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Coordinating Patent Strategies Across PTAB And EPO

Of all the changes introduced by the America Invents Act, arguably the most impactful, from a procedural standpoint, has been the introduction of new post-grant proceedings. Inter partes reviews, post-grant reviews and covered business methods reviews have changed the landscape of enforcing patents and defending against infringement.

While some aspects of the post-grant proceedings remain controversial, these proceedings, as well as ex parte re-examinations, are faster and far less costly than traditional litigation. Because of this, the use of post-grant proceedings is likely to continue, and patent strategies will increasingly employ, or account for, these proceedings.

But when employing or accounting for these proceedings, practitioners should understand how the positions they take in those proceedings will impact positions in prosecution, litigation and other post-grant proceedings — both in the U.S. and abroad. For example, positions, arguments and prior art raised in U.S. post-grant proceedings, while not dispositive, may influence the positions, arguments and prior art raised in other jurisdictions. Likewise, practitioners should understand how a coordinated approach across jurisdictions can benefit their overall patent strategy.

Practitioners should pay particular regard to European Patent Office oppositions involving counterpart cases. The U.S. and the contracting states of the EPO represent nearly half of the world's GDP,[1] and the patent strategies for assets originating in either jurisdiction will almost certainly involve foreign filing in the other. U.S. post-grant proceedings and EPO oppositions share many traits, such as being adjudicated by three-member panels, being subject to appellate review and often being conducted in English.[2]

Both also feature a similar timeline of events and overall length of time to a final decision. For example, both U.S. post-grant proceedings and EPO oppositions feature: (1) a preliminary non-binding opinion following submissions by both parties; (2) an opportunity for both parties to respond to the preliminary opinion; and (3) an oral hearing before receiving a final written decision. EPO oppositions, similar to post-grant reviews, must be filed within nine months of grant. With a final decision in an EPO opposition usually given on the same day as the hearing, and the EPO's recent streamlining of opposition procedures to 15 months,[3] the overall length of an EPO opposition is substantially in line with U.S. post-grant proceedings.

Importantly, while often overlooked by U.S. practitioners, EPO oppositions represent the only current opportunity for central revocation of an EU patent. That is, if an EU patent is revoked at opposition, the patent is also revoked in each national jurisdiction. The stakes therefore involved in EPO oppositions are high, and attract a similar level of commitment, preparation and quality of arguments as U.S. post-grant proceedings.

Furthermore, it is common for prior art and/or positions taken in a U.S. proceeding to find their way into an EPO opposition, and vice versa. First, both EPO oppositions and U.S. post-grant proceedings are public forums where the prior art references, arguments and amendments are fully accessible via a patent number search of the European Patent Register[4] or the [USPTO's](#) PTAB E2E,[5] respectively. Second, while the law on prior art differs to some extent between the USPTO and the EPO, the approaches to patent jurisprudence are very similar; therefore, the

prior art references, arguments and amendments used in one are often applicable in the other.

The jurisdictions share similar basic concepts of novelty and obviousness. Although each jurisdiction features its own approach for determining the latter, disparities between decisions on obviousness, based on the same prior art, are more likely to be due to the composition of the respective three-member panels than to the standard used to determine obviousness. For example, the EPO favors the problem-solution approach for determining whether or not an invention lacks an inventive step (i.e., is obvious).[6] Although the problem-solution approach requires an establishment of the “objective technical problem” from the closest prior art reference, a concept not found in U.S. patent jurisprudence, the factual inquiries underpinning the problem-solution approach are similar to those outlined in *Graham v. John Deere Co.*[7] (e.g., determining differences between the claimed invention and the prior art, determining obviousness in view of the skilled person, etc.).

One area of significant difference is the U.S. and EPO standards for claim support. While the U.S. has a more patentee-friendly obviousness standard to determining whether or not a claim is supported by the specification (i.e., the invention is sufficiently described such that the skilled person can reasonably conclude that the inventor has possession),[8] the EPO uses a stricter standard (i.e., whether or not the claim is “directly and unambiguously” derivable), which is often compared to a novelty test in reverse.[9] As a practical matter, this makes attacks based on lack of support for a claim far more common in EPO oppositions, especially in divisional claim sets or amendments where the language of the claims does not have literal support in the specification.

