



Mewburn

The forward-looking  
IP firm

Ellis



# EPO videoconference hearings for JIPA

**Chris Denison, Mewburn Ellis LLP**

**July 2021**



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# Mewburn in numbers

- **280** strong - we're made up of over **100** scientists and engineers, as well as trade mark and legal specialists and business management experts.
- We have **5** growing offices in the UK and Europe.
- We've seen almost **40%** growth in the last three years.
- New people join us and stay, our staff retention rate for the last 12 months was **86%**.
- Almost **50%** of our **42** technical trainees are women (national average of women graduating in STEM subjects in 2019 according to UCAS was 26%).
- Some of the brightest and best minds in the business work at our firm. Nearly **70%** of our partners have PhDs.
- We are '**Top Tier**' in Legal 500 and MIP IP Stars, '**Band 1**' in Chambers & Partners UK, '**Gold Ranked**' in IAM Patent 1000 and '**Recommended**' in WTR.
- We work in more than **50** specialist technical areas for over **3000** active clients.
- We have over **25,000** active cases and more than **800** dispute resolution cases ongoing.
- We work with **8** out of the **Top 10** Universities in the UK as well as more than **1500** Start-ups and SMEs.
- More than a third of our clients have worked with us for over **20** years.
- Our clients stay with us, our client retention rate over the last three years is **78%**.
- Our oppositions success rate is enviable. Only **7.4%** of patents we have opposed in the last 15 years have been maintained as granted, compared with an EPO average of 24.6%. We're even more effective if the case goes to appeal, our maintained as granted rate is **2.7%** at appeal compared to an EPO average of 11.9%.\*

# Enviably successful success rate in oppositions & appeals

- Mewburn Ellis have a proven track record in successfully defending IP rights for our clients and attacking third party rights that cause concern.
- Our patent opposition specialists have years of experience. We also have unique insight into the changes at the EPO and their implications for oppositions. We have recently undertaken hours of research to analyse opposition cases from the last 10 years.
- We currently have in excess of **300** live patent oppositions at the EPO, including defending several of the most-opposed patents over the last few years.
- Our oppositions success rate is enviably successful. Only **7.4%** of patents we have opposed in the last 15 years have been maintained as granted, compared with an EPO average of 24.6%. We're even more effective if the case goes to appeal, only **2.7%** of the cases we attack are maintained as granted compared to an EPO average of 11.9%.\*\*
- We prepare creative and persuasive submissions and we're not afraid to try and change the law and help shape EPO practice. Significantly more than **50** cases handled by our attorneys feature in the EPO's Case Law Book – testament to our creative approach.

# Law and practice library available to all

- Fully searchable, our Law and Practice Library consists of over 100 guides all available online and covering a huge range of IP topics.
- In the spirit of openness and information sharing we have decided to keep them openly available to all.
- These are so good our competitors use them as reference – we know because they've told us!

## ACCELERATED PROSECUTION

Our pages 'UK Patents - The Basics' and 'European Patents - The Basics' set out in detail the various procedural steps involved in obtaining UK and...

## COMPENSATION OF INVENTORS ACCORDING TO THE PRINCIPLES OF THE GERMAN COMPENSATION GUIDELINES

Type (lump sum or instalments) and amount of compensation are determined by an agreement between the employer and employee. The calculation of a...

## CONFIDENTIALITY

[Download Confidentiality Agreement Form](#)

Often you may wish to tell other people about your invention, for example if you are trying to license or...

## COPYRIGHT IN TRADE MARKS

When a trade mark contains or consists of a logo, it is likely that there is copyright in the trade mark. If so, it is important that the trade mark...

## DEFERRED PATENT EXAMINATION SYSTEM

Several Patent Offices operate a deferred patent examination system under which patent applications remain dormant until the applicant takes steps...

## DEFERRED PATENT EXAMINATION SYSTEM - GERMANY

The German Patent Office operates a deferred patent examination system under which patent applications remain dormant until the applicant takes steps...

## DESIGNATION OF THE EU VIA THE MADRID PROTOCOL

The European Union is a member of the Madrid Protocol and so the European Union can be designated in an International Registration so as to seek...

## DESIGNATION, EXTENSION AND VALIDATION STATES FOR EUROPEAN PATENT APPLICATIONS

For European patent applications filed since 2009, all available EPC member states are designated by payment of one designation fee.

The EPO has a...

## DIRECT EUROPEAN PATENT APPLICATIONS: EARLY STAGE PROCEDURE AND PAYING SEARCH FEES

[Download flow chart - EP Early Stage Procedure & Paying Search Fees - Decision chart for action after issuance of a partial search report on a direct...](#)

## DISCLOSURE OF SEARCH RESULTS

From 1st July 2004 the UK Intellectual Property Office has been requesting the results of official searches produced by other patent offices to be...

## DOMAIN NAMES

The importance of trade marks is being increasingly highlighted by the rapid growth in use of the Internet. This page explains the process and some...

## DUTY OF DISCLOSURE

Failure to disclose relevant information to the United States Patent and Trademark Office (USPTO) can result in a patent becoming invalid and...

