

Amicus Curiae in matters of G 1/21

From

A. Schauinsland

aschauinsland@gmail.com

To the registry of the Enlarged Board of Appeal

EBAamicuscuriae@epo.org

Following decision T 1807/15 by Board 3.5.02 the following question has been referred to the Enlarged Board of Appeal:

“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 referral is pending under G 1/21.

In the following an amicus curiae brief is set up dealing with a plurality of topics relating to the referral under G 1/21.

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Executive Summary

Holding oral proceedings by ViCo without the consent of the parties and allowing the members of the boards to decide without sitting in Munich or Haar, lack any legal basis in the EPC as it stands.

Such a fundamental change of the procedure before the EPO can only be arrived at after a Diplomatic Conference modifying Art 116EPC. Neither the Chair of the Boards, nor the Boards of Appeal Committee under R 12(c) or even the Administrative Council of the EPO have the legitimacy for such a change.

Oral proceedings by ViCo are not at stake if both parties agree and all the members of Board when deciding on an appeal are sitting together in Munich or Haar.

Procedural laws in member states do not allow an extension of measures introduced during the pandemic ad infinitum and that members of the Boards can be scattered around Europe.

The Chair of the boards and any member of the boards having contributed to the elaboration of Art 15aRPBA2020 should be excluded from the Board deciding G 1/21 pursuant Art 24EPC.

What does Art 116 say or not say

Although Art 116 does not literally forbid oral proceedings to be held by ViCo, it is a big step to first decide that they are authorised as such and secondly there is an even further big step to leave it to the discretion of the boards of appeal to decide that oral proceedings held by ViCo can be imposed without the consent of the parties.

It is somehow puzzling that one the one hand an applicant or a proprietor has the choice of the form in which a patent is granted or maintained, cf. Art 113(2), but he has no say whatsoever about the form in which oral proceedings will take place.

Oral proceedings are the way for parties to actually exercise the right to be heard. Hearing of parties in oral proceedings held by ViCo is not a mere administrative decision which cannot be challenged as it touches the core of the right to be heard.

The “Travaux préparatoires” on Art 116 are not very revealing. It is possible to quote IV/6514/61-D, page 83, and M/21, page 236.

One aspect is nevertheless to be concluded from the “Travaux préparatoires”. The presence of the parties in front of the boards of appeal was required in spite of the costs which were going on a par with such “hearings”. The boards of appeal as they were conceived in the various drafts of the then “European Patent” could not decide in the absence of the parties. It means a contrario that oral proceedings have to be held in presence of the parties in one of the buildings of the EPO.

That Art 116 EPC is silent about oral proceedings by ViCo, with or without the consent of the parties cannot be taken as an authorisation to hold oral proceedings by ViCo. The same applies to the scattering of members of the boards across member states or even outside, see below.

Art 23 RPBA2020, states that the RPBA2020 are “binding upon the Boards of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention. But this is exactly which is the case of the amendment brought in by Art 15aRPBA2020.

The pandemic should not be a pretext to change fundamentally the way the EPO is working

No party to a procedure before the EPO has ever envisaged that OP by ViCo would become the rule. What is to be noted is that OP by ViCo have been introduced during the pandemic. Without the pandemic, there would have been no reason to render oral proceedings by ViCo not only mandatory, but that they can be held without the consent of the parties.

The Covid 19 pandemic is merely a pretext to completely change the way the EPO and the boards are working. Whilst during the pandemic OP as ViCo can be a good solution when the parties consent, this does by no means justify that this form of ViCo should remain mandatory after the pandemic and the more that they can be held without the consent of the parties.

This point will be emphasised when looking under Art 125EPC at procedural laws of members states.

Art 15a RPBA2020 and its various problems

Art 31 and 32 of the Vienna Convention on the Law of Treaties cannot be taken as allowing the interpretation presently made under Art 15a RPBA2020 of oral proceedings by ViCo. This also applies to the mandatory character of oral proceedings by ViCo without the consent of the parties before the first instance.

In a series of decisions T 1427/10, T 0037/08, T 1266/07 and T 0663/10 boards of appeal have refused to hold oral proceedings by ViCo. The reason given at the time was that “the boards of appeal do not at present have the facilities and procedures for holding public oral proceedings by videoconference”.

This does not mean a contrario that should the facilities and procedures be available, they would be allowable as such and moreover without the consent of the parties.

Oral proceedings in form of videoconferences were originally allowed in first instance and in ex-parte procedures. By accepting oral proceedings by ViCo, the applicant had to give its consent and waive the right to oral proceedings in person.

