

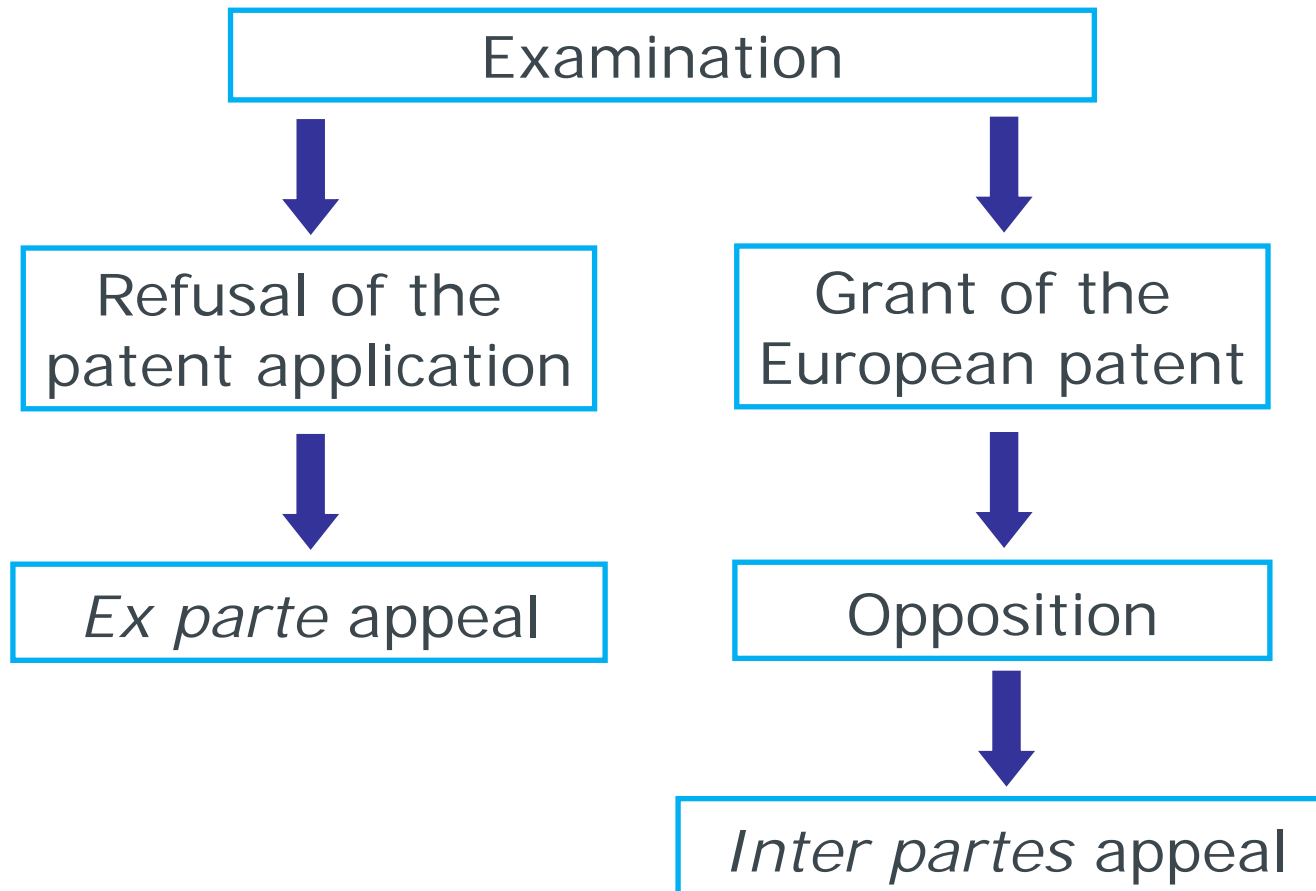


The influence of the Rules of Procedure on the decisions of the boards of appeal of the EPO

