



**FICPI-UK**

The British Association of the International  
Federation of Intellectual Property Attorneys

**THE BRITISH ASSOCIATION OF  
THE INTERNATIONAL FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS  
(FICPI-UK)**

**Comments on the draft proposed amendments to the Rules of Procedure of  
the Boards of Appeal**

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Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including European patent attorneys, national patent attorneys and patent agents in all EPC contracting and extension states.

**FICPI** aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI**, including **FICPI-UK**, strives to offer well balanced opinions on proposed international, regional and national legislation based on its members' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

**FICPI-UK** is pleased to have the opportunity to provide comments with respect to the draft proposed amendments to Rules of Procedure of the Boards of Appeal (RPBA).

**I. Article 12(1)(c) RPBA**

The draft proposed amendments to **Article 12(1)(c) RPBA** concerning **Basis of appeal proceedings reduce the period for any written reply** of the party or party **from four months** from notification of grounds of appeal **to just two months**. It is only with the discretion of the Board that a longer period, of no more than four months, may be specified. Particularly, the standard period is halved. Extensions are also only with the discretion of the Board and are exceptional. This proposed reduction in the period is further limited by the amendments to Rules 126(2), 127(2), and 131(2) EPC, which will come in to force on 01 November 2023.

This proposed reduction to the period is **contrary to the principle of equal treatment of parties** and is hence inequitable, as presented below.



Article 108 EPC defines that a statement setting out the grounds of appeal shall be filed within four months of notification of the decision. It is well established that “an appeal which was filed after pronouncement of a decision in oral proceedings but before notification of the decision duly substantiated in writing complied with the time limit pursuant to Art. 108, first sentence, EPC 1973” (Case Law of the Boards of Appeal 2022, V.A.2.5.3 a)).

Hence, the Appellant has **at least four months** to prepare the statement setting out the grounds of appeal. In practice, since the Appellant knows the outcome of the Oral Proceedings and in most cases also the decisive points for the reasoning of the first instance, the Appellant has significantly more than four months to prepare the statement setting out the grounds of appeal.

In contrast, the Respondent would have only **at most two months** as the standard period to prepare any written reply, unless the Board specifies a longer period, of no more than four months. Particularly, the Respondent discovers, for the first time, the grounds of appeal only upon notification thereof. The Respondent would thus have only **at most two months** as the standard period to set out their complete appeal case (Article 12(3) RPBA).

The **principle of equal treatment** and the right of parties to a fair trial as e.g. enshrined in Article 6(1) of the Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) obliges the Boards of Appeal to apply uniform criteria to the parties, rather than in an arbitrary manner, following the decision of the Enlarged Board of Appeal in **G 1/05** of 7 December 2006 (OJ 2007, 362).

Particularly, post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given **equally fair treatment**, as decided by the Enlarged Board of Appeal in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420).

Consequently, **the principle of equal treatment** is well established before the Boards of Appeal, being also a term used 38 times in the tenth edition of the "Case Law of the Boards of Appeal of the EPO".

Further, a party's **right to be heard** is a fundamental principle of any judicial system. This fundamental right applies to any party to the same extent. This proposed reduction to the period is **offends the Respondent's right to be heard**.



Hence, the draft proposed amendments to **Article 12(1)(c) RPBA** give an inequitable advantage to the Appellant, as is clearly apparent even from a simple comparison of the lengths of the respective periods.

In other words, since the Appellant is granted by Article 108 EPC a period of 4 months, **the principle of equal treatment** requires that the Respondent is also granted the same period. A shorter period would be indicative of partiality towards the Appellant, which is impermissible.

By way of example, consider revocation of a patent before an Opposition Division. Together with the with the statement setting out the grounds of appeal (their complete appeal case), the **Patentee/Appellant** files numerous auxiliary requests within **four months** of notification of the decision of the Opposition Division. Irrespective of the admissibility or otherwise of the numerous auxiliary requests, the **Opponent/Respondent** as of right would be obliged to set out their complete appeal case in **at most two months** as the standard period and hence address in full the numerous auxiliary requests, despite the excessive burden while offending the **Opponent/Respondent's right to be heard**. In this example and in every example, **the principle of equal treatment** requires that the **Opponent/Respondent** must have the same period as the **Patentee/Appellant** to set out their complete appeal case. This period and hence **the principle of equal treatment** cannot be a matter of the discretion of the Board of Appeal.

Hence, the draft proposed amendments to **Article 12(1)(c) RPBA** are **contrary to the principle of equal treatment of parties**.

Therefore, **FICPI-UK** does not agree with the draft proposed amendments to **Article 12(1)(c) RPBA** and, as a consequence, to Article 25 RPBA.

## II. **Article 13 (2) RPBA**

The draft proposed amendments to **Article 13(2) RPBA** concerning **amendment to a party's appeal case** shift the initiating event of the third level of the convergent approach from the Summons to Oral Proceedings to the Notification of a Communication under Article 15(1) RPBA.

Typically, Oral Proceedings appear to be scheduled several months in advance. In contrast, Communications under Article 15(1) RPBA are typically issued later, i.e. closer to the Oral



Proceedings. Communications under Article 15(1) RPBA may be seen as a caesura to the subject of the proceedings, drawing attention to matters that seem to be of particular significance for the decision to be taken and optionally, providing a preliminary opinion. Hence, while the Summons to Oral Proceedings schedules the conclusion of the proceedings in time, the Summons to Oral Proceedings does not usually form any caesura to the subject of the proceedings.

Therefore, **FICPI-UK** agrees in principle with the draft proposed amendments to **Article 13(2) RPBA**.

### III. Further Amendments

**FICPI-UK** agrees in principle with the draft proposed amendments to **Article 12(7) RPBA** and **Article 15(9)(b) RPBA**.

However, since Article 13(1) RPBA refers to the communication under Article 15(1) RPBA, then the time limit of at least four months mentioned therein should generally be fixed and non-variable to avoid an element of legal uncertainty. Thus, we suggest amending Article 15(1) RPBA as follows: *“The Board shall ~~endeavour to~~ issue the communication at least four months in advance of the date of the oral proceedings, unless there are exceptional circumstances or the parties agree.”*

Such exceptional circumstances can be, for example, acceleration of proceedings due to ongoing parallel litigation.

Since the submission of the Respondent may also contain new subject matter, we suggest amending Article 15(1) RPBA further as follows:

*“In cases where there is more than one party, the Board shall ~~endeavour to~~ issue the summons no earlier than two months after receipt of the written reply or replies referred to in Article 12, paragraph 1(c).”*

### IV. Further Discussion

**FICPI-UK** is of course always open for further discussions and willing to contribute the feedback of its members to the EPO.

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