



Institut der beim Europäischen Patentamt zugelassenen Vertreter
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European Patent Institute · Bayerstrasse 83 · 80335 Munich · Germany

Mr Carl Josefsson
President of the EPO's Boards of Appeal
80298 Munich
Germany

22nd April 2018

Dear Mr Josefsson,

Re: Consultation on a Revision of the Rules of Procedure of the Boards of Appeal at the EPO

Thank you for asking **epi** to provide comments on the proposed amendments to the Rules of Procedure of the Boards of Appeal at the EPO ("RPBoA"). **epi** provides its comments below.

epi

As you know, **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 wording of the RPBoA.

Our Previous Letter

Before the consultation began, **epi** sent you a letter, dated 7th September, 2017, with some thoughts on the content of the RPBoA. For ease of reference, we attach a copy. We consider that many of the points raised in that letter still apply and we request that you take into account the contents of that letter in connection with the present consultation.

General Comment

epi welcomes the proposed amendments to the RPBoA to the extent that they have the objective to streamline and harmonise appeal proceedings. In our view, the amendments should also have the objectives to enable the Boards to maintain the high quality of appeal decisions, maintain the independence of the Boards, increase the efficiency of appeal proceedings and reduce total pendency times. However, it should also be an objective that any amendments to the RPBoA do not adversely affect the rights of the party(ies) to be heard in appeal proceedings, as provided for in Article 113 EPC.

President • Francis Leyder

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

president@patentepi.com



Points from Our Previous Letter

epi would refer again to points (i) to (v) made in our letter of 7th September, 2017 and would ask that these be taken into consideration.

Nature of Appeal

As regards our point (i), **epi** considers that the new RPBoA address this point but go too far. Proposed Article 12(2) refers to the object of the appeal proceedings as being to “judicially review” the decision under appeal. In many jurisdictions, a “judicial review” has a very strict meaning and implies that the body carrying out the review only decides whether there was a very clear breach of procedure or non-observance of the law. It does not involve any review of the evidence, facts and arguments presented in the instance whose decision is being “judicially reviewed”. Thus, this object is contrary to the rest of Article 12(2) which refers to “requests, facts, objections, arguments and evidence”. It is therefore suggested that any reference to “judicial review” should be deleted from the proposed RPBoA. We would refer you to the detailed suggestions in Section (i) of the Annex to our letter.

Case Management

As regards our point (ii), we can see nothing in the proposed RPBoA which relates to case management. There is no onus on the members of the Boards to deal with cases expeditiously as the only time limits are imposed on the parties, not on the Boards. **epi** considers that there should be provisions for case management in the proposed RPBoA. We would refer you to our detailed suggestions in Section (ii) of the Annex to our letter.

Transitional Provisions

As regards our point (v), **epi** considers that transitional provisions in the proposed RPBoA are not sufficiently extensive. If the proposed RPBoA come into effect immediately, it will not have been possible for the first instances to adapt their procedures to the proposed RPBoA and it will not have been possible for parties to first instance proceedings to take them into account in prosecuting the matter before the first instance. **epi** therefore considers that the new RPBoA should not apply to any matter for which oral proceedings have taken place before a first instance before the new RPBoA come into force.

Consistency and Cross-fertilization

The proposed RPBoA do not address our points (iii) and (iv) at all. We consider that these suggestions should be looked at carefully and taken into account when the proposed RPBoA are further amended before coming into force.

Amendments of a Party's Case

epi also has concerns that the proposals relating to amendment of a party's case are draconian and do not take into account the possible shortcomings of the handling of the case by the first instance. In light of this, **epi** considers that the proposed RPBoA should be amended to allow for any such shortcomings in the first instance.



Annex

epi sets out in the attached Annex detailed comments on the proposed RPBoA which support the points made above. It is requested that these detailed comments be taken into account during further consideration of the proposed RPBoA.

Hearing

It is suggested that the Boards should hold a hearing so that all interested parties can discuss the proposed RPBoA and assist the Board further in its review of the RPBoA.

Conclusion

epi again thanks the Boards for their invitation to comment on proposed RPBoA and offers its assistance in further developing the RPBoA in whatever way the Boards would find helpful.

