

Revision of the Rules of Procedure of the Boards of Appeal of the EPO

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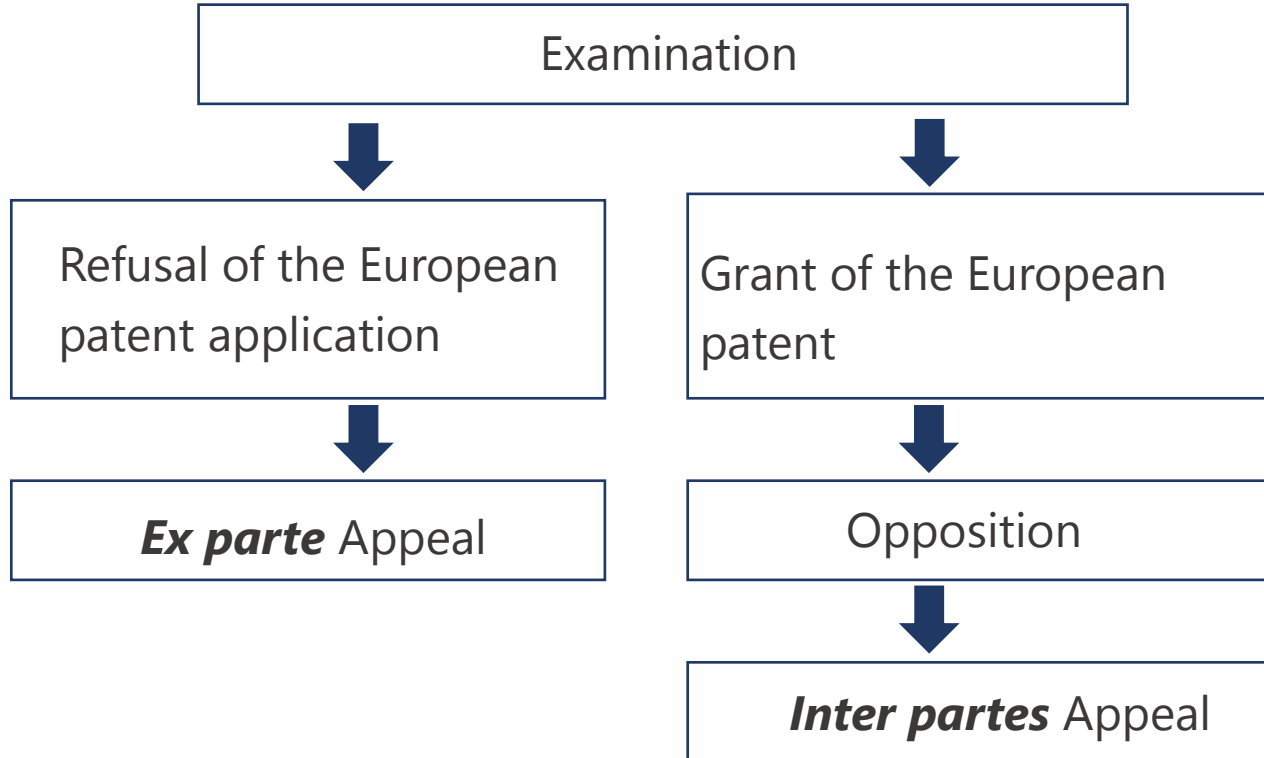
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Technical Expertise:

- semiconductor technology
- process technology
- memory technology
- physics of solid state
- magnet and superconductivity technology
- automotive engineering
- sensor-/actuator technology and fluid technology

1. Introduction – Types of Appeal



1. Introduction – Procedural Aspects

- Appeal proceedings are separate and independent from grant/opposition proceedings
- Principal function: give a judicial decision on the correctness of the earlier decision issued by the examining/opposition division
- Appeal proceedings are not restricted to a judicial review but also involve the examination of the procedural and patentability requirements in the preceding proceedings, however, to a limited extent
- In their decisions, Board members are not bound by any instructions and have to comply only with the provisions of the European Patent Convention (court status)
- Legal framework in Art. 108 to 111 EPC, Rules 99 to 103 EPC and Rules of Procedure (legitimated by Rule 12c EPC)

1. Introduction – Revised Rules of Procedure (RPBA)

Aim is: - to more strictly regulate the appeal proceedings and limit their substantive extent in order to expedite the proceedings