With the introduction of Art 15a RPBA2020 the Administrative Council of the EPO has decided, following a proposal of the Boards of Appeal Committee, to leave it to the discretion of the boards to hold oral proceedings by ViCo and further to leave it to the discretion of the chair in the specific appeal to allow members of the boards not to sit in Munich or Haar.

Absence of any legal basis in the EPC for holding oral proceedings by Vico be it in first instance or before the boards

All the considerations on Art 116 expressed by the management of the EPO or of the boards of appeal fail to overcome the fact that oral proceedings in form of ViCo, be it in first instance or before the boards of appeal, lack any legal basis in the EPC as it stands.

In any case oral proceedings by ViCo should receive a legal basis, and they should only be held with the agreement of the party or parties.

Exceptions to this rule should be limited to exceptional circumstances and limited in time. This is not the case with Art 15aRPBA2020.

In Point 20 of the document BOAC/16/20, submitted by the president of the boards it is stated that “Article 15a RPBA clarifies the practice of the Boards of Appeal since May 2020 of conducting oral proceedings by videoconference. Therefore, the Boards of Appeal may adapt their practice before the date of entry into force. The existing discretionary power of the Boards of Appeal to hold oral proceedings by videoconference remains unaffected. Accordingly, Boards may summon parties to oral proceedings by videoconference for a date before 1 April 2021 and may convert oral proceedings scheduled to take place on the premises before that date to oral proceedings by videoconference, even without requiring the parties' agreement to this format”.

This statement acknowledges that the boards of appeal have been acting contra legem since May 2020 under the conduct of the president of the boards of appeal.

Art 12(1,e) RPBA2020 cannot serve as legal basis for holding oral proceedings by ViCo

Art 12(1,e) RPBA2020 provides that “Appeal proceedings shall be based on minutes of any video or telephone conference with the party or parties sent by the Board”.

As boards of appeal have to be neutral in appeals on a decision of an opposition division, this provision can only apply in ex-parte appeal procedures. It can be

considered equivalent to an informal consultation between the examiner in charge and the applicant or its representative.

Provided the minutes of such video or telephone conference are public, there is nothing against such a way of handling in ex-parte appeals.

It can by no means be considered as introducing oral proceedings by ViCo before the boards of appeal, and even less without the consent of the parties, especially in opposition appeal procedures.

No legitimacy of the AC to modify the EPC as suggested in Art 15a RPBA2020

Be it for the Chair of the Boards, the Boards of Appeal Committee under R 12cEPC or for the Administrative Council, none of those persons respectively institutions, have the legitimacy to introduce such a fundamental change in the way the EPO and its deciding bodies are organised and working.

When Art 17 and 18 were brought together in order to allow search and examination to be carried indistinctly in Munich and in The Hague, this was the result of the Diplomatic Conference of 2000 revising the EPC.

By leaving to the discretion of the boards to decide whether oral proceedings before the boards and allowing the deciding board not to sit in Munich, the procedure before the boards of appeal undergoes a fundamental change. Imposing such a fundamental change in the procedure before the EPO cannot be left to the management of the boards and the other related institutions.

Such fundamental changes in the procedure before the EPO, can only be the result of a Diplomatic Conference.

Such a Diplomatic Conference could best be prepared by first holding a conference of ministers of the Contracting States responsible for patent matters as foreseen in Art 4c EPC, which has not been used since the entry into force of the EPC 2000 on 13.12.2007.

Another solution could be, at minima, to amend the Implementing Regulations. Documents sent electronically or by fax were admitted without changing the EPC. For oral proceedings by ViCo, R 115 or 116 EPC should be amended or preferably a new Rule 115a should be introduced dealing specifically with oral proceedings by ViCo.

By this new rule the legislator would be obliged to make it clear that there is no contradiction of this new rule with Art 116 EPC, (see Art 164(2) EPC).

A provision such as Article 15a RPBA2020 is not appropriate, as of oral proceedings by ViCo also concerns the first instance.

In any case, there is a need for a legal basis for oral proceedings by ViCo, at minima in the Implementing Regulations. Presently there is a legal vacuum on this topic!

No control of the discretion given to the boards in Art 15a RPBA2020

The mere fact that OP by ViCo are left to the discretion of the boards is not acceptable. Through the RPBA 2020 the boards received and extraordinary discretion. Whilst the boards are empowered to assess whether divisions of first instance have exercised their discretion correctly, there is no body foreseen within the EPC to assess whether the boards have exercised their discretion correctly.

