

EPO Enlarged Board of Appeal
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Via email only
To the attention of Mr. Nicolas Michaleczek
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KBS Ref: JS
Your Ref: G1/21

Amicus Curiae Brief G1/21
Written Statement under Article 10 (1) RoP EBoA
by Jürgen Schmidtchen LL.M.

Dear Ladies and Gentlemen, dear Mr. Michaleczek,

Attached please find a Written Statement by Jürgen Schmidtchen LL.M.
under Article 10 (1) RoP EBoA regarding case G1/21.

Sincerely,

This document has been generated electronically.
Jürgen Schmidtchen LL.M.
Professional Representative

27 April 2021

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Written Statement under Article 10 (1) RoP EBoA in case G1/21 by Jürgen Schmidtchen

1. Referred Question and Answer

The question referred to the Enlarged Board of Appeal by T1807/15 is:

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?

The phrasing of the question as such and the deduction of the meaning of the relevant wording of Article 116 EPC in T1807/15 in points 3 to 5.11.5 are nearly perfect such that I agree and do not repeat the same.

Certain arguments pro and contra may be added and numerous are discussed in other Amicus briefs filed so far. However, I cannot recognize that the intrinsic logic of the above deduction can be overcome. In my view, based on the above cited deduction, the only possible answer to the question is NO.

2. Additional considerations regarding practicability and the pandemic

a) General Introductory Remarks

One additional question may be, why the whole issue had to go to the Enlarged Board at all, if the answer is clear as argued above.

Obviously, there are strong tendencies in the EPO and the Boards of Appeal (see T2320/16 and the amended RoP BoA) to consider oral proceedings by videoconference as complying with Art. 116 EPC, even if not all parties agreed, for a) practical reasons and for b) reasons of relieving problems due to the COVID 19 pandemic (or similar situations).

First of all, in this context, it is necessary in my view to point out that the right to oral proceedings is part of the right to be heard, and thus part of a fundamental right, which cannot be subject to considerations of practicability only. Fundamental rights may be impractical sometimes, but they must remain to be fundamental and cannot be negotiable or redefinable based on practicability. So the above “a) practical reasons” may be understandable but cannot be a basis for deciding the question.

On the other hand, in my view, regarding the above “b) reasons of relieving problems due to the COVID 19 pandemic”, it is like with all constitutional or otherwise fundamental rights.

Lockdowns and similar restrictions of fundamental rights are possible, but only, and really only only only at times of emergency like war or pandemic.

In emergency, fundamental rights can be overpowered without rewriting the corresponding constitution/law. We can all see it in the contracting states due to the COVID 19 pandemic.

But not otherwise!

The whole approach that oral proceedings by videoconference comply with the law, if the party/parties does/do not agree, is not correct (see above 1.).

If a party wishes to attend by videoconference, that is possible anyway as briefly discussed further below, because the party can waive its right to in-person face-to-face oral proceedings.

An issue worth an obiter dictum may be the arrangement of oral proceedings by videoconference without consent of all parties in times of emergency.

b) T2320/16 is no suitable starting point for compulsory oral proceedings by Vico

In my personal view, the wording of the law in Article 116(1) EPC, which reads in English

Article 116 Oral proceedings

(1) Oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings. However, the European Patent Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

(2) Nevertheless, oral proceedings shall take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it intends to refuse the European patent application.

(3) Oral proceedings before the Receiving Section, the Examining Divisions and the Legal Division shall not be public.

(4) Oral proceedings, including delivery of the decision, shall be public, as regards the Boards of Appeal and the Enlarged Board of Appeal, after publication of the European patent application, and also before the Opposition Divisions, in so far as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

prohibits word twisting as it has been done in T 2320/16 in the reasons 1.5, especially in 1.5.2 (pasted below)

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.

Beside the fact that fundamental rights should never be subject to change by interpretation after decades of uniform understanding in case law and practice. The approach for overpowering or reshaping a fundamental right by playing with the words of the law is not a proper approach.

The starting point of such law reshaping is stating that the law allegedly does not define something or something is not excluded.

T 2320/16 uses exactly this starting point, stating that Art. 116 (1) EPC allegedly does not define the exact form of oral proceedings other than quote "being oral in nature", and then makes own definitions not based on the wording of the law.

