
The first year with the new Rules of Procedure of the Boards of Appeal RPBA 2020 – An overview and recommendations

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The new Rules of Procedure of the Boards of Appeal, RPBA 2020, have now been in force for one year; they include considerably more stringent standards regarding late filings (see Art. 12, 13(1) and 13(2) RPBA 2020 in particular). With respect to amended Art. 13(1) and (2) RPBA 2020, the EPO's Technical Boards of Appeal have already rendered first decisions. This IP Report takes a look at the application of amended Art. 13(1) and (2) RPBA 2020 in these first decisions and at their implications on practice. It also provides an outlook on the application of new Art. 12 RPBA 2020 which is expected to be similar. Patent proprietors and opponents generally have to make their appeal submissions as early and as completely as possible. Amendments to the submissions have to be filed in direct response to the pleadings of the other party. Additionally, reasons for the amendments have to be provided to ensure that their consideration in the decision of the Boards of Appeal is not at risk.

1. Legal foundations

On January 1, 2020, the new Rules of Procedure of the Boards of Appeal (RPBA 2020) became effective. They particularly rendered the rules on late submissions more stringent as compared to those of the RPBA 2007. What still applies is that the grounds of appeal and the corresponding reply – i.e.

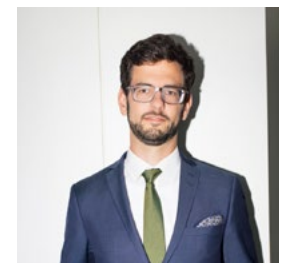
the first brief of each party involved in the appeal proceedings – have to contain the complete appeal case (see Art. 12(2) RPBA 2007 and/or Art. 12 (3) RPBA 2020).

The earlier version of the Rules of Procedure (RPBA 2007), more specifically Art. 12(4) thereof, did admittedly grant the Boards of Appeal the discretion to not admit facts, evidence or requests which could already have been submitted at first instance. However, the general principle was that the entire submission of the grounds of appeal and/or the corresponding response had to be taken into consideration. Now, the RPBA 2020 basically takes the opposite approach: Revised Art. 12 (2) in conjunction with Art. 12 (4) states that a submission which is not directed to issues on which the decision under appeal was based is to be deemed an amendment. Generally, such amendments are not to be taken into account if the Board of Appeal does not admit them exercising its discretion pursuant to Art. 12(4) RPBA 2020. Additionally, not only new facts, evidence or requests may be excluded from admittance now, but also new objections and mere arguments which Art. 12(2) RPBA 2020 explicitly lists.

Similarly, the Rules of Procedure have become more stringent regarding amendments during the course of appeal proceedings. According to RPBA 2007, the Boards of Appeal indeed already had the discretion over whether to admit such amendments, but now it is mandatory for the parties involved to provide justifying reasons for such amendments (Art. 13(1) 1st and 3rd sentence RPBA



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2020). Pursuant to the revised provision (Art. 13(1) sentence 4 RPBA 2020), now, in addition to the state of the proceedings and procedural economy, the question of whether the amendment serves to resolve issues raised during the appeal proceedings is also taken into account when the Board exercises its discretion. If a patent or patent application is amended, the party involved additionally has to demonstrate that the amendment, *prima facie*, overcomes issues raised during the appeal proceedings and does not give rise to new objections.

If the amendment to the appeal case is submitted after the expiry of a period specified by the Board (R. 100(2) EPC) or after the notification of the summons to the oral hearing, such amendment is now generally not taken into account (Art. 13(2) RPBA 2020). Only in exceptional cases, that is if there are exceptional circumstances, which have to be justified with cogent reasons, can an amendment to the appeal case made at such a late stage be admitted.

