

THE DOCKETING EXCELLENCE WEBINAR SERIES



Black Hills IP

SLW INSTITUTE
Building Extraordinary IP Assets

European Patent Office (EPO) Opposition Docketing

EPO Opposition Docketing

- **Presenters:**

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- Linda Swanson, Retired Foreign Filing Paralegal, Schwegman, Lundberg & Woessner, P.A.

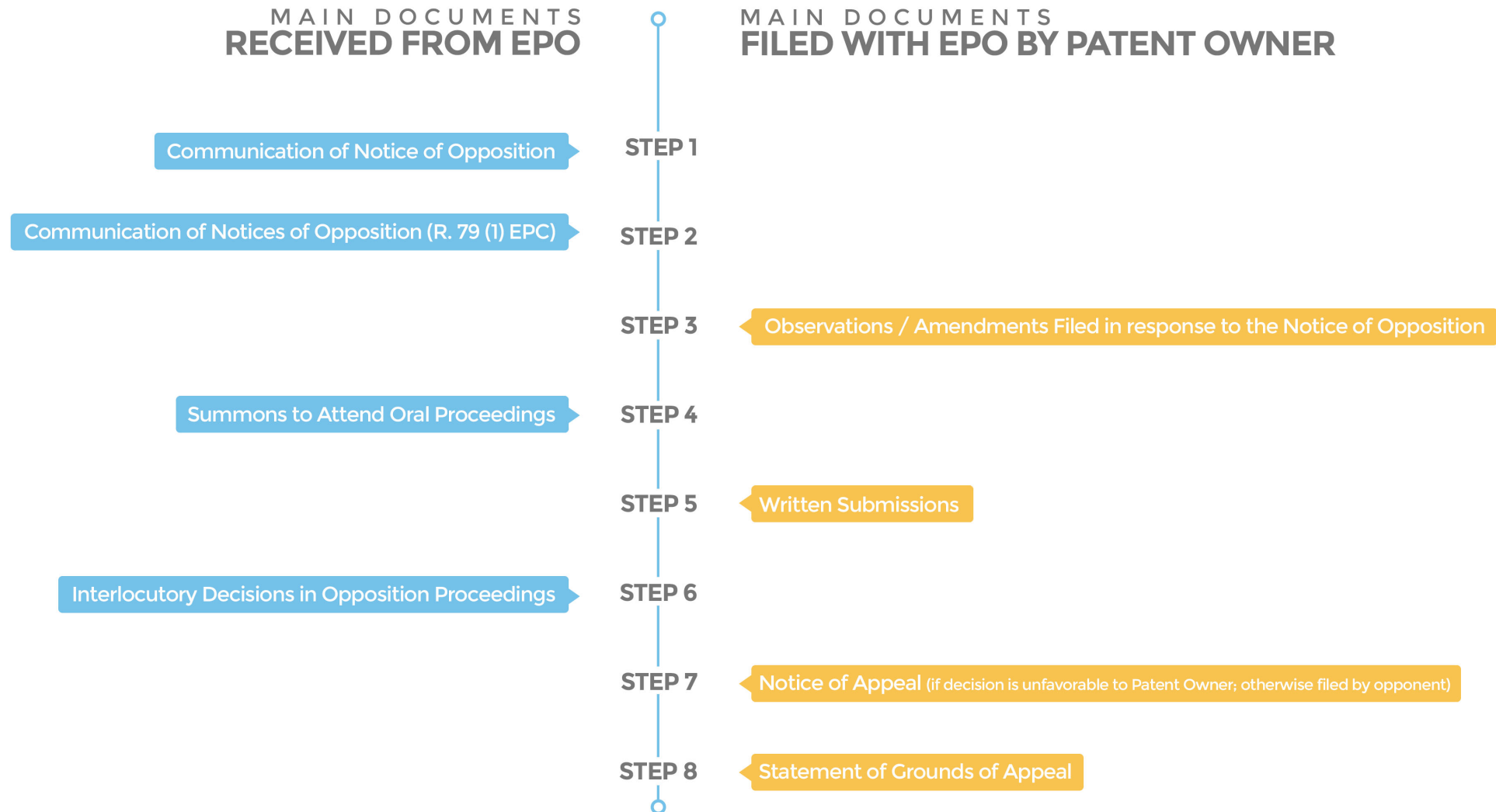
Topics

- Filing of an Opposition
- Opposition Division Proceedings
- Board of Appeal Proceedings
- Enlarged Board of Appeal (very limited procedural option)
- Patent Maintained in Amended Form

