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Data-driven innovation IP protection for techbio platforms

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Editorial

Neither technology nor the law stands still. With big data and AI all around us, this month we consider IP protection for data-driven innovation in the techbio space. We also examine where patent infringement occurs in computing systems that cross international borders. Equally, we all skip between countries virtually in video conferences and we report on the EPO's latest position on in-person versus video oral proceedings. We were ranked a top tier UK practice for patent prosecution services in the recent IPSTARS global survey and the IAM Patent 1000 survey ranked us as a gold tier firm before the EPO and in the UK commenting that D Young & Co is "undoubtedly one of the United Kingdom's strongest prosecution practices". Great work, team!

Nick Malden, Editor

Webinars & events

Protecting innovation in the techbio sector
Webinar, on demand
Robbie Berryman, Jennifer O'Farrell and Alan Boyd discuss the development of the techbio sector and its IP needs.

European biotech patent case law
Webinar, 05 September 2023
Registration is now open for our ever popular biotech case law webinar, presented this time by Simon O'Brien and Tom Pagdin.

IPO Annual Meeting
Boston, USA, 10-12 September 2023
Garreth Duncan (Vice-Chair of the Pharma and Biotech Committee) and Nicholas Malden (member of the Software Related Inventions Committee) will be attending.

IP4U University Tech Fair
London, UK, 19-20 September 2023
We are gold sponsors of this event promoting new tech in sustainability and future health.

TechBio UK 2023
London, UK, 18 October 2023
Jennifer O'Farrell will chair and Robbie Berryman will be a panelist in the Innovation Showcase session at this event.

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Techbio

Data-driven innovation
IP protection for techbio platforms

Here we assess the forms of protection available for platform innovation within the techbio field, which may differ from the forms of protection available for innovation arising from using techbio solutions within the biotech and life sciences fields.

IP protection for data-driven innovation in the life sciences field

Techbio is fast emerging as a technical sector of interest, focusing on the application of "big data" techniques to drive innovation in the biotech and life sciences fields. Data-driven analysis can reduce the amount of wet lab experimental research needed to identify relevant biological pathways and screen candidate compounds for the treatment of particular diseases. As discussed in our article about the rise of techbio and its intellectual property (IP) needs, patent protection can, in principle, be available for compounds or methods of treatment arrived at using computational methods, with the claims of the patents covering the compounds or methods of treatment themselves (rather than the methods used to develop them) in the same way as those obtained through traditional wet lab methods.

Related article
The rise of techbio and its IP needs: IP strategies for data-driven innovation
dycip.com/riseoftechbio

Techbio innovation may also lie in the provision of a machine learning based diagnostic tool, for example, a machine learning model trained to predict, based on biomarker data or scan images from a patient, whether a patient has a particular medical condition. Patent protection can be available for such diagnostic tools. However, the patent application should be drafted carefully to ensure commercial relevance of the claims, and to ensure that the specification provides a sufficient disclosure of the machine learning model and how it was trained, in order to permit arguments for the presence of an inventive step to be made during prosecution. Care must also be taken when drafting the patent application to avoid restrictions on the patentability of diagnostic methods, which exist in many jurisdictions. Our article about practical considerations for patenting AI provides more detailed tips on drafting patent applications in the field of machine learning.

Related article
Practical considerations for patenting AI
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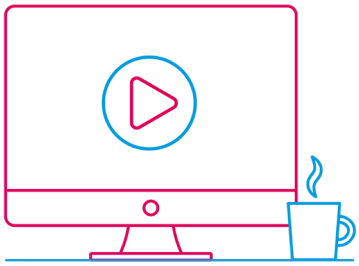
What intellectual property is available for techbio platform providers?

Some life science and biotechnology companies may wish to use computational approaches to further their research, but may not have the expertise to develop their own data-driven research tools. Therefore, an emerging class of techbio companies, which develop generic computation platforms that can be licensed for use by others and applied to a wide range of life science problems, are coming to the fore. For example, the platform may provide a generic machine learning framework, and users of the tool may provide their own data sets for training this tool to handle a specific task. Developers of such a techbio platform may wish to protect their investment using IP. What options are available?

Protection using unregistered rights (for example, copyright and trade secrets)
Copyright will automatically subsist in the software underpinning the platform and can be useful in supporting licensing of the software to customers, but will only protect the specific code and not the underlying functions. Care should be taken in agreeing terms on ownership of the copyright when engaging contractors for software development work. Confidential know-how associated with the working of the techbio platform may also be protected as a trade secret. However, such unregistered forms of IP will not protect against a competitor independently producing a competing platform without any copying of your innovation.

