

## Oral Proceedings – a Personal View

Casting my mind back over the past 30 years or so of practice at the EPO, during which I must have attended over 300 Oral Proceedings, certain events spring into prominence, which I would like to share.

Although I had already worked in the UK profession for about six years, my EPO career really began in the early eighties, when I first joined Hoffmann · Eitle at their offices in Munich to assist with their growing case load of EPO applications in English. In those days, the EPO was a relatively new organization, and had only recently moved out of its original home at Motorola House in Rosenheimer Strasse. Since the EPO was new, there was little, if any, developed Board of Appeal case law. We therefore had to rely on experience gained before the national Patent Offices, national case law and practice and common sense.

### Early Encounter with the Problem and Solution Approach

I remember what was probably my first case before the Technical Board of Appeal. I was confronted by George Szabo as chairman. He apparently was not very impressed with my arguments on obviousness, because a day or so after the hearing (which I lost), he called me up and invited me in for a chat. This was when I first encountered the famous “problem and solution approach”. George very kindly explained the whole concept from first principles, and I remember he referred to the so-called “frying pan model”, which the EPO used internally to test their ideas. The frying pan invention was to coat an otherwise known frying pan with Teflon<sup>®</sup>. Was that inventive? While we were pursuing this interesting discussion, I saw smoke rising from the corner of the room, and interrupted George to point this out, thinking that perhaps he was testing out the effectiveness of the frying pan! It turned out however to be a vapour generator for the treatment of George’s asthma.

As a direct result of this meeting, I decided to write an article for the CIPA journal on the subject of the Problem and Solution approach, which seemed to generate a certain heat in some quarters. However, I was glad to be congratulated shortly afterwards by a senior Examiner for my efforts, so felt that my explanation could not be too far wide of the mark.

It was around this time that I became involved in a long-running battle with a particular Examiner, who is now quite senior in the EPO. He would not accept my arguments on inventive step, but I was convinced a

patentable invention was there to be claimed. Eventually, I asked for an interview, which he duly granted. But in spite of my best efforts, I was unable to convince him of the merits of the case, and left feeling rather disappointed. However, the following day he called me up and told me that he had decided to allow the application after all, because he had come up with a better argument than the one I presented!

After I returned to London in 1985, the number of contested cases increased relentlessly. I had the good fortune to represent a particular US client whose applications were nearly always opposed by one or sometimes two or three of his European competitors. These Oppositions nearly always ended with Oral Proceedings, and were very often appealed by the losing party.

### Doing without Counsel

In those days many UK practitioners would engage Counsel if they were summoned to Oral Proceedings. However, as a result of the experience I had gained working in Munich, this was never an option I considered. When attending such proceedings, it was my habit to stay in a flat which my firm had on a more or less permanent lease. Whilst having cost advantages, this also caused some major problems. One difficulty was that one would arrive from London perhaps in the early evening and find that the fridge was empty. This problem was solved by appropriate logistical arrangements, but on one particular occasion a more serious difficulty arose – my alarm clock failed. Moreover, the weather had changed and the ground was covered with a thick blanket of snow, which disrupted public transport. I awoke at about 8.55 am in a panic and telephoned the EPO to explain why I would be late. They seemed to be sympathetic and I said I would arrive as soon as possible. I think it took about an hour to struggle through to Neuperlach, where the hearing was to take place. But when I arrived, I was told that the Chairman had decided to begin without me and that the application was now refused!

All my protestations seemed to be in vain, and I departed in high dudgeon, muttering “We’ll see what the Board of Appeal has to say about the matter”. I had already left the building and was on my way down the street to the S-Bahn station, when I heard someone calling my name. One of the Examiners had followed me out into the snow and was asking me to return. It transpired that they’d had a change of heart, and decided to wipe the slate clean and start over again! The application was then allowed, but as a consequence of these events, I decided in future always

to stay in a hotel with a wake-up service, and to buy a more reliable alarm clock.

Shortly afterwards, I was asked to take over a case which had previously been handled by another firm. Unfortunately, the Examiner had taken a wrong view of the matter and had proposed amendments which appeared to change the nature of the invention to such an extent that essentially a completely erroneous inventive concept was claimed, and passed to grant. Fortunately, there was still a way of interpreting the granted claim which could, at a stretch, cover the intended subject matter, so that the claim could be amended to home in on the correct target without conflict with Art. 123, but I could see that we would have an uphill battle, especially since four parties had opposed the Patent and, perhaps not surprisingly, all had interpreted the claim as the Examiner had intended.

