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Unified Patent Court comes closer as Austria progresses towards ratification of PAP

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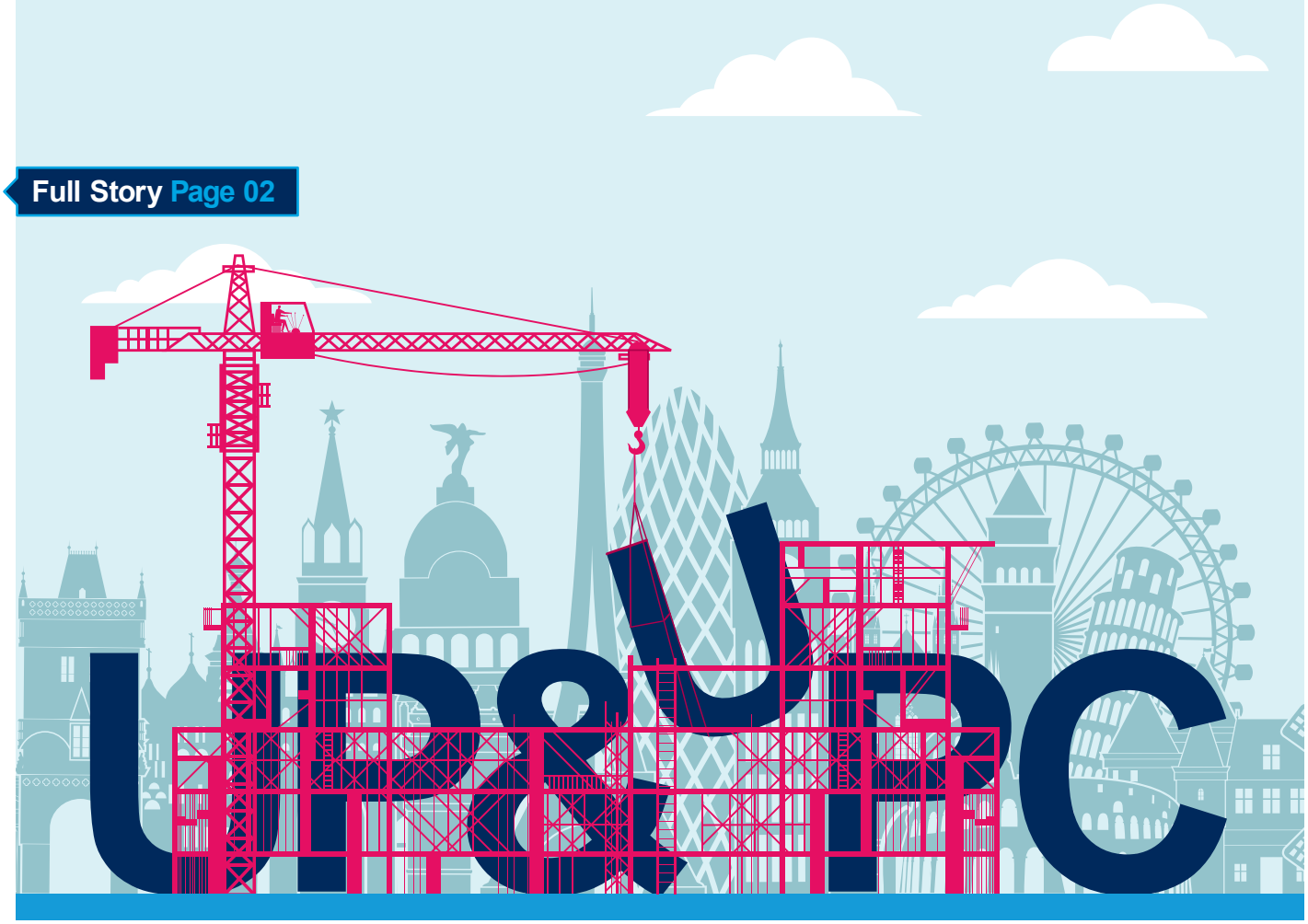

Editorial

As the year draws to a close much has changed over the past 12 months and much is different. Sadly on a global scale, many are still suffering and dying from Covid-19, while vaccination has enabled some semblance of normal life to return for others. As the virus mutates into new and possibly more infectious strains no one can be sure as to what is in store for 2022.

