

Statistics for EPO Oppositions and Appeals – Update

1. Background

1.1 This article provides an update to our PageStop publication of March 2008 on [EPO opposition and appeal statistics](#). The EPO publishes these figures annually in the Annual Report and in a Special Edition of the Official Journal. Although the Annual Report for 2009 has been published, containing all of the opposition and some of the appeal statistics for that year, the remainder of the 2009 appeal statistics will be published later this year in the Official Journal. Thus the most recent statistics, for 2008 and/or 2009, are presented below.

1.2 As discussed below, the proportion of opposed cases in which revocation is ordered by the Opposition Divisions is steadily increasing, making the opposition procedure an increasingly powerful weapon to use.

2. Opposition statistics

2.1 First Instance Organisational and Procedural Context

2.1.1 After grant of a European patent, there is a nine-month window in which a person may file centrally at the EPO a notice of opposition to the patent, alleging that the patent was wrongly granted.

2.1.2 Oppositions are relatively common because they represent an economically attractive way of removing an IP obstacle to a planned commercial activity over a substantial market place. English is the language of the proceedings in by far the majority of cases. Oppositions in which there are multiple opponents to a single patent are not uncommon.

2.1.3 Oppositions are examined and decided at first instance by an "Opposition Division". Opposition Divisions usually comprise three members all of whom are technically qualified; occasionally, the Division is expanded to include a legally qualified member. The EPO Opposition Division initially examines the opposition to see whether it is formally admissible. If it is, the Opposition Division then conducts a substantive examination of the opposition, based on the arguments of the

opponent(s) and the patentee, the text of the granted patent and its prosecution history.

2.2 2008 and 2009 First Instance Case Statistics

2.2.1 In 2009, slightly fewer oppositions were filed than in 2008, both in terms of the absolute number of oppositions and as a percentage of the newly-granted patents available for opposition. Thus, in 2009 oppositions were filed against 2,700 patents (a rate of 4.7%), whereas in 2008 there were 2,800 oppositions filed (a rate of 5.2%).

2.2.2 By contrast, the number of first instance decisions issued in opposition cases increased to 2,314 in 2009, from 1,982 in 2008. In about 44% of these 2,314 cases the patent was revoked, in about 30% of cases it was maintained in amended form and in about 26% of cases it was maintained as granted (i.e. the opposition was rejected). The proportion of revocations has in fact increased steadily since 2006, when about 37% of opposed cases were revoked at first instance and about 31% of cases were maintained as granted.

3. Board of appeal statistics

3.1 Appellate Level Organisational and Procedural Context

3.1.1 The EPO Boards of Appeal consist of the Technical Boards of Appeal, the Legal Board of Appeal, the Disciplinary Board of Appeal and the Enlarged Board of Appeal.

3.1.2 There are four subject matter divisions in the Technical Boards of Appeal:-

- Mechanics
- Chemistry
- Physics and
- Electricity

3.1.3 These hear appeals against decisions of the examining division (ex partes proceedings) as well those of Opposition Divisions.

3.1.4 The Enlarged Board of Appeal decides important points of law but is a closed jurisdiction in that it may only address:

(i) points of law referred to it by the other boards of appeal;

(ii) points of law referred to it by the President of the EPO; and

(iii) requests for petition for review of decisions of the Boards of Appeal.

3.1.5 As of 31st December 2009, there were 155 Boards of Appeal chairmen and members. Technical Boards of Appeal usually comprise three members, of whom one is legally qualified; occasionally they comprise five members of which usually two are legally qualified.

3.2 2008 and 2009 Appeal Case Statistics

3.2.1 Numbers of cases, types, distribution and language

3.2.1.1 The number of new appeal cases filed with the EPO Boards of Appeal increased by 3.2% to 2,543 in 2009, from 2,464 in 2008.

3.2.1.2 Of the new cases filed in 2009, the vast majority (2,484) were with the Technical Boards of Appeal, of which about 49% related to ex partes proceedings, about 50% related to inter partes proceedings and less than 1% related to Patent Convention Treaty (PCT) protests.

3.2.1.3 Statistics on the distribution of new appeal cases between the various Technical Boards of Appeal in 2009 have yet to be published, but in 2008 the distribution was as follows:-

- 32.2% Mechanical
- 31.5% Chemical
- 12.6% Physical and
- 23.7% Electrical

3.2.1.4 In 2009, the EPO Boards of Appeal collectively decided 1,979 cases, compared with 1,849 in 2008. Again, the great majority of the 2009 cases, 1,918 in total, were decided by the Technical Boards of Appeal.

3.2.1.5 About 41% of these related to ex partes proceedings, about 58% related to inter partes proceedings and about 1% related to PCT protests.

3.2.1.6 Again, statistics on the distribution of decided appeal cases between the various Technical Boards of Appeal in 2009 have yet to be published, but in 2008 the distribution was as follows:-

- 34.9% Mechanical
- 37.5% Chemical
- 11.4% Physical and
- 16.2% Electrical

3.2.1.7 One new case was referred to the Enlarged Board of Appeal in 2009, compared with four in 2008. Decisions were issued in two cases before the Enlarged Board of Appeal in 2009 and one case in 2008.¹

3.2.1.8 Under Article 112a EPC, which was introduced with the EPC 2000, parties adversely affected by a decision of the boards of appeal may file a petition for review by the Enlarged Board on the grounds that a fundamental procedural defect occurred in the appeal proceedings or that a criminal act may have had an impact on the decision. A petition for review is examined by an Enlarged Board of Appeal consisting of two legally qualified members and one technically qualified member. A petition which is clearly inadmissible or clearly unallowable is rejected, otherwise a decision on the petition is taken by an Enlarged Board of Appeal consisting of four legally qualified members and one technically qualified member.

