

# Kluwer Patent Blog

## Happy New Year? Entry into force of the new Rules of Procedure of the Boards of Appeal

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As the clock strikes midnight on 31 December 2019, we hope that the new [Rules of Procedure of the Boards of Appeal \(RPBA\)](#) will not be the first thing on our minds. Nevertheless, the beginning of this new decade will mark the entry into force of these new rules, which look set to have a significant impact on appeal proceedings.

When first announced, the new RPBA were presented as part of the plan to increase the efficiency of the Boards without reducing the quality of the decisions issued. Several of the amendments will contribute towards these goals by changing the internal organization of the Boards. However, there is a growing realization that several of the other amendments concerning the appeal procedure as it is experienced by EPO users are unlikely to improve efficiency, and may even be detrimental to overall quality if they are not applied prudently.

In the following, we will discuss the most important changes to the appeal proceedings for EPO users, and will provide our analysis on whether they are likely to help achieve these twin goals of the EPO of increased efficiency while maintaining quality.

### 1. Remittal of case to the first instance

The Boards of Appeal (BOA) currently have a broad discretion to remit appeal cases to the first instance, and frequently do so where the first instance decision does not address all of the issues necessary to reach a final decision. New Article 11 RPBA aims to reduce the broad discretion of the BOA to remit the case, by stating that remittal is generally not permitted:

The Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

The explanatory remarks accompanying this amendment make clear that it seeks to reduce the number of remittals, and that the BOA will not be expected to remit where they can decide the case “without undue burden”. As a result, from 1 January 2020, it will likely become more common for the BOA to reach a final decision without remitting the case.

The shift towards settling cases without remittal means that more cases will be decided based on issues only discussed before the BOA. There is a risk that this change is contrary to the goal that efficiency will not lead to a decrease in the quality of BOA decisions, as having a case discussed by two instances is in our view more likely to lead to identification of the key issues for a sound decision. It is also uncertain whether this shift will reduce the workload of BOA members and thus reduce pendency times: if parties cannot expect a remittal, they may feel encouraged to make detailed submissions on all possible opposition grounds, regardless of whether they have been discussed in the first instance decision. This might be expected to lead to longer submissions on appeal, and more complex appeal proceedings. It also means that the BOA will have to consider more issues afresh, without being able to make use of findings by the first instance.

Thus, while the intention of the new Art. 11 RPBA certainly is laudable and the BOA have perhaps tended to unnecessarily remit too many cases in the past, it would probably be welcomed by the parties if they received case management directions by the BOA very early in the appeal proceedings, informing them which points of contention will be dealt with during the appeal procedure and which points need not be addressed by the parties in view of a planned remittal should they become relevant. Whether this is feasible at all and likely to happen remains to be seen.

## **2. Allowability of amendments**

Perhaps the most significant change to the RPBA are the restrictions of the allowability of amendments to the requests, facts, objections, arguments and evidence making up the appeal case relative to the case on file before the first instance. The present three-stage structure is maintained under the new RPBA, under which it becomes increasingly difficult to amend the case as it proceeds towards the decision of the Board. However, it will be more difficult to amend the appeal case at each stage, and there are new formal requirements for making such amendments.

### **2.1 Amendments during first stage of appeal**

The Grounds of Appeal (GoA) and the response thereto are filed during the first stage of appeal. The present RPBA state that everything presented in the GoA and response thereto is admitted to the appeal proceedings. Although there are some notable exceptions to this, parties currently have some flexibility in bringing new requests, facts, objections, arguments and evidence on appeal. New Articles 12(2) and (4) RPBA work together to make it more difficult to make any changes on appeal relative to the first instance case as they give more discretion to the BOA not to admit anything not directed to the requests, facts, objections, arguments and evidence on which the first instance decision was based.

(2) In view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based.

(4) Any part of a party's appeal case which does not meet the requirements in paragraph 2 is to be regarded as an amendment, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal. Any such amendment 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. In the case of an amendment to a patent application or patent, the party shall also indicate the basis for the amendment in the application as filed and provide reasons why the amendment overcomes the objections raised.

The Board shall exercise its discretion in view of, inter alia, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy.

The new RPBA therefore require that the parties identify any such amendments to their cases, and that reasons be provided for submitting the amendment on appeal. For example, this means that if an argument is made on appeal which was not made in the first instance, it is necessary both to identify it and to explain why it is only being submitted on appeal.

