

EPO Examination Oral Proceedings

The examination procedure in European patent applications is primarily conducted in writing. However, all applicants have the right to be heard in oral proceedings. This can be a very useful procedure if the progress made in written correspondence is unsatisfactory. This briefing note provides an overview of such oral proceedings.

Every European patent application is assigned to a group of three examiners, called an examining division, for examining the application and deciding whether it should be allowed or refused. In most cases this procedure is carried out in writing and is entrusted to just one of the members of the examining division, known as the Primary Examiner. If the Primary Examiner believes there are any grounds for objection to the application he or she will issue a written examination report setting out the objections with a deadline for responding to them in writing. The applicant's representative can then respond either by amending the application to overcome the objections, arguing that the objections are not valid, or a combination of the two.

However if, after one or two rounds of this written procedure, the Primary Examiner has not been persuaded to allow the application, and the applicant has previously requested them, Oral Proceedings before the examining division will be appointed. This is an opportunity for the applicant's representative to put their case in person, in front of all three members of the examining division, before a decision to refuse the application is made.

Prior to attending the oral proceedings it is usually advisable to file arguments against the objections in writing, together with a series of amendments to the claims as fallback positions, known as "auxiliary requests" in case the examining division maintains its objections even after it has heard the oral arguments. Sometimes these further written arguments are sufficient to persuade the examining division to grant the application. It is also common, particularly as the date of the hearing approaches, for the representative to negotiate informally with the Primary Examiner with a view to reaching agreement to avoid the need for the oral proceedings to go ahead. Thus even if Oral Proceedings are appointed it is not necessarily the case that they will take place.

If they do take place the Oral Proceedings will usually be held at one of the buildings of the European Patent Office in Munich or in The Hague, but they are also sometimes held in Berlin. The opportunity to present the arguments orally can be particularly useful if the arguments are quite subtle, or if the examining division has not been able to fully understand either the invention or the prior art from the written correspondence alone. It also ensures that the members of the examining division other than the Primary Examiner play an active part.

After discussing the objections and hearing the arguments, the examining division will take a recess in which it decides whether or not it has been convinced by the oral arguments. If the division has been convinced then the oral proceedings will be closed and a patent will be granted in due course. If the division has not been convinced then each of the fallback positions will be discussed and decided upon in turn. This process will continue until the examining division is prepared to allow one of the fallback positions, or until there are no more fallback positions to consider. If the examining division is not prepared to allow anything then the patent application will be refused.



If, at the end of oral proceedings, the examining division has not allowed the scope of protection to which the applicant believes it is entitled (even if it did agree to grant a narrower scope) it is possible to file an appeal against the decision of the examining division. If an appeal is filed then an independent Appeal Board will consider the arguments again and will decide whether or not to uphold the decision of the examining division.

Every applicant before the European Patent Office has the right to Oral Proceedings before an adverse decision is taken against them but this right must be requested in advance and thus we routinely make a request in the first written response. This avoids the possibility of a summary refusal of the application and allows time to negotiate an acceptable outcome either before or at the hearing.

Further advice

If you would like any further advice in relation to EPO Oral proceedings then please contact one of our Patent Attorneys using the details below.

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