

# Constraints on inventive step attacks in opposition procedures at European Patent Office

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The number of inventive step attacks in opposition procedures at the European Patent Office may be constrained in the future due to a recent change in the EPO Guidelines. According to David Brophy, partner at FBK Kelly, the change will improve efficiency, although the restrictions may also open up a new avenue for criticising decisions on appeal. Kluwer IP Law asked Brophy what has changed.  
'An opponent seeking to revoke a patent will naturally wish to have multiple attacks, since only one needs to succeed. The Guidelines have been changed to make it harder in some cases to launch multiple attacks based on lack of inventive step.'

The first step in the "problem and solution" approach favoured by the EPO in assessing inventive step, is to identify the closest prior art. The phrase itself, "the closest prior art", would seem to imply that if document A is the closest prior art, then document B cannot also be "closest", but this is not necessarily true. The EPO Guidelines for Examination (G-VII, 5.1) have long recognised that *"In some cases there are several equally valid starting points for the assessment of inventive step... If a patent is to be granted, it may be necessary to apply the problem-solution approach to each of these starting points in turn."* The passage furthermore said *"In such a situation, there is no need to discuss which document is 'closest' to the invention; the only relevant question is whether the document used is a feasible starting point for assessing inventive step."*

In practice, because the latter part of this instruction appears to say "don't worry about whether the starting point really is 'closest' or not", opposition divisions have often given little weight to arguments that a document was not in fact the closest prior art. The error in this approach (in my view) was that it ignored the opening sentence which implies that to qualify for consideration, the starting points must be "equally valid" and that this will only apply "in some cases". Efforts by a patentee to prevent a succession of attacks using different starting points have often been dismissed because if an attack based on a new starting document appeared plausible, it was assumed that the starting document must implicitly have been a candidate for the closest prior art, which appears to me to be a back-to-front approach to the question.

The November 2018 version of the Guidelines have added an important qualifier. While maintaining the same acknowledgment that there may be several equally valid starting points and that in such cases inventive step must be assessed in turn from each such document, and also that among those documents there is no need to determine which is the absolute "closest", the Guidelines now add: *"However, applying the problem-solution approach from different starting points, e.g. from different prior-art documents, is only required if it has been convincingly shown that these documents are equally valid springboards. In particular in opposition proceedings the structure of the problem-solution approach is not that of a forum where the opponent can freely develop as many inventive step attacks as he wishes in the hope that one of said attacks has the chance of succeeding (T 320/15, Reasons 1.1.2)."*

## **Why do you think this change was introduced?**

'Changes to the Guidelines for Examination are typically driven by two factors: either the case law has developed in such a way that the change is unarguably required (e.g. due to a decision from the Enlarged Board, or a decision has become so widely cited that it expresses a generally accepted principle, or almost all the Boards are deciding the same issue identically), or the EPO management wants to implement a change in practice for its own reasons. Decision T320/15 cited in the new Guidelines as justifying the change is not a widely cited or landmark decision in any sense, and therefore we can assume that the change was made instead for internal reasons, and to encourage a change in how oppositions are handled. The reason I say it was not a landmark decision is that T 320/15 has not as yet been cited in any other case; in addition every decision of the Boards of Appeal is graded for distribution purposes from "A" (publication in the official journal) down through "B" and "C" (varying degrees of distribution to members of other Boards), to the lowest level "D" (no distribution), and T 230/15 was graded "D".

From this I would infer that those in charge of managing oppositions in the EPO have a feeling that opponents are presenting "too many" attacks, which increases the complexity and time taken to hear and decide on opposition cases. By discouraging multiple attacks from different starting points, those in charge may hope to encourage a more streamlined and focussed approach to inventive step. It may not be a coincidence that this change follows closely upon the introduction at the start of 2018 of dedicated opposition directorates which were created to improve the efficiency and coherence of opposition proceedings.'

***In a recent article you quoted Groucho Marx's statement "Those are my principles, and if you don't like them... well, I have others." to describe the situation before November 2018. Do you think the new guidelines are an improvement?***

'Personally, I do think the change is for the better. However, I recognise that my view may be influenced by the fact that in my own practice I more frequently represent patentees than opponents! Objectively, however, I think it is beneficial overall to ensure that if the problem-and-solution approach is being used, it is applied rigorously and fairly, and that the initial step of identifying the closest prior art is not glossed over. It is still very much open to an opponent to argue that there are a number of equally valid starting points, provided only that they can justify this position to the opposition division and not just have it assumed to be true.'

## **Does this increase the efficiency of the opposition procedure?**

'It will certainly improve efficiency in some oppositions, where inventive step is the main issue and where the number of documents is large. Ensuring that attention is focussed on a small number of attacks benefits the parties in terms of preparation for oral proceedings and the associated costs, and should also ensure that oral proceedings can be run more efficiently to arrive at a good decision with fewer surprises.'

## **Do you see disadvantages?**

'Well, apart from the obvious disadvantage that an opponent may have to make harder choices when deciding which attacks to argue, there is also a likelihood that it will open up a new avenue for criticising decisions on appeal. Every time that an opposition division has to decide a preliminary point like this, which is basically an admissibility point applied to an argument, it opens up the final decision up to criticism on appeal from one side or the other - after all they have to disappoint one or another party whichever way they decide. There is also a delicate balancing act to be carried out between curtailing the introduction of new attacks and respecting the right to be heard that is enshrined in Art. 113 EPC. I'm sure that if you ask me again after I have been on the wrong end of the new Guidelines I'll think of a few more disadvantages.'

## **How should parties change their approach to inventive step to respond to the new Guidelines?**

'Decision T 320/15 emphasises a point found elsewhere in the Guidelines, which is that the first step in the problem-and-solution approach is to actually identify the closest prior art. Opponents should be careful to explicitly justify on every occasion why their chosen starting point is the closest prior art, and if a second starting point is introduced, great care needs to be taken in developing an argument that it represents an "equally valid" starting point. Conversely, a patentee in opposition should be ready to argue why their preferred starting document is the (sole) closest prior art, and to have arguments to hand as to why each other document that might be a plausible starting point is not "equally valid" according to the criteria found in the Guidelines and Case Law.'