
Comments to the Revision of the Rules of Procedure of the Boards of Appeal of the EPO / First Public Draft

Although the proposed revision aims at improving "the efficiency and predictability of appeal proceedings before the Boards of Appeal of the EPO", it appears doubtful whether these objectives will be achieved. The result may well be overloading first instance proceedings as well as subsequent appeal proceedings by precautionary submissions, and merely shifting the dispute in appeal proceedings from substantive to formal procedural matters without any efficiency gains. Furthermore, the revision runs the risk of losing sight of a reasonable trade-off between predictability and flexibility required in patent granting proceedings.

1. General comments

The proposed revision of the Rules of Procedure of the Boards of Appeal (RPBA)¹ was drafted from the perspective of the Boards of Appeal. Obviously, the project aims at increasing the efficiency of the Boards of Appeal and the predictability of appeal proceedings by limiting the possibilities of the parties to make further submissions in the course of appeal proceedings and even at the beginning of the appeal proceedings. The Draft seems to be oriented at a more restrictive approach existing in the case law.

However, while some principles expressed in the case law may be appropriate in the cases decided upon, the question arises whether these findings should be generalized for other situations.

So far, the perspective of the users has not yet been taken into consideration. As a general remark, it is important to note that the pendency time of appeals was a concern of users expressed in the discussion about the structural reform of the Boards of Appeal. However, this does not mean that the users were of the opinion that the Boards should reduce the backlog by spending less time per case and rendering summary decisions. It clearly appears from the comments of the user organizations that the backlog should be reduced by providing sufficient staff for the Boards of Appeal.² We share this position.

In respect of the project to revise the RPBA, we believe that the aim should not be to limit the rights of the parties to the proceedings but to harmonize the practice of the Boards and thereby to make decisions more foreseeable. To this end, it appears appropriate to keep in mind that the RPBA are not a set of Rules to be seen in isolation. Rather, the basic principles of the Convention have to be kept in mind, in particular the fundamental principle of the



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right to be heard. It should not happen that the right to be heard is interpreted in the light of the RPBA³ but the RPBA should be drafted and interpreted in the light of the right to be heard. The amended text should contain a clear statement that the RPBA have to be applied in conformity with the parties' right to be heard.

It is not to be expected that setting stricter rules for further submissions of the parties will increase efficiency of the Boards of Appeal. In the past, the restriction of late submissions has not resulted in the expected streamlining of appeal proceedings. An empirical study of 150 decisions taken in each of the years 1995, 2004 (i.e. after entering into force of the RPBA 2003) and 2013⁴ has shown that appeal proceedings have become much more formalized and that substantive issues have been replaced by formal ones. Looking at decisions taken in 1995 shows that they were on average shorter and much more to the point than decisions in 2013. Nowadays, the experience in oral proceedings is that often the morning and the afternoon is spent for tiresome discussions on procedural problems before the substantive discussion can begin which one would expect to be the core of the examination of the allowability or validity of the claimed invention. In the same way, arguments on the admission of requests make a major part of most decisions.

From a party's perspective, decisions based on substantive criteria of patentability tend to be much more persuasive and acceptable in particular to the losing party than those based on procedural restrictions. If the case is lost because requests have not been admitted, the losing party will often get the impression that the case would have been decided in its favor if the Board had dealt with the substance of the submission. It goes without saying that decisions based on non-admission of allegedly late submissions will more and more raise the problem of the liability of the representative to the client.

The amendment of the RPBA 2003 already resulted in an increasing number of auxiliary requests. From 1995 the number of auxiliary requests rose by 150 % and a further increase of early auxiliary requests must be expected if the requirements for further requests filed at a later stage will become even stricter. This fact cannot be surprising since, as a matter of precaution, parties would be required in first instance proceedings to prepare their case in any respect that in one way or another might become relevant in subsequent appeal proceedings, thus regularly overloading both instances with subject matter that may turn out to be not relevant at all for the final decision.