We have a responsibility to ensure our business has a positive impact on the people, communities and environment around us so we have launched the Forward Community Programme

### Diversity & Inclusion

Gender Pay Gap Reporting  
D&I Audit  
D&I Training  
Sponsorship of CREST Awards  
Wellness Committee  
Mentoring of school age children  
Sponsorship of BSA 'Smashing Stereotypes' campaign

[Read More](#)

### Sustainability

Focus on: waste,  
saving energy & our  
carbon footprint  
Paperless office  
Sustainability considered in  
our new building choices  
New approach to travel  
Facilities and front of house  
review

[Read More](#)

### Community

1% profit - £150,000 to charity  
250 CSR Days  
Coronavirus Support  
National Partnership with  
British Science Association  
Support for local charities  
covering: cancer, end of life care  
for children & homelessness

[Read More](#)

# Chris Denison

- BA in Natural Sciences from Cambridge
- Qualified 2000; partner 2002
- 3 month placement in Japan 2001; visits for 1-2 weeks most years since then
- Involved with JIPA since the start of the F4 course on EP law and practice
- Practice: biotechnology, especially therapeutic antibodies
- Major clients: Japanese and multinational pharmaceutical companies and start-ups; Japanese food companies
- Much experience of EPO opposition and appeal work



# EPO hearings by videoconference

- Where are we now?
  - Examining Divisions moving to videoconferencing (ViCo) OPs
  - Pilot project for Opposition Division ViCo OPs
- Practicalities
- The Boards of Appeal
- ViCo vs in-person
- Looking forward, and some experiences



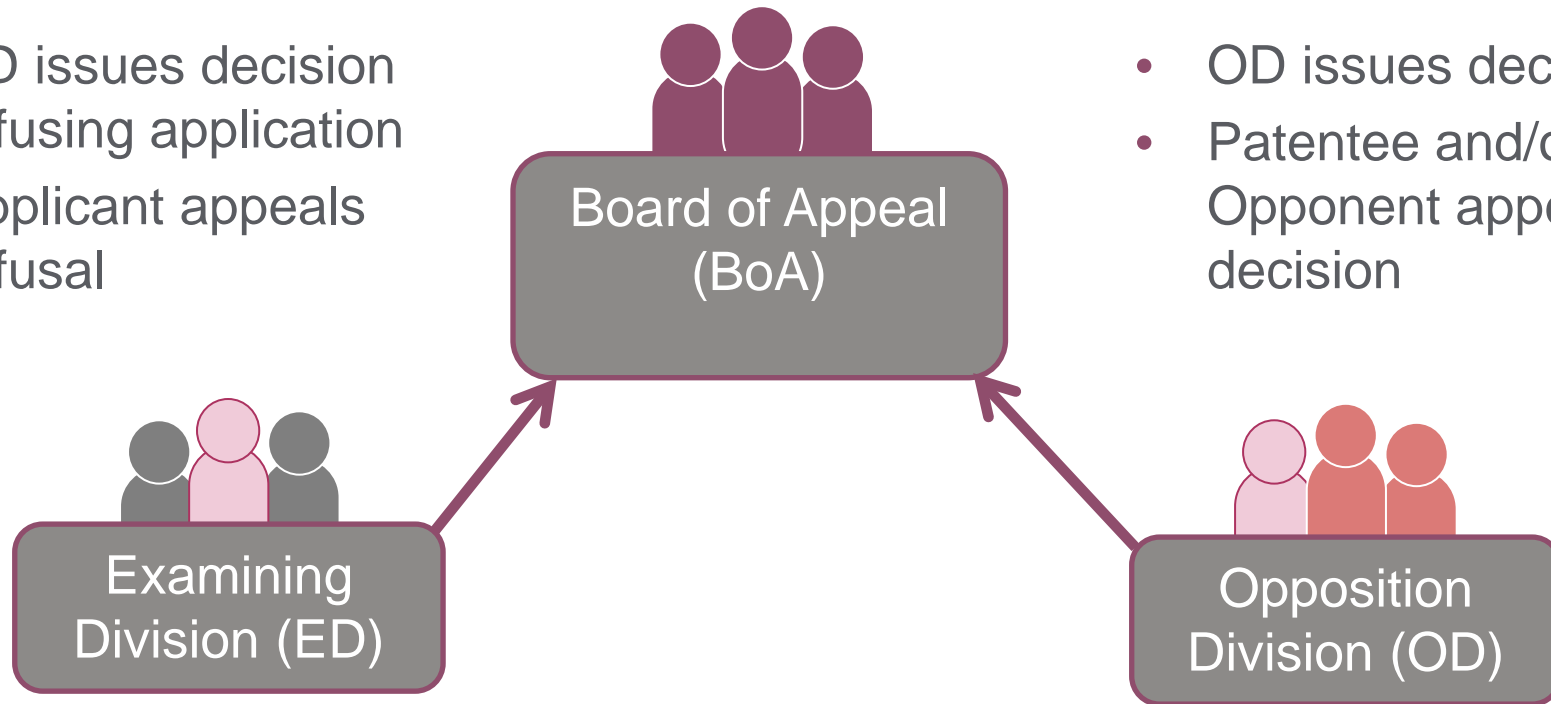
# EPO hearings by videoconference

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# 3 types of hearing / oral proceedings (OPs)

