

Oppositions, appeals and access to justice at the EPO post-lockdown

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Innovation | Branding | Strategy | Solutions



Speakers



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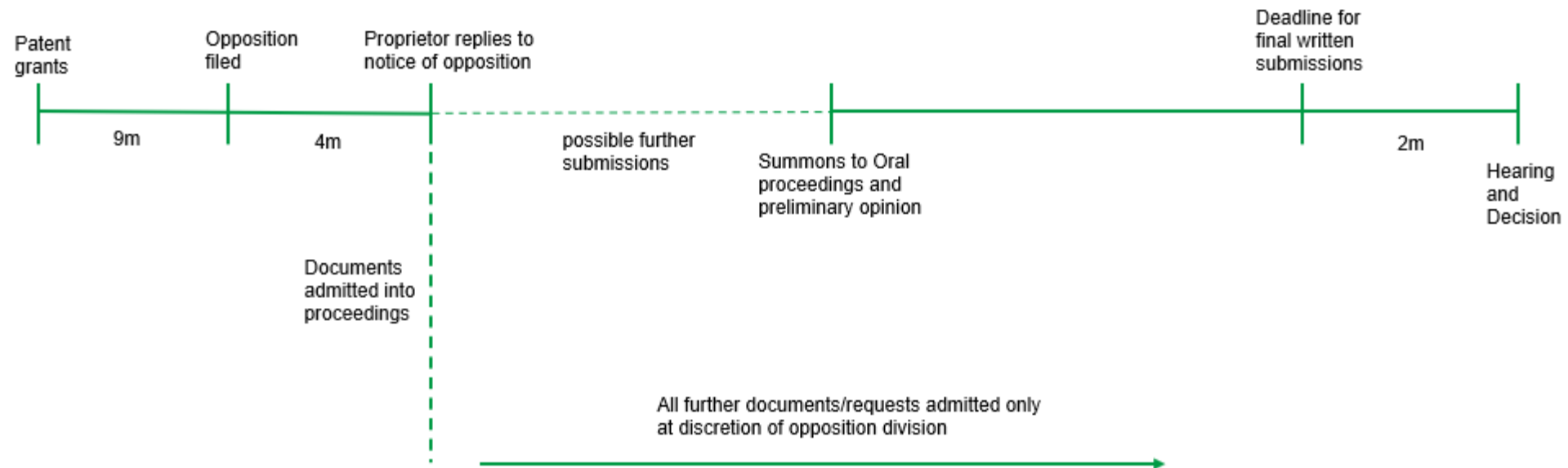
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EPO opposition and appeal procedure

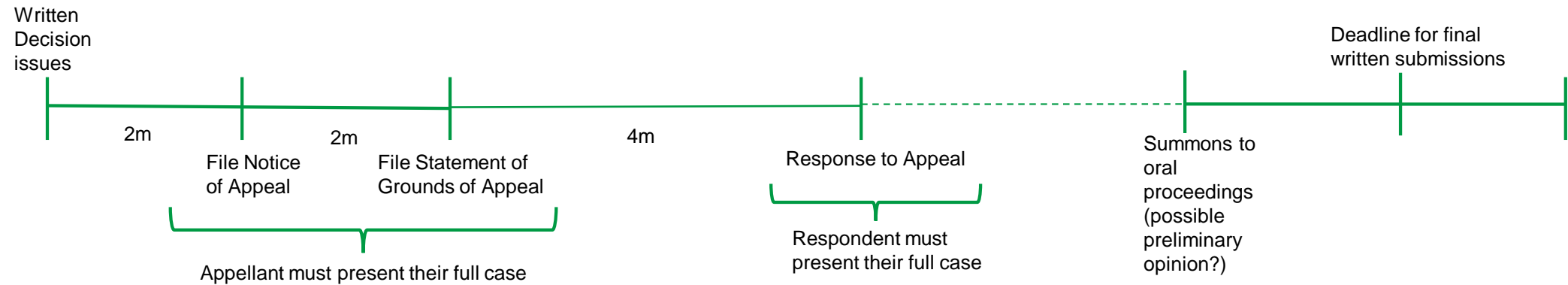
First Instance – Opposition Division:





EPO opposition and appeal procedure

Second Instance – Appeal of Decision from Opposition Division:





EPO opposition and appeal - timescales

- Opposition (first instance) previously took from 2 to 4 years
- Appeal (second instance) used to take a similar length of time
- This was seen as undesirable – possible 8 years + to reach a final decision
- We have been involved in extreme cases where a final decision was made 18+ years after the patent application was filed



Streamlined opposition proceedings

- Came into force 1 July 2016
- Aim to cut duration of straightforward oppositions to 15 months (from an average of 26 months in 2015)
- Extensions only granted in exceptional cases with duly substantiated requests
- Opposition division may disregard facts or evidence not submitted in time unless *prima facie* relevant, i.e. they would affect the outcome of the decision