Patent protection
In view of the limitations of unregistered

Related webinar



Our webinar "Fireside chat: protecting innovation in the techbio sector" is now available on demand at: dycip.com/web-techbio-innovation

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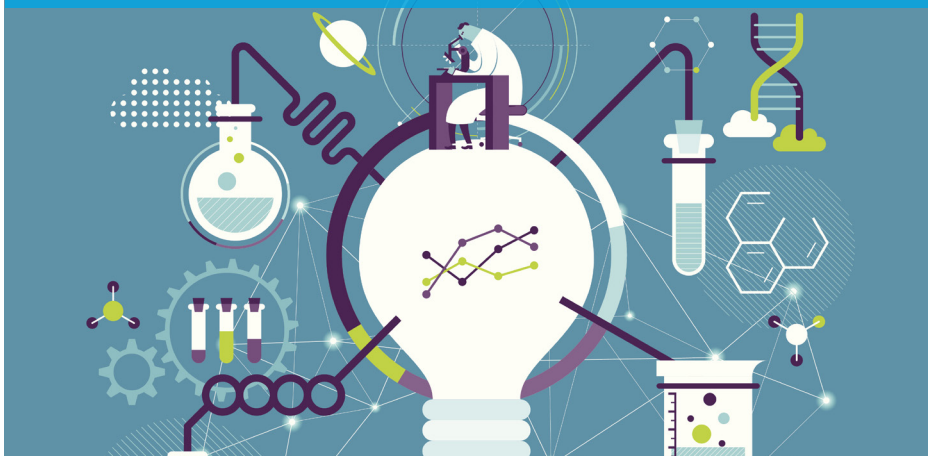
Patent protection for data-driven techbio platforms



rights, patents may provide stronger protection of the technical functionality of the techbio platform. Patents can provide a monopoly right which can be enforced against others even if there is no evidence of copying. However, for generic platform providers, it can be challenging to obtain strong patent protection, as most patent offices have restrictions on the patentability of abstract mathematical methods defined generically without a specific real world use case, and overcoming these restrictions may require the patent to be relatively narrow in scope.

For example, in Europe patentability requires a claimed invention to provide a technical contribution. As with other types of mathematical methods, the European Patent Office (EPO) considers claims to machine learning based methods to be excluded from patentability unless either:

- The claim specifies a specific technical purpose for which the method is used (for example, application of the computational platform to development of a treatment for a particular disease); or
- The claim defines a specific technical implementation of the method, and the method is particularly adapted for that implementation, in that its design is motivated by technical considerations of the internal functioning of the computer (for example, this could apply if the machine learning model includes processing steps adapted for particularly efficient use of memory or network bandwidth).

For a generic platform provider the use case may be defined by the customer, not inherent to the platform itself, and so it may be a challenge to define a specific technical purpose, which could meet the EPO's requirements, while still being generic enough to cover all likely uses. If a patent is to be granted, it may be that the patentee needs to accept a compromise where the patent is limited to a particular use or class of uses (for example, prediction of a compound for treatment of a specific class of medical conditions), rather than being defined for generic application. For an inventive step to be present, it may also be that the claim needs to be limited to specific features of the computational processing adapted for the claimed use that make the processing work better for that use.

A claim directed to a specific technical implementation might be relatively narrow in scope, and it may be that others producing similar competing techbio tools might not adopt the same technical implementation, or it might be difficult to check whether a competitor's platform uses that technical implementation. Nevertheless, if there are any inventive features which make the platform use hardware resources of a computer more efficiently, this could provide a route to patentability that might not be limited to a particular use.

Another factor to consider when considering patent protection for data driven techbio platforms is that patent applications are generally published 18 months after the first filing. To meet the requirement of sufficient disclosure of the invention, most patent offices expect to see detailed disclosures of implementation methods for a machine learning platform, so the publication of the patent application may give away information to others which might have been hard to reverse engineer from the product itself. Companies may wish to balance this against the chances of success of obtaining adequate patent protection, when considering whether to file a patent application.

However, one strategy can be to file a patent application initially to allow for any non-confidential discussions of the technology with potential investors or commercial partners, and to then decide in good time before the 18-month publication date whether to allow the application to publish, and continue efforts to prosecute the patent to grant, or withdraw the patent application to prevent publication of its contents. This decision could be based on the patent office search opinion, which will often be received in the first 12 months after filing, and/or based on any feedback from investors or commercial partners.

Therefore, there can be a complex set of considerations to take into account when assessing what steps to take, which will vary depending on the specific technology at issue. With close collaboration from attorneys in D Young & Co's life sciences and computing groups, our team can review your specific needs and help you decide how to proceed.

Related webinar

Protecting innovation in the techbio sector, presented by Robbie Berryman, Jennifer O'Farrell and Alan Boyd.
dycip.com/web-techbio-innovation

Authors:
Robbie Berryman & Jennifer O'Farrell

G 1/23
Assessing whether commercially available products are prior art

A referral has been made to the European Patent Office's highest legal authority, the Enlarged Board of Appeal, to seek clarification concerning the extent to which products that are commercially available before a patent application is filed must be analysable and reproducible by the skilled person, in order to constitute prior art for assessing novelty and inventive step under the European Patent Convention (EPC).

To what extent does enablement play a role in assessing whether commercially available products are state of the art?

This case relates to an appeal, T 438/19, filed against the decision of the Opposition Division to reject an opposition against EP2626911. In order to determine whether the subject matter of granted claim 1 involved an inventive step in this case, it was necessary to establish whether the commercial product (a polymer sold under the trade mark ENGAGE® 8400) had been made available to the public before the effective filing date of the patent, and could thus represent the closest prior art.

