

INVALIDATING EUROPEAN PATENTS

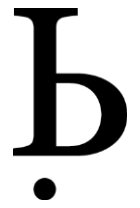
EPO OPPOSITION OR NATIONAL REVOCATION
PROCEEDINGS? AND HOW DOES THE EQUATION
CHANGE WITH THE UPC?

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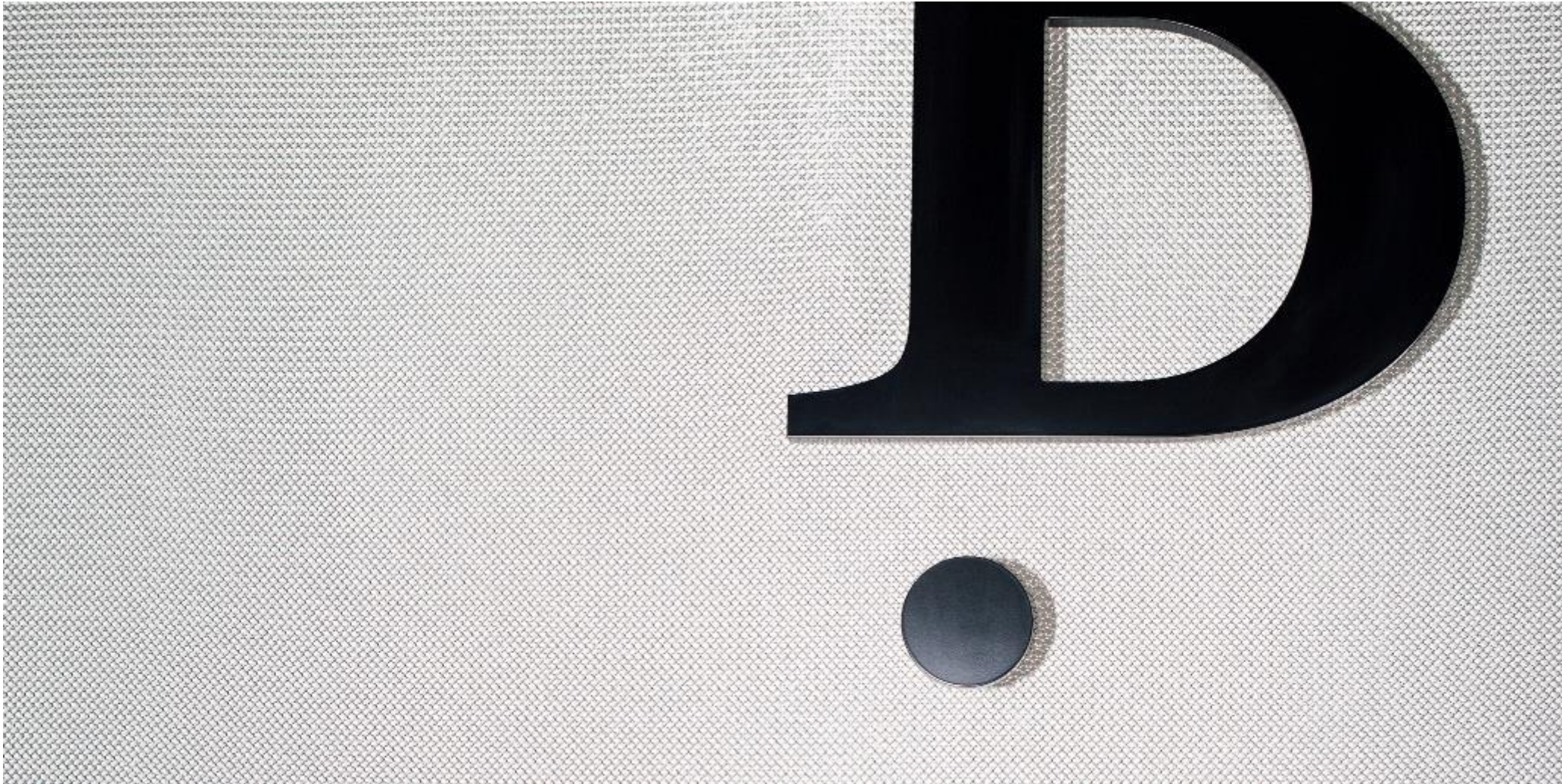
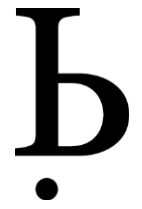
**BARDEHLE
PAGENBERG**

Impact.
Passion.
IP.



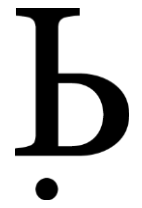
- I. The Options Of the Attacker**
- II. Comparison Of the Proceedings**
- III. Different Practices**
- IV. Outlook: Unified Patent Court (UPC)**