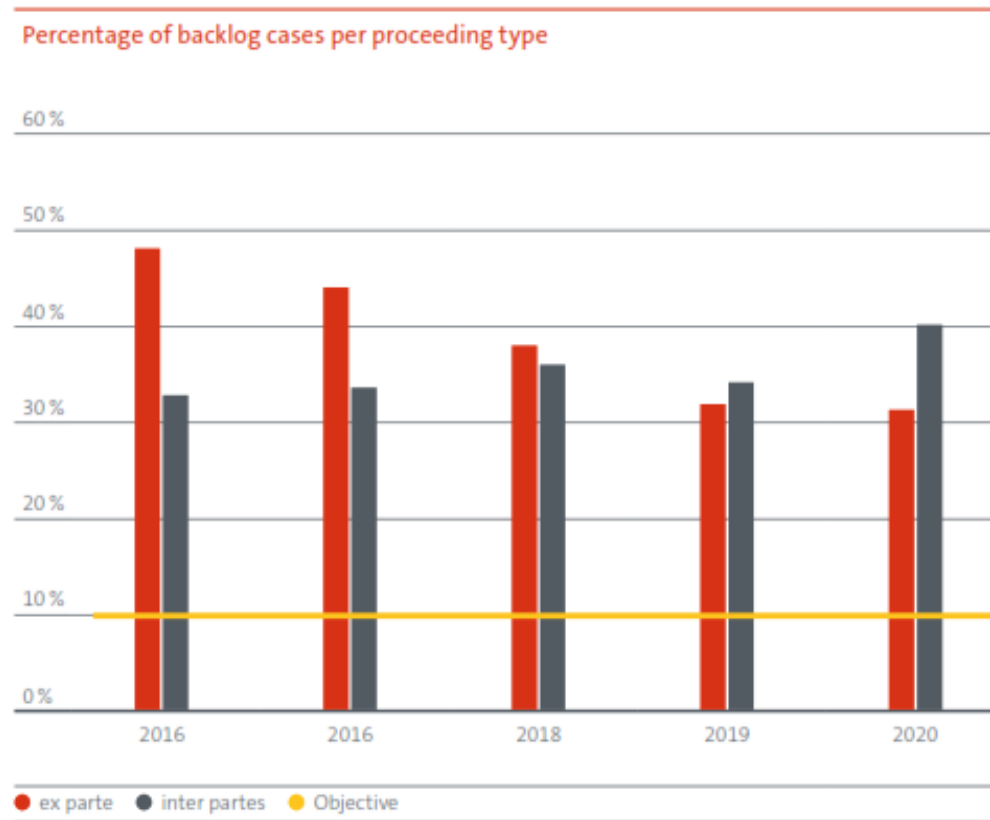
Streamlined opposition proceedings

- By 2018 average pendency 17 months
- Pre-streamlining - 68% of patentees used 2 month extension for initial response
- Post-streamlining - only 15% of patentees request an extension
- Extensions granted have decreased from 95.8% to 33.7%
- Summons to oral proceedings typically issued within 3 months of response
- But the increased efficiency of the oppositions means that appeals are filed sooner...



Board of Appeal – efficiency

Aim to settle 90% of cases within 30 months





New rules of procedure of Boards of Appeal

- Came into force January 2020
- Apply to all pending cases
- Aims of new rules to increase:
 - i. efficiency, by reducing number of issues to be treated;
 - ii. predictability for the parties; and
 - iii. harmonisation
- Possibility for parties to amend their case increasingly limited



Key provisions

- A12 (2):** In view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based
- A12 (3):** The statement of grounds of appeal and the reply shall contain a party's complete appeal case
- A12 (4):** Any part of a party's appeal case which does not meet the requirements in paragraph 2 is to be regarded as an amendment, ... Any such amendment may be admitted only at the discretion of the Board
- A13 (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 shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned



Case law – interpretation of the rules

Some cases under the new rules lead to horror stories of Draconian implementation:

- **T 1185/17** – filing new requests after receipt of the preliminary opinion:
“The appellant's further argument that the number of opponents and the numerous objections did not allow each and every objection to be dealt with, is also not accepted. The number of opponents is only three and the objections under Article 123(2) EPC do not appear particularly numerous.”
- **T 2486/16** – new requests “*prima facie* allowable”? Not enough:
“The Board does not feel it necessary to decide on the issue of prima facie allowability, since, even if this were accepted, the appellant did not provide cogent reasons why, in the present case, such prima facie allowability alone was sufficient to meet the requirement of Article 13(2) RPBA 2020 that there were "exceptional circumstances".”



Case law – interpretation of the rules

- **T 0954/16** – objections should have been addressed at first instance:
“The patent proprietor therefore could and should have formulated auxiliary request 5 in reply to the opponent's objections in a timely manner, before the Board had given its preliminary opinion. Against this background, the procedural economy aspect argued by the patent proprietor becomes irrelevant.”
- **T 908/19** – no new arguments regarding documents already in proceedings:
“These new lines of attack constitute an amendment to the appellant's case in the sense of Article 13 RPBA 2020 read in conjunction with Article 12(4) RPBA 2020. Pursuant to Article 13(2) RPBA 2020, any amendment to a party's case made after notification of a summons to oral proceedings, in principle shall not be taken into account unless there are exceptional circumstances which need to be reasoned by the party concerned.”