Filing an Opposition

- An opposition can be filed within 9 months of the grant of a patent (grant is the publication of the notice of grant)
- If you are acting for the opponent, the date needs to be docketed
 - Notice of opposition
 - Grounds of opposition
 - Novelty and inventive step
 - Non-statutory subject matter
 - Added subject matter
 - Non-enabling disclosure
- How to docket?
 - Docket Task: 9 months from the grant date for the notice and grounds of opposition **if Opponent**
 - No action needed **if Patent Owner**

Opposition Division Proceeding Overview



Opposition Division Proceedings

- **Communication of Notice of Opposition**
 - This is the initial notice to the Patent Owner from the EPO.
 - Notifies the Patent Owner that a Notice of Opposition has been filed if the correct formalities have been met
 - Contains the details of the the opposition.
- **How to docket?**
 - Docket Task: Does not have a due date for responding
 - Recommend adding a reminder to monitor for receipt of (R.79(1) EPC) communication
 - EPO will issue a further communication setting a deadline for the patent owner to respond after the Notice of Opposition has been examined for formalities

Communication of Notice of Opposition (Excerpt)

Communication of a notice of opposition

You are hereby informed of a notice of opposition to the European patent specified above (see attached copy in the enclosure). The documents specified as patent documents in the notice of opposition are available for inspection via the European Patent Register at www.epo.org/register. Should you wish to receive these documents in paper format, they will be supplied to you free of charge if specifically requested on receipt of this communication (see OJ EPO 2009, 434).

If oral proceedings are to take place, parties are advised to check the electronic file via European Patent Register in advance of the hearing to ensure they are in possession of all relevant documents.

An invitation to file observations and to file amendments, where appropriate, to the description, claims and drawings (R. 79(1) EPC) will be issued separately.

The period within which such observations may be filed will not be fixed until the following conditions are met:

- (a) the opposition period has expired;
- (b) the notice of opposition has been examined for certain formal requirements (R. 77 EPC).

For the Opposition Division

Opposition Division Proceedings

- Communication of Notices of Opposition (R.79(1) EPC)
 - This is the second notice to the Patent Owner from the EPO.
 - Form looks very similar to the first notice, but has an invitation to file observations and amendments.
- How to docket?
 - Example Docket Entry: “Observations – Due” if **Patent Owner**
 - Deadline is 4 months from the notification of the communication
 - 10-day rule applies (because it is from the “notification” of the communication)
- Extensions Available?
 - 2-month extension may be requested

Communication of Notices of Opposition (R.79(1) EPC) (Excerpt)

Communication of notices of opposition (R. 79(1) EPC)

Notice of opposition has been filed within the opposition period by:

01. GN ReSound A/S / Widex A/S / Oticon A/S/Lautrupbjerg 7 / Nymollevvej 6 / Kongebakken 9/2750 Ballerup / 3540 Lyngby / 2765 Smorum/DANEMARK//

The notice of opposition indicated above has already been communicated to you.

You are requested to file your observations within a period of **four months from notification of this communication.**

You may also file amendments, where appropriate, to the description, claims and drawings within the period specified. One set of these documents is to be filed.

If you introduced documents which have not yet been mentioned during the proceedings, your attention is drawn to Rule 83 EPC.