Yours sincerely,

A handwritten signature in blue ink, appearing to be 'Francis Leyder', written over a faint, light blue oval-shaped background.

Francis Leyder
President

Annex to epi letter dated 20/04/2018

The following comments follow the numbering of the proposed RPBoA.

Articles 1 to 9

epi has no particular comments on these Articles as such but considers that these Articles should be expanded to include provisions relating to case management so that there is an onus on the Boards to conduct appeals in an efficient and timely manner.

Article 10

epi is of the view that the provisions on acceleration of an appeal are unbalanced. Any party requesting acceleration has to provide "... objectively verifiable reasons ... supported by relevant documents". However, in response to any request, all the Board has to do is to give a decision. **epi** considers that the Board should have to give reasons for its decision so that there is transparency. Without reasons, it might appear that the Board refusing the request is merely being capricious. The same is true where a court has requested acceleration. It would appear to be impolite at the very least not to give a court reasons for refusing its request.

epi considers that the number of cases where acceleration will be requested is likely to be small and so it should not present the Boards with a large burden to give reasons for not accelerating.

Article 10(6) refers to a "strict framework". However, this is completely unspecified and so parties to any such accelerated appeal proceedings have no idea what this means. **epi** therefore suggests that there should be at least some guidance as to what such a "strict framework" would be. There should be a standard scheme for this and this scheme should be part of the case management system.

It has already happened that a Board decided in opposition appeal proceedings that there should be acceleration but one of the parties decided not to comply with an accelerated timetable. In that case, the Board had no sanction against that party and so the acceleration was useless. If a Board decides to accelerate proceedings, of its own motion or following a request, then **epi** considers that there should be a sanction for not complying with any order issued by the Board. The sanction could be that anything which is filed after a time limit set by the Board will not be admitted into the proceedings.

Article 11

epi considers that the question of remittal should be further clarified. **epi** is particularly concerned about the situation where a decision from a first instance addresses only a single argument. For instance, in an opposition proceedings, the opponent may argue that claim 1 does not meet the requirements of Article 123(2) EPC and also argue that that claim lacks novelty over D1. If the opposition division agrees with the Article 123(2) argument, then it may revoke the patent for that reason only. If the Board decides that the opposition division was incorrect, the Board could either remit the case to the opposition division for a consideration of novelty or could decide on the novelty argument itself. If the Board takes the latter course, is it acting as an appellate instance or is it acting as an administrative instance with no possibility of appeal from the administrative instance? **epi** appreciates that remittal in that case would prolong the proceedings,

which is disadvantageous, but that it would be in accord with the object of ensuring that the Boards act as an appellate instance.

This is a situation where the practices established before the first instances are counter to the objective of having a timely procedure. It may therefore be appropriate for the Boards to consult with DG1 to see whether this situation can be resolved by a change in the practices of the first instance.

Article 12

epi considers that this Article should just be headed “Appeal proceedings” because, as presently drafted, this paragraph confuses the proceedings and the basis for the decision. It is suggested that there should be a separate Article relating to the basis for the decision, as set out below.

epi also suggests that the paragraphs of Article 12 should be re-ordered, in particular that paragraph (2) should be the first paragraph as it sets out a general objective of appeal proceedings which is then further specified in later paragraphs. It is also considered that Article 12(1) should be a separate Article as it seems to be a recitation of the matters which should be taken into account when the Board takes its decision and seems to follow on more logically from Articles 12 to 15.

In Article 12(2) as proposed, it is considered that it should not refer to “judicially review” for the reasons set forth above.

epi also considers that the additional wording in proposed paragraph (2) makes the paragraph unclear. In this connection, **epi** would point out that in any proceedings, the party or parties make requests, which may be procedural requests or claim requests. In order to support its requests, a party will provide evidence, such as documents, declarations, samples, recordings and so on. The evidence is provided in order to prove facts. On the basis of the facts, the parties make arguments which the party considers will show why the facts support its requests. It therefore cannot be seen why proposed Article 12(2) refers to “objections” and “arguments”.