At the EPO at least, we have received confirmation that double patenting has legal basis as a ground for refusal, but with the question of "same subject matter" left for debate. We can be sure of a continuation of oral proceedings by ViCo and possibly a decision from the Enlarged Board on if and under what circumstances post-filing data may be admitted in support of inventive step. Although the referral does not encompass the same questions with regard the assessment of sufficiency, clarification for inventive step where reformulation of problem can result in a change in the whole question of inventive step, will be of value.

So, looking forward to a year of greater clarity and the possibility of more face-to-face contact, I pass on best wishes for the festive season and 2022 from all here at D Young & Co.

Neil Nachshen, Editor

Events

European Biotech Patent Case Law
Webinar, 08 February 2022
Simon O'Brien and Tom Pagdin present our most recent round up of important and recent European biotech case law. Register now to secure your webinar seat.

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UP & UPC
Unified Patent Court comes closer as Austria progresses towards ratification of PAP

This is a complex and ever-evolving area of patent law that our UP and UPC experts continue to monitor. We are keeping a close eye on developments and we will provide further advice and updates as the situation changes and in the run up to the commencement of the new system.

We have produced detailed guides to both the UP and UPC that are available on a dedicated UP & UPC section of our website: www.dyoung.com/upandupc. If you have any queries regarding these, please do contact your usual D Young & Co representative or email us at mail@dyoung.com.

Clients will be contacted with specific guidance in the coming months and we will continue to publish regular and timely updates on our website UP & UPC pages. The following discussion provides an update on the expected timeline for the commencement of the UPC.

Latest progress of the ratification of the Protocol on the Provisional application of the UPC Agreement

Following recent developments by Austria, the UPC and UP are likely to become a reality between the middle and end of 2022, or in early 2023.

On 19 November 2021, the Austrian Parliament approved the Protocol on the Provisional application of the UPC Agreement (PAP-Protocol). This was then followed on 2 December 2021 by unanimous approval of ratification of the PAP-Protocol by the Austrian Federal Council (the second chamber of the Austrian Parliament). Austria are now therefore in a position to ratify the PAP-Protocol and bring the provisional application period for the UPC into effect.

As explained in previous articles, the PAP-Protocol is a short preparatory agreement of secondary legislation governing preparations for the start of the UPC by provisional application of some the Articles of the UPC Agreement required for those preparations. 13 member states need to have ratified the PAP-Protocol in order for it to come into effect and Austria is looking like the final, thirteen state. Assuming Austria deposits its ratification in late 2021 or early 2022, the provisional application period will commence. More information is set out below.

When will the UPC provisional application period begin?

Once Austria has completed its ratifications of the PAP-Protocol, the provisional application period of the UPC should start. This will allow for completion of preparatory work establishing the UPC, including stress testing of the electronic case management system and the appointment of judges. The provisional application period is expected to last from six to ten months, most likely eight months, and, as noted above, is likely to commence in late 2021 or early 2022.

When will the UPC system come into force?

With the provisional application period in effect, Germany can deposit its ratification of the UPC Agreement. Once German ratification is deposited, the new court will commence on the first day of the fourth month after the month in which that deposit occurs. Germany will not trigger this timetable until all preparatory work is complete.

The UPC Preparatory Committee have indicated that: "When it is clear that the UPC will be operational upon the entry into force of the UPCA the final ratification of the Agreement by Germany can take place serving as a "gatekeeper" for Member States to ensure a proper process".

Consequently, the UPC and UP system could come into force between mid 2022 and early 2023.

Sunrise period

Ratification by Germany will also determine the beginning of the "sunrise period" – a three-month window before the UPC becomes fully operational when patent owners are able to file "opt-outs" for existing European patents validated in one or more countries taking part in the UPC. The list of countries is available here: http://dycip.com/upc-countries.

Opting out in the sunrise period is important for patent owners wanting to avoid the

UP & UPC resources

Our UP & UPC guidance is kept up to date online at: www.dyoung.com/upandupc

jurisdiction of the UPC. If an opt-out is not validly registered in the sunrise period and an action started in the UPC when it becomes fully operational, it is not possible to then "opt out".

