

PART D

GUIDELINES FOR OPPOSITION PROCEDURE

PART D

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CHAPTER I**GENERAL REMARKS**

(A notice on the opposition procedure before the EPO was published in OJ 3/2001, 148.)

1. The meaning of opposition

The public may oppose a granted European patent on the basis of one or more of the grounds mentioned in Art. 100. The grounds on which the opposition is based may arise for example from circumstances of which the EPO was not aware when the patent was granted (e.g. prior use or a publication which was not contained or not found among the material available to the EPO). Opposition is therefore a means by which any person may obtain the limitation or revocation of a wrongly granted patent.

2. Opposition after surrender or lapse

An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States. This is relevant in that in such cases the rights acquired with the patent remain in existence during the period up to surrender or lapse and claims arising from such rights may subsist after that date.

Art. 99(3)

3. Territorial effect of the opposition

The opposition applies to the European patent in all the Contracting States in which that patent has effect. Thus the opposition should formally be in respect of all the designated States. If an opposition is filed in respect of only some of the designated States it will be treated as if it were in respect of all the designated States.

Art. 99(2)

Nevertheless, the effect of an opposition may differ as between Contracting States. This may arise where the patent contains different claims for different Contracting States in accordance with Rule 16(2) or Rule 87, or where the claims must take account of different art under the provisions of Art. 54(3). Thus the patent may be differently amended in respect of different Contracting States and may be revoked in respect of one or more Contracting States and not in respect of others.

4. Entitlement to oppose

"Any person" may give notice of opposition without specifying any particular interest. "Any person" is to be construed in line with Art. 58 as meaning any natural person (private individual, self-employed persons, etc.), any legal person or any body assimilated to a legal person under the law governing it. "Any person" does not include the proprietor of the patent (as was decided in G 9/93 (OJ 12/1994, 891), reversing G 1/84 (OJ 10/1985, 299)).

Art. 99(1)

Notice of opposition may also be filed jointly by more than one of the persons mentioned above. In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it has to be clear throughout the procedure who belongs to the group of common opponents. If a common opponent (including the common representative) intends to withdraw from the proceedings, the EPO must be notified accordingly by the common representative or by a new common

representative determined under Rule 100(1) in order for the withdrawal to take effect (see also G 3/99, OJ 7/2002, 347).

Oppositions are not assignable but may be inherited or succeeded to as part of an overall succession in law, e.g. in the event of the merger of legal persons. Acquiring companies may also take over oppositions filed by acquired companies.

5. Intervention of the assumed infringer

Art. 105(1)
Art. 105(2)

Under certain conditions (see VII, 7) 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. Once the notice of intervention has been filed in good time and in due form, the intervention is to be treated as an opposition (see IV, 5.6). For accelerated processing of oppositions on request, see E-VIII, 4.

6. Parties to opposition proceedings

Art. 99(4)
Art. 105(2)
Art. 115(1)

The proprietor of the patent, the opponent and, where applicable, the intervener will be parties to the opposition proceedings. However, an opponent who has withdrawn notice of opposition or whose opposition has been rejected as inadmissible will remain a party to the proceedings only until the date of such withdrawal or the date on which the decision on rejection has become final. The same will apply in the case of interveners. Third parties who have presented observations concerning the patentability of the invention in respect of which an application has been filed are not parties to opposition proceedings (see E-VI, 3).

Art. 118

Where the proprietors of a European patent are not the same in respect of different designated Contracting States, they are to be regarded as joint proprietors for the purposes of opposition proceedings (see VII, 3.1, concerning the unity of the European patent).

Art. 99(5)
Art. 61(1)(a)

Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of that State instead of the previous proprietor, he is entitled on request to replace the previous proprietor in respect of that State. In this event, by derogation from Art. 118, the previous proprietor and the person making the request are not deemed to be joint proprietors unless both so request. The aim of this provision is to afford the new proprietor the opportunity of defending himself against the opposition as he sees fit (see VII, 3.2, as regards the conduct of the opposition proceedings in such cases).

Art. 20(1)

The Legal Division is responsible for decisions in respect of entries in the Register of European Patents (see Information from the EPO, OJ 9/1990, 404).

7. Representation

As regards the requirements relating to representation of opponents and patent proprietors, reference is made to A-IX, 1. Deficiencies in the representation of an opponent when filing the opposition and their remedy are treated in IV, 1.2.1(ii) and 1.2.2.2(iv).

8. Information to the public

As soon as an opposition has been received, the date of filing of the opposition is entered in the Register of European Patents and published in the European Patent Bulletin. The same applies to the date on which opposition proceedings are concluded and to the outcome of the proceedings.

CHAPTER II**THE OPPOSITION DIVISION****1. Administrative structure**

Each Opposition Division is part of an EPO directorate comprising several Examining and Opposition Divisions. Rule 12(1)

2. Composition**2.1 Technically qualified examiners**

An Opposition Division consists of three technical examiners, at least two of whom must have taken no part in the proceedings for grant of the patent to which the opposition relates. Art. 19(2)

2.2 Legally qualified examiners

If the Opposition Division considers that the nature of the decision so requires, it is enlarged by the addition of a legally qualified examiner who has taken no part in the proceedings for grant. Art. 19(2)

The principles established for inclusion of a legally qualified member and for consultation of the Directorate Patent Law, the department responsible for providing legally qualified members for Examining and Opposition Divisions, by the Examining Division apply mutatis mutandis to the Opposition Division (see C-VI, 7.8). In addition to this, difficult legal questions may arise during the examination as to whether an opposition is to be rejected as inadmissible. Consultation of a legally qualified member should also be envisaged in cases where it is questionable whether or not a disclosure by means other than a document was made available to the public.

2.3 Chairman

The Chairman must be a technically qualified examiner who has taken no part in the grant proceedings.

3. Allocation of duties and appointment of members of the Opposition Division

C-VI, 1.2 applies mutatis mutandis. Rule 9(1)

4. Tasks of the Opposition Divisions**4.1 Examination of oppositions**

The Opposition Divisions are responsible for the examination of oppositions against European patents. Art. 19(1)

The examination of newly submitted documents for compliance with physical requirements will essentially be the task of the competent formalities officers (see II, 7, A-I, 2, A-III, 3.2, and C-VI, 2.1).

4.2 Decision concerning the awarding of costs by the registry (i.e the formalities officer)

The Opposition Division will decide on requests to have the costs fixed by the registry reviewed (see IX, 2.1). Art. 104(2)
Rule 63(3), (4)

4.3 Ancillary proceedings

Art. 122(4)
Rule 69(2)

It will be incumbent upon the Opposition Division to conduct ancillary proceedings arising in the course of opposition proceedings, such as the processing of applications for restitutio in integrum in respect of a time limit which was not observed vis-à-vis the EPO during the opposition proceedings or of requests for a decision concerning a finding arrived at by the formalities officer that a right has been lost. Additional tasks may be entrusted to the Opposition Divisions by the President of the EPO in accordance with Rule 9(2).

5. Allocation of tasks to members

Art. 19(2)
Art. 117(2)

An Opposition Division will normally entrust one of its members with the examination of the opposition, but not with the conduct of oral proceedings, up to the time of the final decision on the opposition (see also IV, 2). If need be, he may also be entrusted with the examination of the evidence adduced (see E-IV, 1.3). He will be referred to as the primary examiner.

6. Duties and powers of members

The primary examiner will conduct the examination of the opposition. In this work he will issue communications to the parties without consulting the other members. However, if the primary examiner believes that the other members may have reservations concerning the procedure which he intends to follow, he must submit the communication to the Opposition Division before despatch. If he considers that the matter is ready for a decision or that oral proceedings should be arranged, possibly in conjunction with the taking of evidence (see E-III, 1 to 4, and E-IV, 1.6.1), he must submit an opinion in writing to the Opposition Division.

In the light of this opinion, the other members of the Opposition Division will give their own opinions in writing, which may simply be a short confirmation of agreement.

If there are differences of opinion, the Chairman must fix a date for a meeting at which the primary examiner will report on the matter. The Chairman will preside at the meeting and, following a discussion, will take a vote on the decision or the further course of the procedure.

Art. 19(2)

Voting will be on the basis of a simple majority. In the event of parity of votes, the vote of the Chairman of the Division is decisive.

Any further measures necessary will as a rule be entrusted to the primary examiner. If no further measures are necessary, the primary examiner will draft a decision on the opposition and will distribute the draft to the other members of the Opposition Division for examination and signature. If any changes are proposed by a member and there are differences of opinion on such changes, the Chairman must arrange a meeting.

Where reference is made hereinafter to the Opposition Division, this should be taken to mean the primary examiner where such a member has been appointed and insofar as he is entitled to act alone under the EPC.

7. Allocation of individual duties

Rule 9(3)

The President of the EPO may entrust to employees who are not technically or legally qualified examiners the execution of individual duties

falling to the Examining Divisions or to the Opposition Divisions and involving no technical or legal difficulties. Insofar as such duties affect the public, their allocation will be notified in the Official Journal of the EPO (see OJ 7/1999, 503).

The formalities officers entrusted with these duties make up the registry of the Opposition Divisions.

CHAPTER III**OPPOSITION****1. Time allowed for filing notice of opposition**

Within nine months from the publication of the mention of the grant of the European patent, notice of opposition has to be given to the EPO in Munich, The Hague or Berlin. Art. 99(1)

For expiry of the time limit see E-VIII, 1.4. Restitutio in integrum in respect of unobserved time limits for opposition is not possible in the case of an opponent (see, however, E-VIII, 2.2.2).

2. Opposition fee

The amount of the opposition fee specified in the Rules relating to Fees under the EPC must be paid before expiry of the time limit for opposition. Art. 99(1)

An opposition filed in common by two or more persons, which otherwise meets the requirements of Art. 99 and Rules 1 and 55, is admissible on payment of only one opposition fee (see G 3/99, OJ 7/2002, 347).

As regards the legal consequences and the procedure where the fee is not paid in good time, see IV, 1.2.1(i) and IV, 1.4.1.

For reduction of the opposition fee, see A-XI, 9.2.4.

3. Submission in writing**3.1 Form of the opposition**

The notice of opposition must be filed in writing and should be typewritten or printed, with a margin of about 2.5 cm on the left hand side of each page. It would be appropriate if the notice of opposition also satisfied the requirements laid down in Rule 35(4). Rule 61a
Rule 36(2)
Rule 35(4)

Such documents as must be communicated to other parties concerned must be filed in a sufficient number of copies. If the party concerned does not comply with this obligation in spite of a request to do so, the missing copies will be provided at the expense of the party concerned. Rule 36(4)

3.2 Notices of opposition filed by facsimile

Notice of opposition may also be filed by facsimile. At the invitation of the EPO, written confirmation reproducing the contents of the facsimile and complying with the requirements of the Implementing Regulations - in particular properly signed - must be supplied. If the opponent fails to comply with this invitation in due time, the facsimile is deemed not to have been received (see A-IX, 2.5). The opposition fee must in any case be paid within the opposition period. Rule 36(5)

3.3 Signature of the notice of opposition

The notice of opposition must be signed by the person responsible, i.e. by the opponent or, where appropriate, by his representative (see also IV, 1.2.1(ii), and A-IX, 1). Rule 36(3), (5)

Initials or other abbreviated forms will not be accepted as a signature.

Where the notice of opposition is filed by facsimile, the reproduction on the facsimile of the signature of the person filing the notice of opposition will be considered sufficient.

If the signature is omitted, the formalities officer must request the party, or where appropriate his representative, to affix his signature within a time limit to be laid down by the formalities officer. If signed in due time, the document retains its original date of receipt; otherwise it is deemed not to have been received (see IV, 1.2.1(ii) and 1.4.1).

