



EUROPEAN PATENT AND
TRADEMARK ATTORNEYS

Top EPO opposition firms by technical areas of specialisation revealed

Analysis of EPO Opposition firms in more
detail, based on the IPC classification of
the opposed patents.

f

e

d

Detailed analysis of EPO opposition representation according to different fields shows that some private practice firms specialise in certain technical areas, while others have expertise across a wider range of IPC sections. Wannes Weymiers of NLO identifies which top private practice firms specialise in particular technical areas when representing clients in EPO oppositions and which are more generalist.

Different types of patentable technologies are classified according to the International Patent Classification (IPC) system. Within this system, inventions are classified in eight main sections:

- A:** Human Necessities;
- B:** Performing Operations, Transporting;
- C:** Chemistry, Metallurgy;
- D:** Textiles, Paper;
- E:** Fixed Constructions;
- F:** Mechanical Engineering, Lighting, Heating, Weapons;
- G:** Physics; and
- H:** Electricity.

Knowledge of which private practice patent firms have specific areas of specialisation and experience in EPO oppositions is useful for patentees or opponents when looking for the best possible representation in their field of technology. This article looks at what the data says about the kind of specialist work the top firms for EPO oppositions did during the 2017-2019 period.

Specialisation

Figures 1 to 3 show the evolution of the IPC section involvement of the top-20 private firms in EPO oppositions for the period 2017-2019. For the purposes of this article, we do not discriminate between opponent representation and patentee representation, but only focus on the technical field of the patents in suit. Within Figures 1-3, the percentage of represented oppositions of each technology is shown by the coloured subdivisions corresponding to IPC Sections A to H.

Figure 1 IPC section involvement of private firms as representatives in opposition before the EPO in 2017.

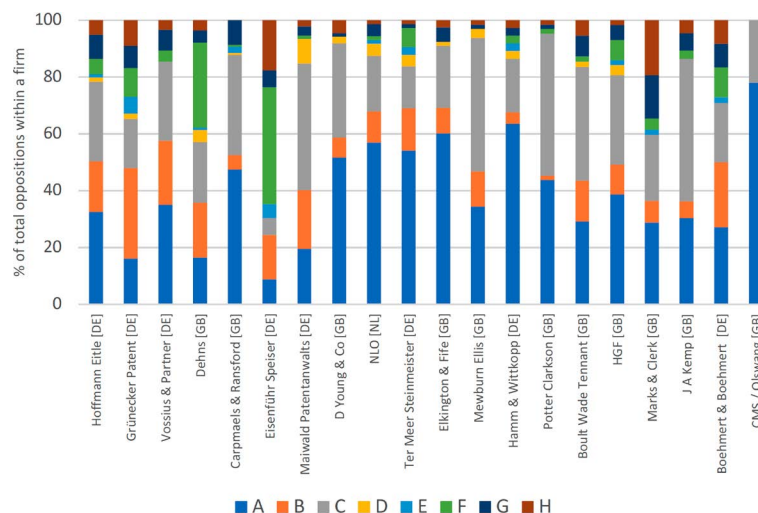


Figure 2 IPC section involvement of private firms as representatives in opposition before the EPO in 2018.

