Appeal procedures before the EPO: Organisation and procedural principles
Online filing in appeal proceedings

EPO User Day – The Hague
Outline

- The role of the Boards of Appeal Unit in the EPO
  Structural reform - facts - news and figures

- The organisation of the Boards of Appeal Unit

- The life of an appeal before a Board of Appeal

- Online Filing in appeal proceedings
Boards of Appeal within the EPO

- President of the Office
- Boards of Appeal
  As of 01.07.2016
- BoA Committee
- Administrative Council
- DG 1
  Patent Granting Process
- DG 4
  Corporate Services
- DG 5
  Legal / International Affairs
Review of first instance decisions

Receiving Section
Examining Divisions
Opposition Divisions
Legal Division

Decision
Appeal

Boards of Appeal

President
Referral

Enlarged Board of Appeal
Decision
Referral
Review

First instance
Second instance
Judicial status of the Boards of Appeal of the EPO (1)

- Judicial body of the EPO: decisions of first instance can only be appealed before the Boards.

- Boards' decisions to revoke a patent or not to grant a patent (refuse application) are final.

- Boards' decisions maintaining a patent: national parts of European patents can be challenged before each corresponding national court.

- In very exceptional cases: Boards' decisions can be reviewed by the Enlarged Board of Appeal (Art. 112a EPC).
Judicial status of the Boards of Appeal of the EPO (2)

The members of the Boards of Appeal perform an independent judicial activity:

- **Members appointed** (five years/can be renewed) by Administrative Council
- Art. 23(3) EPC: "In their decisions the members of the Boards shall **not be bound by any instructions** and shall comply only with the provisions of this Convention."
- Members **may not have** acted as members in the first instance department in the appealed case
- However, the Boards of Appeal are integrated in the EPO in terms of organisation
Boards of appeal reform (1)

- Adoption of the reform by the Administrative Council in June 2016
- **Aim**: Increase of the managerial autonomy of the boards, the perception of their independence as well as their efficiency
- Boards of Appeal Unit: Separate unit within the EPO (no DG3 anymore)
- President of the BoA (see new [Rule 12a EPC](#)):
  - Mr Carl Josefsson since 1 March 2017 (also Chairman of the Enlarged BoA and the Disciplinary BoA and member of the Legal BoA)
Boards of appeal reform (2)

- **Delegated** functions and powers from the President of the EPO
  - The Act of Delegation was renewed by the newly appointed President of the Office (OJ EPO 2018, A63)
- **Solely** responsible to the Administrative Council
- **Appointed** on a joint proposal of the Boards of Appeal Committee and the President of the EPO
- Proposes appointments and **is consulted** for reappointments
- **Responsible** for proposals for amendments to the Rules of Procedure of the BoA and the EBoA
Boards of appeal reform (3)

- Boards of Appeal Committee (see new Rule 12c EPC):
  - Subsidiary body of the Administrative Council
  - Six members (three AC members and three from national/international judges)
  - Advise the Administrative Council and the President of the BOA with regard to matters concerning the Boards of Appeal Unit in general
  - Adoption of the Rules of Procedure of the BoA and the EBoA
Boards of appeal reform (4) - Comparison

- Directorate-General 3
- Vice President DG 3
- President of the EPO
  - proposes appointment
  - consulted for re-appointment
- Advisory organ: Presidium

- Rules of Procedure: adopted by Presidium / EBoA

- Boards of Appeal Unit
- President of the BoA
- President of the BoA
  - proposes appointment
  - consulted for re-appointment
- Advisory organs: Presidium & BOAC
- Rules of Procedure: adopted by BOAC, on proposal from President of the BoA
Boards of appeal reform (5) - News
Revised RPBA 2020

- **RPBA 2020** - Revised Rules of Procedure of the Boards of Appeal as of 01 January 2020
  - Legal basis: Rules 12b(3)(c) and 12c(2) EPC; Article 23(4) EPC

- **Aims** of the revision:
  - increase efficiency
  - predictability for the parties
  - harmonisation
Boards of appeal reform (6)

New: Revised RPBA 2020

- Revision timeline:

- 2017/2018
  - 2017  Start of internal consultation
  - Feb 2018  First public draft
  - Apr 2018  Online user consultation
  - Nov 2018  Second public draft
  - Dec 2018  User consultation conference
Boards of appeal reform (7)