EPO oppositions also have several procedural differences from U.S. post-grant proceedings that factor into overall strategic concerns. First, EPO oppositions lack discovery, do not require the real party of interest to be identified and do not have an argument estoppel effect. Thus, the risks involved in opposing EU patents are far less than those related to U.S. post-grant proceedings.

Second, EPO oppositions offer a better forum for introducing amendments and contingent claim sets (i.e., auxiliary requests). While both U.S. post-grant proceedings[10] and EPO oppositions[11] require all amendments to be made in response to a ground of the respective post-grant proceeding and not enlarge the scope of protection of the claims, the procedures for introducing these amendments is currently in a state of flux in the U.S.[12]

The procedures in the EPO, on the other hand, are more established and more patentee-friendly, with the ability to enter amendments and new contingent claim sets at many points in the procedure (even at the oral proceedings), although the admissibility of these claim sets can be at the discretion of the three-member panel based on: (1) the stage of the opposition procedure; (2) whether or not the claim amendments are prima facie allowable; and (3) whether or not the claims are in response to a new argument.

Finally, EPO oppositions are typically more dynamic than U.S. post-grant proceedings. For example, as a counterbalance to the EPO’s more patentee-friendly ability to enter amendments and new contingent claim sets, the EPO also allows late arguments and evidence to be entered at any stage, although the admissibility of new evidence is also at the discretion of the three-member panel based on: (1) the stage of the opposition procedure, (2) whether or not the new evidence is prima facie more relevant than already in the opposition; and/or (3) whether or not the new evidence is in reaction to a new amendment.

In conclusion, practitioners should be mindful of coordinating their strategies with prosecution, litigation and other post-grant proceedings, including those in foreign jurisdictions such as EPO oppositions. As stated above, EPO oppositions have similar timelines and similar patent jurisprudence in key areas, and will likely feature similar arguments and prior art.

Notably, the most impactful change, from a substantive standpoint, introduced by the America Invents Act was moving the U.S. from a first-to-invent to a first-to-file jurisdiction, further synchronizing the U.S. and EPO approaches.

Thus, the need to coordinate between U.S. post-grant proceedings and EPO oppositions will likely only increase — and U.S. patent attorneys should be mindful of differences in both substantive law and procedure, and how those differences factor into their overall patent strategies.

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[1] Gross Domestic Product of 2018, [World Bank](http://databank.worldbank.org/data/download/GDP.pdf), available at <http://databank.worldbank.org/data/download/GDP.pdf>.

[2] English is the first language in the EPO. As the language of the opposed patent is English in about 70 percent of EPO cases, it is automatically the language of the opposition proceedings in those cases.

[3] European Patent Office, Official Journal, May 2016, available at <https://www.epo.org/law-practice/legal-texts/official-journal/2016/05/a43.html>.

[4] <https://register.epo.org/regviewer>.

[5] <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/patent-trial-and-appeal-board-end>.

[6] See EPO, Guidelines of Examination, Part G, Chapter VII, 5, available at https://www.epo.org/law-practice/legal-texts/html/guidelines/e/g_vii_5.htm.

[7] See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

[8] See, e.g., *Moba BV v. Diamond Automation Inc.*, 325 F.3d 1306, 1309 (Fed. Cir. 2003).

[9] EPO, Case Law of the Boards of Appeal, II, E, 1.2.1, available at https://www.epo.org/law-practice/legal-texts/html/caselaw/2016/e/clr_ii_e_1_2_1.htm.

[10] See 37 C.F.R. § 42.121.

[11] See R. 80 EPC and Article 123(2)-(3) EPC.

[12] See *Western Digital Corp. v. SPEX Techs. Inc.*, Case IPR2018-00082, -00084 (Apr. 25, 2018) (Paper 13).

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