These steps are summarised in the table below with an indication of the **earliest** dates we expect events to take place.

Action/event	Comments	Earliest expected date (approximate)
Austria ratifies the Protocol on the Provisional Application Period.	End of which the PAP Protocol enters into force.	Q4 2021-Q1 2022.
PAP preparations to include (1) Governing bodies of the UPC assemble adopt secondary legislation (2) UPC budget finalised (3) IT systems finalised (4) Recruitment of judges of the court finalised.	Expected six-ten month period.	Q1-Q2 2022.
Germany deposits last instrument of ratification of the UPC Agreement (UPCA).	When work has progressed enough, Germany will deposit the last instrument of ratification of the UPCA. This is a four-month alert to the start of UPC and UP.	Q2-Q3 2022.
Sunrise period begins.	Three-month window before the UPC becomes fully operational. Opt-outs for EPs can be filed.	Q2-Q3 2022.
Commencement of the UP & UPC system.		Q3-Q4 2022.

This timetable is provisional at this stage and there are still some details to be clarified. One is the location of a UPC Central Division following the UK's withdrawal from the UPC. Nevertheless, we would suggest re-visiting the UP and UPC with particular focus on whether to "opt out" existing EP Patents from the UPC. Transactional matters such as agreements and licences should also be reviewed.

If you need any assistance or advice, please do contact your usual D Young & Co representative or email us at mail@dyoung.com.

Key points to note about the UPC, UP and opt-out

- A UP must be litigated in the UPC.
- All European patents must be litigated in the UPC for member states of the UPC, unless the patent owner opts out of the UPC.
- A validly filed opt-out is effective for the life of the patent.
- The opt-out will be available from the beginning of the sunrise period until the end of the transitional period (at least seven years from the start of the UPC).
- If proceedings are commenced in the UPC before an opt-out is filed, the patent owner is restricted to the jurisdiction of the UPC.
- The UK's withdrawal from the UPC means that a European patent designating the UK can only be enforced in the UK courts. A similar situation will arise for other member states of the EPC which are not signatories of the UPC Agreement, for example Spain, Poland, Switzerland and Norway.
- The UP and UPC do not impact the EPO opposition and appeal procedure.

Representation

A UP is obtained by filing a European patent application and selecting the UP at grant. Both our UK and Germany based European Patent Attorneys will be able to obtain UPs at the European Patent Office, exactly as we currently do for European patents. We will also be able to prepare and file opt-outs.

Furthermore, D Young & Co's experienced European patent attorneys, UK and German qualified patent attorneys as well as solicitors and Rechtsanwälte have the rights of representation before the UKIPO, the DPMA, the EPO and the UPC and can advise and support you when enforcing or defending actions for patent infringement and revocation/nullity actions. We will therefore be able to advise on a strategy for choosing the most appropriate route for patent protection utilising both the options of the unitary patent and national patent rights to match budget with respect to our client's business strategy.

Further advice and updates

We will keep a close eye on developments and we will be providing further advice and guidance over the next few months.

Authors:
Rachel Bateman & Alice Stuart-Grumbar

View our guides to the UP & UPC

D YOUNG & CO INTELLECTUAL PROPERTY UP& UPC

Our detailed guides to the UP and UPC are now available via our website at www.dyoung.com/upandupc

T 3072/19
When can a comparative test be used to demonstrate a technical effect?

A recent decision from the EPO Board of Appeal considered whether a comparative test (which was described in the application as filed) could be used to shown an improvement over the prior art. In T 3072/19, independent claim 1 of the main request was directed to an insecticide composition:

> "1. Insecticidal aerosol, characterized in that it comprises:
> 00.1 - 0.5 % by weight of alpha cypermethrin,
> 00.1 - 0.3 % by weight of permethrin,
> 0.01 - 0.5 % by weight of tetramethrin,
> 0.1 - 3.0 % by weight of piperonyl butoxide,
> 0-0.5 % by weight of a fragrance,
> one or more solvents,
> one or more propellants, and
> 0.2 - 0.6 % by weight of a carbamate insecticide."

The examining division refused the application for lack of inventive step starting from the commercial insecticidal aerosol "ORO". Claim 1 of the main request differed from ORO in having: (a) alpha cypermethrin in an amount of 0.1-0.5%; and (b) a carbamate insecticide in an amount of 0.2-0.6%.

