



European Patent Institute · Bayerstrasse 83 · 80335 Munich · Germany

Mr Carl Josefsson
President of the EPO's Boards of Appeal
Bob-van-Benthem-Platz 1
80469 München

07.09.2017

Re: Revision of the Rules of Procedure of the Boards of Appeal at the EPO

Dear Sir,

epi is the representative and disciplinary body for all those entered on the list of Professional Representatives before the EPO established under Article 134 EPC (commonly known as European patent attorneys). The vast majority of those who represent applicants, patent proprietors and opponents before the Boards of Appeal at the EPO are members of **epi**. **epi** therefore has a significant interest in the purport and the wording of the Rules of Procedure of the Boards of Appeal ("RoPBA").

epi is aware that the Board of Appeal Committee ("BOAC") of the Administrative Council ("AC") will be meeting in early September in order to consider the RoPBA. In its considerations, the Committee may wish to take advantage of **epi**'s extensive experience with EPO appeal procedures. Therefore, and in view of its own great interest and the interest of the users which it represents, **epi** would be pleased to assist in the further development of the RoPBA, as expressed in this letter.

epi believes that any changes in the RoPBA should aim at maintaining high quality of appeal decisions as well as independence of the Boards, but also at enabling the Boards to increase efficiency of appeal proceedings and reduce total pendency time. However, rules and practices of appeal procedures directly correlate with the rules and practices of the first instances (Examining Divisions, Legal Division and Opposition Divisions) whose decisions give rise to appeals and, as a consequence, meaningful improvements in appeal procedures

President • Francis Leyder

epi Secretariat · Bayerstrasse 83 · 80335 Munich · Germany
Phone +49 89 242052-0 · Fax +49 89 242052-20
president@patentepi.com
info@patentepi.com · www.patentepi.com

should be accompanied by corresponding adjustments in the first instance practices. This would apply in particular to opposition procedures.

The principles which **epi** sees as essential for the RoPBA and any amendments thereof are that:

- (i) the Boards act as instances of appeal, not tribunals to hear new cases:
 - this implies that new facts, evidence and requests can be introduced only if convincing reasons are provided for their late filing. Thus, criteria should be defined when late filings can be accepted (relevance and solid reasons justifying late filings); and
 - this implies on the other hand that the appeal is not a purely legal review;
- (ii) case management ensures timely and effective consideration of appeals:
 - this includes a clear time schedule for the Board and the parties and an early and mandatory preliminary opinion by at least one member of the Board – a significant reduction of the pendency of the average appeal should be the ultimate goal;
- (iii) there is consistent procedural practice across all Boards:
 - this applies especially to the application of criteria for the admissibility of evidence and requests filed after the opposition proceedings or after the start of the appeal;
- (iv) the way in which the Boards are constituted encourages cross-fertilization between the Boards; and
- (v) transitional provisions that ensure that there are no detrimental effects to pending proceedings have to be provided.

It is important that any major change of the RoPBA will not be effective for pending cases where, under the presently valid Rules, there are still opportunities to react, if these are not available under the proposed new Rules.

In the Annex, these principles and their background are further elaborated.



epi trusts that the comments presented in this letter and in the Annex will assist the BOAC in its work. **epi** would be pleased to explain its comments in more detail in writing or in a meeting, or as an observer in the committee's deliberations.

Yours sincerely

Francis Leyder
President

Heike Vogelsang-Wenke
Vice-President

Copy to Mr Battistelli, President of the EPO.

Enclosure: Annex 1

ANNEX to Letter of epi to the BOAC

In order to discuss the principles set out above, it may be helpful to set out some of the problems which arise from the present practices of the first instances as these affect the way in which the RoPBA could be written.

Appeals under Current Practice

The current appeal practice at the EPO is generally experienced as being of reasonably good quality as to substance. However, a large part of the users feel that the average pendency, which is in the order of three years, is much too long. Also differences in practice, especially in the application of criteria for allowing parties to adjust their case during the appeal proceedings, are considered by many to be too large. As a result, there is room for improvement of the efficiency and predictability of appeal proceedings.