Eventually, the case came before the Board of Appeal. I presented my alternative claim, and explained how the invention actually worked, and why, therefore, all the arguments presented by the Opponents were completely irrelevant. The Board seemed rather surprised by my presentation, and had obviously not fully appreciated the situation before the hearing. Eventually, the Board decided to adjourn the case and to appoint new Oral Proceedings at which the “correct” invention could be considered! Needless to say, the Opponents were not very happy about the outcome, but I felt that justice was done, and the Patent was eventually maintained in amended form.

#### Multiple Opponents – and beer

Another case with multiple opponents comes to mind. Again, this was a case we had taken over from another firm of representatives after the Patent had passed to grant. Somewhat unusually, the granted patent had four separate independent claims in the same category, each of which claimed something rather different. Moreover, each of the four Opponents cited different prior art and relied therefore on different arguments. We were therefore faced with a situation where essentially we had sixteen separate Oppositions to contend with. Not surprisingly, the hearing was a long drawn-out affair. However, the situation was exacerbated by the Chairman, who insisted on asking each Opponent in turn to comment on the arguments made by each of the other Opponents!

By 11 pm the hearing was still going strong, and we had not had any dinner. Moreover, flights home had had to be cancelled and hotels found at short notice, all in the breaks while the Opposition Division made

various interim decisions. While we waited for the nth such decision to be made, one of the Opponents found that a cupboard labeled “EPO Chess Club” was left unlocked and contained a supply of beer! As an emergency measure, it was unanimously decided to take advantage of this.

Of course, the case could not be completed under such circumstances, and had to be adjourned. In fact, it was not continued until some 11 months later. No minutes of the first hearing had been issued, apparently on the basis that the hearing was notionally still in progress! Of course, in the meantime all parties had a somewhat hazy memory of the previous events, and moreover the composition of the Opposition Division had changed! The Board of Appeal eventually held the change of composition to give rise to a serious procedural violation so the case was remitted to the Opposition Division to start all over again.

#### Lock-out caused by Mouse

A few years later, I arrived at the main EPO building in Erhardtstrasse to find that all the doors had been chained and padlocked by Greenpeace, protesting about the OncoMouse case. I pointed out to their leader that, if they were against experimentation on mice, they ought to be in favour of the patent, since this allowed the use of the technology to be restricted and controlled. He thanked me for my advice, in a somewhat sarcastic tone. Most of the EPO staff were standing outside, looking rather bemused, but a few early birds had managed to gain entry before the doors were locked. Amongst the crowd I recognized several members of the Boards of Appeal. Eventually, I met up with two of the members of the Examining Division before which I was to appear. They agreed that we could in principle conduct the proceedings in a local restaurant. However, one of the members was unfortunately inside the building and unable to escape! In the end, we solved the problem by sneaking in through the underground car park, and the hearing could begin.

#### Eccentric behaviour

On another occasion, I was representing a Japanese Corporate client in a case of some commercial importance. The Examining Division were particularly obstinate, and objected mainly to the somewhat unconventional use of English in the claims. Eventually, we were summoned to Oral Proceedings and three members of the Japanese Company decided to attend. We all arrived outside the hearing room and were met by two members of the Division, but no Chairman. At the

appointed time, we were invited into the room, but still no Chairman appeared. Eventually, some ten minutes later, the door burst open and the Chairman entered clad in full cycling gear, including a safety helmet and bicycle clips. He then proceeded to divest himself of bits of kit, store them in a cupboard, and put on his tie. Having taken his place, he then declared the proceedings open as if nothing unusual had occurred.

You can never predict what will happen. I turned up for a routine contested hearing a year or so ago, and met the Opponent's representative outside the hearing room. Gradually we became aware that the corridor was becoming rather crowded. A group of some fifty persons was gathering outside the room. What could this mean? An EPO Official then approached and asked if we had any objection to the presence of the members of a course run by the EPO Institute. The hearing room had been rigged up with two rows of seats, like a theatre, and we were to provide the "entertainment"! I remember waiting for the applause after I had presented my case, but there was only silence.

### Conclusion

Can any useful conclusions be drawn from these assorted recollections? Probably not, but I hope they have conveyed a sense of the EPO having been over the years a surprisingly human organization which does its best to find the right answer in sometimes adverse circumstances. I do hope that the new rules and stricter approach will not be at the expense of this underlying philosophy.

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