

## **Revision of the Rules of Procedure of the Boards of Appeal**

The IP Federation represents the views of UK Industry in both IP policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed at the end of this paper. It has wide experience of how IP law, including patent litigation, works in practice in the UK, Europe and internationally.

### ***The consultation***

A key part of the reform measures being undertaken to improve the efficiency and predictability of appeal proceedings before the Boards of Appeal of the EPO is the revision of the Rules of Procedure of the Boards of Appeal (RPBA - OJ EPO 2007, 536). The Boards of Appeal Committee (BOAC) and the President of the Boards of Appeal have therefore invited users to take part in a [written consultation](#) on the proposed revised Rules of Procedure of the Boards of Appeal, which are now available in English (first published draft dated 1 February 2018).

This online consultation will remain open until **noon on 30 April 2018**. It is intended that a further draft will be issued in good time before the user conference planned for late autumn 2018.

### ***IP Federation response***

The IP Federation welcomes the proposal to revise the Rules of Procedure of the Boards of Appeal which clearly seek to improve timeliness and certainty for parties in the appeal procedure. It is important to our members that the EPO appeal procedure operates according to a reliable and consistent time-frame that is not excessively long while providing certainty of the procedure and high-quality decisions.

Our feedback on specific proposed amendments, which we have also submitted via the [online EPO form](#), are provided below.

### ***Article 10(3)***

“On request by a party, the Board may accelerate the appeal proceedings. The request shall contain objectively verifiable reasons why the appeal proceedings should be accelerated and shall, where appropriate, be supported by relevant documents. The request shall be filed as soon as the reasons become known to the party. The Board shall inform the parties whether the request has been granted.”

The article is clear that requests for acceleration must be timely and the reasons verifiable, though the standard of such reasons and constraints on the board to admit such requests for acceleration are not present in the rule itself. The commentary accompanying the amendment is helpful though the inclusion of some indication of the standard of justification required within

the rule itself would promote consistency in the application of the discretion and serve to align the expectations of parties.

### **Article 12(1)**

The following are missing and should be included in Article 12(1):

- any submission to the department having issued the decision under appeal;
- *prima facie* relevant facts, arguments and evidence and requests filed until end of the period of Article 108 EPC; and
- option to file request(s) to amend claims and/or description of the patent and/or patent application triggered by any new facts, arguments and evidence submitted by the other parties or board of appeal.

### **Article 12(1)(a)**

“Appeal proceedings shall be based on (a) the decision under appeal and any minutes of oral proceedings before the department having issued that decision.”

Any suggestion that the decision under appeal and associated minutes are not part of the basis of appeal proceedings must be incorrect in all circumstances. The effect of the explicit inclusion of the decision and minutes in the rules of procedure (and the definition of an “amendment” under Article 12(4)) serves to indicate that the list in Article 12(1) is exhaustive (where previously it was not necessarily so). Such an exhaustive list serves to constrain the submissions of the parties so promoting expediency and this ambition is welcomed.

On the other hand, the reference to “the decision under appeal” suggests only a single decision is appealed and omits to consider the case in which interlocutory decisions are appealed together with a final decision under Article 106( 2) EPC. If there is to be a tendency towards an exhaustive list in Article 12(1) of the rules of procedure, then it is essential that the proper scope of such an exhaustive list is ensured. The same observation applies to Article 12(2).

### **Article 12(1)(e)**

“Appeal proceedings shall be based on ... (e) any minutes of a video or telephone conference with the party or parties sent by the Board.”

The provision should be extended to include minutes of an in-person meeting with a party or parties.

### **Article 12(2)**

Article 12(2) and 12(3) provide limitations beyond what is provided for in Rule 99 EPC. In particular, Rule 99(2) EPC provides that the statement of grounds shall indicate the reasons for setting the decision aside and the “facts and evidence on which the appeal is based”. Accordingly, Rule 99(2) EPC does not provide a limitation on “objections or arguments”. Nor does the Convention provide anywhere the possibility for an instance of the European Patent Office or the Boards of Appeal to disregard arguments or objections. To the contrary, where Article 114(1) EPC mentions “arguments” in relation to examination by the European Patent Office, Article 114(2) EPC limits the ability to disregard elements of a case to only facts and evidence that is late submitted. The provisions of the proposed Article 12(2) to 12(6) are at odds with the

Convention and the implementing regulations thereof to the extent that reference is made to “objections” or “arguments” in these provisions.

It is suggested that in Art. 12(2) the wording “requests, facts, objections, arguments and evidence” be replaced with “legal and factual framework”. Such wording properly reflects the principle of “judicial” review yet leaving the parties the appropriate room to argue its case in appeal within the legal and factual framework forming the basis of the decision.

### **Article 12(3)**

In Article 12(3) an amendment corresponding to that proposed for Article 12(2) should be made, or alternatively both provisions should delete the words “objections” and “arguments” to bring these provisions in line with Rule 99 EPC.

### **Article 12(4)**

“Any part of a submission which does not meet the requirements in paragraph 2 is to be regarded as an amendment and may be admitted only at the discretion of the Board. The party shall clearly identify each amendment and provide reasons for submitting it in the appeal proceedings, and, in the case of an amendment to a patent application or patent, shall indicate the basis for the amendment in the application as filed as well as reasons why the amendment does not give rise to further objections. The Board shall exercise its discretion in view of inter alia the complexity of the amendments, the suitability of the amendments to solve the issues which led to the decision under appeal, and the need for procedural economy.”