New: Revised RPBA 2020

- **2019/2020**
  - Apr 2019  Adoption by BOAC in all three languages
  - Jun 2019  Approval by Administrative Council
  - 1 Jan 2020  Entry into force
Boards of appeal reform (8)

**New:** Revised RPBA 2020

The main changes focus on:

- **During initial phase:**
  - Annual publication of list of cases – Article 1(2)
  - Extension of period for filing reply to statement of grounds of appeal up to a maximum of six months – Article 12(7)
  - Flexibility on when to designate members for Board composition – Articles 1(3) and 5(1)
  - More tasks for case rapporteur – Article 5
Boards of appeal reform (9)

**New:** Revised RPBA 2020

- Dealing with connected cases – consolidation of proceedings
  Article 10(2)
- Acceleration of appeal proceedings – new Article 10(3) to (6)

**When preparing for oral proceedings:**
- Mandatory communication by Board in preparation for oral proceedings – Article 15(1)
- New timescale for Boards when preparing oral proceedings (summons and communication) – Article 15(1)
- Change of date of oral proceedings – Article 15(2)
Boards of appeal reform (10)

**New**: Revised RPBA 2020

- **Decision phase:**
  - New timescale for Boards to *issue written decision* – Article 15(9)

- **Entry into force**: 01 January 2020
  - New Articles will apply to *all appeals pending* on that date
### Appeal proceedings by case

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<thead>
<tr>
<th></th>
<th>New cases</th>
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The Boards of Appeal – Facts and figures 2018 (2)

- New cases 2018
- New cases by technical field
The Boards of Appeal – Facts and figures 2018 (3)

- Settled cases 2018
The Boards of Appeal – Facts and figures 2018 (4)

- **Staff:**
  - In 2018, all previously vacant member posts could be filled.
  - The total number of staff at **31 December 2018:** **225**
    - **166** members of the Boards of Appeal divided amongst
      - 28 technical Boards of Appeal and
      - the Legal, the Disciplinary and the Enlarged Board of Appeal
    - **59** support staff
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The organisation of the Boards of Appeal Unit

The life of an appeal before a Board of Appeal

Online Filing in appeal proceedings
Organisational diagram of the Boards of Appeal

- **Presidium**
- **President of the BoA as of 1.3.2017**
- **BOAC Boards of Appeal Committee**

**Enlarged Board of Appeal**

**Legal Board of Appeal**

**28 Technical Boards of Appeal**

- **Disciplinary Board of Appeal**

- **3.0 Legal Research & Administration**
  - 3.0.10 Registry
  - 3.0.20 Planning & Administration
  - 3.0.30 Legal Research Service
  - 3.0.40 Business Processes & Data Management

- **3.2 Mechanics (8)**
- **3.3 Chemistry (10)**
- **3.4 Physics (3)**
- **3.5 Electricity (7)**
The Technical and Legal Boards of Appeal

The Technical Boards of Appeal:

- Responsible for hearing appeals against decisions of the Examining and Opposition Divisions

- Composition:
  - one legally qualified member
  - two technically qualified members
  - in certain cases, two legally qualified and three technically qualified members

The Legal Board of Appeal:

- Responsible for hearing appeals against decisions of the Receiving Section, the Legal Division and against decisions of an Examining Division that concern «legal» aspects

- Composition:
  - three legally qualified members (one of whom is the chairman)
The Enlarged Board of Appeal (1)

Referral Art. 112 EPC (2-3 new cases per year)

- Ensures uniform application of the law
- Decides on points of law referred by a Board – either ex officio or at request of a party
- Gives opinions on points of law referred by the President
- Composition:
  - Five legally qualified and
  - Two technically qualified members

Among the legally qualified members: up to two members of national courts and authorities of Contracting States may be appointed
The Enlarged Board of Appeal (2)
Petition for review Art. 112a EPC (11 new cases in 2018)

- Review of decisions of the Boards of Appeal on the ground that a fundamental procedural defect occurred or that a criminal act may have had an impact on the decision

- No suspensive effect (Art. 112a(3))

- Composition:
  - **Stage 1** (decision = rejection when petition is clearly inadmissible or clearly unallowable):
    two legally qualified members and one technically qualified member
  - **Stage 2** (decision on petition if not rejected during stage 1):
    as in stage 1 plus two legally qualified members
The Disciplinary Board of Appeal (18 new cases in 2018)

- Hears appeals against decisions of the Disciplinary committee of the EPI (Europ. Pat. Institute – Inst. of profess. repr. before the EPO), the Disciplinary Board of the EPO and the Secretary of the examining committee or the examining committee of the European qualifying examination.

