

In association with



iam[®]

How to prepare for oral proceedings for European patents

NLO

Hans Hutter and René van Duijvenbode

Patents in Europe **2018/2019**

*Helping business compete
in the global economy*



HOW TO FORTIFY YOUR **INNOVATIONS,** **IDEAS** AND **TRADEMARKS**

Innovations, designs and trademarks are a valuable asset in any business. They enhance a company's distinguishing capacity, boost its impact, strengthen its competitive position and make it more attractive to investors. Therefore, there is every reason to give Intellectual Property a prominent place in your business strategy. We can support you by protecting and enriching your innovations, designs and trademarks, thanks to our extensive range of services and the expertise of our trademark, design and patent specialists who find solutions where others don't. We are the largest consultancy in Intellectual Property in the Netherlands and Belgium and one of the most pioneering firms in Europe. If you would like to know more, visit **www.nlo.eu**



EUROPEAN PATENT AND
TRADEMARK ATTORNEYS

www.nlo.eu



How to prepare for oral proceedings for European patents

By Hans Hutter and René van Duijnbode, NLO

Senior European patent attorneys will, with a certain nostalgia, remember the ‘good old days’ in which they could easily call an examiner of the European Patent Office (EPO) and informally discuss a pending application. Attorneys could also simply make an appointment with an examiner for an informal meeting to discuss a case in person. During such a meeting, the other two members of the examining division would be absent.

Oral proceedings – especially before an examining division – also tended to be informal. An attorney had significant freedom to change pending claims extensively.

Those good old days are gone. EPO proceedings have become increasingly formal, especially in relation to oral proceedings. Attorneys who do not correctly follow the formal rules for preparing and conducting oral proceedings can end up with empty hands. In examination, this can be repaired by filing a divisional application. However, this may be a costly and unnecessary affair. In opposition, no such repair is available.

This chapter explains the legal background, but also provides ways to avoid such pitfalls. Both the European patent attorney and the applicant/owner have a responsibility here.

Legal basis

Articles 113, 114 and 116 and Rules 116 and 137 of the European Patent Convention (EPC) provide the general legal basis for how to interact with the EPO.

Article 113 instructs the EPO to provide parties concerned with the option to defend their case: “The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to

present their comments.” However, parties cannot simply file documents to defend their case at any time they like. For example, after an applicant has filed an application, it may take a while before it gets an opportunity to do so. For instance, in accordance with Rule 137 of the EPC, an applicant may not amend its patent application in any way before it receives the search report. Only upon entering the European phase after the Patent Cooperation Treaty phase is it allowed to do so before the EPO starts the search (Rule 161 of the EPC).

Together with the opinion accompanying the European search report, the applicant will be invited to comment on the search opinion and, if desired, file amended application documents (Rules 70a and 137 of the EPC). However, thereafter the EPO has no further obligation to allow the applicant to make additional amendments – Article 137(3) of the EPC explicitly states: “No further amendment may be made without the consent of the Examining Division.” This rule gives the EPO significant legal power to prohibit applicants from making further amendments. In practice, applicants almost always get one or two more opportunities to do so, but it is good to understand that the EPO need not do so.

Finally, Article 114(2) stipulates that parties to EPO proceedings should meet the time limits given by the EPO: “The European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned.”

Oral proceedings in examination

If written proceedings before the EPO do not result in a decision meeting the desires of a party, oral proceedings may be held. Oral proceedings are



Hans Hutter

Partner

hutter@nlo.eu

Hans Hutter joined NLO in 1991. He began his patent career with the Netherlands Industrial Property Office in 1988, examining patent applications mainly in the field of semiconductor technology.

He has been drafting and prosecuting patent applications in semiconductor technology, smart cards, lithography machines, telecommunications and navigation systems. He also specialises in the patenting of software-related inventions and has published several articles in this particular area. In recent years he has been involved in major complex litigation and advice cases relating to CD-R, DVD-R, MP3, JPEG, LCD, telecommunications (UMTS, LTE) and audio and video streaming.

He has an MSc in electrical engineering and holds a PhD in the history of science and technology.



René van Duijvenbode

Partner

vanduijvenbode@nlo.eu

René van Duijvenbode provides a full service to large and medium-sized chemical companies, including food multinationals. His daily activities involve patent drafting, prosecution, freedom-to-operate opinions and litigation. Corporate counsel greatly value his service, as evidenced by his receipt of a Client Choice Award for intellectual property (patents) in 2015. He enjoys representing both opponents and patentees in hearings before the Opposition Division and the Boards of Appeal at the European Patent Office, acting in about 15 to 20 oral proceedings annually.

a fundamental right under Article 116(1) of the EPC, which states: “Oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings.”

