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T 0969/14 and late-filed submissions in EPO oppositions

Arnie Clarke (GJE Intellectual Property) · Monday, October 22nd, 2018

T0969/14 is the latest in a long line of decisions which make it clear that the EPO Boards of appeal will not accept late filed requests which could have been filed in first instance proceedings, whether or not the submission of such requests might be perceived as a procedural abuse.

One of the consequences of decisions like this is a proliferation of auxiliary requests in first and second instance opposition proceedings. This, in turn, is being used by patentees to justify certain procedurally abusive behaviours in oral proceedings which are disadvantageous to opponents.

How has this come about, and what can the EPO do to redress the balance?

The Law and the Rules of Procedure of the Boards of Appeal

The EPC and the Implementing Regulations do not contain explicit provisions concerning the admissibility of amendments in appeal proceedings. Therefore, appellants are not entitled, as a matter of right, to present amendments of their own volition at the appeal stage, but as a matter of discretion to be exercised by the board.

Article 12(4) RPBA gives the Board of Appeal the discretion over whether or not to admit requests which could have been, but were not, presented at first instance:

“Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2).”

When exercising its discretion, the Board must take due account of the judicial nature of the appeal procedure and the interests of the parties concerned. Admission of a new request into the proceedings hinges on the question whether a party to appeal proceedings was in a position to make its submission earlier, and whether it could have been expected to do so under the circumstances.

The Case Law

In T 01178/08 (an appeal from the Examining Division), amended claims filed with the statement of grounds of appeal were deemed not to be a reaction to the reasoning underlying the appealed decision. Instead they were the result of the applicant's decision no longer to pursue claim 1 as

originally filed and to submit a fresh case to the board of appeal.

The board decided that the amended claims should have been submitted in the first-instance proceedings. By presenting its sole and amended request only in appeal proceedings the applicant made it impossible for the Board to examine the contested decision.

In T 01067/08 the Board noted that bad conduct is not required in order for Article 12(4) RPBA to be used in rejecting auxiliary requests. The purpose of first and second instance is not to enable forum shopping. Instead, the Board emphasised the necessity to maintain “the proper distribution of functions between the departments of first instance and the boards of appeal” and that the tactics of parties shall not be used to alter this distribution.

The Enlarged Board of Appeal seems to concur with this approach, rejecting as unallowable the referral R 0013/11 from original decision T 0023/10. T 0023/10 applied a similar line of reasoning to T 0167/08.

Recent decision T 0969/14 follows a similar line of reasoning to T 0023/10. The patentee was adequately warned by the opposition division that a particular document was potentially relevant as prior art, but chose not to file a request dealing with the problem at first instance.

Only on appeal the patentee decided to file documents (which had been in its possession from the outset of the proceedings) and a claim request which dealt with the problem.

The Board decided that the patentee was bringing an entirely fresh case, and that this is not in line with the purpose of the appeal proceedings. Consequently, the Board exercised its discretionary power and decided to not admit the auxiliary request in the appeal proceedings.

In doing so, the Board pointed out that its function is mainly to give the losing party an opportunity to challenge the administrative decision against it and to obtain a judicial ruling on whether this decision is correct. Since the appeal board, as a review instance, cannot be expected to deal with all the outstanding issues after the amendment of the appellant’s case, admission of the auxiliary requests into the proceedings would give the appellant the opportunity to compel the board to remit the case. This would be contrary to a reliable and fair conduct of proceedings.

Effects on Patentee Conduct in Opposition Proceedings

The earlier filing of auxiliary requests in opposition proceedings is an effect of these types of appeal decisions. This is a desirable result as it minimises the risk of opponents having to deal with late requests, and it enables the opposition division to consider the patentee’s whole case prior to oral proceedings, thereby allowing it to come to a reasoned and fair decision.

Unfortunately, such decisions have also led to the proliferation of auxiliary requests, as patentees attempt to deal with all objections and various permutations. It is now not unusual to see upwards of 30 auxiliary requests in response to an opposition, at the Rule 116 stage or with the grounds of appeal.

This is an understandable and arguably proportionate reaction to potential preclusion of such requests being admitted if submitted at a later date. However, it is the opinion of the author that such justifiable behaviour is being piggy-backed by unjustifiable procedural abuse in the form of delaying tactics at oral proceedings.

As the EPO has been trying to speed up the opposition procedure, diaries have filled up with oral proceedings, most frequently one-day hearings. Additional days are only added in exceptional circumstances. Therefore, it is the responsibility of the parties, and particularly the opposition division, to ensure that the oral proceedings are conducted efficiently in order to arrive at a final decision on the day.

In first instance oral proceedings it is becoming increasingly common to find that the patentee employs delaying tactics. These include lengthy oral submissions, repetition, irrelevant arguments, the drip-feed of arguments, and the like. This often results in the decision on the main request of the patentee not being decided upon until late in the day.

Being confronted with such circumstances, the opposition division is left with a decision to give the patentee the “benefit of the doubt” and allow one of its early requests, or to continue the hearing late into the night. It is the author’s experience that the former choice is taken more frequently than the latter, and the decision unfairly goes the way of the patentee.

How should the EPO respond?

The EPO really only has two options in how it can reduce or eliminate unfair outcomes for opponents.

On the one hand, it can instigate longer hearings. However, it rarely does this of its own volition, and only slightly more frequently when asked to do so by an opponent who is wise to the possible problems down the line. This is understandable, given the level of subsidy that the EPO affords opposition proceedings. It justifiably does not want to voluntarily add to its costs.

It is also the case that the EPO will not be able to predict the behaviour of the parties to the proceedings until the hearing. Therefore a two-day hearing will often be unnecessary between cooperating and reasonable parties.

Consequently, such measures will only likely add to the administrative and cost burden on the EPO, and slow down the progress of opposition procedures as a whole. Parties themselves may also begrudge the added expense of an extra hearing day.

Alternatively, the opposition division could be more assertive and interventional in directing the conduct of the oral proceedings. In the author’s experience, opposition divisions (and increasingly the Boards of Appeal) are becoming less and less interventional. This seems to be a reaction to it not wanting to be accused of breaching the right of the parties to be heard, hence opening itself to an allegation of procedural violation.

However, this reaction is frequently an over-reaction. The right to be heard is not a right to be re-heard; it is not breached by preventing the parties from repeating themselves and dealing quickly and dismissively with irrelevant arguments.

If the opposition division wishes to prevent all too frequent patentee gamesmanship, and to provide a fair outcome for all parties, it must direct proceedings with greater authority, and be prepared to intervene more frequently.

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