



Appeal proceedings

# Practical consequences of the new Rules of Procedure of the Boards of Appeal

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# 1. Introduction

As of January 1, 2020, new Rules of Procedure apply for proceedings before the Boards of Appeal of the European Patent Office (further referred to as “rules of procedure”, “rules”, or “RPBA”). The new rules have been introduced to increase efficiency, harmonization and predictability of appeal proceedings.

The **core concept** of the new rules is the fact that the primary object of an appeal is the judicial review of the first instance decision. To emphasize this concept, **convergent restrictions** to the possibility of amending a case during the progression of appeal proceedings have been specified in the rules of procedure. These provisions have practical **consequences for drafting and filing of submissions during appeal proceedings** (as discussed at point 2 below).

In addition to restricting the possibilities of amending a case, further relevant amendments to the Rules of Procedure concern the remittal of cases to the first instance department, the defined periods for filing submissions by the parties as well as for the issuance of communications and decisions by the Boards, the form of decisions, and the provisions for changing the date set for oral proceedings. These amendments have **consequences for the course of the proceedings** (as discussed at point 3 below).

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## 2. Consequences for drafting and filing of submissions

### 2.1 During the first instance proceedings

**Art. 12(1) RPBA** lists the following documents as being the basis of appeal proceedings: (a) the decision under appeal and minutes of any oral proceedings; (b) the notice of appeal and statement of grounds of appeal; (c) any written reply filed within four months of notification of the grounds of appeal; (d) any communication sent by the Board and answers thereto requested by the Board; (e) minutes of any video or telephone conference.

**Art. 12(2) RPBA** stipulates that the appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based.

The basis of appeal proceedings is defined in Art. 12 RPBA, where **Art. 12(1) RPBA** lists the documents which will be considered. In comparison with previous Art. 12(1), the **decision under appeal and minutes of any oral proceedings** have now been explicitly defined. This emphasizes that the procedure is about evaluating the correctness of the decision of the first instance, rather than about evaluating the patentability of the claimed invention.

To be able to rely on all elements of the first instance proceedings, it is advisable not to withdraw or abandon any requests, objections, lines of argumentation or evidence (see **Art. 12(2) RPBA**).

In line with the concept of judicial review, hurdles have been defined in the new rules for amending the appeal case in comparison to the first instance case. In view of these hurdles, it is important to consider the following points even before an appeal is initiated, as will become clear from the below discussion of the amended rules.

To consider	<ul style="list-style-type: none"><li>- Submit all useful objections before the first instance decision.</li><li>- Submit all useful amendments to a patent or an application before the first instance decision.</li><li>- Do not withhold evidence.</li><li>- Request a formal decision of the first instance on admissibility of requests, evidence and/or objections, particularly where they did not become a basis for the decision.</li><li>- Explicitly state maintenance of parts which did not become a basis for the decision at the end of first instance oral proceedings (and request to include this statement in the minutes and/or decision).</li><li>- Evaluate the correctness of minutes of oral proceedings and request a correction as soon as possible where necessary.</li></ul>
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## 2.2 Drafting the statement of grounds of appeal and the reply thereto

**Art. 12(3) RPBA** defines that the statement of the grounds of appeal and the reply must contain a party's complete case. The party's case is further defined as

- the reasons why the decision should be reversed, amended or upheld;
- an express specification of all requests, facts, objections, arguments and evidence relied on.

**Art. 12(3) RPBA** provides that the statement of the grounds of appeal and the reply thereto must contain the party's **complete case**. Any part of this initially presented appeal case which has not been a "**basis for the decision**" is considered as being an **amendment to the case**, as defined in the first part of **Art. 12(4) RPBA** (see below).

Thus, a party's case could be divided in parts which were a basis for the decision, and amendments.

It is important to realize what may be considered as an amendment to the case since any amendment must be **identified** as being an amendment and **reasons** must be provided for submitting it for the first time at the appeal stage (i.e. for not having submitted it during the first instance proceedings).