Case law – interpretation of the rules

But it's not all doom and gloom...

- **T 0247/20** – Framework of Case? No exceptional circumstances required:
“Oral proceedings would serve no purpose if the parties were limited to present a mere repetition of the arguments put forward in writing. Instead, parties must be allowed to refine their arguments, even to build on them provided they stay within the framework of the arguments, and of course the evidence, submitted in a timely fashion in the written proceedings.”
- **T 0172/17** – Boards of Appeal can exercise discretion:
“RPBA 2020 [does not provide] an absolute prohibition of taking late-filed submissions into account.”



Case law – interpretation of the rules

T 1790/17– Amendment after summons:

“The purpose of the oral proceedings for the appellant is to better explain his case and for the Board to understand and clarify points which, perhaps, up to that point were not sufficiently clear. This is particularly relevant in ex parte cases where besides the applicant/appellant no other party is involved. If amendments resulting from such discussions were not possible, oral proceedings would be pointless. The new [substantially amended] auxiliary request was filed as a direct reaction following the exchange of arguments in the oral proceedings and addressing the objections and concerns the Board had. Furthermore, this request overcame the grounds on which the appealed decision was based. The Board considers the filing of such a request is justified by exceptional circumstances and therefore admits it into the proceedings.”



New rules of procedure of Boards of Appeal

Take Home Message:

- ❗ It seems very dependent on the Chair of the BoA:
 - Stricter Chairs have been given the legitimacy by the new rules to proceed with their strict interpretation
 - More lenient Chairs continue to use their discretion
- ❗ May allow efficiency to increase in the longer term, but has lead to uncertainty for the parties
- ❗ Address all issues early and with possible numerous amendments filed early
- ❗ Don't work to the deadlines...?



Impact of COVID-19 pandemic

- All in person hearings suspended – proceedings postponed
- Oral proceedings held by video conference for *ex parte* hearings since 1998
- Pre-COVID-19 all *inter partes* hearings held in person
- Pilot for opposition hearings – May 2021
- All opposition hearings by video conference – from January 2021



Oral proceedings by video conference



In 2019, 900 oral proceedings by video conference (examination only)



In 2020, 2326 oral proceedings by video conference in examination, 333 oral proceedings by video conference in opposition



May 2020 to February 2021: 380 appeal cases by video conference



Initially held only by consent of all parties



Impact of COVID-19 pandemic

- Frequently changing, but at present all opposition hearings will be held by video conference until at least 31 January 2022
- EPO President Campinos on the future of hearings by video conference:
 - “ *It takes time for people to accept ... changes in culture. As the technology improves and the acceptance of the parties starts to increase, I think that now is the right time to move to videoconferencing by default.* ”
- The President has jurisdiction over the Opposition Division and Examination Division. However, the Boards of Appeal are independent of the President
- The Boards of Appeal, in our experience, are less keen to move to video conference by default



G1/21

“Is the conduct of oral proceedings in the form of a videoconference compatible with the right to oral proceedings as enshrined in Article 116(1) EPC if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference?”

- ! Stems from T1807/15, where despite both parties objecting to the use of video conferencing (ViCo) for the appeal in question, the Board held the oral proceedings by ViCo
- ! The appellant requested that a question be referred to the Enlarged Board of Appeal (EBA) on this matter



G1/21

Following the oral proceedings on 2 July 2021, the EBA issued the order of its decision which states that:

*“During a **general emergency** impairing the parties’ possibilities to attend in-person oral proceedings at the EPO premises, the conduct of oral proceedings before the **boards of appeal** in the form of a videoconference is compatible with the EPC even if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference.”*

The reasons for the decision will be issued in writing in due course



G1/21

- Notably the order only refers to oral proceedings before the Boards of Appeal and does not address video conferencing in examination or opposition proceedings
- It also does not address the question whether oral proceedings by videoconference may be held without the consent of the parties in the absence of a period of general emergency
- Therefore video conferencing post-pandemic is still be decided



Advantages of remote hearings

- ! Enables virtual attendance for multiple people within an organisation without travel
- ! Can hear from expert witnesses without need for them to travel
- ! Useful to have access to office and staff during hearing
- ! Ease of discussions during breaks
- ! Simultaneous translation into a non-EPO language
- ! Anonymous attendee?



Disadvantages of remote hearings

- ! Can't see all parties at once
- ! Hard to determine if all members of Opposition Division/ Boards of Appeal looking at right documents
- ! No eye contact
- ! Can't judge "mood in the room"
- ! More difficult to confer with other opponents
- ! Anonymous attendee?

Questions?



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