

Chapter 11

The Boards of Appeal of the European Patent Office

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11.1 Overview of the patent system

11.1.1 Evolution of the European patent system

The European Patent Convention (EPC) was signed in 1973 and revised in 2000.¹ It is a special agreement under Article 19 of the Paris Convention and a regional patent treaty under Article 45(1) of the Patent Cooperation Treaty.² The EPC, however, goes significantly further than these treaties. What distinguishes the EPC is that it not only harmonizes substantive and procedural patent law but also creates a public authority with the power to grant patents completely independent from national patent offices – the European Patent Office (EPO). Patents granted by the EPO are called European patents.

Before the entry into force of the EPC, patent protection in multiple European countries could only be achieved by following the distinct grant procedures in each of those countries. The EPC now provides a single grant procedure in a single language (English, German or French, as the working languages of the EPO) for patent protection in up to 38 Contracting States.³

However, the procedure before the EPO does not supersede national grant procedures. When seeking patent protection in one or more Contracting States of the EPC, applicants have a choice between following national grant procedures before several national patent offices or taking the single European route before the EPO, which confers protection in all Contracting States designated by the applicant.

Once granted by the EPO, a European patent becomes a bundle of patents having equivalent effect to national patents, which must be validated in each of the selected Contracting States. The envisaged European patent with unitary effect removes the need for national validation procedures in the Contracting States participating in this system.⁴

11.1.2 Patent application trends

In 2021, 188,610 European patent applications were filed – a 4.5 percent increase over the filings in 2020. There was strong growth in digital technologies, such as digital communication, medical technology and computer technology.⁵ More information on patent application trends is available from the website of the EPO Statistics and Trends Centre.⁶

Figure 11.1 shows the total number of patent applications (direct and Patent Cooperation Treaty (PCT) national phase entry) filed with the EPO from 2000 to 2021.

11.2 Patent institutions and opposition proceedings

11.2.1 European Patent Organisation

The European Patent Organisation, instituted by the EPC, has two organs: the EPO and the Administrative Council.⁷ Executive powers are assigned to the EPO and its president, and supervisory powers are assigned to the Administrative Council.⁸ The Administrative Council consists of representatives of the Contracting States to the EPC.⁹ The Boards of Appeal, although not a separate organ of the European Patent Organisation but structurally a part of the EPO,¹⁰

1 Convention on the Grant of European Patents (European Patent Convention) (with Implementing Regulations), Oct. 5, 1973, 1065 UNTS 199, revised by the Act revising the EPC, Nov. 29, 2000 [hereinafter EPC], www.epo.org/law-practice/legal-texts/epc.html

2 See EPC, preamble.

3 In addition, the European Patent Organisation has an extension agreement with Bosnia and Herzegovina and validation agreements with Morocco, the Republic of Moldova, Tunisia and Cambodia.

4 EPC, art. 142. For further information, see www.epo.org/applying/european/unitary/unitary-patent.html

5 For a concise overview of the trends in 2021, see the infographic for the Patent Index 2021, accessible from www.epo.org/about-us/annual-reports-statistics/statistics/2021/statistics/patent-applications.html

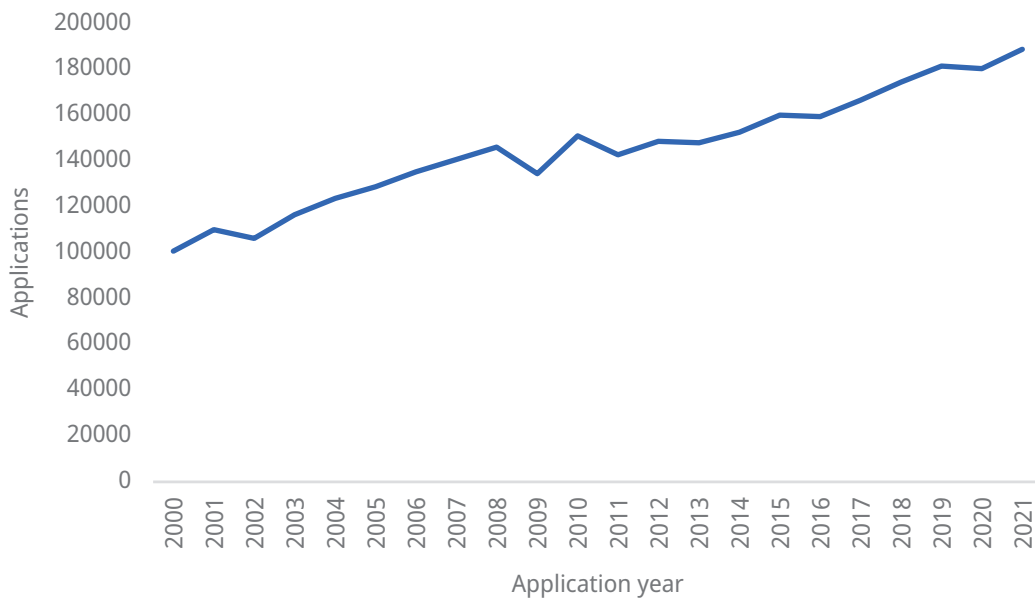
6 Accessible from <https://new.epo.org/en/statistics-centre>

7 EPC, art. 4(2).

8 EPC, arts 4(3), 10.

9 EPC, art. 26(1).

10 EPC, art. 15.

Figure 11.1 Patent applications filed with the EPO, 2000–2021

Source: WIPO IP Statistics Data Center, available at www3.wipo.int/ipstats/index.htm?tab=patent

are assigned the role of an independent judiciary in this patent system.¹¹ They provide an independent review of decisions taken by the EPO's Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division.¹²

11.2.2 Opposition proceedings

The opposition procedure before the EPO is a contentious administrative procedure following the grant procedure. The relief sought by the opponent is not, as in pre-grant opposition, the refusal of the patent application but rather the revocation of the patent with retroactive effect in all designated Contracting States.¹³ Opposition proceedings thus allow, during a limited period, a request for the revocation of the entire European patent (i.e., encompassing all national parts) to be brought before and decided by the EPO in a centralized procedure.

