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European Oppositions

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European Oppositions

- Preparation
- Demeanour
- Opening statements
- Case citation
- Experimental evidence
- Experts
- Withdrawing requests
- Costs
- Appeals

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Preparation

- Written submissions are vital
- So cover every point
- But don't
  - include more than necessary
  - deny there are better and worse points
- The medium is **not** the message
- Beware standardisation
- For the OP, prepare topics in "modules"
- Preparation is never complete

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Demeanour at Oral Proceedings

- Formality/familiarity (“Vous”)
- Language
  - Avoid colloquialisms
  - Don’t talk just to the native English speaker
  - Be familiar with EPOnglish
  - Simultaneous translation
- Body language
  - Gestures, appearances are important
  - Eye contact (good and bad)
  - Nodding and shaking of heads
- Control
  - your team
  - your temper

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Opening statements at Oral Proceedings

- Introductions
  - Beware the “scriptwriter’s trap”
  - Better bin the summary than annoy the Division
  - Have an alternative (use the modules)
- Tell them what you’re going to tell them
  - Then tell them
  - Then tell them what you’ve told them

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Presentation at Oral Proceedings

- Make structure clear
- Follow your written arguments
- Don’t just read out notes
- Don’t cover everything
  - Emphasize good points
  - Not bad points
  - But be prepared to answer them
- Watch the reactions
- Have the modules ready

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Case citation

- Don’t cite a large number of T decisions
- Use the decision not the Case Law book
- Beware “established case law of the Boards of Appeal”
- Guidelines v. case law
- Give notice of cited decisions
  - Explain in written submissions
  - Give notice before oral proceedings

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Experimental evidence

- Is it necessary?
- File it as early as possible
- Is it inherently convincing
- Put all your cards on the table
  - After checking the cards carefully
- If you bring the expert who did it…

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Experts

- Several types of expert:
  - A party's own technical expert
  - The inventor
  - An independent (authoritative) expert
- What they may say:
  - The skilled person
  - State of the art
  - Novelty, inventive step, etc.
- How they say it:
  - Declarations
  - Accompanying persons
- What value they may have
- Ensure they know what **not** to say

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Withdrawing requests

- Art. 12(4) RPBA
  - *"Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the* [complete case] *requirements in (2)."*
- Interpreted to exclude requests not made at first instance
- Discretionary but increasingly invoked
- So
  - File all possible requests during opposition
  - Don't withdraw any
  - Insist on a decision on each

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Costs

- Why is there a “no-costs culture” at the EPO?
- Costs only usually to sanction bad behaviour (Art 104 EPC - “for reasons of equity”)
  - Unannounced absence at oral proceedings
  - (Very) late-filed evidence
- Patent attorneys dislike the costs of costs
- More costs might lead to better behaviour

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Appeals

- They cannot be avoided
- File a precautionary appeal after interlocutory decision
- Learn from reactions of Opposition Division
- And still expect the unexpected

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