CHARTERED INSTITUTE OF PATENT ATTORNEYS (CIPA)

Enlarged Board of Appeal
Referral G1/21

The Chartered Institute of Patent Attorneys (CIPA) is the professional and examining body for patent attorneys in the UK, representing virtually all the 2,500 registered patent attorneys in the UK, whether in industry or in private practice, and most UK-based European Patent Attorneys. Total membership is over 4,000 and includes judges, barristers, trainee patent attorneys and other professionals with an interest in intellectual property. CIPA represents the views of the profession to policy makers at national, European and international level, with representatives sitting on a range of influential policy bodies and working groups in the UK and overseas.

Executive Summary

CIPA has previously stated its support for videoconference oral proceedings, subject only to the underlying systems being fit for purpose.

We welcome the speed at which the Enlarged Board has convened oral proceedings in this reference and urge similar expedience in issuing a decision to minimise the period of uncertainty.

We are aware that concerns have been raised over an appearance of partiality of the Enlarged Board as constituted. CIPA strongly believes that the impartiality of the Enlarged Board is essential for the rule of law.

We note the detailed construction by the referring Board of the term “oral proceedings” in Article 116 EPC (point 5 of the referral). We agree with the Board’s recognition at 4.1.3 that “running videoconferences using a technology that generally functions properly is compatible with both the right to be heard and the right to a fair trial”. Neither the wording of Article 116 nor its intent would appear to preclude videoconferencing.

The referring Board identifies at 3.7 that there is a correlation between the appropriateness of videoconferencing, the right to be heard under Article 113 EPC and the issue of party consent. CIPA does not see a general requirement of party consent to the *form* of proceedings as long as it is compatible with both the right to be heard and the right to a fair trial. However, if the Enlarged Board decides that consent to the form of proceedings is relevant, or if a party specifically requests in-person proceedings, then we urge that *reasons* be required to indicate why videoconferencing in any particular case would *not* meet the conditions of the right to be heard or the right to a fair trial.

Discussion

1. At 5.1, the referring Board discusses the previous case law concerning oral proceedings by videoconference. However, the Board had presumably not seen the recently-published decision T 2320/16.

2. We agree with T 2320/16 that, while videoconferencing and in-person proceedings are different, they are both consistent with Article 116 EPC. For example, point 1.5.3:-

   Hence, while accepting that there are differences in the transmission and perception of non-verbal communication signals, the board is not convinced by the argument that said differences necessarily render communication inferior or degraded, let alone degraded to an unacceptable level in oral proceedings by videoconference compared to in-person oral proceedings.

   Therefore, the presence of differences between oral proceedings by videoconference and in-person oral proceedings as such is not a valid ground for considering oral proceedings by videoconference to be inconsistent with the right to oral proceedings pursuant to Article 116 EPC.

3. A logical corollary of the differences is that forced "mixed" or "hybrid" oral proceedings (where one party attends in person while another attends by videoconference) should not be permitted. All parties should be heard on the same footing unless there is specific agreement to mixed oral proceedings. In particular, mixed proceedings should not be forced if a party merely requests videoconferencing because of travel difficulties caused by the current pandemic.

4. From points 5.4 to 5.7, the referring decision argues that the <u>literal</u> meaning of the term "oral proceedings" is limited to in-person proceedings. Point 5.4.1 suggests:-

   To ascertain the authentic meaning of this term, it needs to be borne in mind that when the EPC was drawn up there were no suitable technical options for adequately replacing traditional oral proceedings. Therefore, in the absence of any technical alternatives, oral proceedings inevitably came to mean in-person proceedings...

   This leads to the statement at 5.7 that the parties have the <u>right</u> to be heard at in-person oral proceedings and to the conclusion at 5.9.3 that there is no need for further interpretation.

   With respect, we disagree. The literal meaning of "oral" (mündlich, orale) relates to the ability to make a spoken presentation by mouth. Even if appearing in person was at one time the only or most suitable technical option, there is nothing in the EPC to set this in stone. As T 2320/16 puts it (point 1.5.2):-

   Article 116 EPC states that "[o]ral proceedings shall take place ...". It does not define in any way the exact form of those proceedings, other than the proceedings being oral in nature. In particular, it does not explicitly exclude oral proceedings by videoconference.

   There have been great improvements in videoconference technology since the EPC was negotiated. There is every reason to believe that this progress will further continue in the future. Even if it were suggested that there might be some issues today which still could not be accommodated (such as a demonstration of the invention), it would be wrong to issue a decision which imposes a restrictive interpretation of "oral", based on the historic use of in-person oral proceedings, for the long term.

5. At 5.9.3, second paragraph, the referring decision notes the appellant's argument that in Germany the parties are *entitled* to appear in person in a courtroom. It might be implied that this is true generally in the EPC member states.

   Again with respect, this is not so. English courts, for example, regularly direct that hearings should be conducted by videoconference. This has been true for some time, not just during the current pandemic. It is entirely within the discretion of the judges – they can decide whether a hearing will be remote or in person. While they will normally take account of arguments raised by the parties for or against videoconferences, English judges are free to decide as they see fit.

   Thus, the cited German practice is not a generally recognised principle in the Contracting States under Article 125 EPC.

   We note that this English practice is compatible with the current practice at the EPO, both in the Boards of Appeal and at first instance. We urge that it should continue, both during and after the pandemic. Indeed, during the pandemic, videoconferences are the only practical option.

   However, if the Enlarged Board decides that consent to the form of proceedings is relevant, or if a party specifically requests in-person proceedings, then we urge that ***reasons*** be required, to indicate why videoconferencing in any particular case would ***not*** meet the conditions of the right to be heard or the right to a fair trial.

   Otherwise we see a risk of procedural abuse or inefficiency. There could be a drift to in-person proceedings requested to cause delay or for other tactical reasons. Or there may be pressure for imposed, imbalanced mixed proceedings.

6. We reiterate our support for videoconference oral proceedings, subject only to the underlying systems being fit for purpose. We agree that the technology "generally functions properly" (referring decision, 4.1.3) and are grateful that the Boards and opposition/examining divisions are sensitive to any technical difficulties which may occasionally arise. We are keen to embrace technology which will reduce the carbon footprint of the patent profession and the EPO.