

# *Comparison between Opposition Systems in Europe and Japan*

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*First published in "Patent 2017, Vol. 70, No.5"*

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# Comparison between Opposition Systems in Europe and Japan

by Kazuya Sekiguchi & Dr. Christian Köster

Opposition procedures before the European Patent Office (EPO) against European Patents granted under the European Patent Convention (EPC) have recently undergone changes which are in effect since 1 July 2016<sup>1</sup>. With these changes the EPO has introduced a streamlined opposition procedure that is intended to simplify opposition proceedings and deliver decisions faster. Also, parties shall be given more time to react to summons and prepare for oral proceedings.

In Japan, former Opposition system was abolished in 2003, in order to unify the patent validity dispute-settlement system to the invalidation trial system in front of a Board of Appeal of the Japan Patent Office (JPO). However, the number of invalidation trial did not increase, because the lawsuit-like proceedings of invalidation trial impose a heavy burden on the parties. In addition, there were needs for the proprietor to set a stable right as early as possible<sup>2</sup>. Therefore, an Opposition system in which anyone can argue the patentability in a simpler and faster way was (re-)introduced in Japan, on 1 April, 2015.

We consider it interesting to compare the streamlined European opposition procedure with the newly introduced Japanese opposition procedure. The below discussion of important aspects of an opposition highlights similarities and differences.

## Legal interest of the opponent – Straw man

### **Europe:**

Article 99 EPC explicitly stipulates that “any person” may give notice of opposition to a granted European patent. According to the pertinent case law<sup>3</sup>, the motives of the opponent are in principle irrelevant. Hence, the opponent is not required to demonstrate any legal interest in a revocation of the opposed patent.

Also according to the pertinent case law<sup>4</sup>, the identity of the opponent is primarily of procedural importance. Thus, where an opponent does not want to reveal his identity to the patent proprietor,

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<sup>1</sup> Official Journal EPO, 2016, A42

<sup>2</sup> Text for the revision of Patent Law in 2014, Chapter 2

<sup>3</sup> G1/84, Official Journal EPO, 1985, 299

<sup>4</sup> G1/84, 審決 T 635/88, T 59/93 等

a possibility could be a straw man who acts as the opponent. According to the EPO's case law<sup>5</sup>, filing the opposition renders a straw man formally the legitimate opponent and the fact that the opponent is acting on behalf of a third party does not render the opposition inadmissible.

Such an opposition by a straw man would only be inadmissible if it amounted to a circumvention of the law by abuse of due process. Specific examples of such an abuse would be the opponent acting on behalf of the patent proprietor as a proprietor cannot oppose his own patent<sup>6</sup>; or the opponent basically acting as a professional representative without possessing the necessary qualifications.

However, professional representatives who do possess the necessary qualifications may typically indeed act as a straw man.

### ***Japan:***

Regarding the qualification of the opponent, Article 113 of Japanese Patent Law stipulates that "any person" may file an opposition. Therefore, similar to European practice, it is possible to file an opposition under the name of a straw man when the opponent does not wish to reveal his identity to the patent proprietor.

The purpose of Opposition system is to give a third party an opportunity to request for re-examining the patentability a patent. In accordance with such a purpose, it is interpreted that the patent proprietor cannot be an opponent.

## **Deadlines**

### ***Europe:***

The most important deadline is the deadline for filing the opposition itself. Actually, an opposition against a European Patent must be filed within nine months the publication of the mention of the grant of the European patent in the European Patent Bulletin. In case this deadline is missed, no legal remedy is available for the opponent.

Thereafter, deadlines are set by the Opposition Division in charge of the case. Under the new streamlined procedure and contrary to the former practice, extensions of time limits will be granted only in exceptional cases with duly substantiated requests<sup>7</sup>. EPO officials have already communicated in seminars that the requirements for a sufficiently substantiated request for an

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<sup>5</sup> G3/97 and G4/97, Official Journal EPO, 1999, 245 and 270

<sup>6</sup> G9/93, Official Journal EPO, 1994, 891

<sup>7</sup> Guidelines for Examination (EPO), Pat E 1.6

extension will be quite high. It is therefore recommendable to typically work under the assumption that deadlines should be met as set and that no extensions are available.