## ED, OD, BoA

- ED issues decision refusing application
- Applicant appeals refusal



- OD issues decision
- Patentee and/or Opponent appeals decision

Pending applications

ViCo was already possible, but rare

Granted patents

# Where are we now?



Mar Apr May June July Aug Sept Oct Nov Dec Jan Feb Mar Apr May Jun Jul Aug Sep Oct Nov Dec Jan

1 April 2020  
Exam Division OPs by ViCo as default

14 April 2020  
Announcement of pilot project for ViCo Opposition Division OPs – all parties must consent to ViCo

OD OPs by ViCo pilot

5 May 2020  
No in-person OD OPs to 1/6/20

21 May 2020  
No in-person OD OPs to 14/09/20

29 July 2020  
No in-person OD OPs to 31/12/20

10 Nov 2020  
No in-person OD OPs to 15/09/21, pilot extended

All OD OPs to at least 31 January 2022 **will** go ahead **by ViCo**  
Only exception is where there are “*serious reasons*” against using ViCo

OD OPs by ViCo pilot

Requirement for consent to ViCo removed

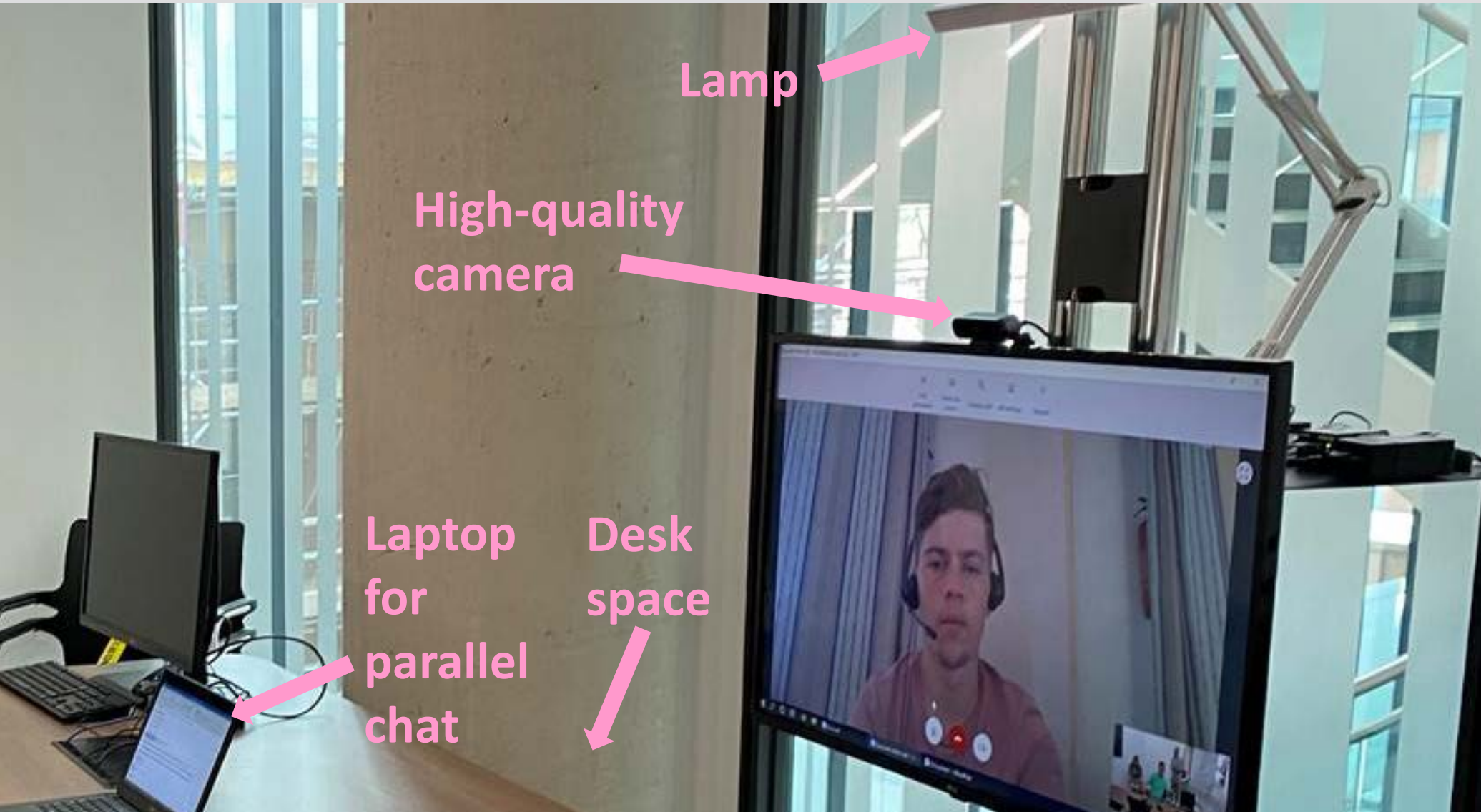
17 June 2021  
No in-person OD OPs to 31/1/22, pilot extended

