

# Appeal proceedings at the EPO: Do the new Rules of Procedure make things “Haar’der”?

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# Agenda

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- An introduction to the most significant changes – *Edward Farrington*
- Real-life examples of the stricter approach to appeal proceedings – *Jakob Pade Frederiksen*

# Procedure of the Boards of Appeal

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Updated Rules of Procedure  
Entry into force  
**1st Jan 2020**



# Boards of Appeal – status Oct. 2019

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- Average pending time of an appeal = 45 months
  - up from 42 months in Sept 2018
- Ca. 9400 pending cases
  - up from ca. 9000 in Sept 2018
- ...reform the Rules of Procedure
- *(other actions)*
  - *Partial refund of appeal fee;*
  - *Recruitment of Board members;*
  - *More Boards*

# Basic principles in the new Rules

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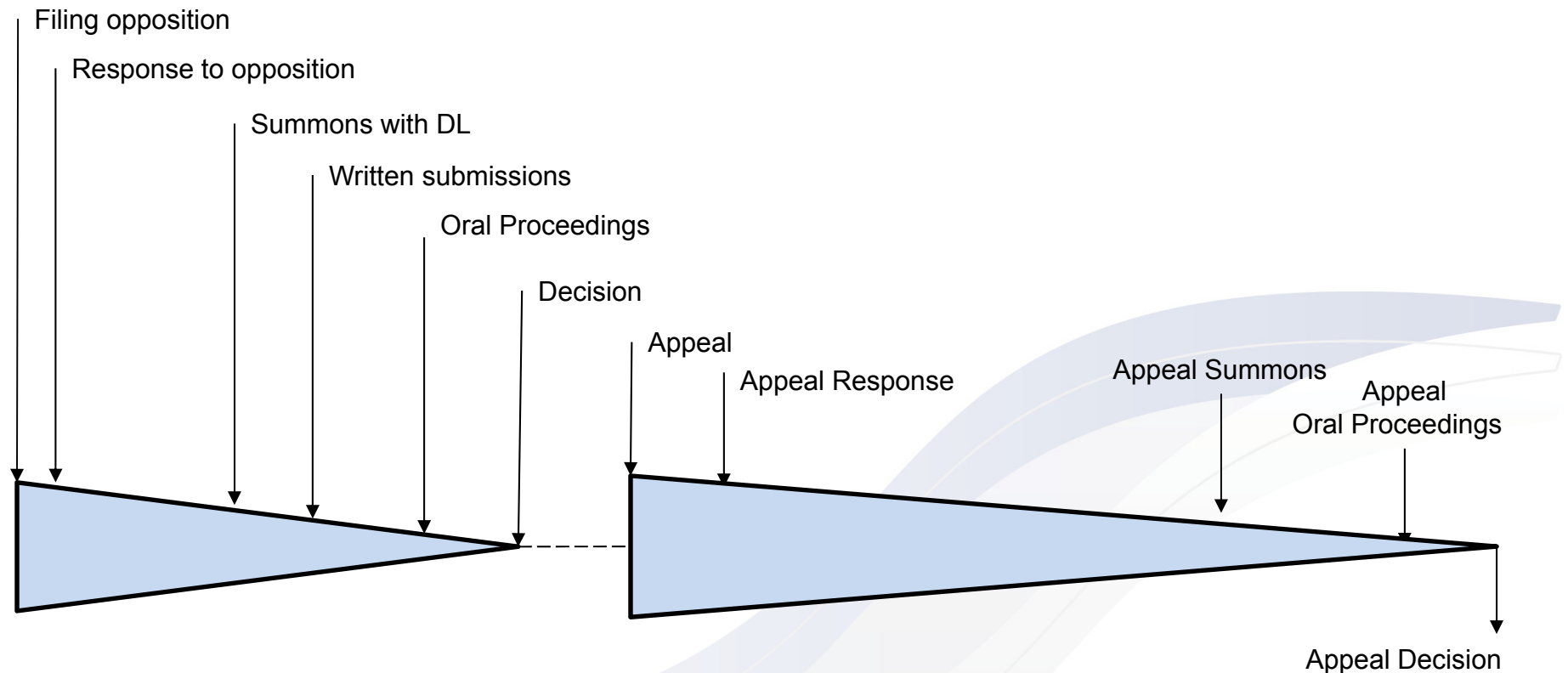
- “Review” instance
- Convergent approach (in all respects)
- Harmonised use of discretion by the Boards
- Parties must explain/justify their actions
- Procedural sanctions for non-compliance