At the same time, it is recognised that part of the reasons for these difficulties resides in the preceding procedure before the first instances of the EPO. Hence, overcoming these difficulties not only requires an adaptation of the appeal practice, but also of the first instance practice, either by direct changes in the first instance practice or by adjustment of first instance proceedings to changed rules for appeal, or both.

One issue with the current practice of the first instances in the EPO is that it is often difficult for a decision to be taken on all the issues which should be dealt with by the first instance. If an Examination Division or an Opposition Division takes the view that a set of claims does not meet one of the formal requirements of the EPC (Articles 83, 84 and 123 and Rule 80 EPC), the application may be refused or the patent may be revoked for failure to satisfy that requirement and, if the applicant or patent proprietor does not file an appropriate auxiliary request, the Division presently does not need to, and typically does not, address any of the substantive grounds (Articles 52-57 EPC). This gives rise to the possibility that the Board to which an appeal is directed may overturn the decision of the first instance and remit the case to the first instance so that the first instance can make decisions on any ground which had not been considered. This clearly is a waste of time as, even with an expedited opposition procedure and an expedited appeal procedure, this can add at least two years to the time needed to resolve the matter. A way of dealing with this issue could be to force the applicant/patentee to file a request overcoming such known formal defect at the first instance and by reducing the admissibility of such requests in appeal; another way would be to encourage (or require, where possible to do so) first instance divisions to also render a (perhaps conditional) decision on the substantive issues where practically possible despite a formal requirement not being met.

This and similar issues burden the appeal proceedings and, moreover, there is also considerable variation in the ways different Boards deal with the questions of which grounds can be considered during an appeal and how to deal with late-filed auxiliary requests and evidence.

With the above in mind, **epi** provides below some commentary on the principles set out above.

Preliminary remark on the coming into effect of changes in the RoPBA

Transitional provisions will be necessary in case RoPBA were to be changed in a major way. The provisions should not be defined by a time period, but should relate to the status of a case. If it will no longer or hardly be possible to introduce evidence and requests in the appeal stage, whereas it was possible to do so under the old rules, the new rules cannot be applied to cases where the time period for filing evidence in an opposition case has already started. A reasonable time for application might be the Summons to Oral Proceedings in first instance.

(i) The Boards as instances of appeal

epi considers that, wherever possible, the Boards should aim to decide primarily whether the decision taken by the first instance was technically and legally correct. In principle, any new evidence filed during the appeal proceedings should only be admissible if it could not reasonably have been filed before, and clearly serves to come to a swift decision.

epi recognises that, in many cases, especially under the present practice, a very strict regime will not be possible and not be desirable. Occasionally the first instance will make a decision which is a surprise to one of the parties. The first instance may take an unexpected view of, for instance, the meaning of a claim, the common general knowledge of a skilled person, the inherent content of a prior art document or the closest prior art for the purposes of inventive step. In such instances, **epi** considers that the party(ies) to appeal proceedings should be able to file new evidence or, in the case of a patent proprietor, new auxiliary requests to address the unexpected situation.

It is within the Boards' discretion to decide on the admissibility of new auxiliary requests and new evidence. In exercising its discretion, the Board will take into account the whole of

the proceedings before the first instance so as to determine whether the decision was unexpected.

epi also considers that criteria regarding admissibility of auxiliary requests and evidence should be different, and these should be distinguished from new arguments. In this respect, the notion “amendment to a party’s case” of Article 13 RoPBA needs specification.

As regards auxiliary *requests*, if a new auxiliary request could and should have been filed in the first instance proceedings, then the Board should refuse to admit it. If the auxiliary request could perhaps have been filed in the first instance proceedings but merely involves striking of a claim, e.g. by combination of an existing independent claim and an existing dependent claim, then that auxiliary request should be admitted at any stage of the proceedings. Also, a new request which does not require any new discussions and clearly allows a swift settlement of the appeal should in principle always be allowed.