OD OPs by ViCo pilot

OD = Opposition Division  
OPs = Oral Proceedings / hearings

- Where are we now?
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# Practicalities





Interpreter - EN

Public

- Off
- EN English
- FR French
- DE German

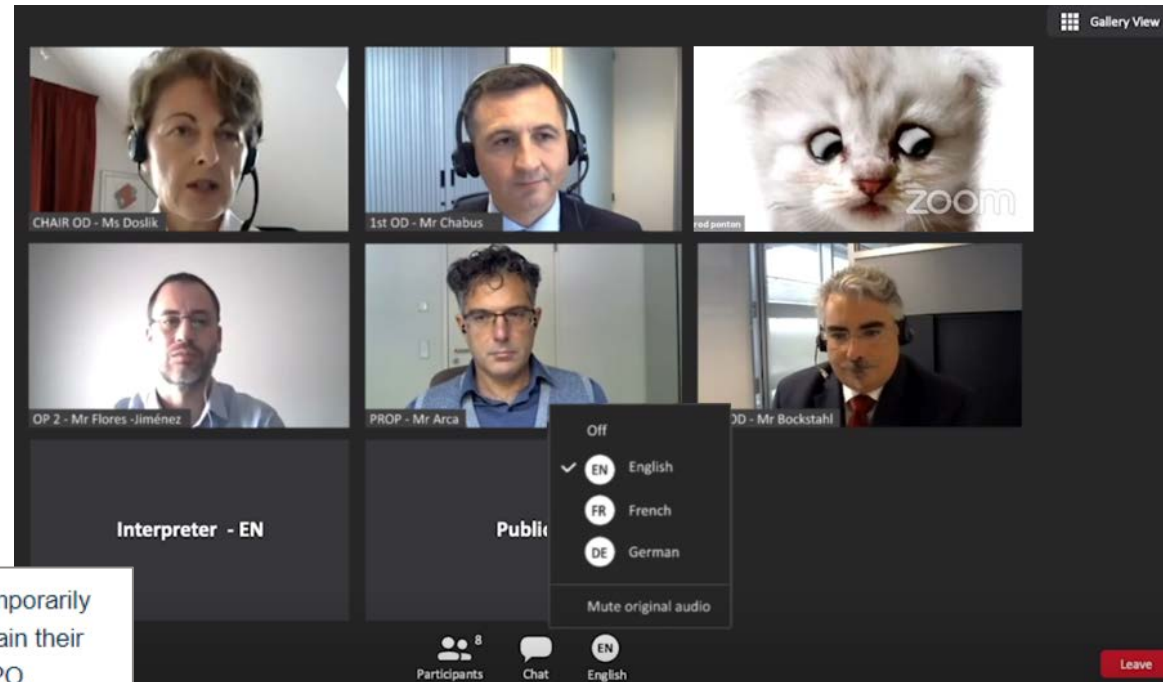
Mute original audio

Screen shot from Zoom mock OPs

# Practicalities

- Two modes for joining
  - Can join as party – part of proceedings
    - Webcam on
    - EPO test call important
  - Can join as member of public
    - Request invitation by email
    - “[insert name]” on screen
    - Not visible (usually)

3. If so requested by the chairperson, the member of the public must temporarily switch on their camera to allow the videoconference participants to ascertain their identity just as if they were taking part in person on the premises of the EPO.



Screenshot of mock OPs from EPO e-learning centre

- Second line of communication with your team
  - Chat for “note-passing” in hearing
  - Everyone totally clear on mechanism

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# Boards of Appeal – very different!

- Opposition Division pilot does not apply: in-person hearings have continued throughout most of the pandemic
- Boards have had wide discretion to hold hearings by ViCo or in-person, as they wish
  - Our experience so far: different Boards (subject areas) and different members within Boards have different preferences.
  - Frustratingly unpredictable
- New Rules of Procedure of Boards of Appeal (Art 15a)
  - Boards can hold hearings by ViCo upon request by a party, or of their own motion, without the consent of all parties
  - Permit hybrid hearings – these take place at EPO, but a party, or a representative, or an accompanying person within a party, can attend by ViCo
  - We don't yet know how the Boards will apply the new rules

