



Oral proceedings at the EPO

Background

Oral proceedings at the EPO are a face-to-face meeting to try to resolve outstanding difficulties. They can be before the examining division during the prosecution stage of a patent application; before the opposition division during an opposition; or an appeal from either the examining or opposition divisions.

There is usually a three-man panel, with the chairman of the panel having absolute control over the proceedings.

The tone of the proceedings is semi-formal. There are certain moments which are very formal, and other moments which are quite informal. It can be helpful to have a technical expert speak, but they will need to be authorised beforehand.

It is usually desirable to travel to the EPO at least the day before the oral proceedings in case there are any travel difficulties. It is also usually desirable to have some time the day before the oral proceedings preparing.

Preparation

It is very important to prepare thoroughly for the oral proceedings. In particular, if there are any fall-back positions to which the applicant may be prepared to retreat, these should be clearly identified between the applicant and the patent attorney at the very least. Moreover, it is also usually best to submit them as auxiliary requests, well before the Hearing, so that the EPO have time to consider them. The EPO have been known to refuse late-filed auxiliary requests asking for a fall-back position to be considered (in certain circumstances).

Guarding against surprises

The outcome of oral proceedings can be unpredictable. The result is usually announced there and then on the day. If the result is adverse and the patent application is refused by the examining division, the refusal can be appealed if required. Alternatively, a divisional patent application can be filed during the period in which appeal is possible, even if no appeal is filed.

Auxiliary requests

The EPO will only decide a black and white answer on the claims before it - are they patentable or not?

They might, if they are feeling helpful, suggest changes to the claims which the applicant could voluntarily decide to incorporate there and then on the day, at which point the EPO will consider the amended claims and give a "yes" or "no" answer. If any single claim in the application is not allowable, then the whole application is thrown out - the same applies to any other ground of objection - it has to be allowable as it stands, or it is refused. For this reason if there is uncertainty as to what the EPO are thinking, it can be necessary to have quite a few auxiliary requests. It is not unknown to have seven or eight auxiliary requests in addition to the main request.

The EPO should not go on to consider the auxiliary requests until they have disposed with the main request and, if the main request is allowed, then the auxiliary requests become moot. On the other hand, the examiners are only human and if they can see a compromise position some way down the auxiliary requests there may be less enthusiasm for them to make their mind up on a difficult issue for a broader claim. Each attorney will have their own views on this subject. However, an important point to consider during examining or opposition division proceedings is that any amendments and arguments that are not put forward during the proceedings will not necessarily be admitted on appeal. All foreseeable potential amendments and arguments should therefore be submitted at first instance, even those that are less preferable, because there may be no further opportunity to submit them on appeal.

Please contact your usual Barker Brettell attorney for further information.

Scope of instructions for attorney attending

It is important for the European patent attorney to know what they can agree to, and what they cannot.

Does the attorney have the authority to do whatever they think best on the day if there are surprises, or must they stand by a predetermined position?

What flexibility and freedom to accommodate the EPO do they have?

Contingency instructions need to be given.