As regards new *evidence*, such as new documents or declarations, if new evidence could and should have been filed in the first instance proceedings, then the Board should refuse to admit it. In any event, **epi** considers that the Boards should generally exercise their discretion and admit the new evidence if it deals with an unexpected decision of the first instance or new evidence or argument introduced by the other party (patentee or opponent).

If, in opposition proceedings, any new evidence or document leads to a new line of attack on the claims¹, then this new evidence or document should be excluded from the proceedings unless it is occasioned by the decision or submission by the proprietor or the patent proprietor agrees to its admission. New evidence or documents should not enable an opponent to start a new opposition at the appeal stage, which would frustrate the purpose of an appeal instance.

epi is aware that, occasionally, an opponent will identify a new, novelty-destroying or otherwise highly relevant document which clearly affects the validity of an independent claim. If this is clearly the case, then the Board may admit that document into the proceedings and may order the opponent to pay the proprietor’s costs, especially if the new document necessitates postponement of the proceedings.

¹ It may be that an opponent had unsuccessfully attacked a claim under inventive step using, say, D1 as the closest prior art. This gives rise to a first line of attack. If the opponent then files a new document, say D10, and then uses this as the closest prior art, then the opponent is raising a new line of attack under Article 56. This means that, in appeal, the opponent is not appealing against the decision of the first instance but is instead starting a new opposition. This should not be allowed.

As to new *arguments*, i.e. new lines of reasoning based on the same, already invoked evidence or document, these should normally be allowed at all stages.

(ii) New Case Management System

epi considers that a new Case Management System should be instituted. Once a Board has been constituted² for the case, much of the preliminary work can be carried out by one member (the Rapporteur) without necessarily involving the other Board members until the case is ready for oral proceedings (or for a decision if oral proceedings have not been requested).

For an *ex parte* case under this system, the Rapporteur would study the notice and statement of appeal to determine not only whether the formal requirements for filing an appeal have been met but also to determine whether there are any points in the appeal which require clarification. The Rapporteur would send a communication to the applicant in order to deal with any points which arise during his preliminary review of the case, setting a short deadline (2 months) for responding to the communication. Within 6 months of receiving the statement of appeal, whether or not a communication was sent and whether or not a response was received, the Rapporteur would send to the applicant a summons to oral proceedings together with the Rapporteur's preliminary opinion on the case. **epi** considers that it should be compulsory for the Rapporteur to send out a preliminary opinion, but it should be made clear that it is the opinion of the Rapporteur and that the Board as such may ultimately have a different view. The preliminary opinion should set out in some detail the Rapporteur's views and expected outcome. The applicant has a short period (2 months) for filing any comments on the preliminary opinion. After the period for commenting, the Rapporteur will then brief the other members of the Board so that they are fully prepared for the oral proceedings or for a decision.

For oral proceedings, the present procedure for their conduct can be adopted, except that a person (member of the Board or not) other than the Rapporteur should be assigned to prepare the Minutes. **epi** considers that the Rapporteur should be able to concentrate on the issues being discussed at the oral proceedings and not be burdened with taking the Minutes. **epi** also considers that the Minutes should be much more comprehensive than they are now in light of the fact that there may be a petition for review.

² **epi** considers that a new method for constituting a Board would be beneficial, as set out below.

For *inter partes* cases, **epi** considers that the procedure can be similar in that a Rapporteur can be solely responsible for the initial management of the case. **epi** suggests **keeping** the first part of the present procedure (notice and statement of appeal and opportunity for respondent(s) to respond) but limiting the time for filing submissions to only 4 months and indicating that any such submissions should be in response to the statement and issues raised in the decision. **epi** also suggests adding in a stage of sending any submissions to the opposing parties with a communication inviting the parties to file any further submissions, which should be strictly in reply to any points made by the opposing party(ies) in the submissions, within a short period. Again, the Rapporteur would study all the submissions and may send out a communication identifying any points which he considers to be relevant and setting a short period for filing any submission strictly in reply to the points made by the Rapporteur. The rest of the procedure can be as set out for *ex parte* appeals, except that the Rapporteur should send out the summons and the compulsory preliminary opinion within about 12 months of receiving the first appeal statement. The proposed system is summarised in the following scheme.

