

## **Online consultation on the proposed amendments to the Rules of Procedure of the Boards of Appeal**

### ***Introduction***

The IP Federation represents IP intensive companies in the United Kingdom, which are extensively involved in business activity in Europe and internationally across a wide range of industries - a list of members is attached. Not only do our members own considerable numbers of European patents and other IP rights, but they are affected by the activities and European patents of competitors and third parties. More specifically, IP Federation members may be either appellants or respondents before the Boards of Appeal, and in fact over time are generally both, i.e. members may have either role in different appeals.

The Boards of Appeal of the European Patent Office have recently launched a user [consultation](#) regarding proposed amendments to the Rules of Procedure of the Boards of Appeal (RPBA) published 15 June 2023. The closing date of the user consultation is **Monday 11 September 2023**.

### ***Brief summary of proposed amendments to RPBA***

It is proposed to amend Article 12(1)(c) RPBA to shorten the standard period for the respondent to file the written response to the grounds of appeal to two months from the present period of four months. The relevant Board would have a discretionary power to specify a longer period up to four months.

Article 13(2) RPBA would be amended to change the trigger for the third level of the convergent approach in appeal proceedings, where no Rule 100(2) EPC communication (invitation to file observations) is issued. At present the trigger in this situation is notification of a summons to oral proceedings, and it is proposed to replace this by the communication under Article 15(1) RPBA (drawing attention to matters of significance, possibly including a preliminary opinion). This will extend the second level of the convergent approach in cases where the Article 15(1) communication is notified later than the summons, provided that no Rule 100(2) EPC communication had been issued.

Article 15(1) RPBA would be amended to require the Board to issue the Article 15(1) communication no earlier than one month after receipt of the response to the grounds of appeal, in cases where there is more than one party. This ensures a minimum duration of the second level of the convergent approach.

### ***IP Federation comments***

The IP Federation is opposed to the proposal to shorten the standard period for the respondent to file the written response to the grounds of appeal to two months (Article 12(1)(c)) for the following reasons:

Firstly, it is believed that two months for response would be inadequate, and so would place respondents under excessive time pressure, causing unreasonable stress for those involved and possibly adversely affecting the quality of the responses filed. Secondly, this change would be inequitable, as it would upset the balance between appellants and respondents, by adversely affecting only respondents. Thirdly, reducing the standard period for response by two months would yield minimal benefit in terms of reduction of the overall length of appeal proceedings, and such a minimal benefit is insufficient to justify the extra burden that would be placed upon respondents.

To expand upon each of these aspects in turn, a two-month period for response would be inadequate because responses to appeals can be complicated and may require translations to be obtained, or consultation with relevant technical experts or commercial functions. Consultation takes time because of the possible absence or unavailability of those being consulted, and even when the outcome of the consultation is known, time may be needed to analyse data received before a response can be prepared.

Furthermore, in cases where the appellant relies on experimental data in the grounds of appeal, the respondent may itself need to carry out experimental work in order to prepare a fully supported response, and such work is itself often time-consuming. Clearly, analysis of data obtained from experimental work, and the preparation of argumentation based on it, cannot commence until the experimental work has been completed.

Even in a case where the respondent believes that experimental data submitted by the appellant constitutes an amendment of the latter's case, at this stage the respondent does not know which way the Board will exercise its discretion under Article 12(4) RPBA, and so the respondent could not afford not to carry out its own experiments and risk finding itself unprepared in the event that the Board does later admit the appellant's experimental data.

Moreover, the proposed two-month period for response to the grounds of appeal would be at odds with the standard periods for response during examination of an application, where a period of four months is normally allowed for reply to an Article 94(3) communication, and a period of two months is only set when the objections raised are minor in nature. However, drafting a response to grounds of appeal is never minor in nature.

Additionally, when the ten-day period for notification under Rule 126(2) EPC is removed from 1 November 2023, the effective time available for responses to all notified documents will be reduced, which means that the proposed reduced period for response will hit respondents even harder.

Secondly, the proposed change would be inequitable, because an appellant has four months in which to prepare the grounds of appeal, measured from notification of the appealed decision (Article 108 EPC). Even though notice of appeal need only be filed within two months of such notification, a would-be appellant can start preparing the grounds of appeal from the moment it decides to file an appeal against the decision, which would normally be well

before it actually files the notice of appeal. In contrast, the respondent cannot start preparing its response to the grounds of appeal until it has actually received said grounds. Even though the respondent would be aware that a notice of appeal has been filed, it needs to see the requests, facts, objections, arguments and evidence on which the appeal is based before it can start to formulate a response in an informed manner.

Moreover, it is sometimes the case that an adversely affected party files a notice of appeal as a tactical measure to increase uncertainty for the other party or parties, and then does not follow it up with grounds of appeal. This is a further reason why a respondent cannot start preparing its response until it has received the grounds of appeal.

In fact, if the EPO were to proceed with the proposed amendment to the period for response, there would also be a danger of precautionary appeals following an opposition where a patent is maintained in amended form, so that all parties are adversely affected and thus eligible to file an appeal. In this situation, each party, suspecting that the other party or parties may appeal the opposition decision, may themselves file an appeal as a tactical measure to place the other party or parties under the same level of time pressure as they would themselves suffer as respondent. Such tactical filing of appeals would be likely to increase the number of appeals filed and hence the workload of the Boards of Appeal, thereby working directly against the Boards' stated desire to reduce the number and duration of appeals pending.

Thirdly, the proposed change would yield minimal benefit in terms of reduction of the overall length of appeal proceedings. Data on pendency time is provided in the Annual Report of the Boards of Appeal for 2022 (i.e. the most recent one available):

[Annual Report BoA 2022\\_EN\\_final\\_rev\\_230609.pdf](#)

Figure 3 on page 8 of the report shows that 90% of cases were settled in 56 months in 2022, compared with a target of 30 months. Additionally, Table 2 on page 9 states that the backlog comprised 30.7% of cases pending in 2022, these being cases pending for more than 30 months. It is therefore apparent that the reduction of two months in the standard period for response to the grounds of appeal will have minimal impact on the timescales of typical appeal cases, as measured in 2022.

The proposal to provide Boards with a discretionary power to set a longer period for response up to four months, and the possibility of exceptionally requesting an extension at the Board's discretion under Article 12(7) RPBA, do not in any way compensate for the disadvantages described above of shortening the standard period for response to two months. This is simply because these are discretionary powers, and so the respondent will be unable to predict how they will be exercised, still less rely on them.

In this context, if the EPO were to proceed with the proposed amendment to the period for response, it would be useful if further examples could be provided of situations in which a Board would normally extend the two-month

time period to four months from the outset. At present the “Explanatory remarks” provided in the draft proposed RPBA amendments dated 15 June 2023 only mention the case where the proprietor is the respondent and there are numerous appeals by different opponents. It is suggested for example that cases relying on experimental data, as mentioned above, would be another suitable candidate.

For completeness, the IP Federation does not have any objections to the proposed amendments to Articles 13(2) and 15(1) RPBA, and appreciates that in certain specific circumstances these amendments may benefit parties to an appeal.

IP Federation  
7 September 2023



## IP Federation members 2023

The IP Federation membership comprises the companies listed below. The UK Confederation of British Industry (CBI), although not a member, is represented on the IP Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. The IP Federation is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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