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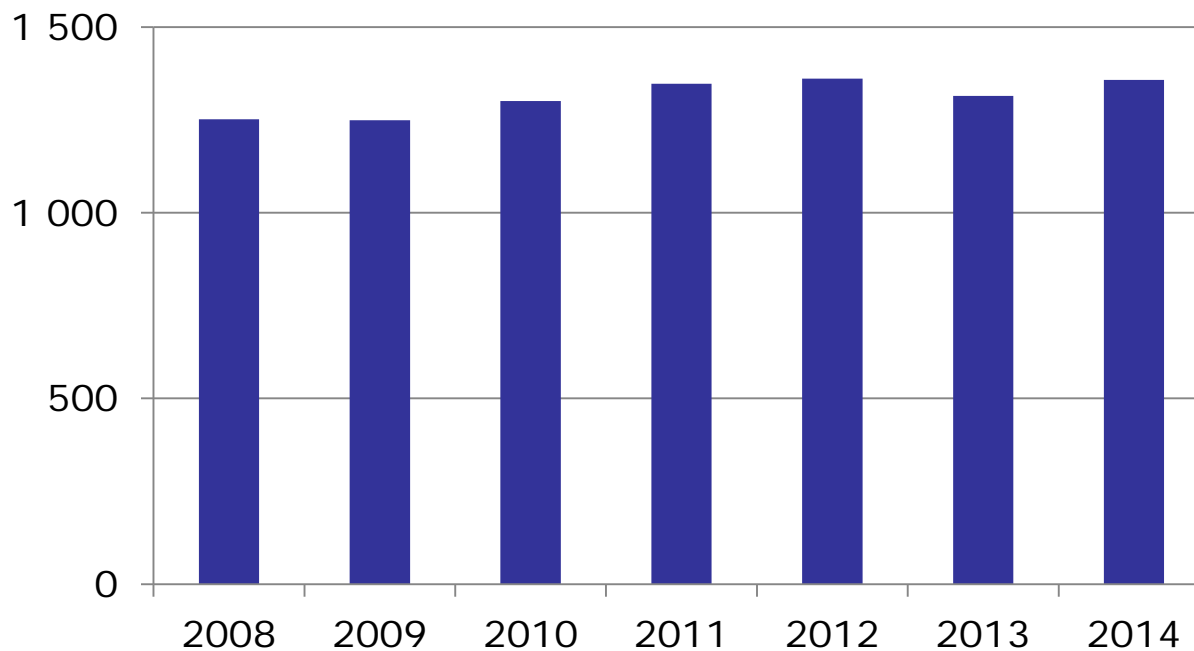
EIPIN - Strasbourg - 29.01.2016

