

[Our response to the proposed new amendments to the Rules of Procedure of the Boards of Appeal \(RPBA\)](#)

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The EPO has opened a [User Consultation](#) on the proposed new amendments to the Rules of Procedure of the Boards of Appeal (RPBA). The amendments seek to support more ambitious timeliness objectives, but in our view they are unlikely to shorten appeal proceedings, will reduce the quality of decisions, and are unfair on Respondents. In our view, they should not be adopted in full.

In the following, we highlight the proposed amendments and our response thereto.

Article 12

Basis of appeal proceedings

(1) Appeal proceedings shall be based on

(...)

*(c) in cases where there is more than one party, any written reply of the other party or parties, **which shall to be filed within four two months of notification of the grounds of appeal unless the Board specifies a longer period, which shall not be more than four months;***

This amendment will have no meaningful impact on the timeliness of EPO appeal proceedings anytime in the foreseeable future, will reduce the quality of decisions, and is unfair on Respondents. As such, it introduces significant disadvantages without bringing any advantages. We are of the view that this amendment should not be implemented.

Amendment will have no meaningful impact on timeliness

The proposed amendment would only have an impact on timeliness if the Boards of Appeal (BoA) dealt with cases as soon as they are transferred to them such that the response to the Grounds of Appeal is the rate determining step. This is not the case at present and is unlikely to be the case in the foreseeable future.

The main delay in EPO Appeal proceedings is the time taken by the BoA to issue the Summons and Communication under Article 15(1) RPBA, which typically do not arrive until well over a year after the Response to the Grounds of Appeal has been filed. Shortening the period for response to the Grounds of Appeal will not have an impact on the timeliness of Appeal proceedings as long as the BoA remain unable to issue the Summons and Communication under Article 15(1) RPBA soon after the Response to the Grounds of Appeal is submitted.

This much seems to be tacitly acknowledged in the “*Explanatory remarks*”, which do not even claim that the amendment will increase the timeliness in itself, but only that it may “*support the pursuit of more ambitious timeliness objectives*”. But the value in setting “*more ambitious timeliness objectives*” is limited when the present objectives have no realistic

prospect of being met in the foreseeable future. As made clear by the “[Annual Report of the Boards of Appeal 2022](#)” page 8 figure 4, the BoA are still falling far short of their objective of settling 90% of cases within 30 months, with all technical fields still significantly above 50 months. Based on the current trend, the current objective may not even be met this decade.

Even if the BoA manage to hit the target of achieving a pendency time of 30 months, it doesn't follow that the proposed amendment will reduce pendency time. Even at 30 months, the BoA will still be far from dealing with cases as soon as they are transferred to them. Shortening the period for Response to the Grounds of Appeal is unlikely to have any impact on the pendency time at all until the pendency time reaches closer to the limit of fourteen months or less based on the timelines already set out in the law (based on the Grounds of Appeal (four months under Article 108 EPC), Response to the Grounds of Appeal (four months under Article 12(1)(c) RPBA), time until summons (two months under Article 15(1) RPBA), time set by summons (four months under Article 15(1) RPBA)).

Amendment will have a negative impact on decision quality

As reported in the “*Annual Report of the Boards of Appeal 2022*” page 10 second paragraph, the quality working group commissioned by the President of the Boards of Appeal (PBoA) highlighted the “*completeness of the examination of relevant factual and legal issues*” as a key factor determining the quality of decisions of the BoA. The proposed amendment gives Respondents less time to respond to the Grounds of Appeal, reducing their ability to bring relevant factual and legal issues to the attention of the BoA. This will inevitably reduce the level of debate before the BoA and the quality of their decisions.

As a result, the proposed amendment will undermine the objective expressed in the “*Annual Report of the Boards of Appeal 2022*” page 10 first paragraph of ensuring that “*efficiency gains are made at no material cost to the quality of the decision-making*”. Instead, the proposed amendment will reduce decision quality while having no meaningful impact on timeliness.

Amendment unfair on Respondents

Appellants already have an advantage as they can start to prepare their Grounds of Appeal after announcement of the decision in oral proceedings. The written decision typically follows months after the oral decision, meaning that Appellants may already have significantly longer than Respondents to set out their complete case in their initial Appeal submission.

The proposed amendment further tips the balance in favour of Appellants, by giving Respondents even less time to respond by default. This is contrary to the fundamental principle of EPO law that in contentious proceedings the parties should be given “*equally fair treatment*” as acknowledged in G 9/91 reasons 2. It is difficult to see how this principle can be reconciled with the proposed amendment which means that Appellants may have several months to prepare a Grounds of Appeal which Respondents may (depending on the discretion of the BoA) have just two months to respond to.