² Union-IP Position paper on Doc. CA/16/15, epi Information 4/15, 120, at p. 122. Reform of the Boards of Appeal, epi Response to the User Consultation, epi Information 3/2015, 87, at p. 88, left. Col.

³ R 1/13 of 17.06.2013, Reasons pt. 13.3.

⁴ Anetsberger, Wegner, Ann et al., Increasing Formalism in Appeal Proceedings – The Boards of Appeal Headed to a mere Reviewing Instance?, epi Information 2/15, 63.

Generally speaking, judicial proceedings involving the granting or challenging of intellectual property rights, in particular patents, are arguably different from other civil or administrative procedures in that the matter in dispute is not exactly defined from the very beginning but may change in the course of the proceedings depending on the established prior art and reactions to it. One would therefore assume a certain amount of flexibility to be naturally needed in such proceedings in the attempt to overcome objections raised by the Board or opponents by changes of the claimed subject-matter and/or to raise new objections against the amended subject-matter if additional pertinent prior art can be found.

Furthermore, a persuasive result of such proceedings may only be achieved after a sufficient exchange of arguments and counterarguments. Although a major part of those procedural requirements can be completed in first instance proceedings, the findings in the decision under appeal normally lead to further reactions by the party/parties, and the EPO Boards of Appeal are the only judicial instance that could deal with them. Therefore, cutting the appeal procedure short by suppressing any changes with a view to increase predictability would go against its very nature.

Hence, all in all, the new Rules significantly limit the possibilities for amendments already at the beginning of the appeal proceedings, reduce them even more after the initial stage, in particular

by requiring *prima facie*-allowability, and remove them completely after the period set in a communication has expired or the summons to oral proceedings has been notified. Any desirable flexibility of the procedure is now transferred to, and limited by, the Board's discretion which, however, is to be exercised under strict criteria, notably procedural economy. As a general result, the battleground in appeal proceedings will be shifted even more from a discussion of the merits of a case to formal issues. As has already been pointed out above, we believe that this does not necessarily improve the efficiency of the proceedings. Moreover, it appears that a vital amount of flexibility has been sacrificed in the name of predictability.

In the following, we will comment on specific aspects of the new Rules as proposed.

2. Art. 6 rev. – Registries

Art. 6(4) is the only provision dealing with the minutes.

For the content of the minutes, Rule 124 EPC is applicable which requires some detail to be contained in the minutes, in particular the essentials of the oral proceedings. Nevertheless, the minutes of oral proceedings before the Board, as a rule, are very short, the essential content being the requests of the parties. This has been justified with the argument that decisions of the Board are not open to appeal.⁵

⁵ T 966/99 of 3.12.2002, Reasons Pt. 7.3.4.

However, the situation has changed to a certain extent by the introduction of review proceedings into the EPC. The usually short minutes have the consequence that the Enlarged Board of Appeal has been repeatedly confronted with different representations of what had happened in the oral proceedings before the Technical Board of Appeal, and there are no practical means of assessing who is right. Therefore, a provision should be taken into the RPBA stipulating that questions discussed in the oral proceedings which had not been addressed in the communication preparing the oral proceeding should be reported in the minutes.

3. Art. 12 rev. – Basis of appeal proceedings

3.1 Art. 12(2) and (4) rev. – Convergent approach – first level

The Draft recites the EBA's statement in G 9/91 that it is the primary purpose of the appeal proceedings to judicially review the decision under appeal. Implementing this principle, numerous restrictions of the parties' right to make submissions have been justified in the past and more are now proposed for the future. The EBA characterized the appeal proceedings as proceedings proper to an administrative Court. However, there is a substantial difference: If a party loses its case before an administrative Court it can return to the administrative body and modify its request and have a better chance on a more promising basis. In *ex parte* cases before the EPO, the applicant appellant may

have a second chance to get a patent granted by filing a divisional application enjoying the priority of the earlier application. But in *inter partes* cases, the patent revoked by the Board of Appeal is finally lost.