- Members:
  - chair, 7 legally qualified members, 9 professional representatives

- Composition (when hearing a case):
  - 3 legally qualified members, 2 professional representatives
  - 2 legally qualified members, 1 professional representative (for EQE matters)
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Online Filing in appeal proceedings
Two kinds of appeals ...

EX PARTE

INTER PARTES
Main steps of the appeal proceedings

1. Filing the appeal
2. Ex parte cases: Interlocutory revision (by Exam. Division)
3. Admissibility check
4. Examination on the merits
   Often: oral hearing
5. Decision
6. Review
   (only under very specific conditions)
Interlocutory revision (Art. 109 EPC)

- *Ex parte* proceedings

- Reconsideration of the decision by the 1st instance department:
  - if appeal is considered admissible and allowable, the 1st instance department rectifies its decision

- If the decision has not been rectified within 3 months it is transmitted to the competent board without comment as to its merits
Admissibility check (R. 101 EPC) (1)

- Is impugned decision an appealable decision? (Art. 106 EPC)

- Have time-limits (filing and fee - 1.880,00 / 2.255,00) been complied with? (Art. 108 EPC)

Notice from the EPO dated 18 December 2017 concerning the reduced fee for appeal (Article 108 EPC) for an appeal filed by a natural person or an entity referred to in Rule 6(4) EPC (OJ EPO 2018, A5)

Appellants wishing to benefit from the reduced fee for appeal must expressly declare that they are a natural person or an entity covered by Rule 6(4) EPC (small and medium-sized enterprises, non-profit organisations, universities and public research organisations.

This declaration may be given in the notice of appeal or on a separate sheet/letter. Pre-printed declaration (Form 1011bis) made available by the EPO can be used. The declaration must be filed at the latest by the time of payment of the reduced fee for appeal.
Admissibility check (R. 101 EPC) (2)

- Is person lodging the appeal entitled to appeal (adverse effect)? (Art. 107 EPC)

- Do the notice of appeal and the statement of grounds of appeal comply with the requirements as to their content? (Art. 108 EPC, R. 99 EPC)
Examination on the merits

Examination by the Board of Appeal of its own motion, taking into account the principles of party disposition and of fairness of the proceedings

- Limits to the examination of its own motion in *ex-parte* proceedings:
  - Proceedings are terminated if the only appellant withdraws his appeal

- Limits to the examination of its own motion in *inter-partes* proceedings:
  - new grounds of opposition may only be introduced if the patent proprietor consents
  - Proceedings are terminated if the only appellant withdraws his appeal
Examination on the merits – written stage

- Chairman designates a "rapporteur"

- Rapporteur:
  - carries out preliminary study of the appeal (Art. 5 RPBA)
  - prepares the oral proceedings
  - prepares draft decision

- Written communications with the parties
  - Art. 15(1) RPBA: communication helping concentration on essentials during oral proceedings
Oral hearing (Art. 116 EPC)

- May take place either at the instance of the Board or at the request of a party
- Public, provided the European patent application has been published
- When case ready for decision: the chairman states the final requests of the parties and declares debate closed
- The Board meets to deliberate
- The decision is announced orally at the end of the oral proceedings (in most of the cases)
- A written decision is issued later
- Taking of evidence (Art.117 EPC), if considered necessary
Types of decisions

- Appeal rejected as inadmissible
- Appeal dismissed

Decision of the first instance set aside:
- Decision on the merits by the Board:
  • to revoke the patent
  • to maintain the patent as granted
  • to remit the case to the first instance with an order to grant the patent
  • to remit the case to the first instance with an order to maintain patent in amended form
- Case remitted to the first instance for further prosecution
- Possibly reimbursement of appeal fee

First instance is bound by the decision of the Board of Appeal
Information concerning the case law of the Boards of Appeal


