Memory jogger

- 1980 - Current RPBA since 2003 – Arts. 12 & 13

- President BoA and BOAC want RPBA changes to increase:
  - **efficiency** (but maintain quality)
  - **harmonisation** = predictability
  - **transparency** = predictability

reduce issues!

But ... EPC!
[Art. 23(3) / Art. 113(1) / Art. 114(1)/(2) EPC...]
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

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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")
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

β 1(a) decision and minutes of oral proc. (Ex.D/Opp.D)
β 1(b) notice/grounds
β 1(c) reply to appeal (filed within 4m)
β 1(d) any comm. of Board and reply (on Board's direction)
β 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

ër primary object ... to review the decision ... in a judicial manner,
ër a party's appeal case shall be directed to the requests, facts,
  objections, arguments and evidence on which the decision ... was based.

ër Review? – And Art. 114(1) EPC?
  • "primary object ... review" ("judicial review"- removed from 1st draft)

ër "Arguments on which decision was based"?
  • "directed to" - can be developed, but beware "change of case"

ër 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.

ër 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)

ër 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"?

β 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...

β 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"?

β 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...

β 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!

 lưu ý what amended, why? and why only on appeal?

 lưu ý Users - Extra hurdle for patentees?

 lưu ý "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.

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**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.

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**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)

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**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)