4. Derogations from language requirements

Derogations from language requirements for written opposition proceedings are dealt with in A-VIII, 2, and for oral opposition proceedings in E-V.

5. Grounds for opposition

Art. 99(1) A written reasoned statement of the grounds for opposition must be filed within the opposition period.

Art. 100 Opposition may only be filed on the grounds that:

Art. 100(a) (i) the subject-matter of the European patent is not patentable within the terms of Art. 52 to 57, because it

- is not new (Art. 52(1), 54, 55),
- does not involve an inventive step (Art. 52(1), 56),
- is not susceptible of industrial application (Art. 52(1), 57),
- is not regarded as an invention under Art. 52(2) to (4), or
- is not patentable under Art. 53;

Art. 100(b) (ii) 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 (cf. Art. 83);

Art. 100(c) (iii) 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 in accordance with Art. 61 (new application in respect of the invention by the person adjudged in a final decision to be entitled to the grant of a European patent), beyond the content of the earlier application as filed (cf. Art. 123(2)).

(See also V, 3 to 5, and C-IV.)

Note that each single condition mentioned above forms an individual legal basis for objection to the maintenance of the patent. Consequently, each such condition is to be regarded as a separate ground of opposition (see G 1/95 and G 7/95, OJ 11/1996, 615 and 626).

The following allegations, for example, do not constitute grounds for opposition: that national rights of earlier date exist which put the patentability of the invention in question (see, however, IV, 5.3, and VII, 4.5), that the proprietor of the patent is not entitled to the European patent, that the subject-matter of the patent lacks unity, that the claims are not supported by the description (unless it is also argued that the claims are so broadly worded that the description in the specification does not sufficiently disclose the subject-matter within the meaning of Art. 100(b)), that the form and content of the description or drawings of the patent do not comply with the provisions as to formal requirements as set forth in Rules 27 and 32, or that the designation of the inventor is incorrect. Nor does the simple allegation that priority has been wrongly claimed constitute a ground for opposition. However, the matter of priority must be subjected to a substantial examination in the course of opposition proceedings if prior art is invoked in connection with a ground for opposition under Art. 100(a) in relation to which the priority date is of decisive importance (see C-IV, 5 and 6, and C-V, 2).

6. Content of the notice of opposition

The notice of opposition must contain:

- | | | |
|-------|---|------------|
| (i) | the name and address of the opponent and the State in which his residence or principal place of business is located. Names of natural persons must be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, must be indicated by their official designations. Addresses must be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They should in any case comprise all the relevant administrative units including the house number, if any. It is recommended that the telephone and facsimile number be indicated (see IV, 1.2.2.2(i), and IV, 1.4.2); | Rule 55(a) |
| (ii) | the number of the European patent against which opposition is filed, the name of the proprietor and the title of the invention (see IV, 1.2.2.2(ii), and IV, 1.4.2); | Rule 55(b) |
| (iii) | 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, evidence and arguments presented in support of these grounds (see IV, 1.2.2.1(iii), (iv), (v), and IV, 1.4.2). However, in order to streamline opposition procedure it is recommended that written evidence be submitted in two copies as soon as possible and ideally with the notice of opposition (see IV, 1.2.2.1(v), last two paragraphs); | Rule 55(c) |
| (iv) | if the opponent has appointed a representative, his name and the address of his place of business in accordance with the provisions of sub-paragraph (i) as set out above (see IV, 1.2.2.2(iii), and IV, 1.4.2). | Rule 55(d) |

IV, 1, sets out further details and explains how to deal with the opposition if one of these requirements is not fulfilled.

CHAPTER IV

PROCEDURE UP TO SUBSTANTIVE EXAMINATION

1. Examination for deficiencies in the notice of opposition and communications from the formalities officer arising from this examination**1.1 Forwarding of the notice of opposition to the formalities officer**

The notice of opposition must be forwarded directly to the formalities officer, who then places it in the files of the European patent concerned in accordance with the relevant administrative instructions and communicates it without delay to the proprietor for information. If a notice of opposition is received prior to the publication of the mention of the grant of the European patent, the formalities officer informs the opponent that for that reason his document cannot be treated as an opposition. This document becomes part of the files and, as such, is also available for inspection under Art. 128(4), and is brought to the attention of the applicant for or the proprietor of the patent as an observation by a third party in accordance with Art. 115 (for details, see E-VI, 3). If an opposition fee has been paid, it will in this case be refunded.

Examinations, observations, communications and, where appropriate, invitations to the parties will be the responsibility of the formalities officer who has been entrusted with this task of the Opposition Division (see II, 7).

1.2 Examination for deficiencies in the notice of opposition

After notice of opposition has been given, the formalities officer examines whether any deficiencies exist.

1.2.1 Deficiencies which, if not remedied, lead to the opposition being deemed not to have been filed

The following deficiencies fall into this category:

- (i) the opposition fee or a sufficient amount of the fee has not been paid in the course of the opposition period (Art. 99(1)). However, if the opposition fee, apart from a small amount (e.g. deducted as bank charges), has been paid within the opposition period, 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 in the present sense;
- (ii) the document giving notice of opposition is not signed and this is not rectified within the period set by the formalities officer, which is fixed at two months as a rule (see E-VIII, 1.2) (Rule 36(3)).

Art. 8 RFees
Art. 9(1) RFees

In the case of Art. 133(2) (see also 1.2.2.2(iv)), the above applies where a professional representative has been appointed within the prescribed time limit but the notice of opposition has not been signed by the representative and he has failed to remedy such deficiency either by signing it or by approving it in writing;

- ==== (iii) where a notice of opposition is filed by facsimile and written
==== confirmation reproducing the contents of the facsimile, if requested

by Formalities, is not supplied in due time (Rule 36(5) and Decision of the President of the EPO, OJ 1/2005, 41);

- (iv) where a notice of opposition is filed by the representative or employee of an opponent, and the authorisation, if any is required (see A-IX, 1.5, and the Decision of the President of the EPO in OJ 9/1991, 489), is not supplied in due time (Rule 101(1), (4)); and
- (v) the Opposition is submitted within the opposition period but not in an official language of the EPO, as specified in Rule 1(1), or if Art. 14(4) applies to the opponent, the translation of the elements referred to in Rule 55(c) is not submitted within the opposition period (see also A-VIII, 2, G 6/91, OJ 9/1992, 491, and T 193/87, OJ 4/1993, 207). This period is extended where the one-month period as required under Rule 6(2) expires later. This deficiency is present if the opposition is not filed in English, French or German or if, for example, an opponent from Belgium files his opposition in time in Dutch but fails to file the translation of the essential elements into English, French or German within the above-mentioned time limits.

For oppositions which, upon submission, are deemed not to have been filed because of deficiencies as described above, see the further procedure as described in IV, 1.3.1, 1.3.3 and 1.4.1.

1.2.2 Deficiencies which, if not remedied, lead to the opposition being rejected as inadmissible

Only such oppositions as are deemed to have been filed will be examined for deficiencies under Rule 56(1) and (2).

If the formalities officer is not sure whether the opposition in question contains a deficiency under Rule 55(c), he will submit the file to the Opposition Division for checking. He will do this in particular if the opposition alleges non-patentability under Art. 52, 54 and 56 and the relevant prior art has been made available to the public by means other than by written description, or if taking of evidence has been requested in accordance with Rule 72.

In this connection the Opposition Division will also examine the extent to which it is necessary for the formalities officer to request the opponent to submit evidence (see IV, 1.2.2.1(v)).

1.2.2.1 Deficiencies under Rule 56(1)

The following deficiencies fall into this category:

- (i) the notice of opposition is not filed in writing with the EPO in Munich or its branch at The Hague or its sub-office in Berlin within the nine-month opposition period, calculated from the date of publication of the mention of the grant of the European patent in the European Patent Bulletin (Art. 99(1));

Accordingly, the opposition is deficient if, for example, notice of opposition is submitted to the EPO belatedly, i.e. after expiry of the nine-month period, or where the opposition is notified within the opposition period but only verbally in a telephone call officially noted in the files. This category of deficiency also includes oppositions which, notwithstanding Art. 99(1), are filed with the central industrial property office of a Contracting State or an authority thereunder and not forwarded by these offices either at all or in time for them to be received by the EPO before the expiry of

the opposition period. There is no legal obligation upon these offices or authorities to forward oppositions to the EPO.

- (ii) the notice of opposition does not provide sufficient identification of the European patent against which opposition is filed;

Such a deficiency exists if the EPO is unable to identify the relevant patent on the basis of the particulars in the notice of opposition; for example, if only the proprietor of the contested patent and perhaps the title of the invention for which the patent was granted are mentioned in the notice of opposition. Such particulars alone are not an adequate description of the contested European patent, unless the proprietor of the patent who alone is named possesses only one patent or possesses several patents, the subject-matter of only one of which fits the title of the invention given in the notice of opposition, being clearly distinct from the subject-matter of the other patents which this proprietor holds. A mere indication of the number of the contested European patent in the notice of opposition constitutes sufficient identification of the patent concerned, provided that no conflicting information is given, e.g. an inconsistent name for the proprietor, and the conflict cannot be resolved from the information given.

- (iii) the notice of opposition contains no statement of the extent to which the European patent is opposed; Rule 55(c)

Such a deficiency is present if it is not clear from the requisite statement whether the opposition is directed against the entire subject-matter of the patent or only a part of it, i.e. whether it is directed against all the claims or only against one or a part of one claim, such as an alternative or embodiment;

- (iv) the notice of opposition contains no statement of the grounds on which the opposition is based; Rule 55(c)

A notice of opposition contains such a deficiency if it does not mention at least one of the grounds for opposition referred to in Art. 100 (see III, 5). If non-patentability is given as a ground for opposition, the statement of grounds must at least implicitly indicate which conditions for patentability (Art. 52 to 57) are considered not to have been fulfilled.

- (v) the notice of opposition does not indicate the facts, evidence and arguments presented in support of the opposition; Art. 99(1)
Rule 55(c)

An opposition is adequately substantiated only if in respect of at least one of his grounds for opposition the opponent adduces facts, evidence and arguments establishing a possible obstacle to patentability under the EPC. He must indicate the technical context and the conclusions he has drawn from it. The content of the statement of grounds must be such as to enable the patent proprietor and the Opposition Division to examine the alleged ground for revocation without recourse to independent enquiries. Unsubstantiated assertions do not meet this requirement. Nor as a rule is mere reference to patent documents enough; unless the document is very short the opponent must indicate on which parts his opposition is based. Where there are allegations that use or oral description are comprised in the state of the art, the Opposition Division must be supplied with an indication of the facts, evidence

and arguments necessary for determination of the matters set out under V, 3.1.2 and 3.2.3. See also in this respect T 328/87, OJ 12/1992, 701.

If, where there are multiple grounds for opposition, the facts, evidence and arguments for one ground are sufficiently indicated, the opposition is admissible, even if the facts, evidence and arguments in support of the other grounds for opposition are submitted belatedly. Such belated facts, evidence and arguments are in that event dealt with in accordance with E-VI, 2.

It is immaterial, as far as the question of admissibility of an opposition is concerned, whether and to what extent the facts, evidence and arguments submitted in due time actually warrant revocation of the contested European patent or its maintenance in amended form. On the one hand, an unconvincing ground of opposition may have been clearly presented and argued (making the opposition admissible), whereas conversely a deficient submission may have been rejected as inadmissible even though, if properly drafted, it could have succeeded (see also T 222/85, OJ 4/1988, 128).

