

EPO OPPOSITION PROCEDUREUNICE COMMENTS**I. INTRODUCTORY REMARKS**

UNICE would like to recall that the purpose of patents is to support innovation by conferring a time-limited exclusive right on new, non-obvious, industrially applicable inventions. Patents play a key role for European companies and their competitiveness. If the degree of protection afforded is too low, investment in innovation may be stifled. If it is excessive, competition is impeded without justification. Therefore the system depends on a balance of between these interests.

In Europe means are provided to challenge clearly invalid patents by opposition proceedings. Oppositions provide benefits for industry if they work properly: they protect the public from invalid patents, create legal certainty and give third parties the opportunity to challenge patents believed to be invalid. But oppositions must be expeditious, fair to both parties and quickly provide considered final decisions at low cost. The timeframe for bringing a dispute to an end must not be too long and terms for filing evidence and arguments must be adhered to as strictly as possible.

II. ASSESSMENT OF EPO OPPOSITION PROCEEDINGS

In its comments on the Commission's green paper on the Community patent and the patent system in Europe [Com (97) 314 final], UNICE called for improvement of the EPO opposition proceedings. In UNICE's view, the existing EPO opposition proceedings are far too lengthy and can unreasonably prejudice the position of either of the parties. They should therefore be thoroughly reviewed.

When the EPO started functioning there was a conscious effort to make opposition proceedings expeditious. A strict timetable was laid down (see Official Journal EPO 1989, 417). Unfortunately this has not proved efficient and the original intentions have not been properly applied and enforced. Almost any late submissions (i.e. filed after the time allowed by the rules including any extensions) are admitted to the file by the opposition divisions up to the deadline now specified under Rule 71a, and often a long period elapses after the last filing of submissions before a date is set for oral proceedings.

To make opposition proceedings fair to both parties and efficient, UNICE believes that seemingly endless replies to replies must be cut short by prompt setting of a date for oral proceedings and the latter must be thoroughly prepared without last-minute surprises. The due process of law provisions of article 113 and 114 EPC and Rule 71a must be fully respected. Furthermore valuable Europe-wide rights must not be put at risk of revocation except where the opponent has proved all necessary matters to the satisfaction of the tribunal on the usual civil law basis of balance of

probabilities.

III. THE MAIN PROBLEMS WITH EPO OPPOSITION PROCEEDINGS

1. Insufficient control of the proceedings. The basic procedure is correct, but for years the opposition divisions have failed to control multiple responses, which encourages yet more arguments, evidence and often a new opposition case. Delay can be caused by either party, although usually only one of them initiates it. Now that Rule 71a has been promulgated the procedure needs scrutiny for the effectiveness of this rule. Furthermore UNICE notes that in some cases the Boards of Appeal do not firmly prevent tendentious and tactical late submissions. At least a rule similar to Rule 71a should also be introduced into the Appeal proceedings.
2. Inadequate attention to burden of proof. An advocate's bare assertions are not evidence and have to be substantiated. An opponent must prove his grounds of attack and must prove his assertions with evidence to show they are clearly correct. But opposition divisions have in some instances accepted such assertions as true. An apparent willingness of the EPO to accept unsubstantiated assertions, the fact that there is no testing thereof by cross-examination and the lack of a further appeal poses a serious problem. If the EPO fails to dismiss unproven opposition cases or accepts patentability based on unproved assertions, parties are encouraged to make such assertions. Such a tendency is an unjust risk for the parties in exchange for a misplaced effort to be "fair".
3. Lack of experience by the members of the opposition divisions and unacceptable slowness by the EPO. There appears to be a lack of proper training in quasi-judicial functions for members of the opposition divisions. The correct evaluation of evidence and arguments put forward by the parties depends on the education, experience and skill of the opposition division members.
4. The parties are given inadequate guidance by the Boards of Appeal about points to be discussed at oral proceedings. This creates unfairness for both parties and again indicates the need for a rule similar to rule 71a in appeal proceedings.
5. The patentee should be allowed to amend his claims during hearings where the amendments are reasonably foreseeable, meet the grounds of the opposition, do not delay the decision and do not in effect create the need for a new opposition. The patentee should not be forced to file numerous sets of auxiliary claims in advance.
6. Decisions must not necessarily be taken orally at the end of oral proceedings and must not be taken hastily. While in appropriate cases they can be given orally, UNICE is of the opinion that, if the case is complicated, judgement should be reserved. UNICE suggests that minutes of the proceedings are distributed to the parties within two weeks of the proceedings and a considered written decision about a month later.
7. There is a tendency for the opposition divisions and the Boards of Appeal not to deal with all the grounds of opposition. Although there might be exceptional cases where separate treatment of sufficiency, novelty and inventive step might save time and effort, the opposition divisions and Boards of Appeal should, as a matter of principle, decide all patentability issues in one proceeding. To treat sufficiency, novelty and inventive step separately at different hearings can be a serious waste of time and resources for the parties.

IV. CONCLUDING REMARKS

UNICE is of the firm opinion that opposition proceedings can be rendered just and efficient only by insisting on a tight timeframe for the procedure, proper and thorough preparations for any oral proceedings, and scrupulous attention to evidence and proof.

In addition UNICE insists that the due process of law provisions of articles 113 and 114 EPC and Rule 71a must be fully respected.

Valuable Europe-wide rights must not be put at risk of revocation by unsubstantiated evidence. In UNICE's view oppositions should only succeed where the opponent has clearly proved all necessary matters to the satisfaction of the tribunal. If there is any doubt that the opponent has not proved his case, the opposition must be dismissed.

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