nine-month period within which an opposition can be filed after a European patent is granted.

When you file the opposition will depend on your commercial objectives and associated opposition strategy.

For example, even though it is usual to wait until close to the end of the nine-month opposition period, we have sometimes filed an opposition for our clients on the date of grant itself so we could use the pending opposition to halt the anticipated national infringement proceedings against it.

In other cases, where multiple oppositions were expected, we filed on the grant date to guarantee that we would be Opponent 1, the first opponent to present our case in the final oral proceedings.

HOW DO YOU ATTACK A PATENT?

NEVER LEAVE THE PATENTEE ANY ROOM FOR ESCAPE

You will need to attack every independent and dependent claim as comprehensively as possible. Also, try to anticipate new claims the patentee might file in response to your opposition based on the description and/or examples of the patent.

Carefully consider the EPO prosecution file for prior art cited in search and examination reports, and don't forget prior art mentioned in the patent itself. This will often reveal highly relevant documents.

Also, look at the prosecution history and any post-grant proceedings of equivalent patent filings in other jurisdictions, especially the United States. Often, this reveals possible lines of attack which can be used against the European patent.

CONDUCT APPROPRIATE SEARCHES TO GATHER AMMUNITION

Are the claims entitled to priority? If a patent claim is not entitled to priority, is there any relevant publication or prior use which becomes available to invalidate the patent?

When assessing priority entitlement, it is important to review not only the technical disclosure of the priority document(s) but also the formal aspects of the priority claim. For a priority claim to be valid, the applicant of the European application must either be the same as the applicant of the priority application or be a successor in title at the filing date. It is not possible to cure defects after the filing date.

A notable recent case where lack of entitlement to priority for formal reasons led to invalidity due to lack of novelty is Broad Institute's European patent No. 2 771 468 covering CRISPR 'gene editing' technology.

FORMAL ATTACKS CAN BE LETHAL

Make sure you don't overlook formal grounds of opposition, especially unallowable amendment ('added matter') during the progress of the application towards the grant of the patent. This is an all too common ground of invalidity of European patents.

TIME TO EXPERIMENT?

Opposition Divisions look for a 'technical effect' when deciding inventive step. If you can show that the invention achieves little more than providing another way to solve the same problem as the prior art it can be easier to show that it would have been obvious. This is especially true in the chemical and biological arts.

Performing experiments to test the effect of the invention against the prior art and filing helpful results can shift the terms of debate about an invention in your favour. File with your opposition to avoid arguments over admissibility.

OPPOSITION IS VERY, VERY PUBLIC

All opposition proceedings are public. This means anyone can see who has opposed the patent.

If you do not wish your opposition to be identifiable as yours, it is possible to conceal the identity of the true opponent by filing an opposition in the name of a so-called 'strawman'. For example, it could be filed under our firm's name or, if we are too easily identifiable as your representatives, we could prepare the opposition but ask another firm to file it.



WHEN YOU ARE ATTACKING A PATENT, WHAT IS THE BEST STRATEGY?

We'd suggest you start with the end in mind. Be completely clear about your commercial objectives and continue to re-evaluate them throughout the opposition procedure.

Whilst it is important to focus on your commercial objectives, you can't afford to overlook those of the patentee.

For example, if you know that the patentee's commercial interests lie in an area that is different from your own, there may be a possible win-win settlement opportunity. You could, for example, obtain a licence giving you freedom to pursue your commercial interests in return for withdrawing your opposition or not opposing the patent in the first place. Alternatively, you might simply agree not to continue to oppose a patent if the claims are limited in a way that would no longer pose a risk to your commercial plans.

However, if there is no opportunity to reach an agreement with the patentee, you need to work closely with a European Patent Attorney firm that specialises in EPO oppositions and appeals to devise the optimal strategy and safely negotiate the procedure.

EPO opposition and appeal proceedings have a unique set of rules and procedures and associated case law and practice. The latest Rules of Procedure of the Boards of Appeal of the EPO, which came into force in 2020, introduce significant changes in the rules concerning what arguments and evidence are admissible at various phases in opposition and appeal proceedings.

