

A guide to hearings at the European Patent Office

Preparing for Opposition Oral Proceedings

“Oral proceedings” is the name given for a hearing held with members of the European Patent Office (“EPO”).

Oral proceedings are usually held at the end of the opposition procedure, which arises when a third party challenges the grant of a European patent. Opposition oral proceedings involve the proprietor and the opponent(s), and are public.

Oral proceedings can also be held before the Board of Appeal if an appeal is filed after the decision from the Opposition Division is received.

1. Opposition oral proceedings

If both the proprietor and the opponent in a European opposition procedure make a conditional request for oral proceedings, then the EPO will hold oral proceedings. The oral proceedings will bring the opposition procedure to a close, and will result in a decision on the outcome of the opposition.

When the EPO issues a summons to opposition oral proceedings, a deadline is set for both parties to file final written submissions and, in the case of the proprietor, amended claims. The oral proceedings will be scheduled to be held by videoconference for the majority of cases, unless the situation is particularly complex in which case it may take place physically in Munich or The Hague.

Opposition oral proceedings are held in public, so anyone can attend. The oral proceedings are held before an Opposition Division, made up of three patent examiners. At least two members of the Opposition Division must not have been members of the Examining Division which granted the patent. A fourth legal member of the Opposition Division can be appointed when there are particularly complex legal issues to discuss.

The proprietor and opponent(s) are each represented by their European Patent Attorney or other representative, and will sometimes have a number of other people attending as observers or to advise the representative on technical matters.

The oral proceedings will normally last between 2 and 9 hours, and will finish within one day unless more than one day has been set aside for the oral proceedings in the summons (for example in a case where there are multiple opponents).

1.1. Videoconference oral proceedings

For oral proceedings before an Opposition Division held by videoconference, the EPO currently operates two VICO platforms: Zoom, for proceedings involving multiple opponents and/or requiring simultaneous interpretation; and Skype for Business, in the other cases. Participants to a VICO oral proceeding should timely familiarise themselves with the EPO technical requirements and recommendations.

Where oral proceedings before an Opposition Division are held by videoconference, any submissions filed during the hearing must be filed as pdf by email.

No evidence may be taken during oral proceedings by videoconference. If the Opposition Division decides to take evidence, those oral proceedings will be adjourned and the parties will be summoned to oral proceedings on the premises of the EPO.

If technical problems preventing the oral proceedings by videoconference from being conducted cannot be overcome during the videoconference, the Opposition Division will issue a new summons to oral proceedings.

In the case of oral proceedings by videoconference, the public is granted remote access upon request. The request is to be submitted via email to the EPO at least three working days prior to the date indicated in the summons to oral proceedings.

1.2. Language to be used

The oral proceedings will be held in the language of the proceedings (i.e. the language of the European patent). However any party may request to speak in another official language (English, French, German). Interpreters may be requested at the expense of the EPO. If simultaneous interpretation at the hearing is required then it has to be requested in good time.

1.3. Auxiliary requests

Fall-back sets of claims, known as auxiliary requests, should be filed by the proprietor in advance of the oral proceedings, preferably within the deadline to submit final written submissions (usually one or two months before oral proceedings). It is good practice to file auxiliary requests as soon as possible in response to objections raised by the opponent or by the Opposition Division. Having auxiliary requests on file does not weaken the proprietor's position with respect to the main request. It is not an "easy option" for the Opposition Division to allow a narrower auxiliary request in preference to a broader main request, because they will have to write a decision explaining why they refused any higher ranked requests.

1.4. File evidence before the hearing

Any evidence must be filed as early as possible in the written proceedings. If new evidence is required in response to evidence or arguments of the opponent or proprietor, this should be filed in advance of the oral proceedings, preferably within the deadline for final written submissions (usually one or two months before oral proceedings).

1.5. Witnesses

The hearing of an "expert" in the sense of Rule 117 requires as a precondition a decision to take evidence (see E-IV, 1.4). This is different from technical experts.

1.6. Technical experts

It is not essential that a technical person accompanies the patent attorney to the oral proceedings, and in each case the proprietor/opponent should agree with the attorney what is best. Sometimes it can be useful for the proprietor's own expert to be on hand to advise the attorney on technical matters, or on the usefulness of amended patent claims. In most cases it is not necessary for anyone other than the attorney to present the case and speak at the oral proceedings. However, if it is intended that another person speaks (e.g. inventor, non-EP attorney), the consent of the Opposition Division must be sought in good time before the hearing.