# Basic principles in the new Rules

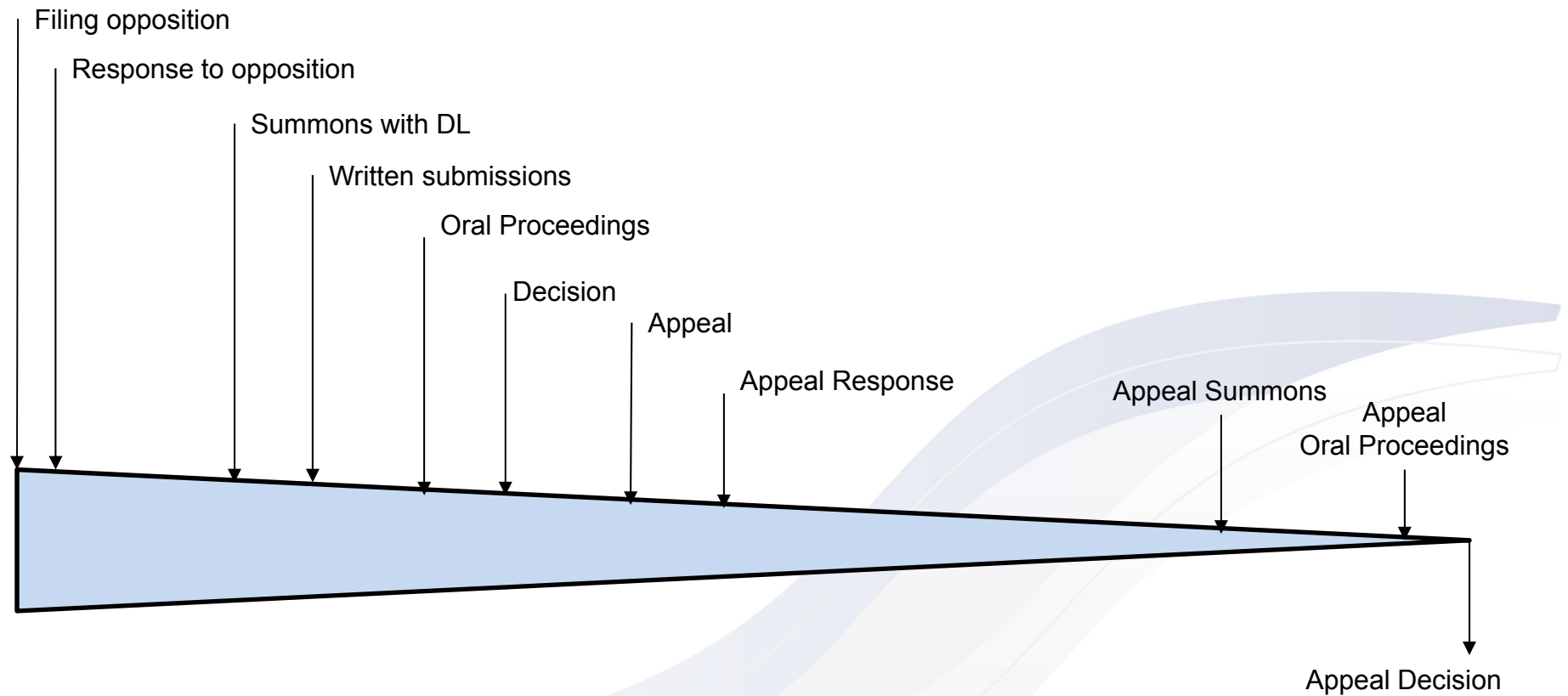
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- “*an amendment to a parties’ case*”...
- Not just claim amendments/requests
- Any action taken by a party before the EPO can constitute an “*amendment to a parties’ case*”...