Status Quo: - huge backlog (appr. 9000 cases pending on Dec. 31, 2018)
- increasing number of appeals („early certainty“ quality ?)
- long duration (appr. 2 – 3 years)
- insufficient manpower (Boards and technical members)

1. Introduction – History of the Revision (RPBA)

The revised Rules of Procedure of the Boards of Appeal (RPBA):

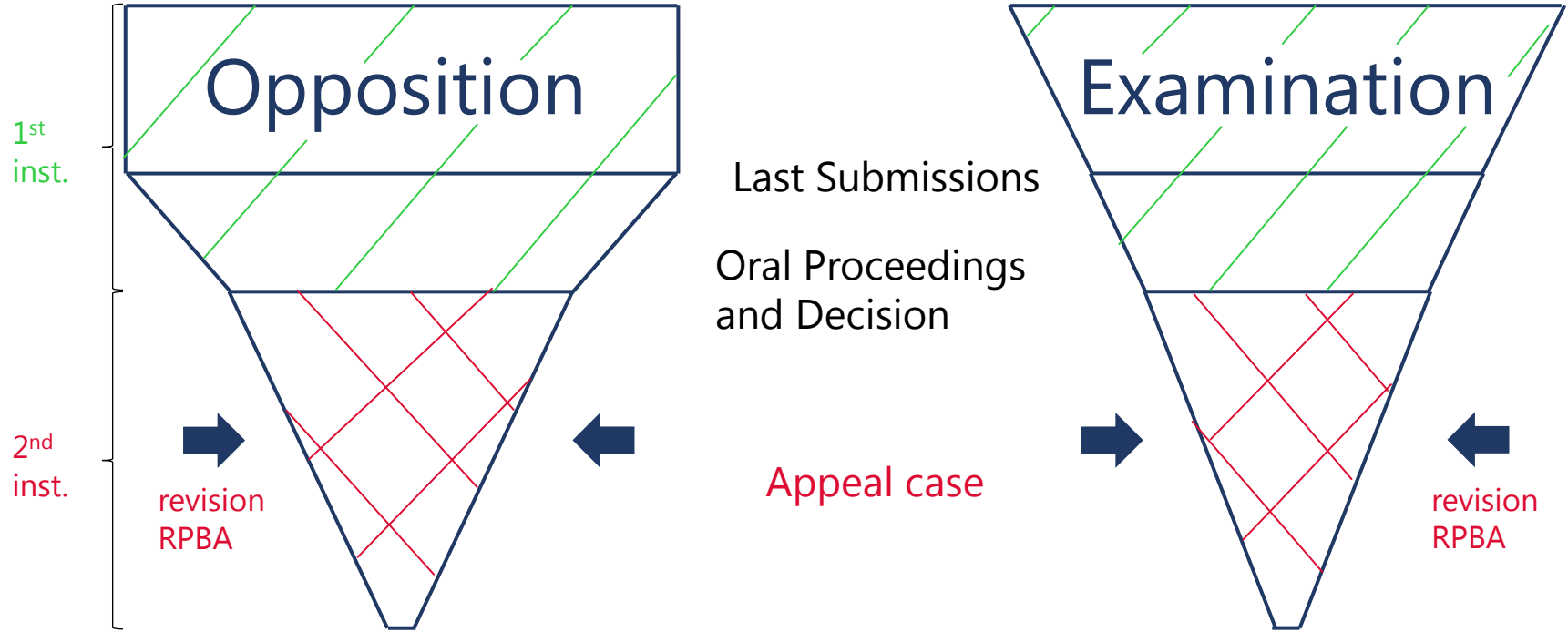
- were intensively discussed at the “user consultation conference” on October 9, 2018 with users of the system, but were hardly changed afterwards
- were adopted by the Boards of Appeal Committee on April 4, 2019
- were unanimously approved by the Administrative Council at its 160th meeting on June 26 and 27, 2019
- will come into force on January 1, 2020
- will, in general, apply to **any appeal pending on, or filed after, January 1, 2020** (see Article 25(1) RPBA)

1. Introduction – Objectives of the Revision

Improvement of Appeal Procedure with respect to:

