

Kluwer Patent Blog

Will the EPO still be normal under the „New Normal“?

Thorsten Bausch (Hoffmann Eitle) · Thursday, April 15th, 2021

The European Patent Office has invited its users and stakeholders to take position on the first draft of its „Towards a new normal“ orientation document.

My experience with such public consultations in the recent past has not been particularly encouraging. It seems to me that outside views are simply collected and then moved into a more or less inaccessible folder somewhere in the EPO's infamous „*complex IT systems with its ,spaghetti structure“*“ consisting inter alia of an „*outdated and unreliable data centre in The Hague*“ and a *PHOENIX Image Archive mainframe* that apparently recently „died“. *RIP*. Perhaps you may think this must clearly be an exaggeration by this blogger. However, as it happens, reality beats fantasy: Just listen to the very same Senior EPO Insiders one more time, who recently summarized the state of their IT system in the following words:

“The shock came when we started to look inside the machinery. It is scary when the technology you have in front of you is from a time when you were still in school, and the people who can help you have long since retired.”

There we are. So when it comes to public consultations, there is apparently bigger fish to fry than the processing of outside opinions on Rules of Procedure of the Boards of Appeal, Oral Proceedings by Videoconference and other stuff. The results of such consultations usually never see the light of the day again, and their impact, if any, is negligible at best. So, for what it's worth, I will summarize a few thoughts on the EPO's New Normal in the following, rather than sending them to the EPO via the official one-way-street channel. Of course, the EPO's consultation officials are very much welcome to read and consider the following together with any comments that other readers of this blog will hopefully add.

What will the EPO's “New Normal” look like?

If only I knew. In my humble opinion, the EPO's draft leaves more questions open than it answers. The language used throughout this document is woolly at best, occasionally suspiciously close to the language used in the infamous communications of the Ministry of Truth in Orwell's 1984. If communication is meant to be “the act of developing meaning among entities or groups through the use of sufficiently mutually understood signs, symbols, and semiotic conventions” (Wikipedia), I would give this document a 2 of 10 max. But perhaps the development of “meaning” was not in the first place what was intended. Having said that, there are at least a few trends that deserve

closer consideration.

Extended Teleworking Scheme

The EPO's planned "New Normal" seems to provide a (much?) extended teleworking scheme. It was presented as a reflection of the results of a staff consultation wherein many allegedly expressed a preference for teleworking, at least to some extent. However, without knowing the precise questions put to staff it is of course difficult to draw sound conclusions from the results of such a consultation. For example, were the questions just limited to "are you in favour of more/less teleworking in general?", or was a price tag attached to it, e.g. "would you accept a lower salary when teleworking from your home country where the costs of living are lower than in Munich/The Hague?" – I may be wrong, but I would not be surprised if the answers were considerably different when staff are confronted with the full consequences of an extended teleworking scheme, at least if this extended scheme is supposed to have a significant impact on the EPO's future building policy and if this policy is to be based – as it seems to be the case – on "the fact that an estimated 50% of staff on average may be on site on any given day." Only 50%? And is this a "fact" or just an "estimate", "assumption" or even "target"? In any case, if this will be the new normal, many staff will probably have to say farewell to their own office space and will have to live with open plan offices.

I am also a bit worried about the consequences of a much extended teleworking scheme on the functioning of the examining and opposition divisions in the future. At least in my mind, which is probably a bit on the idealistic side, these divisions were originally supposed to sit together and thoroughly discuss the case before them until they have reached the best possible result. In view of the EPO's declared top priority, i.e. quality, this would make a lot of sense to me but it requires that the members of these divisions have the necessary time and opportunity for a thorough discussion. If they are not sitting in the same location, there is a high likelihood that such discussions will be cut short, will be made even more subject to a strict time budget, and that any informal conversation about critical questions of a case will no longer take place, or will at least be reduced in frequency and intensity. I cannot imagine that extended teleworking will be good for the quality of the decision process of a panel. The ultimate outcome of the decision will depend even more than ever on the quality of the preparation of the case by the first examiner. Which raises the question why the EPO has "Examining Divisions" at all, rather than just individual examiners who grant patents or refuse applications. If the underlying rationale of an Examining Division is that three pairs of eyes see more than one, then the other two pairs of eyes should be given the necessary time for a thorough review of the case and the opportunity of an open and thorough discussion within the panel, which cannot always be organised in terms of the usual 0.5 or 1 hour intervals of a Video Conference. Mixing members of an ED or OD from different locations is no good idea and has never been one.