In the board's view, a prerequisite of oral proceedings is that the parties can see the members of the board and vice versa. This distinguishes oral proceedings pursuant to Article 116 EPC from a telephone conference in which the board members and parties are not visible to each other. At the same time, it must be possible in real time for the board to interrupt or question the parties where necessary. This distinguishes oral proceedings from an exchange by letter, fax or E-mail, where an exchange of views in real time, i.e. essentially simultaneously, is not possible.

Really? Oral proceedings via telephone are oral but not oral enough to be oral proceedings in line with Art. 116 EPC, but Art. 116 EPC requires "visual" proceedings?

And the "visual" proceedings must allow interruption in real time, and all that comes from Art. 116 EPC as an original source although it allegedly does not define the exact form of oral proceedings?

Apart from the above constraints, the form in which the parties orally present their arguments - with or without physical presence - is not predetermined by Article 116 EPC (in agreement with T 1378/16, reasons, 1.3).

Apart from being oral but not too oral only and from being visual with real time interruptions, there are no constraints? If the "visual" requirement was really true, does it mean that a blind person cannot represent a person in oral proceedings?

And this is all written/ruled in Art. 116 EPC but not that the proceedings are in-person before the Division/Board?

T2320/16 makes a surgical extraction of single words like "oral" and examines their alleged meaning out of their context in Art. 116 EPC. For example, Art. 116 EPC literally requires that "Oral proceedings shall take place before the Receiving Section, the Examining Divisions and the Legal Division or before the Opposition Divisions". By virtue of the context, Art. 116 EPC also requires that "Oral proceedings shall take place [before] the Boards of Appeal and the Enlarged Board of Appeal". However, this context is not considered in T2320/16 at all.

This approach and line of argumentation in T2320/16 cannot be the proper way of overpowering and/or reshaping a fundamental right already for these reasons.

Art. 116 EPC originates from 1973 and needs to be understood in the context of the judicial traditions of the contracting states of the EPC. As already said, the deduction in T1807/15 is nearly perfect.

One contracting state is the Federal Republic of Germany and the „Mündlichkeitsgrundsatz“ (principle of oral form or speech form) is a fundamental principle of the German civil procedural law since the foundation of the Republic in 1949 and was before in large parts of Germany since the Napoleonic Code Civil of 1806 i.e. for more than 100 years.

What does it or did it mean? It essentially means that the parties argue/plead in person before the judge(s) different from the Prussian written court proceedings. A judge who cannot hear and/or speak cannot be a judge in such “oral“ proceedings. If we focussed on the ability to speak and hear only, "telephone“ would be OK!?? However, there is something else, namely “before“ the judge(s).

Of course, and I don't think that needs thorough discussion, in the understanding of 1920 or 1950 or 1973, "before the judge(s)", or in the wording of Art. 116 EPC "before the Receiving Section, the Examining Divisions, the Legal Division, before the Opposition Divisions, the Boards of Appeal, the Enlarged Board of Appeal," meant in-person face-to-face before the judge(s) or the members of the respective Divisions, Boards.

Of course, “tele“-visual-hearings are feasible in 1973 or in 2000 (latest amendment of the EPC) but the original wording and thus the original meaning was not changed.

Oral proceedings in the wording of Art. 116 EPC meant, were intended to mean and still mean in-person face-to-face proceedings at least in the German tradition.

It is so relatively simple. And the approach in T2320/16 cannot lead to something different in a credible way.

There is no question that the interaction between judge(s)/member(s) and party/parties is different in in-person face-to-face hearings and videoconference hearings. Maybe next year it is practical to establish virtual reality hearings. All can be done, but only by way of changing the law.

Many practitioners (including me) are convinced that oral proceedings by Vico will become an important if not the predominant way of holding oral proceedings, because applicants and representatives will select the same in many cases for practical reasons like balance of costs versus importance of the case, time saving, protection of the environment, etc.

These practical and economic benefits and the potential modernization of the operations are honest reasons to ask for a change of the practice. But they are no justification for redefining a fundamental right without changing the law. It is a huge difference whether applicants and representatives are forced to accept oral proceedings by Vico or whether they can select the same depending on their understanding of the requirements and needs of their cases, which will happen anyway.