***Japan:***

When a third party wishes to oppose a patent, it is necessary to file a notice of opposition within six months from the date when the Japanese patent was published on the Patent Gazette. There is no remedy, for the opponent, of missing this deadline. In the opposition proceedings, documents must be filed by paper and no online filing is possible. Therefore, it is important to prepare for any documents of opposition proceedings well ahead of time.

In the proceedings of an opposition, the Opposition Division issues a notice of reasons for revocation, when the division concludes that the patent should be revoked. In response to the notice, the patent proprietor can file an argument with or without correction request within sixty (60) days (ninety (90) days for foreign proprietor). This deadline cannot be extended in principle, though theoretically there is a possibility to extend the deadline in an exceptional case. It is recommendable to ask the Opposition Division if the request for extension will be admitted, before filing the request.

When the patent proprietor filed a correction request in response to the notice from the Opposition Division, the Opposition Division gives, in principle, the opponent an opportunity to file an argument against the newly filed corrected claims within thirty (30) days (fifty (50) days for foreign proprietor). This deadline cannot be extended and there is no exception for accepting the request for extension of the term<sup>8</sup>.

## Timeframe of the procedure

***Europe:***

The basic procedural outline for the first instance is the filing of a notice of opposition by an opponent, then the filing of observations by the proprietor of the opposed patent in response to the opposition and thereafter the issuance of summons to attend oral proceedings by the Opposition Division. There can be deviations from this scheme, but this scheme is generally followed and can be used to set out the time frame for the opposition procedure in the first instance.

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<sup>8</sup> Q&A for Opposition (JPO), Q3-23

As outlined above, the opposition period is nine months after grant. Any filed notice of opposition is forwarded to the patent proprietor. The EPO will thereafter examine the opposition for its formal admissibility. If admissible, the EPO will invite the proprietor of the patent immediately after expiry of the opposition period to file his observations concerning the oppositions communicated earlier. The deadline for filing such observations is regularly four months<sup>9</sup>. The reply is then communicated to the opponent. Under the streamlined opposition procedure, the Opposition Division will at the same time prepare the next action which will normally be the issuance of summons to oral proceedings. As a rule, the oral proceedings will not be earlier than six months after dispatch of the summons.

In view of this deadline regimen and taking internal processes into account, the EPO has announced that under the streamlined procedure, “the total time needed for a decision in straightforward cases will be reduced to 15 months, calculated as from expiry of the opposition period.”<sup>10</sup> Compared to the former situation in which the overall duration of straightforward opposition cases was usually between 19 and 27 months, this will amount to a significant improvement. The EPO calls this early certainty from opposition.

### ***Japan:***

Once a notice of opposition is filed, the formality Examiner of the JPO examines if it meets the formality requirements soon after the expiration of the six months’ opposition period. When it is concluded that the notice of opposition complies with the formality requirements, the notice is forwarded to the patent proprietor. At this time, the patent proprietor has no opportunity to respond to the notice of opposition.

In contrast, if the formality Examiner finds that the notice of opposition does not comply with the formality requirements, the opponent is requested to amend the notice or the notice of opposition is rejected.

Then, the Opposition Division comprising of three or five Examiners starts the examination of the case. When the Opposition Division concludes that the patent should be maintained, the Division issues a final decision for maintenance of the patent.

On the other hand, when the Opposition Division concludes that the patent should be revoked, it sends a notice of the reasons for revocation to the patent proprietor. In response to said notice of the reasons for revocation, the patent proprietor can file an argument with or without request for

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<sup>9</sup> Guidelines for Examination (EPO), Pat E 1.2

<sup>10</sup> Official Journal EPO, 2016, A43

correction of claims, specification and drawings within sixty (60) days, (ninety (90) days for foreign proprietor). The correction is limited to (i) restricting the scope of claims, (ii) correction of typo or mistranslation, (iii) clarifying the unclear part, or (iv) correction of dependency (Article 120-5 (2) of Japanese Patent Law).