Enclosures:

For the Opposition Division

Opposition Division Proceedings

- The Opposition Division sends a communication to the Opponent to enable the Opponent to comment on the observations and amendments filed by the Patent Owner
- How to docket?
 - Example Docket Entry: “Observations – Due” if **Opponent**
 - Deadline is 4 months from the notification of the communication
 - 10-day rule applies (because it is from the “notification” of the communication)
- Extensions Available?
 - 2-month extension may be requested

Opposition Division Proceedings

- **Summons to Attend Oral Proceedings Pursuant to Rule 115(1) EPC**
 - This is notice from the EPO with the scheduling details for the Oral Proceeding.
 - The oral proceeding is a hearing in front of the Opposition Division.
 - The Summons may include a preliminary, non-binding opinion of the opposition division.
- **How to docket?**
 - Example Docket Entry: “Oral Proceedings”
 - Date and time for Oral Proceeding are listed in this document.
 - Example Docket Entry: “Written Submission/Documents – Due”
 - Deadline for final written submissions and/or arguments (R. 116 EPC) are also listed in this document.
 - Deadline is usually 1 to 2 months before date of the Oral Proceeding.
- **Extensions available?**
 - Date of the oral proceeding is NOT extendable.

Summons to Attend Oral Proceedings Pursuant to Rule 115(1) EPC -- (Excerpt)

Summons to attend oral proceedings pursuant to Rule 115(1) EPC

You are hereby summoned to attend oral proceedings arranged in connection with the above-mentioned European patent.

The matters to be discussed are set out in the communication accompanying this summons (EPO Form 2906).

The oral proceedings, which will be public, will take place before the opposition division

on 13.11.14 at 09.00 hrs in Room 1660 at the EPO,
Grasserstr. 2, PschorrHöfe, D-80335 München

No changes to the date of the oral proceedings can be made, except on serious grounds (see OJ EPO 1/2009, 68). If you do not appear as summoned, the oral proceedings may continue without you (R. 115(2) EPC).

Your attention is drawn to Rule 4 EPC, regarding the language of the oral proceedings, and to the Special edition No. 3 OJ EPO 2007, 128, concerning the filing of authorisations for company employees and lawyers acting as representatives before the EPO.

The final date for making written submissions and/or amendments (R. 116 EPC) is 13.10.14.

You are requested to report in good time beforehand to the porter in the EPO foyer. Room 1601 and 1657 are available as waiting rooms.

Opposition Division Proceeding

- Interlocutory Decision in Opposition Proceedings (Art. 101(3)(a) and 106(2) EPC)
 - This is the written decision of the Opposition Division.
 - This is an decision that is appealable by either the Patent Owner or the Opponent
- How to docket?
 - Example Docket Entry: “Notice of Appeal – Due”
 - Deadline is 2 months from the notification of the decision.
 - 10-day rule applies (because it is from the “notification” of the communication)
 - Example Docket Entry: “Statement of Grounds of Appeal – Due”
 - Deadline is 4 months from the notification of the decision.
 - 10 day rule applies (because it is from the “notification” of the communication)
- Extensions available?
 - Both deadlines are NOT extendable.

Interlocutory Decision in Opposition Proceedings (Art. 101(3)(a) and 106(2) EPC) – (Excerpt)

Interlocutory decision in Opposition proceedings (Art. 101(3)(a) and 106(2) EPC)

The Opposition Division - at the oral proceedings dated 13.11.2014 - has decided:

Account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates are found to meet the requirements of the Convention.

The reasons for the decision are enclosed.

