



8 September 2023

User consultation on proposed amendments to the Rules of Procedure of the Boards of Appeal

Comments on behalf of epi

Dear Mr. Josefsson,

The present comments are presented on behalf of **epi** which has a membership of over 14,000 European patent attorneys¹ from 39 EPC member states. Our members work in private practice, industry and academia and represent every sort of applicant, patent proprietor and opponent, from individual inventors to large, multinational corporations, from all around the world. Many of our clients do not have as their mother tongue an official language of the EPO. As you will be well aware, in most proceedings before the Boards of Appeal, the parties are represented wholly or mainly by European patent attorneys. Therefore, within **epi**, we have a great deal of expertise on the written and oral proceedings before the Boards of Appeal.

epi appreciates the opportunity to comment on the proposed amendments to the Rules of the Procedure of the Boards of Appeal (RPBA). Below, we will give our opinion on the amendments one by one. However, it would, we think, be useful first to put the amendments in context.

General observation

It is acknowledged that the proposed amendments to the RPBA are intended to increase legal certainty by allowing the Boards to settle cases more quickly and within more predictable timeframes. **epi** considers that, as an overall strategy, this is to be supported. We also find that a pendency time of 56 months for 90% of all appeal cases² is far too long. However, **epi** feels that the burden for speeding up the proceedings before the Boards should not be placed solely on the parties to the proceedings, as this will not decrease the overall time to settle appeals to any significant degree. For much of the appeal proceedings, the parties cannot do anything because they are waiting for the Board to act. There have been occasions where it has taken a long time, in one case of which we are aware 18 months, just to receive the written decision. Thus, **epi** considers that the Boards should continue their efforts to improve the processing time within the Boards.

Moreover, **epi** doubts that reducing the time available to the parties to answer key points, which may have been raised by the other party at short notice, will improve legal certainty. To the contrary, lack of appropriate time to deal with key points may result in legal uncertainty as the Boards will not be presented with relevant and coherent submissions so that the Boards will have to make decisions on the basis of sub-optimal submissions. The parties who have made such sub-optimal submissions may then try to add to those submissions, either by filing further submissions

¹ European patent attorneys, as we all know, is the normal abbreviation for Representatives entered on the List kept by the EPO under Article 134 EPC.

² 2022 Annual Report of the Boards of Appeal, Figure 3.

or by making new arguments at oral proceedings. All this will lead to there being less time spent on reviewing whether an application should be granted or whether a patent should be maintained and more time being spent on dealing with admissibility questions as to whether the RPBA have been complied with. We fear that this will not lead to more legal certainty.

Any change to the RPBA will not reduce the pendency time or period of legal uncertainty of appeals in *ex parte* cases. However, it is likely to lead to increased pendency times and reduced legal certainty in *inter partes* cases. It is likely that, because they will not be given enough time to present a complete case in response to the appeal, respondents will attempt to supplement their case later in the proceedings, with the concomitant reaction from the appellant that any supplementary submission should not be admitted. This would involve the Board in more time in evaluating whether any supplementary submission is an elucidation of the respondent's case or the presentation of a new case and whether any supplementary submission should be admitted. On legal uncertainty, if the respondent has not had sufficient time to present a complete case and has not been allowed to supplement it later, the Board will have to make a decision on the case without having all the relevant facts and arguments to consider. Thus, if a patent is maintained on appeal, there will be an increase in legal uncertainty which could lead to an increased number of respondents resorting to national or UPC revocation proceedings, thereby extending the period of legal uncertainty. Even after a national or UPC revocation action, there can still be legal uncertainty as this would lead to a patchwork of protection as the UPC does not have competence for all possible designated EPC states.

It would be much better if there is more legal certainty from the Boards, which requires full and considered submissions from the parties, so that the options to "review" the Boards' decisions nationally or via the UPC are not taken. However, the way to improve the legal certainty is to ensure that the parties have enough time to prepare full and coherent submissions on any points raised by the Boards or any new points raised by another party. Thus, we consider that some of the proposals in the present document should not be adopted because, as shown below, the proposed shortening of some time limits would very likely negatively impact the quality and duration of the appeal proceedings in a substantial number of cases.

Article 12 – Basis of the proceedings

According to the proposal, the period referred to in Article 12(1)(c) will be reduced from 4 months to 2 months (but a Board can specify a longer period of not more than 4 months). epi considers this proposal is unacceptable for the following reasons:

- It is considered that this would further increase the imbalance between the time available for the appellant to provide its appeal statement and the time available for the respondent to reply to it. Although the statutory period for preparing a reasoned statement of appeal is four months - with good reason – the appellant in fact has a much longer period available for preparing the appeal statement. At the end of the oral proceedings before the Opposition Division, the appellant will already know why their arguments were not accepted and so can immediately start work on preparing arguments for the appeal statement and searching for further support for those arguments. Since the written decision of the Opposition Division is usually not issued until about 2 months after the end of the oral proceedings, the appellant *de facto* has at least 6 months for preparing the appeal

statement. The proposal to reduce the time for responding to the appeal statement results in significantly more unequal treatment of, and thus unfairness to, the respondent.