Get any of this wrong and you risk losing a winnable case. This is another reason to enlist the help of attorneys with a long and successful track record in EPO oppositions and appeals.

OUR TOP TIPS FOR ATTACKING A PATENT:



ACTIVELY MONITOR PENDING CASES, IT'LL SUPPORT EARLY PREPARATION.



MAKE THE BEST USE OF THE OPPOSITION PERIOD.



ENSURE YOUR ARGUMENTS ARE FULLY EVIDENCED AND DEVELOPED AGAINST ALL CLAIMS.



TIMING IS EVERYTHING, OFTEN—BUT NOT ALWAYS—THIS MEANS THE EARLIER, THE BETTER.



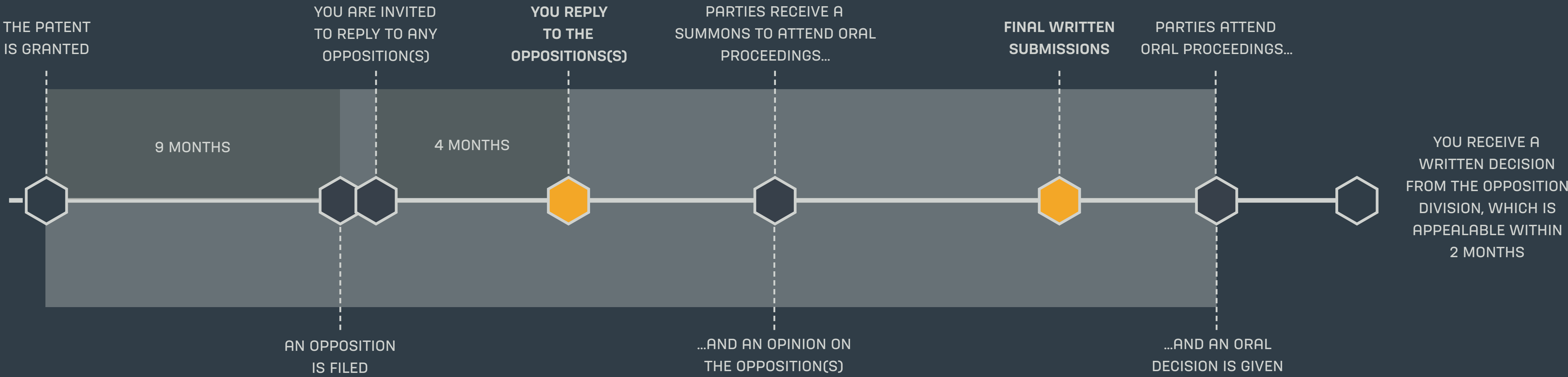
ALWAYS CONSIDER THE FULL EXTENT OF ISSUES IN THE DECISION OF OPPOSITION DIVISION WHEN CONSIDERING AN APPEAL.

02

DEFENDING YOUR PATENTS

WHAT IS THE PROCESS WHEN YOU ARE DEFENDING A PATENT?

HOW DOES THE **PATENT OPPOSITIONS PROCESS** WORK IF YOU ARE THE PATENTEE?



HOW SHOULD YOU **DEFEND** YOUR EUROPEAN PATENT **AGAINST EPO OPPOSITIONS**?

Given the commercial stakes involved in an EPO patent opposition, it is vital that you have the right opposition strategy in place from day one.

PREPARE YOUR PATENT FOR A FIGHT FROM DAY ONE

Having support from patent attorneys with extensive experience of winning oppositions will make sure your patent is a product of the best possible drafting practices.

On day one you should start from the perspective that your patent is likely to be opposed by someone in some way. This means investing in high quality patent drafting built on a patent specification that includes clear basis for numerous fall-back positions which have commercial value.