Documents for the maintenance of the patent as amended:

Main request

Description, Pages

2-13 of the patent specification

Claims, Numbers

1-37 filed during Oral proceedings on 13-11-2014

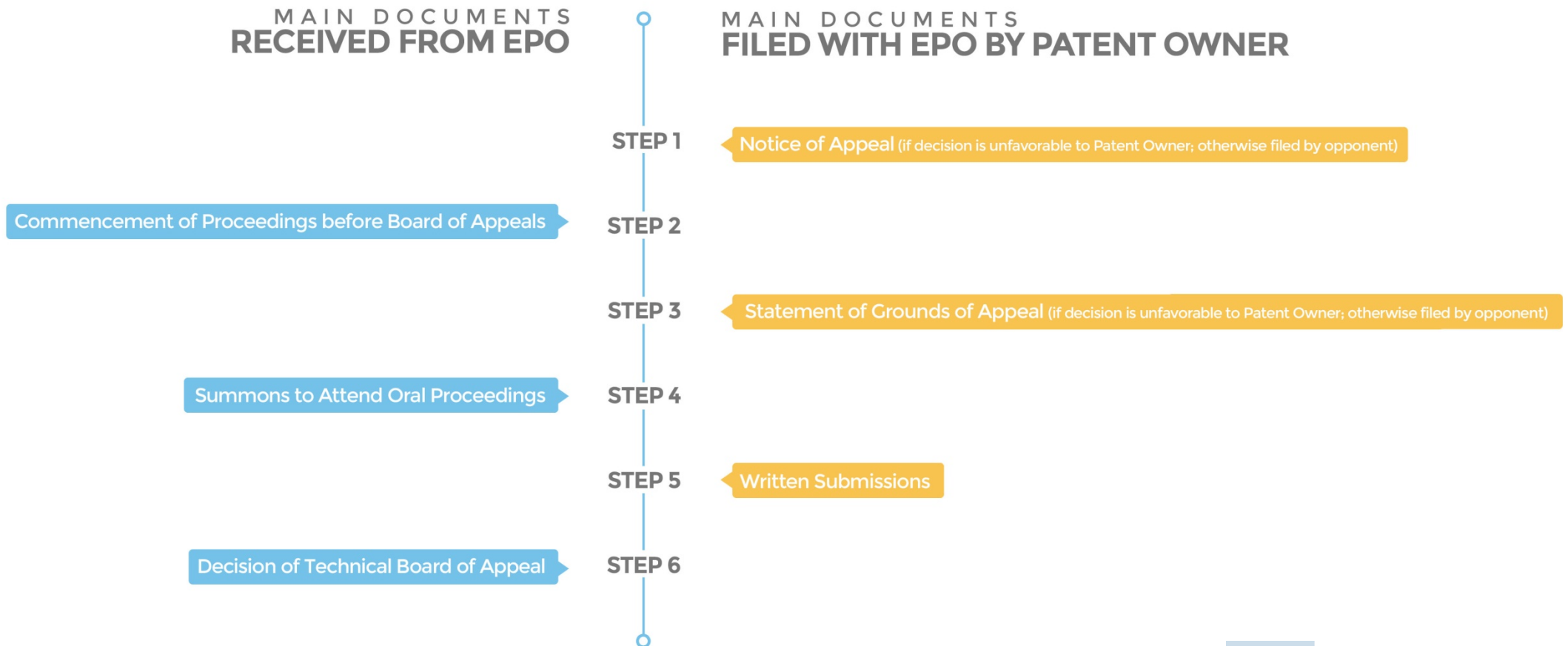
Drawings, Figures

1-20 of the patent specification

Possibility of appeal

This decision is open to appeal according to Article 106(2) EPC. Attention is drawn to the attached text of Articles 106 to 108 and Rules 97 to 98 EPC.

Board of Appeal Overview



Board of Appeal Proceedings

- **Commencement of Proceedings before the Board of Appeal**
 - This is a notice to the Patent Owner or Opponent from the EPO.
 - Notifies the Patent Owner or Opponent that an Appeal has been filed by the Opponent or Patent Owner.
 - The notice is only sent if the appeal meets the formalities (fee paid, notice and grounds filed in time)
- **How to docket?**
 - No docket entry at this time

Commencement of Proceedings before the Board of Appeal (Excerpt)

Commencement of proceedings before the Board of Appeal

The letter dated 17.03.15 filed by the opponent

against the decision of the European Patent Office of 07.01.15
has been referred to Board of Appeal 3503.

The reference number is mentioned above.