Within nine months after publication of the mention that a European patent has been granted, anyone may give the EPO a notice of opposition.¹⁴ Opposition may only be filed on certain grounds – namely that:

- the patent's subject matter is not patentable (e.g., because the claimed subject matter is not novel, does not involve an inventive step or is excluded from patentability);
- the patent does not disclose the invention clearly and completely enough for it to be carried out by a person skilled in the art; or
- the patent's subject matter extends beyond the content of the (earlier) application as filed.¹⁵

In opposition proceedings, the Opposition Division examines whether the grounds for opposition prejudice the maintenance of the European patent.¹⁶ If necessary, the Opposition Division will

11 See e.g. German Federal Constitutional Court, consolidated cases BvR 2480/10, 2 BvR 421/13, 2 BvR 786/15, 2 BvR 756/16 and 2 BvR 561/18, 8 November 2022; High Court of Justice in the United Kingdom (Patents Court) in *Lenzing* [1997] R.P.C. 245, 22 May 1997; European Commission of Human Rights, *Lenzing AG v. U.K.* 9 September 1998 (in relation to Article 6 of the European Convention on Human Rights); see also the decisions of the Enlarged Board of Appeal and the Technical Boards summarized in Legal Research Service of the Boards of Appeal, *Case Law of the Boards of Appeal*, ch. VII sub-s. 1.2. "Boards of appeal as judicial authorities" (10th ed. 2022), http://www.epo.org/law-practice/legal-texts/html/caselaw/2022/e/clr_vii_1_2.htm

12 EPC, art. 106(1) first sentence.

13 EPC, art. 68.

14 EPC, art. 99(1).

15 EPC, art. 100.

16 EPC, art. 101(1) first sentence.

invite the parties to file written observations.¹⁷ The patent proprietor may file a description, claims and drawings in amended form.¹⁸ Proposals for amendment to the patent – in practice, these proposals are filed as (auxiliary) claim requests – might not be considered if they are late-filed.¹⁹ Oral proceedings before the Opposition Division must be arranged if requested by a party.²⁰ As a rule, oral proceedings in opposition proceedings are held by videoconference.²¹

At the conclusion of opposition proceedings, the Opposition Division may decide:

- to reject the opposition and maintain the patent as granted;
- maintain the patent in amended form; or
- revoke the patent.²²

Any party adversely affected by the Opposition Division's decision may lodge an appeal with the Boards of Appeal. Such an appeal has suspensive effect.²³

11.3 Judicial institutions

11.3.1 Judicial administration

The Boards of Appeal and the Enlarged Board of Appeal, including their registries and support services, are organized as a separate unit within the EPO. They are directed by the President of the Boards of Appeal, who is appointed by the Administrative Council of the European Patent Organisation. The President of the Boards of Appeal is solely responsible to the Administrative Council and exercises functions and powers delegated to them by the President of the EPO.²⁴

The President of the Boards of Appeal is advised by the Presidium of the Boards of Appeal. The Presidium consists of the President and 12 members of the Boards of Appeal elected by other members. It also adopts a Code of Conduct for the members of the Boards of Appeal²⁵ and, in an extended composition, the business distribution scheme.²⁶

11.3.2 Specialized intellectual property judiciary

11.3.2.1 Boards of Appeal as the first and final judicial instance

The Boards of Appeal are the first and final judicial instance in the procedures before the EPO. They have the task of reviewing contested decisions of the departments of first instance. In their decisions, they are not bound by any instructions and must comply only with the provisions of the EPC.²⁷ They are recognized as independent courts based on the rule of law.²⁸

11.3.2.2 Specialization

The Boards of Appeal deal exclusively with patent cases and are therefore a highly specialized intellectual property judiciary. They usually decide in a composition of two technically qualified members and one legally qualified member.²⁹ At the end of 2021, there were 196 board members and 28 Technical Boards of Appeal, each of which has a different technical specialization. The Boards of Appeal settled 3,395 patent cases in 2021.³⁰

As expert patent courts, the Boards of Appeal have a central role in the development of European patent law. Their decisions are final and not subject to any further appeal. Their case law and

17 EPC, art. 101(1) second sentence.

18 EPC, art.123(1), r. 81(3).

19 EPC, arts 114(2), 123(1), r. 116.

20 EPC, art. 116(1).

21 See Decision of the President of the European Patent Office dated 22 November 2022 concerning the format of oral proceedings before examining and opposition divisions, the Legal Division and the Receiving Section.

22 EPC, art. 101(2), (3)(a), (3)(b).

23 EPC, arts 106(1), 107.

24 EPC, r. 12a(1)–(2).

25 For the text of the Code of Conduct and explanatory remarks thereto, see *Approval of the Code of Conduct for Members of the Boards of Appeal and of the Enlarged Board of Appeal*, EPO Doc. CA/68/21 (Nov. 26, 2021), www.epo.org/modules/epoweb/acdocument/epoweb2/530/en/CA-68-21_en.pdf

26 EPC, r. 12b(1)–(4).

27 EPC, art. 23(3).

28 See Section 11.2.1.

29 EPC, art. 21.

30 For statistics and more information on the Boards of Appeal, see the annual reports, accessible from www.epo.org/law-practice/case-law-appeals/annual-report.html

interpretations of the EPC are not only the basis for the practices established by the EPO for examination and opposition proceedings but are also deemed highly persuasive in national court proceedings.³¹

The most important of the over 42,000 decisions that the Boards of Appeal have rendered from 1978 to 2021 are summarized in the book *Case Law of the Boards of Appeal* (in its 10th edition, published in 2022), which provides a compendious overview of their jurisprudence.³²

11.3.2.3 Enlarged Board of Appeal

The Enlarged Board of Appeal is mainly responsible for ensuring the uniform application of the EPC. It decides on points of law of fundamental importance referred to it either by a Board of Appeal or by the President of the EPO.