During proceedings before the Technical Board of Appeal, reference was made to the previous Enlarged Board of Appeal's decision G 1/92, which addressed the requirements for "availability to the public" in the sense of Article 54(2) EPC. In particular, reference was made to the headnote of this opinion, which reads:

"1. The chemical composition of a product is state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition.

2. The same principle applies mutatis mutandis to any other product."

A particular focus was placed on the degree of analysability and reproducibility required for the ENGAGE® 8400 product to be considered state of the art. This is because in G 1/92 the Enlarged Board of Appeal ruled that the skilled person must be able to discover the composition or internal structure of the product, and then reproduce it **without undue burden**, for the composition or internal structure to become state of the art.

In its submissions, the opponent argued that an exact reproduction of the product was not required. Moreover, it was argued that irrespective of the extent to which the chemical composition of ENGAGE® 8400 polymer could be reproduced, certain properties of that material (which were covered by the claims) had been placed in the public domain before the filing date, and it would be incorrect and unreasonable to disregard such information on the basis that ENGAGE® 8400 could not be **exactly** reproduced.

Conversely, the proprietor suggested that while it is not disputed that ENGAGE® 8400 was commercially available before the filing date, the polymer could not have been made available to the public within the meaning of G 1/92, since the skilled person would be unable to exactly reproduce it, and without undue burden. The proprietor indicated that reverse engineering such a polymer, without knowing the conditions for its synthesis, would require an extensive research programme, the need for which would represent an undue burden, and without a guarantee of success.

The proprietor therefore considered that the ENGAGE® 8400 polymer was not enabled and thus could not constitute prior art.

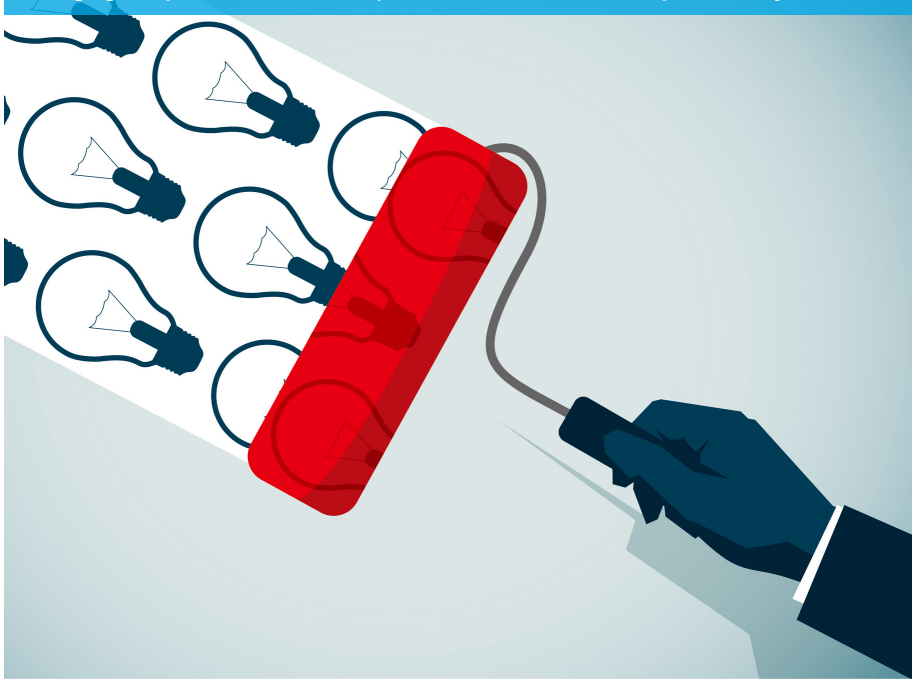
In its analysis, the referring board noted that opinion G 1/92 has given rise to diverging interpretations, leading to legal uncertainty regarding when commercially available products are considered state of the art. For example, the board highlighted diverging interpretations relating to the degree of analysis required to determine the composition of a commercial product, and thus its application as state of the art. Whilst some boards adopted a requirement for the analysis of the exact composition of the product, other boards have adopted a more lenient position, and considered that a complete analysis of a product put on the market was not required to take away the novelty of claimed subject matter. The diverging interpretations arising from G 1/92 are clear from an analysis of T 946/04, where it was suggested that a complete analysis of the product was required, and T 952/92, where a complete analysis was not required.

Similar diverging interpretations have also been provided for the so-called "reproducibility criterion" arising from G 1/92. In particular, while some boards have suggested that G 1/92 indicates that a product must be exactly reproduced, other boards have adopted a more lenient position and considered that a product put on the market constituted prior art without explicitly or only partially addressing its reproducibility. The diverging interpretations arising from G 1/92 in this regard are clear from an analysis of T 977/93, where exact reproduction of the product was required, and T 952/92, where a complete analysis to enable exact reproduction was not required.