2. Case law - the decisions

As the decisions of the Boards of Appeal presented in this IP Report show, the amendments to Art. 13(1) and (2) RPBA 2020 are strictly applied.

a. In the two decisions **T 752/16** and **T 995/18**, the Boards of Appeal did not admit amended auxiliary requests which had been submitted after the summons, even though they were directed towards objections by the Board of Appeal which were first raised by the latter. As a reason, each Board of Appeal stated that its objections were based on objections which the opponent had already made at an earlier stage:

In appeal case **T 752/16**, the Board of Appeal gave a preliminary opinion which was favorable for the patent proprietor in a first communication. This preliminary opinion was revised in a second communication. The auxiliary requests submitted after the summons to the oral hearings, but in response to the second communication, were rejected as being late (Art. 13(2) RPBA 2020). The Board of Appeal stated that an amendment to the preliminary opinion had to be expected at any stage before the decision is pronounced. The Board continued that an amendment to the preliminary opinion specifically did not constitute an “*exceptional circumstance*” within the meaning of Art. 13(2) RPBA 2020. It explained that, since the amendment to the preliminary opinion was a reaction to objections raised in the grounds of appeal, the patent proprietor would have had to submit corresponding auxiliary requests in its response to the grounds of appeal already.

This decision was confirmed in decision **T 995/18**. The Board of Appeal did not admit an amended main request which had been submitted during the oral hearing in response to a clarity objection regarding a dependent claim first raised by the Board. In this regard, the Board stated that this clarity objection had already been raised during the opposition proceedings. Hence, according to the Board, the patent proprietor should have reacted to the objection in its response to the grounds of appeal at the latest.

Additionally, in both decisions mentioned above, the Board of Appeal expressed doubts as to whether the amended requests would have met the criteria of Art. 13(1) RPBA 2020 at all, i.e. whether they would have overcome raised issues and not given rise to new objections - aspects which the Board has to

consider even where there is an “*exceptional circumstance*”.

b. In decisions **T 1482/17** and **T 1278/18**, however, the Board of Appeal recognized an “*exceptional circumstance*” within the meaning of Art. 13 (2) RPBA 2020. In these cases, amended auxiliary requests were admitted, even though they had been submitted only after the summons to the oral hearing – which is a glimmer of hope. According to the Board, there was an “*exceptional circumstance*” because the auxiliary requests were submitted in immediate reaction to objections first raised by the Board *ex officio*. As opposed to the decisions mentioned above, **T 752/16** and **T 995/18**, the patent proprietor reacted to the new objections at the earliest time possible so that the auxiliary requests had to be admitted.

c. In decision **T 995/18**, the Board of Appeal admitted the deletion of a dependent claim from a set of claims, which deletion only took place during the oral hearing. The Board decided that the deletion was not an amendment to the appeal case in this specific case, because the deletion neither provided a new meaning to the other claims nor had any other implications on the appeal case of the patent proprietor. Hence, Art. 13(2) RPBA 2020 was not applicable. Therefore, the deletion was not to be rejected as being late, even though it was only made after the summons to the oral hearing.

d. New objections and new arguments based on documents already introduced into the proceedings were rejected in decisions **T 995/18** and **T 908/19**:

In decision **T 995/18**, Art. 13(2) RPBA 2020 was applied to the submission of new objections. A lack of enablement objection regarding a certain feature which had first been raised in the oral hearing was rejected as being late, as the objection related to a feature which had already been part of the original claim. Thus, the objection could have been submitted earlier. The Board of Appeal did not consider the fact that the opponent only first thought of this objection later to be an “*exceptional circumstance*”.

In decision **T 908/19**, the opponent submitted new objections after the summons had been served. The objections related to a lack of inventive step based on documents already introduced into the proceedings and were submitted after the Board of Appeal had expressed a preliminary opinion unfavorable to the opponent. This new submission was not admitted either by the Board of Appeal because it did not find any “*exceptional circumstance*” within the meaning of Art. 13(2) RPBA 2020 which would have justified why the submission in question had not taken place earlier.

e. Additionally, amendments to appeal cases must not be admitted if the party involved does not provide any justification for the amendments. In decisions **T 1004/18** and **T 2279/16**, for example, the Board of Appeal did not admit auxiliary requests newly submitted to the proceedings without any justification. In **T 2279/16**, the Board additionally stated that Art. 13(2) RPBA 2020 is even applicable if the oral hearing was cancelled.

