

EIP

Amendments to Rules of Procedure of the Boards of Appeal: attempt to enhance timeliness for cases involving parallel litigation

Summary

On the 1 January 2024, amendments made to the Rules of Procedure of the Boards of Appeal came into force [1]. A change to Article 15(1) means that a Board can now summon parties to oral proceedings earlier than before. Article 13(2) has also been amended such that the strictest criteria governing admissibility before the EPO Board of Appeal now apply at a slightly later stage. Overall, the aim of these amendments is to enhance the timeliness of the appeal procedure, particularly in cases where proceedings are accelerated in view of parallel national or UPC litigation [2], while also safeguarding the rights of parties.

Boards can initiate oral proceedings sooner

The amendment to Article 15(1) relates to the scheduling of oral proceedings for inter partes appeal proceedings. Appeal proceedings are initiated by an appellant submitting a Notice of Appeal followed by a Statement of Grounds of Appeal, to which the respondent(s) then have four months to file a response. Previously, the Board of Appeal aimed to issue a notice of summons to oral proceedings no earlier than two months after receiving such a response. The amendment to Article 15(1) now stipulates that the Board will issue the communication no earlier than one month. Hence, the Boards can now initiate oral proceedings one month sooner.

The strictest level of the convergent approach to admissibility is now triggered later

The amendment to Article 13(2), relating to admissibility of submissions filed later in the appeal proceedings, has been discussed previously by EIP in the context of how the Boards of Appeal's new "convergent approach" to admissibility has been working over the last four years. This amendment also intersects with that made to Article 15(1). Previously, the strictest rules governing admissibility, described in Article 13(2), were initiated when the Board's summons to oral proceedings was notified. Given that the amendment made to Article 15(1) allows the Board to issue such summons one month earlier, the strictest admissibility criteria would also have been triggered one month earlier when this occurred. However, Article 13(2) has been amended such that it is now triggered from notification of the Board's communication under Article 15(1), outlining the matters of particular significance to be discussed at oral proceedings and providing their provisional opinion. As such, appellants have been given some relief from the most stringent of the rules on admissibility.

Impact on future cases

The amendments allow Boards of Appeal to summon parties earlier on in appeal proceedings which is intended to help achieve early legal certainty for parties, particularly in cases involving parallel litigation. In times of a severe backlog of cases, the Board's provisional opinion can often be issued several months after summons. In such cases, parties will now have a significant amount of time to review respondent's replies to the Statement of Grounds of Appeals and file submissions before the triggering of the strictest admissibility criteria under Article 13(2). However, if there are cases where the Board decides to issue its provisional opinion concurrently with the summons, parties may have just a single month to review and file any further submissions or amendments to ensure their submission is not judged by the strictest rules. This latter scenario may put a significant procedural burden on EPO practitioners, particularly in complex cases involving multiple parties or lengthy replies. However, appellants should take note that admissibility of later submissions under Article 13(1) still requires substantial

justification, and research by EIP suggests that Boards reject around two-thirds of submissions at this stage. Thus, parties will benefit from submitting their claim requests and submissions in the earliest stages of appeal proceedings when possible.

[1] Amended Articles 13(2), 15(1) and 15(9)(b) of the Rules of Procedure of the Boards of Appeal (RPBA) enter into force on 1 January 2024 | Epo.org

[2] Notice from the European Patent Office dated 7 November 2023 concerning accelerated processing of oppositions where an infringement or revocation action has been instituted before the Unified Patent Court or a national court or competent authority of a contracting state (OJ Nov 2023)