When the patent proprietor corrected the patent in response to the notice of the reasons for revocation, the opponent is informed about the correction and is invited to file an observation against the correction within thirty (30) days, (fifty (50) days for foreign proprietor). The Opposition Division further examines the corrected patents with an observation from the opponent, if any.

If the Opposition Division still considers that the patent should be revoked, it also issues a second or further notice of the reasons for revocation. Then, the same procedure applies again. That is, the patent proprietor can file an argument with or without request for correction, and the opponent can rebut against the correction. Therefore, patent proprietor will have at least two opportunities for correcting the patent.

When the Opposition Division finally concluded that the patent should be revoked, even considering the corrections and/or arguments filed by the patent proprietor, it issues a final decision for revocation. As the opposition can be requested on claim basis, the decision is made for each of opposed claim.

During the opposition proceedings, an interview may be summoned when the Opposition Division considers it necessary, or when it is requested by the patent proprietor. However, in contrast to oral proceedings in European practice, it is impossible for the opponent to attend the interview between the patent proprietor and the Opposition Division. This is because the purpose of the Opposition is to re-examine the case, and thus it is to be proceeded between the proprietor and the JPO (Opposition Division). The record of the interview can be inspected.

The opponent cannot request an interview with the Opposition Division. Only when the Opposition Division decides that it is necessary to have an interview with the opponent, he will be summoned to it<sup>11</sup>. Though the patent proprietor will be informed about the interview between the Opposition Division and the opponent, he cannot attend it.

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<sup>11</sup> Practical Guide for Opposition (JPO)

## Grounds for Opposition

### **Europe:**

Article 100 EPC contains a conclusive list of available grounds for opposition against a European patent. These grounds are that

- the subject-matter of the European patent is not novel,
- the subject-matter of the European patent is not inventive,
- the subject-matter of the European patent is not susceptible of industrial application,
- the subject-matter of the European patent is not regarded an invention under the EPC,
- the subject-matter of the European patent is excluded from patentability,
- the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, and
- the subject-matter of the European patent extends beyond the content of the application as filed.

It is seen that some additional patentability requirements for a European patent are in principle not relevant in the post-grant opposition procedure. This is especially important for the requirements of unity and clarity. Neither lack of clarity nor lack of unity of the granted patent can be raised by the opponent.

It is however noteworthy that in case amendments to the granted version of the patent are made by the patent proprietor in the course of the opposition procedure, the patent as amended must fulfill all patentability requirements of the EPC. It is therefore often encountered that amendments filed by a patent proprietor are objected to by the opponent especially for lack of clarity.

A procedurally important aspect is that each ground for opposition raised by the opponent must be individually substantiated in the notice of opposition. Otherwise, it might not be examined in the opposition procedure.

### **Japan:**

The limitative grounds for opposition are listed in Article 113 of the Japanese Patent Law. These grounds are:

- the subject-matter of the patent extends beyond the content of the application as filed,
- the patent was granted in violation of an international treaty,
- the subject-

- the subject-matter of the patent is not novel,
- the subject-matter of the patent is not inventive,
- the subject-matter of the patent is not susceptible of industrial application,
- the subject-matter of the patent offends public order and morals,
- the patent was granted to the non-first application,
- the patent does not comply with the requirements of enablement, disclosure, and clarity.

In contrast to the Grounds of opposition in EPC, lack of clarity is also a ground for opposition in Japan (Article 113, paragraph 4).

The Opposition can be requested on claim by claim. The Opposition Division cannot examine the grounds for opposition with regard to the claims not opposed, but it can examine the grounds not raised in the notice of opposition for the opposed claims. In the Opposition Division of the EPO can also examine, of its own motion, the grounds not raised by the opponent<sup>12</sup>.

It is important that the ground for opposition must be argued concretely in each opposed claims. The grounds raised in the notice of opposition and evidences can be amended until the end of opposition period or until the notice of reasons for revocation is issued, whichever comes earlier.

