



# **New Rules of Procedure of the Boards of Appeal**

**FICPI Italy**  
**Collegio dei Consulenti**

Daniel X. Thomas ©, Former Director, DG 1

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# New Rules of Procedure of the Boards of Appeal

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# New Rules of Procedure of the Boards of Appeal

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# New Rules of Procedure of the Boards of Appeal

## Introduction

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# New Rules of Procedure of the Boards of Appeal

## Introduction

- The New Rules of Procedure of the Board of Appeal (NRPBA) will enter into force on **01.01.2020**
- Following an online user **consultation** in April **2018**,
  - **140** comments were **filed**
  - Some of them were taken into consideration, but others clearly not followed
  - There has been **one** amendment to the Rules of Procedure after having been presented at the **User consultation conference** held in Munich on Dec 5<sup>th</sup> 2018, that is Art 12(7) NRPBA according to which the **time limit** for replying to the grounds of appeal can be **extended up to 6 months**
- The aim of the New Rules of Procedure is to **increase** the **efficiency**,
  - by **reducing** the **number** of **issues** to be treated

# New Rules of Procedure of the Boards of Appeal

## Introduction

- The New Rules of Procedure of the Board of Appeal (NRPBA) have also to be seen as **a reply to ever increasing number of appeals pending** since 2014
  - which has increased from over 8000 to nearly 10 000 at the beginning of 2019
- The objective is to **settle 90% of cases within 30 months** of receipt and to reduce the number of pending cases to less than 7 000 by 2023
- This objective will be achieved by
  - **increasing the efficiency/productivity** of the Boards of Appeal by 32% as from 1st January 2017 and
  - the allocation of additional resources for a limited period of time
    - that is the appointment of new members of the Boards

# New Rules of Procedure of the Boards of Appeal

## Introduction

- In **2018**, all previously vacant technically qualified member posts could be filled
  - Four chairpersons, one legally qualified member and 24 technically qualified members took up their new function in the Boards of Appeal
    - At 31 December 2018, there were **166** chairpersons and members of the Boards of Appeal
  - The **111** technically qualified and **27** legally qualified members were divided among **28 Technical** Boards of Appeal and the **Legal** Board
  - The total number of staff of the Boards of Appeal was 225
- In **2019**, 23 additional technical member posts are foreseen in the 2019 budget
- In **2020**, 16 technical member posts have been included in the 2020 budget

# New Rules of Procedure of the Boards of Appeal

## Introduction

- The **thrust** of the **whole appeal procedure** will be the judicial review of first instance decisions,
  - **not** merely a **continuation** of the procedure started in first instance
- An important factor to be taken into consideration is the large discretion the Boards will have in deciding on the **admissibility** of submissions **at any moment** during appeal procedure
- Beside petitions for review there is **no mechanism** insuring that the discretion of the Boards has been correctly applied
  - The Enlarged Board has regularly considered that if a the admissibility of a submission has been discussed the right to be heard has been respected



# New Rules of Procedure of the Boards of Appeal

## Introduction

- Two series of measures will be highlighted
  - All the new measures related to the notion of **case management**
    - which makes a **heavy inroad** into the procedure before the Boards of appeal
  - The introduction of **rings of convergence** which will emphasise that the **whole appeal procedure** will be limited to the **judicial review** of first instance decisions
- It will have to be seen **if the aim** of the New Rules of Procedure
  - which is to **streamline** the procedure before the Boards of Appeal in order to reduce the number of pending cases
  - will be **detrimental to the overall efficiency** of the EPO
- The **presentation** will **concentrate** on the **amendments** to the rules **and not** to the rules which have **not** been **amended**

# New Rules of Procedure of the Boards of Appeal

## Introduction

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- **Examples of decisions**
- The **examples given** further down in this presentation correspond to decisions taken under the rules of procedure valid up to 31.12.2019
  - but **exemplify how** the new rules of procedure will be applied

# New Rules of Procedure of the Boards of Appeal

## Case management

- In order to increase efficiency **case management** measures have been **decided**
- **Publication of a list of cases** Art 1(2)NRPBA
- Before the beginning of each working year, each Board will **publish a list of cases** in which the Board is likely to
  - hold oral proceedings,
  - issue a communication under R 100(2) or
  - issue a decision in written proceedings in 2020.
- <https://www.epo.org/law-practice/case-law-appeals/about-the-boards-of-appeal/annual-list-of-cases.html>
  - An Excel table with direct link to the register is also available on the above URL

