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 primarily dealt with by 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 (or their 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 the Examining Division has not been persuaded to allow the application after one or more rounds of this written procedure, and if Oral Proceedings have previously been requested, then the Examining Division may summon the Applicant to Oral Proceedings to discuss the case. This is an opportunity for the Applicant (or their 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 Applicant (or their representative) to discuss the case informally with the Primary Examiner with a view to reaching an agreement such that Oral Proceedings can be avoided. Thus, even if Oral Proceedings are appointed it is not necessarily the case that they will take place.

If Oral Proceedings are held they 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. The use of Oral Proceedings also helps ensure that all three members of the Examining Division play an active part in making the decision.

After discussing the objections and hearing the arguments, the Examining Division will typically 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 does not allow the scope of protection to which the Applicant (or its representative) has argued it is entitled, 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 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 attempt to negotiate an acceptable outcome, either before or at the hearing.

**Further advice**

If you would like any further advice please contact us at Dehns using the details below.