The phrase “the need for procedural economy” suggests that there could be different needs for different boards and/or at different times such that overloaded boards have a greater need for procedural economy than underloaded boards, for example. Accordingly, the approach to discretion might be expected to vary for parties depending on present workload burdens of particular boards and/or at particular times. It is proposed that the consideration should be rephrased as simply “a need for procedural economy” to introduce an objective that such considerations are sought to be applied consistently by all boards.

### **Article 12(6)**

“The Board shall not admit facts, objections, evidence and requests which were advanced in the proceedings leading to the decision under appeal but not admitted in those proceedings unless the decision not to admit them suffered from a manifest error in the use of discretion or unless the circumstances of the appeal case justify their admittance. The Board shall not admit facts, objections, evidence or requests which should have been presented, or which were withdrawn or no longer pursued, by the party concerned in the proceedings leading to the decision under appeal unless the circumstances of the appeal case justify their admittance.”

It needs to be beyond doubt that the caveat “unless the circumstances of the appeal case justify their admittance” includes circumstances where submissions must be admissible. For example, an instruction to boards not to admit submissions that were not admitted at first instance may contravene the requirement of Article 106(2) EPC that interlocutory decisions can always be appealed along with a final decision. Furthermore, adequately substantiated grounds of appeal alleging a substantial procedural violation should always be admissible (T1020/13 reason 1).

**Article 13(1)**

“The Board shall exercise its discretion in view of inter alia the current state of the proceedings and the suitability of the amendments to solve the issues which were admissibly raised by the other party or parties or which were raised by the Board. The Board must also be satisfied that the amendment enhances procedural economy.”

See also the comments with respect to Article 12(4) with respect to “procedural economy”. The requirement for *enhancing* procedural economy goes beyond the requirement in Article 12(4) of “procedural economy” and is not defined in the Article or the commentary. For consistency, it is proposed to refer only to “The Board shall exercise its discretion in view of inter alia the current state of the proceedings, the suitability of the amendments to solve the issues which were admissibly raised by the other party or parties or which were raised by the Board, and a need for procedural economy.”

**Article 13(2)**

“Any amendment to a party’s case made 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.”

It is not apparent what communication is referred to or the circumstances in which a Board would issue a communication explicitly setting a deadline for the submission of new amendments to a party’s case (which seems unlikely in the context of the other provisions in the proposed Rules of Procedure). It is proposed to remove this reference to a “communication”.

**Article 15(2)**

“A request of a party for a change of the date fixed for oral proceedings may be allowed if the party can put forward serious reasons which justify the fixing of a new date. If the party is represented, the serious reasons must relate to the representative, and not the party.”

While it is acknowledged that the word “serious” derives from the existing Notice of the VP of DG 3 concerning oral proceedings before the Boards of Appeal (OJ EPO 2007, Special Edition No. 3, 115), the opportunity can be taken to improve clarity and certainty for applicants and representatives, especially in the circumstances not otherwise enumerated in the proposed Article 15(2)(b). In particular, “serious” reasons are not necessarily good and compelling reasons. It is proposed to replace the word “serious” with the word “compelling”.

**Article 15(7)**

“Where the decision on the appeal has been announced orally in accordance with paragraph 6, the reasons for the decision may, with the explicit consent of the parties, be put in writing in abridged form. However, where it has been indicated to the Board that a third party or a court has, in the particular case, a legitimate interest in the reasons for the decision not being in abridged form, they shall not be abridged. Where appropriate, the reasons for the decision in abridged form may already be included in the minutes of the oral proceedings.”

The workload benefits of preparing abridged decisions is acknowledged and, subject to the proposed controls that all parties must agree, the proposal appears acceptable with the caveat that such abridged decisions must

nonetheless include reasons howsoever abbreviated. That is to say, the mere recitation of a final decision would never be acceptable. Further, to protect the public interest, it is proposed to permit third parties to request un-abridged decisions during a defined period following the conclusion of oral proceedings. Such provisions recognise the impact and relevance of decision of the Boards on third parties as well as the party's themselves. Similar comments apply to Article 15(8).

**Article 15(9)(a)**

"Where the Chairman announces the decision on the appeal orally in accordance with paragraph 6, the Board shall put the decision in writing and despatch it 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."

This provision, which sets a clear timeframe expectation, is very welcome indeed.

IP Federation  
25 April 2018



## **IP Federation members 2018**

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd  
Airbus  
Arm Ltd  
AstraZeneca plc  
Babcock International Ltd  
BAE Systems plc  
BP p.l.c.  
British Telecommunications plc  
British-American Tobacco Co Ltd  
BTG plc  
Caterpillar U.K. Ltd  
Cummins Ltd.  
Dyson Technology Ltd  
Eisai Europe Limited  
Eli Lilly & Co Ltd  
Ericsson Limited  
ExxonMobil Chemical Europe Inc.  
Ford of Europe  
GE Healthcare  
GKN plc  
GlaxoSmithKline plc  
HP Inc UK Limited  
IBM UK Ltd  
Infineum UK Ltd  
Johnson Matthey PLC  
Merck Sharp & Dohme Ltd  
Microsoft Limited  
Nokia Technologies (UK) Limited  
NEC Europe  
Ocado Group plc  
Pfizer Ltd  
Philips Electronics UK Ltd  
Pilkington Group Ltd  
Procter & Gamble Ltd  
Renishaw plc  
Rolls-Royce plc  
Shell International Ltd  
Siemens plc  
Smith & Nephew  
Syngenta Ltd  
UCB Pharma plc  
Unilever plc  
Vectura Limited  
Vodafone Group