



Challenging the grant of a European Patent

If you are faced with one of the following problems, you should seek immediate advice from a European Patent Attorney:

- Your European patent has been opposed by another party?
- A European patent has been granted in your field of technology, which could harm your business today or in the future?
- A European patent application has been filed in your field of technology which, if granted, could harm your business today or in the future?
- You have been notified, threatened or sued by a competitor or a third party that you are infringing a European patent or European patent application?
- You want to test the strength of your opposition or defense of a European patent prior to an oral hearing?

Zacco's team of European Patent Attorneys, specialized in the task of prosecuting oppositions on your

behalf, can assist you, both when you are the Opponent or the Patent Proprietor.

As a unique approach to maximizing our success on your behalf, we conduct a rehearsal or "**mock trial**", to prepare the responsible European Patent Attorney for oral hearings before the European Patent Office (EPO) in Munich or The Hague. Key aspects of the opposition process are explained below:

When can a European patent be opposed?

European patents can be opposed within nine months from the date of mentioning the grant of the patent by the EPO.

How can Opposition provide a life-line to a potential infringer?

If you are sued for infringement, it is always a good idea to assess your chances of having the potentially infringed patent revoked, or at least amended, in opposition proceedings. An amended patent may be just sufficient for a potential

infringer to work outside the patentees more limited patent rights. Your chances of success are often better before the EPO than later in proceedings before a national court, and it is also cheaper if you are likely to be sued in more than one European state.

If you are sued for infringement of a European patent after the nine-month time limit, you should check whether another party has started an opposition, in which case, you are entitled to join in with your own opposition.

What is the key to winning an Opposition?

Zacco conducts Oppositions with a dedicated team of European Patent Attorneys: At Zacco, opposition proceedings are placed in the hands of a team led by an experienced European Patent Attorney supported by one or more Patent Attorneys, who contribute their up-to-date technical understanding of the patented invention. A lawyer may join the team if evidence relating to prior public use or sale arises. The team's

task is to prepare soundly documented and well-argued submissions to the EPO on behalf of either party, in the knowledge that the target for Opposition are patents of great value for both the Patent Proprietor and the Opponent (e.g. the competitor). A carefully crafted written submission paves the way to a success.

Opponents and Patent Proprietors can contribute their expert technical knowledge during opposition proceedings:

An Opponent starts opposition proceedings by submitting the Grounds for Opposition supported by evidence and arguments to the EPO. A client can valuably assist the team of Attorneys by identifying prior art (publications prior to the first filing date of the patent application), previously overlooked by the EPO, that can demonstrate a lack of novelty and inventive step in the opposed patent. Supplementary (or full) database searches, using search specialists, in close cooperation with the client, is an essential tool used to identify pertinent prior art to support the client's case. The client is also in a unique position to provide evidence of prior public use or sale of the patented invention.

Zacco uses “mock trials” to prepare for oral hearings: Oral hearings at the EPO give each party the opportunity to plead their case before the EPO and to respond to each others arguments. Zacco employs a unique approach to prepare the responsible European Patent Attorney, by conducting a rehearsal or “mock trial”, before going to Munich or The Hague for the oral hearing. All European

Patent Attorneys at Zacco, participating in oral hearings, prepare for and participate in this “mock trial”, to ensure that the arguments are robust and consistent with the case law at the EPO and that we can handle any unexpected situation. Our client, i.e. the Patent Proprietor or the Opponent, is invited to take part in these preparations for the oral hearing.

Are Opposition proceedings the only solution?

From the Opponent perspective: Starting opposition proceedings against your competitor's patent is one route to securing freedom to sell your potentially infringing products, if this leads to the patent being revoked or sufficiently narrowed by amendment. However, you will need to weigh up your chances of success and the cost of an Opposition, against the potential benefits to be gained from dialog with the Patent Proprietor, if this results in a favorable license under the patent. You may even be in a position to cross-license in-house patented technology with your competitors, and further secure your position vis-à-vis your competitors. Our task, as your patent attorneys, is to outline your options and guide you towards an IP strategy which best supports and strengthens your commercial position. A well argued Opposition document, ready for filing, may be all that is needed to persuade the patentee to enter a license agreement with you.

From the Patent Proprietor's perspective: The Patent Proprietor may have no option but to defend his patent throughout Opposition

proceedings, unless the Opponent sees an advantage in licensing your patented technology. Here again, a convincing response that overcomes the Opponent's submitted grounds and arguments for revocation of your patent, may be enough to persuade the Opponent to withdraw his Opposition. The EPO will only pursue the Opposition further on their own, if they have serious reasons to doubt the patentability of the patent claims. If your patent appears weak in view of the arguments raised by the Opponent, amending the patent to narrow and strengthen the claims may be the best solution before starting infringement proceedings, or defending your patent before a national court. You may seek to voluntarily limit your patent with the EPO before starting infringement proceedings if you feel that your patent is too broad and therefore too weak to be enforced.

If you do not already use Zacco patent attorneys, this may be the moment to consider using us in Oppositions, where you can benefit from the expertise of the Zacco Opposition Group. We can provide a second opinion on the strategy and strength of your own or your Opponent case. We can also set up a “mock trial” to prepare you for the oral hearing, even though we are not acting as your professional representative at the oral hearings. Good preparation always pays off!

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