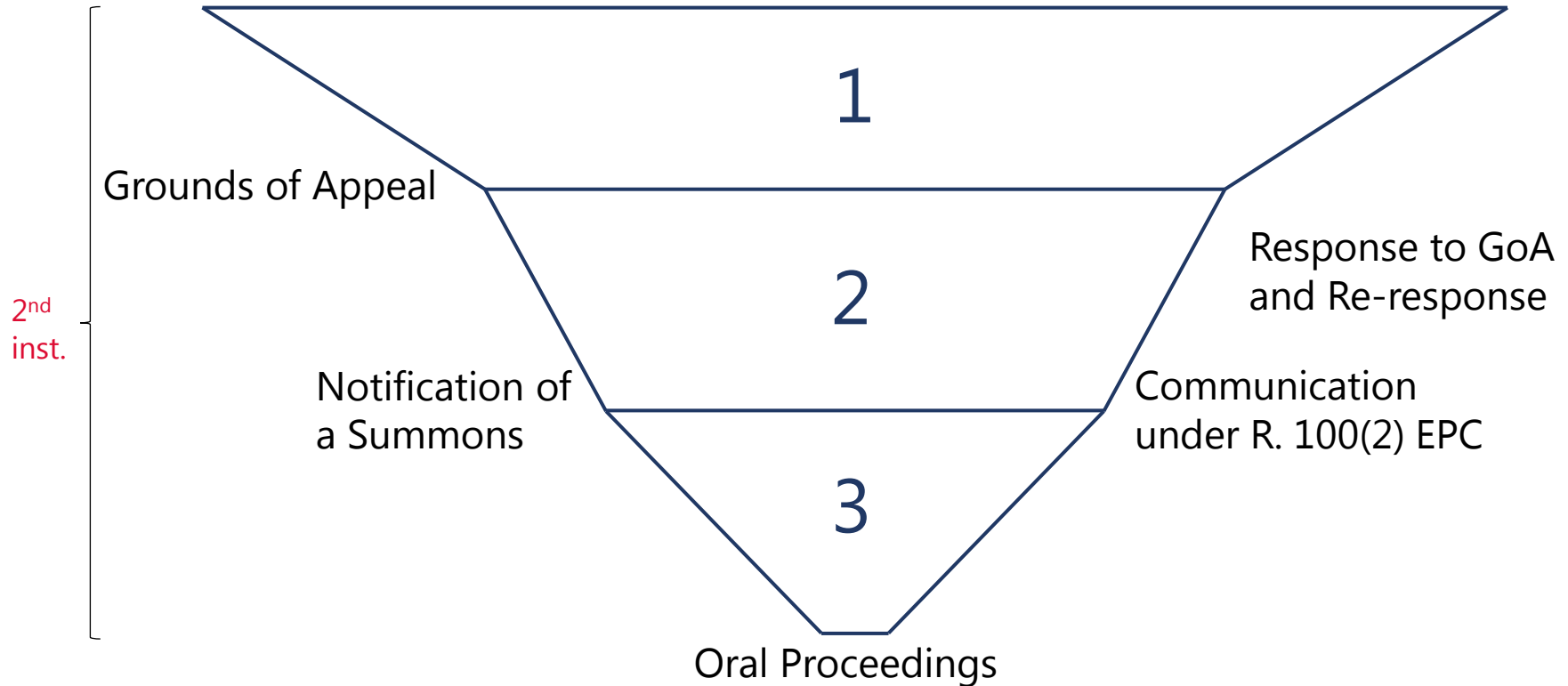
- Predictability / transparency
 - List of cases to be dealt with by the Board within next year (Art. 1 (2))
 - Mandatory Board communication before oral proceedings (Art. 15 (1))
 - Provisions for what is admissible at which stage of appeal (Art. 12 and 13)
- Consistency
 - Codification of the main line of case law on „change of a parties case“ (Art. 13) and the Boards' discretion (Art. 12(4))
- Efficiency / duration
 - Reducing the number of issues to be dealt with in decision (revised Art. 12 and 13)