Introduction



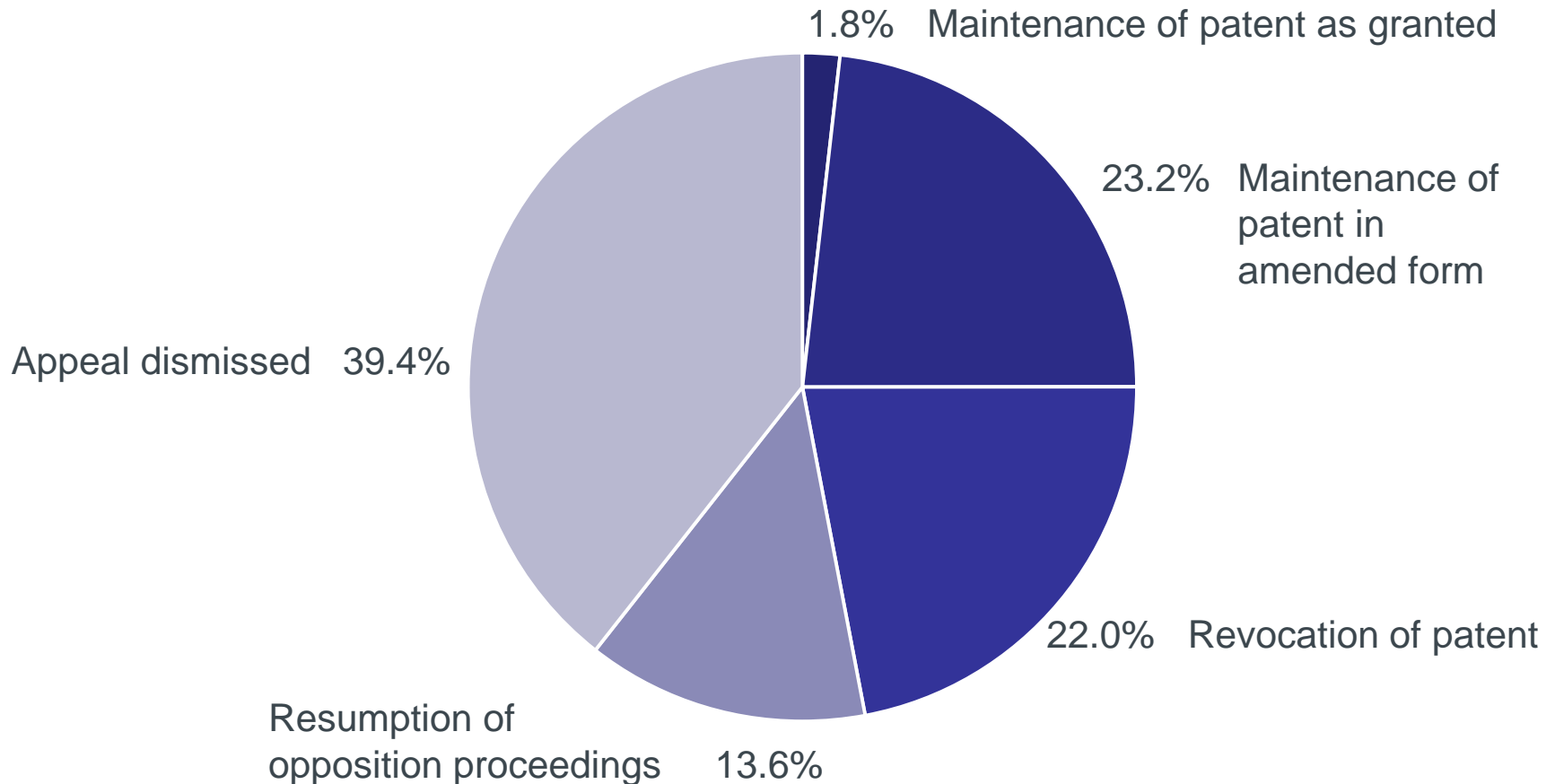
Introduction

Appeals received - *inter partes*



Technical boards of appeal

Introduction



Technical boards of appeal - *inter partes* appeals

Proceedings before the boards of appeal

- Appeal proceedings are **separate and independent** from grant/opposition proceedings
- Principal function: give a **judicial decision upon the correctness of the earlier decision** taken by the examining/opposition division
- Appeal proceedings are not confined to a judicial review but **also involve the examination of the procedural and patentability requirements** in the preceding proceedings
- However, the boards of appeal are not going to repeat everything

Independence of the boards of appeal

- In their decisions, board members are **not bound by any instructions** and have to comply only with the provisions of the European Patent Convention
Art. 23(3) EPC
R 19/12, R 2/14, R 8/13
- **Judicial nature of the boards**
 - The boards are courts: confirmed by the Patents Court of the UK, the German BGH and the German Constitutional Court (however, new case presently pending)
 - Legitimacy of proceedings before the boards: recognised by the European Court of Human Rights
 - Decision of the CJEU not binding on the boards R 1/10

Appeal - Legal framework in the European Patent Convention

- Art. 108 EPC: File **notice of appeal** + pay **appeal fee** + file **grounds of appeal**
- Art. 107 EPC: Only a **party to proceedings** who is **adversely affected** by the decision may file an appeal
- Art. 110 EPC: Examination of appeals
- Art. 111 EPC: Decision in respect of appeals
- Procedural details in Rules 99-103 EPC

Rules of Procedure of the Boards of Appeal

- The [Rules of Procedure of the Boards of Appeal](#) (RPBA) place the admission of late requests at the boards' discretion
- The parties are responsible to submit:
 - Facts (e.g. an anticipatory document)
 - Evidence (e.g. experimental proof)
 - Requests (e.g. new set of claims) or
 - Argumentsas [early and completely](#) as possible
- Reason = expedite proceedings + principle of fairness towards the other parties

Rules of Procedure - Complete case

- **Article 12(2) RPBA**

The statement of grounds of appeal (appellant) and the reply (respondent) shall contain a party's **complete case**

