

OPPOSING A EUROPEAN PATENT AFTER EXPIRY OF THE OPPOSITION PERIOD



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In some special cases it is possible to oppose a granted European patent even after expiry of the opposition period.

Article 105EPC provides a means for an alleged infringer to intervene in pending opposition proceedings before the European Patent Office (EPO) against a granted European patent provided the alleged infringer can prove that:

- (a) Proceedings for infringement of the same European patent have been instituted against him; or
- (b) Following a request of the proprietor of the European Patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent.

It is however important that the intervention is filed in accordance with the Implementing Regulations of the EPC. The notice of intervention shall be filed and the official fee be paid within three months of the date on which any of the above proceedings are instituted to be deemed admissible. The requirement of the form and content of the notice of intervention corresponds to those of a notice of an opposition.

Accordingly the notice of intervention must clearly identify the European patent in question, the opponent, and include a written reasoned statement naming the grounds on which the intervention opposition is based, as well as an indication of the facts and evidence presented in support of these grounds. It should be noted that new grounds can be raised. Thus the intervention opposition is not restricted by the grounds already raised in the pending oppositions. If the intervention is deemed admissible it is treated as an opposition and opposition proceedings continues with the further opponent.

In case G 3/04 the Enlarged Board of Appeal came to the conclusion that a valid intervener acquired the status of an opponent only, irrespective of whether the intervention occurred during the proceedings before the opposition division or at the appeal stage, and that his rights and obligations were the same as those of other opponents. So an intervener in proceedings before the opposition division, where all the opponents had withdrawn their oppositions, can still continue the opposition proceedings alone and even file an appeal.

Intervention opposition can be filed during pending opposition appeal proceedings, in which case the appeal fee normally needs to be paid too. Care should however be taken to make arrangement that the sole appeal is not withdrawn because the proceedings cannot be continued with a third party who intervened during the appeal proceedings, as if he intervened during opposition proceedings. If the precise time of day at which the EPO receives notice of withdrawal of appeal can be established, then withdrawal is effective from that moment.

“WHEN THE UNITARY PATENT COMES INTO FORCE THE INTENTION IS THAT ALL PENDING APPLICATIONS AND GRANTED EUROPEAN PATENTS AND UNITARY PATENTS ARE SUBJECT TO A NEW UNIFORM PATENT LITIGATION SYSTEM.”

If the sole appellant's notice of withdrawal of appeal and a notice of intervention are filed by fax on the same day, the chronological order in which they arrive will be taken into account, because for a notice of intervention to be valid the appeal proceedings must be pending when it is filed (T0517/97).

The possibility of intervening in opposition proceedings offers the alleged infringer a centralised procedure for potential revocation of an already opposed European patent in question. If no opposition is pending the alleged infringer may be left with time-consuming and expensive national proceedings in each relevant contracting state.

When the Unitary Patent comes into force the intention is that all pending applications and granted European patents and Unitary Patents are subject to a new uniform patent litigation system, in which proceedings and lawsuits must be made before a Unified Patent Court. However a transitional rule enables European patent proprietors and applicants to use the present European patent opposition system during a transitional period of seven years after the date of entry into force of the Agreement on the Unitary Patent, and actions relating to infringement or revocation may still be brought before national courts.

If consultations and surveys carried out two years before expiry of the seven-year transitional period reveal that owners still favour the old system and not the new system, the agreement includes an option to prolong the transitional period to 14 years.

It will be interesting to follow the preferences of patent proprietors and applicants to the old and the new systems. ■

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