The proposed amendment is also not in line with Article 23 RPBA, which requires that the RPBA should “*not lead to a situation which would be incompatible with the spirit and purpose of the Convention*”. Article 108 EPC stipulates that Appellants have **two months** just

to file the formal Notice of Appeal, and **four months** to prepare their substantive Grounds of Appeal. The further time and effort required to deal with a complex substantive submission on appeal is expressly recognized by and hence within the spirit of the Convention. Giving Respondents just two months for the equally complex task of responding to the Grounds of Appeal is incompatible with the spirit of the Convention and hence violates Article 23 RPBA.

It is also noted that in proceedings before the EPO, a two-month period is normally only set for issues which are “*merely formal or merely of a minor character; if simple acts only are requested*” – see Guidelines E-VIII, 1.2. Presenting a complete case in response to a Grounds of Appeal is one of the most challenging and time-consuming submissions before the EPO, so setting a two-month period by default is completely out of step with the rest of EPO practice.

These issues are also exacerbated by the fact that the 10-day notification period no longer applies from 1 November 2023, further shortening the time that Respondents have to reply.

Amendment reduces the attractiveness of Opposition Proceedings before the EPO relative to the UPC

Parties can now choose the forum for pan-European invalidity proceedings between the UPC and the EPO. The UPC aims to process cases more rapidly than the EPO, but the rules still give Respondents **three months** to respond to the Grounds of Appeal (see Rules of Procedure of the UPC 235(1)). The proposed amendment makes the EPO proceedings less attractive than UPC proceedings, by combining lengthy proceedings with shorter timelines for response.

Article 13

Amendment to a party's appeal case

(...)

*(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 **communication under Article 15, paragraph 1**, shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.*

We fully support this amendment.

Article 15

Oral proceedings and issuing decisions

(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. 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. **In cases where there is more than one party, the Board shall issue the communication no earlier than one month after receipt of the written reply or replies referred to in Article 12, paragraph 1(c).***

This proposed amendment will have no meaningful impact on the timeliness of EPO appeal proceedings anytime in the foreseeable future for essentially the same reasons given for Article 12(1)(c) RPBA above. The proposed amendment would only have an impact on timeliness when the BoA are able to deal with cases as soon as they are transferred to them.

The proposed amendment impels parties to respond to the response to the Grounds of Appeal within just one month in order to avoid the risk that their submissions fall under the strict admissibility requirements of Article 13(2) RPBA. It places parties to the Appeal proceedings under unnecessary pressure to make complex submissions on a very short timescale. It will therefore have a negative impact on the quality of decisions for essentially the same reasons given for Article 12(1)(c) RPBA above.

As a result, it introduces significant disadvantages without bringing any advantages. We are of the view that this proposed amendment also should not be implemented at least until the BoA are able to deal with cases as soon as they are transferred to them.

The issuance of the Communication under Article 15(1) RPBA is highly significant for the parties under proposed Article 13(2) RPBA, since it starts the third level of the convergent approach. If the proposed amendment to Article 15(1) RPBA is implemented, it is requested that a mechanism be introduced such that the parties can request delay of the Communication to allow time to formulate their response. This will help reduce the pressure on parties in those cases where a response is planned. If no such mechanism is desired, the term set forth in Article 15(1) RPBA should be at least two months so as to allow parties at least one further opportunity to respond to submissions by their adversaries with adequate time, before entering the next level of convergence under Article 13(2) RPBA.

In any event, the last sentence of amended Art. 15(1) RPBA should at least be reworded as follows:

In cases where there is more than one party, the Board shall issue the communication no earlier than one month after the Board's notification, to the other parties, of receipt of the written reply or replies referred to in Article 12, paragraph 1(c).

Indeed, the parties to *inter partes* proceedings have no control over any delay between the receipt by the EPO of the “*written reply or replies referred to in Article 12, paragraph 1(c)*” and its/their notification. The receipt may occur several days before the parties are notified. It would be very user-unfriendly to have a time period start to run from an unknown date of receipt of a document by the EPO rather than from its notification to the parties. It goes without saying that this time period is of significant importance under the proposed amendments: the written reply starts the clock running on the earliest issuance of the

Communication under Article 15(1) RPBA and hence the earliest start date of the final level of convergence under Article 13(2) RPBA.

Article 25

Transitional provisions

(...)

(4) Article 12, paragraph 1(c), as in force from 1 January 2024 shall not apply to 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.

The proposed amendment does not deal with the complex situation introduced by the proposed amendment to Article 13(2) RPBA for the many cases for which the summons but not the Article 15(1) RPBA Communication is notified by 31 December 2023. Namely, the strict admissibility requirements of Article 13(2) RPBA would seem to apply to amendments made in 2023 after the notification of the summons but **not** to later amendments made in 2024 before the Article 15(1) RPBA Communication is notified.

This point seems to be appreciated in the Explanatory Remarks. However, as this is an issue which will impact many Appeal proceedings, for legal certainty the principles outlined in the Explanatory Remarks should be introduced into Article 25 RPBA.