When a Board of Appeal refers a specific point of law to the Enlarged Board, the Enlarged Board decides only that point. The decision on the appeal itself is then taken by the referring Board, which is bound by the decision of the Enlarged Board in respect of the point of law that it referred.

The President of the EPO may also make a referral to the Enlarged Board, provided that two Boards of Appeal have given different decisions on a point of law of fundamental importance.³³ The Enlarged Board of Appeal will then give an opinion on this point of law.

If a Board of Appeal considers it necessary to deviate from an interpretation or explanation of the EPC contained in an earlier opinion or decision of the Enlarged Board of Appeal, it must refer the question (again) to the Enlarged Board of Appeal.³⁴

A further task of the Enlarged Board is a limited judicial review of decisions of the Boards of Appeal regarding possible fundamental procedural defects.³⁵ If a petition for such a review is successful, the decision is set aside, and the appeal proceedings are reopened before the Boards of Appeal.³⁶

11.3.3 Relationship between invalidity and infringement proceedings

The EPC created a patent litigation system in which an international court (i.e., the Boards of Appeal of the EPO), the national courts of the Contracting States to the EPC and the Unified Patent Court have concurrent jurisdiction on the validity of a European patent. The European patent as a whole – that is, the entire bundle of patents having equivalent effect to national patents – is subject to the centralized procedure before the EPO and its Boards of Appeal. At the same time, the individual national parts of a European patent are subject to national revocation proceedings (e.g., a German court may revoke the German part of a European patent; and a French court, the French part) and to revocation proceedings before the Unified Patent Court.³⁷

Appeal proceedings before the Boards of Appeal of the EPO and proceedings before national courts or the Unified Patent Court are formally independent of each other. However, a European patent revoked by the Boards of Appeal may not be reinstated by national courts or the Unified Patent Court, and a national part of a European patent revoked by a national court or the Unified Patent Court may not be reinstated by the Boards of Appeal.

31 See, e.g., *Merrell Dow Pharmaceuticals, Inc. v. HN Norton & Co. Ltd* [1996] R.P.C. 76 (HL), para. 12 (U.K.); *Human Genome Sciences v. Eli Lilly* [2011] UKSC 51, para. 84 (U.K.); Bundesgerichtshof (Federal Court of Justice), April 15, 2010, Xa ZB 10/09 (*Walzenformgebungsmaschine*), para. 14 (Ger).

32 *Case Law of the Boards of Appeal* can be accessed free of charge in English, French or German from www.epo.org/law-practice/case-law-appeals/case-law.html

33 EPC, art. 112.

34 Rules of Procedure of the Boards of Appeal, art. 21 (July 3, 2019) [hereinafter RPBA 2020].

35 EPC, art. 112a. See also the Enlarged Board of Appeal, July 15, 2008, R 1/08, which was the first case on a petition for review: "Under no circumstances should the petition for review be a means to review the application of substantive law.' [...] The Board therefore considers that Article 112a EPC provides an exceptional means of redress, which provisions have to be applied strictly. Thus, it is not the purpose of Article 112a EPC that a case be decided upon by a third instance, but rather, it provides the right for a judicial review founded on a limited number of grounds that have been exhaustively defined by the legislator." *Id.* at 10.

36 EPC, art. 112a(5).

37 EPC, arts 99, 100, 138. See also Agreement on a Unified Patent Court, 2013 OJ (C 175) 1 [hereinafter Agreement on a Unified Patent Court], art. 65(2).

Infringement procedures on European patents fall under the competence of the national courts of the Contracting States to the EPC³⁸ and the Unified Patent Court.³⁹

11.3.4 Judicial education on intellectual property

The Boards of Appeal have a dedicated Professional Development Committee, which organizes comprehensive training programs for all board members – including lectures and interactive discussions on various patent-related topics – including with judges from other patent courts. The support services of the Boards of Appeal also include the Legal Research Service of the Boards of Appeal, which provides summaries of recent decisions and comparative studies on patent and procedural law. This ensures that board members are up to date with the latest developments in European patent law. Furthermore, newly appointed chairs and members receive extensive introductory training, and legal drafting and language courses are offered continuously to all board members.

11.4 Patent invalidity proceedings and invalidity grounds

As noted above in Section 11.2.2, the EPC provides an exhaustive list of grounds for opposition (i.e., grounds on which a European patent may be revoked). These are that:

- the patent's subject matter is not patentable (e.g., because the claimed subject matter is not novel, does not involve an inventive step or is excluded from patentability);
- the patent does not disclose the invention clearly and completely enough for it to be carried out by a person skilled in the art; or
- the patent's subject matter extends beyond the content of the (earlier) application as filed.⁴⁰

In opposition and opposition appeal proceedings, the patent proprietor may file amendments to the patent. The Opposition Division or the Board of Appeal will then assess whether the amended patent and the invention to which it relates meet the requirements of the EPC.⁴¹ An important requirement is that an amendment may not extend the protection conferred by the European patent.⁴² If it does, the European patent cannot be maintained on the basis of the amendment, and it may eventually be revoked.

The EPC also provides an exhaustive list of grounds for revocation of the national part of a European patent in national invalidity proceedings. These possible grounds for revocation correspond to the grounds for opposition mentioned above⁴³ and further include:

- that the protection conferred by the European patent has been extended (which must also be assessed by the EPO in case of amendments during opposition or opposition appeal proceedings); and
- that the proprietor is not entitled to the right to the European patent.⁴⁴

11.5 Patent infringement

As noted above in Section 11.3.3, infringement procedures regarding European patents fall under the competence of the national courts of the Contracting States to the EPC and the Unified Patent Court.