The Options Of the Attacker



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EUROPEAN PATENTS
4/21/2022

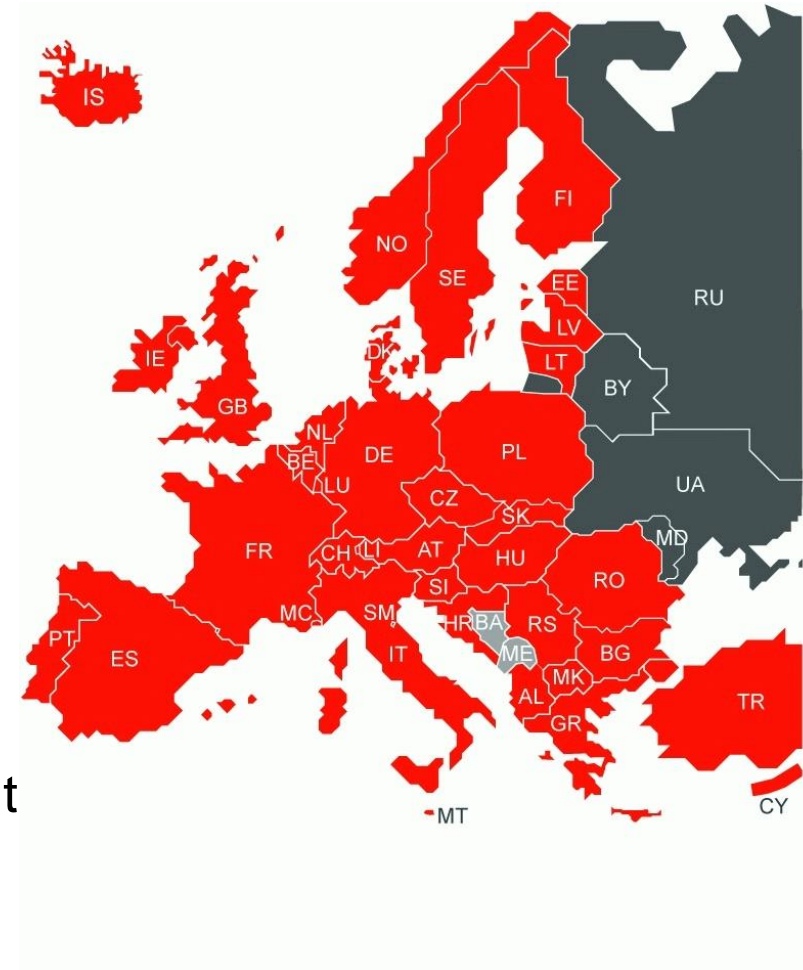
European Patents



After grant of a European patent application, the EP patent becomes a bundle of national patents. Infringement and invalidation are dealt with by national courts

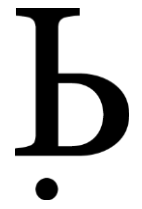
Example: an EP patent is validated in UK, FR, DE. If infringement of the German part is found, the decision has no effect for the UK or France. If a German court finds the DE part of the EP patent invalid, the UK and FR parts remain valid

However, within 9 months from grant, a European patent can be invalidated entirely in opposition proceedings at the EPO



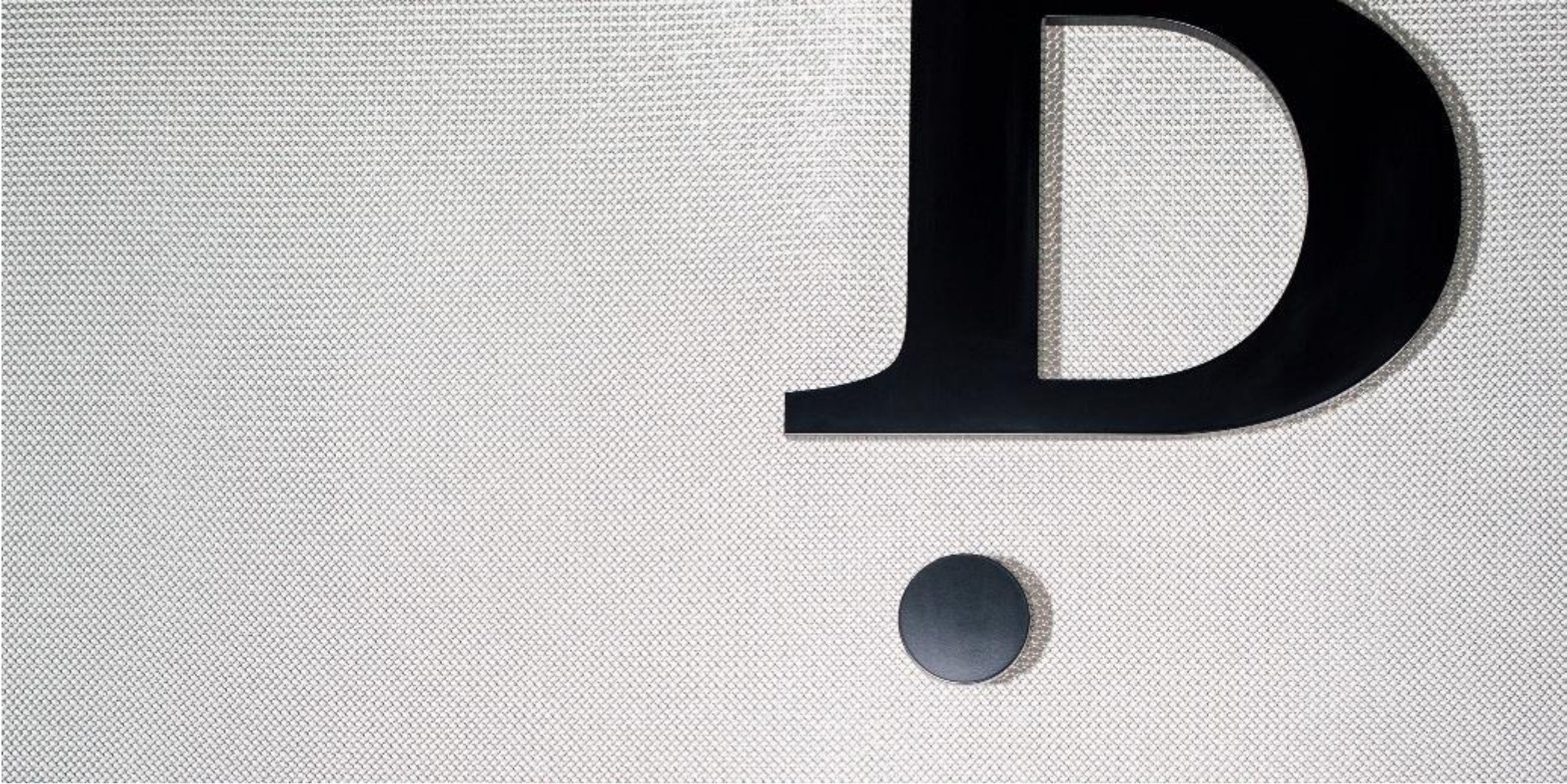
THE OPTIONS OF THE ATTACKER

The Attacker's Choice?