2. Convergent Approach – Opposition vs. Examination

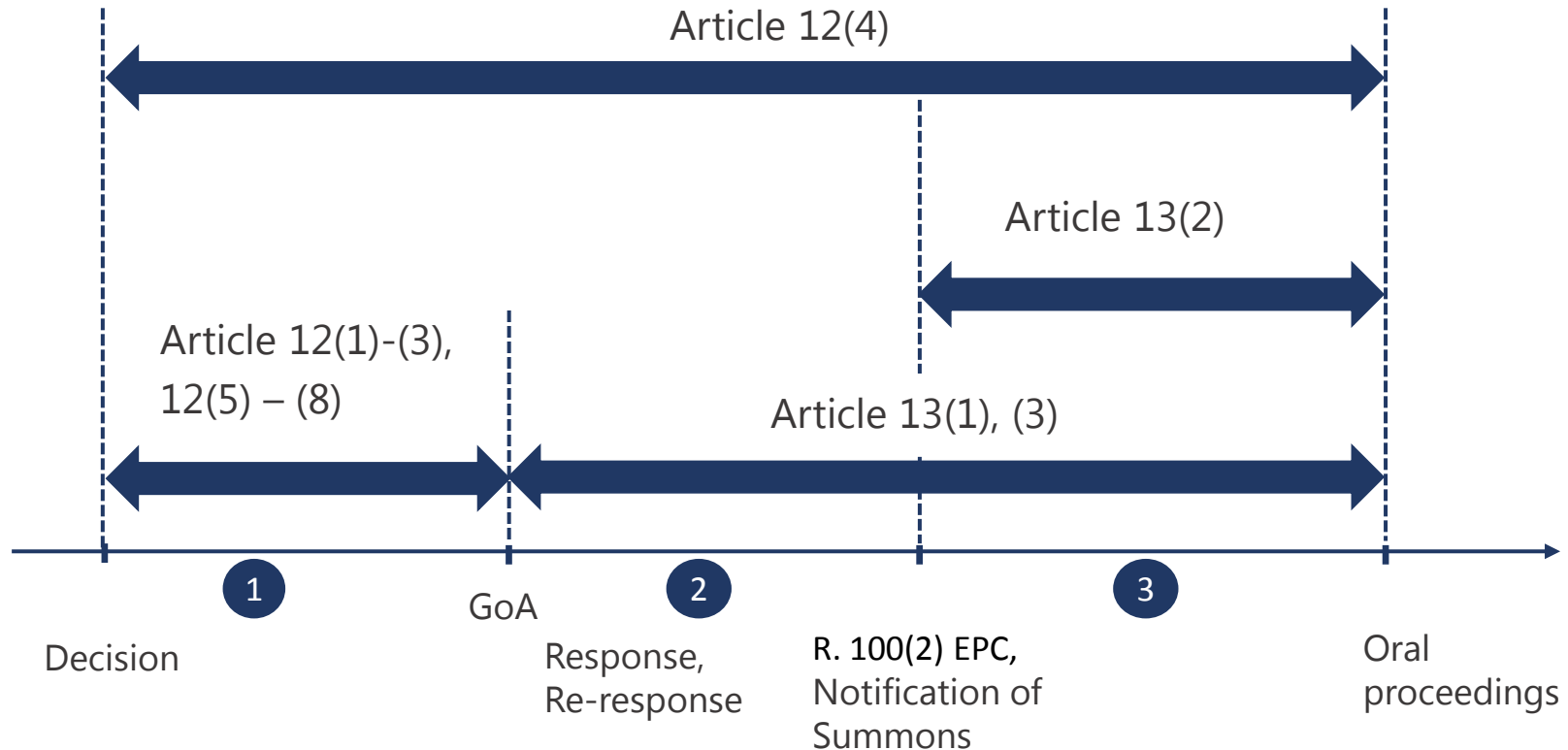


2. Convergent approach – Revised stages of an appeal case

Decision of Opposition/Examination



3. Applicability of revised RPBA to 1st, 2nd, 3rd stage

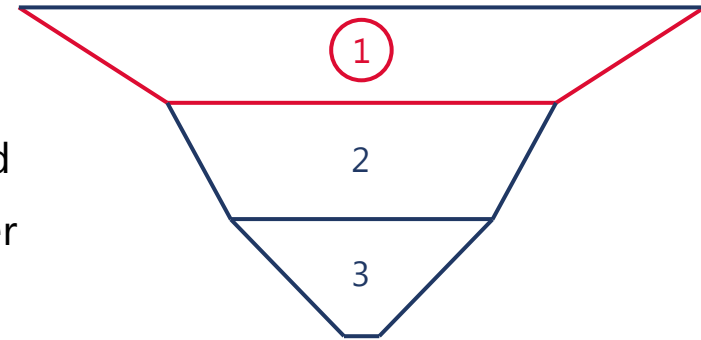


3.1 Basis of appeal proceedings– 1st stage (Art. 12)

Appeal proceedings are now explicitly based on (Art. 12(1)):