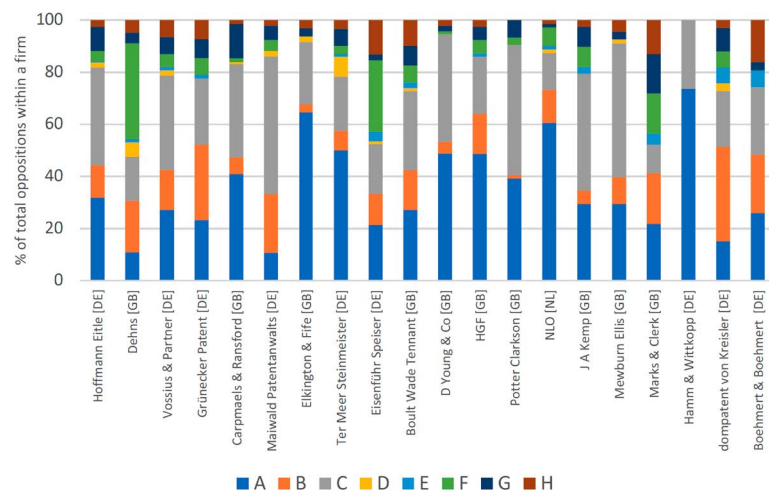
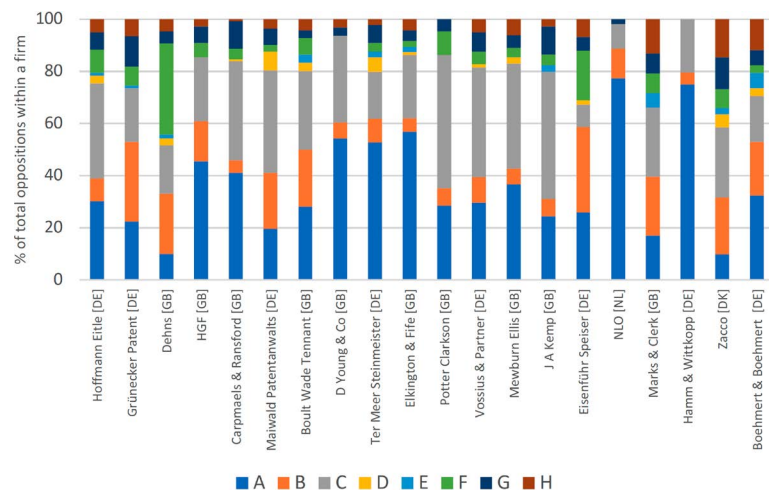


Figure 3 IPC section involvement of private firms as representatives in opposition before the EPO in 2019.



Generalists and specialists

Regarding the core technologies of each private practice firm, Figures 1-3 indicate that some firms tend to specialise in specific IPC sections (specialists), while others have portfolios which are not dominated by only one or two sections (generalists). For instance, looking at the 2019 data in Figure 3, some of the top firms - such as Hoffmann Eitle, Grünecker Patent and Dehns and other important firms such as Eisenführ Speiser, Marks & Clerk, Zacco and Boehmert & Boehmert - have opposition portfolios which are balanced over most or all of the IPC sections. We consider these firms generalists. By contrast, other firms - such as D Young & Co, Potter Clarkson, NLO and Hamm & Wittkopp - predominantly represent patentees in IPC sections A and C, and can be considered specialists in these sections.

Based on the relative proportion of patentee and opponent representation for a particular section with regards to the total representation of that firm, the most specialised patent firms in 2019 for each particular section are:

- For IPC section A: NLO (77%), Hamm & Wittkopp (75%) and Elkington & Fife (57%).
- For IPC section B: Eisenführ Speiser (33%), Grünecker Patent (31%) and Dehns (23%).
- For IPC section C: Potter Clarkson (51%), JA Kemp (49%) and Vossius & Partner (42%).
- For IPC section D: Maiwald Patentanwalts (7%), Ter Meer Steinmeister (6%) and Zacco (5%).
- For IPC section E: Boehmert & Boehmert (6%), Marks & Clerk (6%) and Boulton Wade Tennant (3%).
- For IPC section F: Dehns (35%), Eisenführ Speiser (19%) and Potter Clarkson (9%).
- For IPC section G: Zacco (12%), Grünecker Patent (12%) and J A Kemp (11%).
- For IPC section H: Zacco (15%), Marks & Clerk (13%) and Boehmert & Boehmert (12%).

While the specialisation of each of the private firms under analysis generally remained substantially stable during the 2017-2019 period, some firms have moved towards further specialisation in some areas. For instance, NLO has increasingly specialised in section A, moving from 57% in 2017 to 77% in 2019. Hoffmann Eitle, meanwhile, is becoming more specialised in section C, going from 28% in 2017 to 36% in 2019. However, it is becoming less specialised in section B, falling from 18% in 2017 to 9% in 2019. Dehns shows slightly increasing specialisation in section F, from 30% in 2017 to 35% in 2019.