# How opposition-appeal used to be...



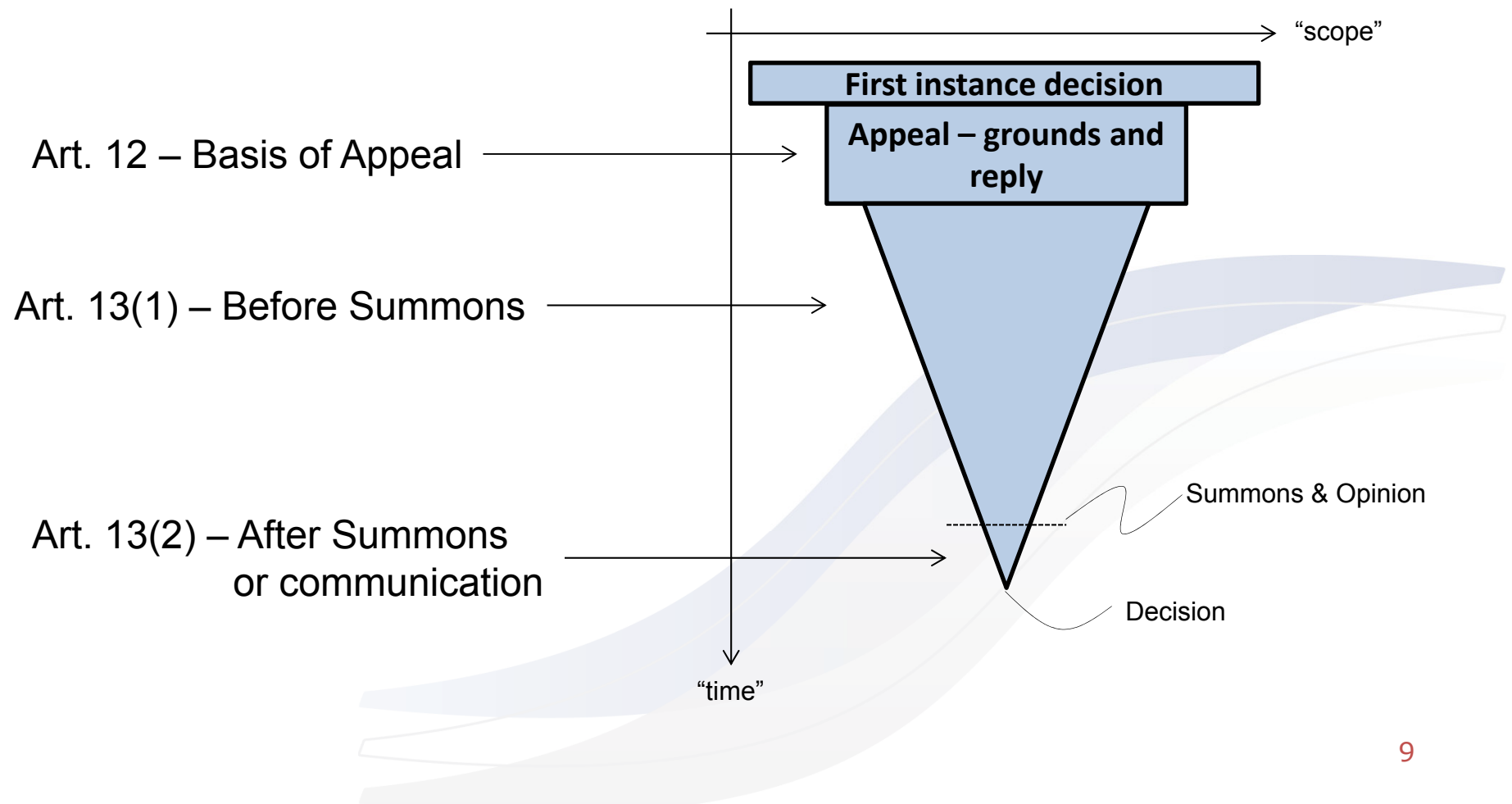
# How opposition-appeal is now...



...one continuous process



# Basic principles



## Article 12(1) – basis of proceedings

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- Appeal proceedings shall be based on
  - Decision and minutes of first instance OPs
  - Notice of appeal & Grounds of appeal
  - Reply to the appeal
  - Communication from Board
  - Minutes of any video or telephone conference in appeal
- ❖ “minutes”

## Art. 12(2)

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- ...a party's appeal case...shall be directed to the
  - requests,
  - facts,
  - objections,
  - arguments
  - and evidenceon which the decision under appeal...was based.
- "arguments" – what about Art. 114(2) EPC?
- Was the decision under appeal "based on" a particular argument?

## Art. 12(2)

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- Distinguish between
  - an "argument" and
  - an "objection" = "line of argument" / "line of attack"
- If novelty over D4 was already an issue, making a new interpretation/reading of D4 and continuing the line of argument should be acceptable
- If novelty over D4 was not already an issue, this may constitute a new "objection".
- "review" instance

## Recent Case Law - New Requests

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- T 2344/15 - During opposition oral proceedings, claim 1 of the sole request was found to lack novelty over D1.
- Requests 1-5 filed for the first time during appeal proceedings were not allowed (citing R.12(4) RPBoA 2007)

## Recent Case Law – New Arguments

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- T1621/09 – Board can decide not to admit a new line of attack filed during appeal oral proceedings even if the argument is based on evidence and facts already in the proceedings.
- T0988/14 – Claim 1 was found to be novel over D5. An inventive step attack, based on D5, and raised during oral proceedings (after novelty over D5 was established), was late-filed and thus not admitted.
- T1684/18 - Opponent unsuccessfully argued that there was no inventive step from E22 combined with E2. The appeal arguments still start from E22, but combined with new documents E33 to E35. Not admitted into the proceedings.