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **Extension of periods specified by the Board**  
Art 12(7)NRPBA
- Only periods specified by the Board may be extended,
  - and thus not the duration of a period which is specified in a legal provision
- However, the period for replying to the statement of grounds of appeal can be extended up to a maximum of six months
  - although it is legal provision set in the Rules of Procedure

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **Designation of the members of a Board**  
Art 1(3) and 5(3) NRPBA
- The designation of the members of a Board is still a **prerogative** of the Chair of the Board (no change)
  - but the Chair of the Board may designate the rapporteur before determining the remaining composition of the Board
- The **composition** of the Board should however be **known** when the **list** of cases is published

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Designation of the members of a Board**  
Art 1(3) and 5(3) NRPBA
- A clear **distinction** is to be drawn between
  - The "**Chair of the Board**",
    - who is Chairman or Chairwoman appointed by Administrative Council
  - The "**Chair in the particular appeal**"
  - who is responsible for a specific case

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Important role of the rapporteur** Art 5(3) NRPBA
- Subject to the direction of the Chair of the Board, who has the complete overview,
  - the rapporteur **will assess** whether
    - the appeal should be given priority over other appeals assigned to him or her,
    - for example if a **remittal seems likely** or if the **appeal appears to be inadmissible** following the report from the registrar
- The rapporteur will also examine **whether** the appeal should be **treated together** with other appeals

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **Important role of the rapporteur** Art 5(3) NRPBA
- Once the **composition** is complete
  - the **rapporteur** will
    - **draft communications** on behalf of Board
    - **make preparations** for oral proceedings
    - **draft decisions**



# New Rules of Procedure of the Boards of Appeal

## Case management

- **Acceleration of appeal proceedings** Art 10 NRPBA
- Acceleration **was already possible** under the present RPBA
- In case of **acceleration at the request of a party**, for which a **reasoned request** has to be filed
  - where appropriate supported by documentary evidence
  - the **other parties** will be **informed** and **may** comment
  - but will normally **not** be **invited** to commentArt 10(3) NRPBA

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Acceleration of appeal proceedings** Art 10 NRPBA
- If a court or other competent authority in a Contracting State **requests acceleration** of the appeal proceedings,
  - the Board shall **inform the court** or authority and the parties **whether** the request has been granted and, **if so**,
    - **when** oral proceedings are likely to take place  
Art 10(4) NRPBA
- A Board may also **accelerate** an appeal **at its own motion**
  - In such a case, the Board **will not inform** the parties  
Art 10(5) NRPBA
- If **acceleration** is decided
  - time lines will be set and  
Art 10(6) NRPBA
  - the parties will have to abide by in a much stricter manner

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Oral Proceedings** Art 15(1) NRPBA
- Annex to the Summons
- It will become mandatory for a Board to send a communication in **annex** to the summons
  - The annex to the summons will **represent** the view of the **whole board**,
    - not just that of a rapporteur
- The communication **will**
  - be based on **thorough analysis** of case
  - draw the attention to matters of particular significance for the decision
- The communication **may**
  - include a **preliminary opinion**

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **Oral Proceedings**
- Summons to Oral Proceedings - Time limit  
Art 15(1) NRPBA
- The summons will be issued in general with a
  - time lead of four months

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Oral Proceedings**
- Change of date of Oral proceedings Art 15(2) NRPBA
- The **reasons** given in the former **Notice of VP3** relating to Oral Proceedings have now been **entered** in the RPBA
- The **serious reasons** for requesting a change of date **must relate to the representative**
- Giving **reasons why** another representative cannot take over will **not be** any longer **necessary**
  - That **substantive submissions** have been made by **several representatives** of an association will however be **taken into account**
    - This like in the Guidelines E-III, 7.1.1.

