



## **Draft proposed amendments to the Rules of Procedure of the Boards of Appeal**

Public draft – online user consultation

15 June 2023

Amendments to the provisions are shown in bold. Deletions are struck through; additions are highlighted in grey.

| RPBA – current provisions   | RPBA – proposed provisions  | Explanatory remarks  |
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| <p><b>Article 12</b><br/><b>Basis of appeal proceedings</b></p> <p>(1) Appeal proceedings shall be based on (...)<br/>(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;</p>   | <p><b>Article 12</b><br/><b>Basis of appeal proceedings</b></p> <p>(1) Appeal proceedings shall be based on (...)<br/>(c) in cases where there is more than one party, any written reply of the other party or parties, <b>which shall</b> <del>to be</del> filed within <b>four two</b> months of notification of the grounds of appeal <b>unless the Board specifies a longer period, which shall not be more than four months;</b></p> | <p>To support the pursuit of more ambitious timeliness objectives, it is proposed to shorten the standard period for filing the written reply to two months. At the same time, it is proposed that the Board be given the discretionary power to extend this standard period of its own motion. For example, in a case where the proprietor is the respondent and there are numerous appeals by different opponents, the Board will normally extend the time limit from the outset.</p> <p>As is the case under the current version of Article 12(1)(c), any respondent will be able to request an extension of the period up to a maximum of six months in accordance with Article 12(7).</p> |
| <p>(...)</p> <p>(7) Periods specified by the Board may exceptionally be extended at the Board's discretion upon a written and reasoned request, presented before the expiry of such period. The same applies mutatis mutandis to the period referred to in paragraph 1(c); however, this period may only be extended up to a maximum of six months.</p> | <p>(...)</p> <p>(7) Periods specified by the Board may exceptionally be extended at the Board's discretion upon a written and reasoned request, presented before the expiry of such period. The <del>same applies mutatis mutandis to the</del> period referred to in paragraph 1(c); <del>however, this period</del> may only be extended up to a maximum of six months.</p>   | <p>No change is proposed to the essence of the provision.</p> <p>An amendment is proposed only for reasons of consistency. As the period under the proposed new Article 12(1)(c) is specified by the Board, an extension of the period for filing a written reply to the statement of grounds of appeal would be in direct application of Article 12(7), first</p>   |

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|   |  | <p>sentence. Hence it is proposed to delete the reference to "mutatis mutandis" in Article 12(7), second sentence.</p>   |
| (...)   | (...)  |  |
| <b>Article 13</b><br><b>Amendment to a party's appeal case</b>  | <b>Article 13</b><br><b>Amendment to a party's appeal case</b>   |  |
| (...)   | (...)  |  |
| <p>(2) Any amendment to a party's appeal case made after the expiry of a period specified by the Board in a communication under Rule 100, paragraph 2, EPC or, where such a communication is not issued, after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.</p> | <p>(2) Any amendment to a party's appeal case made after the expiry of a period specified by the Board in a communication under Rule 100, paragraph 2, EPC or, where such a communication is not issued, after notification of a <del>summons to oral proceedings</del> <b>communication under Article 15, paragraph 1</b>, shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.</p> | <p>Currently, the third level of the convergent approach applicable in appeal proceedings may be triggered before a Board sends a substantive communication under Rule 100(2) EPC or under Article 15(1). This is because it may be triggered by notification of a summons to oral proceedings, which may be despatched without a communication under Article 15(1). At times, in particular when the communication under Article 15(1) has been notified considerably later than the summons to oral proceedings, this has been perceived as not being ideal.</p> <p>It is thus proposed to replace notification of a summons to oral proceedings with notification of a communication under Article 15(1) as a trigger for the third level of the convergent approach. The expiry of a period specified by the Board in a communication under Rule 100(2) EPC would remain as a trigger for the third level of the convergent approach.</p> <p>Under the proposed new provision, users</p> |