"Parts of the case" extend to requests, facts, objections, arguments and evidence. Whereas additional requests, facts and evidence may be identified rather easily, this might be more difficult for arguments. However, it seems that arguments which change the "**line of argumentation**" will most probably be considered as being an amendment.

To consider	<ul style="list-style-type: none"><li>- Discuss the first instance decision, rather than the patent or the application.</li><li>- Do not simply refer to first instance submissions but specify why a particular part of these submissions is relevant for the evaluation of the correctness of the decision.</li><li>- Has the needed part of the first instance submissions been a <b>basis for the decision</b>?<ul style="list-style-type: none"><li><b>Yes:</b> specify the argument on the basis of the relevant part of the submission</li><li><b>No</b> (e.g. patent revoked for containing added matter and decision not based on raised novelty or inventive step objections, auxiliary requests which have not been discussed, specific combination of prior art documents not considered by the first instance, ...): evaluate whether the needed part of the submissions has been admissibly raised and maintained in the first instance proceedings and justify depending thereon (see below)</li></ul></li></ul>
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**Art. 12(4) RPBA** provides that any part of the case (requests, facts, objections, arguments and evidence) which was not a basis for the decision is regarded as an amendment, unless the party demonstrates that it was admissibly raised and maintained in the first instance proceedings.

Furthermore, Art. 12(4) RPBA provides that the parties shall clearly identify each amendment and provide reasons for submitting it in the appeal proceedings. For (new) amendments to an application or patent, Art. 12(4) RPBA defines that additionally the basis for the amendment in the application or patent, as well as reasons why the amendment overcomes the objections, shall be provided.

The final part of Art. 12(4) RPBA provides that amendments may be admitted only at the discretion of the Board, 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.

**Art. 12(5) RPBA** defines, by referring to Art. 12(3) RPBA, that the Board has discretion not to admit any part of a case for which no reasons for requesting the reversal of the decision under appeal are provided or any part which does not expressly specify requests, facts, objections, arguments and evidence relied upon.

**Art. 12(6) RPBA** provides that the Board shall not admit requests, facts, objections or evidence which have not been admitted in the first instance proceedings (unless this was due to an error or where the circumstances justify their admittance), or which should have been submitted or were no longer maintained in first instance proceedings (unless the circumstances justify their admittance).

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## 2.3 Early amendments to the appeal case

In **Art. 13(1) RPBA**, the submission of amendments after having filed the statement of grounds of appeal or reply thereto is defined as being subject to the party's justification and the provision of reasons for submitting the amendment at this stage of the proceedings. Such amendments may be admitted only at the discretion of the Board. The Board shall exercise its discretion in view of e.g. the current state of proceedings, the suitability of the amendment to resolve issues which were admissibly raised by another party or the Board, procedural economy, whether the party has demonstrated that an amendment to a patent application or patent, *prima facie*, overcomes issues raised by another party or by the Board and does not give rise to new objections.

Whereas Art. 12 RPBA concerns amendments compared with the case on which the first instance decision has been based, **Art. 13 RPBA** concerns amendments to the case compared with the statement of grounds of appeal or the reply thereto.

**Art. 13(1) RPBA** represents the **second level of the convergent approach** now applied. The article is intended as a limitation on a party amending its appeal case **after the initial stage of the proceedings**, i.e. after the submission of the statement of grounds of appeal or reply thereto – but before expiry of the period for responding to a Board's invitation to comment or before issuance of summons to oral proceedings (see Art. 13(2) RPBA).

As in Art. 12(4) RPBA in connection with amendments submitted at the first level of the convergent approach, a non-exhaustive list of criteria that may be considered by the Boards when deciding whether to admit amendments at the second level of the convergent approach is provided in **Art. 13(1) RPBA**. An interesting difference between the lists in Art. 12(4) RPBA and Art. 13(1) RPBA shows that the Boards must apply **more strict criteria** at the second level of the convergent approach: whereas allowable amendments must only be suitable to "address" the issues concerned at the first level, they must be considered suitable to "overcome" the issues concerned at the second level of the convergent approach.