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Oral Proceedings**
- Change of date of Oral proceedings Art 15(2) NRPBA
- When **requesting** a change of date,
  - the dates at which a **representative** is **not available** will have to be given
  - This **applies** as well to the **representatives** of the **other** parties
- There is **not**, like in first instance, a **set rule about a number of days** to be **kept free** between oral proceedings
  - for instance when following Oral Proceedings are to be held in different locations
  - This is left to the **discretion** of the Boards

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Oral Proceedings**
- Abridged decisions Art 15(7) NRPBA
- If the decision is **announced** at the **end** of oral proceedings,
  - and the **parties** have given their **consent**
    - it may be in **abridged** form
- If a **third party or a court** has, in the particular case, a **legitimate interest** in the reasons for the decision not being in abridged form
  - they shall not be abridged
- Where **appropriate**, the **reasons** for the decision **in abridged form**
  - may **already be included** in the minutes of the oral proceedings

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Oral Proceedings**
- Abridged decisions Art 15(8) NRPBA
- Under the condition that the provisions of Art 113(1) have been respected, and if the Board **agrees with the decision of first instance** and all its findings,
  - it can, **without the consent** of the parties,
    - decide in **abridged** form
- In such a situation, it is **irrelevant**
  - whether the **decision** has been **announced** orally at the end of the oral proceedings



# New Rules of Procedure of the Boards of Appeal

## Case management

- **Oral Proceedings** Art 15(9) NRPBA
- Issuance of decisions after oral proceedings
- Decision announced at the end of Oral Proceedings
  
- A time limit of **three months** has been set if a **decision** is **announced** at the end of Oral Proceedings
  - but there is **no sanction** in case the time limit is not respected
  
- If a Board cannot issue the decision within three months
  - the parties will be **informed** when the decision will be despatched

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **Oral Proceedings** Art 15(9) NRPBA
- Issuance of decisions after oral proceedings
- Decision announced at the end of Oral Proceedings
  
- **Decisions** which
  - refer a question of law to the Enlarged Board of Appeal
  - to take evidence
  - decisions to postpone oral proceedings
  - do **not fall under** this rule

# New Rules of Procedure of the Boards of Appeal

## Case management

- **Oral Proceedings** Art 15(9) NRPBA
- Issuance of decisions after oral proceedings
- Decision not announced at the end of Oral Proceedings
  
- If the decision is **not announced** at the conclusion of the oral proceedings
  - the time limit of **three months** for issuing a decision applies as well
  
- The Chair will **indicate the date** on which the decision on the appeal is to be despatched
  
- Also in this case
  - there is **no sanction** in case the time limit is not respected

# New Rules of Procedure of the Boards of Appeal

## Case management

- **New rule on remittal to department of first instance**  
Art 11 NRPBA
- The Boards **shall not** remit case to department of first instance,
  - **unless** there are **special reasons**
    - The special reasons have to be decided case by case
- As a rule, **fundamental deficiencies** which are apparent in the proceedings before that department
  - **constitute** such special reasons
- In other words the **Boards should only remit** in case of a **substantial** procedural violation
  - but even in this case the Boards are not obliged to remit

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **New rule on remittal to department of first instance**  
Art 11 NRPBA
- The aim is to **reduce**
  - the likelihood of a "**ping-pong**" effect between Boards and departments of first instance
  - any **undue prolongation** of the entire proceedings before the EPO
- If **all issues can be decided** without an undue burden
  - a Board should **normally not remit** the case

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **New rule on remittal to department of first instance**  
Art 11 NRPBA
- This new provision has apparently been strongly suggested
  - by the **external judges** members of **Boards of Appeal Committee**
- It manifestly does not apply to remittals with order to grant or maintain who were strong proponents of

# New Rules of Procedure of the Boards of Appeal

## Case management

- **New rule on remittal to department of first instance**  
Art 11 NRPBA
- It will have to be seen **how** this new provision can be put into practice
  - some scepticism appears not to be misplaced
- In case of **added subject-matter**, or when the **disclosure** is manifestly **insufficient**
  - **how** can a **decision** upon novelty and inventive step be taken?
- **Legitimate doubts** can be raised
  - **whether** this new provision will **alter** the **present practice** of the Boards in matter of remittal

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **New rule on remittal to department of first instance**
- Is this amendment to the RPBA practicable?
- Depending of how it is applied
  - this new Article in the Rule of Procedure of the Boards of Appeal could have quite a **direct influence** on the way the **divisions** of first instance **exercise their discretion**
- This amendment might have **far reaching consequences** going above the already expected increase of auxiliary requests in first instance



# New Rules of Procedure of the Boards of Appeal

## Case management

- **New rule on remittal to department of first instance**
- Is this amendment to the RPBA practicable?
- Some questions
  