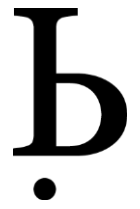


BUNDESGERICHTSHOF

Comparison Of the Proceedings

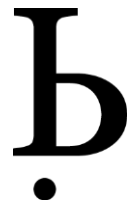


EPO Opposition v. German Invalidity Proceedings – Fundamentals



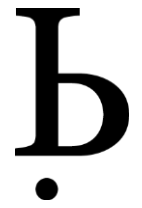
EPO Opposition		German Invalidity Proceedings
Whole EP bundle patent	Scope	DE part
Same	Grounds	Same
<= 9 months after grant	Time Window	Any time after opposition window or opposition proceedings
Needs to be filed within the 9 months after grant	Prior Art	Can be supplemented until about 3 months prior to first instance hearing

EPO Opposition v. German Invalidity Proceedings – First Instance



EPO Opposition		German Invalidity Proceedings
EPO Opposition Division	Decision Maker	German Federal Patent Court
Opposition fee (EUR 815) plus attorney fees. No cost reimbursement.	Costs	Court fees (typically EUR 15 to 45 k) plus attorney fees. Loser pays court fees and statutory attorney fees.
15 months (+)	Duration	24 to 36 months
After 10-15 months	Preliminary Opinion	After 6 months (?)

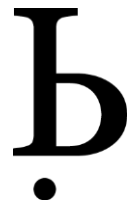
Duration Of German Invalidation Proceedings (First Instance)



Average duration [months] of invalidity proceedings according to statistics of Federal Patent Court					
	2016	2017	2018	2019	2020
Duration [months]	24.6	25.8	26.9	27.8	32.8

Source: 2020 Annual Report German Federal Patent Court

Duration of EPO Opposition (First Instance)



EP procedures

Procedure	Months	<i>Previous year</i>
Search (all searches) ⁽¹⁾	4.3	4.1
Examination ⁽²⁾	23.7	26.1
Opposition ⁽³⁾	15.4	17.5

- (3) Mean value calculated from expiry of opposition filing period to date of opposition decision for standard opposition cases (i.e. excluding cases with more than one opponent, participation of a legal member or re-scheduling of oral proceedings).

Early Certainty across all processes

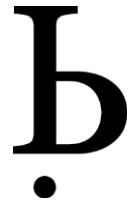
15 Standard
opposition
months

... **median** time to decision

Sources:

- „Statistics 2020“, CA/F 5/21, European Patent Office, October 6, 2021 ([Link](#))
- “Speed of Processing at the EPO“, John Beatty, September 18, 2017 ([Link](#))