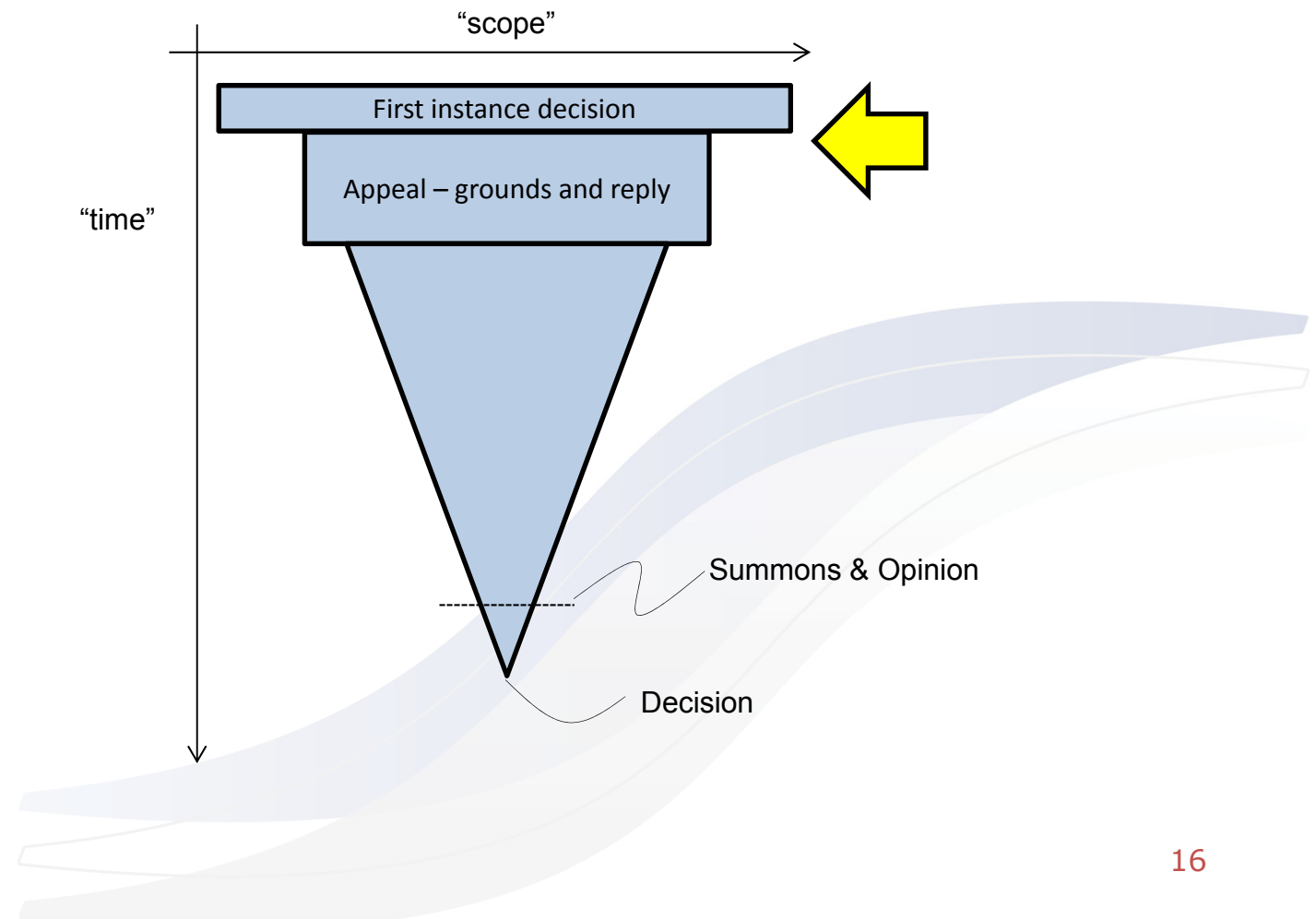
## Art. 12(3)

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- The statement of grounds of appeal and the reply shall contain a party's complete appeal case.
- Accordingly, they shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld...
- and should specify expressly all the **requests, facts, objections, arguments and evidence** relied on.
- (Art. 12(5) – the Board has the discretion not to admit any part of a submission by a party which does not meet the requirements in paragraph 3.)

# Art. 12(4)

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## Art. 12(4) – first sentence

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- “Any part of a party’s appeal case which does not meet...Art. 12(2) **is to be regarded as an amendment**, unless the party demonstrates that this part was **admissibly raised and maintained** in the (first instance) proceedings.”
- If a part of a case is not maintained; it is not automatically part of appeal proceedings.
- Not just “raised” – “admissibly raised”
- It may be admitted under the “late-filing” considerations
- “amendment” ≠ “claim amendment”

## Art. 12(4) – second sentence

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- Any such amendment shall be admitted **only at the discretion of the Board**
- ...party shall clearly identify each amendment and provide reasons for submitting it in the appeal...
- ...and provide reasons why the amendment overcomes the objections raised.
- Onus on parties:
  - What is amended?
  - Why?
  - Why not earlier?
    - All the way back to first-instance proceedings.