The patent is a property right enjoying constitutional protection in the Contracting States. Getting the patent granted requires investment in search and development and cost for prosecuting the application. Its grant may result in entrepreneurial decisions involving further investment. Thus, a patent should only be revoked for good reasons. Legitimate attempts of the proprietor in the course of the proceedings to get his patent maintained in a valid version should not be labeled from the outset as late with a tendency to too late.

Whereas, the Draft increases the hurdles for further submissions for the parties by even excluding a "*new line of attack or argument*" on appeal (see explanatory remarks to Art. 12(2) rev.), there is no indication whatsoever how the cited principle that the primary purpose of appeal proceedings is a judicial review affects the manner⁶ in which the Boards of Appeal conduct the proceedings. In G 9/91, the EBA stated that the principle of examination *ex officio* is to be applied in opposition appeal proceedings in a restrictive manner. However, this has not prevented the Boards from raising objections *ex officio* even at the last minute. This may be illustrated by a review case. The petitioner alleged a procedural violation because he had not been given an appropriate oppor-

⁶ G 9/91, OJ EPO 1993, 408 – Power to examine/ROHM AND HAAS, Reasons Pt. 18.

tunity to overcome a late objection by the Board. The EBA approved the conduct of the proceedings by the Technical Board of Appeal concerned. In the oral proceedings, the Board had raised *ex officio* an objection to a formal deficiency already present in the claims as granted and never mentioned before in the opposition or opposition appeal proceedings. The proprietor tried to overcome the objection by an amendment which the Board did not admit on the basis of a *prima facie* examination. The EBA expressly stated that a late objection raised *ex officio* does not give the proprietor a right to a full response, i.e. a thorough discussion of the request filed in reply to the objection.⁷ Apparently such conduct not only goes beyond the scope of the legal and factual framework of opposition⁸ proceedings established by the notice of opposition, it also deprives the proprietor of a fair chance to have his patent maintained in an allowable version.

Therefore, the Draft should contain a provision acknowledging the contentious character of *inter partes* opposition appeal proceedings and the neutral position of the Board of Appeal as addressed by the EBA in G 9/91.⁹ Such a provision should stipulate that the Board of Appeal examines the appeal within the legal and factual framework defined by the appeal and the reply to it as well as any further

submissions of the parties admitted by the Board. This would avoid the occasionally arising impression that the true adversary of the proprietor is not the opponent but the Board of Appeal¹⁰, not acting like a Court in validity proceedings¹¹ but like an Examining Division.

The requirement that the appeal shall be directed to the “*requests ... on which the decision under appeal was based*” may be interpreted to restrict the parties to the requests submitted in first instance proceedings. In this respect, see the comments on Art. 12(6).

In any case, a new provision should make clear that late objections require an appropriate opportunity for reaction by the applicant or proprietor, see below at Art. 13.

As explained below, amending claims in reaction to the decision under appeal is a quite normal procedural conduct. In a usual case, there should be no requirement that the applicant justifies the submission of an amendment made with the grounds of appeal proceedings for this purpose. The normal and obvious justification is that he wants to overcome the ground for refusal or revocation. An exception is only appropriate if the amendment amounts to a fresh case.

⁷ R 1/13, *supra*, Reasons pt. 16.3.

⁸ G 9/91, *supra*, Reasons pt. 6.

⁹ G 9/91, *supra*, Reasons, pt. 2. See the consequences in later case law, in particular in review cases, Case Law of the Boards of Appeal of the EPO, 8th ed. 2016, IV.F.3.13.6.

¹⁰ Anetsberger, Wegner, Ann et al., *supra*, epi Information 2/15, 63, at p. 69, left col.

¹¹ Cf. G 9/91, *supra*, Reasons pt. 2.

Making the justification of new submissions a requirement for routine cases would have the consequence that the justification will be an additional point at issue in all *inter partes* cases. Being obliged to act in the interest of his client, the opponent's representative will have to object to the amendment in all cases. This will certainly not make appeal proceedings more efficient.