- Can a division **be forced** to decide on novelty and/or inventive step of a claim which manifestly offends Art 123(2)
  - What is then the **prior art** to take into account?
    - Shall the division simply ignore the offending amendment and decide on the claim as a whole, i.e. with the offending part, and by taking as effective date, the effective date of the not offending reminder of the claim
  
- Can a division **refuse to admit** and examine a late filed request which manifestly offends Art 123(2)
  - **but** the applicant/proprietor wants to have examined

# New Rules of Procedure of the Boards of Appeal

## Case management

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- **New rule on remittal to department of first instance**
- Is this amendment to the RPBA practicable?
- Some questions
  
- Can a division **refuse** to decide upon novelty and/or inventive step when an invention is not sufficiently disclosed
  - It seems to me that it is **difficult to decide** upon novelty and inventive step of claims relating to an insufficiently disclosed invention
  
- Can a division **refuse** to decide when a claim is manifestly lacking clarity
  - If one does not know what is the substance of claim, it seems moot to discuss novelty and/or inventive step

# New Rules of Procedure of the Boards of Appeal

## Case management

- **New rule on remittal to department of first instance**
- Is this amendment to the RPBA practicable?
- Some questions
- If there is only a **decision on novelty** taken on the basis of a piece of prior art under Art 54(2),
  - should the division **also decide or even be forced to decide also** on inventive step on the basis of the same document taken as closest prior art
    - The Board of Appeal could be of a different opinion with respect to novelty
- When deciding that a claim offends Art 83, Art 123(2) or in examination Art 84,
  - will a division be **requested** to systematically **make an obiter dictum** to discuss novelty and/or inventive step

# New Rules of Procedure of the Boards of Appeal

## Case management

- **New rule on remittal to department of first instance**
- Is this amendment to the RPBA practicable?
- Some questions
  
- If an opponent bases **grounds of opposition** on a public prior use and the opposition division comes to the conclusion that it is not properly supported
  - can the opposition division **be forced** to take a decision in which the public prior use is considered properly supported
  - From the three criteria when-what-how **which one** is the **most important** and has to be correctly supported
  
- Is an opposition division **obliged to hear a witness** in every case in which an opponent proposes a witness to corroborate a public prior use

# New Rules of Procedure of the Boards of Appeal

## Case management

- **New rule on remittal to department of first instance**
- Is this amendment to the RPBA practicable?
- Some questions
  
- It is **common practice** nowadays that the Boards of Appeal **remit** to the first instance
  - in order **finalise** grant or maintenance of the patent,
    - and especially to **adapt** the description
- Can this type of **remittal**,
  - which is **common practice**,
    - be considered falling
      - under the criterion of an **exceptional circumstance**?
  
- Can the **parties** therefore **request** from the Boards not to remit in such a situation?

# New Rules of Procedure of the Boards of Appeal

## Case management

- ***New rule on remittal to department of first instance***
- *Would such a decision still be possible?*
  
- **T 839/14**
  - The Board has considered the exercise of the first instance discretionary power **not to admit the fresh ground** under Art 100(c), and has further **considered opposition grounds** based on Art 100(b) and Art 100(a) in relation with Art 54(1) in respect of E13 and
    - has reached the **conclusion** its subject-matter contained **novel features** with respect to this disclosure

# New Rules of Procedure of the Boards of Appeal

## Case management

- ***New rule on remittal to department of first instance***
- *Would such a decision still be possible?*
  
- **T 839/14** **II**
  - The opposition division has **neither**
    - **considered novelty** with respect to the **other documents** brought forward against it,
    - **nor did it** examine and decide on the ground of inventive step in the light of further citations
  - At **appeal stage neither** the Appellant/Opponent **nor** the Appellant/Proprietor have **submitted** any argument in relation to these issues
  - Therefore, as was confirmed at the oral proceedings before the Board, neither the parties **nor** the Board were in a position to conduct a meaningful discussion of these remaining issues

# New Rules of Procedure of the Boards of Appeal

## Case management

- ***New rule on remittal to department of first instance***
- *Would such a decision still be possible?*
- **T 839/14** **III**
  - The Board decided to exercise its discretionary power of the Board under Art 111(1) to remit the case to the department of first instance
- **Comment**
  - If, in the future, the **Boards** adopt a **broad view** for the notion of “**special circumstances**”
    - the situation with respect to remittal **may not really** change under the NRPBA