Rule 55(c)
Rule 59

An indication of at least one ground of opposition and of the facts, evidence and arguments on which it is based fulfills the prerequisites for admissibility of the opposition in this respect. The evidence itself can also be produced after the expiry of the opposition period. Because of the long opposition period (9 months) it is however recommended, in order to expedite the opposition proceedings, that written evidence indicated in the notice of opposition be submitted in two copies as soon as possible and ideally with the notice of opposition.

Otherwise, if his opposition is admissible, the opponent will be invited to supply such evidence as soon as possible and as a rule within two months. If the documents thus requested are neither enclosed nor filed within the time limit set, the Opposition Division may decide not to take into account any arguments based on them. (As regards facts or evidence not submitted in due time and arguments presented at a late stage see E-VI, 2, and E-III, 8.6.)

Art. 99(1)
Rule 55(a)

- (vi) the opposition does not indicate beyond any doubt the identity of the person filing the opposition (Art. 99(1), Rule 55(a)).

1.2.2.2 Deficiencies under Rule 56(2)

The following deficiencies fall within this category:

Rule 55(a)

- (i) the notice of opposition does not state the name and address of the opponent and the State in which his residence or principal place of business is located in the prescribed manner (see III, 6(i));

Rule 55 (b)

- (ii) the number of the European patent against which the opposition is filed or the name of the proprietor of the patent or the title of the invention is not indicated;

Each of the particulars listed in (ii) above must be supplied within the time limit set by the formalities officer (see IV, 1.3.2), even if the contested European patent may be identified by means of one of these or other particulars within the opposition period (see IV,

1.2.2.1(ii)). If the name of the proprietor of the patent as indicated by the opponent is not the same as that recorded in the Register, the formalities officer will inform the opponent of the proprietor's correct name.

- (iii) where the opponent has appointed a representative, the name or the address of the place of business of such representative is not indicated in the notice of opposition in the prescribed manner (see III, 6(iv)); Rule 55(d)
- (iv) the opponent has neither his residence nor his principal place of business in one of the Contracting States (Art. 133(2)) and has not communicated the appointment of a professional representative (Art. 134). In the communication requesting him to remedy such deficiency the opponent must also be asked to arrange for the signature or approval of the notice of opposition by the representative to be appointed; and
- (v) the notice of opposition fails to satisfy further formal requirements other than those mentioned in Rule 56(1). For instance, it may fail to comply with the provisions of Rule 36(2) without due justification. Rule 61a

1.3 Issue of communications by the formalities officer as a result of examination for deficiencies

If, in the course of his examination as described in IV, 1.2, the formalities officer notes deficiencies which may still be remedied, and if there are no deficiencies which may no longer be remedied (in the case of deficiencies which may no longer be remedied see IV, 1.4), he will issue the communications described in IV, 1.3.1 and/or 1.3.2, to the opponent, if possible in a single communication. Art. 14(4), (5)
Rule 1(1)
Rule 6(2)
Rule 36(3), (5)
Rule 56(1), (2)
Rule 101(1)

1.3.1 Communication in the event of deficiencies as described in IV, 1.2.1, which, if not remedied, will lead to the opposition being deemed not to have been filed

The communication will indicate the deficiencies noted in accordance with IV, 1.2.1, and will state that the opposition will be deemed not to have been filed unless the deficiency or deficiencies are remedied within the time limits indicated in IV, 1.2.1.

1.3.2 Communication in the event of deficiencies as described in IV, 1.2.2, which, if not remedied, will lead to rejection of the opposition as inadmissible

The communication will indicate the deficiencies noted in accordance with IV, 1.2.2.1, or IV, 1.2.2.2, and will state that the opposition will be rejected as inadmissible unless the deficiencies as described in IV, 1.2.2.1, are remedied within the opposition period and unless the deficiencies as described in IV, 1.2.2.2, are remedied within the period stipulated by the formalities officer.

1.3.3 Extent of the formalities officer's obligation to issue the above communications

Although the formalities officer is not obliged to do so, he should notify the opponent of deficiencies as described in IV, 1.2.1(i), (iii) and (iv), and IV, 1.2.2.1, in good time before the expiry of the time-limits within which it is still possible to remedy the deficiencies. However, the opponent can seek no legal remedy against failure to issue these communications,

which should be regarded merely as a service afforded the opponent by the EPO so as largely to obviate any adverse legal consequences. Deficiencies as described in IV, 1.2.1(ii) and 1.2.2.2, must in any event be officially notified to the opponent, since this is a statutory requirement. Should this communication inadvertently be omitted notwithstanding deficiencies of this type in the notice of opposition, the opponent may submit the missing particulars on his own initiative at any time, even after the expiry of the opposition period without suffering adverse legal consequences.

1.4 Subsequent procedure in the event of deficiencies which may no longer be remedied

Rule 69(1)

1.4.1 Deficiencies which may no longer be remedied, as a result of which the opposition is deemed not to have been filed

If the formalities officer establishes that the deficiencies referred to in IV, 1.2.1, have not been remedied within the time limits laid down in the EPC or by the EPO, he will inform the opponent in accordance with Art. 119 that the notice of opposition is deemed not to have been filed and that a decision may be applied for under the terms of Rule 69(2) (see E-VIII, 1.9.3). If no such application is made within the prescribed period of two months after notification of this communication, and if there is no other valid opposition pending, the proceedings are closed and the parties informed accordingly. Any opposition fees which have been paid are refunded. The file is returned to the patent registry.

Documents submitted with a notice of opposition which is deemed not to have been filed will form part of the file and will thus be available for inspection in accordance with Art. 128(4). They will be regarded as observations by third parties under Art. 115 (see in this connection V, 2, and E-VI, 3). If a further admissible opposition is pending, the proceedings are continued in respect of it.

1.4.2 Deficiencies which may no longer be remedied in accordance with Rule 56(1) and (2), resulting in the opposition being rejected as inadmissible

If there are no deficiencies of the type referred to in IV, 1.4.1, but a notice of opposition which is deemed to have been filed reveals deficiencies under the terms of Rule 56(1) (see IV, 1.2.2.1) which may no longer be remedied and which have not been communicated to the opponent in accordance with IV, 1.3.2 (because the opposition period has already expired), the formalities officer must, by virtue of Art. 113(1), notify the opponent of these deficiencies, allowing him time in which to submit comments (normally two months), and point out to him that the notice of opposition is likely to be rejected as inadmissible.

If the opponent does not refute the opinion expressed by the formalities officer on the existence of deficiencies which may no longer be corrected or has failed to remedy in good time deficiencies which may be corrected (Rule 56(2)) and which were communicated to him pursuant to IV, 1.3.2, the formalities officer will reject the notice of opposition as inadmissible, except in the case mentioned in IV, 1.2.2.1(v) (for which the Opposition Division is competent to decide, see the Notice from the Vice-President of the Directorate-General 2 of the EPO concerning the entrustment to non-examining staff of certain duties normally the responsibility of the examining or opposition divisions, dated 28 April 1999, OJ 7/1999, 503). As regards the form of the decision, see E-X, 4 and 5.

In all other cases the formalities officer will submit the opposition documents to the directorate responsible for the European patent in suit (for designation of an Opposition Division, see IV, 2).

The decision declaring the opposition inadmissible under Rule 56(1) or 56(2) can be taken without the participation of the proprietor of the patent in accordance with Rule 56(3). However, for reasons of procedural economy, the substantive examination is in fact initiated if at least one further admissible opposition is pending. The proprietor of the patent may also comment on the admissibility of the former opposition in the course of that examination.

When the decision declaring the opposition inadmissible has become final the opponent concerned is no longer a party to the proceedings.

1.5 Notifications to and observations by the proprietor

Communications and decisions in the course of the examination as to whether the opposition is deemed to have been filed and is admissible are also notified to the proprietor of the patent. If he files observations on his own initiative concerning such a communication, they may be taken into account in the decision.

1.6 Subsequent procedure

For the subsequent procedure in the event of one or more oppositions with no deficiencies see IV, 5.2.

2. Activity of the Opposition Division

The formalities officer submits the files to the competent directorate on expiry of the periods specified in 5.2, 5.3 and 5.5 and in the remaining cases (see IV, 1.4.2) immediately.

Art. 19(2)

The director responsible will then designate the three technical members of the competent Opposition Division. The Opposition Division will decide whether one of its members – and if so, which – is to be entrusted with the examination of the opposition up to the taking of a decision (see II, 5). The technical members of the Division should not be designated if the opposition is rejected as inadmissible by the formalities officer and no further admissible opposition has been filed (see IV, 1.4.2).

3. Rejection of the opposition as inadmissible by the Opposition Division, the proprietor of the patent not being a party

(For rejection of the opposition as inadmissible at a later stage, the proprietor of the patent being a party, see IV, 5.1 and 5.5)

In cases of insufficient substantiation, where the formalities officer is not competent to decide on the inadmissibility (see IV, 1.2.2.1(v)), the Opposition Division will either:

- (i) issue the decision rejecting the opposition as inadmissible (when the formalities officer has already informed the opponent of this deficiency pursuant to IV, 1.3.2); or
- (ii) consider the opposition admissible and continue with examination of the opposition (see V); or
- (iii) communicate its findings to the opponent in question and at the same time request him to submit observations.

If the opponent does not refute the opinion expressed by the Opposition Division on the existence of these deficiencies which may no longer be corrected, the Opposition Division will reject the notice of opposition as inadmissible. As regards the form of the decision, see E-X, 4 and 5.

The decision will be communicated to the other parties. An inadmissible opposition or documents produced in support of an inadmissible opposition will be placed in the files and will therefore be available for inspection in accordance with Art. 128(4). As regards the possibility of taking them into consideration as observations by third parties, see V, 2, and E-VI, 3. If there are further admissible oppositions, for reasons of procedural economy this decision to reject the opposition as inadmissible will normally be taken at the end of the procedure together with the decision on the admissible oppositions.

For the possibility of appeal by the opponent and other possible means of redress, see E-XI, 1 and 7.

4. Termination of opposition proceedings in the event of inadmissible opposition

Under the terms of Art. 101(1) and Rule 57(1), the examination as to whether the European patent can be maintained can only be performed if at least one admissible opposition has been filed. This means that the Opposition Division has to refrain from commenting on the substantive merits of the opposition when expressing an opinion on its inadmissibility if there is no further admissible opposition (see T 925/91, OJ 7/1995, 469). Opposition proceedings are terminated once all notices of opposition filed against a European patent have been rejected as inadmissible and the last decision in this respect has become final. This will be communicated to the parties.

5. Preparation of substantive examination

5.1 Inadmissibility at a later stage

Since the admissibility of an opposition is always open to question by the proprietor, no separate communication that the opposition is admissible will be sent to the opponent or the proprietor of the patent. Where deficiencies on the basis of which the notice of opposition is likely to be regarded as inadmissible, but of which the opponent has not been informed by the formalities officer, come to the attention of the Opposition Division in the opposition documents submitted to it or because the proprietor has raised the issue at any stage of the proceedings, it will inform the parties about its reservations in a communication and at the same time request the opponent in question to submit observations. If deficiencies within the meaning of Rule 56(2) are involved, it is sufficient to specify a period for the opponent to remedy such deficiencies.

If the opponent does not refute the opinion expressed by the Opposition Division on the existence of these deficiencies which may no longer be corrected or fails to remedy in good time deficiencies which may be corrected, the Opposition Division will reject the notice of opposition as inadmissible. As regards the form of the decision, see E-X, 4 and 5. For subsequent procedure, see the last two paragraphs of IV, 3.