3.2 Art. 12(6) rev.

Art. 12(4) RPBA as in force, corresponding to Art. 10a(4) RPBA 2003 was conceived as an exception to the general rule in Art. 12(1) RPBA that appeal proceedings shall be based on the statement of grounds of appeal and the reply thereto, thereby more or less guaranteeing the consideration of any subject matter relating to the case if filed at the very beginning of appeal proceedings. This becomes clear from the structure of the provision, the first paragraph containing the general rule and the fourth paragraph an exception. The wording "*Without prejudice to the power ... to hold inadmissible ... everything shall be taken into account ...*" also shows that the overriding principle is to take everything into account which is limited by the Board's power to hold certain submissions inadmissible.

In appropriate situations, Boards have recently emphasized the exceptional character of the power to hold the earliest

submissions in appeal proceeding inadmissible. It has been stated that non-admission under Art. 12(4) RPBA requires that the "*late*" submission is the consequence of an abusive procedural conduct, in particular, if it was chosen deliberately for tactical reasons.¹² The proposed amendment intends to reverse the order: Non-admittance becomes the rule and admission becomes the exception. This substantially compromises the scope of judicial review available to the parties. It does not appear reconcilable with a proper system of judicial review if submissions are not admitted which were submitted at the earliest possible stage of appeal proceedings.

The situation is aggravated by the additional requirement that an admission of the any new submission in appeal proceedings has to enhance procedural economy in accordance with Art.12(4) RPBA rev. In other words, this appears to mean that even in a situation in which further submissions can be dealt with in substance with the same effort as non-admission of the submissions, they should not be admitted. This formal requirement conflicts with the overriding principle of the right to be heard and contradicts the core purpose of judicial review that justice is done in substance.

As to the limited review of the discretion exercised by the department of first instance addressed in Art 12 (6), first sen-

¹² T 134/11 of 6.11.2012, Reasons pt. 3.3.
T 2259/11 of 2.06.2016, Reasons pt. 1.
T 1364/12 of 12.02.2015, Reasons pt. 1.3.
T 1743/12 of 15.07.2016, Reasons pt. 2.

tence, RPBA rev., the proposal would have the consequence that the first instance can decide to which extent its assessment of substantive patentability criteria may be subject to review by the Boards of Appeal. Quite often a *prima facie* rejection may be based on the same arguments as a substantive decision.¹³ A decision that an amendment is *prima facie* not allowable is to be based on the same substantive criteria as a decision that an amended claim does not meet the requirements of the Convention. In the first situation, the Board of Appeal would only examine whether the first instance correctly exercised its discretion, in the second situation the Board of Appeal would examine whether the patentability criteria were correctly applied. It is obvious that the first instance would tend to the first alternative, thereby limiting the access of the users of the European patent system to judicial review.

However, it cannot be the task of the administration to control the access to judicial review concerning the requirements of patentability. This is why several recent decisions have taken the position that a discretionary decision by the first instance on the non-admission of late submissions is subject to full review if it is based on an assessment of substantive criteria as e.g. inventive step or clarity.¹⁴ Quite convincingly the Board in T 1816/11 points to the fact that G 7/93¹⁵, always cited to justify a limited review of first instance discretionary decisions, was dealing with

a situation in which the exercise of discretion was based on procedural aspects and in which the substance of the requested amendment was not contested. The Board in T 1816/11 concluded that the review of decisions based on substantive criteria is the core competence of the Boards of Appeal and that the considerations in G 7/93 cannot be applied in this area. It may be added that the EBA in G 7/93 did not accept the procedural reasons for not allowing the amendment, stating that the amendment, requested at the latest possible date, should be allowed. The EBA concluded that the importance to the party of obtaining a valid patent was decisive, even if the amendment caused a short delay. Thus, the EBA considered the substantive interest of the party in obtaining appropriate protection as a more relevant criterion than the interest of the Examining Division to terminate the case without further effort. It appears that, for justifying restrictions for reviewing the discretion exercised by the departments of first instance, an isolated sentence is taken out from G 7/93 without accepting the EBA's general message that it is the main task of the EPO to grant appropriate protection for the invention disclosed in the application.

