

## EPO Streamlines Opposition Process

From 1st July 2016, the EPO will initiate a new streamlined opposition process.

### Summary

The intention is to bring opposition proceedings to a speedy conclusion and thereby establish legal certainty for all parties to the opposition proceedings and the public. The aim is for the first instance (opposition division) to reach a decision in straightforward cases **within 15 months** calculated as from the expiry of the opposition period.

Critically the streamlined procedure now requires the **proprietor of the patent to respond to any opposition within 4 months** of notification. **Extensions of time limits will be granted only in exceptional cases with duly substantiated requests.**

This represents a significant change from the present process where time limits are extended on request up to a total of six months with requests for longer extensions allowed in exceptional circumstances.

Whilst the desire of the EPO to streamline the opposition procedure should be applauded, there is a notable distinction between the 9 months available to an opponent to prepare their opposition case (more if the application has been monitored prior to grant) and the now 4 months available for the proprietor to compile its defence of the patent to the opposition.

The revised provisions apply only to

the procedure before the opposition division. For any subsequent appeal the 2007 Rules of Procedure of the Boards of Appeal remain in force, and backlogs mean that most appeal proceedings will continue to take 3 years or more.

### The streamlined process in more detail

An opposition may be filed by any person within 9 months of the publication of the mention of the grant of a European patent in the European Patent Bulletin (Article 99 EPC). An opponent must provide a notice of opposition and this must contain an indication of the facts, evidence and arguments in support of the opposition (Rule 76(2)(c) EPC). The indicated evidence should be filed with the notice of opposition. The indicated evidence may only exceptionally be submitted subsequently.

The patent proprietor will be notified of the opposition by the EPO and should submit a **full** response to the opposition **within 4 months** of notification.

The observations and any amendments filed by the patent proprietor are **immediately** communicated to the opponent for information and **at the same time**, the opposition division **will prepare the next action**. If considered necessary this will be a communication inviting the parties to reply within a

specified time limit (normally 4 months; again no extension of the time limit except in exceptional circumstances). In most cases however the opposition division will issue a summons to oral proceedings.

**Therefore parties to opposition can expect to receive a summons to oral proceedings soon after the response of the proprietor to the notice of opposition has been filed.**

As a rule the date on which oral proceedings are to take place will not be earlier than **six months** after dispatch of the summons. As is the situation now, requests to alter this date may only be considered in exceptional, duly substantiated cases.

The summons to oral proceedings will provide the preliminary opinion of the opposition division and must set a date under Rule 116 EPC for submitting observations and amendments (usually 2 months prior to the date of oral proceedings).

### Further information in the revised Notice

The revised Notice from the EPO (OJ EPO 2016 A42) advises that:

The opposition division may disregard facts or evidence which are not submitted in due time by the parties

concerned (Article 114(2) EPC) unless they are of prima facie relevance.

In order for the proceedings to progress expeditiously, parties should submit all facts, evidence and requests at the beginning of the procedure. Where this is not possible, the facts, evidence and requests must be submitted at the earliest opportunity. If relevant facts or evidence are submitted by a party at a late stage of the proceedings **without very good reason** and if, as a consequence, the costs of oral proceedings or taking of evidence are incurred by another party this may be taken into account in the apportionment of costs.

These statements are largely unchanged from the previous Notice from the EPO (OJ EPO 3/2001 page 148 to 155) and thus it is expected that the same considerations will continue to apply with respect to late filed facts, evidence and requests. As noted above, the summons to oral proceedings must in any case still set a date under Rule 116 EPC for submitting observations and amendments.

The revised Notice further limits examination by the opposition division of its own motion under Article 114(1) EPC. The opposition division may now only

**exceptionally** consider other grounds for opposition which, prima facie, in whole or part would seem to prejudice the maintenance of the European patent. The Notice points out that opposition is not an opportunity for the EPO to undertake a complete re-examination of the patent of its own motion.

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## Need advice?

For more information, please contact [email@carpmaels.com](mailto:email@carpmaels.com).

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