## Intervention – Third party observations

### ***Europe:***

If during an ongoing opposition the patent proprietor brings an action for patent infringement against a third party which is not the opponent, this third party might want to join the opposition procedure. This is especially relevant when an infringement action is taken against the third party in a member state of the EPC which does not allow a separate nullity action against the national part of the concerned European patent which is already under opposition (as it is the case in e.g. Germany).

The EPC allows in such a scenario for an intervention. That is, a third party may intervene in European opposition proceedings after the opposition period has expired, if the third party proves that proceedings for infringement of the same patent have been instituted against him. The same provisions apply for the case that the third party takes court action first, i.e. that the third party files

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<sup>12</sup> G10/91, Official Journal EPO, 1993, 420

a court action for a declaration of non-infringement before the proprietor commences an infringement lawsuit.

For intervening, the third party is required to file a notice of intervention within three months of the date on which the infringement action or the action for a declaration of non-infringement is instituted. This requires a written reasoned statement and the payment of an opposition fee. The intervention is then treated as an opposition and the third party becomes party to the opposition procedure.

In case the applicable deadline is missed or in case a third party who is not sued for patent infringement becomes interested in an ongoing European opposition procedure, there is also the possibility to file third party observations. Whoever files such observations, which can also be filed anonymously, will however not become a party to the opposition proceedings.

### ***Japan:***

Article 119 of Japanese Patent Law stipulates that person(s) having interests to the subject patent can intervene the opposition proceedings, to protect the patent.

The request for intervention must be filed when the opposition proceedings are still pending.

If it is concluded that the person(s) requesting the intervention does not have interests to the subject patent, the request for the intervention will be rejected. Once the intervention request is admitted, the intervener has the same status as the patent proprietor.

On the other hand, in contrast to European practice, it is impossible for the third party to intervene with the opposition proceedings for of the opponent. Therefore, if a third party which is brought an action for infringement by the patent proprietor wants to revoke the patent, he needs to rebut the invalidity of the patent in front of the court and/or to file an invalidation trial to the JPO's Appeal Board.

The third party can also file third party observations to the JPO. Similar to the EPO practice, the third party filed the observations will not become a party to the opposition proceedings.

## **Appeals**

### ***Europe:***

Typically, at the end of the oral proceedings before the Opposition Division, a decision is announced by which the patent is maintained as granted, maintained in amended form or entirely revoked. In the first case the decision is negative for the opponent, and in last case it is negative

for the proprietor. Where the patent is maintained in amended form usually both sides are adversely effected by the decision taken by the Opposition Division. The EPC gives any party to the opposition proceedings which is adversely affected by the decision the right to file an appeal against that decision.

Once the adversely effected party has been notified of the written decision of the Opposition Division, a notice of appeal has to be filed within two months and grounds of appeals have to be filed within four months. Provided the appeal is admissible, it will be heard by one of the currently twenty-eight technical Boards of Appeal of the EPO.

The Boards of Appeal are in principle integrated in the organizational structure of the EPO, but the Boards are independent in their decisions and are bound only by the European Patent Convention. The Boards of Appeal of the European Patent Office also have their own Rules of Procedure. The discretion of the Boards and their members in the appeal procedures is significant. We thus refrain from providing any further general statements about procedural aspects, time frames etc. of an appeal procedure in this article.

### ***Japan:***

When the Opposition Division comes to conclusion, it issues a decision of maintaining the patent (as granted or in amended form) or revoking the patent. In response to the decision to revoke the patent, the patent proprietor, the intervener or the party whose request for intervention was rejected, may file a lawsuit in front of the Intellectual Property High Court (IPHC), within thirty (30) days (120 days for the foreign proprietor) from the decision. If the IPHC decides the decision by the Opposition Division is inappropriate, the case is remanded to the Opposition Division of the JPO.

On the other hand, in contrast to the European practice, there is no possibility to file a lawsuit, etc. against the decision to maintain the patent. If the opponent is not satisfied with the decision, the only possibility to revoke the subject patent after the positive decision is to file an invalidation trial in front of the JPO's Appeal Board.