The non-admission of requests under Art. 12 (4) RPBA in the present version and Art. 12 (6) of the proposal has turned out to be a particular problem and the practice of the Boards is quite divergent,

¹³ There is certainly no clear distinction between the two situations, cf. T 2324/14 of 4.10.2017, Reasons pt. 2.

¹⁴ T 1816/11 of 22.11.2016, Headnote and Reasons Pt. 2.6 with further references.

¹⁵ G 7/93, OJ EPO 1994, 775 – Late submissions.

thus impeding predictability. The criterion that a request should have been presented in first instance is easily answered in the affirmative *ex post* after knowing the decision of the first instance and after proper reflection of the reasons given. In the stress situation of first instance oral proceedings, e.g. faced with a new objection and without the possibility of contacting the client, the situation may look quite differently from the representative's perspective.¹⁶

The fact that a request was withdrawn in first instance does not necessarily mean that re-introduction of the request is not legitimate. There is sufficient recent case law showing that such procedural conduct is not negligent *per se*.¹⁷ A much more flexible criterion for the allowability of late amendments which is more related to the effect of the submission on the course of the appeal proceedings is the well-established criterion of a "fresh case" which is also reflected in the different stages of convergence. An applicant who re-introduces a claim which was withdrawn in first instance after the first instance has clearly expressed its negative position on the claim's allowability does certainly not present a "fresh case" in appeal proceedings.¹⁸

The drafting of both sentences Art. 12(6) of the proposal that the "*Board shall not admit*" ... submissions ... "*unless*" ... will be interpreted to mean that admission

is the exception. In practice, it is a quite normal situation, that the appellant, having studied the decision under appeal, accepts the reasoning and pursues his case with claims removing the deficiencies objected to in the requests submitted with his grounds of appeal. For *ex parte* cases, this is expressly foreseen in Art. 109 EPC, providing for interlocutory revision. The main case for interlocutory revision is that the applicant removes the deficiencies on which the refusal of the application was based. In this situation, the Examining Division is obliged to grant interlocutory revision.¹⁹ However, this presupposes that the amendment with claims which could/should have been submitted in first instance proceedings is to be admitted.

In *inter partes* proceedings, it is quite normal that the appellant tries to defend his patent in a version which has good chances to be held allowable, thereby drawing consequences from the decision under appeal. As long as his requests are "*convergent*" and he does not present a "*fresh case*", such conduct may reduce the questions contested between the parties and contribute to the efficiency of proceedings. Therefore, Art. 12 (6) rev. presenting the admission of further requests as an exception is not only in contradiction to established case law, it also tends to discriminate proper procedural behavior.

¹⁶ See the considerations in T 2301/12 of 22.11.2017, Reasons Pt. 2.6.

¹⁷ T 2301/12, *supra*; T 2230/12 of 12.12.2017 - LDPC encoding and decoding I/LG ELECTRONICS, T 1364/12, *supra*, Reasons pt. 16; T 1743/12, *supra*.

¹⁸ See e.g. T 2230/12, *supra*, Reasons Pt. 16.3; T 1743/12, *supra*, Reasons Pt.2.

¹⁹ Case Law of the Boards of Appeal, *supra*, IV.E.4.3.3.e).

Reading decisions of the Boards of Appeal, one may sometimes get the impression that the admission of “late” submissions is an act of mercy of the deciding Board. This is not what it should be. Art. 12 and 13 RPBA have to be applied in the legal framework of the Convention itself, i.e. Art. 113(1) and Art. 114. Art. 114 (2) EPC gives the EPO the discretion to disregard facts or evidence which are not submitted in due time. Thus, the first step when considering further submissions has to be to examine whether or not a submission has been made in due time. If yes, there is no discretion to disregard facts or evidence, even if submitted late. If submissions have been made as a legitimate reaction to developments in the appeal case, be it because of actions of the adverse party or of the Board of Appeal, the submissions have to be admitted, even if they may cause a delay, e.g. postponing oral proceedings or remitting the case. Otherwise the right to be heard enshrined in Art. 113 (1) EPC is violated.

