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Institute of Professional Representatives before the European Patent Office
Institut des mandataires agréés près l'Office européen des brevets

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Ausschuss für Europäische Patentpraxis
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Commission pour la Pratique du Brevet Européen

26th November, 2020

epi COMMENTS ON PROPOSED ARTICLE 15a RoPBA

To: Derk-Jan De Groot – Chairman of the BOAC and
Carl Josefsson – President of the Boards of Appeal

epi is pleased to provide observations on the User Consultation regarding a proposed new Article 15a Rules of Procedure of the Boards of Appeal (RoPBA) launched by the Board of Appeal Committee (BOAC).

Introduction

epi is the organisation set up according to Articles 134 and 134a EPC and representing all persons entered on the List of Professional Representatives before the EPO. At present, there are over 12,000 members of **epi**. The members work in both private practice and industrial practice and come from all 38 member states of the EPC.

Face-to-Face Oral Proceedings

The launch of the consultation coincided with a meeting of **epi**'s ruling Council and gave rise to discussion of the matter of oral proceedings in general. As a result of the discussion, Council demanded that a Resolution be presented to Council. The wording of the Resolution is as follows:

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.

This Resolution was passed by a large majority.

It can thus be seen that the Council of **epi** considers that, after the pandemic is over, the default for oral proceedings should be face-to-face. This is considered to be required especially for the Boards of Appeal as the Boards are a court of final instance and so operate in a judicial manner and need to be perceived to be acting in a judicial manner. The perception of acting in a judicial manner is not present for videoconference oral proceedings. Moreover, oral proceedings before a Board may be

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the final instance for the case and so all parties should be allowed to present their arguments in whatever way they deem appropriate.

The main driver for this proposed new Article seems to be to deal with the backlog of appeal proceedings caused by the pandemic. **epi** understands the need for emergency measures to deal with the pandemic but considers that such a radical change in law should not automatically be made permanent. The Boards, as a diligent judicial body, should tread very carefully in making new, permanent legislation without much more extensive consultation¹. As can be seen from the resolution above, **epi**'s Council considers that the permanent introduction of videoconference should not be adopted and so it is clear that a large number of users are against making Article 15a permanent.

It is indicated in the Consultation that oral proceedings by videoconference are equivalent to oral proceedings in person. However, this has not been proved but is merely an assertion. It is not clear that holding oral proceedings by videoconference fully complies with Article 113 EPC. It is clear from T492/18 that not all Boards consider that this is the case. That Board in point 2.3 of the decision indicated that it is necessary for oral proceedings held by videoconference to be perceived as equivalent to usual oral proceedings. It is certainly the case that many users perceive oral proceedings by videoconference not to be equivalent to "usual" oral proceedings.

epi Point 1

In light of the above, the first point **epi** has regarding the Consultation is that it should be made clear that Article 15a will only remain in force for the duration of the pandemic and should thereafter be removed from the RoPBA. It should be part of the decision bringing Article 15a into force that Article 15a expires one year from coming into force and that there will be a review of the Article before its expiry.

epi has many more points about the apparent move by the BOAC to making oral proceedings by videoconference the norm. These are not set out in detail here as they are not relevant to the situation during the pandemic. However, if the BOAC were to make Article 15a a permanent part of the RoPBA, contrary to **epi**'s Point 1 above, **epi** will present all these points for consideration by the BOAC.

Article 15a(1)

epi understands that, in the present time, with the pandemic still affecting all EPC member states, it is necessary to take measures to ensure that the Boards can operate effectively and so would welcome some clarity from the Boards as to the circumstances in which oral proceedings can proceed. However, **epi** considers that the proposed Article 15a(1) does not provide this clarity.

¹ Il est vrai que, par une bizarrerie qui vient plutôt de la nature que de l'esprit des hommes, il est quelquefois nécessaire de changer certaines lois. Mais le cas est rare; et lorsqu'il arrive, il n'y faut toucher que d'une main tremblante: on y doit observer tant de solennités et apporter tant de précautions que le peuple en conclue naturellement que les lois sont bien saintes, puisqu'il faut tant de formalités pour les abroger (Montesquieu – Lettres persanes)

(It is true that, through a quirk which comes more from nature than from the minds of men, it is sometimes necessary to change certain laws. But the case is rare; and when it arrives, it should only be touched with a trembling hand: so many solemnities should be observed and so many precautions taken that the people naturally conclude that the laws are very holy, since so many formalities are required to repeal them.)

In particular, Article 15a(1) is clearly discretionary, as it starts with “The Board may decide ...”. However, the Article provides no details of what factors will influence the Board to decide to hold oral proceedings by videoconference. It is not sufficient to put the guidance in accompanying documents as these have no legal force. In *inter partes* proceedings, this may lead to a large amount of argument from the parties as to whether the Board has exercised its discretion properly.

epi Point 2

epi therefore considers that Article 15a(1) should make clear the factors the Board will take into account when deciding to exercise its discretion.