Eisenführ Speiser has increased its representation in sections A and B, but not to the level of the top firms in these sections. At the same time, its specialisation in section H is decreasing, dropping from 18% in 2017 to 7% in 2019; and it shows the same trend for section F, down from 41% in 2017 to 19% in 2020. Thus, it seems that this firm is evolving from a specialised firm in sections F and H to a generalist firm with a more evenly spread portfolio. Finally, Boehmert & Boehmert's specialisation in section H has risen from 8% in 2017 to 12% in 2017, while Marks & Clerk's specialisation in the same section has decreased from 19% in 2017 to 13% in 2019.

Experience

Figures 4-11 show the percentage of total oppositions in a particular IPC section for the top-10 private firms between 2017 and 2019. The ones analysed are those that appeared in the top 20 of patentee and opponent representation in any of the years during the period. The top-10 firms for each IPC section, as presented in Figures 4-11, are ranked by the total number of oppositions in which these firms acted as representatives.

Figure 4 Private firm representation in IPC section A opposition procedures in the period 2017-2019.

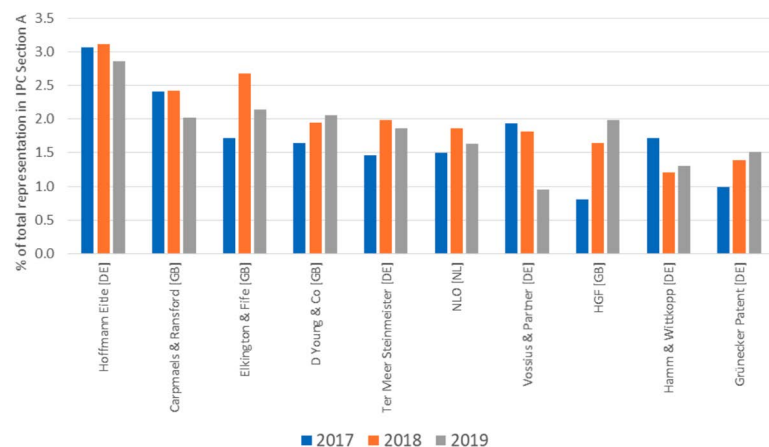


Figure 4 shows the top-10 private practice firms active in opposition procedure in the field of Human Necessities (IPC section A), the technical field with the highest extent of specialization as shown above. The top three is formed by German firm Hoffmann Eitle and UK firms Carpmaels & Ransford and Elkington & Fife. The first two present a decreasing percentage of patentee and opponent representation, while lower ranked firms, such as D Young & Co, Ter Meer Steinmeister, HGF and Grünecker Patent, show the opposite trend. In sixth slot overall, the only non-German, non-UK firm, NLO from the Netherlands, holds a strong position and consistently accounts for more than 1.5% of the total representatives.

Figure 5 Private firm representation in IPC section B opposition procedures in the period 2017-2019.