11.6 Judicial patent proceedings and case management

11.6.1 Key features in patent proceedings

The primary objective of proceedings before the Boards of Appeal is to review the decision under appeal in a judicial manner.⁴⁵ As mentioned above in Section 11.3.2.1, the Boards of Appeal

38 EPC, art. 64(3).

39 See Agreement on a Unified Patent Court, art. 32.

40 EPC, art. 100.

41 EPC, art. 101(3)(a).

42 EPC, art. 123(3).

43 EPC, art. 138(1)(a)–(c).

44 EPC, art. 138(1)(d) and (e).

45 RPBA 2020, art. 12(2).

constitute the first and final judicial instance in the procedures before the EPO. In this capacity, they review appealed decisions on points of law and fact.

Parties may amend their cases during appeal proceedings, which also includes the possibility for the applicant or patent proprietor to amend their patent application or patent. However, as appeal proceedings progress, the possibilities for parties to amend their cases become increasingly limited. This has been coined the “convergent approach” and is described in Section 11.6.4 below.

11.6.2 Venue, jurisdiction and case assignment rules

11.6.2.1 Venue and jurisdiction

The Boards of Appeal are located in Haar, near Munich, Germany. Their oral proceedings take place either at the Haar premises or at the EPO’s headquarters in Munich and may also be conducted by videoconference (see Section 11.6.8.4).

The Boards of Appeal have jurisdiction over the decisions taken by the Receiving Section, the Examining Divisions, the Opposition Divisions and the Legal Division of the EPO.⁴⁶ The Boards of Appeal deal only with patent validity, not with questions of patent infringement (see Section 11.3.3).

11.6.2.2 Case assignment

Technical cases are assigned to each Technical Board according to the business distribution scheme before the beginning of each working year.⁴⁷ Responsible for this allocation is the Presidium of the Boards of Appeal, extended to include all chairs of the Boards.⁴⁸ For technical cases, appeals are allocated to each Board based on the main International Patent Classification attributed to the application or patent at the time of the filing of the appeal.

Technical Boards may also share an International Patent Classification class. For Boards that share a class, cases are divided by year of appeal filing (e.g., appeals concerning a specific class filed in 2019 are allocated to one Board, and appeals of the same class but filed in 2020 are allocated to another Board).⁴⁹ If it is more appropriate to allocate a case to a different Board because of its technical content, the chairs of the two Boards may agree to change the allocation of the case.⁵⁰

A Technical Board usually consists of four to eight technically qualified members and two to four legally qualified board members. Technically qualified members are allocated to a single Technical Board; legally qualified board members are usually allocated to three different Technical Boards.⁵¹

The actual composition of a particular appeal is determined by the chair of the Board according to the criteria set out in the business distribution scheme. In particular, chairs take into account the technical and language requirements of the case and the workload of each member of their Board.⁵²

11.6.2.3 Party representation

As a rule, parties to proceedings before the Boards of Appeal (or to any proceedings before the EPO) are not obliged to be represented by a professional representative.⁵³ However, if parties do not have their residence or principal place of business in a Contracting State, they must be represented by professional representatives and act through them.⁵⁴ If, in such a case, a representative is not appointed, the procedural steps taken by the non-represented party are deemed not to have been taken.⁵⁵

46 EPC, art. 21(1).

47 The Legal Board of Appeal has a business distribution scheme, which is also adopted by the Presidium. The Enlarged Board of Appeal adopts its own business distribution scheme. Business distribution schemes can also be amended during the working year. See EPC, r. 12b(4) fourth sentence; RPBA 2020, art. 1(1) second sentence.

48 EPC, r. 12b(4) first sentence.

49 Presidium of the Boards of Appeal, *Business Distribution Scheme of the Technical Boards of Appeal for 2022* (Jan. 1, 2022) [hereinafter Business Distribution Scheme], see for example the allocation of appeals between Board 3.2.02 and Board 3.2.08 in art. 1(1).

50 Business Distribution Scheme, art. 1(2).

51 Business Distribution Scheme, art. 2.

52 Business Distribution Scheme, art. 3(2).

53 EPC, art. 133(1).

54 EPC, art. 133(2).

55 EPC, r. 152(6).

The EPO maintains a list of professional representatives who may represent parties in proceedings before the EPO. A professional representative must be a national of a Contracting State, have their place of business or employment in a Contracting State, and have passed the European Qualifying Examination.⁵⁶ The European Qualifying Examination is organized by the EPO and tests candidates' knowledge and aptitude to represent applicants in EPO proceedings.

Legal practitioners qualified in a Contracting State can also represent parties in EPO proceedings to the extent that they are entitled in that Contracting State to act as a professional representative in patent matters.⁵⁷

11.6.3 Statements of case

11.6.3.1 Appellant's statement setting out the grounds of appeal, and the respondent's reply thereto

An appellant who seeks to impugn the decision of the EPO's departments of first instance must file a notice of appeal within two months of the notification of the decision and, additionally, a statement setting out the grounds of appeal within four months of the notification of the decision.⁵⁸

The notice of appeal must contain the name and the address of the appellant, an indication of the decision impugned and a request defining the subject of the appeal, such as that the patent be revoked or that it be maintained in amended form.⁵⁹

The statement of grounds of appeal must contain the reasons for setting aside the decision being impugned – or state the extent to which it is to be amended (e.g., in which version the patent should be maintained, in particular with which set of claims) – and the facts and evidence on which the appeal is based.⁶⁰

The respondent (i.e., the non-appealing party in opposition-appeals proceedings) may file a reply to the appellant's grounds of appeal. The reply must be filed four months after the grounds of appeal are notified to the respondent.⁶¹

11.6.3.2 Parties' complete appeal cases

An appellant's statement of grounds of appeal and the respondent's reply thereto must contain each party's *complete* appeal case.⁶² This ensures a "front-loading" of the appeal proceedings so that the members of the Board, particularly the rapporteur responsible for the case, have all facts and requests on the table when they start examining the cases.