In addition, the board highlighted diverging case law regarding whether, when undue burden is found to be required to analyse and reproduce a product, the product and its composition should be excluded from the state of the art, or whether only the composition of the product should be excluded. In order to highlight the importance of this distinction, the board noted the wider implications for inventive step, with emphasis on determining the closest prior art. In particular, if in application of opinion G 1/92 a product is not state of the art pursuant to Article 54(2) EPC, that product cannot be used as starting point for assessing inventive step. However, if the conclusion is only that its composition is not state of the art, but the product itself is still state of the art as it is commercially available, the product could be used as a starting point for the assessment of inventive step, should technical information about that product reported in documents of the state of the art make it of particular interest for the skilled person. The board noted that this was the case in the present appeal, as the commercial product ENGAGE® 8400 was shown in the examples of D1 to be suitable for the

Useful link
T 0438/19, Boards of Appeal, 27 June 2023: dycip.com/t0438-19

Diverging interpretations have been provided for the so-called "reproducibility criterion"



same purpose as the present invention. In view of the above uncertainty, and to ensure uniform application of the law, the following questions have been referred to the Enlarged Board of Appeal:

"1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date.

2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (for example, by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?

3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?"

Request for written statements

The Enlarged Board of Appeal is likely to hold oral proceedings in 2024, and its decision may be expected in early 2025. In the meantime, the EPO has provided the opportunity for third parties to file written statements on this matter. Any such submissions are to be filed by 30 November 2023 to ensure that they can be given due consideration. We are monitoring the progress of the case before the Enlarged Board of Appeal and will keep you updated.

Author:
Oliver Cartwright

UPC

Early usage of the UPC Infringement and revocation proceedings

The Unified Patent Court (UPC) opened its doors on 01 June 2023. Now, more than six weeks since the opening of the court, based on publically available statistics, we consider the actions that have been brought before the UPC, both in terms of infringement proceedings and revocation proceedings.

- When reviewed on 17 July 2023, the UPC lists seventeen infringement actions and three revocation actions, of which one is a counter claim for revocation in response to an infringement claim.
- Initial uptake in terms of revocation actions appears relatively low. By way of comparison, the number of patents opposed at the European Patent Office (EPO) each year is typically around 4,000.
- There is no noticeable bias in terms of infringement actions in relation to particular areas of technology. Infringement actions are pending for companies operating in the fields of pharmaceuticals, biotechnology, telecommunications and retail technology.
- On the other hand, all three revocation actions relate to pharmaceuticals and/or biotechnology.
- The uptake of the UPC is broadly spread geographically, with approximately one third of claimants being European and two thirds being non-European.

Overall, while it is still early days for the UPC, it seems that initial uptake may not be as high as suggested by some observers in the run up to the launch of the new system. It may be that a number of companies are waiting to see how cases are handled by the UPC and how the case law develops. So far it seems that only a relatively small number of specific companies are taking advantage of the opportunities afforded by this new court. It will be interesting to see how uptake of the UPC develops. We will continue to monitor and report on this over the coming months.

Author:
Keith Daly

Newron can't play fast and loose
UK Patents Court restricts combination SPCs

Case details at a glance
Jurisdiction: England & Wales
Decision level: High Court
Parties: Newron Pharmaceuticals Spa
Applicant: [2023] EWHC 1471 (Ch)
Date: 26 May 2023
Decision: dycip.com/ewhc1471

In a recent decision, the UK Patents Court considered the issue of whether supplementary protection certificates (SPCs) could be granted for a product which is a combination of two active ingredients (A+B), based on a basic patent claiming the combination A+B, and a marketing authorisation for only one of those active ingredients (A), when issued together with instructions in the summary of product characteristics (SmPC) that the product A should be taken in combination with B. Such a combination has been termed in the art as a "loose" combination of A and B. The court held that such a marketing authorisation and SmPC could not support an SPC for A+B, affirming the UK Intellectual Property Office's (UKIPO's) decision that the use of the product cannot be taken into account when determining the product for which SPC protection is sought, and confirming that the loose combination SPC did not meet the requirements of Article 3(b) of Regulation (EC) 469/2009 (the SPC Regulation).

Newron Pharmaceuticals Spa owned a basic patent (EP1613296B) claiming the use of safinamide, in combination with levodopa, and a peripheral decarboxylase inhibitor (PDI) for the treatment of Parkinson's disease. It obtained a marketing authorisation from the European Medicines Agency (EMA) for safinamide, but with wording in the SmPC that the drug is indicated as add-on therapy to levodopa and other PDI medicinal products in the treatment of Parkinson's disease.

SPC application

Newron then sought a UK SPC based on the above basic patent and marketing authorisation, arguing before the UKIPO that the reference in the SmPC, that the active ingredient safinamide was indicated as add-on therapy, meant that the authorised product was a combination product. The UKIPO hearing officer disagreed, being of the view that the marketing authorisation was for safinamide alone, and that the wording in the SmPC related solely to the intended use of the product and did not change the fact that the marketing authorisation granted was for safinamide alone. On this basis, and existing UK and Court of Justice of the European Union (CJEU) case law on SPCs, the UKIPO decided to refuse the SPC application on the grounds that Article 3(b) of the SPC Regulation was not met.

Appeal

Newron appealed that decision to the UK Patents Court, arguing that the term "product" may have a different meaning between the various limbs of the SPC Regulation, and that the wording in the SmPC meant that the authorised product was in fact a combination product.

The court dismissed Newron's appeal, confirming that the instructions in the SmPC to take safinamide as an add-on to levodopa did not mean that the definition of the authorised product changed from safinamide alone to safinamide in combination with any other actives. The UKIPO's decision that the SPC did not meet Article 3(b) of the SPC Regulation was therefore upheld.