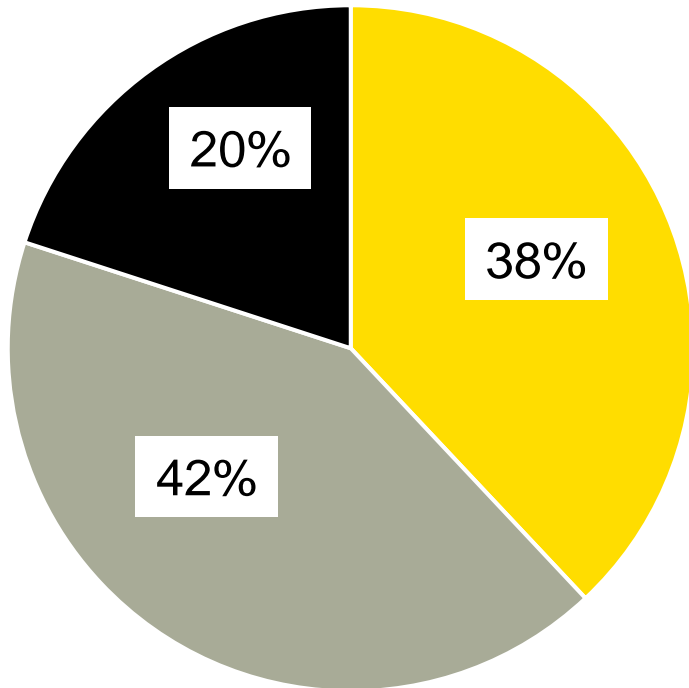
Duration of EPO Opposition



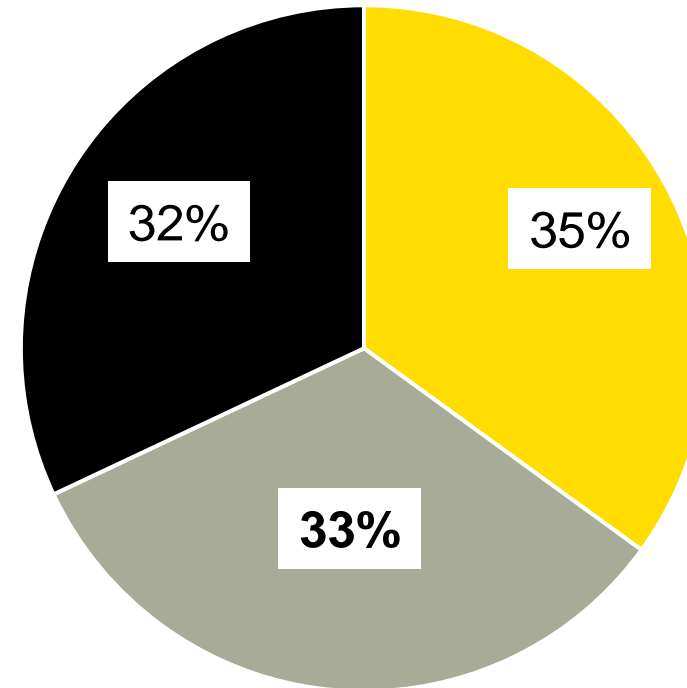
- Possibilities of accelerating EPO opposition procedures
 - First instance: in case of an infringement complaint: Guidelines **E-VIII 5., Official Journal EPO 2008, 221**
 - Appeal: involved parties with a “legitimate interest”: **E-VIII 6., Official Journal EPO 2008, 220**. Standard case: infringement complaint

Difference In Chances Of Success?

Results German Nullity Proceedings
(First Instance)



Results EPO Opposition Proceedings
(First Instance)



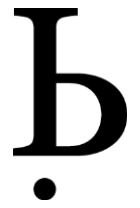
■ Invalidated ■ Partially invalidated ■ Maintained

■ Revoked ■ Limited ■ Opposition rejected

Sources:

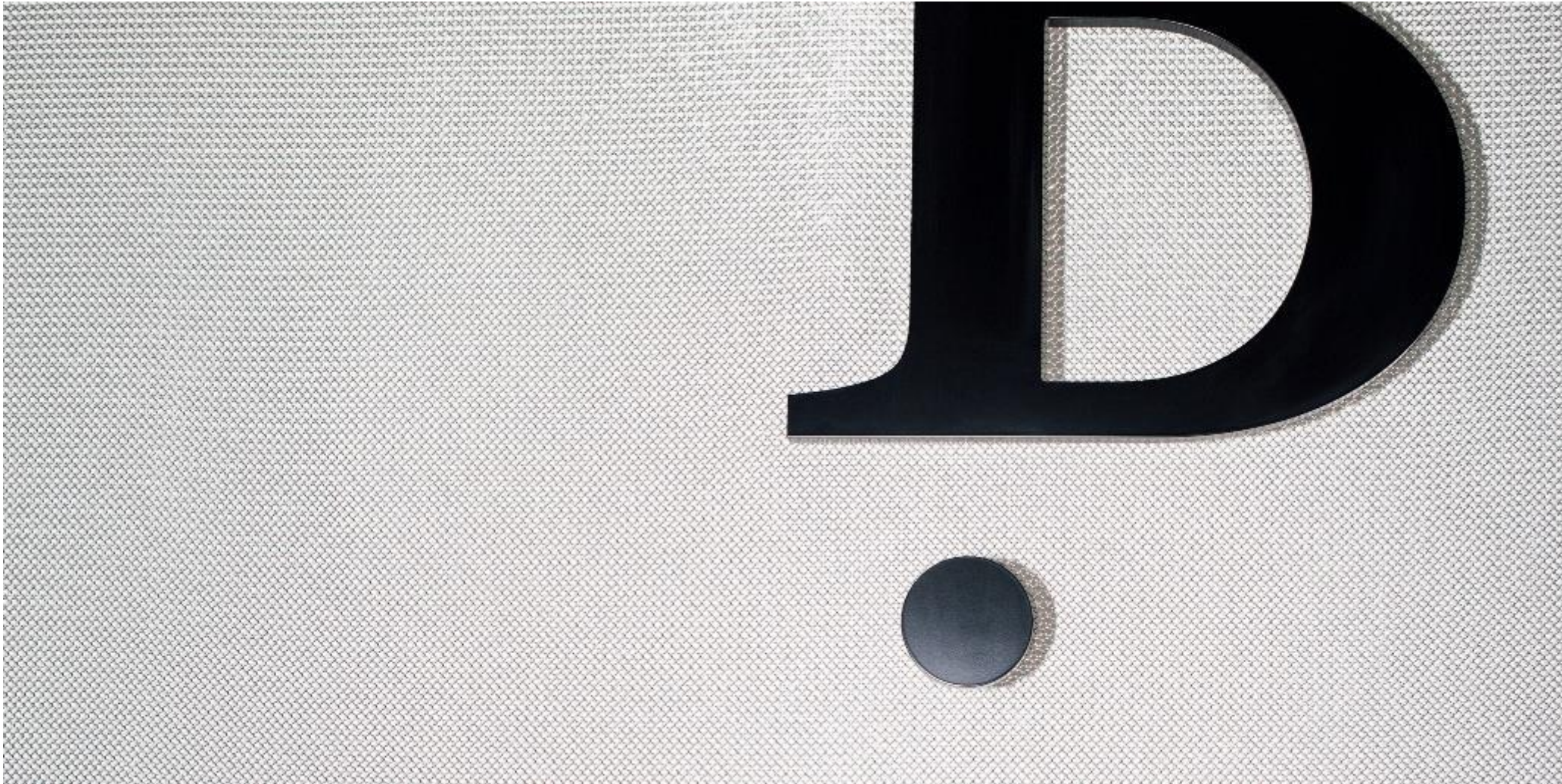
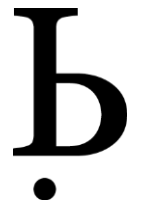
- [“Current revocation rates in German patent nullity proceedings”](#), Prof. Dr. Tilman Müller-Stoy, Dr. Anna Giedke, Julian Große-Ophof, Bardehle Pagenberg IP Report, December 7, 2021
- [“Statistics 2020”](#), CA/F 5/21, European Patent Office, October 6, 2021

