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## IS IT TOO LATE? INVENTIVE STEP ATTACKS IN APPEALS BEFORE THE EUROPEAN PATENT OFFICE

In January 2020 the Boards of Appeal (BoAs) of the European Patent Office (EPO) introduced new rules of procedure. These rules are aimed at ensuring that appeal proceedings before the BoAs are not used by the parties in proceedings before the EPO to reopen the first instance examination or opposition proceedings. In fact, appeal proceedings before the BoAs are a judicial review of the correctness of the first instance decision, i.e. the decision taken by the EPO Examining Division or Opposition Division, and they are not an opportunity for the parties to discuss anew everything that was put forward before those Divisions and more. The nature of the judicial review of appeal proceedings before the BoA was already enshrined in the rules of procedure that were in force prior to January 2020, but the new rules of procedure make this even more explicit.

A recent decision of the BoAs, although taken on the basis of the rules of procedure that were in force prior to January 2020, is quite interesting as it addresses the question of whether a lack of inventive step attack can be raised for the first time in appeal proceedings when it was not raised during the first instance proceedings.

During the opposition leading up to this BoA decision, the opponent had only argued that the patent lacked novelty over a certain piece of prior art, but had not also argued - e.g. as a fall-back position - that the patent lacked inventive step over that prior art. The Opposition Division had decided that the patent did not lack novelty over that prior art. On appeal, the opponent argued for the first time, during the hearing concluding the appeal proceedings, that the opposed patent also lacked inventive step over the prior art that was previously used to argue lack of novelty.

To justify this late-filed attack, the opponent argued that that attack was a response to the BoA's preliminary opinion issued before the hearing, and that since that attack was based on the same prior art that was previously used to argue lack of novelty, the patentee would not be taken by surprise.

However, the BoA ruled that the lack of inventive step attack was inadmissible, reasoning that:

- The BoA's preliminary opinion did not introduce new aspects into the discussion that would justify the submission of a new attack;
- The opponent had raised the new attack only during the final hearing, while he could have already raised it by the deadline indicated in the BoA's preliminary opinion for the parties to file their final submissions prior to the hearing, thereby giving the patentee sufficient time to prepare a rebuttal;
- While the use of the piece of prior art that was previously used for the lack of novelty attack as the closest prior art (i.e. the starting point) for the lack of inventive step attack could be reasonably predicted by the patentee, the patentee could not reasonably predict which other prior art documents the opponent would use to complete that attack. Thus, admitting the new attack into the proceedings could have jeopardized procedural efficiency, as the patentee could then have legitimately requested that the hearing be adjourned.

The above BoA decision, read in conjunction with the new rules of procedure of the BoAs, is a stark reminder that all possible grounds of opposition should be raised as early as possible in proceedings before the EPO, in order to avoid the risk of their not being admitted into the proceedings. The strategic advice is therefore to carefully consider all possible grounds of opposition when filing an opposition at the EPO, so as to include from the outset all the grounds that the opponent may wish to rely on throughout the proceedings.