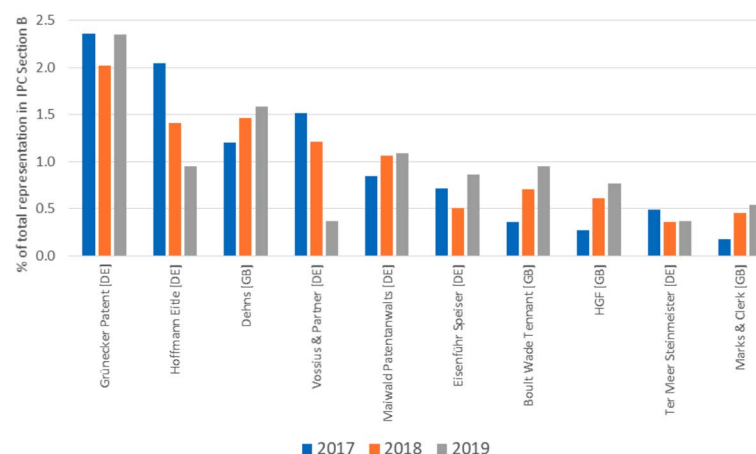
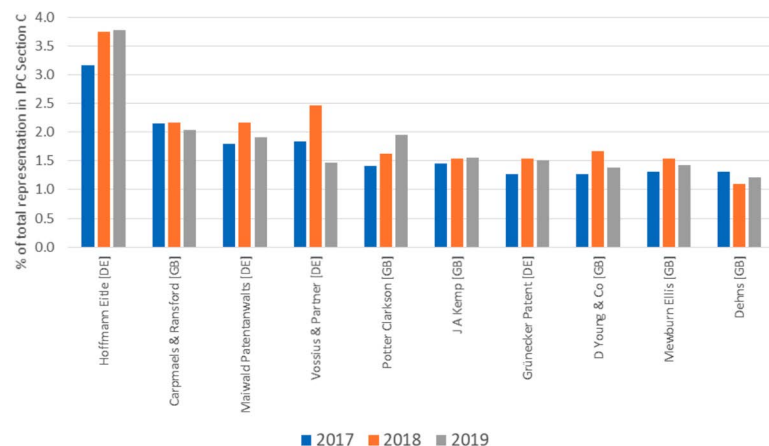


Figure 5 shows that Grünecker Patent, Hoffmann Eitle and Dehns are the top three firms in IPC section B (Performing Operations, Transporting). Of these, Grünecker Patent held first position during the entire 2017-2019 period. However, Hoffmann Eitle representation decreased markedly, while the one of Dehns share increased. Among the rest of the top 10, Maiwald Patentanwälte, Boulton Wade Tenant, HGF and Marks & Clerk representation appears to be increasing, while that of Vossius & Partner decreased sharply.

Figure 6 Private firm representation in IPC section C opposition procedures in the period 2017-2019.



Hoffmann Eitle, Carpmaels & Ransford and Dehns are the top three firms for IPC section C (Chemistry, Metallurgy), as shown in Figure 6. Hoffmann Eitle gained ground throughout the 2017-2019 period, while the other two remained relatively stable. Although most of the rest of firms in the top 10 showed little change, Potter Clarkson enjoyed a clear upward trend.

Figure 7 Private firm representation in IPC section D opposition procedures in the period 2017-2019.

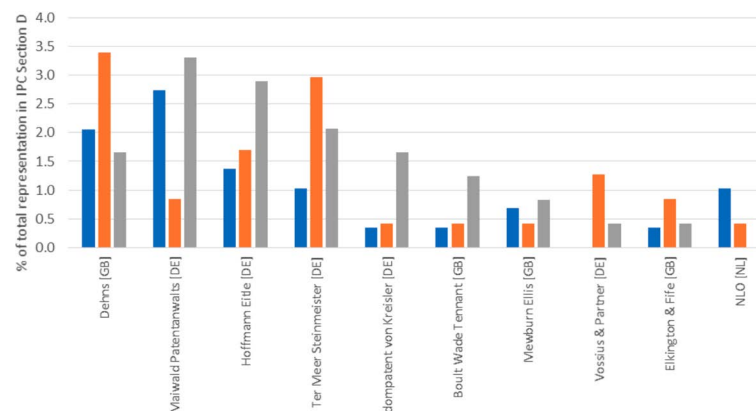
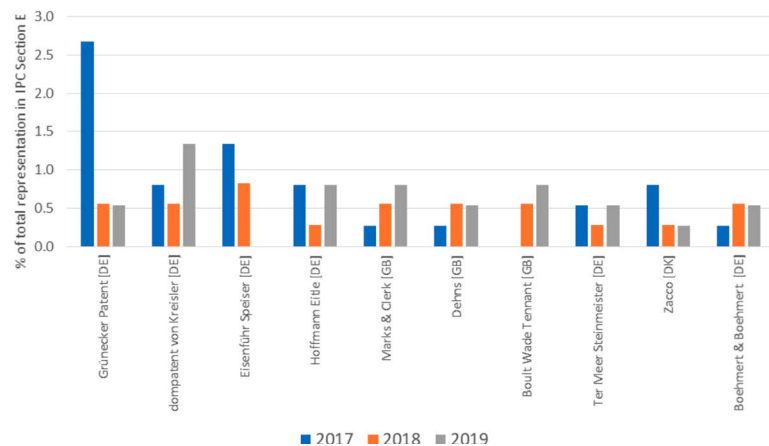