5.2 Invitation to the proprietor of the patent to submit comments and communication of opposition to the other parties concerned by the formalities officer

If the formalities officer considers that no further ex-officio objection to the admissibility of each or the only opposition remains, he will invite the proprietor of the patent, immediately after expiry of the opposition period or the period laid down by the formalities officer for the remedying of the deficiencies in accordance with Rule 56(2) (see IV, 1.2.2.2), or for the presentation of evidence (see IV, 1.2.2.1(v)), to file his observations concerning the oppositions communicated earlier and to file amendments, where appropriate, to the description, claims and drawings within a period to be fixed by the formalities officer (normally four months). This also applies to oppositions where a decision to the effect that they are deemed not to have been filed or are inadmissible has not yet been taken or has not yet become final.

Rule 57(1), (2)

If several notices of opposition have been filed, the formalities officer will communicate them to the other opponents at the same time as the communication provided for in the previous paragraph. This will not be combined with an invitation to file observations or the setting of a time limit.

5.3 Filing of amended documents in reply to the notice of opposition

Any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100. That is to say, amendments are admissible only if they are required in order to meet a ground for opposition. However, the ground for opposition does not actually have to have been invoked by the opponent. For example, in opposition proceedings admissibly opened on grounds of non-patentability, the patent proprietor can also submit amendments to remove added subject-matter. Opposition proceedings cannot be used merely to tidy up and improve the disclosure in the patent specification (see T 127/85, OJ 7/1989, 271). The mere addition of new claims to the claims as granted is inadmissible because such amendments cannot be said to meet a ground of opposition. However, the replacement of one independent claim as granted by multiple, e.g. two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted is admissible if such a replacement is occasioned by grounds of opposition specified in Art. 100 (T 223/97, not published). Apart from the above, amendments occasioned by national rights of earlier date are admissible pursuant to Rule 87 (see also C-IV, 6a, with the exception of withdrawing the designation, and the reference in VII, 4.5, to C-III, 8.4).

Rule 57a

If the proprietor proposes amendments to the patent in reply to the grounds of opposition and the Opposition Division intends to maintain the patent in amended form, pursuant to those grounds, other amendments, not related to the grounds of opposition (e.g. corrections, clarifications), may be allowed provided that the patent thus amended still fulfils the requirements of the EPC. Such amendments, however, should not be proposed by the Opposition Division and they can only be taken into consideration up to the pronouncement of the decision (in oral proceedings) or until the date the decision is handed over to the EPO's internal postal service for transmittal to the parties (in written proceedings) (see G 12/91, OJ 5/1994, 285).

The amended documents should, provided that it is not irrelevant at the stage reached in the procedure, be as complete as possible and drawn up

in such a way as to allow the European patent, where appropriate, to be maintained without further delay in the amended version.

These considerations apply also to documents of second preference in which the proprietor proposes amendments for consideration by the Opposition Division only if the Division is unable to grant his main request, for example that the opposition should be rejected. In both cases, however, it will be more convenient in certain circumstances to determine first the form of the claims, leaving purely consequential amendments in the description to be dealt with later.

Care must be taken to ensure that any amendments do not offend against Art. 123(2) and (3) (see V, 5 and 6). The proprietor of the patent should, where this is not obvious, indicate the points in the original application documents or claims of the granted patent from which the amendments may be derived (Art. 100(c) and Art. 123(2)). In addition, he should file observations as regards the patentability of the subject-matter of the patent as amended (with reference to Art. 100(a) and 100(b)), taking into account the state of the art and objections raised in the opposition notice together, where appropriate, with the evidence presented in support. It must also be checked that the patent, by the amendments **themselves**, does not contravene the requirements of the EPC (with the exception of Art. 82, see V, 2). For the form of amended documents, see E-II.

5.4 Communication of observations from one of the parties to the other parties

Rule 57(3)

The formalities officer will, at any stage in the procedure, immediately communicate the observations of any of the parties to the other parties for information.

If the proprietor of the patent files amended documents with his observations, where applicable as part of an alternative request, the formalities officer will invite the other parties to submit observations within a period to be fixed by him (normally four months).

If the Opposition Division considers that observations are called for in the course of the further procedure, a separate invitation is issued and a period is fixed (normally four months), with or without a communication stating the grounds.

5.5 Decision concerning the admissibility of an opposition, the proprietor of the patent being a party

If the proprietor of the patent, when replying to the notice of opposition, contends that the opposition is inadmissible pursuant to Rule 56(1) and (2), because of deficiencies which are to be specified, the opponent concerned must be given the opportunity to submit his comments within a period fixed by the formalities officer (two months).

If the Opposition Division concludes that the opposition is inadmissible, it must as a rule first take a reasoned decision, which is appealable. If, on the other hand, on the basis of another – admissible – opposition, an immediate decision can be taken on the rejection of the opposition or oppositions or on the revocation of the patent, the decision on admissibility is to be taken together with this final decision.

If, despite the observations of the proprietor of the patent, the Opposition Division concludes that the opposition is admissible, the decision on

admissibility is normally to be taken together with the final decision, especially where at least one other admissible opposition exists. If there are only oppositions where the admissibility is doubtful, a reasoned intermediate decision should be issued, which is appealable, provided that this will not unduly delay the proceedings.

An opponent whose opposition has been finally rejected as inadmissible is no longer a party to the subsequent proceedings once this decision becomes final.

5.6 Examination of the admissibility of an intervention and preparations in the event of an intervention

When examining whether an intervention is admissible, the formalities officer and the Opposition Division should proceed as for the examination as to admissibility of an opposition (see IV, 1, 3 and 5.5) but on the basis of the requirements for intervention under Art. 105.

Rule 57(4)

Rule 36(4) will apply in respect of the documents to be sent, in accordance with IV, 5.2 and 5.4, to the parties, including any third party who has validly intervened (see also III, 3.1). Paragraphs IV, 5.2 and 5.4 may, however, be disregarded in the case of an application for intervention in opposition proceedings.

Rule 61a

Accordingly, particularly in the case of proceedings which are at an advanced stage, the formalities officer will inform third parties who have intervened of the progress of the proceedings and request them to indicate within one month whether they will also require the documents received from the parties in accordance with Rule 57(1), (2) and (3), together with the communications from the Opposition Division and the observations of the parties under Rule 58(1), for the preceding period. If this is the case, the formalities officer should also provide the documents filed in accordance with Rule 36(4) for the preceding period and send them with the relevant communications from the Opposition Division or the formalities officer to the intervening third party.

CHAPTER V

SUBSTANTIVE EXAMINATION OF OPPOSITION

1. Beginning of the examination of the opposition

Once the preparations for the examination of the opposition have been completed pursuant to Rule 57, the Opposition Division examines whether the grounds for opposition (see III, 5) laid down in Art. 100 prejudice the maintenance of the European patent. The examination may also begin if a single admissible opposition has been withdrawn in the interim (see VII, 6.3). If the opponent has died or is legally incapacitated, the examination may begin even without the participation of the heirs or legal representatives (see VII, 6.2).

Art. 101(1)

2. Extent of the examination

2.1 Extent to which the patent is opposed

In the unusual case where an opposition is limited to only a certain part of the patent, the Opposition Division has to limit its examination to the part opposed. However, if the opposition is directed only to an independent claim, the dependent claims are considered to be implicitly covered by the extent of the opposition and may be examined by the Opposition Division, provided their validity is *prima facie* in doubt on the basis of the information already available (see G 9/91, OJ 7/1993, 408). Similarly, if only a process claim is opposed, a product-by-process claim making reference to the same process is considered to be implicitly covered by the extent of opposition and may be examined under the same conditions as above (see T 525/96, not published in OJ).

2.2 Examination of the grounds for opposition

As a general rule, the Opposition Division will confine its examination to those grounds for opposition brought forward by the opponent. If, for example, the opposition is filed only on the grounds that the subject-matter of the European patent is not adequately disclosed or that it extends beyond the content of the patent application as filed, the Opposition Division will examine the patentability of the subject-matter of the European patent pursuant to Art. 52 to 57 only if facts have come to its notice which, **prima facie**, wholly or partially prejudice the maintenance of the patent (see G 10/91, OJ 7/1993, 420).

If, therefore, once the proceedings for examining the opposition(s) have been initiated, because an admissible opposition has been filed (although it may have been withdrawn in the interim), there is reason to believe that other grounds exist which, *prima facie*, in whole or in part prejudice the maintenance of the European patent, these grounds should generally be examined by the Opposition Division of its own motion pursuant to Art. 114(1). Such other grounds may result from facts emerging from the search report or the examination procedure, the examiner's personal knowledge or observations presented by third parties pursuant to Art. 115 (see also E-VI, 3). Such grounds may also have been put forward in an opposition which has been withdrawn, in another opposition which has been rejected as inadmissible, or in another opposition deemed not to have been filed. They may also be any grounds submitted belatedly (see E-VI, 1.1 and 2). In carrying out such examination the Opposition Division should, however, take the interests of procedural expediency into account (see E-VI, 1.2). If the decision is to be based on grounds to be

Art. 114

taken into account pursuant to Art. 114(1), the parties must be given the opportunity to comment (see E-X, 1).

Pursuant to Art. 100, the absence of unity of invention is not a ground for opposition (see III, 5).

Art. 82

Since unity of invention under Art. 82 is only required for the European patent application, the unity of the subject-matter of the European patent may not be examined by the Opposition Division, even of its own motion. In particular, where the facts, evidence and arguments which come to light in the opposition proceedings lead to the maintenance of the European patent in amended form, there should be no further examination as to whether the remaining subject-matter of the patent contains a single invention or more than one. Any lack of unity must be accepted (see G 1/91, OJ 6/1992, 253).

The grounds for opposition laid down in Art. 100 are examined in greater detail below.

3. Non-patentability pursuant to Art. 52 to 57

Art. 100(a)

The same substantive requirements apply in the opposition procedure regarding patentability pursuant to Art. 52 to 57 as in the examination procedure. Part C, Chapter IV, should therefore also be applied in opposition proceedings. However, it will be more common in opposition proceedings than in examination procedure for the examination as to patentability to be based on the state of the art as made available to the public not by written description but "by means of an oral description, by use, or in any other way" (see Art. 54(2)). The above-mentioned ways in which the state of the art may be made available to the public will accordingly be considered in more detail below.

3.1 State of the art made available to the public "by use or in any other way"

3.1.1 Types of use and instances of state of the art made available in any other way

Use may be constituted by producing, offering, marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange.

The state of the art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on television.

Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the state of the art concerned.

3.1.2 Matters to be determined by the Opposition Division as regards use

When dealing with an allegation that an object or process has been used in such a way that it is comprised in the state of the art, the Opposition Division will have to determine the following details:

- (i) the date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use);

- (ii) what has been used, in order to determine the degree of similarity between the object used and the subject-matter of the European patent; and
- (iii) all the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject-matter having become available to the public.

On the basis of the submissions and the evidence already submitted, e.g. documents confirming sale, or affidavits related to the prior use, the Opposition Division will first establish the relevance of the alleged prior use. If on the basis of this assessment it is of the opinion that the prior use is sufficiently substantiated and relevant, it may decide on the opposition using the submissions and the evidence, if the patentee does not contest the prior use. If the patentee does contest it or certain circumstances of it, the Division will need to take further evidence, if offered (e.g. hearing witnesses or performing an inspection) for those facts which are relevant to the case and which cannot yet be considered proven on the basis of the evidence already submitted. Evidence is always taken under participation of the parties, normally in oral proceedings. For details concerning means of evidence see E-IV, 1.2.

