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THE EUROPEAN PATENT OFFICE LISTENS TO USERS WHEN IT COMES TO THE RIGHT TO BE HEARD

In a decision of September 2020, a Board of Appeal (BoA) of the European Patent Office (EPO) found that the Opposition Division (OD) of the EPO had acted in violation of the parties' right to be heard, and decided to remedy that violation.

The facts are as follows.

In opposition proceedings, the patent owner had filed a number of auxiliary claim requests by the deadline set by the OD prior to the hearing concluding the opposition procedure. Those auxiliary claim requests had been drafted to address the preliminary opinion of the OD as conveyed to the parties with the summons to attend the hearing.

During the hearing itself, the OD changed its mind from the position it had preliminarily taken when summoning the parties to the hearing, but when the patent owner tried to file four new claim requests - during the hearing - in reaction to that change of mind by the OD, the OD refused to admit into the proceedings more than one of those claim requests, drawing on their discretionary power to do so. Thus, the OD admitted into the proceedings only the first auxiliary claim request presented during the hearing, but not the second, third or fourth auxiliary claim requests.

In the appeal, the BoA found that the OD had not permitted a discussion on the admissibility on the merits of all four auxiliary claim requests presented by the patent owner during the hearing, limiting that discussion to only the right to file any further claim requests during the hearing, regardless of the content of the specific claim requests that the patent owner had submitted at that stage. In fact, the BoA found that “[t]here was however no specific argumentation either from the [OD] or from the opponents as to why auxiliary requests 2-4 should not be admitted, such as a reference to their *prima facie* relevance, to their contents or at least an indication of why the filing of four requests would be considered to be excessive in view of the circumstances.”

The BoA therefore concluded, also on the basis of the statements contained in the minutes of the hearing before the OD, that the patent owner's right to be heard with respect to the admissibility of auxiliary claim requests 2 to 4 as presented during that hearing had been violated. The BoA stated that “while an [OD] has the discretion not to admit late-filed requests, there is no discretion, regardless of how late a request is filed, to deny the patentee's right to discuss the admittance of a request”.

The BoA therefore remitted the case to the OD for further prosecution, given that no discussion on the merits of auxiliary claim requests 2-4 had taken place before the OD and thus the BoA was not in the position (in its role as a 2nd instance body whose task is to review 1st instance decisions) to decide on the merits of those claim requests without the OD having first decided on that point. The BoA also decided to reimburse the appeal fee.

This is a very important and reasonable decision, and sets a positive precedent for proceedings before the EPO. This is especially true considering that, as recently as January 2020, new rules of procedure came into force that limit the power of BoAs to remit a case to the 1st instance only in very specific and exceptional circumstances. Indeed, in this case the BoA found that that limited power should not be interpreted in a way that unduly restricts it, as this undue restriction would be contrary to the spirit of the European Patent Convention.