Figure 7 shows that Dehns, Maiwald Patentanwalts and Hoffmann Eitle are the top three firms in IPC section D (Textiles and Papers). Notably, there was quite a lot of fluctuation, with Hoffmann Eitle experiencing a consistent upswing in its share, while the other two showed no consistent trend. Dompotent von Kreisler, Boult Wade Tennant and Mewburn Ellis also increased their shares, while NLO saw a downswing.

Figure 8 Private firm representation in IPC section E opposition procedures in the period 2017-2019.



As shown in Figure 8, Grünecker Patent takes the top position in IPC section E (Fixed Constructions), mainly caused by a large peak in 2017 which then decreased in subsequent years. Eisenführ Speiser in third position, experienced a similar trend, while dompatent von Kreiser, in second position, saw an upward trend in 2019. Among the rest of the top 10 firms, Marks & Clerk, Dehns and Boulton Wade Tennant gained ground, while Zacco experienced a downward trend.

Figure 9 Private firm representation in IPC section F opposition procedures in the period 2017-2019.

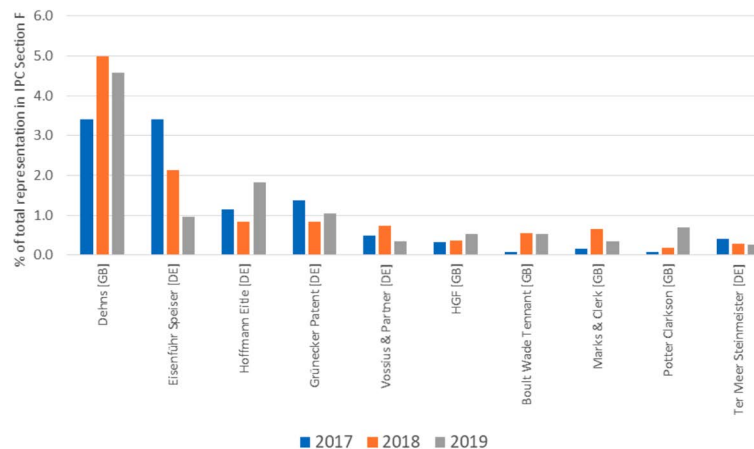


Figure 9 shows that Dehns, Eisenführ Speiser and Hoffmann Eitle were the top three firms in opposition representations in IPC section F (Mechanical Engineering, Lighting, Heating, Weapons). Dehns and Hoffmann Eitle enjoyed an overall upward trend, while Eisenführ Speiser steadily lost ground. Dehns was the clear leader in section F, with over 4% of the total oppositions in 2019, more than double the amount secured by second place Hoffmann Eitle. Among the rest of the firms in the top 10, Vossius & Partner and Ter Meer Steinmeister lost share, while HGF and Potter Clarkson grew, but remained well below 1% of the total number of representations.

Figure 10 Private firm representation in IPC section G opposition procedures in the period 2017-2019.

