



Documents, arguments, requests: what changes in the opposition and appeal procedure, and how to prepare

The new Rules of Procedure of the Boards of Appeal of the European Patent Office (EPO) will apply from 1st January 2020, to proceedings for which an appeal will be lodged from that date, as well as to pending appeal proceedings.

The most significant change consists in treating, as a matter of principle, as late [1] any amendment to a party's case, i.e. of any element[2] on which the first instance decision was not based[3].

Previously, at the appeal stage, the Rules of Procedure of the Boards of Appeal reserved the possibility of treating as late only facts, evidence or requests that could have been submitted in first instance (or those actually submitted in first instance but not admitted)[4]. Any other element presented by the applicant in the grounds of appeal was in principle taken into consideration by the Boards of Appeal.

With the new Rules, this admission at the stage of filing of the appeal no longer applies. Elements which could have been produced in first instance or which have not been admitted will continue to be excluded from the appeal procedure, except in special circumstances[5].

The revision of the Rules of Procedure makes it more explicit that the Boards of Appeal will only validate or invalidate the contested decision[6]. It also implies the application of this principle more strictly than with the current case law, with a goal of more effective appeal procedures.

In practice, this means that the Boards of Appeal will only take into account the elements submitted by the parties in first instance (before the Examining Division or the Opposition Division), which were expressly referred to in the contested first instance decision or in the minutes of the oral proceedings of that first instance.

New documents, requests, criticisms of statements or tests, additional documents in response to an argument, new lines of attack presented for the first time in appeal or any new arguments[7] will be considered as "amendment" whose admission will be left to the Boards discretion[8]. The only "amendments" that the Boards of Appeal will systematically take into account are those on law interpretation.

The parties must therefore manage the opposition proceedings bearing in mind that in appeal, they will play the same match, based on the same facts and arguments. They may be tempted to bring less relevant documents or arguments into the opposition proceedings, so that they are on file "just in case" they would be needed in appeal. This strategy has been envisaged and excluded by the new Rules: elements of the appeal which do not relate to what the contested decision is based on are considered to be a amendment, unless it is possible to demonstrate that these requests, facts or objections have been validly raised and maintained until the Opposition Division has taken its decision[9].

It follows from these provisions that any element presented in support of the grounds of appeal will no longer be automatically included in the appeal procedure.

In addition, the new Rules expressly require the parties to indicate proactively and clearly the "amendments" made, and to justify why their submission is made at this stage of the procedure[10].

The new Rules provides more stringent requirements to admit new elements into the procedure. This approach is described as a "three-levels convergent approach".

The first level, developed above, takes place at the stage of filing the grounds of appeal.

Later in the appeal proceedings, if a party wishes to modify its arguments[11] before the summons to oral proceedings has been notified, it will have to justify why it is submitting this amendment at this stage of the appeal[12]. The discretion of the Boards of Appeal will be exercised even more strictly[13] than for the examination of the amendments submitted with the appeal. This is the second level of the convergent approach. The assessment criteria are relatively standard and take into account the state of the proceedings, whether the amendment is suitable to resolve the issues concerned, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, to demonstrate why the amendment, *prima facie*, does not give rise to new objections[14].

The later the parties wish to make changes in the appeal procedure, the more difficult it becomes for them to be included in the procedure. Thus, the amendment of grounds after the expiry of the reply to the notification of R 100(2), or after the oral proceedings service, will not be taken into account unless the party justifies "exceptional circumstances" [15]. This is the third level of the convergent approach.

The only derogation provided concerns the intervention of the assumed infringer at the appeal stage[16]: the intervener at the appeal stage should be able, for example, to present a new ground of opposition.

The case, and in particular in opposition, will therefore be won at first instance.

How to deal with this new Rules:

By carefully reading the oral proceedings minutes of the Opposition Division, and by reporting errors / omissions within those minutes;



By introducing all relevant facts and arguments into the opposition proceedings and supporting / maintaining them until the Opposition Division's decision.

Transitional provisions are provided[17] for appeals that have already been filed when the new Rules enters into force.

Grounds of appeal filed before the entry into force of the new Rules and statements in response filed in due course shall continue to be taken into consideration by the Board in accordance with the principles of the old Rules of Procedure[18]. Thus, the first level of the convergent approach will not apply to the grounds of appeal filed before 1st January 2020 nor to their timely response. In addition, the third level of the convergent approach will also not apply to responses to summonses to oral proceedings or notifications under Rule 100(2) EPC served before 1st January 2020.

How to deal with this new Rules during the transitional period:

By anticipating your appeal filing or response to a notification under Rule 100(2) EPC before 1st January 2020, if your case allows;

By being as exhaustive as possible in you're your grounds of appeal filed before 1st January 2020 (arguments, documents, lines of attack / of defense, claims amendment...). If the grounds of appeal have been filed before 1 January 2020 and your reply is due after that date, you will also benefit from the provisions of the old Rules of procedure: be as exhaustive as possible in your reply.

Other innovations appear in the Rules of Procedure of the Boards of Appeal 2020, which will be the subject of future articles. Reference can already be made to Article 11, which will limit the back and forth exchanger between the Opposition Division and the Boards of Appeal (unless "special reasons" justify it[19]). Articles 5 and 10 also introduce a new feature, since it will now be possible for one appeal to be heard with another one (at the request of the parties, or ex officio, even without the consent of the parties, parties having been heard on this subject), or immediately after that other appeal. The cases envisaged are those which relate to divisional applications, parent applications, or applications claiming the same priority. Article 10 also provides a useful step forward since the parties will know whether a request for acceleration of the procedure is being granted. Article 15 provides that the reasons for the decision, or parts thereof, may, with the explicit consent of the parties, be put in writing in abridged form.

[1] Article 12(4) RPBA (Rules of Procedure of the EPO Boards of Appeal) 2020, which refers to the application in principle of the discretion of the Boards of Appeal to allow an amendment of the grounds of appeal

[2] grounds, facts, requests, lines of attack, arguments, evidence

[3] Article 12(2) RPBA 2020

[4] First part of Article 12(4) RPBA 2007

[5] Article 12(6) RPBA 2020

[6] De facto already identified by case law (G9/91)

[7] The question of treating a new element as "late" at any stage of the proceedings could, however, remain an open question, a recent case law T1914/12 considering that Article 114(2) EPC does not give the Boards of Appeal discretion to refuse a new argument

[8] Article 12(4) RPBA 2020

[9] Explanatory remark to Article 12(4) RPBA 2020

[10] Article 12(4) RPBA 2020, last two parts

[11] grounds, facts, requests, lines of attack, arguments, evidence

[12] Article 13 RPBA 2020

[13] Explanatory remark to Article 13(1) RPBA 2020

[14] Article 13(1) EPC

[15] Article 13(2) EPC

[16] this convergent approach applies to the intervener only " in so far as justified by the circumstances of the case", Article 14 RPBA 2020

[17] Article 25 RPBA 2020

[18] Article 25(2) RPBA 2020 referring to Article 12(4) RPBA 2007

[19] the question of the basis for this limitation may arise in the light of the very general freedom permitted by Article 111(2) EPC