In any event, **epi** suggests that the reference to “arguments” in this paragraph could be removed. Once the facts are established, then a party should be able to make any argument based on the established facts. For instance, it may be that an opponent has made an argument that, based on the D1 as the closest prior art and D2 as a secondary document, a claim lacks inventive step. During the proceedings, it may become clear that a better argument is that D2 is the closest prior art and that D1 should be the secondary document. This does not change the evidence or facts and does not complicate the case. Therefore, parties could be allowed to make new arguments at any time during the appeal proceedings as long as they rely only on already-admitted evidence and facts.

In light of this, **epi** considers that Article 12(2) should become Article 12(1) and should read as set out below, optionally with the deletion of “arguments”.

It would then make more sense to make proposed paragraph (3) new paragraph (2) and that this should set out what is required in the statement of grounds and any reply from another party, as set out below.

If reference is made to the requests, evidence, facts and arguments from the first instance proceedings, there should be no need for any of that material to be submitted to the Board, as it will already be present

in the file. Since the appeal proceedings are supposed to be limited to a review of the first instance proceedings, it cannot be seen why, at this place in the RPBoA, there should be any reference to other material.

However, **epi** agrees with the convergent approach set out in the proposed RPBoA and agrees that a paragraph similar to proposed paragraph (4) should be present. However, **epi** suggests that there should be only one Article referring to the admissibility or otherwise of an amendment of case and suggests that it should all be in what, under our proposal, would become Article 14. This would mean that proposed Article 12(4), which would now become Article 12(3), should read as shown below.

By referring here to Article 14, proposed paragraphs (5) and (6) can be moved into Article 14.

On proposed Article 12(5), it is assumed that this should refer to paragraph (4) and is intended to apply to cases where the statement or reply contains “new” matter but there is no justification for adding the “new” matter. A clarifying amendment is suggested below.

On proposed Article 12(6), **epi** considers that the use of the word “manifest” in connection with the exercise of discretion places too high a burden, for no apparent reason, on the party against whom the decision was made and so should be removed.

In proposed Article 12(7), which would now become Article 12(4), **epi** considers that the last sentence should be removed. While **epi** agrees that, in general, time limits should be strict, there are circumstances where too strict an approach is unfair. In opposition proceedings, appellants usually have a longer time to consider the decision at first instance. In many cases, the decision will have been issued after oral proceedings. At the oral proceedings, the appellant will have heard orally the reasons why the opposition division took its decision and so will be in a position to begin preparing its appeal immediately after the oral proceedings, which may be a few months before the decision is issued in written form. Any appellant therefore has well over four months to prepare its appeal. In contrast, the respondent will not be able to begin preparing its reply until it has seen the statement of appeal from the appellant.

Also, it may well be the case that the statement of grounds contains “new” material, such as new experiments or new documents, to which the respondent needs to reply. As there is no provision in the proposed RPBoA for any case management, the respondent will not know whether any such material has been admitted into the proceedings and so will have to respond to it. If the respondent is given only four months, there may not be time to carry out counter-experiments or deal with any new documents.

Moreover, there are a significant number of cases where there are multiple opponents. If the proprietor succeeds before the opposition division, there may be many appeal statements to consider, all raising different arguments. It is then unfair to expect the proprietor to respond to all the appeal statements in four months.

Thus, appellants and respondents are not always in the same position. It is therefore the view of **epi** that the Board should retain its discretion to extend this time limit in appropriate cases.

epi considers that Article 12(8) should become Article 12(5).

Article 13

As noted above, **epi** agrees that the Boards need to be able to control the proceedings such that the primary objective set out above is met and considers that all provisions relating to admission of new material should be in one Article. However, the question of admissibility can also arise in oral proceedings and so it seems more appropriate to have the Article dealing with admissibility after the Article on oral proceedings. **epi** therefore suggests that Article 13 be moved to become Article 14. The different levels of convergence referred to in the explanatory remarks can then all be dealt with in one place. **epi** suggests that Article 14 should read as shown below.

Article 14

epi has no objection to Article 14 but considers that it should follow our proposed Article 14 because, as far as possible, all the procedural provisions, in particular relating to oral proceedings and admissibility, in the RPBoA should apply to interveners. It is therefore suggested that this be made Article 15, with slight amendment, as shown below.