- the decision appealed;
- the minutes of any Oral Proceedings of 1. instance;
- a party's notice of appeal and its substantive case;
- any written reply if more than one party is involved; and
- any communication issued by the Board and any answer
- minutes of any video or telephone conference with the party/parties held in appeal proceedings

A party's appeal case shall be directed to the requests, facts, objections (e.g. "line of attack and arguments") and evidence on which the decision under appeal was based. (Art. 12(2)) to form of a complete case (Art. 12(3))



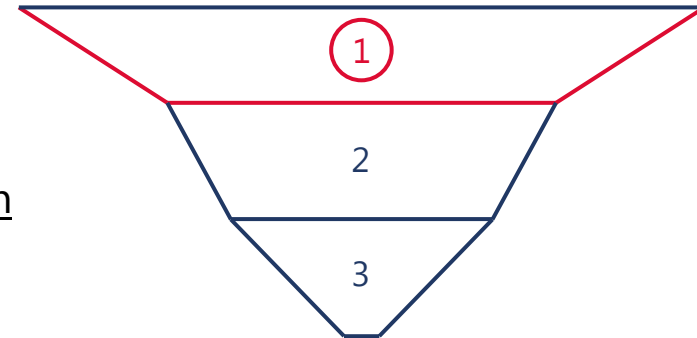
3.1 Basis of appeal proceedings– 1st stage (Art. 12)

Anything else is considered an amendment,

unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal or **unless** the decision excluded it under erroneous discretion or **unless** the circumstances justify the admittance

Admittance of any amendment is subject to the discretion of the Board. (Art. 12(4) RPBA)

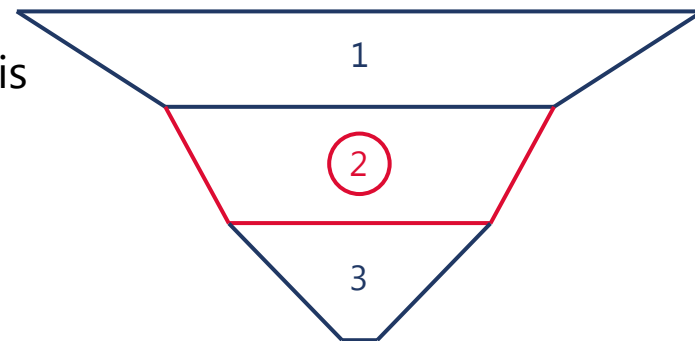
- The Board may take into account inter alia:
 - whether the amendment is suitable to resolve the issues concerned
 - its complexity
 - whether the amendment complies with procedural economy



3.2 Amendments– 2nd stage (Art. 13 (1), (3))

After filing the Grounds of Appeal or after the response thereto (term 4 + 2 months):

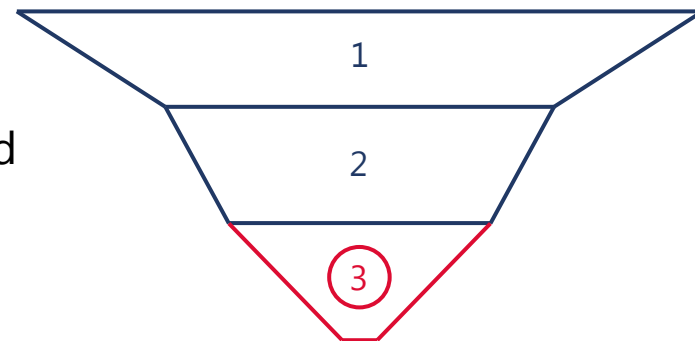
- The Board further takes into account:
 - justification for submitting the amendment at this stage is provided;
 - suitability to resolve issues raised by other party or Board
 - the amendment is detrimental to procedural economy;
 - the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party or by the Board and does not give rise to new objections.



3.3 Amendments – 3rd stage (Art- 13 (2))

After a period specified by the Board (R. 100(2) EPC) or notification of the Summons to Oral Proceedings:

- any amendment shall, in principle, not be taken into account unless under exceptional circumstances, and
- cogent reasons are provided, additionally to criteria as of Art. 13(1) RPBA, e.g.:
 - the Board or the other party raised an objection for the first time in a communication.



