

**WORKING GROUP:
PROCEDURAL LAW**
RULES OF PROCEDURE OF THE
BOARDS OF APPEAL AND OF THE
ENLARGED BOARD OF APPEAL



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RULE 12C (1) EPC

**BOARDS OF APPEAL COMMITTEE AND PROCEDURE
FOR ADOPTION OF THE RULES OF PROCEDURE OF
THE BOARDS OF APPEAL AND OF THE ENLARGED
BOARD OF APPEAL**

- (1) The Administrative Council shall set up a committee (the "Boards of Appeal Committee") to advise it and the President of the Boards of Appeal on the Boards of Appeal Unit in general and to adopt the Rules of Procedure of the Boards of Appeal and of the Enlarged Board of Appeal. The Committee shall be composed of six members appointed by the Administrative Council, three from among the delegations of the Contracting States within the meaning of [Article 26](#), and three from among serving or former judges of international or European courts or of national courts of the Contracting States.

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RULE 12C (1) EPC



The President of the European Patent Office and the President of the Boards of Appeal shall have the right to attend the Committee's meetings. Further details, in particular as to the Committee's composition, alternate members, working arrangements and functions in advising the Boards of Appeal Unit, shall be determined by the Administrative Council in the decision setting up the Committee.



RULE 12C (2) EPC



- (2) On a proposal from the President of the Boards of Appeal and after the President of the European Patent Office has been given the opportunity to comment, the Committee set up under paragraph 1 shall adopt the Rules of Procedure of the Boards of Appeal and of the Enlarged Board of Appeal.

Article 12 RPBA 2007

Basis of Proceedings

- (1) Appeal proceedings shall be based on
- (a) the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC;
 - (b) in cases where there is more than one party, any written reply of the other party or parties to be filed within four months of notification of the grounds of appeal;
 - (c) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board.

- (2) The statement of grounds of appeal and the reply shall contain a party's complete case. 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 facts, arguments and evidence relied on. All documents referred to shall be
- (a) attached as annexes insofar as they have not already been filed in the course of the grant, opposition or appeal proceedings or produced by the Office in said proceedings;
 - (b) filed in any event to the extent that the Board so directs in a particular case.

(3) Subject to Articles 113 and 116 EPC the Board may decide the case at any time after filing of the statement of grounds of appeal or, in cases where there is more than one party, after the expiry of the time limit in (1)(b).

(4) 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).

(5) Extension of time limits may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request.

Article 13 RPBA 2007

Amendment to a party's case

(1) Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. 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.

(2) Other parties shall be entitled to submit their observations on any amendment not held inadmissible by the Board ex officio.

(3) Amendments sought to be made 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.

German Patent Act Section 83: Communication of the court (1)

(Official Translation)

- (1) In the proceedings for revocation of the patent or of invalidity of the supplementary protection certificate the Federal Patent Court shall indicate to the parties as early as possible those aspects which will presumably be of particular significance in respect of the decisions or which are helpful for concentrating the oral proceedings upon the issues which are essential for the decision. No such indication need be made if the aspects to be discussed appear self-evident on the basis of the parties' pleadings. Section 139 of the Code of Civil Procedure shall in addition apply.
- (2) The Federal Patent Court may set a time limit within which the parties may submit final comments on the indication in accordance with subsection (1) by making relevant requests or additions to their pleadings and also in other respects. The time limit may be extended if the party affected submits important grounds for this. These shall be substantiated.

German Patent Act Section 83: Communication of the court (2)

- (3) The competences under subsections (1) and (2) may also be exercised by the presiding judge or by a member of the Senate to be determined by him.
- (4) The Federal Patent Court **may reject** means of challenge or defence introduced by a party or a change to the action or a defence brought forward by the defendant by means of an amended version of the patent which are brought forward only **after the expiry of a time limit set for this under subsection (2)** and may decide without further examination if
 1. giving consideration to the new submission would **require the postponement** of the scheduled oral proceedings, and
 2. the party affected **does not sufficiently excuse** the delay, and
 3. the party affected has been instructed about the consequences of failing to observe a time limit.

The ground of excuse shall be substantiated.

Art. 12 (4) RPBA – Application in Practice

T 162/09 – Fairness towards the opposite party

The Enlarged Board of Appeal held in established case-law that it is the main purpose of the *inter-partes* appeal proceedings to give the losing party the opportunity to factually challenge the decision of the Opposition Division (G 9/91, G 10/91, G 1/94). In this respect, the appeal proceedings primarily aim to provide an independent judicial review of a decision with regard to factual, procedural and substantive correctness. The discretionary power of the Board and the requirements regarding a correct conduct of proceedings of the parties are stipulated in the Rules of Procedure of the Boards of Appeal (RPBA), in particular in Article 12 (Basis of Proceedings) and 13 (Amendment to a Party's Case) RPBA. These regulations aim to accelerate the proceedings and reflect the principle of fairness towards the opposite party/parties.

Art. 12 (4) RPBA – Application in Practice [continued]

T 1685/07 – No legal entitlement to amend requests in the appeal proceedings

The function of the appeal proceedings to provide the losing party the opportunity to have the correctness of the decision of the administrative instance reviewed has led to some decisions which effectively conclude that the appealing proprietor in appeal proceedings is not entitled at all to amend his requests in the appeal proceedings, but that the admission of amendments generally lies within the discretion of the Boards of Appeal (T 840/93, T 427/99 of 15 November 2001 [3 et seq.]; T 455/03 of 05 July 2005 [2.1]; T 651/03 of 10 May 2007 [2]; T 339/06 of 05 December 2007 [6.2 et seq.]; T 240/04 of 13 December 2007 [16.1 et seq.]

Legal remedies against severe procedural defects

Article 112a EPC – Petition for review by the Enlarged Board of Appeal

- (1) Any party to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review of the decision by the Enlarged Board of Appeal.
- (2) The petition may only be filed on the grounds that:
 - (a) a member of the **Board of Appeal** took part in the decision in breach of Article 24, paragraph 1, or despite being excluded pursuant to a decision under Article 24, paragraph 4;
 - (b) the **Board of Appeal** included a person not appointed as a member of the Boards of Appeal;
 - (c) **a fundamental violation of Article 113 occurred;**
 - (d) any other fundamental procedural defect defined in the Implementing Regulations occurred in **the appeal proceedings;** or

Legal remedies against severe procedural defects

Article 112a EPC – Petition for review by the Enlarged Board of Appeal

- (e) a criminal act established under the conditions laid down in the Implementing Regulations may have had an impact on the decision.
- (6) Any person, who, in a designated Contracting State, has in good faith used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the period between the decision of the Board of Appeal and publication in the European Patent Bulletin of the mention of the decision of the Enlarged Board of Appeal on the petition, may without payment continue such use in the course of his business or for the needs thereof.

EPC: Deficiencies of legal protection in EPO

Deficiencies in granting the right to be heard in appeal proceedings

- Art. 12 (4) RPBA does not prevent the unexcused presentation of new documents by the appellant opponent, since it is only assessed whether they are *prima facie* relevant
- But Art. 12 (4) RPBA prevents in many cases the proper defense of the patent proprietor due to the absence of a legal right to claim examination of new claim versions
- Boards of Appeal may deviate without further communication from earlier communications
- The Enlarged Board of Appeal does not examine whether the objection of late-filing is justified, as no review of discretionary adjudications takes place

Thank you for your attention

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