In preparation for oral proceedings, the EPO sends an invitation specifying the date and location of the proceedings, topics to be discussed, a preliminary opinion of the EPO and – most importantly – a final date for filing submissions. This date is exceptionally two months, but usually one month prior to the oral proceedings and is to be taken very seriously. The invitation will include a sentence such as: “The attention of the applicant is drawn on the final date for making written submissions or amendments... Later amendments will be disregarded by the examining

division if they do not overcome *prima facie* all the outstanding objections set out above or give rise to new objections.”

Consequently, a party that wishes to be sure that all of its arguments and documents are considered by the EPO should send them to the EPO by that due date. The EPO may accept further amendments to claims during the oral proceedings, but is not obliged to do so. It will do so only if such late amendments solve all outstanding issues.

A very European way to handle the EPO’s potential refusal to accept further amendments during the oral proceedings is through filing auxiliary requests, whereby one proposes a fall-back position for claims to be assessed by the EPO should it refuse the claims of the main request.

Several such sets of auxiliary requests may be filed. It is recommended to do so by the date of filing the written submissions and not to wait for the oral proceedings themselves. Filing them on the date of oral proceedings runs a high risk of being refused on formal grounds.

Applicants should not hesitate to file auxiliary requests; the EPO will not see this as weakening the main request and will seriously assess all requests. More importantly, if they are not filed at this stage of the proceedings, there is a high risk that they will never be admitted into the proceedings during appeal.

There is no formal limit to the number of auxiliary requests that can be filed, but it should be reasonable. Too many may irritate the EPO and hamper the case.

An important issue is the content of successive auxiliary requests. While the EPO was previously willing to accept consecutive auxiliary requests directed at unrelated subject matter, it no longer does so. It wishes to prevent 'shooting for a prize' and increasingly accepts auxiliary requests only where a following auxiliary request is limited in scope relative to a former one (*cf* T1903/13).

During the oral proceedings, the EPO starts with the admissibility of all claim sets filed. When they are filed by the due date, the 'late filing' argument cannot be used. However, claim sets not solving all outstanding issues may only be briefly commented on and then simply not admitted in the proceedings. Moreover, the EPO usually warns that further auxiliary requests may be filed during the oral proceedings only with its consent.

The EPO must give such consent only if it refers to new prior art not mentioned before or when the EPO has changed its mind after sending the invitation for the oral proceedings with the preliminary opinion (T273/04).

In practice, during oral proceedings in examination the EPO tends to be slightly flexible, because no patent has been granted yet and no other parties are involved.

Oral proceedings in opposition

Opposition proceedings are in principle governed by the same rules as examination proceedings. However, parties filing an opposition should also be aware that a notice of opposition must contain "a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds" (Rule 76(2)(c) of the EPC).

"In practice, during oral proceedings in examination the EPO tends to be slightly flexible, because no patent has been granted yet and no other parties are involved"

The consequence of this rule is that all additional facts and evidence filed by an opponent at the course of the opposition proceedings are formally filed late and may accordingly be disregarded by the opposition division. The opposition division need only admit such further facts and evidence if they are *prima facie* relevant (ie, it is directly clear that assessing them will influence the outcome of the proceedings). To some extent there is room for discussing why such facts and evidence were not presented earlier in the proceedings.

A high percentage of all opposition proceedings end up in oral proceedings because the parties usually cannot agree during the written proceedings. With the recent steps at the EPO to accelerate opposition proceedings, the timeframe for parties to settle will only decrease. At some point – now typically within four to six months after the patentee replies to the notice(s) of opposition – all parties will receive a formal invitation to such oral proceedings and must meet the due date for filing any submission, at the risk of not being admitted into the proceedings. Again, this date is one to two months before the hearing. The content of this invitation is essentially the same as that which an applicant will receive during examination.

Because several parties are involved in opposition and their interests diverge, the opposition division tends to be more formal than an examining division. Consequently, it is even more highly recommended to file all facts, evidence and arguments by the due date of written submissions and not to await the date of oral proceedings. Here it is no exception that the opposition division does not admit a request even when filed at the final written submissions deadline, for it being filed late. It depends on the circumstances, but the patentee should be prepared to defend the timing of such request.