Since the first exchange of briefs must already contain a party's complete appeal case, the possibility of amending the appeal case later in the appeals proceedings is limited. During the later stages of the proceedings, opponents might attempt to attack the patent by submitting new facts or new evidence, and the patent proprietor might seek to defend the patent in an amended form by filing new auxiliary requests (i.e., new sets of claims). However, such amendments made by the parties to their respective initial pleadings may be admitted only at the discretion of the Board (see the following section).⁶³

11.6.4 Parties' amendments to their cases on appeal – the Boards of Appeal's convergent approach

The function of the Boards of Appeal is to review the appealed decision, not to merely continue the examination or opposition proceedings by reexamining the application or the revocation grounds against the patent. One of the consequences of this primary objective is that, as appeal proceedings progress, the possibilities for parties to amend their cases become increasingly

56 EPC, art. 134(1)–(2).

57 EPC, art. 134(8).

58 EPC, art. 108 first and third sentences.

59 EPC, r. 99(1).

60 EPC, r. 99(2).

61 RPBA 2020, art. 12(1)(c). The period for reply may exceptionally be extended at the Board's discretion by a maximum of two additional months for a total maximum of six months. RPBA 2020, art. 12(7).

62 RPBA 2020, art. 12(3).

63 RPBA 2020, art. 13(1).

limited. This has been coined the “convergent approach,” which consists of three levels, as regulated in the Rules of Procedure of the Boards of Appeal [hereinafter RPBA 2020].⁶⁴

Which of these provisions applies depends on the point in time at which a party changes its case:

- Article 12(4) applies when a party changes its case at the outset of the appeal proceedings (i.e., in its statement of case) with respect to what the party had filed before the Examining or Opposition Division, or with respect to what was decided by the division.
- Article 13(1) applies when a party changes its appeal case after the initial stage of the appeal proceedings but before a summons to oral proceedings has been notified.⁶⁵
- Article 13(2) applies when a party changes its appeal case after the summons to oral proceedings has been notified.⁶⁶

These three levels of convergence are explained in detail in the following sections.

11.6.4.1 First level of the convergent approach

In a party’s statement of grounds or their reply, the case must be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based.⁶⁷ This is in accordance with the primary objective of the appeal proceedings to review the decision under appeal.

If parts of a party’s appeal case are not directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based, they are regarded as an “amendment.”⁶⁸ Two situations must be distinguished. In the first situation, the party presents, in its appeal, a case that is amended in comparison to what it had presented before the department of first instance. For example, a patent proprietor files a new claim request (i.e., a new set of claims) in its appeal, or the opponent submits a new prior art document, which had previously not been brought before the Opposition Division. In such a case, the filing of the new request or document is an amendment of the party’s case and may be admitted only at the discretion of the Board.⁶⁹ The criteria that the Board may use in the exercise of its discretion are, *inter alia*, the complexity of the amendment, the suitability of the amendment to address the issues that led to the decision under appeal, and the need for procedural economy.⁷⁰

In the second situation, the appellant’s case on appeal is not changed in comparison to the case it had presented during the first instance proceedings. However, the department of first instance did not base its decision on what was submitted by the party in the first instance proceedings. The submission on appeal is still regarded as an amendment under Article 12(4) of RPBA 2020. If, for example, the Opposition Division found the patent proprietor’s main claim request to fulfill the patentability criteria of the EPC, it had no reason to address the patent proprietor’s auxiliary requests in its decision. It is also possible that the Opposition Division found the disclosure of one prior art document to be novelty-destroying so that it had no reason to consider a second prior art document on which the opponent relied before the Opposition Division and still relies in its appeal. In such cases, the patent proprietor must demonstrate that the auxiliary requests – and the opponent must demonstrate that the second prior art document – were admissibly raised before the Opposition Division and maintained until the Opposition Division took its decision.⁷¹ If the party concerned complies with this obligation, the auxiliary requests and second prior art document will be part of the appeal proceedings and cannot be excluded by the Board.

In addition to these two situations, which are governed by Article 12(4) of RPBA 2020, Article 12(5) and (6) of the Rules regulate other typical situations in which a party submission may not be

64 RPBA 2020, arts 12(4), 13(1)–(2). See the explanatory remarks to the RPBA 2020 as contained in *Rules of Procedure of the Boards of Appeal*, EPO Doc. CA/3/19, 2020 OJ EPO Supp. 2 (Jan. 31, 2020) [Hereinafter Rules of Procedure of the Boards of Appeal]; see, in particular, the explanatory remarks to Articles 12(4), 13(1) and 13(2).

65 Or a period set in a communication under Rule 100(2) of the EPC has expired. However, these communications are sent sparingly by the Boards.

66 Or a period set in a communication under Rule 100(2) of the EPC has expired.

67 RPBA 2020, art. 12(2).

68 RPBA 2020, art. 12(4) first sentence.

69 RPBA 2020, art. 12(4) second sentence.

70 RPBA 2020, art. 12(4) fifth sentence.

71 RPBA 2020, art. 12(4) first sentence.

admitted into the appeal proceedings. For example, it is required that the statement of grounds of appeal and the reply thereto clearly and concisely set out the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and it should specify expressly all the requests, facts, objections, arguments and evidence relied upon.⁷² Any part of the submission not meeting this requirement may not be admitted.⁷³ Moreover, the Board might not admit a request or document if the same request or document was already not admitted by the Opposition Division⁷⁴ or if a request or document should already have been submitted during the opposition proceedings (or, if they were submitted, no longer maintained).⁷⁵ Articles 12(5) and (6) of RPBA 2020 are applicable throughout the entire appeal proceedings – that is, they are also applicable at the later levels of the convergent approach.⁷⁶

11.6.4.2 Second level of the convergent approach

After the initial exchange of briefs (i.e., the appellant's statement of grounds of appeal and the respondent's reply thereto), the second level of the convergent approach commences. If parties amend their appeal case at this stage, they must provide reasons as to why their initial case has been amended and why this has been done only at this stage of the appeal proceedings. All amendments of a party's appeal case at this stage are subject to the Board's discretion alone.⁷⁷