## Art. 12(6) – what is not admitted

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- Board **shall** not admit facts/evidence etc...**which was not admitted by the department of first instance**, unless
  - an error in the use of discretion
  - circumstances of the appeal justify the admittance
- What is "out", stays "out"...
- The Board shall not admit requests, facts, objections or evidence which **should have been submitted, or which were no longer maintained**, in (first instance) proceedings... unless the circumstances of the appeal case justify their admittance.

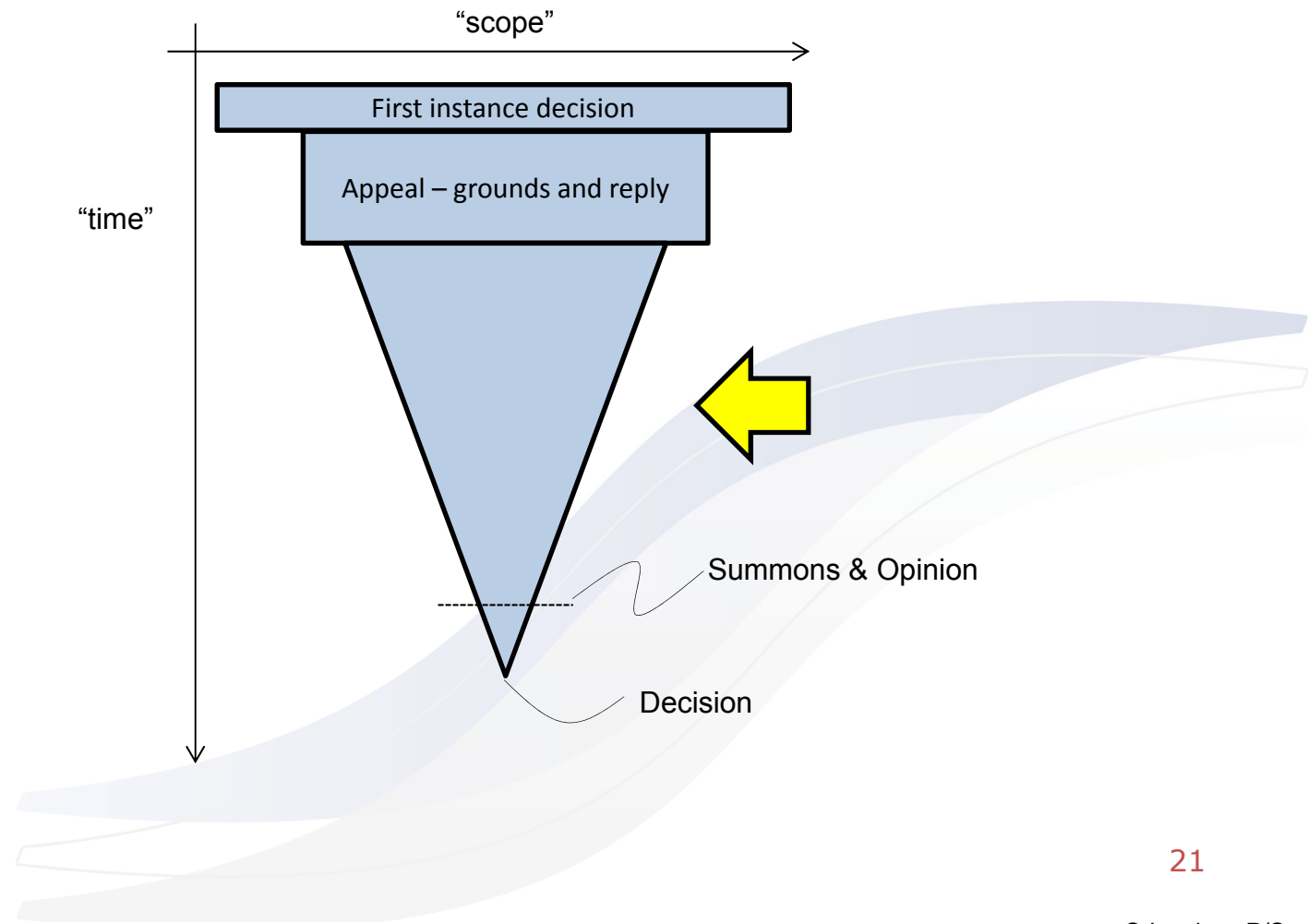
## Art. 12(7) – period for response

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- Periods for response may...in exceptional cases...be extended...
  - Requires a written reasoned request.
  - Up to a maximum of 6 months
  - “complex cases”

