

Memory jogger • core concepts

§ Appeal primarily to **review** decision

§ **Convergent** approach to amendments (next slide)

§ Boards' **use of discretion** to be **transparent/harmonised**

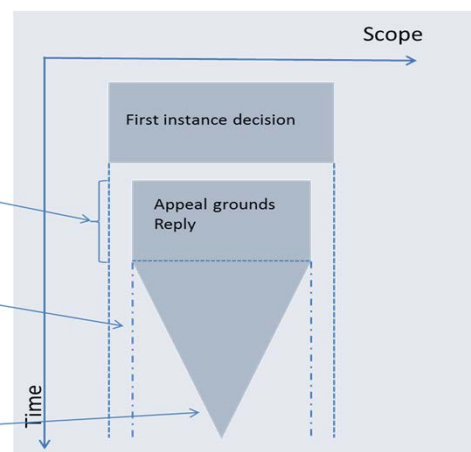
§ **Onus on parties** to explain/justify amendments

Memory jogger – 3 stages of convergence

Art. 12 – Basis of appeal
(decision/minutes, grounds/reply)
Amendment **when filing/replying**
to appeal.

Art. 13(1) – Amendment **before**
summons or time-limit expiry of
a communication (R.100(2) EPC)

Art 13(2) – Amendment **after**
summons or time-limit expiry of
a communication (R.100(2) EPC)



Written consultation – Users' wishes

§ Majority • Allow “more flexibility” to parties
(Arts. 12 & 13 too strict)
– changes made to 1st draft

§ Provide more clarifications
– changes made to 1st draft

§ *More requirements on Boards (opinions/case mgmt.)*

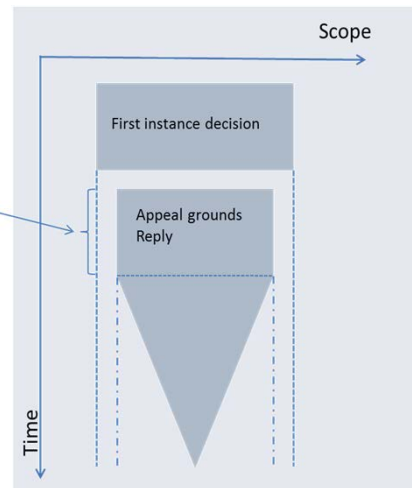
§ *Longer transition before introduction*

§ *Inclusiveness • Gender neutral (e.g. "Chairman"/"he")*

**The detail
(some at least...)**

Art. 12 – Basis of appeal - Art 12(1)
(decision/minutes, grounds/reply)

Any **amendment** limited compared to today.



Art. 12(1) – basis of proceedings

What **is** part of the appeal

§ 1(a) **decision and minutes** of oral proc. (*Ex.D/Opp.D*)

§ 1(b) notice/grounds

§ 1(c) reply to appeal (filed within 4m)

§ 1(d) any comm. of Board and reply (on Board's direction)

§ 1(e) **minutes of video/tel.** conference with party

- in particular "**decision and minutes**" – correction ...
- for **future** • video conf.

Art. 12(1) – basis of proceedings – Users' comments

§ 12(1)(a) **decision and minutes** of oral proc. (*Ex.D/Opp.D*)

Users: Include **all submissions** made by parties at first instance

Notes:

No change made to 1st draft.

Current Art. 12(2) requires to “specify expressly” (also new Art. 12(3))

Not Board’s task to decide **which** previous submissions might relate to the appeal case and **to what extent**.

Art. 12(2) – 1st stage convergence

Art. 12(2)

§ **primary** object ... to **review** the decision ... in a **judicial manner**,

§ a party's appeal case **shall be directed to** the requests, facts, objections, **arguments** and evidence **on which the decision ... was based**.

Notes: "Review the decision" – **not new examination!**
(n.b. review - on points of fact and law)

“Judicial manner” – **sets the tone** • BoA a **judicial** body (G10/91)

Art. 12(2) – 1st stage convergence - Users' comments

§ primary object ... to review the decision ... in a judicial manner,

§ a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision ... was based.

§ Review? – And Art. 114(1) EPC?

- "primary object ... review" ("judicial review" - removed from 1st draft)

§ "Arguments on which decision was based"?

- "directed to" - can be developed, but beware "change of case"

§ What if DG1 delivers poor quality?

– Board discretion [e.g. Art. 11, 12(4)/(6) RPBA, Art. 111 & 114EPC]

Art. 12(3) and (5) – 1st stage convergence

Art. 12(3) ... grounds/reply ... shall ... specify expressly all requests, facts, objections, arguments and evidence relied on.

§ mirrors current Art. 12(2) – “requests” and “objections” added

Art. 12(5) – Sanction for Art. 12(3)

Board has discretion not to admit any part of a submission ... which does not meet ... Art. 12(3)

§ mirrors current Art. 12(4)

Art. 12(2) – 1st stage convergence – Users' comments

Art. 12(2) • ... a party's appeal case shall be directed to requests, facts, etc ... on which the decision under appeal was based.