- **Article 12(4) RPBA**

The board can hold inadmissible facts, evidence or requests which

- could have been presented, or
- were not admitted

in the first instance proceedings

Rules of Procedure - Late filings

- **Article 13(1) RPBA**

The board has discretion not to admit any amendment to a party's case after it has filed its grounds of appeal or reply

The discretion shall be exercised in view of *inter alia*

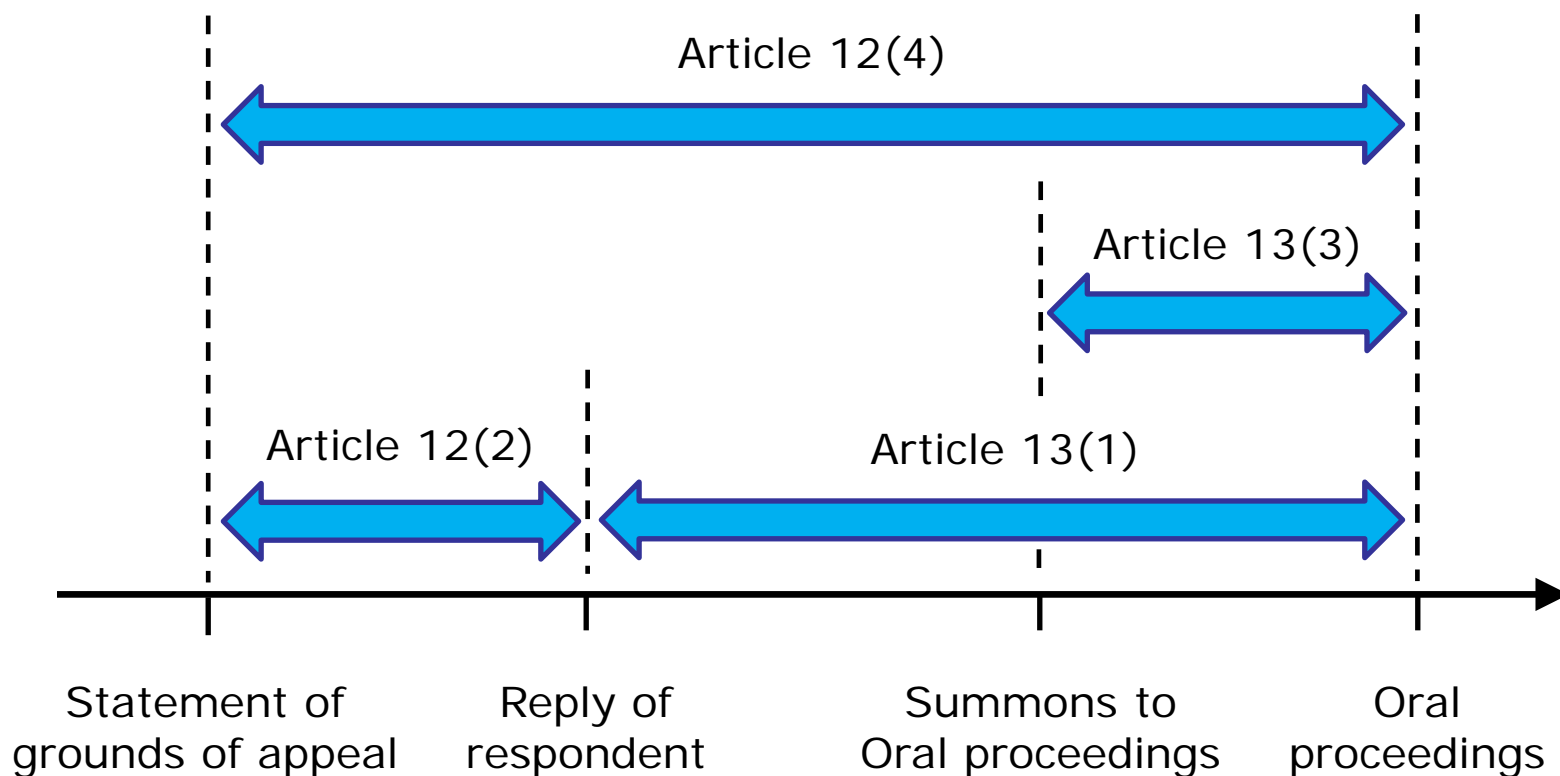
- the complexity of the new subject matter submitted,
- the current state of the proceedings, and
- the need for procedural economy

