1 Introduction

One of the core aspects of a patent attorney’s job, when representing his or her clients before the European Patent Office, are opposition and appeal proceedings. The patents litigated in these proceedings are mostly of high commercial value for both the patent proprietor and the opposing parties. Success in these proceedings is therefore extremely important. A saying often quoted by patent attorneys is ‘expect the unexpected’, which reflects the difficulties attorneys are confronted with in these proceedings. This is partly linked to a lack of knowledge and, more importantly, a lack of understanding of the legal framework within which opposition and appeal proceedings take place. Another important reason is a lack of practical experience with these types of proceedings before the European Patent Office.

The first objective of this book is therefore to set out in detail the legal framework for opposition and appeal proceedings before the European Patent Office. Knowing and understanding the legal framework is a necessary but not a sufficient precondition for success. More specifically, this legal framework leaves the parties with ample room for manoeuvre, and success very often depends on which of the many options available within this legal framework are chosen. Accordingly, the second objective of this book is to give practical advice on which choices are appropriate in which circumstances. This does not only concern choices available in opposition and appeal proceedings. On the contrary, during the filing and prosecution stage many options are already available and a wrong choice at this stage may have a detrimental effect later on in opposition and appeal proceedings. Therefore the book also tries to give advice about what should be done when drafting and prosecuting European patent applications with a view to opposition and appeal. To emphasize these practical aspects at all stages of the proceedings, the book contains numerous ‘practical advice’ paragraphs for each topic and tries to set out the consequences of wrong or right choices by means of ‘example cases’. In most example cases the case is presented as it evolved with emphasis on the issues relevant
for the book. In some examples an existing case was modified by adding the authors’ own thoughts beyond what was in the decision. For these latter examples, it was decided not to mention the case number. Throughout the book the practical advice and example cases have been cast in a different lay-out to distinguish them from the main text.

To the authors’ knowledge, the present book is the first book that combines detailed information on the legal framework for opposition and appeal proceedings with practical advice for the successful conduct of these proceedings. In the authors’ opinion this book is unique for the further reason that it deals with all stages of proceedings before the European Patent Office, including the drafting and prosecution stage, with a particular emphasis on the types of choice needed at each stage to be successful in opposition and appeal. Additionally, last but not least, the present book is the first to discuss in depth the Rules of Procedure of the Boards of Appeal as in force since January 2020, from a theoretical as well as practical perspective.