

FEMIFI

Fédération Européenne des Mandataires
de l'Industrie en Propriété Industrielle

Europäischer Verband der
Industrie-Patentanwälte

European Federation of Agents
of Industry in Industrial Property

Established in 1971

To the President of the Boards of Appeal of the EPO
Richard-Reitzner-Allee 8
85540 Haar
Germany

Munich, 30. April 2018

**RE: EPO: BOARDS OF APPEAL: USER CONSULTATION ON THE REVISION OF
THE RULES OF PROCEDURE OF THE BOARDS OF APPEAL**

Dear Mr. Josefsson

We thank you for the opportunity to take part in the written consultation on the proposed revised Rules of the Procedure of the Boards of Appeal. In parallel we tried to submit our comments via the web consultation but although everything seemed to be completed correctly, we only received error messages. Therefore would like to take the liberty to submit our comments and consideration in writing to you personally.

For your information, FEMIFI is the umbrella organization of the professional organizations of patent attorneys and patent agents in European industry. It is our aim to support any step to further develop the Boards of Appeal and to strengthen the whole European patent system. The revised Rules of Procedure of the Boards of Appeal should reflect a balance between the legitimate interests of patent holders, opponents, and the public. Foremost, FEMIFI pleads for a high quality appeal system with independent Boards of Appeal to guarantee best legal practice. A high quality appeal system is of particular importance because the Board of Appeal will also in future and

even if eventually a European Unified Patent Court has been established decide as last instance over the validity of European Patents. In a globalized and digitalized world, patents are more important and valuable assets for industry than ever. Therefore FEMIPi has great interest that decisions on the existence of these assets are taken with great care and with a comprehensive consideration of all relevant facts.

FEMIPi proposes the following amendments to the proposed revised Rules of Procedure of the Boards of Appeal (please confer to the annex with the amendments to the proposed revised Rules of Procedure of the Boards of Appeal):

- (i) Article 12, paragraph (4): deletion of the last sentence;
Article 12, paragraph (6): insertion of “amendments of the case constituting”:
Especially in view of the nature of the appeal proceedings as a judicial review of an impugned decision, the appellant should have the possibility to amend and adapt the case without being limited too much. Procedural economy alone must not be the overall goal of the Boards of Appeal procedure but legally deeply founded decisions. Therefore, the discretion of the Boards of Appeal should be only as proposed in the amended paragraph (6) for amendments to the case (please be aware that amendment according to Article 12 (4) differs to amendment of a patent application or patent). The complexity of the amendment must not limit an appellant as complexity could be founded in the nature of the case itself. Also the need for procedural economy must not limit the appellant in amendments, especially in view of the Boards of Appeal as judicial review and therefore last instance in the case.

Alternatively, this paragraph could be part of Article 13 that deals with amendments of the appeal case.

- (ii) Article 12, paragraph (6): deletion of “manifest”:
Any error in the use of discretion during the proceedings leading to the appealed decision should result in the admittance of amendments of facts,

objections, evidence and requests. The type of error should not be specified and there should be no threshold (“manifest”) of such an error.

(iii) Article 13, paragraph (1): deletion of the last two sentences:

In Article 13, paragraph (1) 2nd sentence the discretion regulations from Article 12 are incorporated into the second level of the convergent approach. A party still must have the possibility to react on the other party’s or the Board of Appeal’s assertions. As the Board of Appeal might raise new objections under Art. 114 (1) EPC, amendments in response to these objections must be allowable. In general, any admissible amendment to a party’s case should be balanced by the other party’s right to an amendment in response. The same standards of admittance should apply as in the first level of the convergent approach, especially in view of the Boards of Appeal as judicial review and therefore last instance in the case.

(iv) Article 15, paragraph (1): insertion of “together with the summoning”:

In addition to the mandatory issuing of a communication, which was already incorporated in the revised Rules of Procedure, this communication should be send together with the summoning. The issuing Board of Appeal is responsible for the timing of the procedure and with it for the timing of the oral proceedings. Therefore, the Board of Appeal should synchronize the summoning of the oral proceedings and the accompanying communication.