Article 15a(2) and 15a(3)

In **epi**’s view, the lack of clarity in Article 15a(1) is compounded by the wording of paragraphs (2) and (3). The use of “may” three times in these two paragraphs indicates that everything is at the discretion of individual Chairs. Again, there is no clarity as to what factors will affect the Chair’s exercise of his or her discretion. Again, having nothing in Article 15a(2) and (3) which explains these factors may well lead to much argument between the parties in *inter partes* cases.

There are particular instances where, during the pandemic, there could be a lot of argument. For instance, what would be the situation if a representative employed in house works in a country where there are no travel restrictions but works for a company which has forbidden all travel? Will that representative be required to attend in person? What would be the situation for a representative who is told that he or she must attend oral proceedings by videoconference but lives in an area where internet access is unreliable and so the representative requests attendance in person? There are many other situations which can arise during the pandemic and could give rise to much argument about whether the Chair has exercised his or her discretion appropriately to ensure that the requirements of Article 113 EPC are met.

epi Point 3

epi therefore considers that Articles 15a(2) and (3) should make clear the factors the Chair will take into account when deciding to exercise his or her discretion.

Hybrid Oral Proceedings

The wording of Article 15a(2) and (3) appears to allow what have been called “hybrid” oral proceedings, with some people present in person and some attending by videoconference. **epi** considers that, in principle, hybrid oral proceedings should be possible. However, it can be seen that hybrid oral proceedings could become unwieldy, especially if there are multiple parties, multiple languages and not all or none of the members of the Board are present in person. It will be very difficult for the Chair to keep control and to be fair and be seen to be fair to all parties. This difficulty will increase if there are members of the public in attendance both in person and by videoconference. It will also put a strain on the required IT systems used for the hybrid oral proceedings.

epi Point 4

epi therefore considers that Article 15a(2) should make clear that, during the pandemic, hybrid oral proceedings should only take place exceptionally. After the pandemic, hybrid oral proceedings should only take place where all the parties agree or the party requesting attendance by videoconference has serious reasons not to attend in person (which would require a definition of what serious reasons might be).

Compulsory Attendance by Videoconference

According to proposed Article 15a(2), a Chair may order a person to attend by videoconference. This seems to be a draconian power. Why should a person who wishes to attend in person be forced against his or her wishes to attend only by videoconference? This would seem to be contrary to Article 113 EPC and could give rise to an increase in the number of petitions to the Enlarged Board. If a person wishes to attend in person but is prevented from doing so for serious reasons, such as quarantine or travel restrictions, then this should be treated in the same way as if a person becomes ill shortly before an oral proceedings, in which case the oral proceedings are usually postponed.

epi does understand that there is the possibility of a representative trying to postpone oral proceedings if an adverse outcome is expected. In such circumstances, it may be appropriate for a Chair to order a representative to attend by videoconference. However, this should only occur in exceptional circumstances and only for the duration of the pandemic.

epi Point 5

epi therefore considers that Article 15a(2) should make it clear that a Chair can only order a representative to attend by videoconference in exceptional circumstances and there should be guidance as to what constitutes such exceptional circumstances.

IT Systems

The above point also gives rise to a point which is not addressed in the Consultation, which is the IT system used. There are clearly deficiencies in the systems presently used by the Boards and so the use of videoconference oral proceedings suffers from these deficiencies. Both the Boards and the parties to the proceedings, where everyone is present in person, benefit from being able to see all those present clearly and to take notice of the "body language" of the Board members and the parties. This is not readily possible with the present IT systems used by the Boards. It is possible for attendees to be almost invisible. There would be greater acceptance of the need, during the pandemic, for videoconference oral proceedings if all representatives and all the members of the Board were required to be visible in reasonable close up. A remote view of a group of people (a party or the Board) from a camera a long way away from the group does not satisfy this requirement.

There are problems for some parties in even accessing the IT system used by the Board. Many companies have forbidden the use of certain videoconferencing systems and so representatives from such companies may not be able readily to access the EPO's system.

There are other ways in which the system used by the Boards are deficient and these have been brought to the attention of the EPO through other channels and so are not repeated here. However, if the BOAC would like to have more details, **epi** would be pleased to supply them.

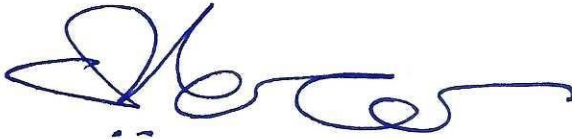
epi Point 5

epi therefore considers that the Boards should aim to provide an improved videoconferencing system so that any oral proceedings which take place by videoconferencing are as close to an in person oral proceedings as possible.

epi looks forward to discussing the proposed Article 15a and the points made above at the meeting with the BOAC and the President of the Boards on 27th November, 2020.

With kind regards,

Yours sincerely,

A handwritten signature in blue ink, consisting of a stylized 'C' followed by a series of loops and a long horizontal stroke.

Chris P Mercer

Chair – European Patent Practice Committee