Users: And **other issues** raised? (decision **not based on** them!)

§ Ex.1: Opposition based on Art 100(c) and 100(a) EPC novelty
Patent **revoked** re. **Art. 100(c)** • patentee appeals.
Opponent replies – repeats **novelty attack** already made.

§ Ex. 2: Opposition filed / patentee responds with auxiliary requests.
Opposition rejected • opponent appeals.
Patentee replies – repeats **auxiliary requests** already made

Art. 12(4) • 1st sentence – is it an "amendment"?

§ **Any part** of a party's appeal case which does **not** meet ... Art. 12(2) is to be regarded as an **amendment**, **unless** the party demonstrates that this part was **admissibly raised & maintained** in the proceedings leading to the decision...

§ ... admitted only at Board's discretion

§ **Not enough** to (only) have **raised** e.g. a request/objection.
It must have been **admissibly** raised (e.g. timely/substantiated).
Party must **demonstrate** this.
The **Board** will judge.

Art. 12(4) • 1st sentence – is it an "amendment"?

§ Any part of a party's appeal case which does not meet ... Art. 12(2) is to be regarded as an **amendment, unless** the party demonstrates that this part was **admissibly raised & maintained** in the proceedings leading to the decision...

§ Ex. 1 - Opposition based on Art 100(c) and 100(a) EPC novelty Patent **revoked** on **Art. 100(c)** • patentee appeals
Opponent replies – repeats **novelty attack** already made.

Amendment? - normally not
If novelty attack **substantiated** in opposition notice (and **maintained**) & this is **demonstrated** to be so, & not otherwise inadmissible

Art. 12(4) • 1st sentence – is it an "amendment"?

§ Any part of a party's appeal case which does not meet ... Art. 12(2) is to be regarded as an **amendment, unless** the party demonstrates that this part was **admissibly raised & maintained** in the proceedings leading to the decision...

§ Ex.2: Opposition filed / patentee responds with auxiliary requests.
Opposition rejected • opponent appeals.
Patentee replies – repeats **auxiliary requests** already made.

Amendment? - normally not
if aux. requests are **substantiated** in reply (and **maintained**) and this is **demonstrated** to be so, & not otherwise inadmissible

Art. 12(4) – 2nd sentence – "amendment"-which/why?

... party shall clearly **identify each amendment** and **provide reasons for submitting it in appeal** ..., & (for) amendment to a patent application/patent shall also indicate the basis ... in the application as filed & **provide reasons why** the amendment overcomes the objections raised.

Onus on parties – must provide reasons!

§ **what** amended, **why?** and **why only on appeal?**

§ **Users - Extra hurdle** for patentees?

§ "reasons why ... overcomes the objection" - is **what is meant** for patentee re. "**identify** and **providing reasons** for submitting it"

Art. 12(4) – 3rd sentence • discretion

Art. 12(4), 1st, • ... amendment ... admitted only **at the discretion of the Board**

Art. 12(4)-3rd • ... shall **exercise its discretion** in view of, inter alia, the **complexity** ..., the **suitability** ... **to address** the issues which led to the decision ..., and the need for **procedural economy**.

Board's discretion (1st stage) **set low** but **higher than current Art.12(4)**

Art. 12(6) – what shall **not** be admitted?

Art. 12(6) 1st sentence

Board shall not admit facts, objections, evidence or requests... not admitted by the Ex.D/Opp.D, unless the decision suffered from an **error in the use of discretion** or unless **circumstances of the appeal case** justify their admittance.

Emphasises "**review**" approach, but gives **judicial discretion**

Art. 12(6) 2nd sentence – mirrors current Art. 12(4)

... shall not admit facts etc. ... which **should have been submitted**, or were no longer maintained in the proceedings leading to the decision ..., unless **circumstances of appeal case** justify ...admittance.

Art. 12(7) – fixed 4m to respond to appeal

Art. 12(7) • ... The period ...in paragraph 1(c) **may not be extended**.

Users: Exceptions to 4m should be allowed!

(e.g. complex cases; multiple opponents versus 1 patentee)

Result: No change to 1st draft

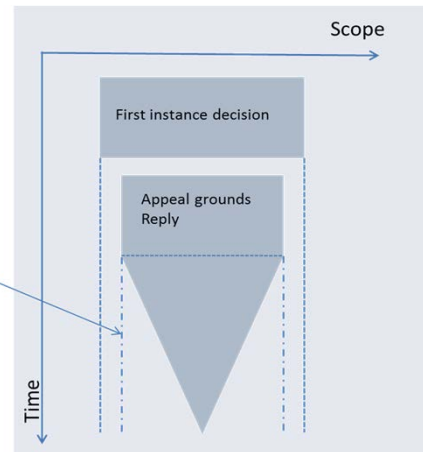
§ **No guarantee** of extension under current RPBA

§ Most issues addressed Ex.D/Opp.D; **new issues** should be few!