Applicant's arguments on appeal

The applicant argued that the examples of the application as filed showed that an insecticidal aerosol according to claim 1 (ARAGON) was more efficient in the control of insects than the commercial aerosol ORO. A summary of results is shown below:

	Total efficacy	
	ARAGON	**ORO**
Mosquitoes	100%	96.25%
Flies	100%	100%
Cockroaches	74%	26%

According to established jurisprudence, a surprising effect demonstrated in a comparative test can be taken as an indication of inventive step. Therefore, since the application as filed provided a comparative test which demonstrated greater efficacy compared to the closest prior art the applicant argued that the objective technical problem should be formulated as the provision of an **improved** insecticidal aerosol.

Decision of the Board of Appeal

Contrary to the applicant's position, the board found that the comparison done in the examples of the application does **not** show that the improvement is achieved **by the distinguishing features**.

This requirement is laid down in numerous decisions. It is also established jurisprudence that, for this purpose, it might be necessary to modify the comparison so that it differs **only** by such distinguishing feature(s).

The two insecticidal aerosols differed in several respects. In particular, the Board of Appeal noted that, the overall content of active ingredients in ARAGON (above 1.06%) is markedly higher than in ORO (0.80%). The table below summarises the two insecticidal aerosols which were tested in the present case:

ARAGON	**ORO**
0.18% alpha cypermethrin	-
0.20% permethrin	0.25% permethrin
0.26% tetramethrin	0.20% tetramethrin
0.42% bendiocarb	-
-	0.34% piperonyl butoxide
-	0.01% d-Phenothrin
Total = 1.06%	Total = 0.80%

Consequently, the Board of Appeal found that the comparative test cannot show that the improvement has its origin in the distinguishing features of claim 1 (that is, alpha cypermethrin and the carbamate insecticide) because the increased efficacy can be expected merely from the higher amount of active ingredients present.

Thus, there was no technical effect associated with the distinguishing features. The objective technical problem was therefore formulated as merely the provision of an **alternative** insecticidal aerosol.

In view of the less ambitious technical problem, the Board of Appeal found a lack of inventive step from ORO in combination with D4, which disclosed that a carbamate insecticide and alpha cypermethrin may be combined to form suitable insecticides for aerosol. The board found that the amounts of carbamate insecticide and alpha cypermethrin were not linked to any technical effect and thus amount to an arbitrary selection with no inventive merit.

Lessons for applicants and third parties

This decision is a reminder to applicants that the EPO Boards of Appeal may take a strict approach to comparative tests. Although the applicant compared an insecticidal aerosol according to claim 1 with the closest prior art, the Board of Appeal did not deem this sufficient to demonstrate a technical effect. In other cases, for example during examination, it may be that such comparative tests would be looked upon more favourably.

On the other hand, third parties should take note that even if comparative tests have persuaded the examining division, such tests should be reviewed critically to assess whether a technical effect is convincingly shown to have its origin in the distinguishing feature(s) of the invention or if there are other differences which may account for any technical effect observed.

Considering the present case, one possible way in which the comparative test could have been modified to demonstrate a technical effect is shown below in Comparative Example 1:

ARAGORN	**Comparative Example 1**
0.18% alpha cypermethrin	-
0.20% permethrin	**0.20% permethrin**
0.26% tetramethrin	**0.26% tetramethrin**
0.42% bendiocarb	-
-	**0.59% piperonyl butoxide**
-	0.01% d-Phenothrin
Total = 1.06%	**Total = 1.06%**

In Comparative Example 1, the overall content of active ingredients is the same, addressing the Board of Appeal's objection. Additionally, the amounts of permethrin and tetramethrin are the same in both compositions.

If, as in the present case, only "non-ideal" comparative tests are available, then the risks and advantages associated with filing such tests should be carefully considered.

For example, when drafting examples it may be advisable to merely refer to any comparative examples as such, for example, "Comparative Example 1", to reduce the risk of the comparative example being cited as the closest prior art.

> The outcome of the present case may have been different if the applicant had not acknowledged that the comparative example was a commercially available insecticidal aerosol. In that case, the examining division may have found it challenging to establish that the comparative example was prior art.

