

Opposition proceedings at the EPO

For a short time after a European patent has been granted it is possible to apply to the European Patent Office (EPO) and ask for the patent to be revoked. This procedure is called opposition.

Oppositions are useful because they are currently the only way that a European patent can be revoked centrally. After the opposition period has expired, a European patent can only be revoked nationally by applying separately in each individual country in which the patent is in force. Thus, although oppositions can be lengthy, they are generally far less expensive and time consuming than engaging in multiple sets of national revocation proceedings.

Background

Opposition proceedings are contentious and inter partes (i.e., between the applicant/proprietor, the EPO, and one or more third parties). The EPO is the judge in the proceedings and assesses the arguments put forward by each party. The proceedings are conducted before an opposition division, which includes three technically qualified examiners, at least two of whom must have taken no part in the proceedings for grant of the patent to which the opposition relates. Sometimes a legally qualified examiner who has taken no part in the proceedings for grant may also take part.

The opposition proceedings are initially conducted by written correspondence and will end in an oral hearing if one is requested by a party during the proceedings. The patent proprietor(s) and other interested parties such as their attorney may be present at oral proceedings if they want to be, but this is not compulsory.

Due to the contentious nature of inter partes proceedings, the outcome of an opposition is very often hard to predict. The realities of the proceedings mean that there will be uncertainty regarding the validity of the patent until the decision is issued. It is not unusual for opposition proceedings to take over two years to conclude. If an appeal is filed by an adversely affected party, this uncertainty can extend for a further period of two years or more, until the appeal process is complete.

Filing an opposition

Time limit

An opposition must be filed within nine months of the official date of grant of the European patent, and the opposition fee must be paid by the same date. No extensions are possible to the deadline for filing an opposition, and the EPO's ten day postal rule does not apply.

Who can oppose?

Any natural or legal person (other than the owner of the patent being opposed) may file an opposition to a granted European patent. More than one opposition may be filed against the same patent by more than one person, and opponents may file either jointly using a common representative or separately. It is possible for a firm of patent attorneys to file an opposition in their name to keep the identity of the opponent a secret.

The status as an opponent cannot be freely transferred, i.e., oppositions cannot easily be bought and sold. As far as legal persons are concerned, the opposition can only be transferred or assigned to a third party together with the business assets in the interests of which the opposition was filed.

Grounds for opposition

An opposition must be filed including a statement of the grounds on which the patent is opposed. There are a limited number of grounds on which a European patent can be opposed. These are:

- that the subject-matter of the patent is not patentable, i.e., is lacking novelty, inventive step, industrial application or relates to excluded subject matter
- that the invention is not sufficiently described to allow a person skilled in the art to carry out the invention
- that the subject matter of the patent extends beyond the content of the application as filed

When opposing a patent it is important to set out as full a case as possible at the outset, indicating all relevant facts, evidence and arguments. If a ground of opposition is not mentioned and substantiated at the outset, it may not be possible to introduce it later on during the proceedings.

Opposition procedure

Admissibility

Before starting substantive examination of the grounds for opposition, the opposition division will examine whether the opposition has been validly filed, i.e., whether it is admissible. If the opposition is found inadmissible (E.g., because the fee was not paid on time, or because the opponent was not unambiguously identified), it is rejected.

Inadmissible oppositions are still forwarded to the patent proprietor for their information, but are not substantively examined by the EPO, and the procedure ends at that point with a decision (which can be appealed).

Arguments

If the opposition found to be admissible, the patent proprietor is set a deadline (usually four months) for submitting arguments and amendments (if required) in response to the opposition. Only amendments that respond directly to a ground of opposition are allowed. As usual, added matter is not permitted. Claim broadening is also not allowed, even if necessary to address a ground of opposition. For example, if a feature present in claim 1 is alleged to add matter, it cannot be deleted in response if doing so would broaden the scope of the claim.

Once the patent proprietor's reply is received, the grounds for opposition are substantively examined by the EPO. The EPO will then issue a preliminary opinion in which (usually) they will invite further comments from one or both parties. Once any such additional comments are received (or the deadline has expired), the next step will usually be a hearing at the EPO, assuming that oral proceedings have been requested by at least one party.