§ In complex/high value cases, extra resources may be required also under current RPBA

2nd stage of convergence

Art. 13(1) – Amendment after appeal grounds/reply but **before** summons or time-limit expiry of a R.100(2) communication.



Art. 13(1) – convergence 2nd stage

Art. 13(1) 1st sentence:

Any amendment to ... case ... is subject to party's justification ... and may be admitted only at discretion of the Board.

For admittance of an amendment **onus again on party**

- but **higher** requirement than 1st stage (see 4th sentence –later slide)

Users: What if **Board/other party** raises a **new** objection?

- Art. 13(3) RPBA/Art. 113(1) EPC

Art. 13(1) – convergence 2nd stage

Art. 13(1) • 2nd/3rd sentences:

§ Art. 12(4) to (6) apply *mutatis mutandis*.

§ Party shall provide **reasons** for submitting amendment **at this stage** of the proceedings.

§ **Cumulative** on Art. 12 and **increasing burden** (i.e. why not submitted **even earlier?**)

Art. 13(1) – 4th sentence - convergence 2nd stage

The Board shall exercise its **discretion** in view of, inter alia,

§ the **current state** of proceedings,

§ the **suitability** of the amendments **to resolve the issues** which were admissibly raised by the other party/parties in the appeal proceedings or ... by the Board,

§ whether the amendment is **detrimental to procedural economy**,

§ and in the case of an amendment to a patent application/patent, whether the party **has demonstrated** that any such amendment, *prima facie*, **overcomes the issues** raised by ... other party ... in appeal proceedings or by the Board and **does not give rise to new objections**.

Art. 13(1) – convergence 2nd stage

1. **Demonstrate • prima facie • overcomes issues/no new objections**
(main line in case law for *prima facie* assessment)

2. "Extra hurdle" for patentees?

§ requirement: “**prima facie, overcomes the issues and does not give rise to new objections**”

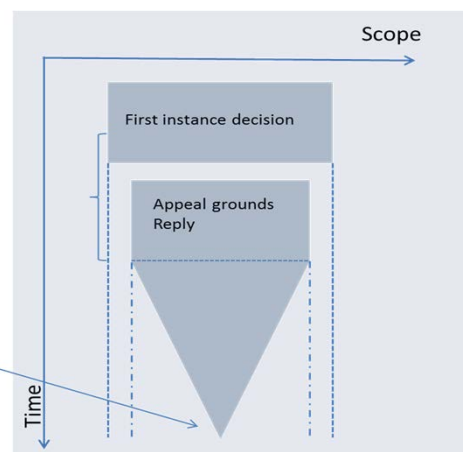
is intended to be same standard as:

requirement “**suitability of the amendments to resolve the issues**”
when **applied to patentees’** amendments

§ all discretion factors now in **one sentence** (can all be balanced one against another)

3rd stage of convergence

Art 13(2) – Amendment **after**
summons or time-limit expiry of
a R.100(2) communication



Art. 13(2) – convergence 3rd stage

Art. 13(2):

Any amendment ... **after** ...

§ **expiry** of a period in a **communication under R. 100(2) EPC**, or

§ where ... not issued, **after summons**

shall, **in principle, not be taken into account** unless there are **exceptional** circumstances, ... justified with cogent reasons by the party concerned.

§ **Strictest** standard – **very high onus** on parties

§ What use is Art. 15(1) comm./opinion? - to **prepare** the parties

§ Clarifies which applies when **both** comm. and summons issued

§ Art. 15(1) comm./prelim. opinion is **not a R. 100(2) EPC** communication (**unless** Board **expressly invites** a response)

Art. 12(8) – reminder...

Art. 12(8) • ... Subject to Arts. 113 & 116 EPC, the Board may decide the case **at any time after filing**.. the grounds... or, where there is more than 1 party, after expiry of *“the 4-month reply period”*

Note: Parties should be observant to make any intended case amendment as early as possible – a **summons** may be issued very soon.

Suggestions?

- § Substantiate your **complete** case to Ex.D/Opp.D
- § Do not expect Board to admit a change of your case (*e.g. new prior art or requests*) unless you **adequately justify** it and you have **thoroughly checked and reasoned** any amendment.
- § After the summons to an oral proceedings before a Board, **expect** any change of your case to be **very difficult**
- § Review **on-going cases now** and make necessary amendments **before** new RPBA in force

What else on Arts. 12 and 13?

Transitional provisions?

Art. 25

§ Early benefits to efficiency • **short transition period**

§ New RPBA applies to **all** appeal cases, unless:

Exception 1 • New Art. 12(4)/(6) not applicable **to grounds/reply filed** before entry into force

Exception 2 • New Art. 13(2) – not applicable if **summons already** issued or an already issued comm. time limit has expired

§ Advanced notice (at least **6m after approval by A/C**) can be used by parties to adapt cases (time for this process)