# Board of Appeal – Haar July 2020



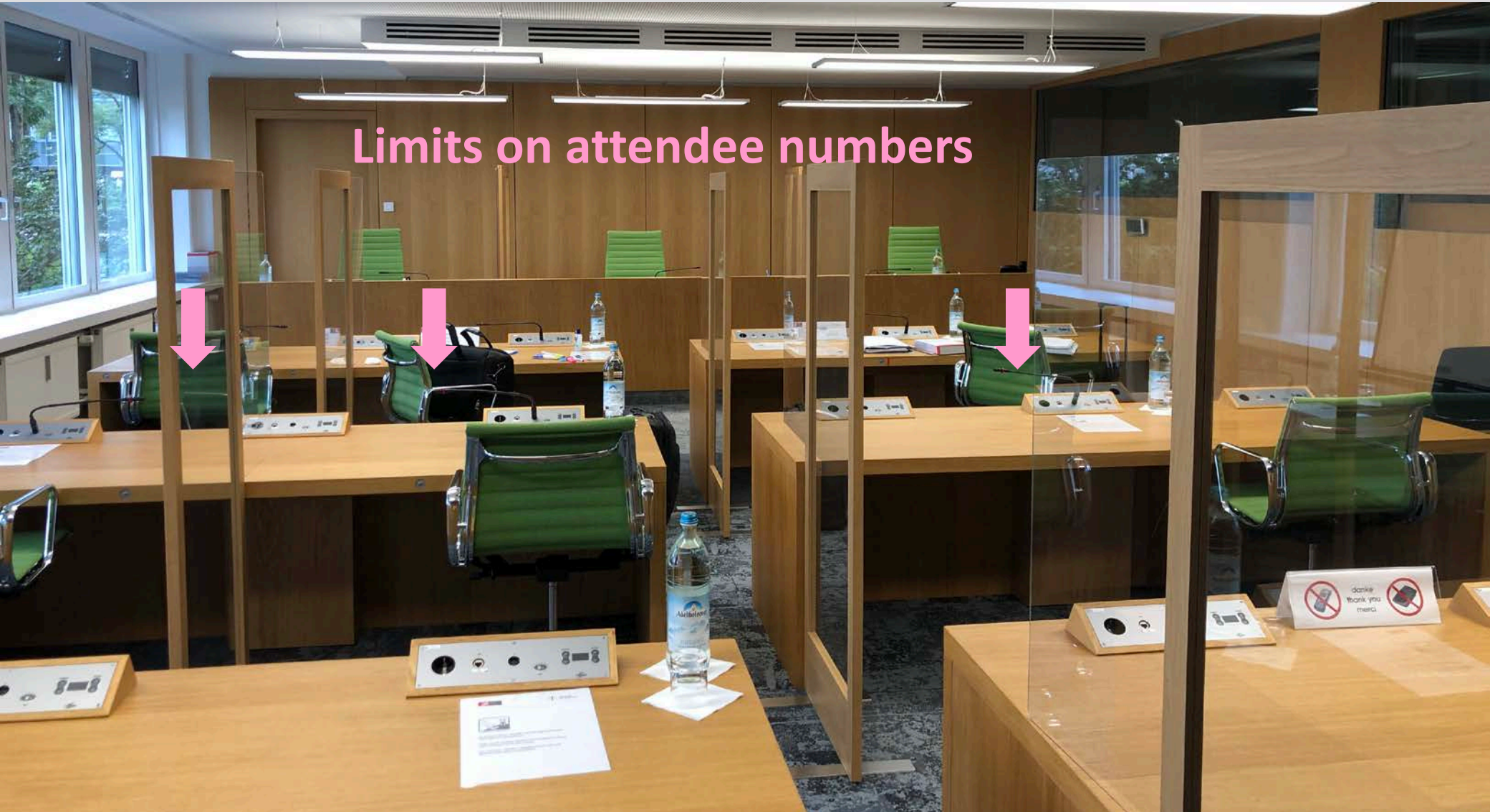
screens

distancing

masks  
chaperones

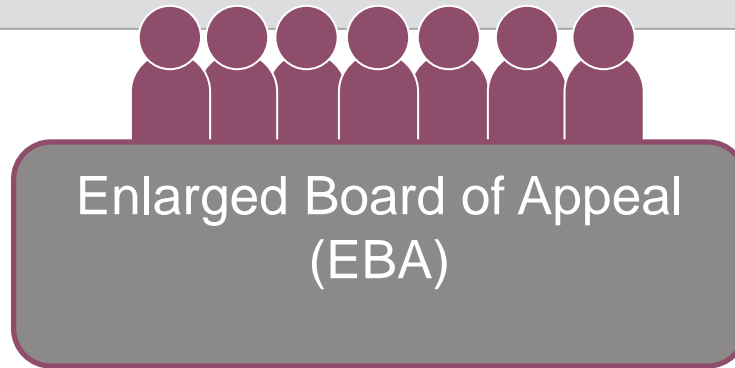
# Board of Appeal – Haar August 2020

Limits on attendee numbers



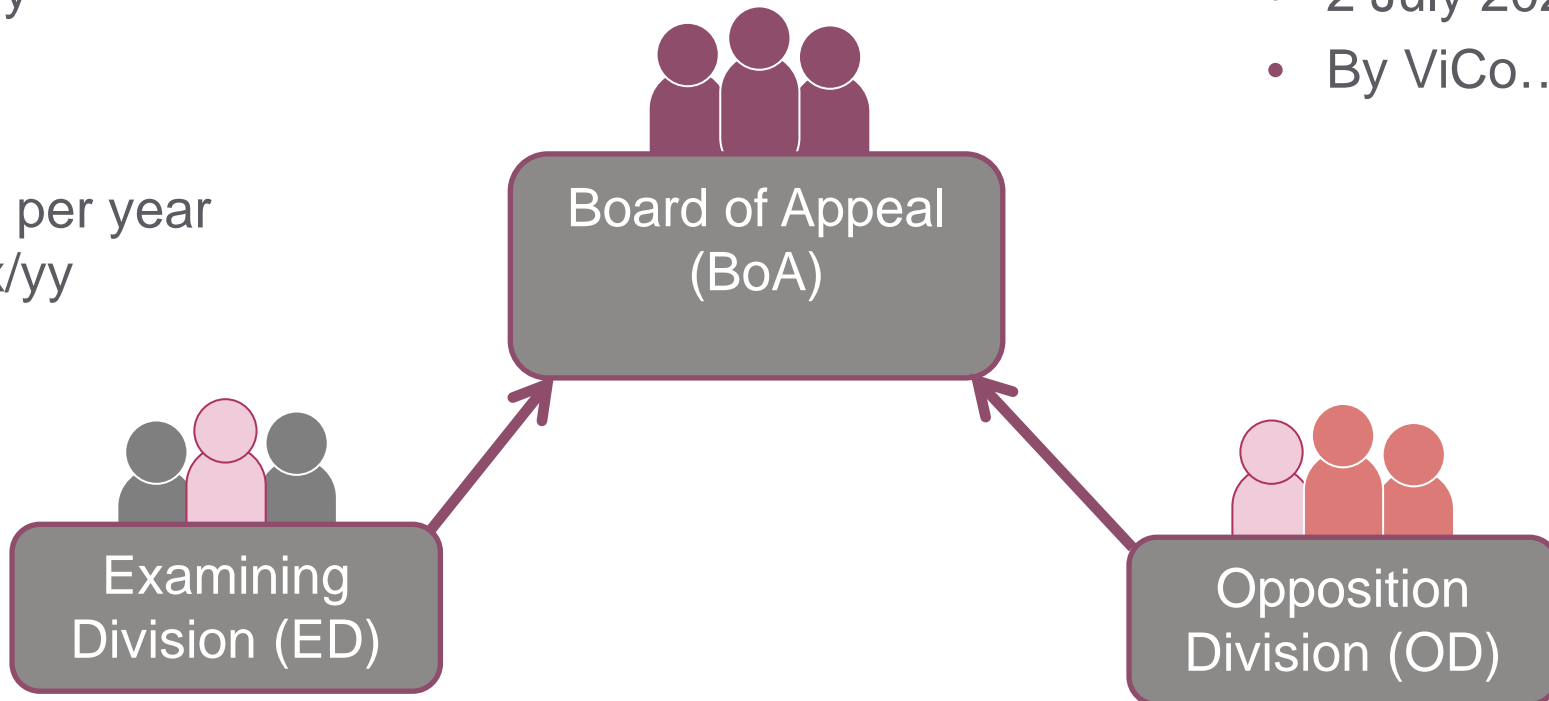
# Enlarged Board of Appeal referral

- Decides on points of law of fundamental importance
- ~3 per year  
G xx/yy



- T 1807/15 refers question to EBA on legality of ViCo OPs
- G 1/21
  - 2 July 2021
  - By ViCo...

- ~3000 per year  
T xxxx/yy



# EPO hearings by videoconference

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- **ViCo vs in-person**
- Looking forward, and some experiences

## ViCo

- Attendees
  - Any location
  - No limit on numbers
  - Technical experts on stand-by
  - Degree of anonymity
- Presentation
  - screen space may be an issue for large hearings
  - Screen sharing
    - YouTube evidence
  - “I am not a cat”

Comparison in terms of your opposition case.

Not comparison of public health issues, environmental issues...

Comparison based on the reality now. ViCo still relatively new, and in-person BoA OPs are socially distanced.

Not comparison with pre-COVID situation

## In-person (currently only BoA)

- Attendees
  - Give notice if request >2 people accompanying
  - Need to get there!
- Presentation
  - Usually everyone visible all the time to everyone else - but only usually
  - “Human connection”
    - But screens, distancing
    - Highly debatable

# ViCo vs in-person

## ViCo

## logistics

## In-person

other side not attending  
1 or 2 opponents  
few documents  
extensive discussion within team (scientists)

interpretation

several opponents  
100's of documents

## predictability of outcome

one of a series of related cases  
very (un) favourable preliminary opinion  
single issue case

preliminary opinion finely balanced  
“needs to be discussed”

## finality of outcome

Opposition Division  
defending patent with (stronger) divisional

Board of Appeal

## certainty

certainty of date wanted for preparation + planning  
early decision wanted e.g. to inform investment