Rules of Procedure - Late filings

- **Article 13(3) RPBA**

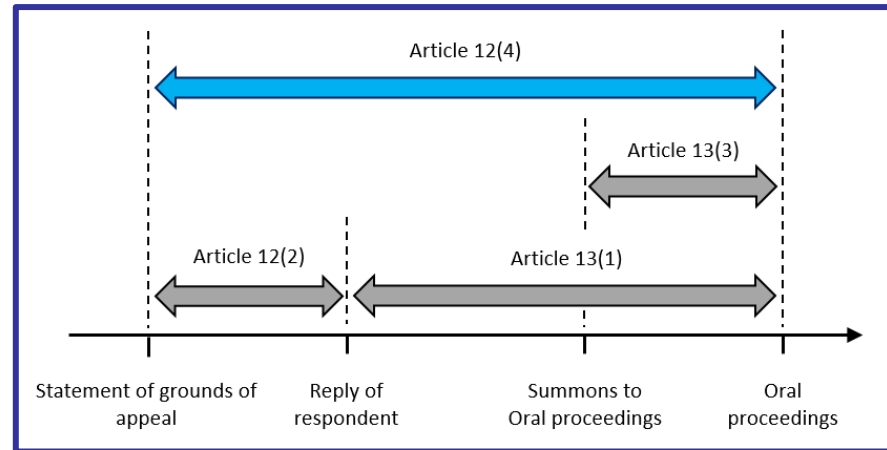
Amendments **after oral proceedings have been arranged shall not be admitted** if they raise issues which the board or the other party or parties **cannot reasonably be expected to deal with without adjournment** of the oral proceedings

Rules of Procedure - When applicable



Late filings - New claim requests

Art. 12(4) RPBA



- The mere fact that a request could have been filed in the first instance proceedings **as such** does not automatically lead to the inadmissibility of this request under Art. 12(4) RPBA
- Waiting for appeal to meet an objection raised already in opposition proceedings is not admissible
 - Against an independent claim T 339/06, T 1705/07
 - Against a dependent claim T 23/10, T 144/09

Late filings - New claim requests

Art. 12(4) RPBA

- Filing a set of claims in appeal that is **broader** than the main request in opposition is normally not admissible T 2075/11
- Re-filing in appeal a set of claims that was **withdrawn** in opposition proceeding may not be admitted
T 361/08, T 691/09, T 1525/10
- **Conclusion:** Consider carefully which claim sets you file or withdraw in the first instance proceedings

Late filings - New facts or evidence

Art. 12(4) RPBA

Prima-facie relevance test

- A document filed late in opposition-appeal proceedings **may be admitted** by the board, in particular in a situation where it is *prima facie* prejudicial to the maintenance of the patent
T 2542/10
- A document is filed late also if it is filed with the statement of grounds of appeal
Hence, if this document is **not *prima facie* relevant, it need not be admitted** into the proceedings
T 2020/09