Conclusion

This decision confirms that the EPO can take a strict approach when considering comparative tests and is a reminder of the potential issues facing applicants when such tests are relied upon.

We recommend seeking advice when designing comparative tests to help ensure that they are suitable for demonstrating a technical effect. For advice or further information please contact your usual D Young and Co representative.

Author:
Nathaniel Wand

Artificial intelligence and IP
Consultation on copyright and patent legislation

View the government consultation at https://dycip.com/ai-consultation

The UK Government has launched a consultation on how the copyright and patent system should deal with artificial intelligence (AI).

The consultation is a follow-up to the wider call for views, as previously reported, and focuses on three areas:

1. Copyright protection for computer-generated works without a human author
Responses to the previous consultation raised questions about the balance in the copyright system between the protection of human works and AI works. AI works are currently protected in the UK for 50 years, but the government is asking whether they should be protected at all and if so, in what manner?

One argument for keeping copyright for AI works is that since copyright for human originating works currently lasts much longer (life plus 70 years), if protection for AI works is lost it may simply result in false attribution to the person running the AI, and actually result in extending the copyright.

2. Licensing or exceptions to copyright for text and data mining, which is often significant in AI use and development
This relates to whether fair use of copyrighted works should clearly extend for example to using them in training (where the AI does not retain a true copy of the work, but may be influenced by it), so that copyright does not act as a barrier to the development of AI itself. Given some of the recent copyright decisions in the world of music, the notion of influence on AI creations has some fascinating implications.

3. Patent protection for AI-devised inventions. Should the UK protect them, and if so, how should they be protected?
Currently (and unlike copyright and registered designs) there is no straightforward means to protect an AI devised invention, as the initial right must start with a person.

In our previous articles on this subject, we have argued that current AIs do not devise inventions but rather act as tools for discovery, with the industrial application of the discovery by the user of the AI being the invention. This approach to automated discovery has solid legal roots and avoids other issues associated with AI-as-inventor, such as whether this also requires including an AI-as-skilled-person for the purposes of inventive step - for potentially all applications - and what that standard might mean.

In the consultation the government has shortlisted policy options for each issue, and provided further questions relating to how these options might be implemented.

Anyone interested in filing a response can send a response form to the government at AIcallforviews@ipo.gov.uk by 07 January 2022.

Author:
Doug Ealey

G 2/21
Questions on the correct plausibility standard referred to the Enlarged Board of Appeal

We recently reported on the provisional referral of three questions to the Enlarged Board of Appeal by the Board of Appeal presiding over case T 116/18, an appeal from the decision of the Opposition Division rejecting Syngenta's opposition against Sumitomo's European Patent 2484209.

Potential EPO Enlarged Board of Appeal referral: post-published data to support inventive step?
For a summary of the facts of T 116/18, please see our previous article"Potential EPO Enlarged Board of Appeal referral: post-published data to support inventive step?", published 10 August 2021.
http://dycip.com/post-published-data

The European Patent Office (EPO) has now officially confirmed that these three questions will be considered by the Enlarged Board of Appeal under case G 2/21 .

Questions referred to the Enlarged Board of Appeal

"1. Should an exception to the principle of free evaluation of evidence (see for example G 3/97, Reasons 5, and G 1/12, Reasons 31) be accepted in that post-published evidence must be disregarded on the ground that the proof of the effect rests exclusively on the post-published evidence?

2. If the answer is yes (the post-published evidence must be disregarded if the proof of the effect rests exclusively on this evidence), can the post-published evidence be taken into consideration if, based on the information in the patent application in suit or the common general knowledge, the skilled person at the filing date of the patent application in suit would have considered the effect plausible (*ab initio* plausibility)?

3. If the answer to the first question is yes (the post-published evidence must be disregarded if the proof of the effect rests exclusively on this evidence), can the post-published evidence be taken into consideration if, based on the information in the patent application in suit or the common general knowledge, the skilled person at the filing date of the patent application in suit would have seen no reason to consider the effect implausible (*ab initio* implausibility)?"

Assessing plausibility

The three questions referred to the Enlarged Board of Appeal thus concern whether, and under what conditions, experimental data provided by the patentee only after the filing date of the patent (so called "post-published" evidence) may be taken into account for the assessment of sufficiency and inventive step.

