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European Patents

Opposition and amendment after grant



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Oppositions

After Grant an Opposition may be filed by any third party within 9 months

Must

- 1) Identify the Opponent
- 2) Identify the Patent
- 3) Provide Grounds of Opposition
- 4) Pay Opposition Fee

Oppositions

Grounds of Opposition

- 1) Subject Matter not patentable
- 2) Insufficient Disclosure
- 3) Added Matter

Oppositions

What are Not Grounds of Opposition?

Proprietor not entitled

Lack of Unity

Claims unclear

Oppositions

What do we mean by “Not patentable”?

not new

does not involve an inventive step

not susceptible of industrial application

not regarded as an invention

(eg methods of treatment, plant varieties, discoveries, mathematical methods, scientific theories, rules for playing games or doing business, computer programs, presentation of information....but some of these ARE patentable if they have a technical effect, eg some computer programs)

Oppositions

Procedure

- 1) File Opposition with grounds and prior art, etc
- 2) EPO checks it fulfils formal conditions
- 3) Sets Time limit for response
- 4) Proprietor responds
- 5) Opponent and Proprietor usually given further opportunities to respond/amend
- 6) Oral Proceedings (if requested by either party)
- 7) Appealable Decision

Oppositions

How Can Proprietor Respond to Opposition?

1) Argue

and/or

2) Amend

3) Take no action- EPO will decide upon merits

Oppositions

Amendments

Must be fully based upon specification as filed

Must not extend scope of protection

(ie cannot be broader than granted claims)

Cannot 'cherry pick' ...

Must be basis for that combination of features in specification.

Difficult to combine features from two or more embodiments

Ideally...should have exact textual basis

Oppositions

Main and Auxiliary Requests

VERY USEFUL and WIDELY USED

In Opposition and also in pre-grant procedures

Auxiliary Requests **ONLY** considered, in order, if Main Request unallowable and reasons given

Oppositions

MAIN REQUEST

Broadest Position

Often the Claims as Granted

Oppositions

AUXILIARY REQUESTS

Progressively Narrower Sets of Claims

With arguments

Preferably; Progressively introduce features from sub-claims into main claims

If necessary, introduce features from description

(but **note**, if a claim is new (not a combination of previous Claims), the board will examine for clarity/disunity)

Oppositions

Examples of Requests (Main claim only for Auxiliary requests)

	Main	Aux 1	Aux 2	Aux 3	Aux 4
Claim 1	A	A+B	A+B+C	A+C	A + E
Claim 2	A+B				(make sure
Claim 3	A+B +C				there is basis)
Claim 4	A + C				
Description	E				
(but not claimed already)					

Oppositions

Oral Proceedings

Munich, Hague or Berlin

Must have presented all written requests a month before

Each party given opportunity to present case, then opposition division questions them

Each request considered in turn

Grounds considered in turn (eg added matter, sufficiency, patentability)

Usually over in a day and oral decision made on day

Written decision sent few weeks later (2 month appeal period from date of receipt of this)

Oppositions

Oral Proceedings

Concise Arguments...EPO does not like 'waffle'!

Only relevant points

Powerpoint presentations usually NOT allowed

Usually attended solely by European Patent Attorneys

Inventors/Applicant can attend but only allowed to talk if invited and must only talk about relevant points of patentability

Expert Witnesses usually not welcome unless very complicated subject matter and pre-arranged

Oppositions

Oral Proceedings

Advice for Japanese Attorneys:

Ensure European Attorney has, as early as possible:

Full analysis of prior art, etc

Details of any competitors' products the patent is to hopefully cover

All 'fallback' (auxiliary) positions which are satisfactory to client,
including the narrowest scope that is satisfactory.

Amendment of European Patents

After grant an EP Patent must be validated in each separate country

Becomes a bundle of separate, independent patents.

Each can be *separately* amended any time after grant

Each country has different rules:

Apply to amend, open to public inspection and comment, examined by local patent office and allowed or refused.

May not extend protection (ie **cannot broaden claims**)

Procedure can vary if the patent is being opposed/litigated when application to amend is made.

Can result in different claims and scope in different states

Amendment of European Patents

If amendment allowed, patent is considered to have new scope from amendment date, not date of grant

Can withdraw patent in any country but not *ab initio*
(ie patent is still considered to have had effect and rights before date of withdrawal)

Amendment of European Patents

Alternatively

Proprietor Can

CENTRALLY

LIMIT or REVOKE the Patent

Applies in ALL validated countries

Ab Initio effect

Amendment of European Patents

Central Limitation/Revocation

Simple

Must only limit/revoke

Examined for:

- a) clarity, conciseness, support by description (Art 84)
- b) subject matter/extension of scope (Art 123(2) and (3))

but NOT novelty/inventive step (although EPO check claims are narrower than granted claims)

Amendment of European Patents

Central Limitation/Revocation

Can be done ANY TIME after grant

Even after expiry

But if an opposition is pending the central proceedings may be stayed until opposition proceedings completed

Drafting Patent Specifications for Europe

EP Examiners are strict!

Particularly on

- 1) Added Matter (EPC Art. 123(2))
- 2) Sufficiency (EPC Art. 83 -The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art)

Drafting Patent Specifications for Europe

Added Matter (Art 123(2))

Include as much detail as possible.

Intermediate Generalisations problematic (when a broad concept is claimed but the description and drawings are of a narrow embodiment) .
Try to include passages of progressively narrowing scope.

More than 15 claims expensive, but no limit on 'statements of invention' (Consistory clauses) so use [plenty](#) of these, of different scope, adding one feature at a time.

Make Clear that features of an embodiment are optional, where appropriate.

Where several embodiments are described, make clear that features may be used interchangeably

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Sufficiency (Art 83)

For claims as filed and any possible subject matter that they might be amended to include: Ensure the skilled reader can reproduce the invention solely (if possible) from the description/drawings

Include range of embodiments.

If a range is claimed (or might be later be claimed) include embodiments which cover the range

Eg “length 10 to 100mm” (provide examples of different length)

“includes an alkali metal” (provide examples using several different ones)

Include detail of how parts may be manufactured

Drafting Patent Specifications for Europe

Sufficiency (Art 83)

Parameters

Not just ones originally claimed but **any** parameters/dimensions referred to in description

(eg stretchability, absorbency, electrical characteristics, distribution, size (particularly of non-rigid materials, or where size varies with temperature, etc)

Give REPRODUCIBLE methods of measuring in detail. Include the precise measuring apparatus, conditions and settings used

Drafting Patent Specifications for Europe

When translating Japanese into , say, English (for PCT EP Phase), check words that may have more than one meaning. Has the correct one been used?

Ask European Patent Attorney to review specification (preferably before filing PCT application) for sufficiency/added matter complications

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