



Conducting Oral Proceedings at the European Patent Office by Video Conference

The European Patent Office (EPO) uses oral proceedings as a means to bring pre-grant examination and post-grant opposition proceedings to a close. Oral proceedings will be appointed when the EPO considers it expedient to discuss outstanding issues face to face and/or at the request of any party to the proceedings. Consequently, the majority of EPO oppositions conclude with oral proceedings. Oral proceedings are rarer during pre-grant examination, but are typically appointed when the EPO intends to refuse the application. The Boards of Appeal also hold oral proceedings during the appeal procedure.

Before April 2020, oral proceedings were held in person at one of the premises of the EPO by default, with videoconference available only upon request during pre-grant examination proceedings. Videoconference was not available for post-grant opposition proceedings or before the Boards of Appeal. However, the EPO has since moved towards carrying out oral proceedings (including before opposition divisions and Boards of Appeal) by videoconference.

From a legal standpoint, oral proceedings held by videoconference and those held in person are of equivalent status. As such, there is no legal reason to favour one format over the other. However, there are practical implications and considerations which may be of interest to and should be taken into account by users of the European patent system. This briefing seeks to explore some of those practical implications and considerations.

Oral Proceedings Conducted by Videoconference

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From a legal standpoint, oral proceedings held by videoconference and those held in person are of equivalent status. As such, there is no legal reason to favour one format over the other. However, there are practical implications and considerations which may be of interest to and should be taken into account by, users of the European patent system. This briefing seeks to explore some of those practical implications and considerations.

Oral Proceedings Conducted by Videoconference

Oral proceedings before examining divisions arranged from 2 April

2020 will, by default, take place by videoconference unless there are “serious reasons” against doing so. Furthermore, under a pilot scheme, oral proceedings before opposition divisions scheduled to take place during the period running from 4 May 2020 to 3 January 2021 may be held by videoconference at the discretion of the opposition division and with the agreement of all parties. For opposition oral proceedings scheduled to take place on or after 4 January 2021 until the end of the pilot scheme on 15 September 2021, videoconferencing will be used by default without needing the parties’ agreement.

The Boards of Appeal have separately announced that oral proceedings may take place by videoconference at their discretion.

Whilst the COVID-19 pandemic was the trigger for these changes, the new provisions relating to examining division oral proceedings are not time-limited or conditional and will therefore remain in place even after worldwide travel restrictions are lifted. Moreover, if the pilot project for opposition division oral proceeding is deemed a success, the EPO is likely to continue with it on a voluntary, or quite possibly a mandatory, basis after September 2021. Likewise, the Boards of Appeal may continue with, and expand, videoconferencing if they believe it is working well.

With the default position for oral proceedings before examining divisions now being videoconference, and the same for opposition oral proceedings from 4 January 2021, we can expect the majority of examining and opposition division oral proceedings to take place by videoconference. The scope of the “serious reasons” that might necessitate an in person oral proceedings appears fairly limited. Examples of serious reasons include: reasons relating to a participant as an individual (e.g. a proven visual impairment that prevents a representative from following oral proceedings on screen), and reasons related to the nature and subject-matter of the proceedings (e.g. where they involve the demonstration or inspection of an object where the haptic features are essential). By contrast, a non-specific preference for oral proceedings in person or a lack of suitable equipment are not considered serious reasons.

If a party prefers examining or opposition division oral proceedings to be conducted in person, it would be advisable to put a request on file early, together with “serious reasons”. It is also possible that the EPO may be open to conducting examining division oral proceedings in person on account of the complexity of the subject-matter at issue, though it remains to be seen whether this will happen in practice. If the request is accepted, the oral proceedings are likely to be rescheduled to take place in person after 15 September 2021.

Attendance by the Parties and Their Representatives

An advantage of videoconferencing is that participants are not bound to any particular geographic location as long as there is a stable internet connection.

Consequently, the EPO envisages the members of an examining division, opposition division or Board of Appeal either connecting together from a videoconferencing studio within an office of the EPO, or separately from home and/or different offices as required.

Similarly, on request, representatives for a given party may also be allowed to connect from different locations, provided that this does not have an impact on the stability of the videoconference connection. Likewise, any “accompanying persons”, such as a client/expert/other legal adviser, may also in principle connect from different locations on request. It is necessary to request permission from the EPO for participants to connect from different locations. Any such request should be made as early as possible, and ideally by the Rule 116 deadline for filing final written submissions where possible.

During examining or opposition division oral proceedings, we expect that all reasonable requests for participation from different locations will generally be accepted.

The EPO, especially for opposition hearings, may refuse the request if the number of additional participants would “impair the efficient conduct of the proceedings”. Such a decision to refuse is not appealable.

Attendance by the Public

Oral proceedings during pre-grant examination are not public. However, the EPC stipulates that oral proceedings before opposition divisions are public (unless the EPO decides otherwise). Likewise, oral proceedings before Boards of Appeal are also public. Consequently, the EPO has had to make provisions for such oral proceedings held by videoconference to be attended by the public.