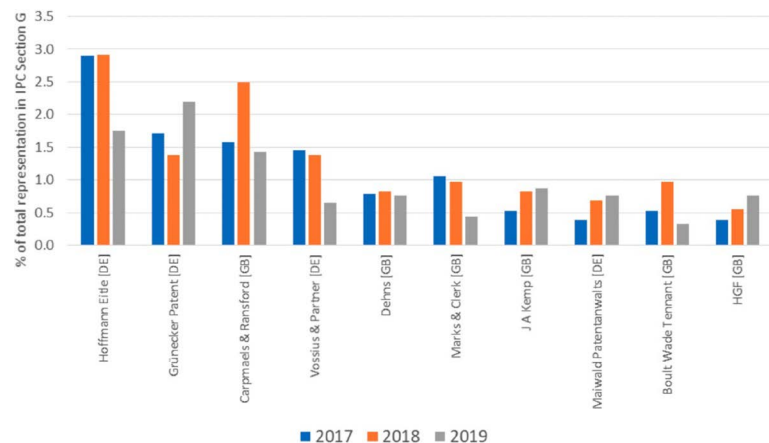
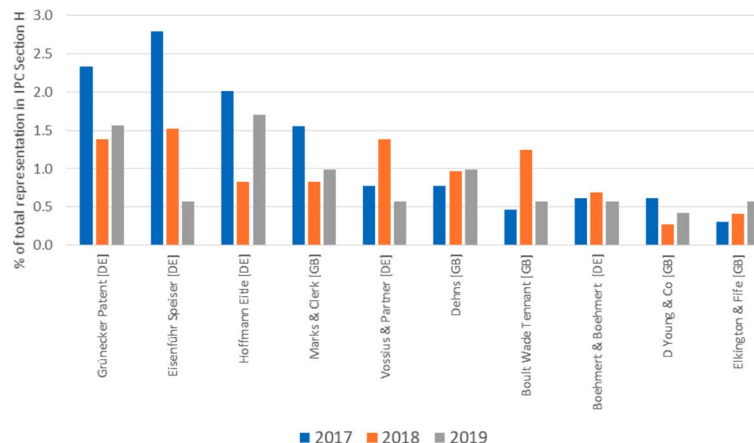


Figure 10 shows that Hoffmann Eitle, Grünecker Patent and Carpmaels & Ransford are the top three firms in IPC section G (Physics). While Hoffmann Eitle and Carpmaels & Ransford experienced a downward trend, Grünecker Patent became increasingly experienced, taking the top slot in 2019. Among the rest of the firms in the top 10, J A Kemp, Maiwald Patentanwälte and HGF increased in representation, while Vossius & Partner and Marks & Clerk decreased.

Figure 11 Private firm representation in IPC section H opposition procedures in the period 2017-2019.



Finally, we turn to Electricity (IPC section H). Figure 11 shows that Grünecker Patent, Eisenführ Speiser and Hoffmann Eitle were the top three firms in this IPC section. However, all of them saw a decrease in their percentage levels of representation during the 2017-2019 period, with Eisenführ Speiser experiencing the steepest decrease. Most other firms in the ranking also decreased, with the exception of Dehns and Elkington & Fife which increased their representation.

A more detailed look at IPC section A

As most oppositions are conducted in IPC section A and it shows the highest level of specialisation, we have looked further into two key subclasses of the section in more detail: A23 (Foods or Foodstuffs); and A61 (Medical or veterinary science; hygiene). Figures 12 and 13 show the percentage of total patentee and opponent representatives for IPC class A23 and for IPC class A61, respectively, for private firms between 2017 and 2019. They are ranked according to the total number of representations in that class over the whole period.

Figure 12 Private firm representation in IPC class A23 opposition procedures in the period 2017-2019.

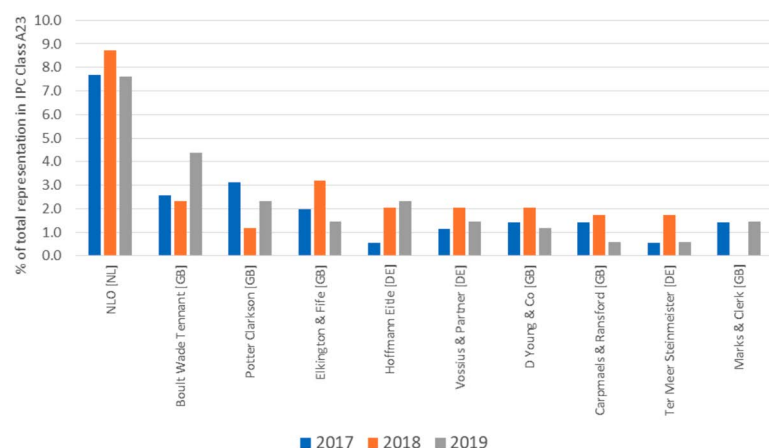


Figure 13 Private firm representation in IPC class A61 opposition procedures in the period 2017-2019.