EPO Opposition v. German Invalidity Proceedings – Appeal



EPO Opposition		German Invalidity Proceedings
EPO Boards of Appeal	Appeal Instance	Federal Court of Justice
Appeal fee (EUR 2,785) plus attorney fees. No cost reimbursement.	Costs	Court fees (typically EUR 25 to 60 k) plus attorney fees. Loser pays court fees and statutory attorney fees.
36 to 60 months	Duration	24 months

Different Practices



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Claim Interpretation



Primarily linguistic or lexical interpretation

Only minor role of description and drawing for interpretation

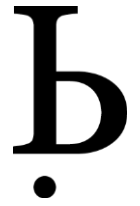
Question of interpretation “secondary”, no intense consideration in writing

Meaning of claim

Description and drawing are to form a unit in combination with claims

In brief: Interpret first, attack afterwards!

Article 123(2) EPC – “Added Matter”



Article 123^{143, 144}
Amendments

(2) The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.



Added matter: The FCJ's "Communication Channel" Decision

Claim 1 as granted	Original claims 1+5
<p>1. A radio station having a communication channel comprising</p> <ul style="list-style-type: none"> - a control channel for transmission of control information, and - a data channel, 	<p>1. A radio station having a frequency division duplex communication channel</p> <ul style="list-style-type: none"> - a control channel for transmission of power control and bit rate information, and - a data channel,
<ul style="list-style-type: none"> - closed loop power control means for adjusting the power of the control and data channels, 	<ul style="list-style-type: none"> - control means for adjusting the power of the control and data channels in a series of steps <p>[D: operated in a closed loop manner]</p>
<ul style="list-style-type: none"> - means for delaying the initial transmission of the data channel until after the initial transmission of the control channels. 	<ul style="list-style-type: none"> - means for delaying the initial transmission of the data channel until after the initial transmission of the control channels.

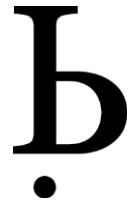
Added matter: The EPO's approach



The EPO's gold standard

- **G 3/89, G 11/91, G 1/93, ...**: not allowed to improve position by adding subject-matter not disclosed in the application as filed
- **GL H V 3.2.1**: added “feature **not related** or **inextricably linked to** the other features of that embodiment”
- Decision would probably have been known as “**FDD** Communication Channel with **Bit Rate** Information”

Article 56 EPC – “Inventive Step”