Time in months from statement	Action	Time limit
0	Statement of appeal	Art 108, 2 nd sentence
4,5	response of respondent(s)	4 m from notification of statement; no extensions, unless appropriate
7	(last) opportunity for appellant(s) to reply to response of respondent(s)	2 m, no extensions*
8,5	(last) opportunity for respondent(s) to comment on reply of appellant(s)	2 m, no extensions*
10,5	optional communication of Rapporteur indicating points of relevance	
13	(last) opportunity for all parties only to comment on points raised by Rapporteur	2 m, no extensions*
14	report of Rapporteur with preliminary opinion on all aspects of appeal, indication of issues to be discussed in oral proceedings (and of those which need not according to the Rapporteur), summons to oral proceedings at date no less than 4 m and no more than 8 m after report (in a transitional period of reducing backlogs, the 8 m maximum may be flexible)	
16,5	opportunity for parties to comment, only to the issues raised by the Rapporteur	2 m from report*
18-22	oral proceedings oral decision	decision only when Board is ready for it; otherwise shortly after oral proceedings, at the latest with written decision
20-24	written decision	2 m from oral proceedings

*extensions may be granted under special circumstances

epi considers that placing the responsibility for case management primarily with the Rapporteur and shifting most of his preparatory work to a relatively early stage of the appeal proceedings will strongly enhance procedural efficiency and reduce pendency times for the proceeding while maintaining high quality as to substance. Naturally the Rapporteur should be free to consult other Board members if needed at any stage.

(iii) Consistent Practice

epi considers that there should be less discretion in the appeal procedure. **epi** appreciates that the Boards need to be able to take decisions entirely independently of any outside influence. However, it cannot be seen how having a consistent procedure can in any way

fetter the Boards in coming to their decisions. At present, how an appeal proceeds is largely determined by the Board to which the case is assigned and is much less dependent on the RoPBA or on any commonly-accepted practice. This point is also addressed in the next section.

(iv) The Constitution of the Boards

At present, members are not appointed to the Boards of Appeal in general. They are appointed to a particular Board which deals with a limited range of technical fields. The only significant exception to this is that legal members may serve on a (small) number of different Boards. Chairmen and technical Members, on the other hand, serve, except in very exceptional circumstances, on only one Board. This may give rise to a tendency for each Board to develop its own way of conducting appeal proceedings and its own view of the requirements of the EPC. This may lead to divergences in procedure and outcome. At its worst, this can lead to diverging decisions which have to be reconciled by the Enlarged Board. **epi** appreciates that Board members do talk to each other about general matters of procedure and practice but believes that this is not the same as seeing how other Boards work. **epi** believes that the Boards would benefit from a more flexible way of constituting Boards so that there is more opportunity for cross-fertilisation between Board members and therefore more opportunity to ensure that there is a uniform procedure across all Boards.

In this respect, it is noted that the examiners of the first instance are to be assigned to subdivisions (a number of directorates) of three large groups covering chemistry, mechanics and electrics. **epi** recognises that a similar broad assignment of Board members is not desirable, because of the required specialisation of Boards, and perhaps not even possible. However, it would be worthwhile to develop a scheme which allows more fluidity in the composition of the Boards. As a result, there would be more opportunity for members to exchange best practices and to share the results within different Boards. To this effect, **epi** suggests combining Boards of related technical competence, thus creating Boards with more members and broader technical competence, still limited to a particular technical field. Apart from the desired cross-fertilisation, this may also allow the Boards to deal more easily with the usual fluctuations of workload.