To consider	<ul style="list-style-type: none"><li>- Concerns amendments <b>before</b> the expiry of the period for responding to a Board's invitation to comment or <b>before</b> the issuance of summons to oral proceedings.</li><li>- Evaluate the Boards' list of cases for the coming working year as published on the Boards' website (if one's case is listed, it may "enter" the third level of the convergent approach in the near future) and review listed cases for possibly needed further submissions.</li><li>- Identify additional parts of further submissions in comparison with the initial appeal submissions.</li><li>- Evaluate whether the additional parts could be considered as an amendment.</li><li>- Define reasons for submitting the additional parts and for submitting them at this point in the proceedings.</li></ul>
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Possibility to introduce parts which were not filed with the initial appeal submissions	<table border="1" style="width: 100%; height: 100%;"> <tr> <td style="width: 12.5%; background-color: #92d050;"></td> <td style="width: 12.5%; background-color: #92d050;"></td> <td style="width: 12.5%;"></td> </tr> <tr> <td colspan="7"> <ul style="list-style-type: none"> <li>- Amendment: anything which has not been filed with the first submissions by the parties in the course of the appeal proceedings (i.e. amendments to the case compared with the statement of grounds of appeal or the reply thereto)</li> </ul> </td> </tr> </table>								<ul style="list-style-type: none"> <li>- Amendment: anything which has not been filed with the first submissions by the parties in the course of the appeal proceedings (i.e. amendments to the case compared with the statement of grounds of appeal or the reply thereto)</li> </ul>						
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## 2.4 Late amendments to the appeal case

**Art. 13 (2) RPBA** provides that any amendment to a party's appeal case after the expiry of the period for responding to a Board's invitation to comment or after issuance of summons to oral proceedings shall in principle not be taken into account, unless where there are exceptional circumstances, justified by cogent reasons by party.

**Art. 13(2) RPBA** defines the **third level of the convergent approach**, which further limits the possibilities of the parties to amend their appeal case **after expiry of the period for responding to a Board's invitation to comment or after issuance of summons to oral proceedings**.

As stipulated in Art. 13(2) RPBA, an amendment at this stage may only be considered by the Boards if the party can convince the Board that there are compelling reasons which justify why the circumstances leading to the amendment are exceptional. Reasons for admitting and not admitting auxiliary requests on the basis of this provision can e.g. be found in Technical Board of Appeal decision T 916/17 (point 3.1 of the reasons) and T 764/16 (point 3 of the reasons), respectively.

To consider	<ul style="list-style-type: none"> <li>- Concerns amendments <b>after</b> the expiry of the period for responding to a Board's invitation to comment or <b>after</b> the issuance of summons to oral proceedings.</li> <li>- Provide compelling reasons for filing an amendment.</li> <li>- Provisions extend to submissions made during oral proceedings.</li> </ul>
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## 3. Consequences for the course of the proceedings

### 3.1 Remittal to the department of first instance

**Art. 11 RPBA** defines that the Board shall not remit a case to the department of first instance unless special reasons exist (e.g. fundamental deficiencies in the first instance proceedings)

Art. 11 of the previous rules provided that the Boards shall remit a case if fundamental deficiencies in the first instance proceedings exist. **Art. 11** of the new rules defines that the Board shall **not** remit a case, unless special reasons exist. This shifts the focus of the provision and indicates that the Boards are urged to exercise their power within the competence of the first instance department to deliver a final decision in the case. The aim is to avoid undue prolongation of the proceedings. In combination with the new convergent approach, it is assumed that more issues will be raised and dealt with in the first instance proceedings.