The RPBA 2020 contains a list of possible criteria for applying that discretion. In general, the criteria for this stage are stricter than those at the first level of the convergent approach. The Board may consider, for example, whether the amendment is suitable for resolving the issues raised (at the first level of the convergent approach, it may be sufficient that the amendment "addresses" them) or whether the amendment is detrimental to procedural economy.⁷⁸

The RPBA 2020 also mentions specific requirements for when the patent or patent application is amended on appeal. In these situations, the applicant or patent proprietor must demonstrate why the amendment, *prima facie*, overcomes the objections raised so far and does not give rise to new objections (such as a new objection of lack of clarity or added subject matter).⁷⁹

11.6.4.3 Third level of the convergent approach

The third level of the convergent approach imposes the most stringent limitations on a party wishing to amend its appeal case. This level commences at an advanced stage of the proceedings, usually after a summons to oral proceedings has been notified.⁸⁰

At this late stage of the appeal proceedings, amendments to a party's appeal case are not to be taken into consideration. However, a limited exception is provided if there are "exceptional circumstances."⁸¹ For this exception to apply, a party must present compelling reasons ("cogent reasons") why the circumstances of the particular appeal exceptionally justify that the amendment be taken into account at this late stage of the proceedings. This may be the case, for example, if a party submits that the Board raised an objection for the first time in its communication that was sent in preparation for the oral proceedings (on this communication, see Section 11.6.8.2 below). The party must explain precisely why this objection is new and does not fall under objections previously raised by the Board or a party. The Board may then decide that there are exceptional circumstances and admit the amendment in the exercise of its discretion.

72 RPBA 2020, art. 12(3).

73 RPBA 2020, art. 12(5).

74 RPBA 2020, art. 12(6) first sentence.

75 RPBA 2020, art. 12(6) second sentence.

76 See RPBA 2020, art. 13(1) second sentence. See also the explanatory remarks to Article 12(4) of the RPBA 2020 as contained in *Rules of Procedure of the Boards of Appeal*.

77 RPBA 2020, art. 13(1).

78 RPBA 2020, art. 13(1) fourth sentence.

79 RPBA 2020, art. 13(1) fourth sentence.

80 RPBA 2020, art. 13(2). The third level also applies if the amendment to a party's appeal case is made after the expiry of a period specified by the Board in a communication under Rule 100(2) of the EPC; but, in practice, such a communication is rarely issued.

81 RPBA 2020, art. 13(2).

11.6.5 Early case management

11.6.5.1 Designation of rapporteur for the preliminary study of appeal

For the early management of a case, the chair of the Board may first designate only the rapporteur before determining the remaining composition of the Board.⁸² The rapporteur then carries out a preliminary study of the appeal.⁸³ The rapporteur also assesses whether the appeal should be given priority over other appeals – for example, if a remittal to the Examining or Opposition Division seems likely (e.g., because of a fundamental deficiency in the proceedings) or if the appeal appears to be inadmissible. The rapporteur can also suggest that the appeal be treated together with other appeals – for example, because they are clearly connected to each other (e.g., parent and divisional applications or applications based on the same priority application).⁸⁴

Only when the composition of the Board is complete may the rapporteur draft communications on behalf of the Board to the parties, make preparations for the oral proceedings and draft decisions.⁸⁵

11.6.5.2 Acceleration of the appeal proceedings

In general, cases are treated based on a first in, first out principle. However, a Board may accelerate the proceedings of its own motion.⁸⁶ This allows the Boards to give an appeal priority over other pending appeals. A case may, for example, be accelerated because the rapporteur has identified a fundamental deficiency in the proceedings at first instance, which renders the case highly likely to be remitted.

Parties may also request the acceleration of appeal proceedings.⁸⁷ The requesting party needs to provide reasons and, where appropriate, documentary evidence. Valid reasons for acceleration are, for example, that national infringement proceedings have been brought or are envisaged or that the decision of potential licensees of the patent-in-suit hinges on the outcome of the appeal.

Acceleration can be requested not only by parties but also by a national court. A court does not need to provide specific reasons for requesting acceleration. As a rule, Boards will grant a request for acceleration from a court. The Board will subsequently also promptly inform the court of when oral proceedings are likely to take place.⁸⁸

When the Board decides to accelerate proceedings, the case is given priority over other cases, and the Board may adopt a strict framework for the purpose of case management,⁸⁹ subject to the parties' right to be heard and the principle of fair proceedings. If the parties agree, the minimum notice of two months for summons to oral proceedings can be shortened as well.⁹⁰

11.6.5.3 Early exchange with the parties

No pre-hearings or case management hearings are organized before the Boards of Appeal. In the written phase of proceedings, the directions on matters of procedure are given by means of written communications.⁹¹ In practice, such early directions are rarely given.

The Board may also invite the parties, through a communication, to file observations on specific issues or in reaction to a preliminary view of the Board on patentability issues.⁹² Such a communication may be useful where parties have not requested oral proceedings. If such an invitation is accompanied by a time limit for reply, the applicant in *ex parte* proceedings must pay

82 RPBA 2020, art. 5(1).

83 RPBA 2020, art. 5(3).

84 See RPBA 2020, art. 10(2).

85 RPBA 2020, art. 5(1) fourth sentence, in conjunction with art. 5(4), (5).

86 RPBA 2020, art. 10(5).

87 RPBA 2020, art. 10(3).

88 RPBA 2020, art. 10(4).

89 RPBA 2020, art. 10(6).

90 EPC, r. 115(1) second sentence. The notice period for the summons can be shortened independently of an acceleration request.

91 RPBA 2020, art. 17(1).

92 EPC, art. 100(2).

special attention to the communication: if the applicant does not reply to the invitation within the period specified by the Board, the European patent application is deemed to be withdrawn.⁹³

In most cases, the first communication on substantive issues is issued to the parties once the date for the oral proceedings is set (see Section 11.6.8.2 below).