3.1.3 Ways in which subject-matter may be made available

3.1.3.1 General principles

Subject-matter should be regarded as made available to the public by use or in any other way if, at the relevant date, it was possible for members of the public to gain knowledge of the subject-matter and there was no bar of confidentiality restricting the use or dissemination of such knowledge (see also C-IV, 5.1 with reference to written descriptions). This may, for example, arise if an object is unconditionally sold to a member of the public, since the buyer thereby acquires unlimited possession of any knowledge which may be obtained from the object. Even where in such cases the specific features of the object may not be ascertained from an external examination, but only by further analysis, those features are nevertheless to be considered as having been made available to the public. This is irrespective of whether or not particular reasons can be identified for analysing the composition or internal structure of the object. These specific features only relate to the intrinsic features. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g. reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made. Typical examples are the application as a pharmaceutical product of a known substance or composition (cf. Art. 54(5)) and the use of a known compound for a particular purpose, based on a new technical effect (cf. G 2/88, OJ 4/1990, 93). Thus, such characteristics cannot be considered as already having been made available to the public (see G 1/92, OJ 5/1993, 277).

If, on the other hand, an object could be seen in a given place (a factory, for example) to which members of the public not bound to secrecy, including persons with sufficient technical knowledge to ascertain the specific features of the object, had access, all knowledge which an expert

was able to gain from a purely external examination is to be regarded as having been made available to the public. In such cases, however, all concealed features which could be ascertained only by dismantling or destroying the object will not be deemed to have been made available to the public.

3.1.3.2 Agreement on secrecy

The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken (reference should be made to the particular case of a non-prejudicial disclosure arising from an evident abuse in relation to the applicant, in accordance with Art. 55(1)(a)), or if the circumstances of the case are such that such secrecy derives from a relationship of good faith or trust. Good faith and trust are factors which may occur in contractual or commercial relationships.

3.1.3.3 Use on non-public property

As a general rule, use on non-public property, for example in factories and barracks, is not considered as use made available to the public, because company employees and soldiers are usually bound to secrecy, save in cases where the objects or processes used are exhibited, explained or shown to the public in such places, or where specialists not bound to secrecy are able to recognise their essential features from the outside. Clearly the above-mentioned "non-public property" does **not** refer to the premises of a third party to whom the object in question was unconditionally sold or the place where the public could see the object in question or ascertain features of it (see the examples in 3.1.3.1 above).

3.1.3.4 Example of the accessibility of objects used

A press for producing light building (hard fibre) boards was installed in a factory shed. Although the door bore the notice "Unauthorised persons not admitted", customers (in particular dealers in building materials and clients who were interested in purchasing light building boards) were given the opportunity of seeing the press although no form of demonstration or explanation was given. An obligation to secrecy was not imposed as, according to witnesses, the company did not consider such visitors as a possible source of competition. These visitors were not genuine specialists, i.e. they did not manufacture such boards or presses, but were not entirely laymen either. In view of the simple construction of the press, the essential features of the invention concerned were bound to be evident to anyone observing it. There was therefore a possibility that these customers, and in particular the dealers in building materials, would recognise these essential features of the press and, as they were not bound to secrecy, they would be free to communicate this information to others.

3.1.3.5 Example of the inaccessibility of a process

The subject of the patent concerns a process for the manufacture of a product. As proof that this process had been made available to the public by use, a similar already known product was asserted to have been produced by the process claimed. However, it could not be clearly ascertained, even after an exhaustive examination, by which process it had been produced.

3.2 State of the art made available by means of oral description

3.2.1 Cases of oral description

The state of the art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation or a lecture or by means of radio, television or sound reproduction equipment (tapes and records).

Art. 54(2)

3.2.2 Non-prejudicial oral description

The state of the art will not be affected by oral descriptions made by and to persons who were bound to, and preserved, secrecy, nor by an oral disclosure which was made no earlier than six months before the filing of the European patent application and which derives directly or indirectly from an evident abuse in relation to the applicant or his legal predecessor. In determining whether evident abuse has occurred, note C-IV, 8.3.

Art. 55(1)(a)

3.2.3 Matters to be determined by the Opposition Division in cases of oral description

Once again, in such cases the following details will have to be determined:

- (i) when the oral description took place;
- (ii) what was described orally; and
- (iii) whether the oral description was made available to the public; this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall; see also V, 3.1.2(iii)).

3.3 State of the art made available to the public in writing or by any other means

For this state of the art, details equivalent to those defined in V, 3.2.3 have to be determined if they are not clear from the written or other disclosure itself or if they are contested by a party.

If information is made available by means of a written description and use or by means of a written and oral description, but only the use or the oral description is made available before the relevant date, then in accordance with C-IV, 5.1, the subsequently published written description may be deemed to give a true account of that oral description or use, unless the proprietor of the patent can give good reason why this should not be the case. In this case, the opponent must adduce proof to the contrary in respect of the reasons given by the proprietor of the patent. Caution should be exercised when considering the type of evidence presented to substantiate the content of an oral description. For example, a report of a lecture written by the lecturer himself may not be an accurate account of what was in fact conveyed to the public. Similarly, a script from which the lecturer purportedly read may not actually have been completely and comprehensibly read (see T 1212/97, not published in OJ).

4. Insufficient disclosure of the invention

4.1 Required form of disclosure

Determination of whether the disclosure of an invention in a European patent application is sufficient is dealt with in C-II.

Art. 100(b)

The principles set out there will also apply *mutatis mutandis* to the opposition procedure. The overriding consideration in this context is the disclosed content of the European patent specification, that is to say what a person skilled in the art is able to infer from the patent claims, description and drawings, if any, without reflection as to inventiveness. Pursuant to Art. 100(b), the patent has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by persons skilled in the art. If the patent specification does not disclose the invention sufficiently clearly to enable it to be carried out in accordance with Art. 100(b), this may be remedied, provided the original documents contained a sufficient disclosure, but subject to the condition that, as required under Art. 123(2), the subject-matter of the European patent does not extend beyond the content of the application as filed and, as required under Art. 123(3), the protection conferred is not extended.

4.2 Disclosure of inventions relating to biological material

Rule 28(1), (2)

The relevant details in this connection can be found in C-II, 6.

4.3 Burden of proof as regards the possibility of performing and repeating the invention

If the Opposition Division has serious doubts as regards the possibility of performing the invention and repeating it as described, the burden of proof as regards this possibility, or at least a demonstration that success is credible, rests with the proprietor of the patent. This may be the case where, for example, experiments carried out by the opponent suggest that the subject-matter of the patent does not achieve the desired technical result. As regards the possibility of performing and repeating the invention, see also C-II, 4.11.

4.4 Cases of partially insufficient disclosure

4.4.1 Only variants of the invention are incapable of being performed

The fact that only variants of the invention, e.g. one of a number of embodiments of it, are not capable of being performed should not immediately give rise to the conclusion that the subject-matter of the invention as a whole is incapable of being performed, i.e. is incapable of resolving the problem involved and therefore of achieving the desired technical result.

Those parts of the description relating to the variants of the invention which are incapable of being performed and the relevant claims must, however, then be deleted at the request of the Opposition Division if the deficiency is not remedied. The patent specification must then be so worded that the remaining claims are supported by the description and do not relate to embodiments which have proved to be incapable of being performed.

Any failure to rectify these deficiencies without good reason will result in the patent being revoked.

4.4.2 Absence of well-known details

For the purposes of sufficient disclosure the patent does not need to describe all the details of the operations to be carried out by the person skilled in the art on the basis of the instructions given, if these details are well-known and clear from the definition of the class of the claims or on the basis of common general knowledge (see also C-II, 4.9 and C-III, 4.4).

4.4.3 Difficulties in performing the invention

An invention should not be immediately regarded as incapable of being performed on account of a reasonable degree of difficulty experienced in its performance ("teething troubles", for example).

1st example: The difficulties which could, for example, arise from the fact that an artificial hip joint could be fitted to the human body only by a surgeon of great experience and above-average ability would not prevent manufacturers of orthopaedic devices from deriving complete information from the patent with the result that they could reproduce the invention with a view to making an artificial hip joint.

2nd example: A switchable semiconductor which, according to the invention, is used for switching electrical circuits on and off without using contacts, thereby making for smoother operation, suffers from teething troubles in that a residual current continues to flow in the circuit when switched off. However, this residual current adversely affects the use of the electrical switch in certain fields only, and can otherwise be reduced to negligible proportions by routine further development of the semiconductor.

5. Subject-matter of the European patent extending beyond the original disclosure

5.1 Basis of this ground for opposition

This ground for opposition under Art. 100(c) refers back to Art. 123(2) and stipulates that the subject-matter of a European patent may not extend beyond the content of the application as filed. In the case of a patent granted on the basis of a European divisional application (Art. 76(1)), two criteria apply: the subject-matter must not extend beyond the content of the earlier application as filed (Art. 76(1)), and it must not extend beyond the content of the divisional application as filed (Art. 123(2)) (see T 434/97, not published in OJ). Similar considerations apply to applications filed under Art. 61. In the case of a patent granted on an application filed in accordance with Art. 14(2), the original text will, as provided for in Art. 70(2), constitute the basis for determining whether the subject-matter of the European patent extends beyond the content of the application as filed. However, unless, for example, the opponent adduces proof to the contrary the Opposition Division may, under Rule 7, assume that the translation referred to in Art. 14(2) is in conformity with the original text of the application.

Art. 100(c)

5.2 Distinction between allowable and unallowable amendments

The distinction between allowable amendments to the content of a European patent application and amendments which are at variance with Art. 123(2) or Art. 76(1) has already been set forth in C-VI, 5.3 and 9.1.4. These guidelines should be applied mutatis mutandis in the course of opposition proceedings in cases where the subject-matter of the European patent as granted or as amended during the opposition proceedings extends beyond the content of the application as filed.

6. Extension of protection

6.1 General remarks

The European patent as granted or as amended in opposition proceedings determines retroactively the protection conferred by the

Art. 69(2)

European patent application, insofar as such protection is not thereby extended.

Opposition proceedings will frequently give rise to amendments to the claims, following from grounds for opposition raised under Art. 100. Reasoned requests filed independently by the proprietor of the patent for an amendment to the claims, e.g. for limitation of the patent in view of an aspect of the state of the art which has come to his knowledge, may also result in amendments to the claims after examination by the Opposition Division.

Art. 123(3) In such cases the claims of the European patent may not be amended in such a way as to extend the protection conferred by the patent.

Art. 69(1) The extent of protection conferred by a European patent is determined by the terms of the claims. Nevertheless, the description and drawings are to be used to interpret the claims.

The Protocol on the Interpretation of Art. 69, which is, pursuant to Art. 164(1), an integral part of the EPC, specifies how Art. 69 is to be interpreted.

Since, pursuant to Art. 69(1), amendments to the description and drawings will also influence the interpretation of the claims, and may therefore extend the protection conferred, any such amendments extending protection in this way are not allowable (see G 1/93, OJ 8/1994, 541).

6.2 Examination of amendments to the claims

In view of the above considerations, all amendments made to claims and any connected amendments to the description and drawings in the course of opposition proceedings, such as a change in the technical features of the invention, must be examined to determine whether such amendments could result in the extension of the subject-matter beyond the content of the application as originally filed (Art. 123(2)) or in the extension of the protection conferred (Art. 123(3)).

If, in view of Art. 84 and Art. 69, the application documents have been adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule, subject-matter deleted for this reason cannot be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) (the cut-off effect). An analogous finding applies to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention (see T 1149/97, OJ 6/2000, 259).