As “special reasons”, Art. 11 RPBA exemplifies fundamental deficiencies in the first instance proceedings. It appears from decisions issued after the entry into force of the new rules that the Boards consider objections which have not been dealt with during the first instance proceedings as a further “special reason” for remitting the case (see e.g. Technical Board of Appeal decisions T 170/19 (point 2 of the reasons) and T 601/19 (point 4.2 of the reasons)).

### 3.2 Extension of periods

**Art. 12(7) RPBA** stipulates that periods specified by the Board may exceptionally be extended at the Board’s discretion upon written and reasoned request. The period for replying to the statement of grounds of appeal may only be extended up to a maximum of six months.

The possibility of extending periods upon request and at the Boards’ discretion was also provided in the previous rules of procedure. However, it has been specified in **Art. 12(7)** of the new rules that the period for providing a reply to the statement of grounds of appeal can only be extended up to a **maximum of six months**. An extension of the four month period will only be granted upon written and reasoned request, which should be filed in good time before the expiry of the four month period since a Board may decide not to grant the extension when it considers that the reasons for the request do not justify an extension. Should the extension not be granted and the reply be submitted after the four month period, the submissions may be considered as an amendment to the party’s appeal case for which the provisions of Art. 13(1) RPBA apply (i.e. the second level of the convergent approach).



## 3.2 Oral proceedings and issuing decisions

**Art. 15(1) RPBA** defines in connection with the time frame for issuing summons to oral proceedings that the Board should endeavor to give at least four month's notice of the summons and, in cases where more parties are concerned, to issue the summons no earlier than two months after receipt of the reply to the statement of grounds of appeal. Art. 15(1) RPBA also defines that the Board shall issue a communication drawing attention to matters that seem to be of particular significance for the decision to be taken and shall endeavor to issue this communication at least four months in advance of the oral proceedings. The Board may also provide a preliminary opinion.

**Art. 15(2) RPBA** defines that a request for the change of a date fixed for oral proceedings may be allowed if serious reasons (relating to the party or, if the party is represented, the representative) justifying the fixing of a new date can be put forward. According to Art. 15(2)(a), the request shall be filed in writing, reasoned and, where appropriate, supported by documentary evidence. A list of dates on which the requesting party is not available should be included. A non-exhaustive lists of reasons which may justify a change of date is provided in Art. 15(2)(b) RPBA, and examples of reasons which, as a rule, do not justify a change of date are provided in Art. 15(2)(c) RPBA.

According to **Art. 15(1) RPBA**, **summons** will, in cases where there is more than one party not be issued earlier than two months after receipt of the reply to the statement of grounds of appeal. This leaves the appellant a (small) definable and minimal timeframe to submit a response and perhaps amendments to the case during the less restrictive second level of the convergent approach. However, the hurdles for filing amendments to the case may increase at any time after the defined two month period.

Art. 15(1) further stipulates that the Boards **must** provide a **communication** indicating the points which need to be discussed, preferably at least four months before the oral proceedings take place in order to be able to concentrate on essential aspects during the oral proceedings. Such communication is not a preliminary opinion, which may however additionally be provided by the Boards. Since any such communication or preliminary opinion is issued after the summons to attend oral proceedings, a party wishing to react thereon must keep in mind that the third level of the convergent approach applies at this stage. Therefore, it is not advisable to postpone the submission of any useful lines of argumentation to a moment where it becomes clear whether the Board tends to decide in favor of a case or not.

If a party wishes to **change the date of oral proceedings**, **Art. 15(2) RPBA** is to be considered. As previously provided, a request for changing the date must be filed as a written, reasoned request, but according to the amended provision, it must now be supported by **documentary evidence**, where appropriate. This stands in contrast to the "sufficiently substantiated written statement" mentioned in the Notice of the Vice-President of Directorate-General 3 of the EPO dated 16 July 2007 concerning oral proceedings before the boards of appeal of the EPO (OJ EPO 2007, Special Edition No. 3, 115), which has previously defined the practical aspects of changing the date of the oral proceedings. If a request is formally defective, it may not be further considered by the Boards.