Article 56⁴⁶
Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

40 EUROPEAN PATENT CONVENTION
Innovation matters

Inventive Step – The three major differences

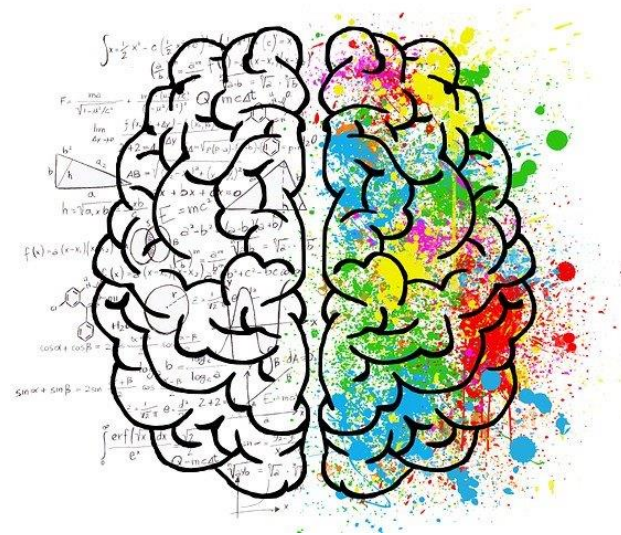
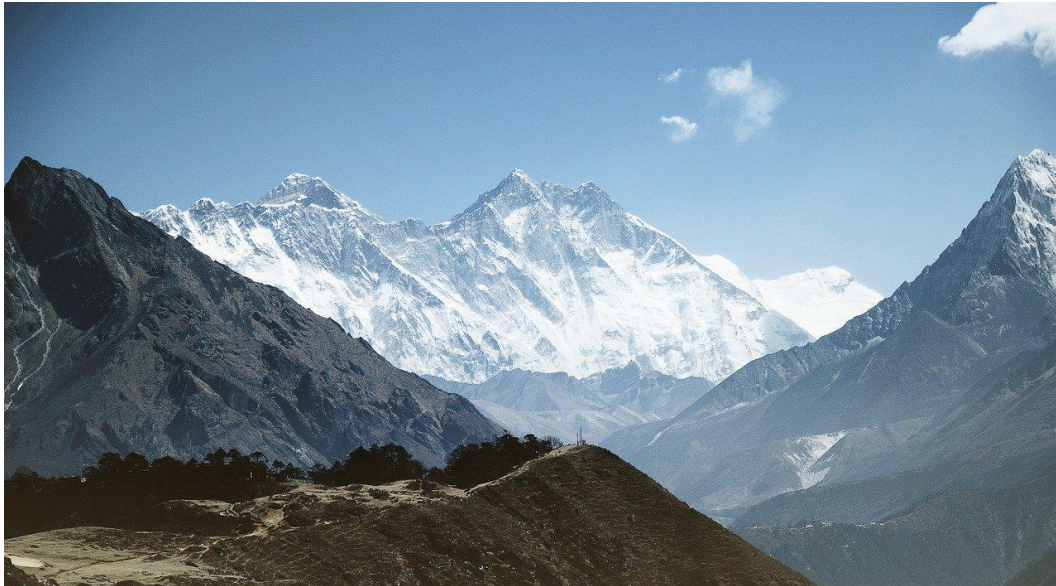
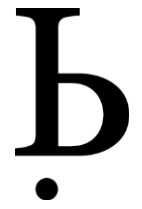
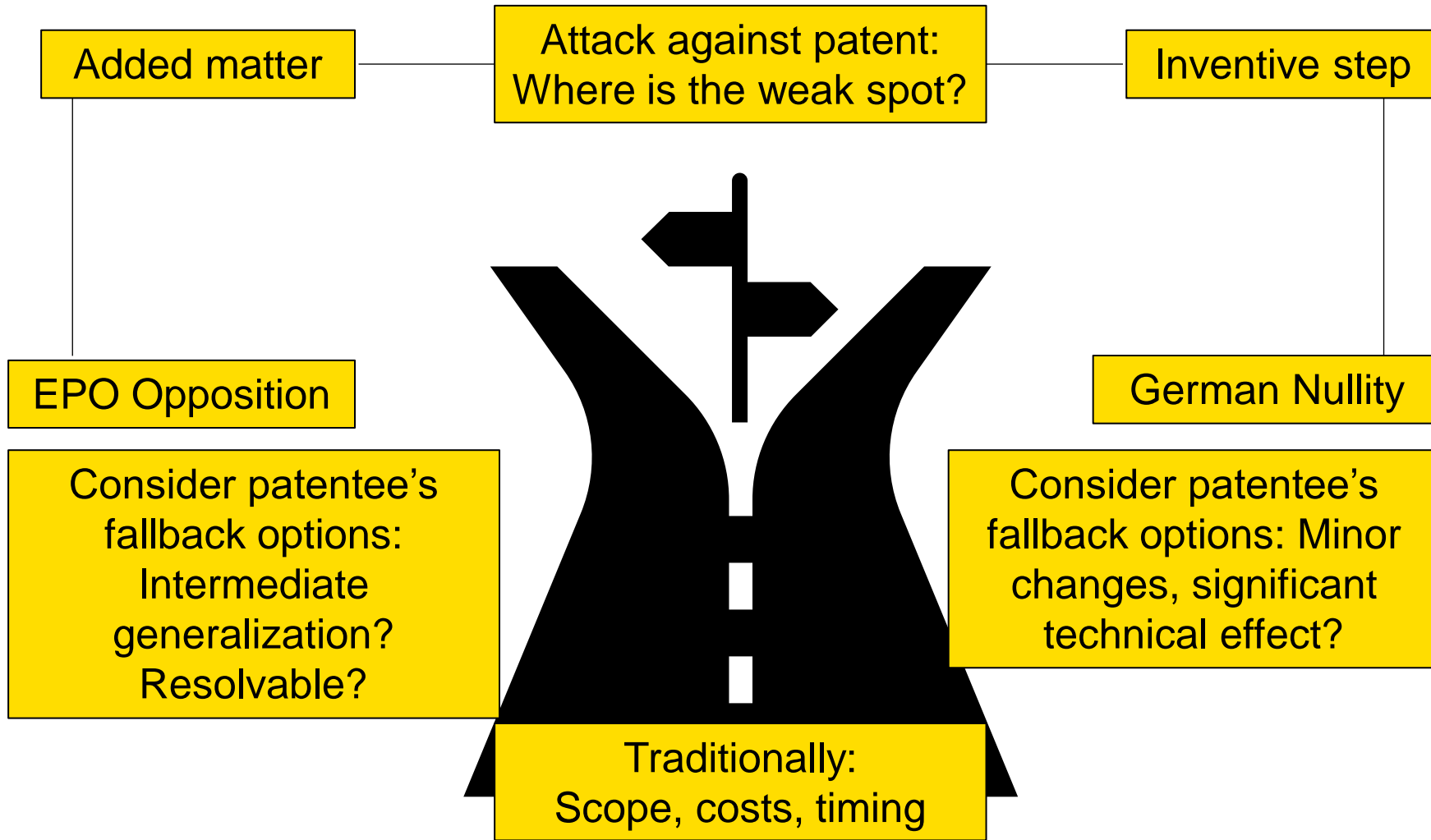
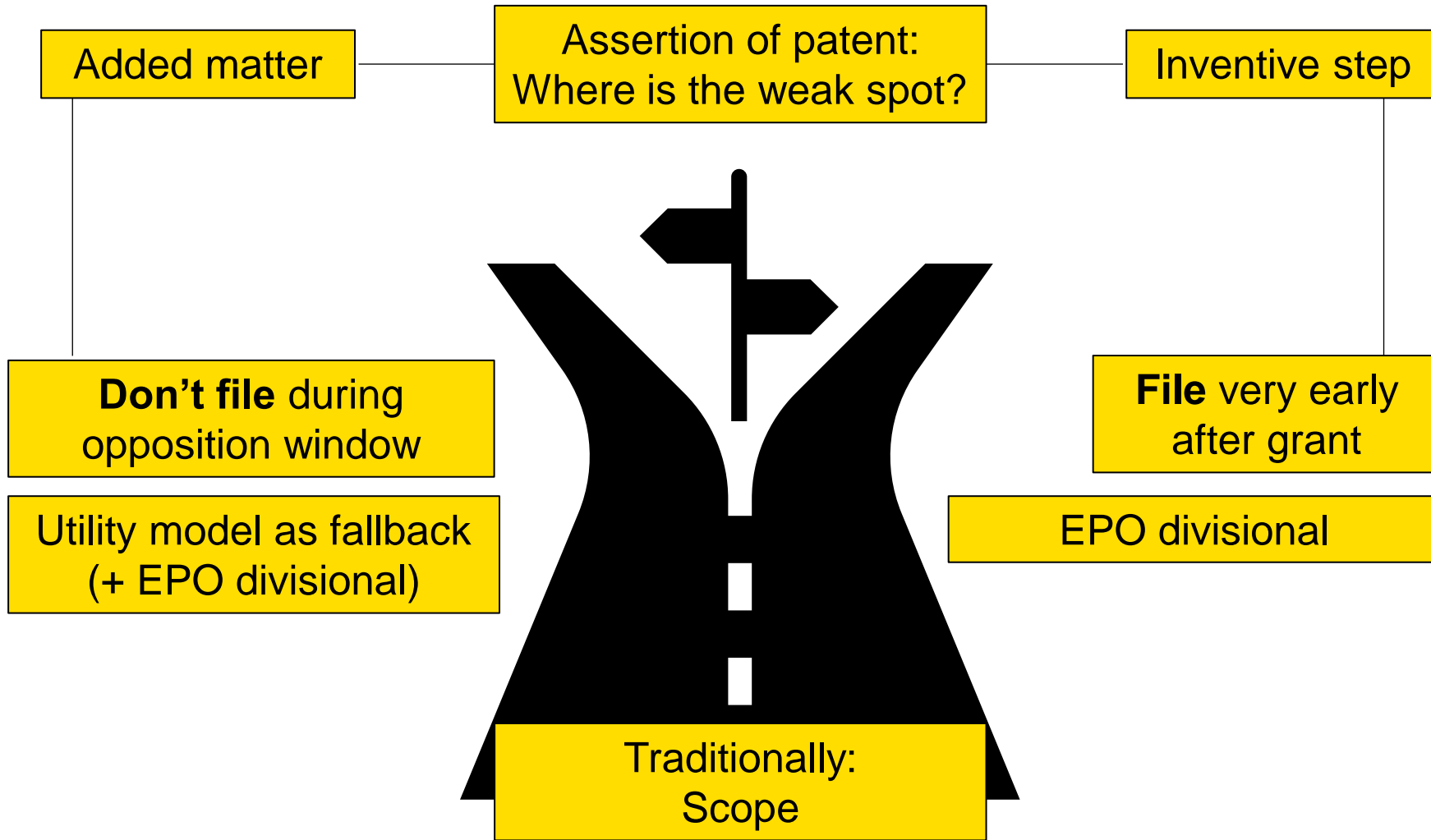