# Art. 13(1) – second stage

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## Art. 13(1) – second stage

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- Any amendment at this stage is subject to party justification
- Admitted only at the discretion of the Board
- Justification required
  - May be a “response” to the actions of the other party or a change in the legal or technical situation

## Art. 13(1) – second stage

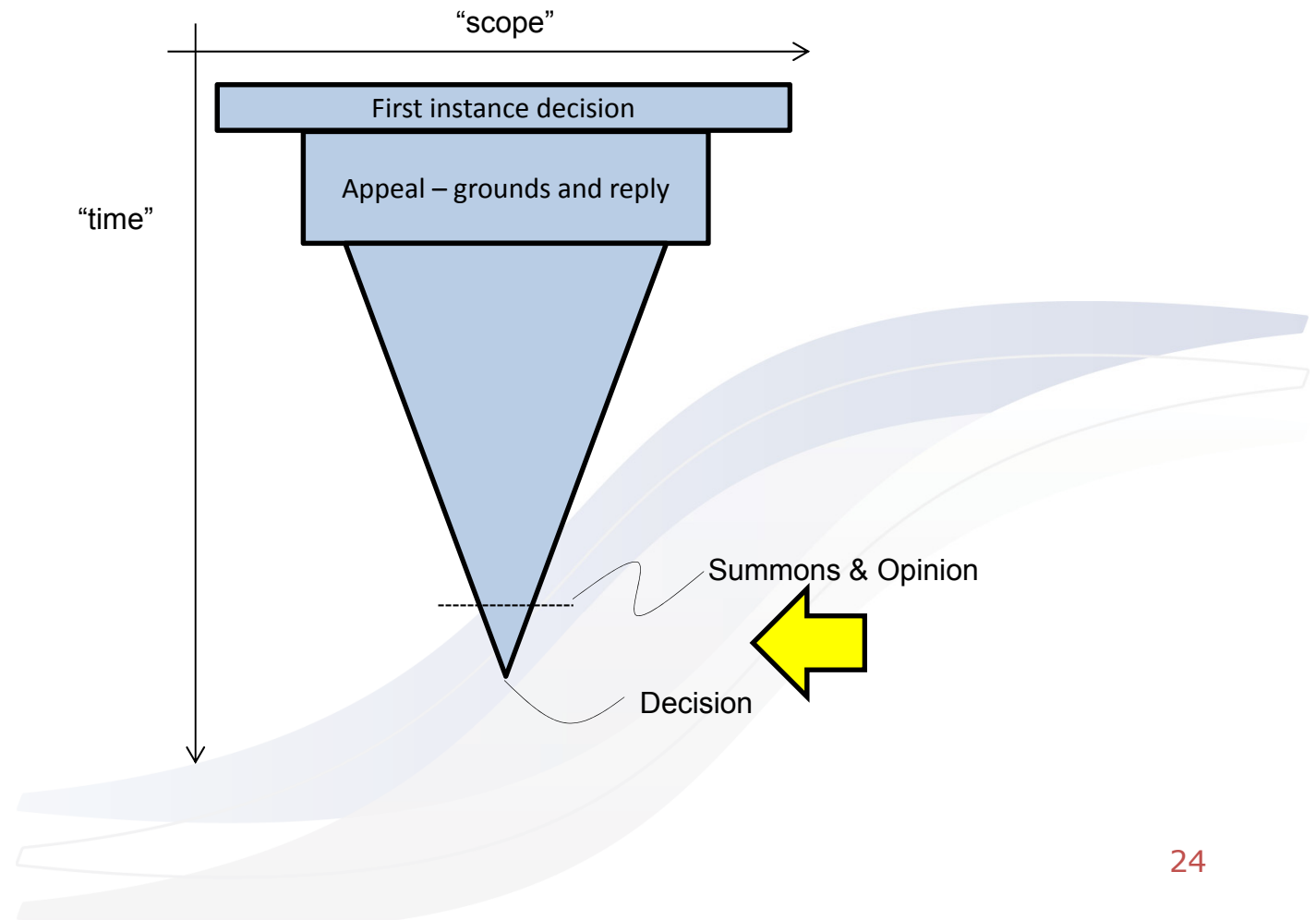
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“Discretion” standards” :

1. Is the amendment detrimental to procedural economy?
2. Demonstrate – prima facie – that the amendment overcomes issues without introducing new issues

# Art. 13(2) – third stage

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## Art. 13(2) – third stage

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Any amendment...filed...