All too often, we see opposition cases where there is no basis to amend to intermediate fall-back positions. This leads to an 'all or nothing' scenario where either the broad main claim survives, or it falls and there is only basis for a claim that is too limited to be of any value to your bid to defend your position against your competitors.

AVOID THE PITFALLS OF CARELESS PROSECUTION

Experience of oppositions will also lead to more careful prosecution. This is crucial because unless the prosecution of your European patent has been handled with the utmost care, it will be vulnerable to opposition.

EPO law and practice regarding basis for amendments is very strict. Unallowable amendment is a very common ground of invalidity of a European patent and any amendments made during the pre-grant examination of European applications will come under intense scrutiny during an opposition.

We have seen many opposition cases where an amendment has been made which is allowable because the claimed subject matter has clear basis in the application as filed. But this could well lead to a loss of priority inadvertently as the same subject matter is not disclosed in the priority document.

A loss of priority can lead to invalidity based on publications or disclosures that would not otherwise be available as prior art. Consequently, the possible impact of any amendment needs to be considered carefully during the prosecution phase.

DIVIDE AND CONQUER

With the most important and valuable cases, it is always wise to consider making a divisional filing before grant. It will provide a backup in case the parent patent does not survive an opposition.

Claims of different category and scope can be pursued during such divisionals. This may provide an alternative basis for arguments in favour of patentability, whilst still affording a commercially acceptable scope of protection.

If third party observations have been filed during the examination procedure, it is an indication that the pending claims are of potential relevance to a third party. This could indicate that an opposition will be filed after the application is granted. In any event, keep your defence options open by filing one or more divisional applications before the grant of your European patent.

ACT IMMEDIATELY

If an opposition to your patent is filed, take immediate action. Appoint an EPO opposition specialist with a proven track-record to help you devise and implement your defence strategy.

WHEN YOU ARE DEFENDING A PATENT, HOW DO YOU **CREATE A WINNING STRATEGY?**

KNOW YOUR ENEMY

Firstly, you need to recognise why your competitor is attacking your patent. Consider the relevance of any existing and future products and processes and any relevant or ongoing legal and commercial disputes.

Are your opponent's commercial interests the same as yours? If not, could there be an opportunity to reach a mutually favourable commercial settlement?

For example, you might be able to grant a license that allows your opponent to operate in their particular market/s in return for the withdrawal of its opposition. Or is there a separate dispute in which the opposed patent could be a lever to finding a settlement?

Investigate the opponent's activities. Is there any evidence of infringement under the opposed patent?

KNOW WHAT SUCCESS LOOKS LIKE

Is it essential to maintain the claims as granted, or are there narrower claims that would provide you with a satisfactory scope of protection?

If there are, perhaps you could consider filing narrower sets of auxiliary claim requests as fallback positions, all ranked by commercial importance.

KNOW WHAT YOU NEED TO WIN

It is vital that you invest enough time and resources at the outset, so you understand the strength of the opposition case against the patent and what you will need to defend it successfully.

These factors include:

» **COMMERCIAL INPUT**

Commercial priorities should be identified at the outset and reviewed at regular intervals during the opposition procedure.

» **TECHNICAL INPUT**

Identify experts who might be needed to support your attorney.

» **EVIDENCE**

Do you need any experimental data, expert declaration(s), witnesses and/or documentary evidence to support your case?

» **LITIGATION**

Are there any related patent disputes? Such disputes could include oppositions and appeals at the EPO or litigation under the opposed or related patents.

If there are equivalent patents in dispute in several jurisdictions, it is important that your EPO opposition strategy is consistent with and complementary to the strategy that is being implemented elsewhere.

You could also consider whether any of your opponent's activities could constitute an infringement of the patent being opposed. If there is potential, you should consider adding any action that would enforce your patent to your overall defence strategy.

» **LEGAL PRECEDENT**

Does the established EPO Board of Appeal case law support your arguments, or will you need to make new law? Are there any relevant decisions pending referrals to the Enlarged Board of Appeal that might affect the outcome and/or duration of your case?