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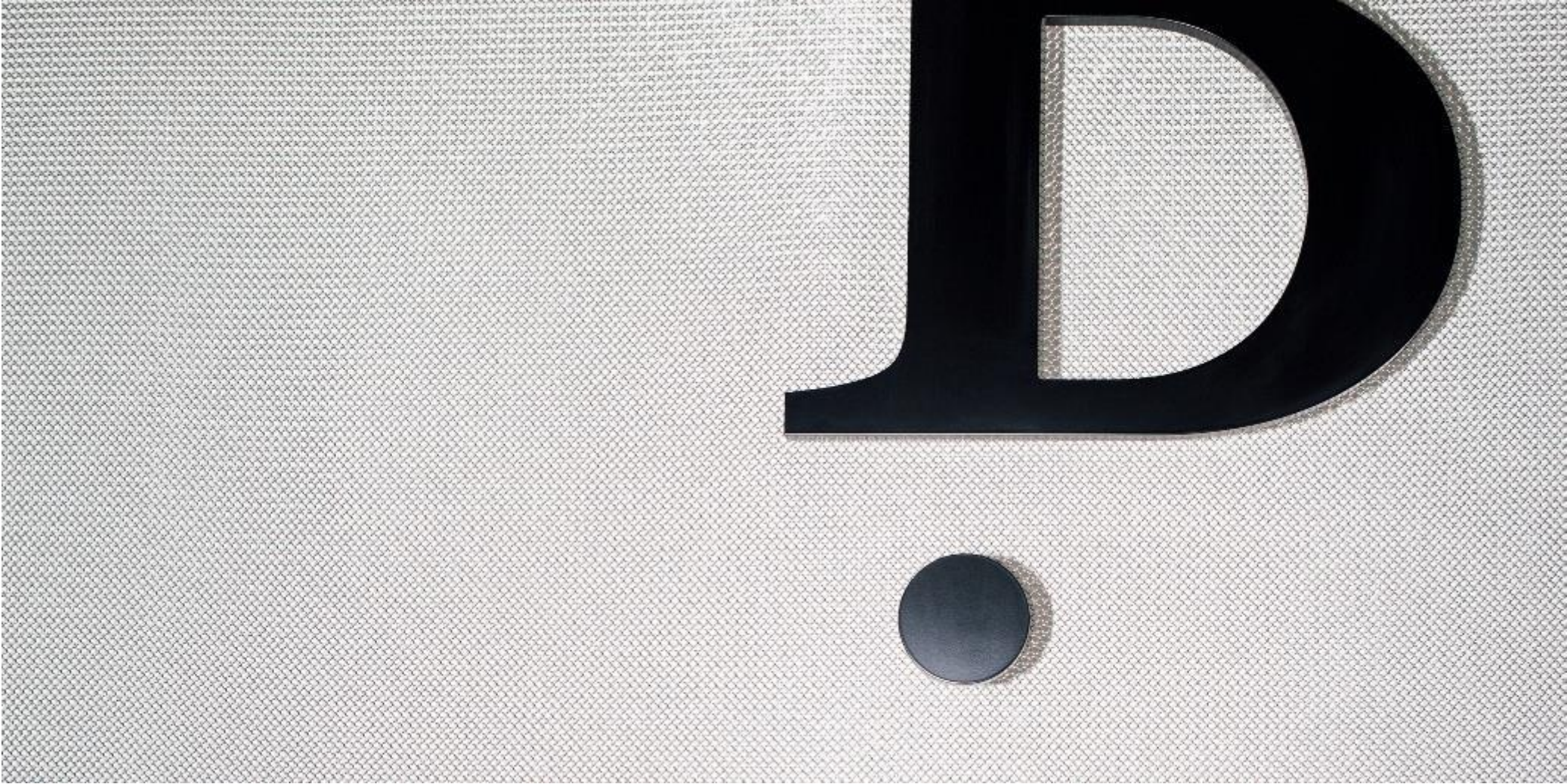
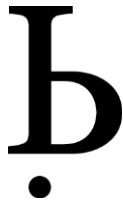
Takeaways – the Attacker’s Perspective