...after...expiry of a period in a communication under R.100(2)  
EPC, or

...after summons to oral proceedings

...**shall, in principle, not be taken into account**, unless  
there are exceptional circumstances,

...which need to be justified by the party concerned.

## Art. 13(2) – third stage

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- A preliminary opinion is not an invitation to comment/amend
  - It does not contain a deadline (cf. opposition proceedings)!
  - The issuance of an (unfavourable) preliminary opinion cannot in itself be used as justification for filing amendments – *T1473/13*
  - A party should not await a Board's preliminary opinion to only then consider an argument seriously threatening its case – *T314/15*

## Art. 15(1) – 2 months

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- In cases where there is more than one party, the Board shall endeavour 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)**
- *I.e. you always have at least 2 months between the written reply to the appeal and the issuance of a Summons*
  - *The “intermediate period” should always be > 2 months long*

## Other matters

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- The Boards will publish a list of cases which they expect to deal with during the subsequent year (published Oct-Nov the year before) – Article 1(2) RPBoA
- Compulsory communication which accompanies the summons
- Connected cases to be dealt with together

# Tips

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- Frontload:
  - Provide your **complete case at first-instance**, with an eye on appeal proceedings
  - **Maintain everything** in appeal; repeat it explicitly
  - **Justify everything** – e.g. a change in the subject of proceedings...
- Monitor the list of cases which the Boards intend to deal with (published Oct-Nov the year before)

# Tips

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- Be pro-active! Especially in the “second stage”
  - Consider adding a 2-month deadline in your system
  - Don’t wait for the summons/opinion
- Expect that – if you file amendments to your case after a summons to oral proceedings – they will not be accepted
- Review ongoing cases **now!**

# Transitional provisions

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RPBA 2020 **applies to all appeal cases**, but:

1 - New Art 12(4) and Art 12(6) are not applicable to a statement of grounds filed before 1 Jan 2020 or replies thereto filed within 4 months

(to avoid different standards being placed on different parties)

2 - If a summons has already been notified on 1 Jan 2020; the new Art 13(2) is not applicable

(to avoid the very strict Rule 13(2) for cases where OPs are scheduled)

# Questions/Discussion?

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# Real-life examples of the stricter approach to appeal proceedings

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- *"The new Rules of Procedure are meant to reflect the Boards' current practice under the existing provisions"*
- Really...?

## T 55/11 – 16.02.2016

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- An inventive step objection based on D13+D1 was raised for the first time by one of the opponents during oral proceedings before the BoA
- Referring to Art. 12(2) and 13(1) the proprietor objected to the admissibility of this new objection which had never been raised before
- Admitted?

## T 55/11 – continued

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- Yes!
- In its preliminary opinion the BoA had indicated that inventive step in view of D1+D13 might be discussed
- The proprietor "**could have foreseen**" that the new argument, i.e. D13+D1, "might well become a subject for discussion"
- The new argument **was not considered incompatible with, or contradictory, the opponents' previous case**

T 55/11 – would admissibility have been decided otherwise under the new RPBA?

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- Art 12(2) – ... a party's case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based.
- Art 13(2) – Any amendment to a party's appeal case made ... after notification of a summons to oral proceedings **shall, in principle, not be taken into account unless there are exceptional circumstances**, which have been justified with **cogent reasons** by the party concerned.