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|   |   | of the patent system would benefit from the less strict approach under Article 13(1) until a later stage in the proceedings. This amounts to an extension of the second level of the convergent approach applicable in appeal proceedings.   |
| (...)   | (...)   |  |
| <p><b>Article 15</b><br/><b>Oral proceedings and issuing decisions</b></p> <p>(1) Without prejudice to Rule 115, paragraph 1, EPC, the Board shall, if oral proceedings are to take place, endeavour to give at least four months' notice of the summons. In cases where there is more than one party, the Board shall endeavour to issue the summons no earlier than two months after receipt of the written reply or replies referred to in Article 12, paragraph 1(c). A single date is fixed for the oral proceedings.</p> <p>In order to help concentration on essentials during the oral proceedings, the Board shall issue a communication drawing attention to matters that seem to be of particular significance for the decision to be taken. The Board may also provide a preliminary opinion. The Board shall endeavour to issue the communication at least four months in advance of the date of the oral proceedings.</p> | <p><b>Article 15</b><br/><b>Oral proceedings and issuing decisions</b></p> <p>(1) Without prejudice to Rule 115, paragraph 1, EPC, the Board shall, if oral proceedings are to take place, endeavour to give at least four months' notice of the summons. <del>In cases where there is more than one party, the Board shall endeavour to issue the summons no earlier than two months after receipt of the written reply or replies referred to in Article 12, paragraph 1(c).</del> A single date is fixed for the oral proceedings.</p> <p>In order to help concentration on essentials during the oral proceedings, the Board shall issue a communication drawing attention to matters that seem to be of particular significance for the decision to be taken. The Board may also provide a preliminary opinion. The Board shall endeavour to issue the communication at least four months in advance of the date of the oral proceedings. <b>In cases where there is more than one party, the Board shall issue the communication no</b></p> | <p>Under the proposed new Article 13(2), notification of the summons to oral proceedings does not mean that a stricter approach will apply to the parties' submissions. When fixing the date for oral proceedings, the Board will consider the circumstances of the case, including its complexity and the envisaged length of the proceedings. Under the proposed new Article 13(2), early notification of a summons to oral proceedings is purely beneficial for parties and representatives, who can make the necessary arrangements. This increases the chances of the participants being available on the scheduled date, in particular in cases involving a high number of parties.</p> <p>Having this in mind, it is proposed to delete the second sentence of Article 15(1): "In cases where there is more than one party, the Board shall endeavour to issue the summons no earlier than two months after receipt of the written reply or replies referred to in Article 12, paragraph 1(c)."</p> |

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|       | <p><b>earlier than one month after receipt of the written reply or replies referred to in Article 12, paragraph 1(c).</b></p> | <p>This sentence currently provides parties with an enhanced possibility to provide comments on the reply or replies to the statement of grounds at the second level of the convergent approach.</p> <p>To continue enabling this under the proposed new Article 13(2), it is proposed to add a sentence to the end of Article 15(1).</p> <p>The proposed new provision strengthens the position of parties to proceedings. The current provision lays down that "the Board shall endeavour", which enables the Board to apply a shorter timescale based on the circumstances of the case (e.g. in the case of accelerated proceedings). The proposed new Article 15(1) guarantees ("the Board shall issue") that the third level of convergence will not be triggered before the expiry of one month after receipt of the written reply.</p> <p>Under the proposed new provision, where there is more than one party the Board may only apply a shorter timescale for issuing the communication if all the appellants consent to a shorter timescale being adopted. A longer timescale remains at the discretion of the Board considering all the circumstances of the case.</p> |
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| <p>(9) The Board shall issue the decision on the appeal in a timely manner.</p> <p>(a) Where the Chair 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. The President of the Boards of Appeal shall also be informed thereof.</p> <p>(b) When a case is ready for decision at the conclusion of the oral proceedings but the Chair does not announce the decision on the appeal orally in accordance with paragraph 6, the Chair 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.</p> | <p>(9) The Board shall issue the decision on the appeal in a timely manner.</p> <p>(a) Where the Chair 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. The President of the Boards of Appeal shall also be informed thereof.</p> <p>(b) When a case is ready for decision at the conclusion of the oral proceedings but the Chair does not announce the decision on the appeal orally in accordance with paragraph 6, the Chair 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 <b>and the President of the Boards of Appeal</b> of a new date or, in exceptional circumstances, shall issue a communication specifying the further procedural steps that will be taken.</p> | <p>The context of pursuing more ambitious timeliness objectives speaks in favour of harmonising Article 15(9)(a) and (b).</p> <p>It is thus proposed to add a reference to the President of the Boards of Appeal in Article 15(9)(b). If the Chair does not announce the decision on the appeal at the oral proceedings even though the case is ready for decision, and the decision is not despatched within three months of the closure of the oral proceedings, the attention of the President of the Boards of Appeal will be drawn to this delay in despatching the decision.</p> <p>In the exceptional situation that the Board decides to continue the proceedings, the Board must also inform the President of the Boards of Appeal that further procedural steps will be taken.</p> |
| <p>(...)</p>  | <p>(...)</p>   |  |

