

Barcelona, 31 January 2005

ORAL PROCEEDINGS AT THE EPO

What are Oral Proceedings (“OP’s”)?

They are not “interviews”; these are discussions held during the application stage with an examiner at which no formal decision can be reached. The examiner is not bound to hold them. Only an Examining Division (“ED”) can grant or refuse a patent.

A97(1)&(2)

They are proceedings at which the whole of a deciding body must be present and at which a formal decision can be, and usually is, announced. The holding of them is obligatory if any party requests them.

A18, A19(2)

R68(1),
A116(1)

Three sorts: During Application - not open to the public
During Opposition - public
On Appeal - public in nearly all circumstances

A116(3)

A116(4)

Very exceptionally the EPO can decide that OP’s that would normally be public shall be held in private.

During Application

Usually the last chance to avoid a refusal. The Examiner who has conducted the examination is a member of the Examining Division (“ED”), not a hostile party, so OP can be comparatively informal and a degree of negotiation is often possible. However must be prepared with fallback positions - Auxiliary Requests (“AR’s”) - EPO can only reach formal decisions on proposals put to it by the applicant. Also, dialogue with the Examiner is still possible while the OP’s are pending; if a satisfactory conclusion is reached the request for OP can be withdrawn.

A113(2)

Appeal from a decision of the ED is subject to the same rules as other appeals (see later) but often the Board, if it sees that grant of a patent may be possible, enters into discussion by correspondence in order to try to avoid OP’s. It can do this because the ED is not party to the Appeal.

From now on, I shall be discussing only proceedings where more than one party is involved and therefore the EPO must adopt a quasi-judicial function.

Opposition OP's

Proceedings are formal. The Opposition Division ("OD") will normally consist of three technically qualified members; Chairman, 1st member who will usually be the examiner who dealt with the application and 2nd member, who writes the minutes. A fourth, legally qualified, member may be added if a question of law is important - most commonly if a prior use is alleged.

A19(2)

The theory is that all points for decision and all the relevant facts and documents will have been exhaustively dealt with in the written part of the procedure, with the OP merely being for dealing with any unresolved queries; in practice, although new documents and substantive new amendments will not be admitted during the OP unless absolutely clearly highly relevant it is very common for entirely new arguments or even new objections to be raised, the latter particularly by the OD.

A114(2)

[Very briefly, the written stages consist of:

A99, A100

Notice of opposition including the grounds and any documents relied on.

R55

Reply by the patentee, including any admissions and any amendments, making clear whether the latter are unconditional or are AR's.

R57(1)

If an unconditional amendment is offered, opponent is invited to say if this satisfies him.

R57(3)

Possible comment or query by the OD (unusual).

Summons from the OD to OP; only one date will be given, at minimum 2 months' notice, changeable only on request by all parties and subject to agreement by the EPO. The summons may include a preliminary non-binding opinion on the various issues. It should specify the points needing to be discussed but frequently does not, or does do so but only in very vague terms. It will also give a last date at which any new material or new amendment may be admitted; this is usually one month before the OP date.]

R71(1)

R71a

Things to think about

Language; what is the language of the proceedings? what is the official language which the other party/ies will use? do you need interpretation and if so from and into which official languages? If the EPO is to provide interpretation - free! - minimum of one month's notice must be given. A Spanish party has the right to speak in Spanish, but must provide interpretation into the language of the proceedings at his own expense unless all parties and the EPO agree to use Spanish exclusively.

A4(3)

R2(1)&R2(5)
R2(1)

R2(4)

Experts/advisers; do you want them? if so, are they merely to accompany you so you can consult them, or do you wish them to be allowed to address the OD directly? If the latter you must give notice of who the person(s) is/are, explain how they are qualified, and specify the topic(s) they are to speak on; even if these steps are taken the OD has discretion to refuse to hear the person.

AR's; vitally important for a patentee if there is the slightest doubt about the outcome.

A113(2)

A102(3)

They must be given in order of preference. Remember that as soon as there is amendment, all legal requirements of the Convention apply to it (i.e. objections not arising out of the opposition may arise). However the patentee cannot amend voluntarily; any change must be in answer to a ground of opposition, even if it is one not put forward by an opponent.

R57a

Law; OD's are primarily technical and will not be interested in abstruse legalistic

arguments; if you have such a point raise it in writing and suggest that a legal member be added to the OD. Even then you will probably have to wait for an appeal for anyone to take much notice of it.

Last day for submissions; do not ignore it. After that no further substantive claim amendments will be admitted, and any new document unless absolutely clearly relevant, will not be considered.

R71a

Preparation; thoroughness is vital. The other parties or the EPO may produce an entirely new argument or objection. You have to know all the documents, even those that have hardly been mentioned, and be ready for all the possible legal objections, especially if there is to be amendment.

A102(3)

Appeal OP's

Technical Boards of Appeal normally consist of two technically and one legally qualified members, but must consist of three technically and two legally qualified members if the OD appealed from had four members and may consist of those five members if the Board feels it to be desirable. Legal Boards (which handle appeals from the Receiving Sections or Legal Divisions) consist of three legally qualified members.