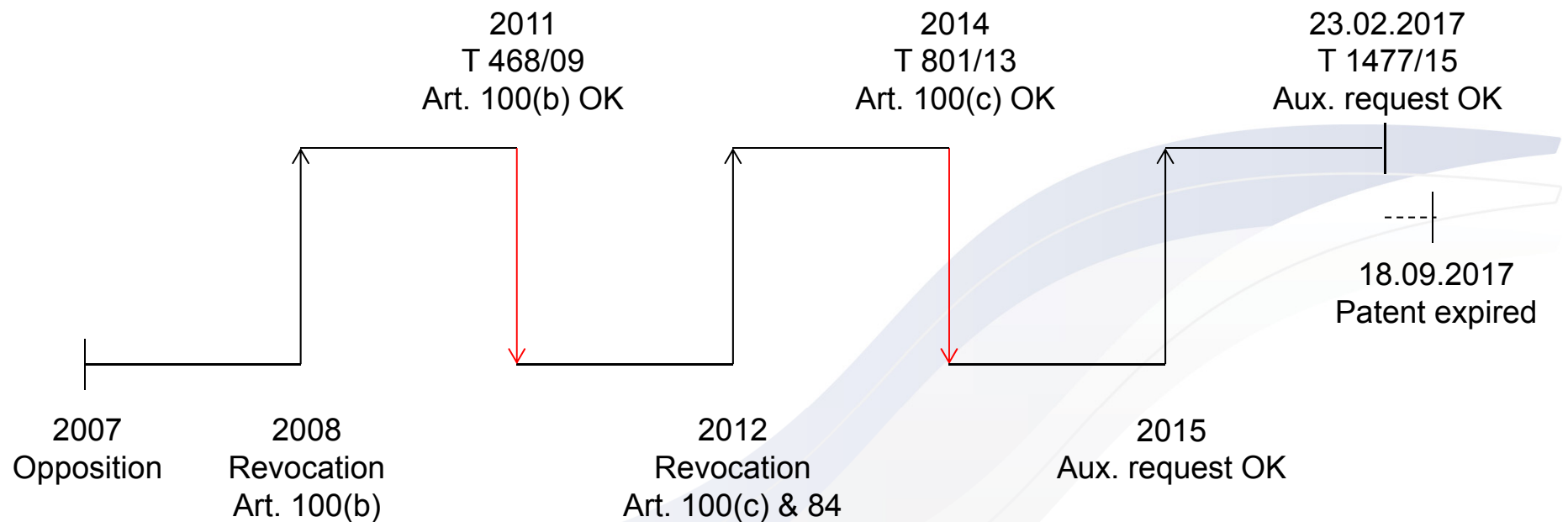
## Art.11 - Remittal

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- The Board shall not remit ... unless special reasons present themselves for doing so.
- BoA explanatory remarks:
  - ... it is to be expected that **more issues will be raised and dealt with in the proceedings at first instance ...**
  - The aim of the new provision is to **reduce the likelihood of a "ping-pong" effect** between the Boards and the ... first instance and ... undue prolongation of the entire proceedings...
  - If all issues can be decided without an undue burden, a Board should **normally not remit** the case

# The saga of EP 1 145 729

Divisional application filed in 2001 (parent filed in 1997)



## T 1477/15

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- New auxiliary request 3 filed at 20:30 o'clock during oral proceedings on Day 2 (17 Nov. 2016) of the oral proceedings before the Board of Appeal (9 years after the opposition proceedings were instituted; 8 years after the first oral proceedings)
- The new auxiliary request was...  
... admitted or not admitted...?

## T 1477/15

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- Admitted
- New auxiliary request was basically a combination of other requests already on file; the BoA failed to see **why the opponents could not deal with the new request** when they must have been prepared to address the other three
- **Procedural efficiency**: requiring the proprietor to file all possible combinations dealing with all possible objections right at the start of the proceedings **would have made the proceedings unnecessarily complex**



## A blast in early 2018

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- First draft for the new RPBA were released on 1 February 2018.
- Exemplary case, oral proceedings (appeal) January 2018:
  - Alleged prior public use at stake
  - In the appeal proceedings, the proprietor's new representative pointed to inconsistencies in the evidence filed in support of the alleged prior public use
  - Chairman: *"please point to those parts of the first-instance file which prove that your arguments were also raised in the first-instance proceedings"*

# Proceedings pertaining to T 2250/15 of 21.05.2019

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- The day before oral proceedings in the first-instance proceedings in 2015, the proprietor filed 10 auxiliary requests without accompanying substantiation re. patentability
- The opposition was rejected in first-instance proceedings; the auxiliary requests were never discussed
- When replying to the opponent's appeal, the proprietor stated that he 'maintained' the 10 auxiliary requests filed with in the first instance
- Referring to case law, the opponent objected to the admissibility of the auxiliary requests for lack of substantiation thereof

## Oral proceedings in T 2250/15

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- Main request not allowed due to lack of inventive step
- No one of the auxiliary requests admitted into the proceedings due to lack of substantiating arguments in the written file
- New auxiliary request filed by the proprietor during the oral proceedings not admitted
- Patent revoked

## T 1082/15 of 23.09.2019

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- Preliminary opinion indicated that auxiliary request 6 might potentially have been allowable
- AR6 was based on claim 5, albeit slightly reworded to conform to the description (reminiscence from pre-G 3/14 situation in 1<sup>st</sup> instance)
- At the oral proceedings, the BoA held that AR6 included added matter
- The proprietor filed new AR6a which combined claims 1 and 5 as granted
- New AR6a was not admitted; no reasons were given at the oral proceedings
- Patent revoked

# Conclusions

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- In recent cases (as of early 2018) the Boards of Appeal seem to have followed an approach which is in line with the new Rules of Procedure.
- The EPO Boards of Appeal have a tradition of arrogating far-reaching and not always consistent discretionary powers. This might not change under the new RPBA.
- Prediction: non-negligible procedural uncertainties will remain under the future regime.
- Parties are well advised presenting their facts, evidence, arguments and requests as early and as complete as possible.
- It remains to be seen if the departments of first instance will implement changes in view of Art. 11 RPBA