In particular, members of the public will be able to watch public oral proceedings held by videoconference in a dedicated room on the premises of the EPO. Alternatively, members of the public may, upon giving prior notice to the EPO, be provided with a link for connecting to the videoconference remotely.

The EPO intends to verify the identity of any member of the public connecting to the videoconference. However, the identities of the members of the public will remain hidden from the parties. Consequently, for example, the interested party behind an opposition by a “strawman” could attend the oral proceedings anonymously, and even provide the representative with input/instructions in real time via a back channel (e.g. messaging software).

Conduct of Oral Proceedings

The EPO is aiming for oral proceedings conducted by videoconference to mimic those conducted in person. Thus, the general structure of the oral proceedings should be the same, irrespective of whether it is held in person or by videoconference. That is to say, at the start of the oral proceedings, the chair will announce the particulars of the patent or patent application under consideration, and identify the parties present.

During this introductory section, the chair will provide an email address to which electronic submissions should be sent during the oral proceedings. The chair will also provide a telephone number to be called in case of technical difficulties arising, and ask the representative(s) to provide a telephone number that they can be reached on. During inter partes proceedings, each party will also be asked to provide an email address to which the other parties can send electronic submissions.

The oral proceedings will then typically proceed in sections focusing on one issue at a time (added subject matter, novelty, inventive step, sufficiency, etc.), generally with a decision announced at the end of each section. The parties’ representatives will be given an opportunity to present their cases on each issue in the usual way.

While presenting during in-person oral proceedings, it is common for the representative to receive input/instructions from a client/expert/other legal adviser who is also present at the oral proceedings. Likewise, if two or more representatives are acting for a particular party, those representatives may well need to consult each other during presentation of their case. Accordingly, to replicate such communications during videoconference oral proceedings, we suggest setting up a “back channel” (for example via an instant messaging service) allowing private communication in real time.

Another aspect to consider are the pauses for EPO deliberation that typically take place after the conclusion of each section. When the oral proceedings are held in person, this involves the parties’ representatives leaving the room whilst the examiners discuss the case privately. When the oral proceedings are held by videoconference, the members of the tribunal will “leave” the main videoconference and deliberate in private, either in person (if they are all at the same location) or via a private videoconference connection if they are at different locations.

During the pause for deliberation, it is usual for the representative(s) to plan for the next section of the oral proceedings and discuss these matters with any clients/experts/other legal advisers present. The back channel discussed above could be used for such discussions, though in some cases it might be preferable to have a separate videoconference or telephone connection available.

Any submissions that are made during oral proceedings via videoconference, such as new claim requests or an amended description, will need to be sent by email to the EPO and, ideally, any other parties involved at the addresses provided at the opening of the proceedings.

At the end of the oral proceedings, the chair will announce a final decision in the usual way, following which the oral proceedings will be closed and the videoconference connection terminated.

In general, our experience of oral proceedings via videoconference is mixed: some hearings seem to progress more slowly, and it can take longer to get points across to the tribunal, than would typically be the case for in-person oral proceedings, but also, some hearings progress overall more quickly, because there is no need for any physical decampment for decision-making recesses, and so recesses tend to be more efficient and take less time.

Technical Considerations

The EPO supports the following technologies for videoconferencing:

- Microsoft Skype for Business (SfB) Clients and SfB Room Systems
- Browser based Web Meeting via Skype for Business WebApp
- Zoom (at least for proceedings involving multiple opponents and/or requiring simultaneous interpretation)

If Skype is used by the EPO for a particular oral proceedings, then, in our experience, the most straightforward option is to use the Skype for Business WebApp. It is possible to use the “share screen” feature of the Skype for Business WebApp for illustrative purposes, although any items shared this way will not be formally considered as submissions. Any documents to be submitted are required to be sent by email. Therefore, the Skype for Business WebApp will provide all the features necessary.

The EPO uses Zoom for oral proceedings involving multiple opponents and/or requiring simultaneous interpretation (in part because it supports multi-channel audio). It remains to be seen to what extent Zoom will also be used for more straightforward opposition cases as well as ex parte proceedings.

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In case of technical problems preventing the oral proceedings by videoconference from being conducted properly on the day, a new summons will be issued. However, as with oral proceedings held in person, if a party fails to appear for other reasons, the oral proceedings may, and generally will, take place in the absence of that party.

Conclusions

The EPO’s recent switch to greater use of videoconferencing for examining division, opposition division and Board of Appeal oral proceedings gives rise to a number of practical implications and considerations which should be taken into account by users of the European patent system. Videoconferencing presents opportunities for parties to engage more fully with oral proceedings because the barriers to being present and engaged are dramatically lowered by removing the need to travel to an EPO office. Should you have any questions regarding oral proceedings by videoconference, please approach your usual contact who will be able to advise.