Any further communications should be addressed to Directorate-General 3 of the European Patent Office and should quote this reference number.

Board of Appeal Proceedings

- The Board of Appeal send a communication to the non appealing party to enable the non appealing party to comment on the grounds of appeal
- How to docket?
 - Example Docket Entry: “Observations – Due”
 - Deadline is 4 months from the notification of the communication
 - 10-day rule applies (because it is from the “notification” of the communication)
- Extensions Available?
 - 2-month extension may be requested

Board of Appeal Proceedings

- The Board of Appeal send a communication to the Appellant to enable the Appellant to comment on the observations and amendments file by the non appealing party
- How to docket?
 - Example Docket Entry: “Observations – Due”
 - Deadline is 4 months from the notification of the communication
 - 10-day rule applies (because it is from the “notification” of the communication)
- Extensions Available?
 - 2-month extension may be requested

Board of Appeal Proceedings

- **Summons to Attend Oral Proceedings Pursuant to Rule 115(1) EPC**
 - This is notice from the EPO with the scheduling details for the Oral Proceedings concerning the appeal.
 - The Summons may include a preliminary, non-binding opinion of the Appeal Board.
- **How to docket?**
 - Example Docket Entry: “Oral Proceedings ”
 - Date and time for Oral Proceeding are listed in this document.
 - Example Docket Entry: “Written Submission/Documents – Due”
 - If further written submissions are permitted, the deadline will be also listed in this document.
 - Deadline is usually 1 to 2 months before date of the Oral Proceeding.
- **Extensions available?**
 - Date of the oral proceeding is NOT extendable.

Board of Appeal

- Decision of the Technical Board of Appeal
 - This is the written decision of the of the Board of Appeal.
 - This decision is NOT appealable.

Enlarged Board of Appeal

- **Petition for Review by Enlarged Board of Appeal**
 - Very limited option available under Article EPC 112a.
 - Petition for review on the grounds that there was a procedural defect in the conduct of the appeal or that a criminal act in relation to the appeal occurred.
- **How to docket?**
 - Example Docket Entry: “Deadline to File Petition”
 - Deadline to file is 2 months from the Decision on the Technical Board of Appeal.

Patent Maintained in Amended Form

- Communication Pursuant to Rule 82(2) EPC
 - Received when the appeal decision maintains the patent in amended form or the opposition division maintains the patent in amended form and no appeal is filed.
 - EPO Publication fee and translations of the claims into FR and DE are due
- How to docket?
 - Example Docket Entry: “EPO Publication Fee / Translations – Due”
 - Deadline is 3-months from notification of this communication.
 - 10-day rule applies (because it is from the “notification” of the communication)

Communication pursuant to Rule 82(2) EPC(Excerpt)

Communication pursuant to Rule 82(2) EPC

You are hereby informed that

- ☐ with the appeal decision of the matter was remitted to the Opposition Division for maintenance of the patent as amended. A complete copy of the documents is attached hereto.
- ☐ the interlocutory decision by the Opposition Division of , on the amended form in which the European patent can be maintained has become final.

To enable the patent to be maintained in the amended form communicated the patent proprietor(s) is (are) requested within a period of **three months** of notification of this communication

1. to pay the fee for the publication of a new specification of the European patent; this fee is set out below:
EUR 75,00
2. to file translations of the mentioned claims in the two other official languages of the European Patent Office.

If the acts are not performed in full in due time they may still be validly performed within two months of notification of a communication pointing out the deficiencies, provided that within this two-months period, in addition to the omitted act(s) being completed, a surcharge of 120 Euro is paid (Art. 2(9) RFees, R. 82(3) EPC).

If the request pursuant to Rule 82(2) EPC is not met and full use or use in due time is not made of the aforementioned possibility, the European patent will be revoked (R. 82(3) EPC).

The designated Contracting States, the title of the invention in the three official languages of the European Patent Office, the international patent classification and the patent proprietor are set out in the attached EPO Form 2356.