1.7. Conclusion of the proceedings

At the end of the oral proceedings the Opposition Division announces the decision. Three decisions are possible:

1. the opposition is rejected and the patent maintained unamended; or
2. the patent is maintained but in an amended form; or
3. the patent is revoked in its entirety.

This spoken decision is followed later by the written decision, which sets out the detailed reasons for the decision. The written decision is accompanied by the minutes of the oral proceedings, which are drawn up by a member of the Opposition Division. It is critical that the minutes are checked thoroughly, to ensure that they correspond to our experiences during the hearing.

2. Opposition appeal oral proceedings

If an appeal is filed against a decision of the EPO Opposition Division (for example the proprietor appealing against a decision to refuse a main request, or the opponent appealing against the decision to reject the opposition), both the proprietor and the opponent(s) become party to the appeal proceedings. Usually all parties file a conditional request for oral proceedings before the EPO Board of Appeal. This means that the Board cannot end the appeal procedure by issuing a decision adverse to any party without first giving that party an opportunity to present arguments in person.

The object of appeal proceedings is for a judicial review of the decision under appeal, and a party's case should be directed to the arguments and evidence on which the first instance decision was based.

It should be noted that any arguments, evidence, or amendments which extend beyond the facts and evidence on which the first instance decision was based is considered to be an amendment to the case and are only admitted at the discretion of the Board.

When the Board issues a summons to oral proceedings, usually accompanied by a preliminary opinion, a deadline may be set for both parties to file final written submissions and, in the case of the proprietor, amended claims. However, new evidence, new arguments, and amendments will only be allowed under very exceptional circumstances at this stage.

The appeal oral proceedings take place in Munich (either at the EPO premises in the Haar suburb or else at the EPO premises near the town centre), and are held in public. In the majority of cases, the Technical Boards of Appeal decide in a composition of two technically qualified members and one legally qualified member. An extended composition of three technically qualified members and two legally qualified members becomes relevant when the Board of Appeal considers that the nature of the appeal so requires.

The proprietor and opponent(s) are each represented by their European Patent Attorney or other representative, and will sometimes have a number of other people attending as observers or to advise the representative on technical matters.

The oral proceedings will normally last between 2 and 4 hours, and will finish within one day, unless more than one day has been set aside for the oral proceedings in the summons (for example in a case where there are a large number of parties).

2.1. Language

The oral proceedings will be held in the language of the proceedings (i.e. the language of the European patent). However any party may request to speak in another official language (English, French, German). Interpreters may be requested at the expense of the EPO. If simultaneous interpretation at the hearing is required then it has to be requested in good time.

2.2. Witnesses

Very rarely proceedings may rely on witnesses who provide witness statements testifying to a public prior use of an apparatus or method which anticipates the claimed invention. The hearing of witnesses requires as a precondition a decision by competent department of the EPO to take evidence.

2.3. Technical experts

Hearing oral submissions by a person accompanying the representative during oral proceedings has to be timely requested and can be allowed at the discretion of the Board.

2.4. Conclusion of the proceedings

At the end of the oral proceedings the Board announces the decision, and three decisions are possible:

1. the appeal is dismissed and the decision of the Opposition Division is maintained; or
2. the Board of Appeal comes to an alternative conclusion and the patent is revoked or maintained, sometimes in an amended form; or
3. the case is remitted back to the Opposition Division to discuss grounds of opposition that were not discussed in the first opposition proceedings.

This spoken decision is followed later by the written decision, which sets out the detailed reasons for the decision. The written decision is accompanied by the minutes of the oral proceedings, which are drawn up by a Board member and are usually very brief.

3. What to expect on the day of the proceedings: Tips and tricks

We have set out on the following pages some brief notes of advice for a party faced with oral proceedings during the EPO opposition procedure.

The Boards of Appeal have their own procedural rules, but the general advice is equally applicable to second instance oral proceedings before the Boards of Appeal.

3.1. Let your attorney guide you

Your attorney will be presenting your case at the hearing, and will be able to answer any questions you have. Since the issues to be discussed at oral proceedings (e.g. novelty, inventive step, added subject matter, clarity, and sufficiency) can be complex patent issues, with arguments dependent on interpretation of the European Patent Convention and many years of EPO case law, it is best to leave the presentation of the arguments to your patent attorney.