If it is intended or necessary to change what Art. 116 EPC meant, was intended to mean and still means, the law needs to be changed with this intention and a clear amended wording that oral proceedings other than in-person face-to-face proceedings are covered by law and not only by deliberate choice of the party.

This is how legislation should work.

c) Oral proceedings by Vico possible with consent of party without changing the law

If a party wishes to attend by videoconference, that is possible, because the party can waive its right to in-person face-to-face oral proceedings.

It is another fundamental principle of civil procedures (not of criminal procedures) in Germany, that the parties can waive the right to an oral hearing. I am quite certain that is also true for many other contracting states.

The law (EPC) allows that one party of plural parties in inter-partes proceedings does not attend the oral proceedings without making the oral proceedings invalid. Accordingly, in-person face-to-face oral proceedings can be held in inter-partes proceedings, in which one party does not attend at all, because this non-attending party can waive its right to attend.

As a result, I do not see any reason why an intermediate waiver between not attending at all and attending in-person face-to-face such as attending by Vico in hybrid oral proceedings should/could violate the law (EPC).

As a consequence, if hybrid oral proceedings are possible with the consent of the party/parties attending by Vico, it is of course possible to hold oral proceedings as videoconference with the agreement of all parties.

c) Oral proceedings by Vico possible without consent of party in times of emergency?

The third and most difficult part of the considerations is overpowering the law (Art 116 EPC) in times of emergency.

This third part is not prevented by the proposed answer NO.

The following considerations may be a way to allow oral proceedings by Vico without consent of all parties during a pandemic.

States have specific rules in their constitutions or otherwise to establish emergency laws allowing to overrule fundamental law/rules.

The EPC has some rules regarding emergencies like Rule 134(5) EPC explicitly mentioning e.g. war, but the EPC did not foresee the necessity of oral proceedings in times of a world wide pandemic.

That can happen. Laws are not per se perfect. However, it is not a reason to redefine a fundamental right coded in the law for all times, because the law clearly defined the fundamental right as discussed before. The exception from the coded law must be limited to the case of emergency.

Unlike the judicial system in a contracting state, in which the legislator can set the rules for traveling or not traveling to and holding of oral proceedings in times of emergency, the EPO and the Boards of Appeal cannot set such rules. And even if they could theoretically set such rules, the 30+ contracting states may, for example, simply prohibit travel. In the present pan-

demic, Norway is a good example for setting prohibitive rules impacting the possibility to travel and thus to hold in-person face-to-face oral proceedings for many months if not years.

Therefore, the law (EPC) seems to lack coded law regarding such an emergency and the specific issue of oral proceedings potentially necessary despite the pandemic. This lack materialized during the present pandemic. Therefore, there may be room for applying emergency rules not coded in the law (EPC).

Therefore, but only in such very specific circumstances, in which

(1) not all parties agree to hold oral proceedings as a videoconference

AND

(2) the circumstances are so pressing that they require the application of uncoded emergency rules,

oral proceedings could be held as videoconference without consent of all parties.

Such pressing circumstances could be evaluated similar to circumstances where a party's right to be heard may be restricted in preliminary injunction proceedings. For example, if one party is cut off legal remedies against other legal proceedings, if the oral proceedings under Art. 116 EPC cannot be held, or if significant economic damages cannot be avoided in such a case.

I cannot give a general definition of such circumstances and I believe nobody can. Therefore, in my opinion, it needs to be decided case-by-case, but oral proceedings in an opposition with copending infringement litigation may be such a reason to apply emergency rules because the opponent/defendant is cut off legal remedies otherwise.

The Enlarged Board of Appeal could take the opportunity of the coincidence of G1/21 and the pandemic to not only answer the question with the, in my view, only possible answer NO, but to also provide an obiter dictum with the following ratio:

Under the specific circumstances of

(A) an emergency like a war or a pandemic, which makes the holding of in-person face-to-face oral proceedings basically impossible,

AND

(B) cases where one or more parties is/are cut off legal remedies (=cut-off parties) without holding oral proceedings,

such oral proceedings can be held as videoconferences on request of the cut-off parties without the consent of the other parties based on a case-by-case evaluation of the necessity.

[End of written statement]