After publication, the new European patent specification can be downloaded free of charge from the EPO publication server <https://data.epo.org/publication-server/> (OJ EPO 2005, 126).

Communication pursuant to Rule 82(2) EPC(Excerpt)

Until 31 December 2013, each proprietor may request in writing to receive the certificate for the European patent as maintained in amended form together with one copy of the new patent specification only if the request is filed within the time limit of Rule 82(2) or (3) EPC. If such request has been previously filed, it has to be confirmed within the same period. The requested copy is free of charge. Any request or confirmation of a request filed after 31 December 2013 or after expiry of the Rule 82(2) or (3) time limit will not be dealt with and the certificate will be delivered without a copy of the new patent specification (cf. Notice from the European Patent Office dated 16 July 2013 concerning communication of the certificate for a European patent, OJ 2013, 418).

Filing of translations in the Contracting States

As regards translation requirements prescribed by the Contracting States under Article 65(1) EPC, please consult the website of the European Patent Office
www.epo.org > Patents > Law > Legal texts > National law relating to the EPC
www.epo.org > Patents > Law > Legal texts > London Agreement

In case of a valid extension or validation

As regards translation requirements prescribed by the Extension or Validation States, please consult the website of the European Patent Office
www.epo.org > Patents > Law > Legal texts > National law relating to the EPC

Failure to supply a prescribed translation in a Contracting State, or in an Extension or Validation State may result in the patent being deemed to be void ab initio in the State concerned (Art. 65(3) EPC).

The date on which the European Patent Bulletin publishes the mention of the decision on the opposition will be indicated in the decision on the maintenance of the European patent (EPO Form 2329).

Note to users of the automatic debiting procedure

Unless the EPO receives prior instructions to the contrary, the fee(s) will be debited on the last day of the period for payment. For earlier payment(s) another method of payment must be used. For further details see the Arrangements for the automatic debiting procedure (supplementary publication 3 - OJ EPO 2015).

Important information concerning fee amounts

Following any amendment to the Rules relating to Fees, the amount(s) mentioned in this communication may be different from the amount(s) **actually due on the date of payment**. The latest version of the Schedule of fees and expenses, published as a Supplement to the Official Journal of the EPO, is also available on the EPO website (www.epo.org) and can be found under www.epo.org/schedule-of-fees, which allows the viewing, downloading and searching for individual fee amounts, both current and previous.

Please note that procedural fees are usually adjusted every two years, on even years, with effect from 1 April.

Payments by cheque delivered or sent direct to the EPO are no longer accepted as from 1 April 2008 (see OJ EPO 2007, 626).

Patent Maintained in Amended Form

- Patent Owner must also re-validate the amended patent in countries that were designated in the original patent if they want protection in those countries.
- How to docket?
 - The deadline for revalidating is 3 months from the date of the re-publication of the granted patent
- Extensions available?
 - NOT extendable.

Patent Maintained in Amended Form (Excerpt)

Decision to maintain the European patent in amended form (Art. 101(3)(a) EPC)

European Patent No. :
Filing date :
Priority claimed :
Designated States and
Patent proprietor(s) :

is maintained as amended.

Maintenance is based on the documents as specified and notified previously.

The announcement that the European patent is being maintained as amended will be published in the European Patent Bulletin / on .

Your attention is drawn to the communication of , regarding the requirements and time limits for submitting translations of the new European Patent Specification in the designated Contracting States.

Opposition division

1st Examiner:

2nd Examiner:

Chairman:

Questions

- Questions on Today's Program
 - Please submitted your questions using the Q&A button on the control bar on your screen.
- If you have questions regarding Black Hills IP's services or processes, please contact:
Jim Brophy
Ph. 612-867-4018
jbrophy@blackhillsip.com

The Docketing Excellence Webinar Series

Please join us for our next presentation:

Best Practices for Efficient Docketing of Routine Formalities
such as Powers of Attorney and Declarations of Inventors

May 24, 2017 at 1:00 PM Central