

# Kluwer Patent Blog

## Dear Mr. President A word on the composition of the Opposition Division Part I

Dr. Malte Köllner · Wednesday, July 31st, 2024

This is an open letter directed to the President of the EPO in his capacity to give directions on the composition of Opposition Divisions. Article 19 EPC explicitly permits the Primary Examiner to be member of an Opposition Division. Many applicants and representatives, however, have a feeling of bias in favour of the patentee before Opposition Divisions. This bias is perceived as a consequence of the participation of the Primary Examiner. I will show that this feeling is justified. Article 19 leaves discretion to the office to call the Primary Examiner to the Opposition Division or not. I urge the President to give directions to the effect that this discretion should be used in a way as not to call the Primary Examiner to the Opposition Division.



Dr. Malte Köllner

### 1. Historic development

The role of a member of the Examining Division, namely the Primary Examiner, in opposition proceedings was a hotly debated topic during the preparation of the EPC.<sup>[1]</sup>

#### 1.1 Member

Proposals were brought forward to the effect that no member of the Examining Division, let alone the Primary Examiner, should be a member of the Opposition Division:

*97. The Committee had before it several proposals from the Observer delegations (IAPIP M/24, point 4, CEEP M/30, point 3. CNIPA M/20. point 6, FEMIP I M/23, point 7 and UNICE M/19, point 2) which were primarily aimed at precluding (although the emphasis differed somewhat in certain proposals) a member of an Examining Division from participating in the work of an Opposition Division considering a case relating to a patent where he had been involved in examining the application for that patent.<sup>[2]</sup>*

These proposals, however, were not supported by a sufficient majority. It was deemed beneficial to the economy of the proceedings to have a member of the Examining Division as member of the Opposition Division as they are familiar with the file, i.e. with the invention, the interpretation of

the claims, and the prior art.<sup>[3]</sup>

## 1.2 Rapporteur

Time and again, it was argued that a member of the Examining Division, if they are admitted as a member of the Opposition Division, should then not be rapporteur.<sup>[4]</sup> This proposal was again not supported by a sufficient majority.

One supporting argument was again the (Primary) Examiner's knowledge of the file. There was agreement that at most one member from the Examining Division could be member of the Opposition Division.<sup>[5]</sup>

Concerns about impartiality were set aside by later case law with the argument that the Primary Examiner could always be overruled by 2:1 by the other members of the Opposition Division.<sup>[6]</sup> This seems to also have been the rationale during the Munich Diplomatic Conference behind having at most one member from the Examining Division in the Opposition Division.

## 1.3 Chairman

Agreement was quickly reached that in order to preserve impartiality, no member of the Examining Division should be chairperson of the Opposition Division.<sup>[7]</sup>

This led to Article 19 EPC in its present form.

## 2. Current legal situation

Article 19 EPC in its present form reads (insofar as of interest to us)

*Article 19 Opposition Divisions*

(1) [...]

(2) *1An Opposition Division shall consist of three technically qualified examiners, **at least two** of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates.*

*2An examiner who has taken part in the proceedings for the grant of the European patent **may not be the Chairman.***

*3Before a decision is taken on the opposition, the Opposition Division may entrust the examination of the opposition to one of its members.*

4[...]

*5If the Opposition Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner **who shall not have taken part in the proceedings for grant** of the patent.*

6[...]

Article 19 allows a member of the Examining Division, i.a. the Primary Examiner, to be member of the Opposition Division (1st sentence). It does, however, not prescribe that the (Primary) Examiner has to be member of the Opposition Division (*at least two*). A former member of the Examining Division may not be the chairman (2nd sentence) but could be the rapporteur (3rd sentence). A legally qualified member may not have participated in the proceedings that led to

grant of the patent (5th sentence).

Article 19 does not focus on the Primary Examiner. Any member of the examining division is treated equally: “*examiner[...] shall not have taken part in the proceedings for grant of the patent to which the op-position relates*“. For simplicity and clarity reasons, we will focus on the Primary Examiner. However, our arguments relate to all members of the examining division.<sup>[8]</sup>

In the following sections, I will try to understand whether these decisions were reasonable and the arguments that led to them were convincing.

### 3. Perceived Bias

Opponents frequently perceive a bias in favour of the patentee before the Opposition Division. Is there a bias?

In an article recently published in *epi information*<sup>[9]</sup> the outcomes of decisions by the Opposition Division were compared to the outcomes of decisions of the boards of appeal. One of the major results is shown in Fig. 1.