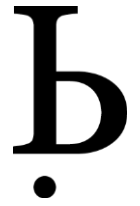
Takeaways – the Patentee’s Perspective



Outlook: Unified Patent Court (UPC)

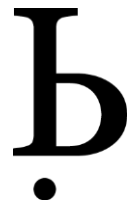


The Option Of the Unified Patent Court (UPC)



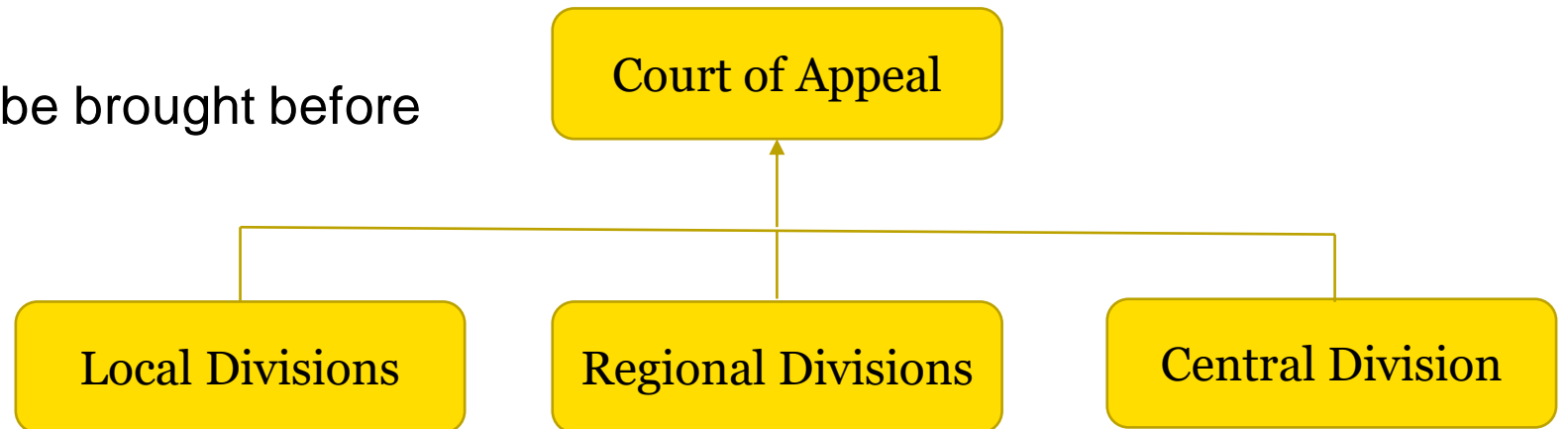
- The Unified Patent Court will start at the end of 2022/beginning of 2023
- UPC will have jurisdiction over newly created Unitary Patent, but also over EP bundle patent as far as nationalized in UPC member states (no member states: e.g. UK, Spain)
- But during transitional period of 7-14 years, patentees can opt out EP bundle patents from jurisdiction of the UPC for the lifetime of the patent
- As a consequence, there will be three different decision makers for invalidating EP bundle patents: (1) the EPO and (2) the national courts or (3) the UPC
- It is the attacker's choice to use the EPO or the courts, but the patentee's choice if the court option is national courts or UPC



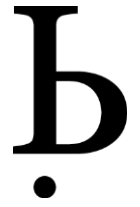


The Option Of the Unified Patent Court (UPC)

- If infringement proceedings are pending before the UPC, the EP patent will typically be invalidated by means of a counter-claim for invalidity
- In this case, typically a Local or Regional Division of the UPC will decide about validity
- A standalone invalidity action can be brought before the Central Division of the UPC
- In either case, the decision of the Division will affect the national parts of all UPC member states
- Second instance always before the same Court of Appeal

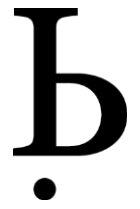


Standalone Invalidation Proceedings before the UPC



Scope	Unitary Patent/national parts of EP bundle patent of all UPC member states
Time Window	Any time, even while opposition is pending
Prior Art	Needs to be filed with initial brief
First Instance Decision Maker	UPC Central Division
First Instance Costs	Court fees (EUR 20 k) plus attorney fees. Loser pays statutory fees.
First Instance Duration	12 months
Appeal Instance	UPC Court of Appeal

Contact



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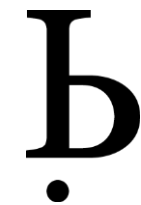


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Thank you!

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