3.2. Preparations before and on the day

For hearings held by videoconference, it is best to test your link to the EPO in advance of the proceedings so that you have time to rectify any issues. The EPO have a dedicated test hub for this purpose. It is also important to test your separate communication channels with your attorney, which on the day of the hearing will be running concurrently with the link to the EPO. On the day, you will set up your attorney link prior to the hearing and then you and your attorney will both connect to the EPO and enter the virtual waiting room before the start of the hearing. A member of the Opposition Division will then admit you and check your details (e.g. by holding up your passport to the camera), and once that has been completed then the proceedings will commence.

For hearings held physically at the EPO, arrive at the site in good time before the oral proceedings are due to start. Take photo ID (e.g. a passport) because the EPO will want to confirm the identity of all the attendees. The hearing can last a long time, so have a good breakfast beforehand. You will be waiting outside the hearing room with the other party(s) before the hearing starts. Once seated inside the hearing room, if interpretation is being provided check if you can operate the headphones.

3.3. Strict rules of procedure

Because at least two parties are present (the proprietor and any opponents), and because the hearing is public, the chair of the Opposition Division/Board of Appeal will closely follow the procedural rules. The parties will be invited in turn to present their arguments on any particular issue, and will then be allowed to respond in turn. The Opposition Division/Board of Appeal cannot suggest allowable amendments to the claims.

3.4. Order of proceedings

The chair of the Opposition Division/Board of Appeal has discretion to choose the order in which the matters are discussed. For example added subject matter of claim 1 of the main request may be discussed first, and then only if the Division/Board decides that the claims meet the requirements of the EPC with respect to added subject matter will the discussion move on to novelty of claim 1. If the decision is that the claims do not meet the requirements of the EPC, the chair will announce that the main request is refused, and will move on to discussion of claim 1 of the next request.

3.5. Amendments on the day

The Opposition Division are unlikely to allow the proprietor to make sweeping changes to the claims on the day, but they often will allow narrowing amendments which are designed to overcome objections raised during the oral proceedings, provided that these are “convergent”, i.e. the amendments are narrowing the scope of the claims in the same general direction. At the appeal stage amendments on the day will be accepted only in extremely exceptional circumstances.

3.6. Watch out for new grounds of opposition

If the opponent raises new arguments, and these do not arise as a result of new amendments which you have made to the patent, then your attorney will try to have these arguments ruled as inadmissible.

3.7. Use the breaks

The Opposition Division/Board of Appeal will normally adjourn the oral proceedings to reach a decision after each matter has been discussed. An adjournment can last 10 to 30 minutes or more. All parties are sent out of the (virtual) room during the adjournment. The chair will then announce their intermediate decision on that matter when the parties return, and discussion moves on to the next issue. It is prudent to use the adjournment time to consider strategy in each of the two possible scenarios, i.e. whether the chair finds in your favour or against you. If for any reason time is needed e. g. to formulate a new set of amendments after an intermediate adverse decision, a break in the proceedings can be requested at any time by any of the parties.

3.8. Opposition Division/Board of Appeal members are usually “skilled in the art”

You can usually assume that the Opposition Division/Board of Appeal understands the technological field of your invention very well. It is not necessary to spend time at the oral proceedings explaining the technology, unless it is apparent that something has been misunderstood.

3.9. Opposition witnesses

The hearing of any witness takes the form of questioning by a member of the Opposition Division/Board of Appeal. There is no cross-examination by the other party, although the other party may ask the chair to put particular questions to the witness.

3.10. No to PowerPoint™, yes to sketches

An Opposition Division/Board of Appeal will not normally permit the presentation of slides or animations unless consent has been obtained in advance, in which case an outline of the presentation must be submitted in writing with the request for consent. However, the distribution of sketches at the hearing is usually allowed, and if you are on site then it can be very effective to use the flip chart provided in the hearing room to make sketches in support of oral arguments at the hearing.

3.11. Samples of the invention

Samples of the invention are usually not so useful in opposition proceedings. The sample may include features which are not among the features of the invention as claimed. If you wish to demonstrate the invention, it is best done by filing evidence and/or photographs as part of the written proceedings.

3.12. Be careful what you say

If you or someone else will be speaking at the opposition oral proceedings as a technical expert, make sure they have agreed in advance with your attorney what will be said so that the attorney is not suddenly surprised. Because other parties are present, there is a risk that things said could be used against you.

3.13. Relish the experience

Finally, oral proceedings are a unique opportunity to see the inner workings of the EPO and the interaction between parties. They are stressful, but try to immerse yourself in the experience to get the most out of the day. Do not let your emotions (positive or negative) spill out into the hearing, as the chair will not take kindly to interruptions or negative personal comments directed at the other party.