11.6.5.4 Annual list of cases

Before the start of a new calendar year, a list of cases is published, indicating for each Board all the cases that will likely be treated in the coming year, particularly cases where it is likely that oral proceedings will be held or a communication will be issued.⁹⁴ This advance planning of the expected workload for the coming year is done by the chair of each Board in October of the preceding year. It is intended to increase efficiency for the Boards and the parties and to make the work of the Boards more transparent and predictable. The annual list of cases is published on the Boards of Appeal website.⁹⁵

11.6.6 Evidence – experts

The EPC provides a nonexhaustive list of how evidence can be obtained and given, such as the production of documents, the hearing of witnesses, opinions by expert, inspection or sworn statements in writing.⁹⁶

Documents constitute the vast majority of evidence considered in proceedings before the Boards of Appeal. Sworn statements are, in practice, rare; instead, unsworn statements or affidavits are produced by the parties. Regarding the taking of evidence by way of an expert opinion, the Technical Boards of Appeal are composed of technical judges, who are well versed in the technical field of the case, so obtaining an expert opinion will almost never be necessary. The hearing of witnesses before the Boards of Appeal is very rare as well. Witnesses, who play a role in the proceedings particularly when an opponent alleged a public prior use, will normally have already been heard before the Opposition Division.

11.6.7 Confidentiality – public file inspection

Files relating to the proceedings before the Boards of Appeal may be inspected on request.⁹⁷ Parts of these files are excluded from public inspection, particularly the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal; all draft decisions and notices and other internal preparatory documents;⁹⁸ and medical certificates filed by the parties.⁹⁹

Parties can request that documents be excluded from file inspection, particularly if their inspection would be prejudicial to the legitimate personal or economic interests of natural or legal persons.¹⁰⁰ Documents may also be excluded by the Board of its own motion for the same reasons, particularly to protect the interests of third parties (i.e., natural or legal persons not parties to the proceedings, or their representatives).¹⁰¹

The public part of the file can be accessed online via the European Patent Register.¹⁰²

93 EPC, art. 100(3). This consequence does not arise for the patent proprietor in opposition appeals proceedings.

94 RPBA 2020, art. 1(2).

95 Accessible from www.epo.org/law-practice/case-law-appeals/about-the-boards-of-appeal/annual-list-of-cases.html

96 EPC, art. 117.

97 EPC, art. 128(4).

98 EPC, r. 144.

99 See EPC, art. 144(d) together with the Decision of the President of the European Patent Office Dated 12 July 2007 concerning Documents Excluded from File Inspection, 2007 OJ EPO Spec. Ed. 3, ch. J.3.

100 See Decision of the President of the European Patent Office Dated 12 July 2007 concerning Documents Excluded from File Inspection, 2007 OJ EPO Spec. Ed. 3, ch. J.3, art. 1(2)(a).

101 Cf. Decision of the President of the European Patent Office Dated 12 July 2007 concerning Documents Excluded from File Inspection, 2007 OJ EPO Spec. Ed. 3, ch. J.3, art. 1(2)(b).

102 Accessible from www.epo.org/searching-for-patents/legal/register.html

11.6.8 Trial and hearing

11.6.8.1 Right to oral proceedings

Parties to proceedings before the Boards of Appeal have a right to oral proceedings.¹⁰³ If one party requests oral proceedings, a hearing must take place. If none of the parties requests oral proceedings (which is rather a rare occurrence), the Board may either summon the parties to oral proceedings on its own motion or decide the case in written proceedings.

Parties are usually summoned at least four months before the hearing is to take place.¹⁰⁴ They are summoned to the Boards of Appeal premises in Haar or to the EPO's headquarters in Munich. Oral proceedings may also be held by videoconference (see Section 11.6.8.4 below).¹⁰⁵

As a rule, oral proceedings before the Boards of Appeal are public.¹⁰⁶ In exceptional cases, a Board may decide to exclude the admission of the public where such admission could have serious and unjustified disadvantages (e.g., for a party to the proceedings).¹⁰⁷ It may also be the case, especially in proceedings before the Legal Board, that the European patent application has not yet been published; in this event, oral proceedings will not be public.¹⁰⁸

Parties may request a change of date of the oral proceedings.¹⁰⁹ However, parties must show serious reasons for such a request to be granted. Typical reasons that may justify a change of the date are the serious illness of the representatives or their firmly booked holiday or business trip, or if they had already been summoned to oral proceedings in other proceedings before the EPO or a national court.¹¹⁰ It is unlikely that reasons such as excessive work pressure or the appointment of a new professional representative will be accepted.¹¹¹

11.6.8.2 Communication issued by the Board of Appeal in preparation for oral proceedings

The Boards always issue a communication in preparation for oral proceedings.¹¹² This communication is based on a thorough analysis of the case and draws attention to matters that seem to be of particular significance for the decision to be taken. The communication should help the parties to concentrate on the essentials of the case in their preparation of oral proceedings and ensures that the oral proceedings are conducted efficiently. The Boards usually also give a preliminary opinion on the decisive points in their communications.¹¹³

These communications are normally issued at least four months in advance of the date of the oral proceedings.¹¹⁴ They may be issued together with the summons or later.

