



HOLLY IP

Tips for Success in EPO Opposition

1. Oppositions often succeed and so this is a very effective method of challenging European patents. A third of oppositions end with the patent being revoked, a third end with the patent being amended and in a third of cases the patent is maintained as granted.
2. Be tactical in choosing the opposition attacks. Do not be too ambitious in using too many weak attacks. However also be open-minded as to what will work. The opposition division will not have the same perspective as you and so do not over-focus on what you think the strongest attack is.
3. A lot of the time the opposition is decided on whether the opponent has shown that the patent is invalid. The opposition division will rarely do your work for you, and so they are more likely to decide on the basis of the arguments and evidence in front of them, rather than seeking to make an objectively correct judgement. Your evidence and arguments should therefore be as complete and as comprehensive as possible.
4. You can file broad arguments as to why the patentee does not deserve the patent based on contribution made, but the EPO essentially works on precise arguments based on specific grounds for revocation and so that should form the structure of the opposition.
5. Try to open up all grounds of attack in the initial opposition.
6. Added matter can be a surprisingly effective ground for attack. Look at added matter in a very strict way to identify all possible attacks.
7. For novelty attacks try to identify implicit features in prior art documents. Novelty attacks are often overlooked as some of the features may be buried deep within the details of a publication.
8. Choose the closest prior art and technical problem being solved very carefully. Opposition divisions often use the problem/solution approach as the basis of looking at inventive step.
9. Do not be tempted to use an inventive step attack based on the problem not being solved if this undermines prior art based inventive step attacks. The latter are more likely to work.
10. In biotech one often finds oneself in the situation of the claim either lacking inventive step or lacking sufficiency because of the nature of the contribution being made. This should be pointed out where it arises, but the EPO will often look at each ground in isolation, and so one must be prepared to argue each ground in that way.
11. Try to predict likely amendments that the patentee could make and be prepared with arguments to attack the amended claims.