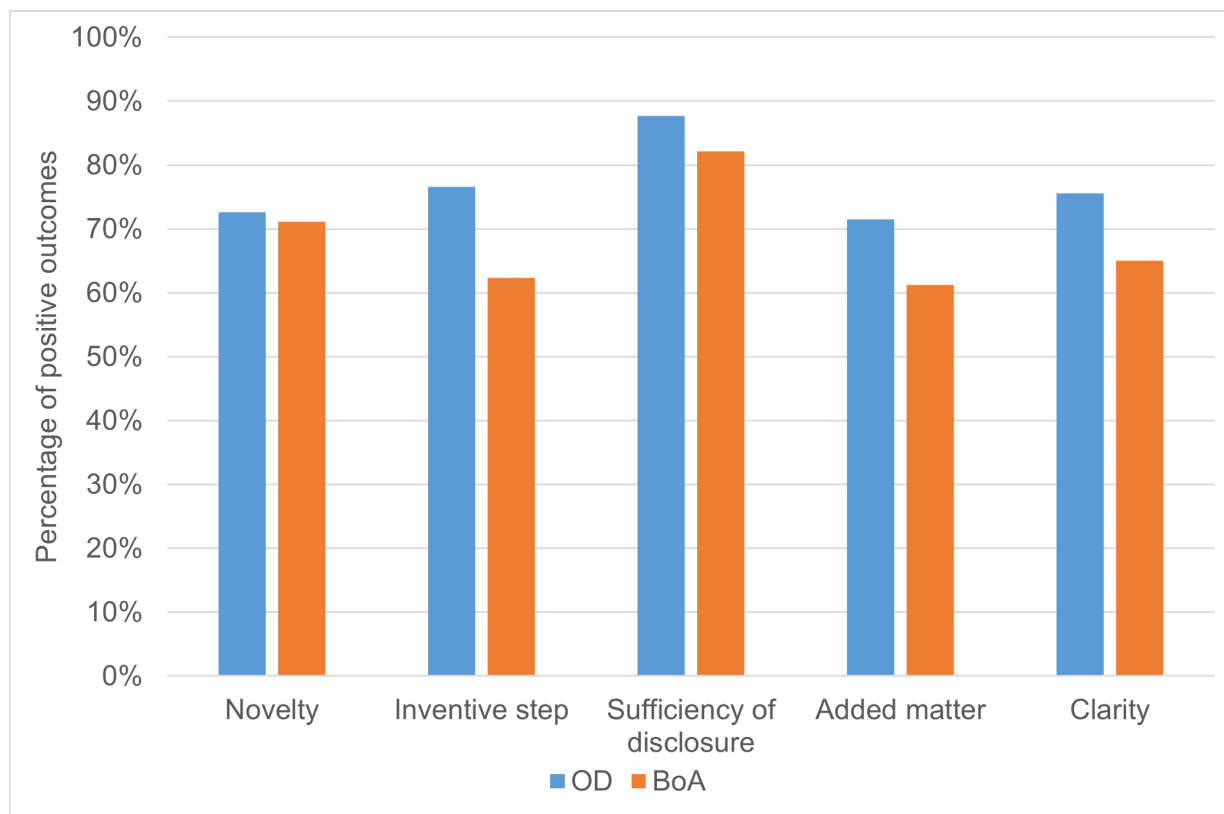


Fig. 1: Percentage of decisions in favour of the patentee concerning individual grounds of opposition from 2013 to 2022

Fig. 1 shows the percentage of a positive outcome for the patentee for different questions that were discussed during the proceedings. It is possible that in a single decision more than one question was discussed with the parties and decided upon.

It seems fair enough to state that there is a bias in favour of the patentee before the Opposition Division. An outcome in favour of the patentee is always more likely before the Opposition Division than before the Board of Appeal. At least it is totally understandable that opponents

perceive it that way.

This finding is supported by a further analysis which came to the conclusion that decisions of Opposition Divisions are significantly more often revoked by a Board of Appeal than rejections of patent applications.<sup>[10]</sup>

#### **4. Primary Examiner can be overruled?**

It was argued in case law that the Primary Examiner can be overruled by 2:1 by the other members of the Opposition Division. This will guarantee objectivity of the decision.<sup>[11]</sup>

This argument ignores how decisions are taken in groups namely in groups as small as a group consisting of only three persons. Empirical studies show that groups have an extreme likelihood of a convergence of the opinions. Even if initially the three members may have very different opinions, over time and until a decision is reached their opinions converge.<sup>[12]</sup>

Applied to the Opposition Division this means the presence of the Primary Examiner will always influence the opinion of the other members of the Opposition Division. The Primary Examiner influences the other members of the Opposition Division to vote in their direction. This is unavoidable.

This general statement is true for all members of the Opposition Division. However, the other members are impartial and, thus, not problematic, while the Primary Examiner is likely partial. Is the Primary Examiner marking their own homework.