Article 15

epi considers that Article 15 should not refer to both oral proceedings and issuing decisions. These are two separate subjects and should be treated separately. After all, in some cases, decisions are issued without there being any oral proceedings.

Oral Proceedings

On the matters relating to oral proceedings, **epi** welcomes the fact that the proposed RPBoA makes it mandatory for the Board to issue a communication prior to oral proceedings. A number of the present Boards already issue such communications and these are generally much appreciated by parties to appeals. However, the degree to which any such communication is useful in preparation for oral proceedings varies with the degree to which the communication is substantiated. **epi** therefore suggests that the RPBoA should specify that the communication should contain “substantiated” comments.

It is also suggested that there should be a reference in this Article to amendments to a party's case during oral proceedings.

Proposed Article 15(2) refers to the date for the oral proceedings but there is no earlier mention of this.

There is also no mention of any date for filing any further submissions. **epi** considers that both of these should be mentioned in the RPBoA. This is not to say that in every case the Board should set a deadline for filing further submissions. It should be at the discretion of the Board to indicate in the summons that it sees no need for any further submissions and even to indicate that any further submissions risk being not admitted.

Proposed Article 15(2) refers to cases where the party is represented and indicates that any request for postponement which relates only to the party will be refused. It is submitted that this is too draconian. In some cases, the party is the inventor or the case involves evidence provided by the party. Questions may arise which can only be answered by the party. If the party cannot attend the oral proceedings in such

cases, that party's right to be heard would be adversely affected. It is therefore suggested that the RPBoA should allow for postponement for reasons relating to the party in exceptional circumstances.

Proposed Article 15(7) states that the Board may, in certain circumstances, in the written decision provide only abridged reasons. **epi** considers that this should not be permitted. This does not provide sufficient transparency. There may be other parties who are interested in the case but who do not want to be identified who would be adversely affected if only abridged reasons were given. Also, if the decision seems to be inconsistent with other decisions, it will not be possible for anyone to see if there really is an inconsistency. Moreover, all decisions of the Boards are available for study and often ones which the Boards, and perhaps the parties, consider to be of low relevance are seen by other parties as relevant. It is therefore considered that Article 15(7) should be deleted.

Suggested wording in respect of all these points is shown below.

Basis for and Issuance of Decisions

As noted above, Article 12(1) seems to relate to the material which should be considered before the Board makes a decision. It is therefore suggested that this part of Article 12 should be moved to a new Article relating to the basis for and issuance of decisions. However, it is considered that Article 12(1) should be amended so that it can be seen that all relevant materials are to be considered by the Board in coming to its decision.

In proposed Article 12(1), the only parts of the first instance proceedings to which a reference is made are the decision of the first instance and the minutes of any oral proceedings which took place. There is no reference to the submissions made by the parties during the first instance proceedings. It would appear from this that the Boards consider that the decision and any minutes are sufficient to establish the relevant requests, evidence, facts and arguments of the parties.

This seems to be based on two assumptions. The first is that the decision and minutes issued by the first instance accurately and fully reflect the proceedings before it. The second is that the proceedings before the first instance were conducted in light of the contents of the proposed RPBoA. Neither of these assumptions is correct.

On the first point, although generally the first instance does provide a decision and minutes which do accurately reflect all the requests, evidence, facts and arguments submitted in the proceedings, there is a significant minority of cases where this is not true.

If there is an omission in the decision, there is no procedure whereby such an omission can be corrected. The only way to correct a decision is to appeal. Thus, it is clearly unfair to the parties if they can only rely on what the first instance wrote in its decision as this would preclude them from raising again material which was admissibly raised in the proceedings but which was not recorded by the first instance.

The same is, to a lesser extent, true for the minutes. These often omit to mention all the arguments made at the oral proceedings and concentrate on the ones which the first instance considered relevant. It is possible to request correction of the minutes but this is not often granted. According to the proposed RPBoA, even a letter requesting correction of the minutes would not be considered in appeal proceedings,

which again is clearly unfair to the parties.