3. Recommendations

What results from last year's decision-taking practice by the Boards of Appeal regarding Art. 13(1) and (2) RPBA 2020 is that any attacks and defenses should be submitted as early as possible, i.e. as soon as the corresponding line of defense and/or attack, respectively, becomes present in the proceedings.

Any amendment to the appeal case made only in reaction to a preliminary opinion of a Board of Appeal or to an amendment of

said preliminary opinion will most probably not be successful if the preliminary opinion merely refers to aspects already introduced into the proceedings. Rather, the prospects of success of amendments to the appeal case are good only if they are made as a direct reaction to objections raised for the first time. Additionally, the amendments should be identified as such and a justification for why they are to be admitted should be given. Otherwise, the party involved risks non-admittance, even if reasons for admitting the amendments exist.

Prospects

In view of amended Art. 12 RPBA 2020, where a similarly stringent application as in case of amended Art. 13(1) and (2) RPBA 2020 is to be expected, we recommend making the entire submission, i.e. submitting all requests, facts, objections, arguments and evidence already at first instance, prior to the deadline stipulated in the communication pursuant to Rule 116(1) EPC.

This particularly applies with respect to amended Art. 12(4), (6) RPBA 2020. This is because, according to Art. 12(2) in conjunction with Art. 12(4) RPBA 2020, requests, facts, objections, arguments and evidence on which the first-instance decision was not already based first have to be admitted by the Board for them to become subject-matter of the appeal proceedings; high hurdles are expected in this regard. Pursuant to Art. 12(6) EPC, particularly requests, facts, objections, or evidence which should have been submitted at first instance shall generally not be admitted, unless the circumstances of the appeal case justify their admittance.

How strictly the Boards of Appeal will exercise their discretion under Art. 12(4) and Art. 12(6) RPBA 2020 and which circumstances justify an admittance under Art. 12(6) RPBA 2020 remains to be seen, since, due to the transitional provisions (see Art. 25(2) RPBA 2020), the Boards of Appeal have not yet rendered any decisions in this regard. However, in view of the case law regarding Art. 13 RPBA 2020, it is to be expected that the discretion pursuant to Art. 12 RPBA 2020 will be exercised similarly strictly and that new submissions will generally not be admitted if the corresponding objections or claims were part of the first-instance proceedings already, i.e. if the submission should already have been made at first instance.

In practice, this means that proactive opponents who would like to avoid risks of preclusion should already present any possible combination of documents regarding a lack of inventive step at first instance. Attacks only submitted later might



be considered new objections and, thus, no longer be admitted, even if they are based on documents already discussed in a different context, which was the case in **T 908/19**. Even individual arguments might no longer be admitted, even if they refer to an objection already raised. It remains to be seen how strictly and/or granularly case law will handle new arguments.

Vice versa, patent proprietors who would like to avoid risks of preclusion are forced to already submit numerous auxiliary requests at first instance. For instance, if all claims of a patent are attacked for different reasons in the opposition proceedings, not only a series of auxiliary requests which are directed at amended independent claims would have to be submitted, but, if you consistently think it through, permutations of the independent claims with various versions of the dependent claims would also have to be submitted. The reason for this is that even amendments to one individual dependent claim may be

precluded from admittance – which happened in **T 995/18**. Otherwise, the only option left to the patent proprietor is deleting the corresponding dependent claim – which also happened in **T 995/18**. Whether this development will promote procedural economy is doubtful at least.

Finding a middle way could potentially include submitting an auxiliary request which tries to overcome all objections raised and limiting the further auxiliary requests to the most important additional feature combinations. This middle way does seem unsatisfactory as it takes away the patent proprietor's full flexibility when handling their patent and/or patent application; however, practical considerations might force patent proprietors to take such approaches. Hopefully, the Boards of Appeal will take such concerns into consideration.