Only submissions not made in due time may be disregarded at the Boards’ discretion. This discretion is not free and unlimited. As any discretionary decision in judicial proceedings, the discretion has to be exercised in an objective manner considering all relevant circumstances.²⁰ Thus, as a rule, it is not the admission of submissions which requires justification, but disregarding submissions has to be reasoned in an objective and understandable way.

It seems to conflict with this principle if Boards of Appeal discard relevant circumstances in their assessment from the outset. It appears as an insufficiently reasoned exercise of discretion if a Board abstains from looking at the relevance of a document filed with the statement of grounds of appeal giving as the only reason that the proprietor had not amended the claims and thus the submission of document could not be a proper response.²¹ If a further submission is a legitimate reaction to a claim amendment, there is no discretion, because the submission was in due time. In the cited case, the opponent had given plausible reasons for submitting the document at this stage of the proceedings. However, the decision restricts itself to state why the Board has a discretion. It does not give a relevant reason why the document was not admitted. In such a situation, relevant circumstances have to be addressed and balanced against each other before deciding on the admission.

Therefore, it is suggested to add a provision to the Draft (Art. 12 and/or 13) providing that a decision not admitting requests, facts or evidence on the grounds that it was not submitted within due time has to be reasoned considering all relevant circumstances. According to the consistent practice and case law, the relevance of late submissions is the most important, albeit not exclusive criterion for admitting late filed documents.²² Therefore, the relevance

²⁰ G 7/93, supra, Reasons Pt. 2.5.

²¹ T 724/08 of 16.11.2012, Reasons Pt. 3. See also T 2206/14 of 11.09.2017, Reasons Pt. 1.3 for an allegedly novelty-destroying document.

²² Case Law, supra, IV.C.1.3.7 referring to IV.C.1.1.4.

of the late submission should be mentioned in Art. 13(1) of the Draft among the expressly indicated criteria to be considered when exercising the discretion.

4. Art. 13 rev. – Amendment to a party’s appeal case

Art. 13(1) and (2) – Convergent approach – second and third level

For the requirement that the amendment has to enhance procedural economy, see already above the comment on convergent approach first level. In addition, it should be decisive who has caused the amendment at this stage. If the amendment is a reaction to a late objection by the opponent or by the Board, it is the objection which compromises efficiency. The amendment has to be allowed in order to safeguard the general legal principle of equality of arms or equal treatment to be respected in opposition proceedings²³ and should need no further justification.

As to the requirement that an amendment must be *prima facie* allowable, the applicant or proprietor has to get a fair chance to overcome a late objection. For example, if the appellant makes a *bona fide* attempt to overcome a substantive objection raised in the communication accompanying the summons, and a formal objection to the amended version is raised in the oral proceedings, procedural fairness may require that a second amendment is admitted.²⁴

5. Art. 15 rev. – Oral proceedings and issuing of decisions

5.1 Art. 15(1) rev.

The fact that a communication becomes obligatory is welcome. It helps concentrating on the essential aspects of the case. Such a communication can only express a preliminary view in respect of the issues to be dealt with and should, in particular in *inter partes* proceedings, not give the impression that the Board has already made up its mind (cf. Art. 17(2)). However, in respect of the issues to be discussed, the communication should be reliable. In particular, if objections are raised or admitted in oral proceedings which were not foreseeable on the basis of the communication and the previous submissions in appeal proceedings, the applicant or proprietor should be given an opportunity for a full reaction, if necessary after postponement of oral proceedings.

It should be stipulated that the communication is sent with the summons. Oral proceedings should only be appointed if the case is ready for oral proceedings. If the communication may be sent after the summons there is the danger that the case was not yet ready for oral proceedings²⁵ when the summons was sent. An example may be that it has not yet been clarified whether a request for taking evidence is relevant and should be acceded to.

²³ Case Law, *supra*, IV.D.5.1.

²⁴ See e.g. 868/06 of 7.08.2007, Reasons Pt. 4.

²⁵ See e.g. Draft Rules of Procedure for the UPC, Rule 110.