In this regard, the court cited the CJEU decisions in Pharmacia Italia (C-31/03), MIT (C-431/04), Yissum (C-202/05), Abraxis (C-443/17) and Santen (C-673/18), as well as its own decision in Yeda v Comptroller-General of Patents [2010] EWHC 1833. In all of these cases, the court ruled that Article 1(b) of the SPC regulation requires that that the "product" is strictly confined to the active ingredient which is the subject of the marketing authorisation.

The court confirmed that this case law meant that neither the intended use of the product, nor the presence of other excipients in the formulation, change this definition, regardless of the merits of the invention on which the basic patent relied. Newron therefore confirms existing UK and CJEU case law on SPCs, that the definition of the "product" for SPC protection is strictly limited to the active ingredient of the authorised medicinal product, and that the intended use of the product cannot be taken into account when determining the definition of the product. Significantly, the court's decision explicitly extends this principle to the effect that instructions in the SmPC, that the approved product (A) should be taken in combination with another product (B), cannot change the definition of the product as set out in Article 1(b), from a mono-product A into a combination product A+B.

Key takeaways

This decision significantly limits the possibilities for obtaining combination SPCs in the UK, effectively closing the door to such combination SPCs based on loose combination marketing authorisations. Following this decision, only an marketing authorisation to a fixed combination including both A and B in the same pharmaceutical preparation would be sufficient to support a UK SPC to the combination A+B in the future.

Applicants seeking SPC protection for combination products in the future will need to re-think not just their SPC strategy but also the underlying regulatory strategy, perhaps seeking approval for a fixed combination rather than a loose combination. We would be pleased to assist with SPC strategy on products that have obtained or are expected to obtain an marketing authorisation. If this would be of interest, please contact us.

Newron argued before the UKIPO that the active ingredient safinamide was add-on therapy

Author:
Garreth Duncan

Cross-border computer systems Patent infringement across multiple jurisdictions

Case details at a glance
Jurisdiction: England & Wales
Decision level: High Court
Parties: Illumina, Inc v Premaitha Health Plc
Citation: [2017] EWHC 2930 (Pat)
Date: 21 November 2017
Decision: dycip.com/illuminavpremaitha

A granted patent is a national right, meaning that the protection conferred by a patent in a particular country only applies within the borders of that country. For modern day computer systems there are no restrictions on location. Cloud computing can be used to offload data processing steps to a server which may be located in a different country to the end user. It is likely that on some occasions that server will be in a country not protected by a patent, as the cost of obtaining patents in every territory where such a server could be located is likely to be prohibitive.

This presents difficulties for establishing whether a patented computer system is infringed when such a system is implemented across multiple jurisdictions.

As discussed in detail in our review of the approach taken by the courts in England & Wales up to 2017, infringement of a UK patent depends on whether the invention is "used" or "put into effect" in the UK. The particular wording of the claim may affect determination of who the user is. For example, for a claim to a method of operating a server, the user was deemed to be the server farm operator so that the method was not considered used in the UK when the server was abroad, while for a claim to a "gaming system", the user was deemed to be the end user playing the game so that the system could be said to be used in the UK, even if the system involves an offshore server.

Illumina Inc v Premaitha Health plc

In the case of Illumina v Premaitha, Illumina was the exclusive licensee of a patent claiming a non-invasive method of detecting and testing foetal DNA. The claims were relatively generic; requiring "a detection method … detecting the presence of a nucleic acid of foetal origin in the sample", without specifying the particular steps of the method.

Premaitha conducted similar tests, referred to as the IONA test (detailed in paragraph 500 of the judgment), in which the initial DNA preparation and sequencing is conducted in the UK, but then the raw data is sent to Taiwan for the actual analysis. The results are then returned to the UK. Premaitha contended


Cloud computing can be used to offload data processing steps to servers in different countries

that the patent was not infringed since some of the steps are conducted in Taiwan. The court held that the user of the IONA test is a laboratory in the UK. It is immaterial that some of the method steps take place in Taiwan, since the result is sent back to the UK for use in the UK. The court therefore found that the IONA test was used or put into effect in the UK, and hence the patent was infringed.

Practical tips for drafting claims

It is important when drafting a patent application to consider whether any of the steps involved in the invention could be implemented on an offshore server, and if so whether those steps are necessary for distinguishing the invention from the prior art.

It is useful to consider whether single-actor or multi-actor claims would be most appropriate for the invention.

A single-actor claim can be used to protect part of a system (for example, a server or client device only), and generally offer broader protection than a multi-actor claim, as single-actor claims require fewer limitations to be present to prove infringement. By including a single-actor claim for one part of the system, even if the other part of the system is implemented in a different territory, that does not affect the location of use for the claimed part of the system.

It is important to consider where the inventive features actually lie within the system. For example, if the inventive features are only present in the server, a single-actor claim for the server can be provided (for example, "performing X", "transmitting Y"), but there may be little inventive in the client device that could support an independent claim for the client device alone, so it is not always possible to obtain single-actor claims for each part of the system.