(v) Article 15, paragraph (7): “abridged form”: insertion of sentence:

Abridged decisions might not be appropriate in the light of public interest where there are divisional applications pending. In such a case, third parties might wish to know the reasons for a decision in respect of a parent application to better navigate Freedom-To-Operate risk associated with the divisional applications. Consequently, decisions in abridged form should not exist in cases where divisional applications still exist.

Additionally, we suggest to delete paragraph (2) and (3) of Article 25. Instead, Paragraph (1) should be rephrased in a manner to avoid all undue disadvantages to any party as a result of the amendments to the Rules. For example, the proposed amendments, if not modified, would force patent proprietors to file numerous auxiliary requests as early as possible, i.e. already with the initial response to an opposition and at the very latest at the deadline set in accordance with Rule 116(1) EPC. For this reason, the new rules should in inter partes proceedings only apply to cases where the opposition was filed after the date of entry into force.

In general, FEMIPi draws attention to the effect of the decisions of the Boards of Appeal on national jurisdictions. Even if not bound by the case law established by the Boards of Appeal, national courts might find the line of arguments developed in the Boards of Appeal decisions persuasive in view of consistency and harmonization. If limited to judicial review, the harmonization function might be less evident.

In view of the petition for review under Art. 112a EPC, FEMIPi would welcome more detailed minutes of oral proceedings. Whilst ideally all objections discussed in oral proceedings appear in such minutes, FEMIPi considers it necessary to at least mention points that have not already been mentioned in the written submissions.

We thank you for considering our proposals.

Sincerely yours,

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Annex: Amended revised Rules of Procedure of the Boards of Appeal: Articles 12, 13, 15 and 25.

Proposed revised Rules of Procedure of the Boards of Appeal, first published draft dated February, 1st 2018 and amendments (~~redline~~) proposed by FEMIP

Article 12

Basis of appeal proceedings

(1) Appeal proceedings shall be based on

- (a) the decision under appeal and any minutes of oral proceedings before the department having issued that decision;
- (b) the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC;
- (c) 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;
- (d) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board;
- (e) any minutes of a video or telephone conference with the party or parties sent by the Board.

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

(3) The statement of grounds of appeal and the reply shall contain a party's complete case and, accordingly, 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. 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.

(4) Any part of a submission which does not meet the requirements in paragraph 2 is to be regarded as an amendment and 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, and, in the case of an amendment to a patent application or patent, shall indicate the basis for the amendment in the application as filed as well as reasons why the amendment does not give rise to further objections.

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

(5) The Board may exercise its discretion not to admit any part of a submission by a party which does not meet the requirements in paragraph 3.

(6) The Board shall not admit ~~amendments of the case constituting~~ facts, objections, evidence and requests which were advanced in the proceedings leading to the decision under appeal but not admitted in those proceedings unless the decision not to admit them suffered from an ~~manifest~~ error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

The Board shall not admit ~~amendments of the case constituting~~ facts, objections, evidence or requests which should have been presented, or which were withdrawn or no longer pursued, by the party concerned in the proceedings leading to the decision under appeal unless the circumstances of the appeal case justify their admittance.

(7) Periods specified by the Board may exceptionally be extended at the Board's discretion upon receipt of a written and reasoned request, presented before the expiry of such period. The period referred to in paragraph 1(c) may not be extended.

(8) 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 period in paragraph (1)(c).

Article 13

Amendment to a party's appeal case

(1) 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.

Article 12, paragraphs 4 to 6, shall apply *mutatis mutandis*.