Established case law of the EPO requires that for such data to be taken into account, it must be "plausible" from the application as filed in combination with common general knowledge that the technical effect allegedly demonstrated by the post-published data was indeed achieved at the filing date of the patent in question. However, as one might expect, the standard applied to establish whether such an effect is indeed "plausible" or not has often proved controversial, especially when the outcome of a particular case hinged on whether post-published evidence was taken into account or not.

Following an extensive review of the existing case law, the Board of Appeal in T 116/18 decided that a referral to the Enlarged Board of Appeal for clarification on this matter was necessary.

The grounds for the decision of the Board of Appeal in T 116/18 have now been published, providing greater insight as to why these questions were referred to the Enlarged Board of Appeal.

Specifically, in the Board of Appeal's view there exist three diverging strands of case law as to how plausibility should be assessed.

Ab initio plausibility

The first of these strands was termed "*ab initio* plausibility". This line of case law held that post-published evidence can only be taken into account if the skilled person would have had reason to assume the alleged technical effect had been achieved at the filing date.

In short, the Board of Appeal appeared to consider that when applying this standard, a technical effect is considered implausible by default unless the skilled person would have had reason to consider it plausible based on the patent application as filed or from common knowledge at the filing date of the patent.

Ab initio implausibility

The second strand identified by the Board was termed "*ab initio* implausibility".
In contrast to the "*ab initio* plausibility" standard discussed above, the Board of Appeal considered this standard to require that post-published evidence can only be disregarded if the skilled person would have had legitimate reasons to doubt that the alleged technical effect would have been achieved on the filing date of the patent. That is, the Board of Appeal appeared to consider that when applying this standard, a technical effect is considered plausible by default, unless it can be shown the skilled person would have had reasons to think otherwise.

The central practical difference between these two standards thus appears to be the party with which the burden of proof lies.

> For "*ab initio* plausibility", it is the patentee who must show that a technical effect is indeed plausible, whereas for "*ab initio* implausibility", the burden of proof rests on the opponent to show that a technical effect was not plausible at the filing date of the patent.

The no plausibility standard

The Board of Appeal lastly considered there to be a line of case law that rejected the concept of plausibility altogether, which was termed the "no plausibility" standard.

According to the Board of Appeal, the

Useful links

Decision T 116/18 - view the Board of Appeal decision dated 11 October 2021: http://dycip.com/t011618

EPO communication regarding G 2/21 - view the communication dated 21 October 2021 regarding the referral to the Enlarged Board of Appeal of G 2/21: http://dycip.com/g221

Three questions will be considered by the Enlarged Board of Appeal in case G 2/21

decisions in this line of case law held that the very concept of plausibility is incompatible with the well-established problem-solution approach applied by the European Patent Office when assessing inventive step, which allows for reformulation of the technical problem when the patentee is faced with a perhaps previously unknown document as the closest prior art.

After identifying the above allegedly diverging lines of case law, the Board of Appeal provided some discussion that perhaps hinted at which standard it believed to be correct. Specifically, the Board of Appeal considered that the "ab initio plausibility" and the "no plausibility" standards represented "two extremes", which it appears were both disapproved of.

It was considered that by applying the strict "ab initio plausibility" standard, the patentee is faced with an "insurmountable hurdle" if an opponent invokes a new closest prior art document in opposition proceedings.

The Board of Appeal further considered that strict application of this standard would go against longstanding case law that the objective technical problem can be reformulated, so long as the "spirit" of the original invention is preserved. Equally, the Board of Appeal considered that if the "no plausibility" standard were applied, applicants would be able to engage in speculative or "armchair" patenting, by filing patent applications based on pure speculation rather than for a true invention.

The Board of Appeal lastly questioned whether the concept of plausibility was even compatible with the long-standing principle of free evaluation of evidence, by which the EPO departments have the power to decide for themselves how much weight to give to a particular piece of evidence when reaching a decision.

It was in particular questioned what legal basis in the EPC could prevent a Board of Appeal from taking into account evidence considered to be convincing.

The Enlarged Board of Appeal will now consider these questions. Its decision could have far reaching implications for users of the EPO patent system. Naturally, any apparent raising of the bar to show plausibility will require applicants to consider more carefully whether the data included in a particular patent application will be sufficient to render plausible any technical effects they may wish to rely on later.