A possible conflict between the requirements of Art. 123(2) and 123(3) may occur where, in the procedure before grant, a feature was added to the application which is considered unallowable under Art. 123(2) in opposition proceedings. In that case, Art. 123(2) would require deletion of such a feature whereas Art. 123(3) would not allow deletion, as this would extend the protection conferred by the patent as granted. In such a case the patent will have to be revoked under Art. 100(c). However, where this feature can be **replaced** by a feature for which there is a basis in the application as filed **and** which does not extend the protection conferred by the patent as granted, maintenance in this amended form can be allowed. If the added feature, **without providing a technical contribution to the**

subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, this feature may be maintained (see G 1/93, OJ 8/1994, 541).

Other requirements of the EPC may also interact with Art. 123(3) after grant. For instance, if a patent as granted only contains claims that in fact define a "method for treatment of the human or animal body by therapy or surgery practised on the human or animal body" or contain such a method step, and such a patent is opposed under Art. 52(4), then Art. 52(4) and 123(3) may operate in combination so that the patent must inevitably be revoked, in that:

- the patent cannot be maintained as granted because its claims define subject-matter which is unpatentable under Art. 52(4); and
- the patent cannot be maintained in amended form because amendment of the claims as granted by deletion of such "method features" would be contrary to Art. 123(3) (see T 82/93, OJ 5/1996, 274).

6.3 Change of category of claim

An amendment can be in the form of a change in the category of a claim, possibly combined with a change in the technical features of the invention. Firstly it must be clear that this amendment is necessitated by grounds of opposition (see IV, 5.3). If that is not the case a change of category should be refused.

Rule 57a
Art. 123(3)

Even if this condition is fulfilled, the Opposition Division should exercise great caution in allowing a change of claim category, because the protection as conferred by the claims may be extended (Art. 123(3)). The change of category requested could involve a change from:

(i) "product" to "use"

If a patent is so amended that a claim to a product (a physical entity) is replaced by a claim to the use of this product, the degree of protection is not extended, provided that the use claim in reality defines the use of a particular physical entity to achieve an effect and does not define such a use to produce a product (G 2/88, OJ 4/1990, 93);

(ii) "product" to "method"

If a patent is so amended that a claim to a product is replaced by a claim to a method for producing the product, this change of category is allowable, provided that the method now claimed only results in the product previously claimed. As it is a fundamental principle of European patent law that the protection conferred by a product claim covers all methods for production of the product, the limitation to one of these methods cannot extend the protection conferred originally (see T 5/90 and T 54/90, neither published in OJ);

(iii) "method" to "product"

If a patent is so amended that a claim to a method of operating a device is replaced by a claim directed to the device itself, this change of category is allowable, provided that the original claim contains the claimed features of the device exhaustively, whether in

structural or functional terms (see T 378/86, OJ 10/1988, 386, and T 426/89, OJ 4/1992, 172).

If, however, the device as now claimed is for its features no longer dependent on the circumstances of its operation whereas it depended on them under the terms of the prior method claim, then such a change of category should not be allowed (T 82/93, OJ 5/1996, 274);

By contrast, the change in claim category from a method in which an apparatus is used to the apparatus itself is not allowable (T 86/90, not published in OJ).

(iv) "method" to "use"

The change from a process for the preparation of a product to the use of the product for a purpose other than previously described is also not allowable (T 98/85 and T 194/85, both not published in OJ).

On the other hand, the change in a claim from a method in which a certain product is used to a claim to the use of that product in performing that same method is allowable (see T 332/94, not published in OJ).

CHAPTER VI**PROCEDURE FOR THE EXAMINATION OF THE OPPOSITION**

(oral proceedings: see E-III; taking and conservation of evidence: see E-IV)

1. General remarks

The Opposition Division will first of all endeavour to reach a decision in written proceedings. Taking account of the investigations usually conducted beforehand by a primary examiner (see II, 5 and 6), the Opposition Division will base itself on the written submissions of the parties and, where appropriate, on other written evidence obtained, in particular, through the production of documents, requests for information and sworn statements in writing.

The evidence should be submitted as soon as possible (see IV, 1.2.2).

However, if the Opposition Division considers it expedient, or if any party requests oral proceedings, oral proceedings in accordance with Art. 116(1) will be held before the Opposition Division after suitable preparation. In the oral proceedings, the parties may state their cases and put forward and argue submissions in order to clarify outstanding questions. Members of the Opposition Division may put questions to the parties.

Art. 116

In special, less common cases it will occasionally prove necessary in opposition proceedings for oral evidence to be taken by the Opposition Division as part of oral proceedings or for the conservation of evidence, or by a primary examiner outside the oral proceedings. The Opposition Division is not obliged to take oral evidence if it does not consider it necessary, even if a party has so requested. Oral evidence may be taken, where appropriate under oath, before the competent court in the country of residence of the person to be heard. A member of the Opposition Division may, at the request of the Opposition Division, attend such court hearings (see E-IV, 1.3).

Rule 72(1)

The principal means of taking oral evidence will be the hearing of witnesses and parties (see E-IV, 1.6).

Only in exceptional cases will evidence be obtained at the initiative of the Opposition Division by means of oral and/or written reports by experts (see E-IV, 1.8.1) or by carrying out an inspection (see E-IV, 1.2, last paragraph). In view of the specialised knowledge of the members of the Opposition Division – and of the costs involved – such means should be used only as a last resort.

2. Adherence to the text of the European patent submitted or approved by the proprietor**2.1 Basis for the examination**

If the proprietor of the patent submits amendments to the description, claims or drawings after the notice of opposition has been communicated to him (see IV, 5.3), the Opposition Division must take as a basis for its examination the text of the European patent submitted by the proprietor. This principle, that the Opposition Division must concern itself solely with the text most recently "submitted or agreed by the proprietor", also applies

Art. 113(2)

to the rest of the opposition procedure. (As regards the possibility of amending texts, see V, 6.1, second paragraph.)

2.2 Revocation of the patent

If the proprietor states that he no longer approves the text in which the patent was granted and does not submit an amended text, the patent must be revoked. This also applies when the proprietor requests that the patent be revoked (Legal Advice No. 11/82, OJ 2/1982, 57).

3. Invitation to file observations

3.1 Examiners' communications

Art. 101(2)

In examining the opposition, the Opposition Division will invite the parties, as often as is necessary, to clarify the substance of the case, to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself (see E-I, 1) and, where appropriate, to adduce evidence in respect of matters under dispute. As regards the length of the period see E-VIII, 1.2, as regards the extension of a period see E-VIII, 1.6 and as regards late submission of observations see E-VIII, 1.7 and 1.8, as well as Art. 114(2).

Rule 58(1)

Communications from the Opposition Division and all replies thereto must be communicated to all parties.

3.2 Summons to oral proceedings

Art. 116(1)

Rule 71(1)

If oral proceedings have to be arranged, the parties must be summoned to them as quickly as possible at reasonable notice (see E-III, 6).

Rule 71a(1)

Together with the summons, the Opposition Division will draw attention to and in an annexed note explain the points which in its opinion need to be discussed for the purposes of the decision to be taken; where this has already been done sufficiently in a prior communication it is appropriate to refer to that communication. Normally, the annex will also contain the provisional and non-binding opinion of the Opposition Division on the positions adopted by the parties and in particular on amendments filed by the proprietor of the patent. At the same time, a date will be fixed up to which written submissions may be made or amendments meeting the requirements of the EPC may be filed. Normally this date will be one month before the date of the oral proceedings. However, an earlier date may be advisable if it is anticipated that a party will reasonably need more time, for example to consider the results of comparative tests filed by the other party. With respect to this date, Rule 84 does not apply, i.e. this time limit cannot be extended on request of the parties.

4. Communications from the Opposition Division to the proprietor of the patent

4.1 Communications from the Opposition Division; reasoned statement

Rule 58(3)

Where necessary, any communication to the proprietor of the European patent should contain a reasoned statement. This also applies to any communication to other parties which is communicated to the proprietor of the patent for information only. A reasoned statement will usually not be required if the communication concerns only matters relating to form or if it contains no more than self-explanatory proposals. Where appropriate, all

the grounds against the maintenance of the European patent are to be given in the communication.

4.2 Invitation to file amended documents

If the Opposition Division considers that the European patent cannot be maintained in an unamended form, but that a more limited text might be acceptable, it must inform the proprietor of the patent accordingly, stating the grounds, and in appropriate cases invite him "to file, where necessary, the description, claims and drawings in amended form." As regards the time limit here, see E-VIII, 1.2. Where necessary, the description adjusted in line with the new claims should also deal with the state of the art as set out in the opposition proceedings, the technical purpose and the advantages of the invention as it will then stand. The Opposition Division may itself make proposals for amendments to the documents and in this case it should point out to the proprietor of the patent that they are no more than proposals, which he is free to accept on his own responsibility and as he sees fit, but that the patent may be revoked if it remains in a form that is open to objection on the grounds set forth.

Rule 58(2)

Proposals for amendment filed at a late stage in the proceedings may be disregarded (see T 406/86, OJ 7/1989, 302).

For amended documents, see E-II.

5. Additional search

In exceptional cases, the Opposition Division, like the Examining Division, may on its own initiative cite new material relating to the state of the art and take it into account in its subsequent decision (see C-VI, 8.7). In the normal course of events, however, since the grant of the patent will have been preceded by a search into the subject-matter of the application by the Search Division, by the Examining Division and generally by the opponents, no additional search will be made. Only in exceptional cases should an additional search by the Search Division be set in train. Such a case might arise, for example, if in the opposition the main subject covered by the patent shifts to elements of a dependent claim which were originally of subsidiary importance, to elements which were previously not set out in the claims, but only in the description, to individual features of a combination, or to sub-combinations, and there are grounds for believing that the original search did not extend to such elements or features and if no relevant document can be found quickly in the circumstances set out in C-VI, 8.7.

6. Examination of the opposition during oral proceedings

For details regarding the examination shortly before and during oral proceedings and the conduct thereof, see E-III, 8.

7. Preparation of the decision

7.1 General remarks

If the Opposition Division does not consider it expedient to arrange for oral proceedings of its own motion (see E-III, 4) or for the taking of evidence even where the latter is requested (see E-IV), and if no admissible request for oral proceedings has been received from a party (see E-III, 2), the decision must be reached on the basis of written proceedings. In this case

Art. 116(1)
Rule 72(1)

there is no obligation to arrange for oral proceedings before a decision is reached.

If the case is decided on the basis of written proceedings, submissions filed after the decision has been handed over to the EPO internal postal service for remittal to the parties can no longer be considered, as from that moment the Division cannot amend the decision (see G 12/91, OJ 5/1994, 285), except to the limited extent provided for in Rule 89 (cf. E-X, 10).

The decision, whether or not preceded by oral proceedings or the taking of evidence, may be to revoke the patent (see VIII, 1.2), to reject the opposition (see VIII, 1.3) or to maintain the patent as amended (see VIII, 1.4).

7.2 Preparation of a decision to maintain a European patent in amended form

7.2.1 Procedural requirements

Art. 113

A decision may be delivered only when the patent proprietor has approved the text in which the Opposition Division proposes to maintain the patent and the opponent has had sufficient opportunity to comment on the proposed new text.

Both prerequisites can be fulfilled during oral proceedings. In written proceedings, the necessary opportunity to comment on the new text proposed by the Opposition Division can also be given to the opponent when a communication is issued to the parties. Once these requirements have been met, a separate communication under Rule 58(4) is neither necessary nor appropriate (see G 1/88, OJ 6/1989, 189).