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| <p><b>Article 25</b><br/><b>Transitional provisions</b></p> <p>(1) The revised version shall apply to any appeal pending on, or filed after, the date of the entry into force, subject to the following paragraphs.</p> <p>(2) Article 12, paragraphs 4 to 6, of the revised version shall not apply to any statement of grounds of appeal filed before the date of the entry into force and any reply to it filed in due time. Instead, Article 12, paragraph 4, of the Rules of Procedure of the Boards of Appeal in the version valid until the date of the entry into force shall continue to apply.</p> <p>(3) Where the summons to oral proceedings or a communication of the Board under Rule 100, paragraph 2, EPC has been notified before the date of the entry into force, Article 13, paragraph 2, of the revised version shall not apply. Instead, Article 13 of the Rules of Procedure of the Boards of Appeal in the version valid until the date of the entry into force shall continue to apply.</p> | <p><b>Article 25</b><br/><b>Transitional provisions</b></p> <p>(1) The revised version shall apply to any appeal pending on, or filed after, the date of the entry into force, subject to the following paragraphs.</p> <p>(2) Article 12, paragraphs 4 to 6, of the revised version shall not apply to any statement of grounds of appeal filed before the date of the entry into force and any reply to it filed in due time. Instead, Article 12, paragraph 4, of the Rules of Procedure of the Boards of Appeal in the version valid until the date of the entry into force shall continue to apply.</p> <p>(3) Where the summons to oral proceedings or a communication of the Board under Rule 100, paragraph 2, EPC has been notified before the date of the entry into force, Article 13, paragraph 2, of the revised version shall not apply. Instead, Article 13 of the Rules of Procedure of the Boards of Appeal in the version valid until the date of the entry into force shall continue to apply.</p> <p><b>(4) Article 12, paragraph 1(c), as in force from 1 January 2024 shall not apply to</b></p> | <p>The proposed new Article 25(4) addresses the situation where the statement of grounds of appeal was notified before the date of entry into force of the new provisions.</p> <p>In appeals with multiple appellants, the transitional provision for Article 12(1)(c) applies if the first statement of grounds of appeal was notified before the date of entry into force of the new provisions. In such cases, the current version of Article 12(1)(c) would also apply to the following statement of grounds in the same appeal case, even if they were notified only after the date of entry into force of the new provisions.</p> <p>No transitional period is envisaged for the proposed new Articles 12(7), 13(2), 15(1) and 15(9)(b).</p> <p>The proposed new Article 12(7) does not change the essence of current Article 12(7). The proposed new provision can also be applied to the period for reply to the statement of grounds of appeal in</p> |
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|  | <p><b>any written reply to any statement of grounds of appeal notified before that date. Instead, the version of Article 12, paragraph 1(c), valid until 31 December 2023 shall continue to apply.</b></p> | <p>appeal cases falling under the transitional provision for current Article 12(1)(c).</p> <p>The proposed new Articles 13(2) and 15(1) will apply from the date of entry into force of the new provisions. In pending appeals where the third level of the convergent approach set out in Article 13(2) as currently in force applies solely due to the notification of a summons to oral proceedings, but neither the period specified in a communication under Rule 100(2) EPC has expired nor a communication under Article 15(1) was notified to the parties, the conditions of the second level of the convergent approach will, upon the entry into force of the proposed new provisions, by operation of law, be applicable until the third level is triggered by the proposed new Article 13(2). In such cases, any amendment to a party's appeal case</p> <ul style="list-style-type: none"> <li>(1) after it has filed its <ul style="list-style-type: none"> <li>(a) grounds of appeal or</li> <li>(b) reply</li> </ul> </li> <li>(2) and before <ul style="list-style-type: none"> <li>(a) the expiry of a period specified</li> </ul> </li> </ul> |
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|  |  | <p>by the Board in a communication under Rule 100(2) EPC or (b) notification of a communication under Article 15(1)</p> <p>will be treated under the second level of the convergent approach governed by Article 13(1), irrespective of the amendment being made before or after the entry into force of the new provisions.</p> <p>Finally, the amendment proposed to Article 15(9)(b) is of internal character only. No transitional provision needs to be laid down in the Rules of Procedure of the Boards of Appeal.</p> |
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