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 and the suitability of the amendments to solve the issues which were admissibly raised by the other party or parties or which were raised by the Board. The Board must also be satisfied that the amendment enhances procedural economy.~~

~~In the case of an amendment of a patent application or patent, it is for the party to satisfy the Board that any such amendment is prima facie allowable.~~

(2) Any amendment to a party's case made after the expiry of a period specified by the Board in a communication or after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which need to be justified with cogent reasons by the party concerned.

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

Article 15

Oral proceedings and issuing decisions

(1) If oral proceedings are to take place, the Board shall send ~~together with the summoning~~ a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings.

(2) A request of a party for a change of the date fixed for oral proceedings may be allowed if the party can put forward serious reasons which justify the fixing of a new date. If the party is represented, the serious reasons must relate to the representative, and not the party.

(a) The request shall be filed in writing, reasoned and, where appropriate, supported by relevant documents. The request shall be filed as soon as possible after the summons to oral proceedings has been notified and the serious reasons in question have arisen. The request should include a list of dates on which the requesting party is not available for oral proceedings.

(b) Serious reasons which may justify a change of the date for oral proceedings include:

(i) notification of a summons to oral proceedings in other proceedings before the EPO or a national court received before notification of the summons to oral proceedings before the Board;

(ii) serious illness;

(iii) a death within the family;

(iv) marriage or formation of a similar recognised partnership;

(v) military service or other obligatory performance of civil duties;

(vi) holidays or business trips which have been firmly booked before notification of the summons to oral proceedings.

(c) Reasons which, as a rule, do not justify a change of the date of oral proceedings include:

(i) filing of new requests, facts, evidence or arguments;

(ii) excessive work pressure;

(iii) unavailability of a duly represented party;

(iv) unavailability of an accompanying person;

(v) appointment of a new professional representative.

(3) The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of a party duly summoned who may then be treated as relying only on its written case.

(4) The Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct.

(5) When a case is ready for decision during oral proceedings, the Chairman shall state the final requests of the parties and declare the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to re-open the debate.

(6) The Board shall ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary. Before the oral proceedings are closed, the decision may be announced orally by the Chairman.

(7) Where the decision on the appeal has been announced orally in accordance with paragraph 6, the reasons for the decision may, with the explicit consent of the parties, be put in writing in abridged form. However, where it has been indicated to the Board that a third party or a court has, in the particular case, a legitimate interest in the reasons for the decision not being in abridged form, they shall not be abridged. **A legitimate interest of a third party should be assumed in the event of pendency of at least one divisional application to the patent application or patent of the appeal case.** Where appropriate, the reasons for the decision in abridged form may already be included in the minutes of the oral proceedings.

(8) If the Board agrees entirely with the decision under appeal, including the reasons given in that decision, the reasons for its decision may be in abridged form.

(9) The Board shall issue the decision on the appeal in a timely manner.

(a) Where the Chairman announces the decision on the appeal orally in accordance with paragraph 6, the Board shall put the decision in writing and despatch it within three months of the date of the oral proceedings. If the Board is unable to do so, it shall inform the parties when the decision is to be despatched.

(b) When a case is ready for decision during oral proceedings but the Chairman does not announce the decision on the appeal orally in accordance with paragraph 6, the Chairman shall indicate the date on which the decision on the appeal is to be despatched, which shall not be later than three months after the closure of the oral proceedings. If the Board is unable to despatch the decision on the appeal by that date, it shall inform the parties of a new date or, in exceptional circumstances, shall issue a communication specifying the further procedural steps that will be taken.

Article 25

Transitional provisions

Paragraph (1) should be rephrased in a manner to avoid all undue disadvantages to any party as a result of the amendments to the Rules. For example, the proposed amendments, if not modified, would force patent proprietors to file numerous auxiliary requests as early as possible, i.e. already with the initial response to an opposition and at the very latest at the deadline set in accordance with Rule 116(1) EPC. For this reason, the new rules should in inter partes proceedings only apply to cases where the opposition was filed after the date of entry into force.

Paragraph (2) and (3) should be deleted.