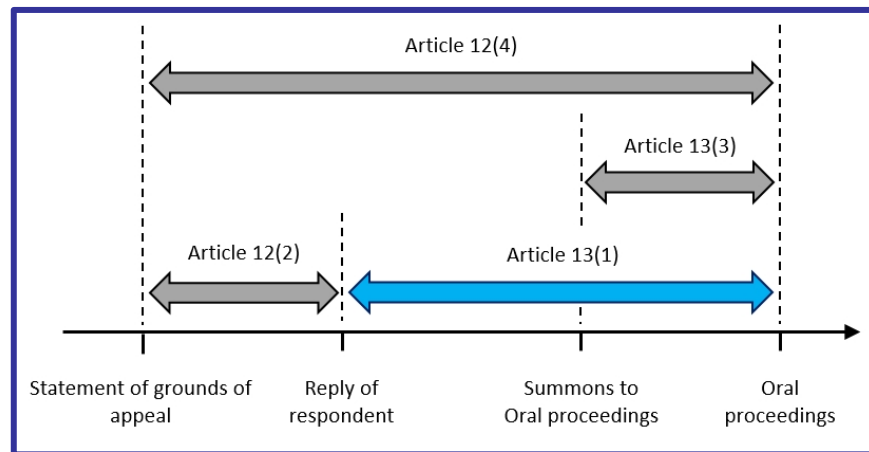
Late filings - New facts or evidence

Art. 12(4) RPBA

New submission as a reaction

- The submission by an appellant of **new evidence** in the statement of grounds of appeal **to overturn the appealed decision** is to be considered as a normal action of a losing party and thus is admissible T 295/08
- If an opponent, upon filing an appeal submits a **new document as a reaction to amendments filed during or shortly before oral proceedings in opposition**, the document is not late-filed T 736/99, T 241/10

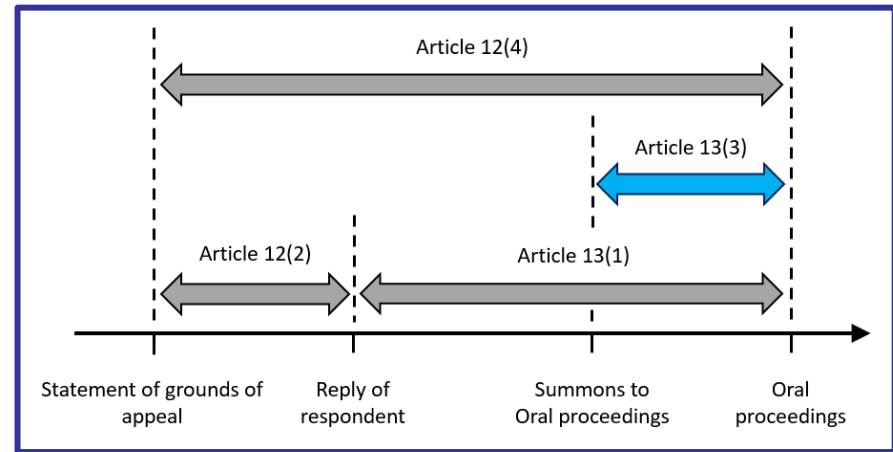
Late filings - New claim requests Article 13(1) RPBA



- 'Complexity' = complexity of technical content or procedural complexity
 T 316/08
- The later a new claim request is filed and the less clearly allowable it is, the smaller the likelihood of admittance
 T 754/01, T 1033/10

Late filings - New claim requests

Article 13(3) RPBA



- It is at the board's discretion to admit claim sets filed after the summons for oral proceedings Art. 13(3) RPBA
- To exercise this discretion it has to be considered **whether it can be expected** from the board and the other parties **to get familiar with the content of the claim sets before the date of oral proceedings**

T 427/05

Late filings - New facts or evidence

Article 13(1) and (3) RPBA

- A **new** inventive step **attack** on the basis of a **new closest prior art** document (the document was already in the proceedings upon filing opposition, but not as closest prior art), made **for the first during the oral proceedings** before the board, is not admissible pursuant to Art. 13(1) and (3) RPBA, since this attack **raises complex new issues** that cannot be dealt with at the oral proceedings

