
Managing EPO Opposition Proceedings Alongside USPTO AIA Trial Proceedings

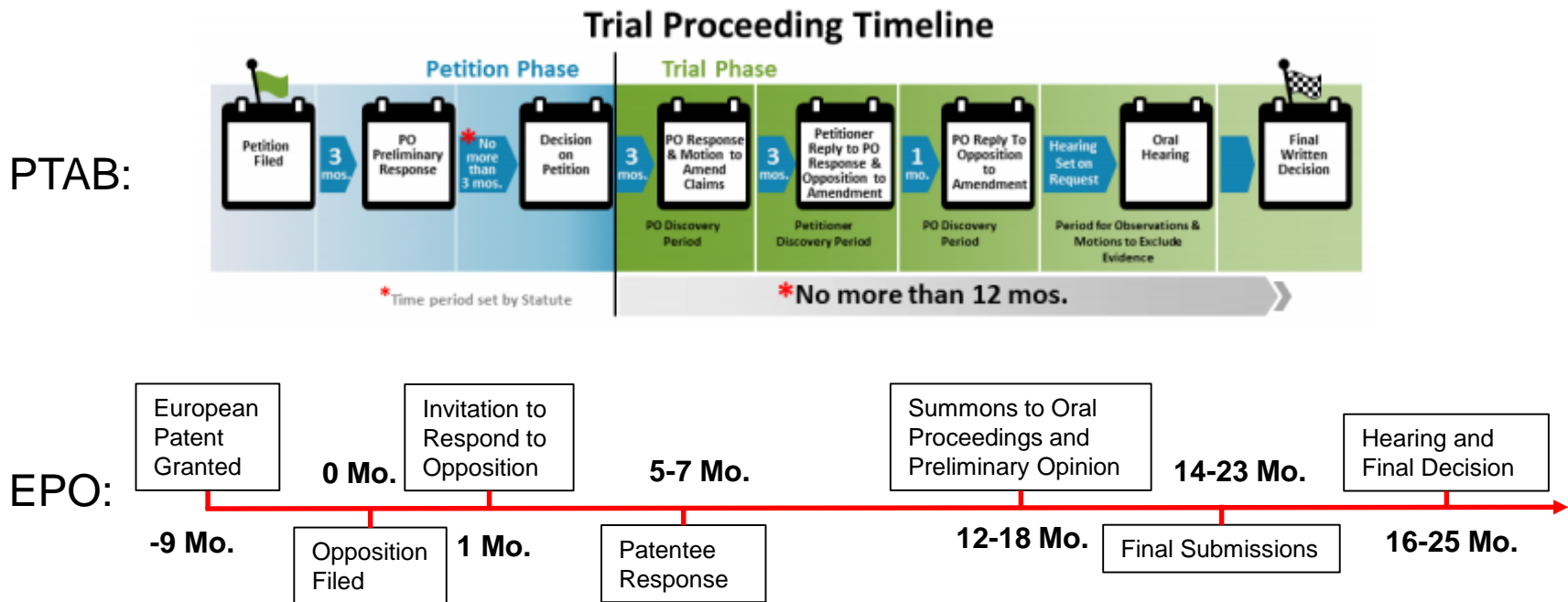
Participants:

- Gene Lee, Perkins Coie LLP (moderator)
- APJ Brian McNamara
- Mary Morry, Merck Sharp & Dohme Corp.
- Lily Rin-Laures, RinLaures LLC

Key PTAB & EPO Proceeding Differences (1 of 4)

- Timing

- PTAB: by statute, FWD issued within 12 months of institution
- EPO: flexible schedule; can take years although a streamlined procedure was introduced in 2016 in an attempt to reduce to 15 mo.



Key PTAB & EPO Proceeding Differences (2 of 4)

- **Deadline to File**
 - EPO: 9 months from “publication of the mention that the patent has been granted”
 - PTAB: PGR
 - within 9 months of issuance
 - PTAB: IPR
 - pre-AIA patents: 12 mo. after filing of infringement lawsuit
 - post-AIA patents: later of 9 mo. from issuance or termination of a PGR
- **Institution decision**
 - no such thing in EPO

Key PTAB & EPO Proceeding Differences (3 of 4)

- Admissibility of evidence
 - PTAB uses FRE
 - EPO reviews late-filed evidence for *prima facie* relevance and may admit at its discretion
- Witnesses/Experts
 - cross-examination not as of right in EPO Oppositions
- Claim amendments:
 - PTAB: a single motion to amend may be filed
 - EPO: multiple auxiliary claim sets may be filed, to be considered in the alternative, and may be considered in the non-binding preliminary opinion and during oral hearing

Key PTAB & EPO Proceeding Differences (4 of 4)

- Timing of Final Decision –
 - PTAB issues final written decision after hearing
 - EPO
 - issues a non-binding preliminary decision months before the hearing, and parties may submit further written submissions in response.
 - makes a decision at the hearing
 - issues a formal written decision after the hearing
- Estoppel
 - no estoppel arises from EPO Oppositions
- Appeal
 - appeal from EPO Oppositions does not require Art. III-type standing
 - EPO appeals go to an administrative agency (the EPO Technical Boards of Appeal)
 - PTAB appeals go to CAFC

IPR v. EPO Opposition

| Proc. | Filing Deadline | Estoppel | Completion Timeline |
|----------|--|-------------------------------------|--|
| IPR | pre-AIA patents: 12 mo. after filing of infringement lawsuit post-AIA patents: later of 9 mo. from issuance or termination of a PGR | Grounds that could have been raised | Must be completed within 12 months from institution, with 6 months good cause exception possible |
| EPO Opp. | 9 months from “publication of the mention that the patent has been granted” | None | Flexible |

- **From patent owner's perspective**
 - How best to keep US and EP arguments consistent?
 - Thinking ahead to US IPRs if EP oppositions come first?
 - Managing experts?
 - Differences in the law: plausibility vs. enablement for priority benefit?
 - Differences in the law: inventive step?

- **From challenger's perspective**
 - Timing – which to file first? Effect of a “win” in US or EP?
 - Differences in the law: plausibility vs. enablement for priority benefit?
 - Differences in the law: inventive step?
 - Using discovery from PTAB proceedings in EP oppositions?
 - Exploiting differences in approaches by patentee's experts?
 - Exploiting differences in arguments by patentee regarding claim interpretation, art, unpredictability?