If the patent can be maintained in the amended form, the Opposition Division should immediately try to obtain the patent proprietor's approval of the text in which the patent can be maintained and give the opponent an opportunity to comment on it. An interlocutory decision can then be delivered straight away.

If these requirements have still not been met and no oral proceedings are being held, a communication under Art. 101(2) must be issued. This also applies when it has been established in principle that the patent can be maintained in a particular form but a complete text expressly approved by the patent proprietor is not yet available.

The patent proprietor's approval of an amended version of the patent need not be given in a separate, express declaration; it may also be apparent from the circumstances, in particular from the fact that he has filed or requested the amended version. This applies equally to versions which have been filed as a subsidiary request. (For the wording of documents in oral proceedings, see E-III, 8.9 and 9.)

Rule 58(4)

The patent proprietor's approval can also be obtained through a communication under Rule 58(4) in which the Opposition Division informs the parties that it "intends to maintain the patent as amended" and invites them to "state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent". If the patent proprietor fails to file objections to the text thus notified, he is considered to approve of it.

Generally speaking, this communication is useful only if the Opposition Division considers that the complete document expressly approved by the patent proprietor, on which the opponent has been able to comment, still requires amendments. However, these must not go beyond such editorial changes to the wording as appear absolutely necessary by comparison with the text most recently submitted or approved by the patent proprietor. The Opposition Division should draw attention to such amendments and state why they are required if they are not self-explanatory.

If within the period specified in the communication, or in a communication under Rule 58(4), the patent proprietor objects to the text in which the patent is to be maintained, the proceedings are continued. The European patent can be revoked in the subsequent proceedings if the patent proprietor objects to the text and fails to submit new, properly amended documents despite having been requested to do so.

If an opponent objects to the text communicated to him in which it is intended to maintain the patent, the Opposition Division will continue examining the opposition if it considers that the EPC prejudices the maintenance of the patent in the text initially envisaged.

7.2.2 Decision on the documents on the basis of which the patent is to be maintained

If the Opposition Division considers that the patent can be maintained on the basis of the text submitted or approved by the patent proprietor, and the opponent has had sufficient opportunity to comment on this text – either in writing or during oral proceedings – as well as on the reasons decisive to the patent's maintenance, the Opposition Division will issue an interlocutory decision to the effect that the patent and the invention to which it relates meet the requirements of the EPC following the amendments made by the patent proprietor during the opposition proceedings. If the patent can only be maintained on the basis of an auxiliary request, the decision has to contain a reasoned statement why the version of the main request (and any preceding auxiliary request) does not meet the requirements of the EPC (see T 234/86, OJ 3/1989, 79).

A separate appeal under Art. 106(3) EPC is allowed against this decision, which must be reasoned having regard to the grounds for opposition maintained by the opponent or taken up by the Opposition Division. The decision is delivered in all cases where a European patent is maintained in amended form, even if the opponent has approved of the text communicated by the Opposition Division or has not commented on it. If this decision is not contested, the ruling enshrined in it becomes final and as a result the documents can no longer be amended.

This interlocutory decision is intended to save the patent proprietor unnecessary translation costs arising from an amendment to the text in appeal proceedings.

7.2.3 Request for printing fee and translations

Once the interlocutory decision becomes final or the amended texts in which the patent is to be maintained have been drawn up in opposition appeal proceedings, the formalities officer requests the proprietor of the patent to pay, within three months, the fee for the printing of a new specification of the European patent and to file a translation of any amended claims in the two official languages of the EPO other than the language of the proceedings.

Art. 102(3)(b)
Art. 102(5)
Rule 58(5)

Rule 54

In the communication under Rule 58(5), the proprietor of the patent is asked whether he requests a paper copy of the new patent specification to be supplied to him with the new certificate for the amended European patent. This paper copy of the new specification is supplied free of charge if requested within the time limit of Rule 58(5) or (6). See also C-VI, 15.10.

If the European patent in the amended form contains different claims for different Contracting States, a translation of all sets of claims – in the text communicated to the proprietor of the patent – into all official languages other than the language of the proceedings must be filed.

Rule 58(7)

The communication under the previous paragraph must indicate the designated Contracting States which require a translation pursuant to Art. 65(1).

Art. 102(4), (5)
Rule 58(6)

If the request under the first paragraph above is not complied with "in due time", the acts may still be validly performed within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this two-month period a surcharge equal to twice the fee for printing a new specification of the European patent is paid. If any of the acts is not performed within the period of grace, the formalities officer will issue a decision for revocation of the patent in accordance with Art. 102(4).

CHAPTER VII**DETAILS AND SPECIAL FEATURES OF THE PROCEEDINGS****1. Sequence of proceedings****1.1 Basic principle**

Examination of the admissibility of the opposition and preparation of the examination of the opposition should be commenced immediately after the notice of opposition has been received by the formalities officer or the Opposition Division (see IV, 1 and 3, and V, 1 and 2).

If during the rest of the proceedings the Opposition Division, on account of the amount of work in hand, is unable to process immediately all the oppositions submitted, the reference date for the sequence of tasks will, in principle, be the date on which the last observations in respect of which a time limit had been laid down were submitted by any of the parties, but may not be later than the date on which the time limit expired. Documents received unsolicited or not subject to a previously stipulated official time limit, in connection with official communications setting a time limit, will not affect the sequence of tasks unless they require a further early notification setting a time limit.

1.2 Exceptions

Notwithstanding VII, 1.1 above, oppositions are to be given priority:

- (i) if the earlier examination proceedings were of considerably longer duration than usual;
- (ii) if the opposition proceedings have already extended over a considerably longer period than usual;
- (iii) if a party to the proceedings has submitted a reasoned request for accelerated processing in a case where an infringement action in respect of the European patent is pending before a national court of a Contracting State, or if the EPO is informed by a national court or competent authority of a Contracting State that infringement actions are pending (Notice from the President of the EPO dated 19 May 1998, OJ 7/1998, 361);
- (iv) if other matters to be dealt with, e.g. divisional applications, hinge upon the final decision concerning the opposition; or
- (v) if the next procedural step can be dealt with relatively quickly.

2. Request for documents

Documents referred to by a party to opposition proceedings must be filed together with the notice of opposition or the written submissions in two copies. If such documents are neither enclosed nor filed in due time upon invitation by the formalities officer, the Opposition Division may decide not to take any arguments based on them into account.

Rule 59

In implementing this provision the desired aim of speeding up the procedure should be borne in mind as much as the common interest in taking obviously relevant submissions into account.

3. Unity of the European patent

3.1 Basic principle

Art. 118

If the proprietors of the patent are not the same for different designated Contracting States, the unity of the European patent in opposition proceedings will not be affected, since such persons are to be regarded as joint proprietors (see I, 6, second and third paragraphs).

In particular, the text of the European patent will be uniform for all designated Contracting States unless otherwise provided for in the EPC (see VII, 3.2 and 4).

3.2 Factors affecting the unity of the European patent

The unity of the European patent in opposition proceedings will be affected if the previous proprietor of the patent and the person replacing him pursuant to Art. 99(5) in respect of a particular Contracting State are not deemed to be joint proprietors (see I, 6). In this event, the opposition proceedings involving the different proprietors must be conducted separately. Since different requests may be submitted by the two proprietors (e.g. as regards amendments to the claims), the two sets of opposition proceedings may lead to different conclusions, e.g. as regards the text of the European patent or the scope of protection.

4. Texts of the European patent which are different for different Contracting States

4.1 Different texts where the entitled person takes part in the proceedings

Rule 16(3)

Where a third party has, in accordance with Art. 99(5), replaced the previous proprietor for one or some of the designated Contracting States (see I, 6, third paragraph), the patent as maintained in opposition proceedings may for those States contain claims, a description and drawings which are different from those for the other designated Contracting States, without, of course, going beyond the original disclosure.

4.2 Different text where the state of the art is different pursuant to Art. 54(3) and (4)

Rule 87

C-III, 8.1, applies *mutatis mutandis*.

4.3 Different text where a partial transfer of right by virtue of a final decision pursuant to Art. 61 and Rule 16(1) and (2) has taken place

C-III, 8.2, applies *mutatis mutandis*.

4.4 Different text where a reservation has been entered in accordance with Art. 167(2)

C-III, 8.3, applies *mutatis mutandis*.

4.5 Different text where national rights of earlier date exist

C-III, 8.4, applies *mutatis mutandis*.

5. Procedure where the proprietor is not entitled

5.1 Suspension of proceedings

If a third party provides proof, e.g. a certificate from the court concerned, to the EPO during opposition proceedings or during the opposition period that he has opened proceedings against the proprietor of the European patent for the purpose of seeking a judgment that he is entitled to the European patent, the Opposition Division must stay the opposition proceedings unless the third party consents to their continuation. Such consent must be communicated in writing to the EPO and is irrevocable. However, suspension of the proceedings may not be ordered until the Opposition Division has deemed the opposition admissible. The parties are to be informed of the order suspending the proceedings.

Rule 13(4)

5.2 Continuation of proceedings

When giving a decision on the suspension of proceedings or thereafter, the Opposition Division may set a date on which it intends to continue the proceedings pending before it, regardless of the stage reached in the proceedings opened against the proprietor of the patent, as referred to in VII, 5.1. The date is to be communicated to the third party, the proprietor of the patent and any other party. If no proof has been provided by that date that a decision which has become final has been given, the Opposition Division may continue proceedings.

Rule 13(3), (4)

If a date is set for the resumption of proceedings, it should be chosen, with due consideration for the interests of the third party who only becomes a party to the proceedings after a judgment has been given in his favour, on the basis of the probable duration of the court proceedings so as to enable them to be concluded within that period of time. If, by the date set, the court has not given a judgment, the opposition proceedings must at all events be further stayed if the judgment is expected in the near future. However, the opposition proceedings should be resumed if it is evident that delaying tactics are being employed by the third party or if the proceedings in the court of first instance have concluded with a judgment in favour of the proprietor of the patent and the legal procedure is extended by the filing of an appeal. Opposition proceedings may also be resumed in the absence of a judgment if the patent can be maintained unamended.

Where proof is provided to the Opposition Division that a decision which has become final has been given in the proceedings concerning entitlement to the European patent, the Opposition Division must communicate to the proprietor and any other party that the opposition proceedings are to be resumed as from the date stated in the communication. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the opposition proceedings.

Rule 13(2), (4)

5.3 Interruption of time limits

The time limits in force at the date of suspension other than time limits for payment of renewal fees are interrupted by suspension of the proceedings. The time which has not yet elapsed begins to run as from the date on which proceedings are resumed; however, the time still to run after the resumption of the proceedings must not be less than two months.

Rule 13(5)

Example:

The three-month time limit under Rule 58(5) begins on 3 January 1974; proceedings are suspended on 23 January 1974 and resumed on 1 October 1974. Of the first month (ending 2 February 1974) there are still 11 days left (23 January - 2 February). The total time which has not elapsed then amounts to 11 days and 2 months.

The time limit ends on 11 December 1974.

5.4 Department responsible

Art. 20

The Legal Division is responsible for questions concerning the suspension and resumption of proceedings (see Information from the EPO, OJ 9/1990, 404).

6. Continuation of the opposition proceedings in the cases covered by Rule 60

6.1 Continuation in the case of surrender or lapse of the patent

Rule 60(1)

If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent filed within two months after the date on which the Opposition Division informed the opponent of the surrender or lapse. Evidence of the lapse must generally be provided by submitting extracts from the Patent Registers of the designated Contracting States.