T 1761/10

Influence RPBA - Summary

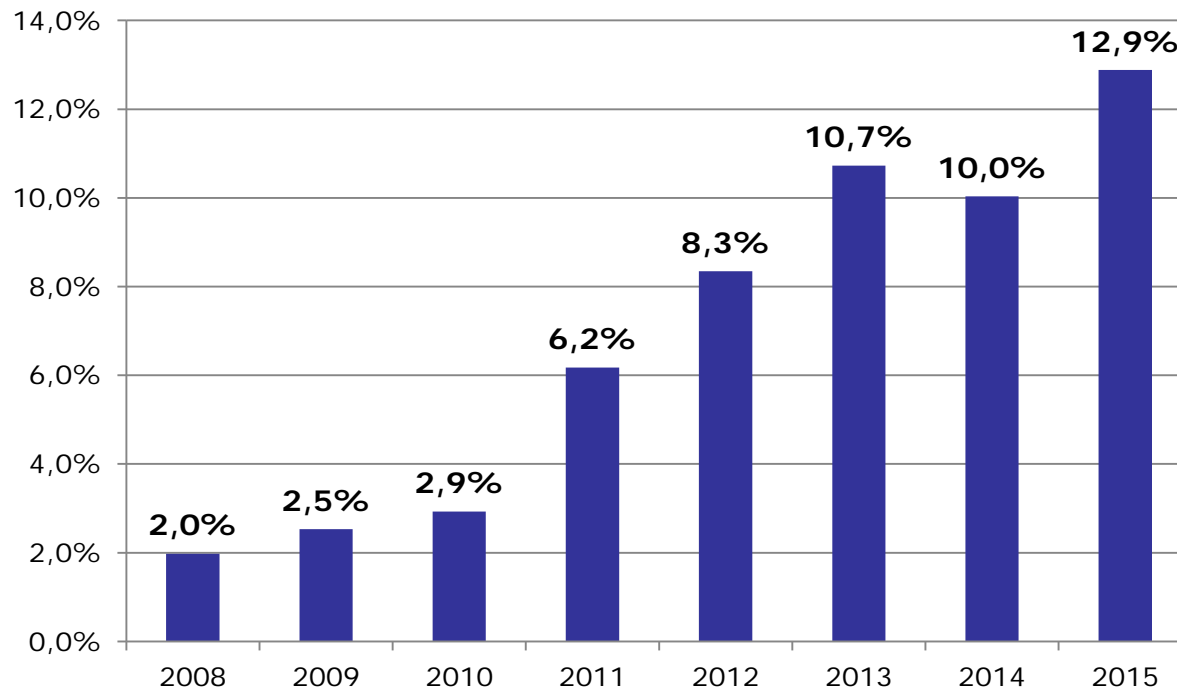
- New facts/evidence or claim requests most likely will be admitted if truly filed as a **reaction to a new submission** by the other party or the board or to a point raised in the opposition proceedings for the first time during the oral proceedings
- There may be a chance that **new** facts/evidence are admitted if they are **really *prima facie* relevant**
- In the same way, new claim requests may be admitted if they are **really *prima facie* allowable**

Influence RPBA - Summary (2)

- If new facts/evidence or claim requests are filed after the grounds or reply thereto and the new facts/evidence or claim requests **raise new issues** the other party has not had sufficient time to react to, the new facts/evidence or claim requests most likely will not be admitted, in particular if filed after the summons