If the bulk of the invention lies in the processing at the server, then to increase the likelihood that infringement is deemed to occur in the UK, even if the server is in another country, it can be useful to also include a multi-actor claim to the system (for example, a system comprising a server and a client device). It could then be argued that the system is used in the UK, even if the server is located outside of the UK.

Authors:
Robbie Berryman & John Cameron

In short

To increase the likelihood of protection against infringers who offload steps to offshore servers, consider including both single-actor claims and multi-actor claims. For example, a patent could include, if possible, claims to:

1. the server;
2. the client device; and
3. the system comprising both devices.

We strongly recommend that you seek professional advice from a patent attorney to ensure that such claims are drafted correctly.

EPO guidance
Requesting "in-person" or ViCo oral proceedings

It is increasingly becoming important, during the written procedure leading to oral proceedings, for parties to the proceedings to provide detailed reasons for or against an in-person hearing. Merely expressing a preference for a particular format is essentially irrelevant. Further, based on developing case law, it seems that referring to G 1/21 and stating in person is the "gold standard" is not, on its own, sufficient.

Background

Mandatory videoconferencing was introduced during the Covid-19 pandemic in a trial phase. Initially, the platform used did not allow virtual break-out meeting rooms or screen sharing, so that all participants could view the shared screen. However, since the end of 2021, Zoom has been the standard platform for oral proceedings held by videoconferencing and it does have these features as well as improved transmission quality.

In October 2021, the Enlarged Board of Appeal determined in G 1/21 that the limitations of video technology make videoconferencing suboptimal as a format for oral proceedings. In G 1/21 it was held that in-person oral proceedings represented the "gold-standard", and should be the default option in the absence of a disruption (such as the Covid-19 pandemic).

From the beginning of 2023, videoconferencing became the default format of oral proceedings before the Examining Divisions and Opposition Divisions following a decision issued by the EPO. Only if there are serious reasons against holding the oral proceedings by videoconference, and the division permits it, will proceedings in opposition be conducted in person.

It is important to note that this decision does **not** apply to the Boards of Appeal. Under Article 15a RPBA, the Boards of Appeal have the discretion to hold proceedings by videoconferencing if they consider it appropriate, either upon request by a party or its own motion.

As can be seen from the selected key case law discussed below, the use of videoconferencing, in particular at the Boards of Appeal, remains far from a settled matter, and the case law continues to evolve around its use.

Case law developments since G1/21

The Board of Appeal in T 0758/20 held that G 1/21 cannot be read as restricting the possibility of oral proceedings by videoconference only in the case of a general emergency. In this decision, it was noted that G 1/21 does not exclude that there are other circumstances specific to a case that justify the decision not to hold in-person oral proceedings.

In T 1158/20, the Board of Appeal held that there had been improvements to videoconferencing allowing high-quality picture and sound. Accordingly, oral proceedings by videoconference are no longer as far from in-person hearings as they were when G1/21 was issued. As a result, it was held that in-person oral proceedings can often be considered equivalent to oral proceedings by videoconference such that the gold-standard of in-person hearings no longer applies.

However, the Board of Appeal in T 2432/19 held that in-person oral proceedings can only be denied under very limited conditions (even in a situation of general emergency such as a pandemic). Further, the Board of Appeal confirmed that parties cannot force the boards to conduct videoconferences instead of in-person oral proceedings. In particular, the Board of Appeal considered that videoconferences, at least with current technology, can only provide a suboptimal form of communication and that parties have a right to the optimum format for oral proceedings (that is, in-person oral proceedings). The Board of Appeal considered that, in this case, the parties may have resorted to detailed explanations revolving around the figures in the description, and, in the Board of Appeal's experience, it was easier for a party wishing to explain the functional effects of structural features to do this by use of a flip chart. Moreover, the Board of Appeal considered that the filing of such sketches by email during a videoconference oral proceedings results in delays, and may well break the flow of a party's submission.

T 0618/21 somewhat contrasts to T 2432/19 and supports T 1158/20. In T 0618/21, the Board of Appeal held that the decisive criterion for using videoconferencing is "expediency", which implies that videoconferencing is fundamentally suitable for achieving the purpose intended by the oral proceedings, and also appears sensible (relevant). In particular, like T 1158/20, the Board of Appeal noted that due to the technical developments which have occurred since G1/21, and the greater experience of all those involved, videoconferences can in most cases now be regarded as an almost equivalent alternative to in person. The Board of Appeal discussed that the specific circumstances of some cases can mean that the format of the videoconference is unsuitable. In particular, the Board of Appeal gave consideration to the issue of drawings being made live on a flip chart. The Board of Appeal highlighted that there is the option of either making a drawing live in a suitable drawing program and letting the other participants participate via a split screen. The Board of Appeal noted that as an alternative, handwritten and scanned drawings with additions can be brought to the attention of the other participants in the videoconference and explained. As a further option, relevant documents could also be emailed to the Board of Appeal in the run-up to or during the course of the hearing, which would then distribute them to the other parties.