Of course, it is also possible that the Enlarged Board of Appeal will disagree with the referring Board of Appeal that there is any divergence in case law, and decline to set out which of the three standards discussed above is the correct one.

EPO issues stay of proceedings

The EPO has issued a notice that in light of this pending referral before the Enlarged Board of Appeal, all examination and opposition proceedings before the EPO in which the decision depends entirely on the outcome of the referral will be stayed until the Enlarged Board of Appeal has issued its decision. The notice clarifies that only cases where the assessment of inventive step is exclusively based on evidence which was not publicly available before the filing date of the patent application (so called "post-published evidence") will be stayed.

It is not yet clear how strictly and at what point during proceedings the above criteria for staying a particular case will be applied. In particular, for complex opposition proceedings it appears that it may be difficult for the Opposition Division to reach the conclusion that the assessment of inventive step is based "exclusively" on post-published evidence, or that the decision depends "entirely" on the outcome of the referral, without hearing the arguments of all parties during oral proceedings.

The apparent limitation of the stays to cases only where the assessment of inventive step, and not sufficiency, is at issue is also notable, given that the questions referred to the Enlarged Board in G 2/21 make no such distinction between the plausibility standard required for inventive step and sufficiency. Indeed, the referring Board of Appeal in T 116/18 noted in its decision that whether plausibility of a technical effect is assessed under inventive step or sufficiency of disclosure depends on whether the alleged technical effect is a feature of the claim or not and explicitly considered that the standard of plausibility should be the same for the assessment of both inventive step and sufficiency (T 116/18, reasons, 9 and 13.3.1). It therefore remains to be seen whether the stay will be applied only to decisions concerning inventive step, or whether Examining and Opposition Divisions will interpret the notice as meaning cases where the plausibility of a technical effect that is a feature of a claim and is thus considered under sufficiency can also be stayed.

We will keep you updated on the progress of this case and will report on future developments as they arise.

Author:
Khalil Davis

G 1/21
Oral proceedings by video conference permitted but suboptimal

Related articles

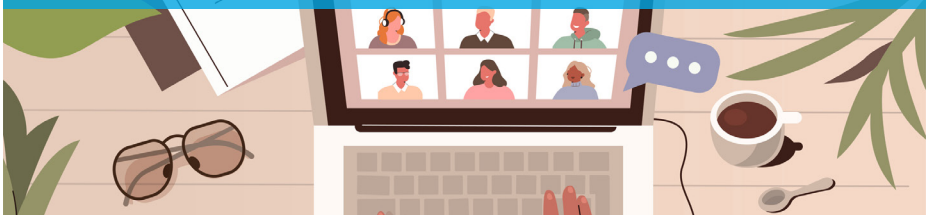
Read more about the background to this case and the order issued in July 2021 in our update of 16 July 2021. https://dycip.com/g121-decision

Read about clarity of the scope of the term "impairing" in the order in our update of 20 October 2021. http://dycip.com/t1197-18

The written decision confirming the order of the Enlarged Board of Appeal in G1/21 and setting out the reasoning behind it has now been issued. Notably, it states that in-person hearings should be the default option for Boards of Appeal and video conferencing is suboptimal format compared to in-person oral proceedings. The Enlarged Board of Appeal confirms that Boards of Appeal have the discretion to deviate from a request for in-person oral proceedings.

The Enlarged Board of Appeal chose not to address the issue in examination or opposition proceedings.

Boards of Appeal have the discretion to deviate from requests for in-person oral proceedings



Video conferencing is a form of oral proceedings under Article 116 EPC

The Enlarged Board of Appeal noted that Article 116 EPC is not primarily concerned with what constitutes oral proceedings but rather addresses the question of when oral proceedings are to take place. The Enlarged Board of Appeal considered that those involved in the legislative process leading to the EPC 1973 had in-person oral proceedings in mind but it cannot be concluded that oral proceedings should be limited to the specific form that was known at the time the Convention was drawn up. The Enlarged Board of Appeal stated that it is improbable that the legislator wished to rule out future formats for oral proceedings which might be made possible by technological progress. Hence, they concluded that oral proceedings in the format of video conferencing are within the meaning of Article 116 EPC. The Enlarged Board of Appeal also noted that no party is obliged to appear in a particular geographical place.

