



## Rules of Procedure of the Boards of Appeal 2020

The Rules of Procedure of the Boards of Appeal are the rules that govern the way appeals are conducted at the European Patent Office (EPO). Recent changes to these rules came into effect on **1 January 2020**. The new rules (known as "RPBA 2020") can be found **here**. The EPO considers the aims of the revisions to be to increase (i) efficiency, by reducing the number of issues to be treated, (ii) predictability for the parties, and (iii) harmonisation.



### *The basis of appeal proceedings and ability to subsequently amend your case*

Under the new rules, the basis of appeal proceedings is governed by Article 12 and the ability to subsequently amend your case is governed by Article 13.

Perhaps the most striking changes introduced with the RPBA 2020 is the increased discretion given to the Boards to allow them to decide what is or is not admissible in proceedings.

Under new Article 12, a party's case is to be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based<sup>1</sup>. As such, it is no longer the case that everything presented at the outset of appeal proceedings is included in the appeal proceedings.

Connected with this, both the decision under appeal and the minutes of any oral proceedings before the department of first instance are expressly listed as being documents upon which the appeal proceedings will be based<sup>2</sup>. It is therefore important to carefully review the minutes of oral proceedings and the grounds for the first instance decision to ensure that it accurately reflects what was discussed, particularly if there was anything discussed at oral proceedings that you may wish to reply upon or discuss further in the appeal.

Any requests, facts, objections, arguments and evidence on which the decision under appeal was not based will be considered as an amendment to a party's case<sup>3</sup>. Such amendments must be identified and justified, and admissibility is at the discretion of the Boards<sup>4</sup>. Furthermore, any requests, facts, objections, arguments, or evidence which were not admitted into the first instance proceedings will not be admitted into the appeal proceedings unless the decision not to admit them at first instance suffered from an error in the use of discretion by the first instance division or if the circumstances of the appeal case justify their admittance<sup>5</sup>.

An amendment of a party's case in appeal proceedings after a summons to oral proceedings has been issued or after expiry of the Rule 100(2) EPC period will not be taken into account unless there are "exceptional circumstances", justified with "cogent reasons".



### *Remittal*

The new rules reduce the likelihood of the so-called “ping-pong effect” between the Boards and departments of first instance as the Boards will only remit a case to the first instance if “special reasons present themselves for doing so”. If all issues can be dealt with by the Board without undue burden, the Board may not choose to remit the case.

As such, it should become less common for Boards to remit a case back to the Examining or Opposition Division. As a consequence of the stricter rules regarding admissibility of appeal submissions, it might be expected that more issues will be dealt with in first instance proceedings and whether the first instance divisions change their practice in response to this still remains to be seen.



### *Preliminary Opinion*

Under the new rules, the Boards now endeavour to issue a Summons at least four months before oral proceedings. The Summons is in the form of a communication drawing attention to the matters of particular importance. The Boards also provide a preliminary opinion on the basis of the written submissions unless it is inappropriate to do so. This communication is intended to allow parties to have some understanding of what it likely to be discussed in the oral proceedings and to prepare accordingly.



### *Priority of appeals & treating appeals together*

Previously, parties to an appeal could request accelerated proceedings in light of, for example, infringement proceedings in a contracting state. From 1 January 2020, Boards are now able to accelerate proceedings in response to requests from parties, or of their own motion without the consent of the parties. A national court may also request acceleration of appeal proceedings and does not need to provide a specific reason for requesting acceleration (contrary to the requirements for a party requesting acceleration).

Boards have discretion to determine the “priority” of appeals, particularly whether an appeal should be given priority over another appeal. Some guidance suggests that this will be the case if, for example, remittal seems likely or if the appeal appears to be inadmissible. This will allow the Boards to more efficiently deal with inadmissible appeals.

Boards also have discretion to treat appeals together where they are “clearly connected”. In this respect, the Boards are able to decide to deal with such appeals one immediately after another or to consolidate appeal proceedings where appropriate.

In general, however, cases will still be treated on the basis of the “first in, first out” principle.



### *Planning Ahead*

A list of appeal hearings expected to be heard by each Board will now be published at the beginning of every working year, allowing parties to more effectively budget and plan for hearings.



## *Applicability of new rules and practical steps*

The new rules apply to all appeals pending on, or filed after, 1 January 2020 subject to the provisos that:

- New Article 12(4)-(6) governing the basis of appeal proceedings does not apply to a statement of grounds of appeal filed before 1 January 2020 or to replies filed thereto within the 4-month period (this is even if the 4-month period expires after 1 January 2020)
- Any submission which was already on file by 1 January 2020 and which was subsequent to the statement of grounds of appeal or the reply filed thereto will be subject to new Article 13(1), which governs amendment to a party's appeal case
- In appeals where a summons to oral proceedings was already issued before 1 January 2020, new Article 13(2), which governs amendment to a party's case after notification of a summons, will not apply

Therefore, the applicability of new Article 12 governing the basis for appeal proceedings is dictated by when the statement of grounds of appeal was filed.

Aside from the provisos set out above, the new rules will apply, and applicants, opponents and patentees alike should take this into account during proceedings at first instance.

For applications where a Summons is issued by the Examining Division, a review should be undertaken to determine whether additional arguments, facts, evidence or requests should be filed at the first instance level by the Rule 116 deadline in case of refusal and subsequent appeal.

For oppositions, parties should ensure that statements of grounds of opposition and responses thereto are as complete as possible in terms of arguments, facts and evidence. For patentees, careful consideration should be given to filing Auxiliary Requests with their response to an opposition as this represents the only time that such requests can be filed without being subject to an admissibility .

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<sup>1</sup> Article 12(2) RPBA 2020

<sup>2</sup> Article 12(1) RPBA 2020

<sup>3</sup> Article 12(4) RPBA 2020

<sup>4</sup> Article 12(4) and Article 13(1) RPBA 2020

<sup>5</sup> Article 12(6) RPBA 2020