It is also pointed out that, at present, it is quite rare for parties to first instance proceedings to request correction of the minutes because, under the present RPBoA, it is usually possible to re-introduce anything which was introduced into the first instance proceedings but was not mentioned in the decision or the minutes. However, under the proposed RPBoA, it will become significantly more difficult for a party to re-introduce anything which is not referred to in the decision or the minutes and so it may be that the practice before the first instances will need to change, which goes to the point about transitional provisions made later.

In light of the above, **epi** considers that proposed Article 12(1) should be amended and should now be Article 16(1) and should read as shown below.

Articles 16 to 24

epi has no comments on Articles 16 to 24 of the proposed RPBoA.

Article 25

epi considers that Article 25 should be amended to delay entry into force of the new RPBoA for any application or patent for which oral proceedings are scheduled or have taken place. As noted above, the practice before first instances has developed to be in accordance with the present RPBoA and so do not take into account the new and stricter provisions for admittance of amendments of a party's case. At this stage in such proceedings, the parties to the first instance proceedings cannot adapt their practice to the new RPBoA and so will be unfairly adversely affected by the changes to be brought about by the new RPBoA.

It is likely that, if the new RPBoA are to apply to such cases, the Boards will be inundated with requests to admit new material and it is likely that there will be petitions for review on the basis that the application of the new RPBoA is an abuse of procedure. The Boards should allow parties to first instance proceedings to adapt their practices to the new RPBoA.

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Suggested Amendments to Articles 12 to 15.

Article 12 – Appeal Proceedings

12(1) The primary object of appeal proceedings is to review whether, based on the requests, evidence, facts and arguments admitted into and not withdrawn from the first instance proceedings, the decision of the first instance was correct. Therefore, a party's appeal case shall be directed to those requests, evidence, facts and arguments. (Corresponds to proposed Article 12(2).)

12(2) The statement of grounds of appeal and any reply, which shall be filed within four months of the notification of the statement of grounds, shall contain a party's complete case and accordingly shall set out clearly and concisely the reasons why it is requested that the decision under appeal be set aside, amended or maintained and should specify all the requests, evidence, facts and arguments admitted into and not withdrawn from the first instance proceedings relied on. (Corresponds partly to proposed Article 12(3) and present Article 12(2).)

12(3) A party amends its case when its statement of grounds, its reply or any other submission it makes during the appeal proceedings refers to a new request, evidence, fact or argument or a request, evidence, fact or argument which was not part of, not admitted into or withdrawn from the first instance proceedings. When a party amends its case, it shall clearly identify any such new request, evidence, fact or argument and shall provide reasons for submitting it in the appeal proceedings. In the case of a request to amend the patent application or patent, the party shall indicate the basis for the amendment in the application as filed and provide reasons why the amendment meets all the requirements of the EPC. The Board shall decide whether any such amendment to a party's case is admissible according to the criteria set out in Article 14. (Corresponds to proposed Article 12(4) and (5) and Article 13(1).)

12(4) A period specified by the Board may exceptionally be extended at the Board's discretion upon receipt of a written and reasoned request presented before the expiry of such period. (Corresponds partly to proposed Article 12(7) and present Article 12(5).)

Article 13 - Oral Proceedings

13(1) As soon as a Board decides that oral proceedings are to take place, the Board shall send a summons setting a date for the oral proceedings and, if the Board considers it expedient, a date by which any further submissions should be filed.

13(2) A request of a party for a change of the date fixed for oral proceedings may be allowed if the party puts forward serious reasons which justify the fixing of a new date. If the party is represented, the serious reasons must, except in exceptional circumstances, relate to the representative and not the party. (Corresponds to proposed Article 15(2) and present Article 16(2).)

13(2)(a), (b) and (c) = proposed Article 15(2)(a), (b) and (c).

13(3) If oral proceedings are to take place, the Board shall, with the summons or as soon as possible after issue of the summons, send a substantiated communication drawing attention... (then as in proposed Article 15(1)). (Corresponds to proposed Article 15(2).)

13(4) If any submission filed after issuance of the communication or submitted orally during the oral proceedings amends a party's case, that amendment will not be admitted into the proceedings unless it clearly meets the requirements set out in Article 14 below.