As a consequence, decisions taken by Opposition Divisions, which have the Primary Examiner as member, will – statistically speaking – show a bias towards the opinion of the Primary Examiner. The hypothesis is that the Primary Examiner is more inclined to uphold the patent than to revoke it – as they already voted in this direction once. Fig.1 seems to empirically prove this.

#### **5. Beneficial to the economy of the proceedings?**

The other argument that was brought forward during the preparation of the EPC was that it is beneficial to the economy of the proceedings if the Primary Examiner takes part in the opposition proceedings as the Primary Examiner knows the file, meaning knows the invention and the prior art.<sup>[13]</sup>

I dare to question this argument. The perceived bias in favour of the patentee leads to unusually high numbers of appeals being filed. The opposition proceedings have to be considered as a complete entity, including first instance and appeal. It is of no avail if the first instance is efficient, but we often need appeals to end the opposition proceedings. An efficient proceedings has a convincing result in the first instance and ends there. The effort to additionally go through appeal is the opposite of efficiency.

The unusually high numbers of appeal largely wipe out any benefits from the knowledge of the file of the Primary Examiner. Let's dig into the numbers.

The average time it takes for opposition proceedings before the office was 19.6 months in 2022.<sup>[14]</sup>

Appeal proceedings take on average 56 months.<sup>[15]</sup> The sum of these two numbers is 76 months or more than 6 years!

It is, however, more adequate not to add these two numbers but to try to calculate the statistical expectation value of the average duration of opposition proceedings (first instance + appeal). To this end, the following Tab. 1 lists the number of opposition decisions in 2022 as well as the number of appeals against opposition decisions filed in 2022.

<b>in 2022</b>	<b>number</b>	<b>duration</b>
<b>oppositions decision taken</b>	3 799 <sup>[16]</sup>	19.6 months
<b>appeals filed</b>	1 978 <sup>[17]</sup>	56 months
<b>percentage of appeals</b>	52%	

Tab. 1: Number of opposition decisions and appeals filed in 2022

In 52% of the cases appeals were filed. This seems a rather high number.

With these numbers, the average duration can be calculated as: 19.6 months for opposition + 2 months for filing appeal + 52%\*56 months for appeal = 50.8 months, which is slightly longer than 4 years.

Is this long? Is 52% a high percentage for appeals? To get a better feeling concerning these numbers, let's take a look at the "same" numbers in German invalidity proceedings for comparison.

<b>in 2022</b>	<b>number</b>	<b>duration</b>
<b>invalidity decisions taken</b>	240 <sup>[18]</sup>	25.4 months <sup>[19]</sup>
<b>appeals filed</b>	48 <sup>[20]</sup>	app. 24 months <sup>[21]</sup>
<b>percentage</b>	20%	

Tab. 2: Number of German invalidity suits and appeals filed in 2022

The average duration for German invalidity proceedings would then be: 25.4 months for invalidity at the Bundespatentgericht + 1 months for filing appeal + 20%\*24 months for appeal at the Bundesgerichtshof = 30.2 months, which is about 2.5 years.

Most strikingly, it looks like the acceptance rate of first instance decisions being at 80% is at lot higher than for Opposition Division decisions.

Although we always have to be careful with these sorts of statistics, it nevertheless looks like the desired efficiency and economy of proceedings by including the Primary Examiner in the Opposition Division is not achieved. Opponents file appeals in very high numbers in order to get a fair trial before impartial persons.

## 6. Intermediate result

The arguments brought forward in favour of Article 19 EPC in its current form and practice have

proven to be very shaky. It seems a lot more likely that the opposite is true. The Primary Examiner is unlikely to be overruled in the Opposition Division. Particularly if they are a rapporteur. And the overall procedural economy is deteriorated by the Primary Examiner's presence – and not the opposite.

“Munich, we have a problem!”

So, what can be done to change this unsatisfactory situation? Are there legal remedies?

We will explore this in Part II of this open letter.

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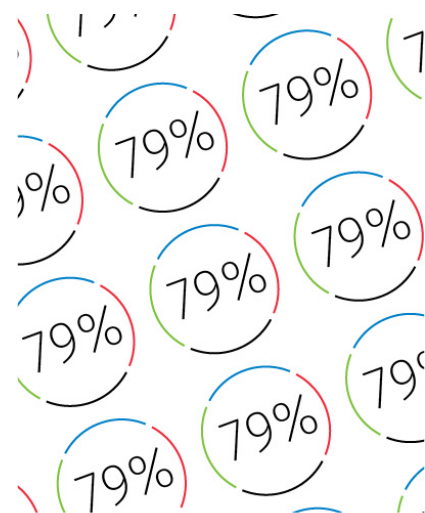
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