5.2 Art. 15(4) rev.

In different legal traditions, the conduct of oral proceedings is quite diverging. It would be welcome to make clear that the Board should play an active role in oral proceedings. A model could be found in § 139(1) of the German law on civil procedure (ZPO) providing:

To the extent required, the court is to discuss with the parties the circumstances and facts as well as the relationship of the parties to the dispute, both in terms of the factual aspects of the matter and of its legal ramifications, and it is to ask questions. The court is to work towards ensuring that the parties to the dispute make declarations in due time and completely, regarding all significant facts, and in particular is to ensure that the parties amend by further information those facts that they have asserted only incompletely, that they designate the evidence, and that they file the relevant petitions.²⁶

5.3 Art. 15(7) and (8) rev.

Pursuant to new Art. 15(7) and (8), the Board is endowed with the option to accomplish the written decision in abridged form. The reasoning may already be included in the minutes of the oral proceedings, and then subsequently merely referred to in the written decision.

While abridged decisions may cause less drafting efforts, sacrificing a full reasoning for the purpose of efficiency gains appears regrettable as a matter of principle.

A regular study of present day decisions, whether or not they have been published in the Official Journal, reveals a wealth of legal and technical arguments in the wider context of the decision as such. These bits and pieces of legal and technical assessments provide an indispensable basis for the further development and "internal" harmonization of the case law, which also contributes to predictability.

Furthermore, it should be taken into account that the Boards of Appeal are the only and last judicial instance if patent protection is denied. One would normally not expect from a national Court at this level to give summary written decisions of more or less administrative character. Hence, abridged decisions would not be supportive of the status of an independent last instance judiciary.

Finally, the decisions of the Boards have an important function for the "external" harmonization of case law throughout Europe, notably in modern technical fields. National Courts follow, or at least take account of, decisions of the Boards which therefore take a pioneering role in the European legal environment. It must be seriously doubted that this central function can be maintained with abridged decisions.

²⁶ Source: https://www.gesetze-im-internet.de/englisch_zpo/englisch_zpo.html

More specifically, decisions should not be abridged if a public interest in knowing the reasons is probable. This is the case if there are co-pending divisional or earlier applications, the outcome of which could be influenced by the reasoning for the decision on the application or patent on which the decision is to be taken. The same applies *mutatis mutandis* to patents granted on divisional or earlier applications which might be the subject of opposition proceedings or validity proceedings before national instances. Hiding reasons for invalidity in such situations would entail the reproach that the EPO prevents patent thickets from being cleared.

The question also arises whether abridged decisions will remain exceptions or become standard practice. In view of the fact that already today, there is an increasing tendency of the Boards to simply confirm decisions taken by an opposition division, it may be expected that abridged decisions will not be unusual. While the willingness of the parties to approve a summary reasoning in cases of oral announcement may not be a driving factor for abridgement in view of information needs of their clients, an indication of interest by third parties or national Courts will be extremely rare and thus would not prevent abridgement. Furthermore, as one can assume, individual Boards which take a cautious approach to abridgement may easily come under considerable production pressure.

Notwithstanding the above objections to abridged decisions as proposed, decisions could often be drafted more to the point and at the same time more efficiently. Quite often decisions are much too long repeating

the whole history of the case and all submissions of the parties. Board members should be trained to write shorter decisions, i.e. decisions not containing details which are not relevant for the Board's conclusions on which the order of the decision is based.

6. Art. 25 rev. – Transitional provisions

The transitional provisions are not straightforward due to the fact that the new Rules as proposed also apply in part to pending cases. Significant effort is therefore required to distinguish parts of pending files falling under the new Rules from those where still the current Rules are applicable. More specifically, the respective statements of grounds and replies fall under current Art. 12(4) whereas any later submissions on file, however submitted before the entry into force, are to be treated under the new Rules. Similarly, the new Rules shall not be applied if the summons has been notified or a time limit set in a communication has expired before the entry into force. Apparently, they are to be applied if this time limit still runs. For a Board having hundreds of cases pending at the time being (such Boards appear to exist), the application of these provisions may thus be quite cumbersome.