- This is exacerbated by the coming into force of the current RPBA, which came into force in 2020, by which appeal proceedings have become much more front-loaded than ever before. This implies that a respondent's response to the appeal statement must comprehensively address each and every argument presented by the appellant – regardless of whether it is a repetition of an argument presented in the first instance proceedings or something completely new submitted in order to overcome any objection raised in the Opposition Division's decision. Thus, the respondent may be confronted with a completely new situation, with hitherto unknown facts and arguments.
- This is further exacerbated because the representative of the respondent will have to consult and obtain instructions from the respondent. Even for an in-house representative, this may take some time as the representative will need to contact the business unit responsible for the opposition. For a large number of opposition proceedings, at least one of the parties is represented by a firm of European patent attorneys. This firm may be instructed by another firm of patent attorneys or a patent department in a non-European country. Thus, there can necessarily be a long chain between the EPO and the respondent.
- This can be yet further exacerbated by language problems. Two-way translations may be necessary to communicate with the respondent and sometimes another translation step into the language of the proceedings may become unavoidable. Carrying out all these necessary steps in two months is very challenging in itself and, in particular in cases requiring translations, increased costs for expedited translation services are likely to be incurred.
- There is a further problem where the respondent is the patent proprietor and there are multiple opponents. There may be appeals from all the opponents. It would place a completely undue burden on the patent proprietor respondent to have to respond to multiple appeal statements within two months.
- Therefore, **epi** considers that a period of only two months for respondents to perform the complex activities required to provide a complete and coherent response to the appeal statement(s) is too short.
- If the Boards were to adopt this proposal, the result would be that respondents will be unable to prepare a complete response supported by necessary, potentially new, evidence. The respondents will therefore be seeking to file further submissions to supplement their responses, causing more procedural difficulties for the Boards.

Therefore, **epi** is strongly of the opinion that Article 12(1)(c) should **not** be amended as proposed. Accordingly, an amendment of Article 25 is not required either.

Article 13 – Amendments to a party's appeal case

epi is in favour of the proposed amendment. As the communication is likely to be issued later than the summons, this will in most cases provide a bit more flexibility (= time) to the parties. This is appreciated, in particular in view of the fact that the amendment shifts the triggering event for application of the last, most restrictive convergence level from the date of issuance of the summons to the date of issuance of the communication under Article 15(1) which, in all likelihood, is weeks or even months later than the summons.

Article 15(1) - Oral proceedings and issuing decisions

Another proposal is that the second sentence in current Article 15(1), which reads as follows:

“In cases where there is more than one party, the Board shall endeavor to issue the summons no earlier than two months after receipt of the written reply or replies referred to in Article 12, paragraph 1(c).”

should be replaced by the following sentence:

“In cases where there is more than one party, the Board shall issue the communication no earlier than one month after receipt of the written reply or replies referred to in Article 12, paragraph 1(c).”


epi observes that according to the present proposal

- (i) The Board shall not only endeavor to but actually shall issue a document
- (ii) The document to be issued is no longer the Summons, but the communication referred to in Article 15 (1)
- (iii) The period the Board is supposed to wait before issuing the communication is reduced from two months to one month.

Whereas **epi** supports the amendments referred to under (i) and (ii) above, **epi** strongly opposes the reduction in the minimum time to be observed before a communication is issued after receipt of the reply or replies. The reason for **epi**'s concerns is that, even in cases of a completely wrong representation of facts and arguments by one of the parties, the other party has less than two months to provide a properly-considered response. It is understood that it is in the Boards' interest not to open up a time window allowing additional submissions. However, in the interests of a well reasoned decision, providing a good level of legal certainty, the parties must have a possibility to draw the Board's attention to a possible misrepresentation in the other party's submission. Therefore, for the reasons as set forth above for Article 12 in relation to obtaining instructions from the client and translation requirements, we would strongly advocate retaining the minimum two month period between receipt of the last written reply and the issuance of the communication by the Board.

We trust that you will find the above comments helpful. If you require any further explanation, we would be glad to provide it. We are also looking forward to the forthcoming MSBA meeting at which the proposed changes could be further discussed.

Yours sincerely,



Peter R. Thomsen
President