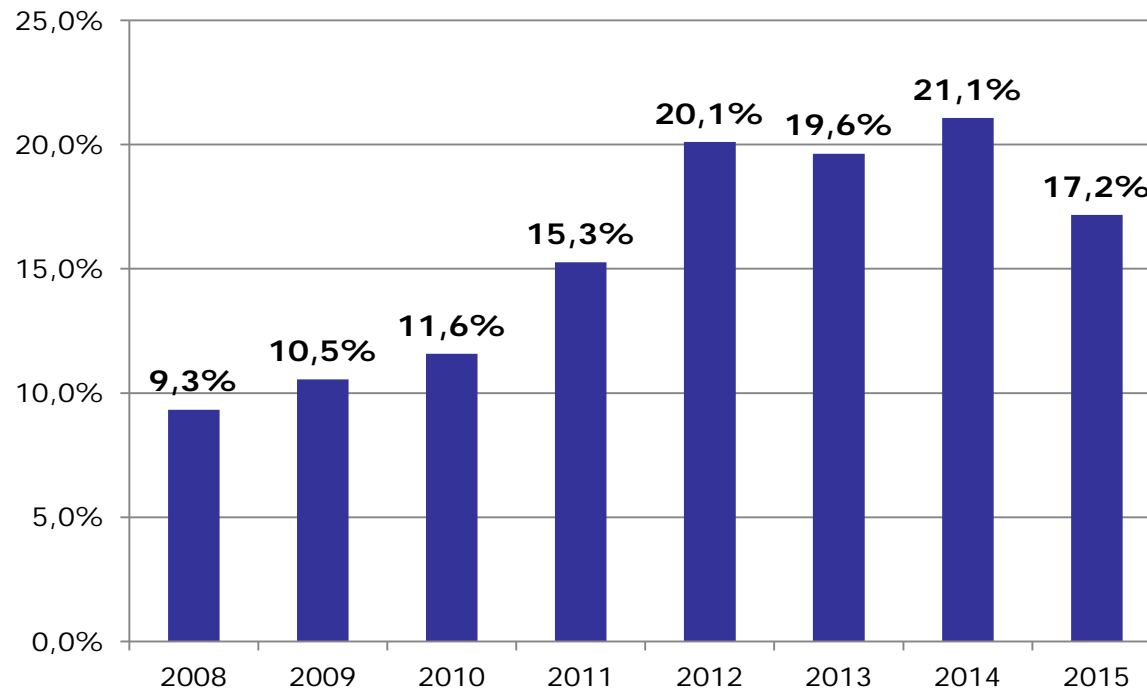
Impact of RPBA on Decisions

- Number of cases before the boards of appeal where in the 'Reasons for the Decision' reference is made to [Art.12\(4\) RPBA](#)



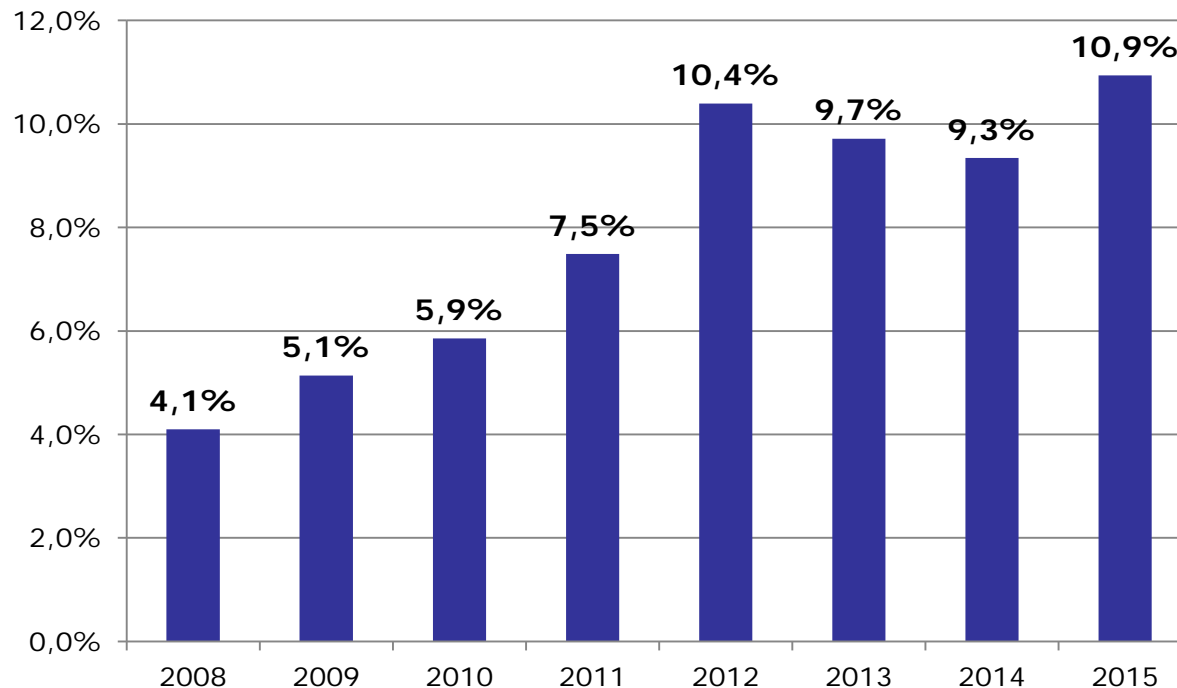
Impact of RPBA on Decisions

- Number of cases before the boards of appeal where in the 'Reasons for the Decision' reference is made to [Art.13\(1\) RPBA](#)



Impact of RPBA on Decisions

- Number of cases before the boards of appeal where in the 'Reasons for the Decision' reference is made to [Art.13\(3\) RPBA](#)





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Thank you for your attention

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