Defending against an opposition as patent proprietor

If an opposition is filed against your patent there is no obligation on you, as patent proprietor, to reply to the opponent's arguments if you do not wish to do so. However, it is worth noting that the EPO will still examine the merits of every admissible opposition anyway, regardless of whether you reply to the opponent's arguments or not.

Failure to submit a response that strongly refutes the opponent's arguments comes with the risk that the EPO might reach a summary judgement in favour of the opponent. For this reason we find that patent proprietors tend to respond to oppositions as a matter of routine, even if the opponent's case appears very strong, and even if they have little interest in the ultimate fate of their patent.

Statistics

Overall, about 5% of patents granted by the EPO are opposed. Of those, about one third are revoked, one third are maintained in an amended, i.e., limited, form (since the scope of a European patent cannot be broadened after grant), and one third are maintained as granted, i.e., the opposition is rejected entirely.

Some estimated opposition costs

If you are the opponent, most of the cost of filing an opposition will be in professional time for preparing the notice of opposition, including the grounds on which the patent is to be opposed. If you are the proprietor, most of the cost of an opposition will be in professional time in reviewing the notice of opposition and formulating arguments in reply. The overall costs will depend on a number of factors such as: the length and complexity of the patent, including the number of claims on file; the number of documents to be analysed; and the extent to which the representative is being asked to carry out work in deciding how to oppose the patent, as opposed to being instructed based on detailed arguments that have already been prepared.

To a large extent each side of an opposition must bear its own costs. However, in certain limited circumstances such as an abuse of procedure, an apportionment of costs may be made by the opposition division, but only if requested before a final decision is made.

Annual renewal fees are still payable on the individual granted national patents during an opposition process. If the patent is amended as a result of an opposition a procedure similar to that following a notice of allowance before grant is followed to implement the amendments in each designated state.

Typical costs for filing an opposition are:

- Preparing and filing a notice of opposition: £4,000 to £15,000, depending in part on how much work is required in preparing the arguments, and how much is already prepared. £5,000 is a typical figure if the issues are straightforward and we are given a few documents to use. If searching is required to locate appropriate prior art, the cost could be significantly higher.
- Reviewing the patentee's observations (around 6 months after filing): £2,000 to £5,000, depending on how extensive the observations are. Around £3,000 is typical
- Reviewing and preparing further submissions or observations (around 4-6 months later): typically £4,000 to £10,000. These costs may range from zero, if no further observations are requested by the OD, to around £10,000 if a detailed analysis and rebuttal is required
- Preparing for oral proceedings (approx. 6 months later): £2,000 to £10,000. If oral proceedings are requested, written submissions may be filed prior to the proceedings taking place, typically in response to a preliminary view by the OD being sent to both parties. £5,000 is typical

- Attending oral proceedings (1-2 months later): £3,000 to £10,000. This includes preparation beforehand, travel and attending the proceedings at the EPO (typically for one day; proceedings rarely last longer). £4,500 is typical
- Overall, the total cost for a typical opposition procedure will amount to around £10,000 – £40,000, with a typical figure being £15,000 to £20,000, spread out over about 2 years

Typical costs for defending against an opposition are:

In the case of a proprietor defending a patent against an opposition, the above costs will be largely similar overall, although with no costs relating to preparation of the opposition (because they are the patentee) and with a higher amount relating to reviewing and responding to the notice of opposition, which will usually include reviewing new prior art and preparing amendments with fall-back positions where appropriate.

Typically, it could cost £2,000 to £5,000 to review the notice of opposition and comment on the strength and weaknesses, and £5,000 to £10,000 to file a response to the opponent, including drafting several auxiliary request fall-back positions.

Appeals during opposition

Any party adversely affected by a decision may appeal. This means that in situations where the patent is maintained in amended form, both parties are entitled to appeal against the decision. If only one party appeals (E.g., the opponent), then the other party will be automatically joined in the appeal proceedings and will be entitled to respond to the arguments put forward by the appealing party. However, where the patentee is the non-appealing party, the patentee will not be permitted to make amendments to the claims during appeal that would put them in a better position than before the appeal was filed.

See below for a simplified guide to the procedures outlined above.

What next?

If you would like more information, then please get in touch.

You can email us info@barkerbrettell.co.uk or call us on **+44 (0)121 456 0000**.

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Events

Timescale