3.2.1.9 In 2009, twenty one petitions were filed, compare with eleven in 2008.

3.2.1.10 English was the language of the proceedings used in the majority of appeal proceedings and PCT protests filed in 2008 (71.5%). German and French were used in 23.7% and 4.8% of cases, respectively.

3.2.2 Duration and outcome

3.2.2.1 Complete statistics on the duration and outcome of proceedings before the Technical Board of Appeal in 2009 are not yet available, hence the 2008 statistics are presented here.

¹ <http://www.epo.org/patents/appeals/eba-decisions/date.html>

3.2.2.2 The average duration of ex partes technical proceedings decided before the EPO in 2008 was 24 months.

3.2.2.3 Sixty four percent of ex parte cases (470 in total) were decided after substantive legal review in 2008, i.e. not terminated through rejection of the appeal as inadmissible or through withdrawal of the appeal or patent/patent application.

3.2.2.4 About 48% of substantively reviewed ex parte appeals were successful (in whole or in part) in 2008 and about 52% were dismissed. For a little under half of the successful appeals, grant of the patent was ordered, and for the rest the resumption of examination was ordered.

3.2.2.5 When appeals by the patentee and appeals by the opponent are considered together, the average duration of inter partes proceedings that were decided before the Technical Boards of Appeal in 2008 was 26 months.

3.2.2.6 Seventy four percent of inter partes cases (743 in total) were settled after substantive legal review (as opposed to mere issues of admissibility) in 2008. Of these, about 61% were successful (in whole or in part), with:-

- maintenance of the patent as granted ordered in about 3% of cases
- maintenance of the patent in amended form ordered in about 21% of cases
- revocation of the patent ordered in about 26% of cases, and
- resumption of opposition proceedings ordered in about 11% of cases.

No statistics are available for the outcome of the 39% of appeals which were unsuccessful, the results of which depend, inter alia, on which party was the appellant.

3.2.2.7 Before the Enlarged Board of Appeal, three petitions for review were withdrawn in 2009, thirteen were rejected as being clearly inadmissible or clearly unallowable, one was rejected as being unallowable by a five-member Enlarged Board of Appeal, and in one petition the decision of the Board of Appeal was set

aside and remittal ordered.² Other than this last case, all petitions for review filed to date have been unsuccessful. In 2008, three decisions issued, all of which held that the petition was clearly unallowable.

3.2.3 Successful appeals to the Technical Board of Appeal by the patentee

3.2.3.1 Based on the above inter partes appeal figures for 2008, and very simplistically, 35% (= 3% + 21% + 11%) of cases could be those in which the patentee has had complete or partial success on appeal and 58% (= 21% + 26% + 11%) could be cases in which the opponent has had complete or partial success on appeal. This analysis includes the indeterminate 21% and 11% tranches in both camps. There is, however, reason to suppose that the 11% tranche represents successful appeals by the patentee.

3.2.3.2 Remittal is the normal outcome if a head of invalidity has not been considered at first instance, which is often the case because the first instance ends the debate on a claim request as soon as one head of invalidity is found. Remittal is not ordered if non-remittal is in the public interest, but such occasions are statistically rare.

3.2.3.3 Remittal can thus normally occur only on appeal when there has been a first instance decision made against a patentee's claim request on a head of invalidity before the last head pleaded and requiring consideration. A successful appeal by the patentee against that previously decided head will give the appellate instance a prima facie obligation to remit to first instance the heads it did not address previously in relation to the patentee's claim request in question.

3.2.3.4 An opponent appeal will only occur at all if the patentee has secured a favourable first instance decision on at least an auxiliary claim request. Because that claim request will have to have survived first instance challenges on all pleaded invalidity heads, any opponent

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<http://www.epo.org/patents/appeals/eba-decisions/petitions.html> and <http://www.epo.org/patents/appeals/eba-decisions/decisions-on-petitions.html>

appeal cannot be against a background of any invalidity head having been left unaddressed by the first instance against the successful claim request.

3.2.3.5 The 11% tranche where resumption of opposition proceedings was ordered ought therefore to be cases where the patentee lost at first instance on one head of validity (with the result that the first instance would not have continued to another head) and won on appeal as to that head, the appellate instance then ordering remittal to first instance for the other heads of validity to be considered.

3.2.3.6 This scenario would suggest that the 11% belongs to the patentee at the expense of opponent, giving 35% of appeal cases which could be those in which the patentee has had complete or partial success on appeal and 58% - 11% = 47% in which the opponent has had complete or partial success on appeal.

3.2.3.7 The above reasoning is applicable even to the extent that appeals are cross-appeals. In those cases, the patentee will have lost on his granted claims (or other main claim request) at first instance with perhaps not all heads considered, but he will have won on an auxiliary claim request. Both parties may then have appealed - the patentee wanted his main request granted at first instance but failed and the opponent thought the allowed auxiliary claim request invalid. A win for the patentee (normally) results in remittal. A win for the opponent on any one head of validity means all patentee requests fail and there will be no remittal.

4. Conclusion

Although it is difficult to see any significant trends in these data, it appears that the number of decisions issued by the Opposition Divisions and the Boards of Appeal is increasing and, unsurprisingly, the relatively new petition for review procedure is gaining in popularity. In addition, with the steady increase in the proportion of opposed cases that are revoked by the Opposition Divisions, it is clear that the opposition procedure is a powerful weapon that companies should consider using against their competition.

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Peer reviewed by Jon Broughton

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