Video conferencing is suboptimal compared to in-person oral proceedings

The Enlarged Board of Appeal stated that video conferencing ensures that the essential features of oral proceedings occur - namely: the opportunity for parties to present their case orally, to have an interactive exchange of arguments and, consequently, the possibility to respond to inquiries and act according to any procedural development.

The Enlarged Board of Appeal acknowledged that video technology has improved in recent times, but considered that it cannot be said to provide the level of communication which is possible when all participant are physically present in the same room. They went on to state that even if video conferencing has shortcomings it provides parties with an opportunity to present their case and, in combination with written proceedings, is sufficient to comply with the principles of fairness of proceedings and the right to be heard.

The Enlarged Board of Appeal dismissed arguments that it is not possible to read body language by stating that visibility of a person depended on factors such as, in the in-person format, the set-up of a courtroom or the distance from members of the board or, in videoconferences, the quality of the cameras, screens and transmission.

It concluded that videoconferencing is suboptimal as a format for oral proceedings but not to such a degree that a party's right to be heard or the right to fair proceedings is seriously impaired.

The Enlarged Board of Appeal stated that in-person oral proceedings are, for now, the optimum (or "gold standard") format.

In-person hearings are the default option

The Enlarged Board of Appeal stated that in-person hearings are the default option and that parties should only be denied this option for good reasons.

It pointed out that if video conferencing is not suitable for a particular case then oral proceedings will need to be held in-person. However, the Enlarged Board of Appeal did not elaborate on what those reasons are.

The Enlarged Board of Appeal also stated that there may be circumstances specific to the case which justify not holding in-person oral proceedings and these circumstances should relate to limitations and impairments affecting the parties' ability to attend in-person oral proceedings at the EPO. In the case of a pandemic, these circumstances could be general travel restrictions, disruptions to travel possibilities, quarantine obligations, access restrictions at the EPO premises and other health-related measures aimed at preventing the spread of the disease. Reasons such as availability of rooms, interpreters or efficiency gains should not be considered.

The Enlarged Board of Appeal confirmed that the Board of Appeal must have the discretion to deviate from the preference of a party to hold in-person oral proceedings.

Post-pandemics, the wording of the decision seems to make it less likely that video conferencing (using current technology) will be the default option for oral proceedings.

Author:
Stephanie Wroe

And finally...

D Young & Co ebook download

EPO Board of Appeal Decisions
Third edition ebook

The third edition of our book of decisions from the European Patent Office (EPO) Boards of Appeal is now available as an ebook download.

The selected Board of Appeal decisions have been chosen on the basis of many years of experience in arguing cases before the EPO. In general, they represent some of the most useful and frequently cited decisions used by D Young & Co's patent group during both our defence of and opposition to European patents.

In this third edition we have included a number of additional cases and an updated section on the Rules of Procedure of the Boards of Appeal of the European Patent Office. We have also included a new section on oral proceedings being held by video conference (ViCo).

Contributors

The book was written and co-edited by members of our biotechnology, chemistry and pharmaceuticals patent group - Charles Harding, Antony Latham, Matthew Gallon and Rachel Bateman.

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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

Contributors

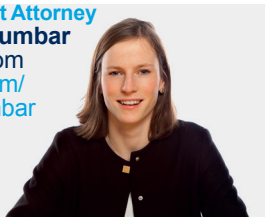
Partner, Patent Attorney
Editor
Neil Nachshen
njn@dyoung.com
www.dyoung.com/neilnachshen

Partner, Patent Attorney
Rachel Bateman
reb@dyoung.com
www.dyoung.com/rachelbateman

Technical Assistant
Khalil Davis
kxd@dyoung.com
www.dyoung.com/khalildavis

Partner, Patent Attorney
Doug Ealey
dre@dyoung.com
www.dyoung.com/dougealey

Associate, Patent Attorney
Alice Stuart-Grumbar
asg@dyoung.com
www.dyoung.com/alicestuart-grumbar



Patent Attorney
Nathaniel Wand
now@dyoung.com
www.dyoung.com/nathanielwand

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