

Oral Proceedings

“Oral proceedings” refers to a hearing at which one or more parties to proceedings before the EPO present their case orally before the EPO. Oral proceedings provide a party with a final chance to be heard by the EPO where the EPO intends to issue a decision adverse to the party.

How and why do oral proceedings arise?

The purpose of oral proceedings is to provide an opportunity to finally discuss all matters raised in proceedings between a party and the EPO, in order to settle as far as possible all outstanding questions relevant to reaching a decision in those proceedings.

Oral proceedings may arise only at the request of a party to proceedings before the EPO (or rarely, when initiated by the EPO if it considers this to be expedient). Generally, a first request for oral proceedings by a party cannot be refused by the EPO: it is enshrined in EPC law that every party to proceedings before the EPO has a right to be heard.

Oral proceedings are most often appointed where the EPO intends to issue a decision adverse to a party and there is a request by the party for oral proceedings in such an event. Most oral proceedings take place before an Examining Division, Opposition Division or Board of Appeal.

For example, a precautionary request for oral proceedings in examination proceedings allows the applicant a final opportunity to submit arguments and/or amend the application to comply with the EPC where the Examining Division intends to issue a decision to refuse the application. During opposition, a precautionary request for oral proceedings allows the proprietor/opponent a final opportunity to try to change the Opposition Division’s view where the Opposition Division intends to do other than maintain/revoke, respectively, a patent as granted.

Reasons to request oral proceedings

A request by a party for oral proceedings, to be held in the event the EPO intends to issue a decision adverse to a party, thus ensures that a party has a final opportunity for its case to be heard by the EPO before

a decision is taken. In the absence of such a request, a party may receive an adverse decision from the EPO without prior warning.

It is highly advisable, therefore, for a party always to make a conditional request for oral proceedings at the start of any proceedings before the EPO. Indeed, we routinely file such requests at the time of filing an application, or filing or responding to an opposition or appeal, at the EPO.

Initial procedure - the summons

The first step is for the EPO to summons the party or parties to oral proceedings. The summons states the subject and date of the oral proceedings. The date set must provide at least two months’ notice and is usually very difficult to successfully change; ‘serious substantive reasons’ must be shown. If a party does not appear as summoned, the oral proceedings may continue without that party.

Where the proceedings are before an Examining Division or Opposition Division, the summons also indicates the issues to be discussed and may indicate the provisional opinion of the Division; the Boards of Appeal, however, are not required to provide such information. Where such information is provided, the summons also sets a final date for making written submissions to be taken into account in preparation for the oral proceedings. This is usually one month before the date of the oral proceedings.

Final written submissions

Written submissions may provide new facts and/or evidence, though these should not depart from the existing legal and factual framework of the case. An applicant or a proprietor may (additionally) submit new amended claims, referred to as ‘requests’.

The EPO is not required to consider new material presented after the final date set (unless the subject of the proceedings has changed). In deciding whether to exercise its discretion to admit ‘late-filed’ material, the EPO takes into account, on the face of it, the relevance

of facts or evidence, or the allowability of an amendment, as well as procedural expediency.

The final written submissions should, therefore, aim to present a party's best possible case for achieving the desired result from the proceedings (for example, allowance of an application, or maintenance or revocation of a granted patent).

Requests

Amended claims filed by an applicant or a proprietor are submitted in the form of 'requests', called 'main', 'first auxiliary', et seq., requests, representing a series of fall-back positions which will be examined sequentially by the EPO. The sequence of requests must be considered carefully as subsequent requests are only considered after the preceding request has been found not to be allowable.

If one of the requests is found to be allowable, a patent would then be granted, or a granted patent would then be maintained, on the basis of that allowed request. In this event, there may no longer be any need for the oral proceedings, such that the oral proceedings may be cancelled.

For example, during examination, the Examining Division may indicate that an auxiliary request would avoid the need for oral proceedings, even if the main request does not. The applicant then has the choice of defending the higher ranked requests at the oral proceedings or limiting to the allowable auxiliary request to avoid oral proceedings. During opposition proceedings, however, the oral proceedings will still be held where an opponent party's request for oral proceedings must be met.

If none of the requests are found to be allowable, the issues in any case remain to be discussed at the oral proceedings.

Oral proceedings

The oral proceedings are like a mini court hearing, only less formal, between the party or parties to the proceedings and members of the relevant department of the EPO. While oral proceedings before an Examining Division are not public, those before an Opposition Division or a Board of Appeal are in general open to the public (with a few exceptional situations).

Normally, a party's case is presented by its European Patent Attorney, who may be accompanied at the hearing by representative(s) of the party. Occasionally,

a person other than the attorney, for example an inventor, may be heard (upon certain notice and formal requirements being met). In addition to the earlier written preparations, taking oral proceedings usually involves significant preparation time immediately before the hearing itself, which may involve meetings with the party. The hearing is essentially for the purpose of repeating and expanding on, or explaining, arguments usually already presented on the basis of the evidence already filed.

Following a discussion of the issues, the EPO will decide on the subsequent procedure to be followed. A decision will almost always be reached and given at the hearing, with the official reasoned written decision issuing (usually from one to six months) afterwards. No submissions by a party will be considered between the oral proceedings and the written decision. Minutes of the oral proceedings should be issued by the EPO as soon as possible after the hearing, though in practice, minutes are often issued at the same time as the written decision.

It is not possible for a decision to grant a patent, or to maintain a patent in amended form, to be given at the hearing because there are further formal requirements that must be fulfilled. In these cases, therefore, the EPO will inform the party or parties of its intention to take such a decision, subject to the formal requirements being met.

Cost of oral proceedings

The costs associated with oral proceedings vary widely, depending on whether the proceedings are before an Examination or Opposition Division or Board of Appeal and the difficulty of the case.

Significant factors contributing to cost include:

- extent and complexity of prior art
- extent and number of written submissions
- time spent preparing for the hearing
- number of parties (in opposition and appeal)
- length of hearing

Although, in theory, costs can be reduced, for example, by a reduction in the depth of analysis or time spent preparing for the hearing, we do not recommend this. Thorough preparation is often the key to a successful outcome.

More information about oral proceedings in opposition proceedings in particular can be found in our "European Patents – Oppositions" information sheet.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at York House, 23 Kingsway, London WC2B 6HP

LONDON
York House
23 Kingsway
London WC2B 6HP
Tel: 020 7240 4405
Fax: 020 7240 9339

BRISTOL
22-24 Queen Square
Bristol
BS1 4ND
Tel: 0117 945 1234
Fax: 0117 926 5692

MANCHESTER
Bridgewater House
Whitworth Street
Manchester M1 6LT
Tel: 0161 247 7722
Fax: 0161 247 7766

CAMBRIDGE
Newnham House
Cambridge Business Park
Cambridge CB4 0WZ
Tel: 01223 420383
Fax: 01223 423792

Email: mail@mewburn.com

© Mewburn Ellis LLP January 2008