The Board of Appeal acknowledged that while there might be a slight loss of spontaneity using videoconference for drawings, it can be clearer and more vivid than is possible over the distances in a meeting room. As a further point, the Board of Appeal noted that, due to the parallel image and sound transmission, the facial expressions of the parties can sometimes be observed better, since you can keep an eye on the other participants side by side on the screen. The Board of Appeal highlighted that the criteria

Useful links

Decision of the EPO concerning the format of oral proceedings before examining and opposition divisions, the Legal Division and the Receiving Station. OJ EPO 2022, A103, European Patent Office, published 30 November 2022: dycip.com/a103

D Young & Co's Guide to ViCo at the EPO and client checklist for ViCo: dycip.com/vicoguide

Currently, the trend seems to be that more Board of Appeal oral proceedings are being held by videoconference

to be taken into account when considering suitability for videoconferences include: additional expenditure of time and money for a journey to the premises of the Board of Appeal, as well as the environment impact of travel. The Board of Appeal acknowledged that videoconferencing would not be considered as equivalent to in-person if, for example, a sample is to be inspected or a direct physical interaction is required.

In T 0423/22, the Board of Appeal held that hearing a witness by videoconference did not infringe a party's right to be heard. The Board of Appeal acknowledged that part of the witness' body language was not visible. However, the Board of Appeal held that the credibility of a witness is not determined based largely on their body language, and even less on body language outside the frame visible in a videoconference. Moreover, as was also concluded in T0618/21, the Board of Appeal highlighted that facial reactions can be seen in greater detail on a screen, compared to witnesses several meters away in a room. The Board of Appeal also noted that movements such as a trembling knee may cause movements of other visible parts of the body. The Board of Appeal emphasised that a witness's credibility is based mainly on their testimony and the absence of contradictions. Like T 0618/21 and T 1158/20, this Board of Appeal also highlighted the technical improvements that have occurred since G 1/21.

Practice points

As mentioned above, there is discretion for an Examining Division or an Opposition Division to allow in-person proceedings, and discretion for a Board of Appeal to use videoconferencing. Currently, the trend seems to be that more Board of Appeal oral proceedings are being held by videoconferencing. Based on the developing case law, factors that could be considered when preparing arguments for or against an in-person hearing include:

- Saving time and cost and reducing the environmental impact of travel may be persuasive that a hearing should be by videoconference.
- The need to use a flip chart or to present drawings may or may not be persuasive that a hearing should be in-person. Different Boards of Appeal seem to take a different approach to this (see T 0618/21 and T 2432/19).
- The need to hear a witness may not necessarily be persuasive that a hearing should be in-person.
- The need to inspect an object may be persuasive for an in-person hearing.
- Personal limitations of individual participants can be persuasive that a hearing should either be in-person or should be by videoconference.

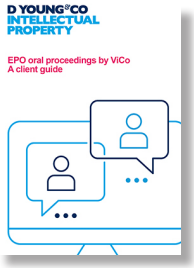
We are well equipped to carry out oral proceedings by videoconference and have extensive experience in doing so.

If you have any questions about oral proceedings by videoconference, please review our Guide to ViCo (see link below) or speak to your D Young & Co representative.

Author:
Stephanie Wroe

Guide to ViCo at the EPO

We have drawn from our experience of *ex parte* and *inter partes* oral proceedings before the EPO by video conference to prepare a guide for participants covering what to expect and how best to prepare.



The guide includes our handy client "Checklist for ViCo".

www.dyoung.com/vico-guide

Rules of Procedure of the Boards of Appeal
EPO consultation on timeliness of appeal proceedings

Useful link
EPO consultation:
dycip.com/epoconsultation

The Boards of Appeal of the European Patent Office (EPO) are an independent body to which decisions made by the EPO can be appealed. A large backlog of appeal cases had been building up over several years creating a roadblock to the efficient conclusion of cases. The Rules of Procedure for the Boards of Appeal (RPBA 2000) came into force on 01 January 2020 with aims to increase:

1. efficiency by reducing the number of issues to be treated;
2. predictability for the parties; and
3. harmonisation.

As part of its drive to improve efficiency and predictability of proceedings before the Boards of Appeal, the EPO has launched a user consultation on further proposed amendments to the RPBA.

Proposal to increase timeliness of appeal proceedings

The goal is for the Boards of Appeal to deal with cases as soon as they are transferred, and to provide users with increased legal certainty by allowing the Boards of Appeal to settle cases more quickly with predictable time frames. In order to achieve this, the proposed amendments to the RPBA aim to modify the procedural framework.

The consultation proposes shortening of the standard period for filing the reply to the statement of grounds of appeal. In cases where there is more than one party, it is proposed that any reply of the other party or parties should be filed within two months of notification of the grounds of appeal rather than four months as currently set by Article 12(1)(c) RPBA.

It is proposed that the Board of Appeal be given the discretionary power to extend this standard period of its own motion, for example, where the proprietor is the respondent and there are numerous appeals by different opponents, the Board of Appeal will normally extend the time limit from the outset. As is the case under the current version of Article 12(1)(c) RPBA, any respondent will be able to request an extension of the period up to a maximum of six months in accordance with Article 12(7) RPBA. A request for extension of a time period will be at the Board of Appeal's discretion, and must be a written reasoned request presented before expiry of such period.

Under proposed new Article 13(2) RPBA, it is proposed that notification of a summons to oral proceedings is replaced with notification of a communication, under Article 15(1) RPBA (the preliminary opinion), as a trigger for the third level of the convergent approach.