A21(4)

A21(2)

There is also the Enlarged Board of Appeal, which has seven members. It is concerned only with points of law referred by other Boards or by the President. Such references are rare and OP's are unusual even when such references are made; I shall therefore deal only with "ordinary" Boards of Appeal.

A22

These have their own Rules of Procedure ("RPAB"), which have been much tightened up about three years ago and are being quite strictly enforced. The effect is that there is little or no opportunity to elaborate the case on appeal once the initial stages have been completed. If, exceptionally, a party is allowed to change the basis of appeal, they may be penalised in costs.

RPBA 10a

RPBA 10b,
RPBA 11a

[Very briefly:

Notice of appeal,

Grounds of appeal may only be those established in opposition; any such put forward must be complete, including all requests, all documents referred to and any evidence to be relied on,

Reply by respondent,

Proceedings closed until summons to OP's specifying issues to be discussed; though the Board could in the meantime communicate with the parties in writing to invite comments, etc.]

RPBA 11(1)

Things to think about

A principal difference between OD and appeal proceedings is that the Board definitely sees itself as having judicial status. This implies both that limitation of issues which has already been noted and a strictly impartial formal control by the Board, especially during the OP's. When there are two or more parties you will never find the Board making suggestions as to possible solutions.

Language, experts, technical advisers; exactly the same considerations as when

appearing before an OD, remembering that fresh notice has to be given to the Board on these topics.

AR's; this is your last chance to save something if you are the patentee and have been strongly attacked - discretion may be the better part of valour.

Law; now is your chance to argue legal points. You will be listened to probably by all the members but certainly by the legal member(s). If you want a question to be referred to the Enlarged Board, a request should be made to that effect, together with reasons, at the time of filing the grounds of appeal. The Board does not have to grant it.

Last day for submissions; since now the proceedings are formally closed after the reply by the respondents this deadline does not usually arise, but if there has been correspondence from the Board and a date is set, it must be observed.

Preparation; once again - this is your last chance!

Procedure at OP's

The Summons will tell you the place and time. Get there and wait outside the room. If you do not intend to be there you must inform the EPO in advance; the OP's will go ahead without you.

You will then be called in and the Chairman will identify the proceedings, introduce the members and ask the parties to confirm - or possibly change - their requests. He will also give instructions about the use of microphones, if there is to be interpretation.

He will then state the order in which the various issues raised by the requests should be dealt with; e.g. first novelty, then obviousness, then sufficiency, etc. Usually this order will be logical and reasonable, but if necessary it can be objected to and then that will be the first issue to be discussed.

Always the party/ies seeking relief speak first, dealing only with the issue then under consideration. The other party/ies then reply. When there are multiple opponents they will speak in order of the filing of the notices of opposition, unless another order is agreed. The first speaker(s) are then invited to respond. Any of the members may ask questions. When it becomes clear that nothing more useful can be said the Chairman will close the discussion and adjourn the OP's for a specified time so that a decision can be reached on the issue which has been debated. The party/ies leave the room and wait at the end of the stated time to be called back into the room to hear the opinion of the OD or Board on that issue. Assuming that this does not terminate the OP's, you go to the next issue on the list. And so on.

Once all the issues have been dealt with, a decision will be given. This is nearly always delivered at the end of the OP's, to conclude the OP's (and if so will be brief and unreasoned), but it is possible for a decision to be reserved or for the OD or Board to decide to continue the procedure in writing.

R68(1)
RPBA 11(6)

If the decision is to maintain the patent subject to amendment of the claims, i.e. in accordance with an AR, then there may have to be consequential amendments in the body of the specification and/or the drawings. Usually the patentee will be asked to do

A69
R27

those amendments on the spot, so that they can be considered by the members and the other party/ies before the proceedings are closed. The representative should be prepared for this and have draft changes ready for each AR he has put forward.

If the decision of an OD is to maintain a patent subject to amendment the formal decision will be an interim one, allowing appeal. This avoids the need for almost immediate re-translation; that can be attended to after the outcome of any appeal, or once it has become clear that no appeal will be filed so that the decision becomes final.

A106(3)

A decision given at OP's will be followed by a written decision giving reasons in full. In the case of an OD decision it is the notification of the written decision that starts the term for filing any appeal.

R68(1)
A108(2)

Practical hints at the OP's

Remember that you are primarily arguing your own case, not contradicting the case made by the opposite party. Of course you will need to deal with any valid points they may make, but that is secondary. Remember too that you are persuading the members that they should agree with you. It is useless to try to bully them, or to get angry either with them (fatal) or with the other side, or to repeat yourself in an ever-louder voice.

I personally think that it is wrong to write out speeches in advance. Notes of the main points should be enough, given that you will have prepared all the documents and arguments; if you write a speech you will lose spontaneity and also flexibility.

Watch the reaction of the members, especially the chairman, to what you and your opposites say so that you get an idea of what they like or dislike. Watch them also when citing documents; make sure that they all have the document and the place in the document that you want to talk about, before you start to talk. Above all, make sure that they understand what you are saying; they may be, and usually are, working in a foreign language.

Visual aids are valuable - drawings, graphs, videos (the EPO will supply equipment, if given notice) overheads, flow charts... There are white boards in the rooms; write up your main points in large writing. And if you can, leave those main points showing on the board while you are out of the room when they are reaching their decision!

Above all, BE PREPARED.