The Enlarged Board of Appeal acting under Art 112a is not the instance which will ever control the exercise of the discretion of the boards as it means that it could be forced to engage into discussions as to the substance.

Although the boards have a large discretion, they should use it sparingly in view of the fact that there is no revision instance. Giving the boards the power to decide in ultimo and without any revision possibility is not acceptable for this reason alone when it comes to oral proceedings by ViCo.

No indication on how the BA should exercise their discretion

The discretion given to the boards in the RPBA2020 is based on a long standing line of case law from the boards in procedural matters going back to the first edition of the RPBA in 2005 and developed under the RPPA2007.

Even in the RPBA 2020 there are clear indications on how the boards should exercise their discretion, see for instance Art 13(1) RPBA2020.

In Art 15a RPBA2020 there is no indication whatsoever as to how the boards should exercise their discretion when summoning parties to oral proceedings by ViCo and moreover without their consent.

Board members do not have to be present in person during OP

Beside the fact that there oral proceedings by ViCo can be imposed without the consent of the parties there is a further problem which has to be considered.

According to Art 15a(3) RPBA2020 “The Chair in the particular appeal and, with the agreement of that Chair, any other member of the Board in the particular appeal may participate in the oral proceedings by videoconference.”

This means that the members of the deciding body, here the board, do not have to sit in one and the same location when deciding on the appeal, i.e. in Munich or Haar when the OP is held as ViCo.

However in G 2/19, the EBA held, see last § before the order, that “Users of the European Patent Organisation's services can legitimately expect that the European Patent Office's departments will not perform acts at whatever other place they choose.” According to Art 15a(3)RPBA2020, the members of the boards may come

to a decision on an appeal in any place they choose, whereby this even be outside the territories of the contracting states.

This statement in G 2/19 shows that Art 15a(3) RPBA2020 is in flagrant contradiction, with the EPC as it stands.

Rules of Procedure of the Enlarged Board of Appeal and oral proceedings before it as ViCo

Art 15 RPBEBA deals with oral proceedings before the Enlarged Board of Appeal.

There is no provision in this article allowing the holding of oral proceedings before it in the form of ViCo and even less without the consent of the parties.

Holding oral proceedings before the Enlarged Board of Appeal by ViCo in case G 1/21 without the consent of the parties lacks thus any legal basis. It is not the introduction of Art 15aRPBA 2020 which only deals with the boards which can authorise the Enlarged Board to hold oral proceedings by ViCo before it.

The reasons raised above here relating to oral proceedings by ViCo before the boards of appeal, and especially without the consent of the parties, apply mutatis mutandis for oral proceedings before the Enlarged Board of Appeal.

According to Art 19 RPEBA the Rules of Procedure adopted by the Administrative Council on 25.03.2015 shall be binding upon the Enlarged Board of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the EPC.

The decision of the Administrative Council of 23 March 2021 introducing Art 15aRPBA2020, did not amend Art 15 RPEBA. .

It has been shown above that Art 15aRPBA20 are clearly incompatible with the spirit and purpose of the EPC. The absence of provisions in the RPEBA for holding oral proceedings before it and without the consent of the parties confirms the lack of legal basis for the envisaged oral proceedings in G 1/21. These oral proceedings are contra legem.

Alone for wanting to hold proceedings by ViCo before the Enlarged Board without the consent of the parties, the members of the Enlarged Board of Appeal designated by the Chair of the Enlarged Board in G 1/21 can be considered as prejudiced and should deport themselves.

Art 125 EPC and the procedure before the boards of appeal

Art 125 provides. “In the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States”.

There are no provisions as such governing oral proceedings by ViCo in the EPC. It is thus interesting to see what is going on in some member states of the EPO.

In Germany Art 128a(1), ZPO (Code of Civil Procedure) provides that “The court may, on request or of its own motion, allow the parties, their representatives and assistants to be present at another place during oral proceedings and to perform procedural acts there”. The members of the court must however be present at its seat.

In France, in view of the pandemic Articles 7 and 8 of Order No 2020-304 of 25 March 2020 authorises the use of videoconferencing to conduct hearings in civil and criminal matters, without the possibility of refusal by the parties. This order is only valid between 12 March 2020 and the expiry of one month from the date of cessation of the state of health emergency. The same applies as in Germany, members of the court must however be present at its seat.

Two conclusions can be drawn:

- It might be possible to hold oral proceedings by ViCo, but the deciding body has to sit together at the seat of the court
- During the pandemic, and only during pandemic oral proceedings by ViCo can be held without the consent of the parties.