Once again, it is questionable whether these changes will achieve the goals of the EPO. They require that more of the appeal case is spent on purely formal issues, such as determining whether an argument is indeed new, or whether it was already made during the first instance. This seems likely to increase, and not decrease the workload of the BOA members, as more time will need to be devoted to these new formal issues. The changes also increase the importance of purely formal aspects relative to substantive issues. It is our view that such increased formalism is not in line with maintaining the quality of the decisions: after all, the good reputation of BOA decisions is not based on their strict implementation of the formal aspects of the RPBA, but rather on their well-reasoned conclusions on matters of substantive patentability based on the EPC.

## **2.2 Amendments during second stage of appeal**

After the GoA and response thereto has been filed, the second stage of the appeal begins. This lasts until the notification of a summons or the deadline set by a communication from the Board, which marks the beginning of the third stage discussed below. Under the current RPBA, the Board has discretion not to admit any amendment to the appeal case at this stage, such as new amendments or documents.

In new Article 13(1) RPBA this discretion has been made subject to the justification given for the amendment:

Any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to the party's justification for its amendment and may be admitted only at the discretion of the Board...

The party shall provide reasons for submitting the amendment at this stage of the appeal proceedings.

The Board shall exercise its discretion in view of, inter alia, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the Board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, prima facie, overcomes the issues raised by

another party in the appeal proceedings or by the Board and does not give rise to new objections.

The new RPBA expressly places a burden on the proprietor or applicant to demonstrate that any amendment to the text of the patent or application “*prima facie*” overcomes the existing objections, without giving rise to new objections. This further increases the importance of formal issues in the appeal proceedings, as it increases the amount of reasoning that must accompany any such amendments made. It also puts the proprietor or applicant in the difficult position of having to identify and then refute objections which may not have been raised by another party or the EPO. In our opinion, the burden placed on the patent proprietor should not be made too high – it would be unfair for him to be expected to anticipate and refute any kind of objection a diligent and combative opponent may come up with. For the same reason, the term “without giving rise to new objections” should probably be qualified as “without giving rise to new *well-founded* objections”.

Are these changes to the RPBA likely to achieve the goals of the EPO of reducing the pendency times without reducing the quality of the decisions issued? Our comments from the first stage apply: they seem likely to increase the workload of BOA members by increasing the length of appeal submissions and importance of formal aspects on appeal. Again, the shift in focus onto formal issues may reduce the quality of decisions due to less attention being paid to substantive issues, unless the Boards apply their discretion with care and a degree of caution.

### 2.3 Amendments during third stage of appeal

As explained above, the third stage begins with the notification of a summons or a deadline set by a communication from the Board. Under the current RPBA, amending the case at this late stage is difficult, and is generally only permitted where it does not raise issues which cannot be dealt with without adjournment of the oral proceedings.

New Article 13(2) RPBA makes amendments at this stage even more difficult by requiring that such amendments cannot be taken into account unless there are exceptional circumstances:

Any amendment to a party’s appeal case made after the expiry of a period specified by the Board in a communication under Rule 100, paragraph 2, EPC or, where such a communication is not issued, 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.

It will therefore be extremely difficult to make amendments at this late stage under the new RPBA. It seems likely that this new extremely strict approach will help with the first goal identified above of reducing the workload of BOA members, as the new RPBA makes it easier for them to ignore material filed at this stage, potentially reducing the complexity of the decisions. It seems less likely to achieve the second goal of maintaining the quality of the decisions. This is because the substantive communication from the BOA about the case is generally issued after the summons and therefore after the beginning of the third stage. These changes therefore make it more difficult for parties to respond effectively to any points highlighted by the BOA. Restricting debate in this way therefore risks decreasing the quality of the final decision, as the parties may not be able to

properly respond to the substantive communication from the BOA, if the Boards exercise their discretion not to allow even reasonable amendments at this late stage in a too expansive fashion.

Putting procedural law before substantive law and over-emphasizing the character of the Boards of Appeal as a review instance as well as the need for procedural efficiency may also tend to have an impact on the ongoing discussion of whether the BOA are a proper independent “court” to review Office decisions, as required by the constitutions of several EPO member states .