It is noted that the reasons which may and do not justify a change of date previously listed in the Notice have now been defined (and slightly amended) in **Art. 15(2)(b) and (c) RPBA**, respectively.

Interestingly, it is no longer required to include in the request a statement why another representative cannot substitute the representative prevented from attending the oral proceedings (as was defined in the Notice). However, a list of dates on which one is not available for oral proceedings should be provided. This is not an obligation, but is intended to make it easier for the Boards to find a suitable replacement date.



**Art. 15(7) RPBA** provides that where the decision has been announced orally and with the explicit consent of the parties, the decision may be put in writing in abridged form.

**Art. 15(8) RPBA** defines that the Board may abridge the reasons for its decision in respect of issues where the Board agrees with the findings of the department of first instance.

**Art. 15(9)(a) RPBA** provides that, where a decision is announced orally, the decision will be put in writing and dispatched within three months of the date of the oral proceedings. If the Board is unable to do so, it shall inform the parties.

Pursuant to new **Art. 15(7) RPBA**, the Boards may consider to **abridge the reasons for its decision in the written decision**. Reasons for not choosing the abridged form are, for example, the relevance of the decision for the development of the case law of the Boards of Appeal and the interest of third parties, courts or the public in the reasons for the decision. The parties will be asked for their consent. Reasons for not consenting to the abridged form must not be given. If a Board has been made aware of a legitimate interest in the Board's full reasoning (where the indication may also originate from another party than the parties to the proceedings, e.g. a third party, a court or the public), the reasons will not be abridged.

For the reasons defined in **Art. 15(8) RPBA**, the explicit consent of the parties is not required and this provision is not limited to decisions announced at oral proceedings. However, also in this case, legitimate interests in a full reasoning will be considered. Furthermore, submissions during the appeal proceedings which have not been presented during the first instance proceedings will normally be addressed to guarantee the right to be heard.

A **time frame** for issuing the written decision, where a decision has been announced orally, was not defined in the previous rules. According to new **Art. 15(9)(a) RPBA**, the parties can now expect that the written decision, or at least some information as to when the decision can be expected, will be issued within three months of the date of the oral proceedings.

## 4. Conclusion

The main practical consequences of the new rules relate to the submission of new aspects to a case in comparison to the first instance case or in comparison to the initial appeal case. This has become more difficult or at least dependent on solid justification according to the Boards' new convergent approach.

When preparing submissions (extending from the statement of grounds of appeal to submissions during the oral proceedings) it is important to be aware of "amendments to the case" and to identify any amendment. If a submitted part is not considered to be an amendment, the party must provide its reasoning. If a submitted part is in fact an amendment, the party must justify the submission of the amendment at the specific stage of the appeal proceedings. In cases of doubt, the justification can be provided as an auxiliary measure.

However, to avoid or at least reduce the need for any justification or reasoning for submissions at the appeal stage, the best option is obviously to carefully consider and submit all possible requests, facts, objections and arguments as much as possible during the first instance proceedings.



## References and links

Rules of Procedure of the Boards of Appeal of the European Patent Office (in force from January 1, 2020) – [Official Journal EPO 2020, A63](#)

Table setting out the amendments to the RPBA and the explanatory remarks – [Official Journal EPO 2020, Supplementary publication 2, Rules of Procedure of the Boards of Appeal 2020](#)

Rules of Procedure of the Boards of Appeal 2020 – Presentation by Mike Harrison ([Board of Appeal and key decisions 2019](#), Seminar November 2019)

Overview of the appeal proceedings according to the EPC, third edition, edited by Hugo Meinders

Annual list of cases of the Boards of Appeal (<https://www.epo.org/law-practice/case-law-appeals/about-the-boards-of-appeal/annual-list-of-cases.html>)

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