What is proposed with **Art 15aRPBA2020** is thus **not conform to principles of procedural law** in two important member states of the EPO.

Not only is the measure **not limited in time**, i.e. for the duration of the pandemic, but the **members of the deciding body** can be **scattered around** the member states and even outside.

The proof has thus been brought that Art 15aRPBA has no legal standing in view of principles of procedural law valid in member states of the EPO

Partiality of some of the designated members of the EBA in case G 1/21

Before deciding on case G 1/21, not only the chair of the EBA in case G 1/21, but all the other appointed members, beside the two external members, having contributed to the elaboration of Art 15aRPBA2020 should deport themselves. If they are not

prepared to do so the procedure foreseen in Art 24 EPC should be applied to them. It is left open whether the rapporteur could also be subject to a procedure under Art 24 EPC.

Art 24(1) EPC speaks about members “having participated in the decision under appeal”. The decision here is to submit Art 15aRPBA2020 to the approval of the Board of Appeal Committee and of the Administrative Council of the EPO by the Chair of the boards and the Boards of Appeal Committee. .

How it came to Art 15aRPBA2020

R 12c(2) EPC provides that “On a proposal from the President of the Boards of Appeal and after the President of the European Patent Office has been given the opportunity to comment, the Committee set up under paragraph 1 [i.e. the Board of Appeal Committee] shall adopt the Rules of Procedure of the Boards of Appeal and of the Enlarged Board of Appeal”.

The chairman of the Board of Appeal Committee and the president of the boards of appeal launched on 13.11.2020 a “User consultation on an amendment to the Rules of Procedure of the Boards of Appeal 2020” ending on 27.11.2020.

The document BOAC/16/20 dated 10.12.2020 has been submitted by the president of the boards. This is a further proof that the president of the boards was directly involved in the drafting of Art 15aRPBA2020. The aim of document BOAC16/20 is to give a legal basis of the practice of the boards since May 2020.

As explained above, the statement in point 20 of BOAC16/20 acknowledges that the boards of appeal have been acting contra legem since May 2020 under the conduct of the president of the boards of appeal. If the president of the boards chairs the Enlarged Board in G 1/21 it is manifest that he is judge and party, i.e. even the perception of his independence is not given and he is prejudiced.

The communication of the boards of appeal dated 15.12.2020, dealing inter alia with oral proceedings before the boards in form of ViCos, could not have been published without the agreement of the president of the boards of appeal.

In accordance with R 12c(2) EPC, the Document BOAC/16/20, dated 10.12.2020, has been drafted by the “president of the boards of appeal”.

The president of the boards of appeal has also participated in the meeting of the Board of Appeal Committee which approved the draft of Art 15aRPBA2020.

The president of the boards of appeal was also present at the deliberation of the Administrative Council of 23.03.2021 when the latter adopted Art 15aRPBA20 (CA/D 3/21). Whether he addressed the Administrative Council or not is irrelevant.

Manifest partiality of the president of the boards of appeal in case G 1/21

The president of the boards of appeal, Mr Josefsson, has decided to put himself as chair in G 1/21.

The succession of facts mentioned above would impose that Mr Josefsson deports himself in G 1/21. Not only he is chairing the case, has contributed to the drafting of Art 15aRPBA2020, but at the same time he has contributed in rushing the whole affair by abiding to the bare minimum foreseen under R 115 when summoning to oral proceedings. In view of his attitude, there is not even the perception that Mr Josefsson would be not prejudiced, he actually is.

Partiality of the members of the boards designated by the president of the boards of appeal to sit in the Enlarged Board deciding upon G 1/21

The president of the boards of appeal is requested to give the names of all the members of the boards of appeal having contributed to the drafting of Art 15aRPBA2020.

All the members of the boards, beside the chair of the working party of the boards on Art 15a RPBA2020 which is not designated as member in G 1/21, and having contributed to the elaboration of Art 15aRPBA 20 should be excluded from the proceedings in G 1/21. Those are the four chairpersons presently designated to sit in G 1/21. Furthermore, it is a known fact that all the chairs of the boards were as well consulted about Art 15aRPBA2020. So that no chair of the boards could act as chair of the Enlarged Board in G 1/21.

It is not only the perception of independence, but the actual independence of the boards of appeal which is at stake here.

How can the users of the EPO have any confidence in the boards of appeal if their president and some chairpersons of boards behave in such an outrageous fashion?