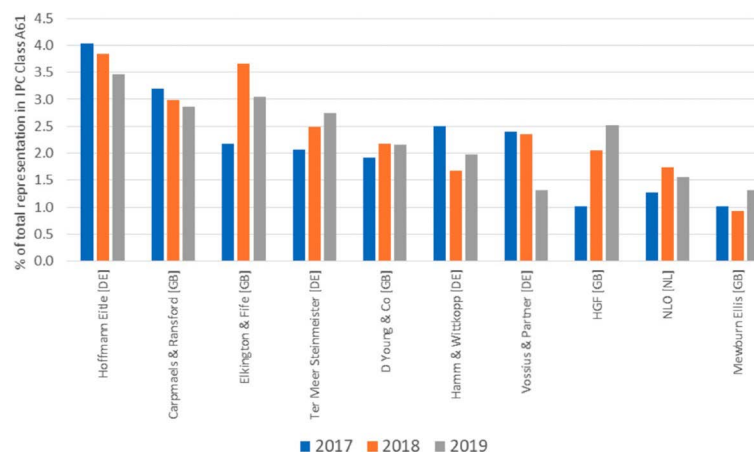


Figure 12 shows that the front-runner in IPC class A23 representation throughout the whole 2017-2019 period was NLO. It consistently accounted for over 7% of the total representation. Boulton Tennant took second place, showing an upward trend and doubling in percentage in 2019 compared to 2018. Third is Potter Clarkson, but with a less consistent trend over the three years. Among the rest of the top-10 firms, Hoffmann Eitle steadily increased its share, while Carpmaels & Ransford representation appears to have decreased.

Figure 13 shows that the leaders in IPC class A61 representation were Hoffmann Eitle, Carpmaels & Ransford and Elkington & Fife, with the first two showing a steadily decreasing trend. Among the rest of the top 10 firms, Ter Meer Steinmeister and HGF showed a clear upward trend, while Vossius & Partner's representation share fell.

The high degree of specialisation for IPC section A, even applies within the sub-classes of this section. Notably, the top firm in class A23, NLO, only ranked ninth overall in class A61; while the top firm in the latter class, Hoffmann Eitle, was only fifth for class A23.

Maximise success

German and UK private practice firms dominate in representation for opposition proceedings at the EPO. This dominance is also clear when looking at the separate IPC sections, where they take almost all spots in the top 10 for each of the IPC sections A-H. The two exceptions are the Netherlands-based NLO, which occupies the sixth position in section A and tenth in section D, and Scandinavia's Zacco, which sits in ninth position in section E. The top firms analysed in this article can be classified as generalists, with a relatively even distribution of representations over the IPC sections without a specific focus, or as specialist, which focus their representations in one or two IPC sections.

Among the IPC sections, the highest extent of specialisation is in section A and to a much lesser extent in section C, another big one for the total number of oppositions. Within Section A, classes A23 and A61 also present a high degree of specialisation, reflected by the top player in each (NLO and Hoffmann Eitle respectively) being ranked in a significantly lower position in the other class.

Patentees and opponents can maximise their success in opposition proceedings before the EPO by carefully looking at the expertise of the firm they (intend to) hire. Such expertise can reside in a focus on patentee or opponent representation, but also in particular technical fields.

This article first appeared on www.IAM-media.com, published by Law Business Research - IP Division.



Wannes Weymiens

Associate partner & Dutch and European patent attorney

I joined NLO as a trainee patent attorney in 2011 and have since developed into an all-round advisor on patents. As well as easily being able to switch from one field of technology to another, I can also switch from being a strategic advisor with a helicopter view to being a sparring partner. All with the aim of protecting your new technology as effectively as possible. One of the aspects I personally enjoy most in my work is luckily what I do on a regular basis: defending or opposing patents during a hearing at the European Patent Office.

> weymiens@nlo.eu