happy for decision to be delayed

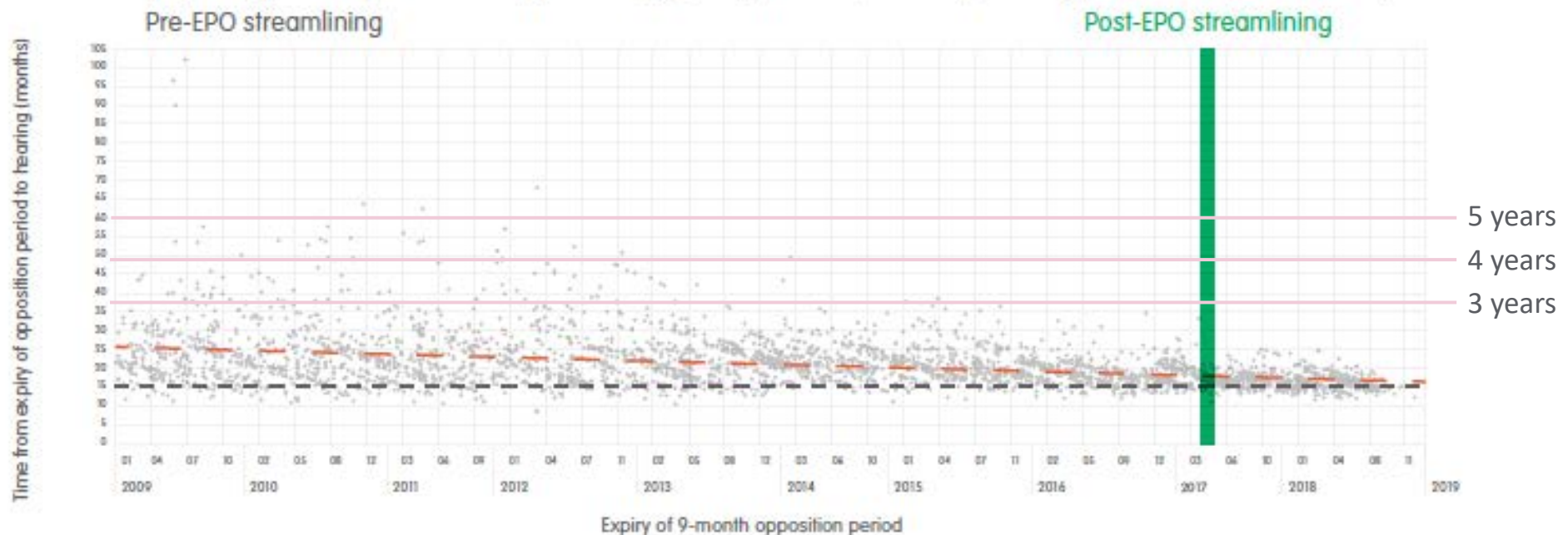
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# Looking forward

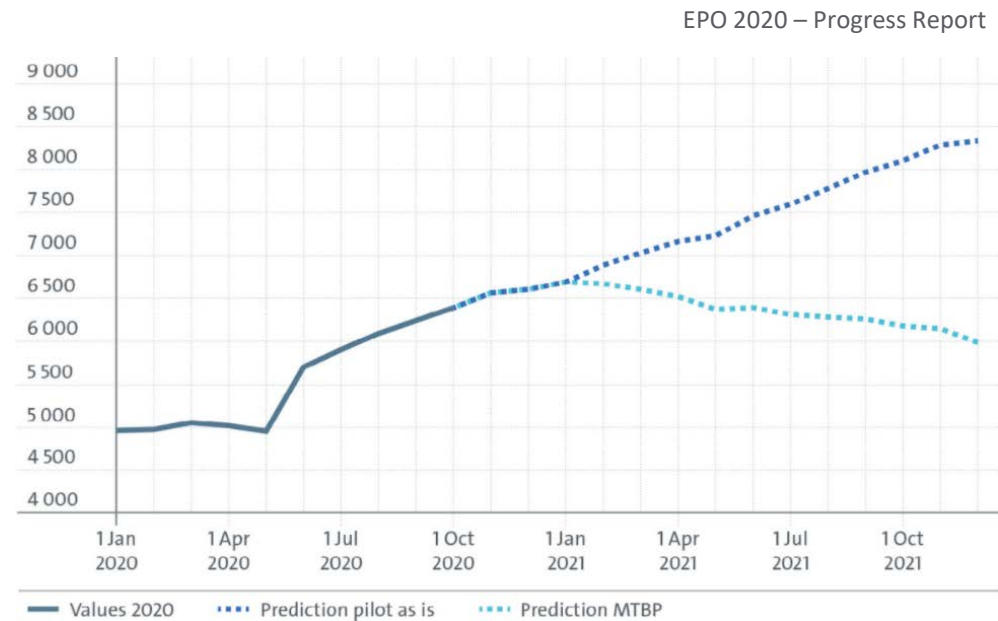
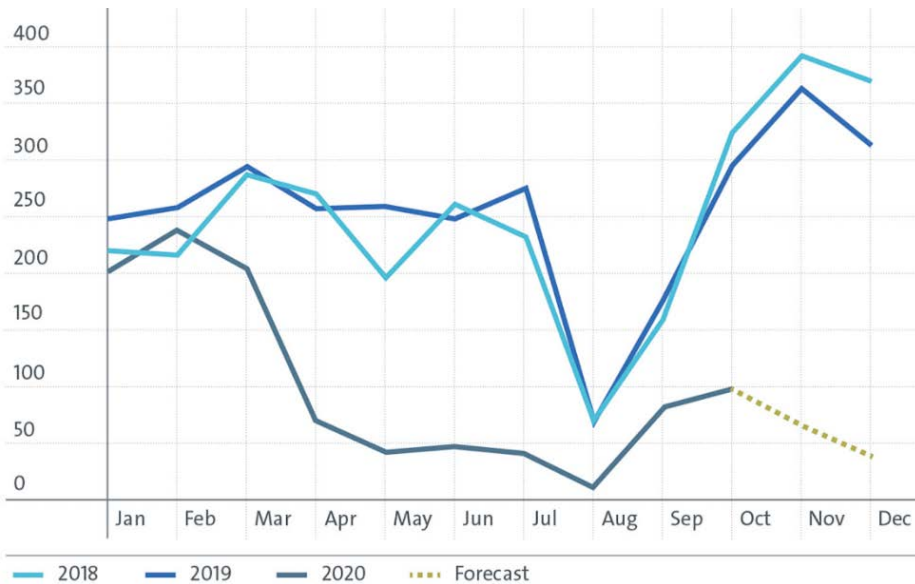
- The EPO has put itself under pressure to hear opposition cases quickly, with as stated target of 15 months from expiry of opposition period to OPs
- Was (*was!*) on track to meet this target soon