## **Costs**

### ***Europe:***

Currently the official fee for an opposition is EUR 785, whereas the current fee for filing an appeal is EUR 1880. Service fees for the European Patent Attorney representing the party obviously depend on the attorney's fee schedule and even more on the complexity of the case. Normally, such costs will however be significantly lower than the costs arising from multi-national invalidation

actions against a European patent which after grant becomes a bundle of national patents. Each of these national patents would have to be invalidated by an interested third party individually, whereas the European opposition procedure establishes a possibility to have the patent limited or even entirely revoked with effect for all member states of the EPC.

As regards the cost risk, it is noteworthy that the general principle is that each party of opposition proceedings before the EPO bears its own costs. Apportionment of costs can in principle be requested. However, an Opposition Division or Board of Appeal will only very rarely order for reasons of equity a different apportionment of costs. We believe that the principle of each party bearing its own costs is overwhelmingly applicable and allows a very good budget planning of a European opposition procedure.

We conclude that compared to a series of national invalidation actions to be taken against the various national parts of the European patent after validation and after the end of the opposition period, the possibility of a central revocation of a European patent by a European opposition against that patent is very good value for money.

***Japan:***

The official fee for an opposition is 16,500 JPY + 2,400 JPY/claim, whereas the fee for filing an invalidation trial is 49,500 JPY + 5,500 JPY/claim. Service fees for the Japanese Patent Attorney representing the party obviously depend on the attorney's fee schedule and on the complexity of the case.

As the official fee for the opposition is less than the official fee for the invalidation trial, and it is possible to use a straw man to file an opposition (whereas the invalidation trial can be filed only by the party having interests to the patent), it is a good measure for the opponent to argue the patentability of a granted patent in front of the JPO.

As a matter of fact, the number of opposition filed in 2016 is more than 1,000<sup>13</sup>, while the number of invalidation trial in the last ten years was around 250-300 per year.

When the patent proprietor requests the correction of claims in response to the notice of reasons for revocation, the official fee of 49,500 JPY + 5,500 JPY/claim should be paid.

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<sup>13</sup> Statistics for Patent applications, Nov. 2016

## General strategic considerations for the streamlined/new procedure

### **Europe:**

In view of the procedural changes to the European opposition, the strategies for such an opposition procedure might be re-considered and potentially changed by both, the patent proprietor and the opponent.

For a patent proprietor it would seem recommendable to

- Prepare a comprehensive response to opposition,
- Procure technical expertise early, and
- Propose (but not necessarily file) fallback positions early.

We call this the “3 Ps”.

For an opponent it would seem recommendable to

- Object to delaying tactics used by the proprietor,
- Openly discuss weak points early (but only internally),
- Oversee the opposition procedure closely.

We call this the “3 Os”.

Obviously, strategies and tactics need to be tailored to the individual case, and industries which traditionally had different approaches in European opposition procedures will probably continue to do so. The consequences of the reform of the European opposition procedure into a streamlined opposition procedure might also be not too dramatic compared to the former times. However, to cite a Nobel laureate: *The times, they are a changin’*.

### **Japan:**

When the Opposition Division issues a notice of reasons for revocation, the patent proprietor has only sixty days (ninety days for foreign proprietor) to respond to the notice, which is in principle non-extendable. In addition, the documents must be filed on paper-base. Therefore, it is recommendable to start analyzing the case/preparing the documents as soon as the notice is issued.

An interview with the Opposition Division will be admitted for the patent proprietor at least once during the opposition proceedings, without the participation of the opponent. Therefore, it is useful to have an interview in order to argue the patentability with the Opposition Division more in detail.

For the opponent, it is easier to use the opposition because the opposition can be filed by a straw man. Further, even the patent is maintained in the opposition procedure, it is still possible to file an invalidation trial to the JPO's Board of Appeal<sup>14</sup>. As the principle for prohibition of double jeopardy is not applicable between the opposition decision and appeal proceedings, the opponent can file an invalidation trial with the same grounds and evidences as the opposition procedure. Consequently, opposition can be used as a primary try to revoke a patent.



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Article first published in **"Patent 2017, Vol. 70, No.5"**

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<sup>14</sup> Handbook for Appeal Procedures (JPO) 67-06