11.6.8.3 Conduct of oral proceedings and languages used

Oral proceedings are presided by the chair in the particular appeal. The chair ensures their fair, orderly and efficient conduct.¹¹⁵ If a party duly summoned to oral proceedings does not appear as summoned, the proceedings may continue without that party,¹¹⁶ and this party may then be treated as relying only on its written case.¹¹⁷

Each case before the EPO has a language of proceedings, which must be one of the official EPO languages (i.e., English, German or French). The language of proceedings is determined by the language in which the European patent application was filed.¹¹⁸ At the oral proceedings, however, parties may use any official language of the EPO.¹¹⁹ If a party chooses to deviate from the language of proceedings at the oral proceedings, they must give notice at least one month before

103 EPC, art. 116(1).

104 RPBA 2020, art. 15(1).

105 RPBA 2020, art. 15a.

106 EPC, art. 116(4).

107 EPC, art. 116(4).

108 See EPC, art. 116(4).

109 RPBA 2020, art. 15(2).

110 See the list in RPBA 2020, art. 15(2)(b).

111 See the list in RPBA 2020, art. 15(2)(c).

112 RPBA 2020, art. 15(1).

113 RPBA 2020, art. 15(1) fifth sentence.

114 RPBA 2020, art. 15(1) sixth sentence.

115 RPBA 2020, art. 15(4).

116 EPC, r. 115(2).

117 RPBA 2020, art. 15(3).

118 EPC, art. 14(3).

119 EPC, r. 4(1).

the oral proceedings so that the EPO can organize and then pay for interpretation.¹²⁰ Parties can, of course, also provide for interpretation into the language of the proceedings at their own expense; at oral proceedings, they can also then use any official language of a Contracting State.¹²¹ In practice, oral proceedings before the Boards of Appeal with interpretation from and into one language – or even two or more languages – are quite frequent.

11.6.8.4 Oral proceedings by videoconference

The Boards of Appeal may hold oral proceedings by videoconference.¹²² Different setups are possible – for example:

- In “distributed oral proceedings,” all members, representatives and accompanying persons attend by videoconference.
- In “mixed-mode oral proceedings,” some parties, representatives and accompanying persons are physically present in the oral proceedings room with the board members, while others attend by videoconference.¹²³ Exceptionally, one or more of the board members may also attend by videoconference.¹²⁴

11.6.9 Decisions of the Board of Appeal

11.6.9.1 Decisions announced in oral proceedings

In the great majority of cases, the final decision of the Board is announced at the end of the oral proceedings.¹²⁵ After the chair closes the debate, they announce the order of the decision – for example, that the appeal is dismissed, that the patent is revoked, that the patent is maintained in a version different from the one granted or that the case is remitted for further prosecution. Once the decision is announced by the chair, it can no longer be changed by the Board.

11.6.9.2 Written decision within three months

The written decision, which includes the summary of the facts, the reasons and the order,¹²⁶ is issued in a timely manner.¹²⁷ For the usual case, where the decision is announced at the oral proceedings, this means that the Board must despatch it within three months of the date of the oral proceedings.¹²⁸

However, it may be that the Board is unable to meet this deadline: for example, because of the sickness of a member or because the case is particularly complex. In such cases, the Board should then inform the parties of the delay and when the decision is likely to be despatched.¹²⁹

The written decision is (electronically) signed by both the chair and the registrar of the Board.¹³⁰ It is notified to all parties.¹³¹

11.6.9.3 Reasons given for decision in abridged form

A Board may put the reasons for a decision, the order of which was announced in the oral proceedings, in an abridged form. However, this is possible only under the condition that the parties have given their consent.¹³² A Board cannot give the reasons in an abridged form if a third party or a court has informed the Board that it has a legitimate interest in the reasons for the decision not being in abridged form.¹³³

A Board may also decide to put the reasons for the decision in an abridged form if it agrees with all the findings and reasoning of the decision under appeal or with only the findings on one or

120 EPC, r. 4(5).

121 EPC, r. 4(1) second sentence.

122 RPBA 2020, art. 15a.

123 RPBA 2020, art. 15a(2).

124 See RPBA 2020, art. 15a(3).

125 RPBA 2020, art. 15(6).

126 EPC, r. 102, second sentence.

127 RPBA 2020, art. 15(9).

128 RPBA 2020, art. 15(9)(a).

129 RPBA 2020, art. 15(9)(a) second sentence.

130 EPC, r. 102 first sentence. For the role of the registrars, see RPBA 2020, art. 6.

131 EPC, r. 125. Decisions are notified by registered letter (EPC, r. 126) or by means of electronic communication (EPC, r. 127).

132 RPBA 2020, art. 15(7) first sentence.

133 RPBA 2020, art. 15(7) second sentence.

more specific issues.¹³⁴ In practice, however, written decisions rarely contain the reasons in an abridged form.

11.6.10 Costs

In *inter partes* proceedings before the Boards of Appeal (and in proceedings before the Opposition divisions), the rule is that each party (i.e., the patent proprietor and the opponent) must bear the costs it incurs.¹³⁵ An exception to this principle is if the Board, for reasons of equity, decides on a different apportionment of costs.¹³⁶

Before the Boards of Appeal, the party seeking a different apportionment of costs must file a request.¹³⁷ Eligible costs include those incurred because a party amended its appeal case at a late stage of the proceedings, because a party's behavior interfered with the timely and efficient conduct of oral proceedings, or because there has been an abuse of procedure.¹³⁸

The Board may decide on the apportionment of the costs by indicating a percentage of the costs to be borne or by expressing a specific sum.¹³⁹ If the total is not already fixed by the Board in the order of the decision as a specific sum, it is subsequently determined in a separate procedure for fixing the costs.¹⁴⁰ Eligible costs include, for example, those charged to a party by its professional representative and those of witnesses or experts paid by a party. However, such costs must always be necessarily and reasonably incurred.¹⁴¹

The final cost orders of the Boards of Appeal (or the EPO) are directly enforceable in the Contracting States. They are equivalent to final decisions given by a civil court of the state in which enforcement is to take place.¹⁴²

134 RPBA 2020, art. 15(8).

135 EPC, art. 104(1).

136 EPC, art. 104(1).

137 RPBA 2020, art. 16(1).

138 See the nonexhaustive list in RPBA 2020, art. 16(1).

139 RPBA 2020, art. 16(2) first sentence.

140 See EPC, art. 104(2).

141 EPC, art. 16(2) third sentence.

142 EPC, art. 104(3). This also holds true in the event that the Board decides, directly in its decision on the appeal, to express the costs to be paid as a specific sum. See RPBA 2020, art. 16(2) second sentence.