Time from expiry of opposition period to oral proceedings (all oppositions, including multi-opponent cases; 2009-2018)



# Looking forward

- EPO Progress Report shows that much of this progress is being undone



- Increasing the number of opposition hearings to **360 per month** for 2021 will deal with the backlog created during the pandemic by 2022

# Where are we now?



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1 April 2020  
Exam Division OPs by ViCo as default

**All ED hearings by ViCo – likely permanent**

14 April 2020  
Announcement of pilot project for ViCo Opposition Division OPs – all parties must consent to ViCo

OD OPs by ViCo pilot

**BoA will do as they please**

5 May 2020  
No in-person OD OPs to 1/6/20

**All OD hearings by ViCo till *at least* 31 Jan 2022**

21 May 2020  
No in-person OD OPs to 14/09/20

**Lots of hearings 2021, 2022...**

29 July 2020  
No in-person OD OPs to 31/12/20

10 Nov 2020  
No in-person OD OPs to 15/09/21, pilot extended

OD OPs by ViCo pilot

Requirement for consent to ViCo removed

17 June 2021  
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OD OPs by ViCo pilot

OD = Opposition Division  
OPs = Oral Proceedings / hearings

# Looking forward

- Easier to involve scientists in Examining Division hearings
- EPO website has lots of helpful information
  - Frequently Asked Questions (FAQs) page
  - EPO e-course - includes videos of mock OPs
  - Technical guidelines for system requirements (internet bandwidth, camera)
- Watch a ViCo hearing as a member of the public
  - EPO calendar
  - Time difference might be awkward...
- Send us any questions

# ViCo vs in-person based on our collective experience so far

- ViCo hearings seem to take longer – lots of checking, breaks
  - More tiring in some ways, less in others
  - More adjournments? Request extra day if case is large / complex?
- People behave differently in virtual setting compared with IRL
  - Be aware of this if you are on-screen (member of party) even if not presenting
  - Especially if you have forgotten to mute...
- Communication between dispersed team members
  - Bigger teams may be appropriate
  - Team members off-screen (member of public) may be valuable
- General agreement: once it gets going, ViCo feels like an in-person EPO hearing



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Thank you for listening

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Chris Denison

July 2021

- Mewburn law and practice library: [www.mewburn.com/law-practice-library](http://www.mewburn.com/law-practice-library)
- Mewburn ViCo page: [www.mewburn.com/law-practice-library/video-conferencing-of-interviews-and-oral-proceedings](http://www.mewburn.com/law-practice-library/video-conferencing-of-interviews-and-oral-proceedings)
- EPO regularly updated COVID-19 information page: [www.epo.org/news-events/covid-19/oral-proceedings-examination-opposition.html](http://www.epo.org/news-events/covid-19/oral-proceedings-examination-opposition.html)
- Information on technical requirements, test calls: [www.epo.org/applying/online-services/proceedings/technical-guidelines.html](http://www.epo.org/applying/online-services/proceedings/technical-guidelines.html)
- Frequently asked questions: [www.epo.org/service-support/faq/procedure-law/oral-proceedings-by-videoconference.html](http://www.epo.org/service-support/faq/procedure-law/oral-proceedings-by-videoconference.html)

- Information on attending videoconference oral proceedings as a member of the public: [www.epo.org/applying/online-services/proceedings/public-access.html](http://www.epo.org/applying/online-services/proceedings/public-access.html)
- Information on EPO Boards of Appeal oral proceedings during the pandemic: [www.epo.org/law-practice/case-law-appeals/communications/2020/20200729.html](http://www.epo.org/law-practice/case-law-appeals/communications/2020/20200729.html)
- Announcement 15 December re OPs and ViCo: [www.epo.org/law-practice/case-law-appeals/communications/2020/20201215.html](http://www.epo.org/law-practice/case-law-appeals/communications/2020/20201215.html)
- Mewburn report on EPO Opposition Trends in the Life Sciences Sector: [www.mewburn.com/news-insights/new-report-launched-epo-opposition-trends-in-the-life-sciences-sector](http://www.mewburn.com/news-insights/new-report-launched-epo-opposition-trends-in-the-life-sciences-sector)



- EPO training materials on oppositions by videoconference: [e-courses.epo.org/course/view.php?id=196](https://e-courses.epo.org/course/view.php?id=196)