### **3. Mandatory substantive communication prior to oral proceedings**

The RPBA have also been changed concerning the substantive communication from the Board prior to oral proceedings. At present, it is not necessary for the Board to issue such a communication, and it is not uncommon for oral proceedings to take place without the parties to the appeal having a concrete idea of the key issues to be discussed in the hearing or the likely outcome, even though most Boards have already sent out such communications in the more recent past. New Article 15(1) RPBA requires the Board to issue a communication drawing attention to matters of particular significance for the decision, which may include a preliminary opinion. It therefore seems likely to achieve the first goal of the EPO described above of decreasing the workload of BOA members: appellants are more likely to drop their cases before the hearing if the preliminary opinion makes clear that they have a weak case.

That said, this communication under new Article 15(1) RPBA does not necessarily give the parties an opportunity to respond by amending their cases by e.g. introducing new arguments, because the strict rules in the third stage apply. Therefore, the way that this change to the rules works together with Article 13(2) RPBA means that it is not certain that the quality of the current decisions will be maintained for the reasons discussed above.

### **4. Impact of other amendments**

New Article 1(2) RPBA mandates the publication each year of a list of the cases in which a summons, Rule 100(2) EPC communication, or decision is likely to be issued in the following year. This will be a useful indicator for parties to the appeal when the third stage of the appeal proceedings is likely to begin. Although it is a welcome change, it is not clear that it will necessarily help the EPO reduce the appeal backlog.

New Articles 15(7) and (8) RPBA provide for abridged decisions, which can be issued where the parties explicitly agree, or else where the Board agrees with the first instance decision. This could certainly help to achieve the first goal of the EPO discussed above, i.e. reducing the workload on BOA members, as it could reduce the number of decisions which have to be written. However, such abridged decisions where the parties agree might be seen as disadvantageous to third parties or national courts, who might otherwise have been able to review the reasoning of the BOA.

### **5. Conclusion**

When the new RPBA enter into force next year, the changes discussed above will apply to all cases, including those which are currently pending, with only a few minor exceptions. As described above, we remain sceptical that the changes will achieve the goals set by the EPO of reducing the pendency times without reducing the quality of the decisions issued. Instead, there is a risk that the increased focus on formal issues will actually increase the workload of BOA members due to longer submissions being filed by the parties to the appeal in an attempt to address the

various new found requirements discussed above. This may also distract from substantive issues, which risks reducing the quality of decisions. Our expectations are not without basis: research by Anetsberger et al published in [EPI Information 2/2015](#) suggests that the stricter approach to formal issues is correlated with an increase in the number of auxiliary requests filed, the length of BOA decisions, and also the fraction of patents revoked on formal grounds.

When challenged on this point at a conference in 2018 concerning these rule changes, some of the authors of the new RPBA acknowledged that there may be a short period in which more time needs to be devoted to formal issues, until EPO users become familiar with the new strict standards. However, the hope is that once the new rules have been accepted such that parties to appeal do not try to change their case relative to the first instance, then the formal issues will no longer need to be discussed to the same extent and efficiency will increase. Only time will tell whether this will indeed prove to be the case.

So if you are an EPO user, it should be clear what your New Year's resolution should be: Frontload your case! More emphasis needs to be placed on filing a complete case during the first instance since it will become even more difficult to introduce new requests, facts, objections, arguments and evidence when filing an appeal and also during the appeal proceedings. And when making changes to your case on appeal, it will now be even more important to identify these changes and explain why they are a suitable response to the development of the case. As the transitional provisions are fairly restricted, many of the new rules apply also to pending cases. So in addition to these New Year's resolutions, perhaps it would not be a bad idea to wish for a time machine for Christmas.

Merry Christmas and Guten Rutch!

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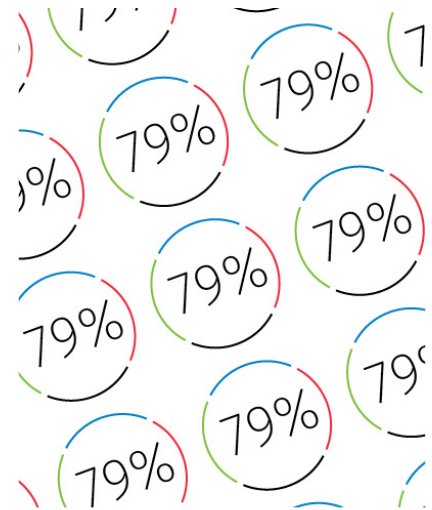
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