3.4 Amendments- Transitional provisions

Article 25(2) and (3) apply to the 1st and 3rd stages of the appeal proceedings:

- New Article 12(4) to (6) RPBA in the 1st stage will not apply to any Grounds of Appeal or response thereto where the GoA was filed before 1 January 2020.
 - everything presented shall be taken into account by the Board (old version of Art. 12(4) RPBA) if and to the extent it relates to the case and fulfills requirements of old version of Art. 12(2) RPBA
- Likewise, new Article 13(2) RPBA in the 3rd stage will not apply if the Summons or the Communication under R. 100(2) EPC was notified before 1 January 2020.
 - amendments not admitted, if the amendments raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the Oral Proceedings (old version of Art. 13 RPBA)

4. Further changes – Issuing communications

New Article 15 RPBA recites that the Board:

- shall issue a communication drawing attention to matters that seem to be of particular significance for the decision to be taken and
- may also provide a preliminary opinion at least 4 months in advance of the date of the Oral Proceedings
- a change of the date fixed for Oral Proceedings may be allowed under serious reasons, such as illness, serious family matters, civic duties, holidays or business trips which have been firmly booked before notification of the Summons

4. Further changes – Abridged decision

- According to new Art. 15(7) RPBA, the reasons for the decision, or parts thereof, may, with the explicit consent of the parties, be put in writing in abridged form, where the decision on the appeal has been announced orally, **unless** a third party or a court has indicated to the Board a legitimate interest in the reasons of the decision
- New Art. 15(8) RPBA even does not require the explicit consent of the parties and is not limited to decisions announced at Oral Proceedings:

“If the Board agrees with the finding of the department which issued the decision under appeal, [...] the Board may put the reasons for its decision in abridged form in respect of that issue.” (new Art. 15(8) RPBA)

4. Further changes – List of cases

New Article 1(2) RPBA requires that, each year, a list of cases will be drawn up and published, on which Boards are likely:

- to hold Oral Proceedings,
- to issue written decisions, or
- to issue communications seeking responses from parties.

The list of cases for 2020 has been published on 10 October 2019.

4. Further changes – Remittal

New Article 11 RPBA aims to limit remittal by specifying that the Board shall not remit a case for further prosecution **unless** special circumstances present themselves for doing so, such as fundamental deficiencies in 1st instance.

- Reduces ping-pong effect
- Applies only for remittals for “further prosecution”
- If all issues can be decided without “undue burden”, normally no remittal

4. Further changes – Acceleration

New Article 10(3) RPBA gives the Board the discretionary power to decide on a party's request for acceleration.

The request shall contain reasons such as:

- that infringement proceedings have been brought or are envisaged, or
- that the decision of potential licensees of the patent in suit hinges on the outcome of the appeal.

New Article 10(5) RPBA gives the Board the discretionary power to accelerate the appeal on its own motion.

Important Conclusions for Parties

- 1st instance should include all strategic requests and arguments
- Do not drop any requests or argumentation lines during the 1st instance possibly needed in appeal
- Check minutes of 1st instance carefully
- For defective or incomplete minutes a correction request should be filed (attorney should draft own minutes for cross-check !)
- Enhanced costs and time efforts in 1st instance
- Divisional applications will gain more importance

“The future depends
on what you do today ”

by Mahatma Gandhi

Important Conclusions for Parties (cont.)

- Much stricter requirements for reasoning GoA and for later amendments in appeal procedure
- All possibly needed requests and arguments should be filed with GoA
- Pending appeals may encounter unexpected problems (transitional provisions)
- Formality issues dominate appeal proceedings in future
- Substantive issues will only be subordinate

"The future depends
on what you do today "

by Mahatma Gandhi

Personal Critical Opinion

- Acceleration of appeal procedure **compromises** fairness towards the parties and legal right to be heard because of limited rights to present the case
- Applicants/Patentees **pay** for acceleration with time pressure and higher fees
- Acceleration **could** also have been achieved with a increased number of technical Boards and technical members (rapporteurs) under more moderately revised RPBA, especially Art. 12 and 13
- EPC Provisions for proof/correction of defective minutes in all instances are still **lacking**
- EPC **sinks** deeper and deeper into a formalities swamp



More details can be found under:

<https://www.epo.org/law-practice/case-law-appeals.html>

Thank you for your interest !

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