

FEMIFI

Fédération Européenne des Mandataires
de l'Industrie en Propriété Intellectuelle

Europäischer Verband der
Industrie-Patentanwälte

European Federation of Intellectual
Property Agents in Industry

Established in 1971

FEMIFI c/o Siemens AG, CT IP, Otto-Hahn-Ring 6, 81739 München

Registry of the Enlarged Board of Appeal
Attention of Mr Nicolas Michaleczek

Case: G 1/21

(EBAamicuscuriae@epo.org)

April 23, 2021

Written statement by third party according to Art. 10(1) RPEBA (Rules of Procedure of the Enlarged Board of Appeal) in case G1/21

In the interlocutory decision T 1807/15 of 12 March 2021 the Technical Board of Appeal 3.5.02 referred to the Enlarged Board of Appeal for decision pursuant to Art. 112(1)(a) EPC the following question:

Is the conduct of oral proceedings in the form of a videoconference compatible with the right to oral proceedings as enshrined in Article 116(1) EPC if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference?

FEMIFI as the European Federation of Intellectual Property Agents in Industry representing IP member organizations all over Europe, would like to deliver the following comments and thoughts:

FEMIFI is of the belief that videoconferencing (VICO) is NOT compatible with the right to oral proceedings. In the following, a number of reasons for our position is spelled out, both based in user surveys and vast EBoA jurisprudence.

Special and careful attention has to be drawn to the fact that the Enlarged Board of Appeal (EBoA) might come to a decision in a composition of members where some members were also involved in the setup of the new Art. 15a RPBA (Rules of Procedure of the Boards of Appeal). Any appearance of a biased decision due to a former contribution and support of the new Art. 15a RPBA of a member of the EBoA might harm the whole European Patent system. Especially there might be a negative influence on the German Federal Constitutional Court in the pending cases for insufficient legal protection at the European Patent Office against decisions of the Boards of Appeal and about the independence of the Boards of Appeal.

The legal discussions of the interlocutory decision T1807/15 construes absolutely convincing the term "oral proceedings" in Art. 116 EPC. The in-depth analysis of the case law of the Boards of Appeal, the literal and systematic interpretation, the review of the

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Travaux préparatoires, the teleological interpretation and the analysis of subsequent agreement or practice all come to the unambiguous conclusion that **conducting oral proceedings in the form of a videoconference without the consent of all parties is NOT compatible with the right to oral proceedings as enshrined in Art. 116(1) EPC.**

We strongly object to the view that there might be an equivalence between videoconference and oral proceedings in the traditional format. A perfect example for that would be a hybrid format for oral proceedings, for example one party via videoconference and another party via the traditional format before a Board of Appeal. Undoubtedly, everyone would assume that the party participating “only” via videoconference is disadvantaged compared to the other party. The decision of the Administrative Council (for the BoA through Art. 15a RPBA) or of the President of the EPO (for grant or opposition procedure) to “force” both parties to a videoconference therefore puts them at the same disadvantage. This is in clear contrast to the *legislator's goals*, one of which is undoubtedly *high-quality and efficient proceedings under the EPC* (T1807/15: 5.11.2).

In further support of this position, please find attached to the written statement the

*Legal Opinion of A. Speer (Ass. jur.) / R. Schregle (Ass. jur.),
Corporate and Intellectual Property Law, TUM School of Management
(Chair: Prof. Dr. jur. Christoph Ann, LL.M. (Duke Univ.)), January 29,
2021*

concerning the legality of default videoconferences for oral proceedings.

The legal opinion confirms that videoconferences cannot be considered just another type to be heard but are inferior with respect to oral proceedings in personam (p. 9, par. 1: last sentence). As an intermediate result, the legal opinion finds for the oral proceedings in the format of videoconferences an infringement of the Right to be heard (Art. 113(1) EPC) which might be justified.

During the pandemic COVID-19 situation, especially for oral proceedings before the Boards of Appeal, inferior videoconferences could be justified. After this crisis is over, and we return to “normal” mode, there are severe doubts that default videoconferences without the consent of all parties are lawful with respect to the Right to be heard and with respect to the Right to oral proceedings (Art. 116(1) EPC).

Oral proceedings in the form of videoconferences can be a very suitable option in many cases. This might be, for example, in cases which are not very complex in the subject matter or in cases where a party has a minor importance in a case due to small revenues with the underlying product or service due to the loss of interest in the technology or of the economic interest. Whatever reason, only the involved party can judge and balance its interests. Neither the Boards of Appeal nor the European Patent Office have expertise or insight into this internal information of the parties

In general, the principle of party disposition is well established as part of the Right to be heard (conf. to Case Law of the Boards of Appeal, III.B.3). As already discussed in the interlocutory decision T1807/15, the principle of party disposition also gives every party the choice not to show up at oral proceedings and the choice how to best handle its case.

Summarizing, the parties should have the choice between oral proceedings in the form of a videoconference or for oral proceedings in person. Only the parties are in a position to assess the importance of the case and are solely in the position to decide whether for a specific case taking the risk of oral proceedings held in the form of a videoconference which might cause in an inferior decision.

Precautionary, in the case the Enlarged Board of Appeal would answer the referred question with YES, we would like to point out for the grant or opposition procedure: According to T1142/12, the question of the venue of oral proceedings is a matter of organizational nature which belongs to the management of the Office pursuant to Art. 10(2) EPC. It is doubtful that oral proceedings in the form of a videoconference instead of on the premises of the EPO is just another venue, as the characteristics and the quality of the oral proceedings are influenced directly. Therefore, the decision of a mandatory videoconference without the consent of all parties without the option on the classical procedure is out of the competence of the President and may not be introduced by a Decision of the President.

In the epi survey on Oral Proceedings by Videoconference (epi Information 01/2021, p. 40ff) 70.16% of the European Patent attorneys agreed with the question "*Council considers that, after the Covid-19 pandemic is over, oral proceedings should as a rule be held face-to-face but any party should be free to attend oral proceedings by videoconference, even if the other parties are attending in person.*" BusinessEurope, speaking for all-sized enterprises in 35 European countries whose national business federations are direct members, also unanimously considers that oral proceedings by VICO are acceptable where all parties agree (<https://www.businesseurope.eu/publications/epo-consultation-amendment-rules-procedure-boards-appeal-regarding-oral-proceedings>). The majority of the users of the European Patent system wants to adhere to the practice of oral proceedings held face-to-face after the pandemic situation.

Summing up the above said:

- Mandatory videoconference should be limited to the time of the COVID-19 pandemic situation.
- In ex parte proceedings, the applicant has the control over the proceedings. This encompasses also the choice whether attending oral proceedings in person or via videoconference. This choice should remain in the exclusive discretion of the applicant. She or he is the only person that can judge whether the effort and costs to hold a presence meeting is justified or not.
- In inter partes proceedings, in view of the quality of the decision, it is even more important that face-to-face oral proceedings should remain available to the parties as a default. Whether or not the parties prefer to hold oral proceedings by videoconference should remain their exclusive decision. In the same way as for ex parte proceedings, only the parties are able to judge whether or not the effort and costs to hold presence meeting is justified.

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- There is a conflict between a timely decision vs. a high quality of the decision. Under this conflict, FEMIFI clearly positions itself as preferring a high-quality decision.
- The referred question to the Enlarged Board of Appeal should be answered with NO.

As is hopefully clear, strong arguments exist for VICO only taking place when both parties decide that is the best way.

FEMIFI is happy to elaborate on our arguments and recommendations if this is wished.



Beat Weibel