EPO opposition and appeal proceedings have a unique set of rules and procedures and associated case law and practice. As we have already mentioned, the latest Rules of Procedure of the Boards of Appeal of the EPO, which came into force in 2020, introduce significant changes in the rules concerning what arguments and evidence are admissible at various phases in opposition and appeal proceedings.

Again, if you get this wrong, you can lose what would otherwise have been a winnable case.

OUR TOP TIPS FOR DEFENDING YOUR PATENTS:



ASSESS THE INVALIDITY CASE THOROUGHLY AND AS EARLY AS POSSIBLE TO WORK OUT HOW BEST TO RESPOND.



FILE YOUR REQUESTS AS EARLY AS POSSIBLE, ESPECIALLY THOSE NOT HAVING BASIS IN THE SUB-CLAIMS.



OBTAIN ALL SUPPORTING EVIDENCE AS EARLY AS POSSIBLE, ESPECIALLY WHEN EXPERIMENTAL DATA IS INVOLVED.



CONSIDER DIVISIONAL FILING BEFORE THE GRANT OF IMPORTANT CASES, ESPECIALLY WHEN THIRD PARTY OBSERVATIONS HAVE BEEN FILED.

WHY SHOULD YOU CHOOSE POTTER CLARKSON?

It's simple. We know how to run and win opposition cases.

Potter Clarkson's specialist oppositions team is made up of patent attorneys with a long and exceptional record of attacking and defending patents, and handling the resulting appeals, at the EPO. We are internationally renowned for handling difficult and complex opposition cases, especially when it comes to defending key patent rights against multiple opponents.

! Our overall success rate of about 72% is outstanding, especially given the average
: —according to the EPO's statistics—is around 50%.

These statistics show why Potter Clarkson is consistently chosen ahead of other European firms to handle the most commercially important, and technically complex, EPO patent opposition and appeal cases for some of the world's largest and best-known companies. We have also helped smaller companies defeat much larger and better resourced competitors in situations where the viability of the entire business was at stake.

! We are currently handling around 400 opposition cases and over the last ten years
: we have handled about 800 oppositions and about 400 appeals.

These cases have involved us attacking or defending some of the most valuable European patents across a wide range of technological areas and industry sectors by drawing upon our attorneys ability to devise a variety of innovative approaches to optimise our clients' prospects of success in an opposition.

Creativity is often the crucial success factor in the most difficult cases. Our attorneys have repeatedly shown their desire to shape, rather than follow, existing case law. This is proven by the fact that 17% of the appeal cases that we have handled are recognised as cases that established some notable legal principle in the Case Law of the Boards of Appeal of the EPO.

However, in every case our focus is to maximise the commercial value our clients enjoy as a result of our involvement. Sometimes this involves working with our litigators to devise a wider enforcement/defence strategy, which may involve parallel litigation in multiple jurisdictions.

! Our ability to offer a fully integrated, multidisciplinary team made up of hugely
: experienced patent attorneys and IP solicitors adds an extra dimension to the
: way we can defend and enforce your patent rights in Europe and beyond.

Being able to unify your litigation and opposition strategies ensures you always have the full set of tools at your disposal, maximising your prospects of achieving the outcome you want.

Better still, as colleagues rather than having to work with external lawyers, we can start working together immediately and in a more efficient and cost-effective way.



YOUR CORE TEAM



SIMON CURTIS
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT SIMON](#)



MARK DIDMON
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT MARK](#)



PETER FINNIE
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT PETER](#)



BENJAMIN HOFFMANN
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT BENJAMIN](#)



CAROLINE MARSHALL
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT CAROLINE](#)



ROB PUGH
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT ROB](#)



TONY PROCTOR
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT TONY](#)



PHILIP THOMAS
PARTNER
PATENT ATTORNEY

[LEARN MORE ABOUT PHILIP](#)



CREATING VALUE FROM INNOVATION

PATENTS

TRADE MARKS

DESIGNS

LITIGATION & LICENSING

CONSULTANCY

POTTERCLARKSON.COM