The EPO has been driving to improve efficiency of proceedings before the Boards of Appeal

This would prevent the triggering of the third level of the convergent approach before a Board of Appeal sends a substantive communication under Rule 100(2) EPC, or under Article 15(1) RPBA, and effectively extends the less strict approach of Article 13(1) RPBA of amendment to a party's appeal case until later in proceedings.

It is also proposed that Article 15(1) RPBA should be amended to delete the second sentence: "In cases whether there is more than one party, the board shall endeavour to issue the summons no earlier than two months after receipt of the written reply or replies" and to add: "In cases where there is more than one party, the board shall issue the communication no earlier than one month after receipt of the written reply or replies referred to in Article 12(9)(c) RPBA."

The proposed Article 15(1) RPBA guarantees that the third level of convergence will not be triggered before the expiry of one month after receipt of the written reply (the current provision allows the Board of Appeal to apply a shorter timescale). Under the new provision, where there is more than one party the Board of Appeal may only apply a shorter timescale for issuing the communication if all the appellants agree to a shorter timescale.

The proposed amendments to Article 15(9)(b) RPBA add reference to the President of the Boards of Appeal in the context of improving timeliness, so that the President is drawn into the delay in despatching a decision which was not announced orally at the conclusion of oral proceedings.

Transitional provisions will only apply to the amendments to Article 12(1)(c) RPBA as in force from 01 January 2024, and shall not apply to any written reply to any statement of grounds of appeal notified before that date.

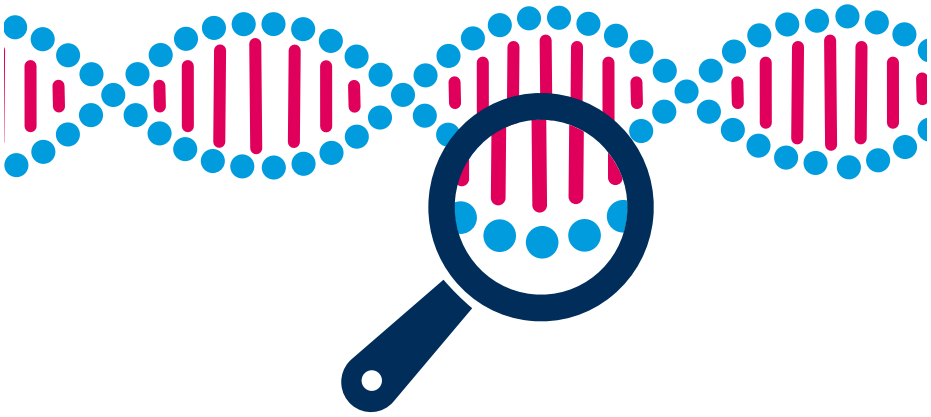
The consultation is open to the public, and is active until noon Central European Summer Time (CEST) on 11 September 2023.

Author:
Emma Hamilton

And finally...

Webinar invitation

European biotech patent case law
Tuesday 05 September, 2023



Our regular European biotech patent case law webinar returns on Tuesday 05 September 2023 at 9am, noon and 5pm UK time (BST), with a round up of recent and significant EPO decisions presented by Chartered and European Patent Attorneys Simon O'Brien and Tom Pagdin.

Speakers

Simon O'Brien was appointed partner in 2010. His area of expertise encompasses both biological and chemical subject matter including the fields of molecular biology, biotechnology, biochemistry, food technology and nutrition, diagnostics, pharmaceuticals, and polymer chemistry. Simon advises on all aspects of patent law, including patent drafting and prosecution, opposition and appeal proceedings.

Tom Pagdin was promoted to partner in 2022. He is a Chartered and European Patent Attorney with a strong technical background in biochemistry, immunology, molecular biology and genetics, with particular experience in antibodies, chimeric antigen receptors, RNAi technologies, vaccines, viral vectors, diagnostics, peptides, food technology and nutritional compositions.

Registration

Find out more and sign up to attend at a time convenient to you:
dycip.com/web-bio-sep23

Contributors

Partner, Patent Attorney
Nicholas Malden
nmm@dyoung.com
www.dyoung.com/nicholasmalden

Partner, Patent Attorney
Robbie Berryman
rjb@dyoung.com
www.dyoung.com/robbieberryman

Technical Assistant
John Cameron
jwc@dyoung.com
www.dyoung.com/johncameron

Patent Attorney
Oliver Cartwright
occ@dyoung.com
www.dyoung.com/olivercartwright

Technical Assistant
Keith Daly
krd@dyoung.com
www.dyoung.com/keithdaly

Partner, Patent Attorney
Garreth Duncan
gad@dyoung.com
www.dyoung.com/garrethduncan

Associate, Patent Attorney
Emma Hamilton
ejh@dyoung.com
www.dyoung.com/emmahamilton

Partner, Patent Attorney
Jennifer O'Farrell
jmo@dyoung.com
www.dyoung.com/jenniferofarrell

Associate, Patent Attorney
Stephanie Wroe
sfw@dyoung.com
www.dyoung.com/stephaniewroe

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Contact details

London
Munich
Southampton

T +44 (0)20 7269 8550
F +44 (0)20 7269 8555

mail@dyoung.com
www.dyoung.com