Conversely, I can see a case for more teleworking during the "quiet time" that examiners need in order to read documents, conduct a search and/or write a decision or communication. The challenge for the EPO management will be to find an intelligent mix of teleworking and working in the office that also takes the individual situations and preferences of staff into consideration. Not everybody has a quiet place at home from which high-quality teleworking is possible. I hope that staff representatives will be fully included and involved in this important discussion.

Another aspect of an extended teleworking scheme is its compatibility with Art. 6(2) EPC.

The European Patent Office shall be located in Munich. It shall have a branch at The Hague.

When the EPO is “virtualized” and physically emasculated to a degree of (more than?) 50%, will the residual EPO still be “located” in Munich/The Hague? Debatable, but at least one thing is clear: the EPO’s New Normal also has legal and political implications for the European Patent Organisation’s member states.

Looking at the EPO’s planned New Normal from a user’s perspective, a similar point arises. In my view, 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 – the acts must be performed in Munich (including Haar), The Hague, Berlin or any other location where the EPO has an approved branch office. This follows from the principle of legitimate expectations. Just as an aside, this is not only my opinion. I have happily borrowed this sentence from the Enlarged Board of Appeal (G 2/19, last paragraph of the reasons). Delocalizing examining and opposition divisions and their decision processes does not seem to me to be in compliance of this EBA decision.

Oral Proceedings by ViCo

This blog is already long enough, so let me only make two brief points:

First, a point of procedure. Readers are of course welcome to submit their comments on the New Normal to the EPO by the deadline of 16 April 2021. However, it will probably more effective and impactful to voice your views on this particular subject by way of an Amicus Curiae brief to the Enlarged Board of Appeal in case G 1/21, where the following referral question will (hopefully) be discussed and answered:

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 Enlarged Board of Appel will accept comments by April 27, 2021 according to [this note](#).

Second, on the merits, I firmly oppose the conduct of oral proceedings by ViCo against the will of a party to the proceedings. Where all parties request or are at least happy with Oral Proceedings by Videoconference (and yes, there can be good arguments for that, e.g. efficiency, saving time and resources etc.), nothing speaks against using this option or even “hybrid” proceedings. *Volenti non fit iniuria*. However, I do not think that Oral Proceedings by ViCo should be the “New Normal”. They can be a further valuable **option** for the parties of the proceedings, if so requested, but parties should not be forced to use this option in the absence of absolutely compelling reasons (such as a pandemic). The default and “new normal” when the pandemic is over, should be the good old normal, i.e. classic oral proceedings in person. In my opinion, parties to the proceedings have a fundamental procedural right to appear in person in public oral proceedings before the deciding body, if they so wish.

If you were to share this opinion, you would find yourself in excellent company. VESPA, the Federation of European and Swiss Patent Attorneys, have already filed their Amicus brief, available [here](#) and I have heard that Siemens AG and epi are about to file at least one as well. Have your say!

Conclusion

So it seems the EPO are planning a significant overhaul of the old normal and whilst I welcome change if fair and well implemented, it appears this will not be the case in many of the New Normal plans. Another example of this in the EPO's move towards a more digital world is the recent e-EQE. Yes, some candidates in the pre-pandemic era had requested that the EQE be conducted on computer, but I do not believe it was their wish that the EQE be conducted through a program on the brink of collapse and where the exam papers (seemingly) had not been adapted at all to the new format. When EQE candidates have to spend a considerable part of their scarce exam time for scrolling up and down documents because the EQE program does not allow for a split screen but neither were they allowed to print out most of the exam materials, such an exam does not make candidates "fit for practice", but at best nervous and at worst desperate. Fortunately, as reported on [IPKat](#), it seems that at least epi has understood that the current exam format has its deficiencies. This is a good start, but as always, care must be taken for the detail when implementing changes to a running system. On the whole, when drawing up plans for a New Normal, perhaps the EPO should carefully consider the impact of such changes and if the totality of such changes are really what people have asked for.

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