**EPO offers 3 online filing options**

**Use online filing in** appeal proceedings

<table>
<thead>
<tr>
<th>Online filing (OLF)</th>
<th>New online filing (CMS)</th>
<th>Web-form filing</th>
</tr>
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<td><strong>What is it</strong></td>
<td>It is a client software which requires regular updates at the user’s end. You prepare your PDF documents (except for the request) off-line. Your documents are stored locally and can be retrieved and re-used at any time later on. A receipt is issued immediately upon filing.</td>
<td>It is a web-based application – no need for updates at the user’s end (except for Gemalto software for your smart card). You prepare your PDF documents off-line (except for the request). Your documents are stored on the EPO server during the whole process and can be retrieved and re-used at any time later on. A receipt is issued immediately upon filing.</td>
</tr>
<tr>
<td><strong>Supported procedures</strong></td>
<td>• EP1001 • EP1200 (Euro-PCT) • EP1038 (including appeal) • PCT DEMAND • PCT SFD (Subsequent actions) • EP OPPO (opposition) • PCT/RO 101 • Supports filing with several national offices, including national office procedure and IB (PCT RO 101)</td>
<td>• EP1001 • EP1200 (Euro-PCT) • EP1038 (including Filing, Search, Examination, Opposition, Limitation and Appeal) • PCT SFD (subsequent actions for all PCT phases and documents) • PCT/RO101 • Does not support filing with national offices.</td>
</tr>
<tr>
<td><strong>Access/ level of security</strong></td>
<td>Users need an activated Smart Card. The smart card is only needed for submission.</td>
<td>Users need an activated smart card and have to register to new online filing (CMS) before they can use it. The smart card is used to access the application and is needed during the whole process, including for signing. Account management enables restriction of certain actions per user.</td>
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<td><strong>Format of documents</strong></td>
<td>PDF or XML format Sequence listings (ST25)</td>
<td>PDF or XML format Sequence listings (ST25)</td>
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<td><strong>Who it is recommended for</strong></td>
<td>All users.</td>
<td>All users.</td>
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<td><strong>Link to more information</strong></td>
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<td>New online filing (CMS) New online filing features and benefits New online filing (CMS) tutorial</td>
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</table>
Online filing in appeal proceedings (1)

Since 16 November 2015:

Revised decision of the President of the European Patent Office concerning the electronic filing of documents (OJ EPO 2015, A91):

The use of the enhanced electronic signature is no longer mandatory in appeal proceedings. The provision of Article 8(2) of the decision dated 26 February 2009 on the electronic filing of documents (OJ EPO 2009, 182) has been deleted in the revised decision, meaning that:

- For documents filed online (using eOLF) in appeal proceedings any of the three kinds of signature is accepted:
  - facsimile signature
  - text string signature
  - enhanced electronic signature

(STILL the signatory must be a person authorised to act in the appeal proceedings.)
Online Filing in appeal proceedings (2)
Online Filing Software

"Ready to Sign" status (all 3 signature types are activated in new EOLF software (V.5.09) since November 2015: Smart Card, Alphabetical and Facsimile)
Online Filing in appeal proceedings (3)
Convenient Information concerning the electronic filing:

- Name and address of the appellant in the notice of appeal.

- Please sort the documents filed online.

- On EPO Form „1038“ you may write requests under „Annotations“, however it would be better to use an accompanying letter.
Online Filing in appeal proceedings (4)
Convenient Information concerning the electronic filing:

- **Notice of appeal** may also be filed by using **EPO Form 3002**.
  It can be downloaded as an editable PDF from the EPO’s webpage: EPC proceedings – Forms.
Online filing in appeal proceedings (5) Check List

A separate form for online filing in appeal proceedings has not yet been developed!

- However, persons filing should use Form EP(1038E) where possible in the appeal proceedings as this makes processing easier ⇒ Document types of appeal proceedings
- Document types of appeal proceedings should be used.

- The use of the enhanced electronic signature is no longer mandatory in appeal proceedings.
- For documents filed online (using eOLF) in appeal proceedings any of the three kinds of signature is accepted (facsimile signature, text string signature and enhanced electronic signature).
  (STILL the signatory must be a person authorised to act in the appeal proceedings.)
New online filing = EPO case management system

- Since 1 April 2015 the filing of documents in respect of appeal proceedings (Articles 106 to 112a EPC) using the EPO case management system (CMS) is allowed according to the decision of the President of the EPO dated 11 March 2015 concerning the filing of documents using the EPO case management system.

- Documents filed via CMS can only be signed with a text string signature or a facsimile signature (see Article 5 of the aforementioned decision). An enhanced electronic signature is not provided and consequently not necessary in CMS.

- A document filed via CMS can be identified by an indication in the lower left-hand corner of Form 1038: “1038-CMS-AP” (“AP” stands for Appeal).
Thank you for your attention