During oral proceedings, the owner may file

“The Board of Appeal may be strict during oral proceedings as regards late filing. When the board suspects that a submission brings about a new case, it will not admit it into the proceedings”

further requests only in case of newly cited and highly relevant prior art, or if the opposition changes its mind and accepts a new argument. Even then, often the opposition division will only allow for limiting to granted sub-claims, based on the argument that those were at least foreseeable to the opposing parties, and would not give rise to tedious clarity discussions. It has been suggested that the opposition division has been given guidance to allow only one attempt per ground. Owners should be aware that the opposition division does not want to take small steps. A request filed on the day should typically form a genuine attempt to solve all matters on file and definitely not introduce new issues.

Board of Appeal Rules of Procedure

The Board of Appeal has its own Rules of Procedure. They reflect that appeal proceedings are intended to appeal first-instance decisions. An appeal cannot be filed to completely re-open a case.

Therefore, the Rules of Procedure specify that the board is empowered to hold as inadmissible any facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings (*cf* Article 12 of the rules).

Moreover, appeal proceedings must be based on the grounds of appeal as filed by the appellant and any communication from the Board of Appeal. In opposition proceedings, parties also have a basic right to comment on the content of any document of another party. They define the framework of the appeal and the board is reluctant to broaden the scope of the proceedings to items not addressed by any of the parties in time.

Therefore, appellants should draft their submissions with great care. For example, the grounds of appeal or a reply thereto should contain the party's complete case. All facts, evidence and arguments should be explicitly filed from the outset.

It is at the board's discretion to accept any new submission during the appeal proceedings. In practice, this will depend on the complexity of

the submission and the state of the proceedings. In essence, the board is not generous in using its discretion.

Oral proceedings in examination, appeal stage

During examination, the board will act according to the Rules of Procedure, but will show some flexibility because it understands that the appellant does not yet have a granted patent and the appeal is its last resort (apart from filing a divisional application and starting all over again against high costs).

It is recommended to follow these Rules of Procedure, especially as to meeting submission deadlines. The Board of Appeal may be strict during oral proceedings as regards late filing. When the board suspects that a submission brings about a new case, it will not admit it into the proceedings. It will certainly do so when (auxiliary) claim sets are presented that could have been filed and defended before the examining division.

Oral proceedings in opposition, appeal stage

The main purpose of an appeal in opposition is to conduct a final review of the decision given by the opposition division and thereby provide the losing party with an opportunity to challenge that decision. Appeal proceedings in opposition are thus largely determined by the factual and legal scope of the preceding opposition proceedings.

Again, because several parties with opposing interests are involved, the Rules of Procedure are generally applied more stringently. It is challenging to have admitted any new piece of evidence or a new request or argument – even a document or argument used in opposition proceedings but not brought forward at the onset of the appeal proceedings. The board has dismissed inventive step arguments based on a closest prior art presented at the hearing where such document was used for novelty in the appeal proceedings leading to the hearing. Illustrative is the common lack of a date for filing final written submissions on the invitation to the hearing. Attorneys arguing that they should be awarded

such an opportunity are often merely gazed at.

Ultimately, if the party wants to achieve something with the board, it better have tried the same thing in the first-instance proceedings. Even then there is no guarantee that the board will admit all previously submitted requests. Convergence is an important parameter here.

Practical lessons

Since the EPO is becoming increasingly strict in applying its procedural rules, it is recommended to act in accordance with the following rules:

- If a party is unsatisfied with the examiner's opinion, it should not give up too easily. Do not file a request for issuing a statement as to the status of the file which can be appealed. Always file and defend a main request and all possible auxiliary requests. One may not get a new opportunity to do so before the Board of Appeal. Be aware that a request tried but withdrawn or abandoned in first-instance proceedings may be gone forever. If a request was not deemed persuasive at first instance, perhaps a variation thereto could still be presented in appeal. With no decision on that

request at first instance, the board has every opportunity to dismiss further attempts.

- Always file any possible auxiliary request by the due date for written submissions in preparation of oral proceedings. Do not wait for the oral proceedings themselves. In opposition proceedings, consider filing these auxiliary requests already in reply to the notices of opposition. Anything later will run a serious risk of not being admitted into the proceedings because of late filing. Notably, filing auxiliary requests is not considered as weakening the main request and has become standard practice.

The good old days may be gone forever, at least when it comes to oral proceedings. However, there is still some room for flexibility at the EPO. The EPO recently intensified the informal telephone interviews in examination proceedings, with opportunities to exchange arguments and discuss possible claim amendments in a matter of time, avoiding time-consuming official actions and small increments of progress in the file. The senior attorneys will undoubtedly appreciate this. *iam*



EUROPEAN PATENT AND
TRADEMARK ATTORNEYS

NLO

Anna van Buerenplein 21A
The Hague 2595 DA
Netherlands

Tel +31 70 331 2500

Web www.nlo.eu