If, in the case of a request for continuation of the proceedings, the proprietor of the patent has renounced before the competent authorities in the designated states all rights conferred by the patent with ab initio and universal effect, or if no request for continuation has been received within the time limit, the opposition proceedings will be closed. The decision to close the proceedings will be communicated to the parties.

If, instead, the proprietor of the patent declares to the EPO that he surrenders/abandons/renounces the patent, the EPO will interpret this as a request for revocation of the patent. For details of the procedure to be followed, see VIII, 1.2.5.

6.2 Continuation on the death or legal incapacity of the opponent

Rule 60(2)

In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the Opposition Division of its own motion, even without the participation of the heirs or legal representatives, for example if the legal proceedings in connection with the will or the appointment of a new legal representative would inordinately prolong the opposition proceedings. This provision will apply not only where only one opposition has been filed: it will also apply in cases where not all those who have filed opposition are deceased or legally incapacitated.

The Opposition Division should continue the proceedings if, for instance, the proprietor of the patent has submitted amendments to the patent in response to the notice of opposition (see T 560/90, not published in OJ). The Opposition Division should also continue the proceedings if it considers that the stage reached in the opposition proceedings is such that they are likely to result in a limitation or revocation of the European patent without further assistance from the opponent(s) concerned and without the Opposition Division itself having to undertake extensive investigations (see T 197/88, OJ 10/1989, 412).

The proprietor of the patent and any other parties are to be informed that the proceedings will be continued. Otherwise the proceedings are closed and the decision to close the proceedings is communicated to the parties.

6.3 Continuation after the opposition has been withdrawn

The opposition proceedings can be continued even if every opposition has been withdrawn. The principles set forth in VII, 6.2, apply *mutatis mutandis* in deciding whether the proceedings are to be continued or closed.

Rule 60(2)

7. Intervention of the assumed infringer

The assumed infringer of a patent (see I, 5) may file notice of intervention in the opposition proceedings within three months of the date on which infringement proceedings were instituted against him or on which he instituted proceedings for a court ruling that he is not infringing the patent. Notice of intervention must be filed in a written reasoned statement. It is not deemed to have been filed until the opposition fee has been paid in the amount prescribed in the Rules relating to Fees under the EPC.

Art. 105

Intervention is permissible as long as opposition or appeal proceedings are pending. A third party can only become a party to the proceedings if a party to the proceedings in which the decision was given files an appeal pursuant to Art. 107; otherwise the decision of the Opposition Division will become final on expiry of the appeal period (see G 4/91, OJ 6/1993, 339 and G 1/94, OJ 11/1994, 787). For accelerated processing of oppositions and accelerated processing before the Boards of Appeal on request, see E-VIII, 4 and 5.

8. Publication of a new specification of the patent

If a European patent is maintained in an amended form, the EPO must, at the same time as it publishes the mention of the opposition decision, publish a new specification of the European patent containing the description, the claims and any drawings, in the amended form.

Art. 103

Rule 54 applies *mutatis mutandis* to the new specification of the European patent.

Rule 62a

CHAPTER VIII**DECISIONS OF THE OPPOSITION DIVISION**

General remarks on decisions appear in E-X.

1. Final decisions on an admissible opposition**1.1 General remarks**

The Opposition Division has to take a final decision on the opposition, by revoking the European patent or rejecting the opposition or ruling that the European patent is to be maintained as amended. If the only admissible opposition or all the admissible oppositions are withdrawn and the Opposition Division takes the view that as the case stands there is no reason for the Office to continue the proceedings of its own motion, the proceedings are closed by means of a formal decision (Rule 60(2), second sentence).

1.2 Revocation of the European patent**1.2.1 Revocation on substantive grounds**

If the Opposition Division is of the opinion that the grounds for opposition mentioned in Art. 100 prejudice the maintenance of the European patent, it will revoke the patent. For revocation because the proprietor of the patent has not given his agreement, see VI, 2.2, 4.2 and 7.2.2.

Art. 102(1)

1.2.2 Revocation for failure to pay the printing fee or to file a translation

If the proprietor of the patent fails in due time to pay the fee for the printing of a new specification of the European patent or to file a translation of the amended claims in the two official languages of the EPO other than the language of the proceedings (see VI, 7.2.3), the European patent will be revoked.

Art. 102(4), (5)

1.2.3 Revocation for failure to notify the appointment of a new representative

If opposition proceedings are interrupted according to Rule 90(1)(c) and the patent proprietor, who is not resident in one of the Contracting States, does not forward a notification of the appointment of a new representative within the two-month period laid down in Rule 90(3)(a) (see E-VII, 2(i)), the European patent will be revoked.

Rule 90(3)(a)

1.2.4 Revocation in the event of requirements not being met until after expiry of time limits

In the cases referred to in VIII, 1.2.2 and 1.2.3, the European patent will be revoked even if the omitted acts have been completed during the period between expiry of the time limit and the taking of a final decision, unless an application for restitutio in integrum has been filed, in which case a decision must first be given on the application.

1.2.5 Revocation of the patent in the event that the proprietor no longer wishes the patent to be maintained as granted

If the proprietor states that he no longer approves the text in which the patent was granted and does not submit an amended text, the patent

must be revoked. This also applies when the proprietor requests the patent to be revoked.

If a proprietor unambiguously declares to the EPO the surrender (or abandonment or renunciation) of the patent, this is interpreted as equivalent to a request that the patent be revoked (see T 237/86, OJ 7/1988, 261). If the request of the proprietor is not unambiguous, he is given the opportunity to request that the patent be revoked or to declare that he no longer approves of the patent being maintained as granted. This results in the patent being revoked (see Legal Advice 11/82, OJ 2/1982, 57).

1.3 Rejection of the opposition

Art. 102(2) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Art. 100 do not prejudice the maintenance of the European patent unamended, it will reject the opposition.

1.4 Maintenance of the European patent as amended

1.4.1 Taking of a final decision

Art. 102(3)
Rule 58(4), (5) If the Opposition Division is of the opinion 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 meet the requirements of the EPC, it will issue a decision to maintain the European patent as amended.

The procedure specified in VI, 7.2.1 to 7.2.3, will precede the decision.

1.4.2 Statement in the decision of the amended form of the European patent

Rule 58(7) The decision must state which text of the European patent forms the basis for maintaining it.

2. Other decisions

2.1 Decision on the inadmissibility of an opposition or intervention

See IV, 3, and IV, 5.5, with reference to the notice of opposition and IV, 5.6, and VII, 7, for the intervention of an assumed infringer.

2.2 Decisions which do not terminate proceedings

Such decisions are dealt with in E-X, 6.

See VI, 7.2.2, with reference to the maintenance of a patent with amended documents.

2.3 Decision on a notified loss of rights at the request of the person concerned

Rule 69(2) This decision is dealt with in E-VIII, 1.9.3.

2.4 Decision on restitutio in integrum

This decision is dealt with in E-VIII, 2.2.7.

2.5 Decision on closure of the opposition proceedings

This decision is dealt with in VII, 6 and VIII, 1.1.

CHAPTER IX**COSTS****1. Charging of costs****1.1 General principle**

Each party to the proceedings must meet the costs he has incurred. However, where costs have been incurred during the taking of evidence or in oral proceedings, an Opposition Division may, for reasons of equity, order a different apportionment of such costs. Art. 104(1)

The phrase "taking of evidence" refers generally to the receiving of evidence by an Opposition Division, whatever the form of such evidence. It includes among other things the production of documents and sworn statements in writing as well as hearing witnesses (see T 117/86, OJ 10/1989, 401).

1.2 Decisions on the apportionment of costs

Apportionment of costs must be dealt with in the decision on the opposition. This apportionment will form part of the main decision and will be incorporated in the operative part of the decision. Rule 63(1)

The decision will deal only with the obligation on the party or parties concerned to bear costs. The actual amounts to be paid by one party to another must be dealt with in the decision on the award of costs (see IX, 2).

A statement that the parties will bear their own costs may be incorporated in the grounds for the decision on the opposition and should be included in cases where one of the parties to the proceedings has submitted a request for a decision on the award of costs which the Opposition Division does not consider justified.

A decision to award costs may be made by the Opposition Division of its own motion, even if no application for the award of costs has been made.

In the absence of an express decision on the award of costs, each of the parties concerned must bear his own costs.

1.3 Costs to be taken into consideration

Apportionment of costs may relate only to those expenses necessary to assure proper protection of the rights involved. Rule 63(1)

Examples of such expenses are:

- (i) expenditure incurred in respect of witnesses and experts, together with other costs arising in connection with the taking of evidence;
- (ii) remuneration of the representatives of the parties in respect of oral proceedings or the taking of evidence; and
- (iii) expenditure incurred directly by the parties, i.e. their travel expenses in coming to oral proceedings or the taking of evidence.

Costs incurred in respect of superfluous or irrelevant evidence, etc., cannot be covered by a decision on costs.

1.4 Principle of equity

Reasons of equity will require a decision on the apportionment of costs when the costs arise in whole or in part as a result of conduct of one party which is not in keeping with the care required to assure proper protection of the rights involved, in other words when the costs are culpably incurred as a result of irresponsible or even malicious actions. Each party may of course defend his rights or interests (e.g. the proprietor his patent) by any legally admissible means within the framework of the opposition proceedings; he may, for example, request oral proceedings or the taking of evidence.

Accordingly, costs incurred as a result of default or of inappropriate legal means used by either party may be charged to the party responsible, even if he has been successful in the opposition proceedings.

The following are examples where the principle of equity may be applied:

The costs incurred by the opponent in preparing oral proceedings which have been appointed may be charged to the proprietor of the patent if he surrenders the patent just before the date appointed for the oral proceedings, although it was clear when the proceedings were being arranged, from a document put forward by the opponent, that the proprietor of the patent had no case and he alone therefore was liable for his irresponsible conduct.

If an aspect of the state of the art is adduced as an argument at a late stage and it can be shown, or it is evident, that the party concerned knew of it earlier, e.g. in that he had made prior use of it, the additional costs of further oral proceedings unnecessarily incurred by the other parties may be charged to the party which caused them by submitting his argument at so late a stage.

If relevant facts or evidence are submitted by a party only at a late stage of the proceedings without any good reason and if, as a consequence, unnecessary costs are incurred by another party, the Opposition Division may decide on the apportionment of costs.

2. Procedure for the fixing of costs

2.1 Fixing of costs by the registry

Art. 104(2)
Rule 63(2)

At the request of at least one party, the registry of the Opposition Division or the registry designated by the President of the EPO in accordance with Rule 9(4) must fix the amount of the costs to be paid under a decision apportioning them. The request is admissible only if the decision apportioning the costs has become final.

Rule 63(2)

A bill of costs, with supporting evidence in respect of each amount involved, must be attached to the request. Costs may be fixed once their credibility is established.

Art. 119

The parties will be notified of the costs as fixed by the registry.

2.2 Appeal against the fixing of costs by the registry

Art. 104(2)

The fixing of costs by the registry may be reviewed by a decision of the Opposition Division.

Rule 63(3)

The request for such a decision, stating the reasons on which it is based, must be filed with the EPO in writing within one month after the date of

notification of the awarding of costs by the registry. It is not deemed to be filed until the fee for the awarding of costs has been paid at the rate prescribed in the Rules relating to Fees under the EPC.

The Opposition Division will take a decision on the request without oral proceedings. Rule 63(4)

3. Enforcement of the fixing of costs

Any final decision of the EPO fixing the amount of costs must be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in the territory of which enforcement is to be carried out. Verification of any such decision must be limited to its authenticity. Art. 104(3)

"Decision" as referred to above also covers the final fixing of costs by the registry of the Opposition Division.