

OPPOSITIONS DIRECTED TO A PART OF A PATENT



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The purpose of opposition proceedings before the European Patent Office (EPO) is to give an opponent, which can be any member of the public, the opportunity to challenge the validity of a granted European patent.

Opposition to a European patent is a relatively cheap and quick way to clear the path to market in the face of invalid or dubious patent rights, and is an opportunity to revoke a European patent centrally. It has finality, in that a decision appealed to the EPO Boards of Appeal under normal circumstances cannot be appealed further.

When an opposition is filed, the opponent has to specify the extent to which the European patent is opposed, and the grounds on which the opposition is based, as well as indicating the facts and evidence presented in support of these grounds. This is considered to be of particular importance in that it gives the patentee a fair chance to consider its position at an early stage of the proceedings.

It is normal for an opposition to be filed against the patent as a whole, but even though in practice it is rather unusual that an opposition is limited to only a certain part (claims) of the patent, this possibility can be used by the opponent. This can be due to the fact that some of the claims are directed to embodiments for which no prior art can be found, which has no relevance for the opponent, since these claims potentially cannot be infringed by the opponent's technology, or simply as a manner of reducing costs in the opposition proceedings.

However, it must be stressed that if the opponent does not specifically request that the patent is revoked in its entirety, and if this is not implicitly disclosed in the opposition, the opponents cannot later extend the opposition to additional subject matter (claims).

It follows that a patent office cannot take any action in respect of a granted patent, however clear it may have become after grant that the patent is invalid, unless initiated by an admissible opposition. If no opposition is filed, the patent can be attacked only in revocation proceedings before a national court. In other words: the competence of a patent office to deal with the patent depends on the action taken by the opponent.

The EPO's competence in dealing with subject matter not explicitly opposed was discussed by the Enlarged Board of Appeal in G9/91.

In this respect the Enlarged Board of Appeal stated that the European Patent Convention (EPC's) requirement to specify the extent to which the patent is opposed within the nine-month time limit would obviously be pointless, if other parts of the patent could freely be drawn into the proceedings later. This would also be contrary to the basic concept of post-grant opposition under the EPC. By limiting the extent to which the patent is opposed to only certain subject matter, the opponent can deliberately refrain from making use of its right under

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the EPC to oppose the remaining subject matter covered by the patent. Such subject matter is therefore, strictly speaking, not subject to any 'opposition', nor are there any 'proceedings' in the sense of EPO Articles 114 EPC (examination by the EPO of its own motion) and 115 EPC (observations by third parties) in existence concerning such non-opposed subject matter. Consequently, the EPO has no competence to deal with them at all.

However, even if the opposition is explicitly directed only to the subject matter of an independent claim of a European patent, the Enlarged Board of Appeal states specifically in G9/91 that subject matter covered by claims which depend on an independent claim which falls in opposition or appeal proceedings, may also be examined as to patentability, provided the validity of the depending claims are *prima facie* in doubt on the basis of already available information.

Amendments to the claims or other parts of a patent in the course of opposition or appeal proceedings still have to be fully examined for their compatibility with the requirements of the EPC (eg, with regard to the provisions of Articles 84 EPC and 123 EPC).

Directing an opposition to only part of the granted patent can in some situations be used strategically. Care must be taken, however, if other parts of the patent later become relevant for the opponent. ■

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