

**CA/PL 16/00**

Orig.: German

Munich, 24.03.2000

SUBJECT: Revision of the EPC: Articles 106 - 111  
DRAWN UP BY: President of the European Patent Office  
ADDRESSEES: Committee on Patent Law (for opinion)

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#### SUMMARY

It is proposed that those provisions relating to the EPO appeals procedure which contain details rather than fundamental elements, be transferred to the Implementing Regulations.

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## **I. INTRODUCTION**

1. Articles 106-111 EPC contain provisions relating to the appeals procedure. It is proposed that, in the same manner as was done with the provisions governing the other procedures before the EPO,<sup>(1)</sup> the details relating to the appeals procedure be transferred to the Implementing Regulations, insofar as they do not relate to fundamental aspects of the judicial review of the EPO's first-instance decisions.

## **II. EXPLANATION OF PROPOSED AMENDMENTS**

### **A. ARTICLE 106 EPC**

2. Article 106(1) EPC in conjunction with Article 106(3) EPC defines which decisions are appealable, ie only final decisions, unless a separate appeal is allowed by the decision which is not final. This is an essential structural feature of the means of legal redress at the EPO and must therefore be dealt with in the Convention.
3. Article 106(2) EPC, on the other hand, contains a clarification which - as in present Article 99(3) EPC (see CA/PL 15/00) - can be incorporated into the Implementing Regulations. Paragraphs (4) and (5) of Article 106 contain restrictions on appeals relating to the apportionment and fixing of costs. Those provisions too are not substantive in nature and can therefore be included in the Implementing Regulations.

### **B. ARTICLES 107 AND 108 EPC**

4. Article 107 EPC specifies the persons who are entitled to appeal and is therefore a fundamental provision which turns the appeals procedure into an individual legal remedy (as opposed to a general means of contesting decisions). It must therefore be contained in the Convention.
5. Article 108 EPC, on the other hand, relates to time limits and the form of appeals. These formal elements of the right of appeal can be transferred to the Implementing Regulations. This would be useful, for example, in the case of the form of appeal in view of the future use of electronic means of communication. The time limits for filing a notice of appeal and the statement of grounds - like the time limits for filing a

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<sup>(1)</sup> See, for example, CA/PL 5/00 regarding the examination on filing, CA/PL 6/00 regarding the examination procedure and CA/PL 15/00 regarding the opposition procedure.

request for examination<sup>(1)</sup> and a notice of opposition<sup>(2)</sup> - can be laid down in the Implementing Regulations.

The provisions relating to the appeal fee and the legal consequences of failure to pay it can also be left to the Implementing Regulations, by analogy with the proposed new wording of Article 51 EPC<sup>(3)</sup>.

6. Present Articles 107 and 108 EPC relate to the filing of the appeal. It is proposed that these provisions be combined in Article 107 and that Article 108 be deleted.

#### **C. ARTICLE 109 EPC**

7. Article 109 establishes the responsibility of the first-instance departments for interlocutory revision. The proposed new wording highlights - without substantively amending the provision - the restriction of interlocutory revision to *ex parte* proceedings. Only the time limit arrangements are to be transferred to the Implementing Regulations.

#### **D. ARTICLES 110 AND 111 EPC**

8. Article 110 EPC in conjunction with Rules 64-67 EPC define how appeals are to be examined.
9. Article 111 EPC lays down the appeal's effect of remittal and the binding effect of the board of appeal's decision. The effect of the appeal, the scope of the boards' power to rule on the substantive issues involved or to remit the case to the department of first instance, and the effect of a board's decision, are fundamental elements of the appeals procedure. The powers of the boards of appeal and the departments of first instance in the subsequent procedure are thereby defined.
10. The provisions in Article 110 EPC can be streamlined and their contents transferred to the Implementing Regulations relating to Part VI of the Convention (Rules 64-67 EPC). Articles 110 and 111 EPC can be combined.

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<sup>(1)</sup> See CA/PL 6/00.

<sup>(2)</sup> See CA/PL 15/00.

<sup>(3)</sup> See CA/PL 8/00.

### III. PROPOSED AMENDMENTS

#### Present wording

##### Article 106

Decisions subject to appeal

(1) An appeal shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division. It shall have suspensive effect.

(2) An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States.

(3) A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

(4) The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal.

(5) A decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount is in excess of that laid down in the Rules relating to Fees.

##### Article 107

Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal.

#### Proposed wording

##### Article 106

Decisions subject to appeal

(1) An appeal shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division. It shall have suspensive effect.

(2) **Delete**

(3) *becomes (2) - wording unchanged*

**(3) The right to lodge an appeal against decisions relating to the apportionment or fixing of costs in opposition proceedings may be restricted in the Implementing Regulations.**

##### Article 107

**Filing of appeals**

**(1)** Any party to proceedings adversely affected by a decision may appeal.

Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

### **Article 108**

#### Time limit and form of appeal

Notice of appeal must be filed in writing at the European Patent Office within two months after the date of notification of the decision appealed from. The notice shall not be deemed to have been filed until after the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

### **Article 109**

#### Interlocutory revision

(1) If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings.

(2) If the appeal is not allowed within three months after receipt of the statement of grounds, it shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

**(2) The appeal must be filed and the grounds for appeal set out in accordance with the Implementing Regulations.**

**Delete** - see proposed Article 107(2)

### **Article 109**

#### Interlocutory revision

**Where the appellant is not opposed by another party to the proceedings**, the department whose decision is contested [...] shall rectify the decision **if it** considers the appeal admissible and well founded. [...] If the appeal is not allowed within **the time limit prescribed in the Implementing Regulations**, it shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

### **Article 110**

#### Examination of appeals

(1) If the appeal is admissible, the Board of Appeal shall examine whether the appeal is allowable.

(2) In the examination of the appeal, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from another party or issued by itself.

(3) If the applicant fails to reply in due time to an invitation under paragraph 2, the European patent application shall be deemed to be withdrawn, unless the decision under appeal was taken by the Legal Division.

### **Article 111**

#### Decision in respect of appeals

(1) Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal.

### **Article 110**

#### Examination of appeals and decision in respect of appeals

**(1) The Board of Appeal shall examine in accordance with the Implementing Regulations whether the appeal is admissible and well founded.**

**(2) In deciding whether the appeal is well founded,** the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution

*Paragraph (2) corresponds to existing Article 111(1).*

**(3)** If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same. If the decision which was appealed emanated from the Receiving Section, the Examining Division shall similarly be bound by the ratio decidendi of the Board of Appeal.

*Paragraph (3) corresponds to existing Article 111(2).*

**Delete** - see proposed Article 110(2) and (3)

The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution

(2) If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same. If the decision which was appealed emanated from the Receiving Section, the Examining Division shall similarly be bound by the ratio decidendi of the Board of Appeal.