13(5) = proposed Article 15(3)

13(6) = proposed Article 15(4)

13(7) = proposed Article 15(5)

13(8) = proposed Article 15(6)

Article 14 – Amendment to a Party's Case

14(1) Any amendment to a party's case, as referred to in Article 12(3) above, is subject to the party's reasons for its amendment and may be admitted only at the discretion of the Board. The Board shall exercise its discretion in view of *inter alia* the complexity of the amendment, the stage of the proceedings, the need for procedural economy and the suitability of the amendment to solve an issue which was admissibly raised by the other party or parties or which was raised by the Board. (Corresponds to proposed Article 13(1).)

14(2) If the party concerned provides no reasons for the amendment of its case, the Board may exercise its discretion not to admit the amendment into the appeal proceedings. (Corresponds to proposed Article 12(5).)

14(3) The Board shall not admit any request, evidence, fact or argument which was advanced in the first instance proceedings but not admitted into those proceedings unless the decision not to admit it resulted from an erroneous application of the first instance's discretion or unless the circumstances of the appeal case justify its admission. The Board also shall not admit any request, evidence, fact or argument which should have been presented or which was withdrawn by the party concerned in the first instance proceedings unless the circumstances of the appeal case justify its admission. (Corresponds to proposed Article 12(6).)

14(4) In the case of an amendment to a patent application or a patent made after the filing of the statement of grounds or the reply, it is for the proprietor to satisfy the Board that any such amendment is *prima facie* allowable. (Corresponds to proposed Article 13(1).)

14(5) Any amendment to a party's case after the expiry of a period specified by the Board in a communication or after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which need to be justified with cogent reasons by the party concerned. (Corresponds to proposed Article 13(2).)

14(6) Any other party shall be entitled to submit its observations on any amendment not held inadmissible by the Board *ex officio*. (Corresponds to proposed Article 13(3) and present Article 13(2).)

Article 15 – Interventions

Where, during a pending appeal, a notice of intervention is filed, Articles 12 to 14 shall apply insofar as



justified by the circumstances of the case. (Corresponds to proposed Article 14.)

Article 16 – Basis for Decisions and Issuance of Decisions

16(1) The decision of the Board shall be based on:

- (a) the requests, evidence, facts and arguments admitted into and not withdrawn from the first instance proceedings;
 - (b) the decision under appeal and the minutes of any oral proceedings before the first instance;
 - (c) any submission made by a party to the first instance after issuance of the decision of the first instance;
 - (d) the notice of appeal and the statement of grounds filed pursuant to Article 108 EPC and, in cases where there is more than one party, any written reply of the other party or parties, provided that any amendment in a party's case has been admitted into the proceedings by the Board;
 - (e) any amendment in a party's case, whether made in writing or orally, submitted after the filing of the statement of grounds or any written reply, provided that that amendment has been admitted into the proceedings by the Board;
 - (f) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board; and
 - (g) any minutes of a video or telephone conference with the party or parties sent by the Board.
- (Corresponds partly to proposed Article 12(1).)

16(2) The Board shall issue a written decision on the appeal in a timely manner. (Corresponds to proposed Article 15(9).)

16(3) If the Board agrees entirely with the decision under appeal, including the reasons given in that decision, the reasons for its decision may be given in abridged form. (Corresponds to proposed Article 15(6).)

16(4) If oral proceedings took place and the Chairman announced the decision on the appeal orally in accordance with Article 13(9), the Board shall prepare a written decision and despatch it to the party or parties within three months of the date of the oral proceedings. If the Board is unable to do so, it shall inform the parties when the decision is to be despatched. (Corresponds to proposed Article 15(9)(a).)

16(5) If oral proceedings took place and the case was ready for decision during the oral proceedings but the Chairman did not announce the decision on the appeal orally in accordance with Article 13(8), the Chairman shall indicate the date on which the decision on the appeal is to be despatched, which shall not be later than three months after the closure of the oral proceedings. If the Board is unable to despatch the decision by that date, it shall inform the party or parties of a new date or, in exceptional circumstances, shall issue a communication specifying the further procedural steps that will be taken. (Corresponds to proposed Article 15(9)(b).)

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