# New Rules of Procedure of the Boards of Appeal

## Case management

- ***New rule on remittal to department of first instance***
- ***Substantial procedural violation and remittal***
- **T 899/17**
  - The **reasons for the failure** of auxiliary requests which were **skipped in the discussion** during the oral proceedings before the opposition division
    - **in favour of more promising** lower-ranking auxiliary requests and
    - **which were explicitly not withdrawn** by the patent-proprietor
    - have to be **set out** in the written decision
  - The Opposition Division thus committed a **substantial procedural violation** and the **case** was thus **remitted** for further prosecution on the basis of the claim requests on file

# New Rules of Procedure of the Boards of Appeal

## Case management

- ***New rule on remittal to department of first instance***
- ***Substantial procedural violation without remittal***
  
- **T 1817/14**
  - During the oral proceedings before the examining division, a **set of claims** according to a second auxiliary request
    - was **filed but not** admitted
  - However, the **decision** under appeal
    - **does not** mention the existence of a second auxiliary request,
    - let alone give reasons why it was not admitted
  - The fact that the second auxiliary request is **not mentioned** in the decision under appeal makes the decision insufficiently reasoned and thus **constitutes a fundamental deficiency** in the sense of Art 11 RPBA

# New Rules of Procedure of the Boards of Appeal

## Case management

- ***New rule on remittal to department of first instance***
- ***Substantial procedural violation without remittal***
  
- **T 1817/14** **II**
  - However, as is **clear from the minutes** the appellant was heard on the admission of the second auxiliary request, and the claims themselves are annexed to the minutes
    - Also, the **reasons** missing from the decision are **available** in the minutes
  - Therefore, the appellant **was in a position to understand the examining division's reasons** for not admitting the second auxiliary request,
    - and **to respond** to them in its grounds of appeal
  - The board considered these circumstances, to constitute **special reasons for not immediately remitting** the case to the examining division under Art 11 RPBA

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

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- **Convergent approach**
  - The New Rules of Procedure aim at a **convergent approach** in Appeal procedures
  - The parties will have to **justify any amendment** to their case
    - This **applies to both** the appellant and the respondent
  - **Any** amendment should be such to **narrow down scope of the case**

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

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- **The discretion given to the Boards of Appeal**
  - Admittance of any amendment is subject to the **discretion** of Board and
    - the **criteria for applying** discretion are set out in Rules of Procedure
  - As appeal proceedings **progress**
    - the **possibilities** for parties to amend their case **become increasingly limited**

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **The basis of the appeal procedure** Art 12(1) NRPBA
- Appeal proceedings shall be based on
  - the **decision under appeal** and **minutes** of any oral proceedings before the department having issued that decision
  - the **notice** of appeal and **statement of grounds** of appeal filed pursuant to Art 108
  - in cases where there is **more than one party**,
    - any **written reply of the other party** or parties to be filed **within four months** of notification of the grounds of appeal

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **The basis of the appeal procedure** Art 12(1) NRPBA
- Appeal proceedings shall be based on
  - any **communication** sent by the Board **and any answer** thereto filed pursuant to directions of the Board;
  - **minutes** of any video or telephone conference with the party or parties sent by the Board

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **The object of the appeal procedure** Art 12(2) NRPBA
- 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**



# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **The elements of the appeal procedure** Art 12(3) NRPBA
- The **statement of grounds** of appeal **and the reply** shall contain a party's **complete** appeal case
- Accordingly, they shall set out **clearly and concisely** the reasons **why** it is requested that the **decision** under appeal be **reversed, amended or upheld**,
  - and should **specify expressly** all the requests, facts, objections, arguments and evidence relied on

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **The elements of the appeal procedure** Art 12(3) NRPBA
- All documents referred to shall be
  - **attached** as annexes **insofar as**
    - they have **not already been filed** in the course of the grant, opposition or appeal proceedings or
    - **produced by** the Office in said proceedings
  - **filed** in any event to the extent that the **Board** so **directs** in a particular case

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Rules applicable at any level of convergence**
- Referral to earlier statements Art 12(5) NRPBA
- The Board has discretion **not to admit any part** of a submission by a party
  - which **does not meet** the requirements in paragraph 3
- If a party **merely refers** to submissions **before** the first-instance department
  - the Boards of Appeal have the discretion **not to admit** such submissions
- As a **decision** has been issued in the mean time
  - **submissions** before the first-instance department
  - **have to be adapted** to the content of the decision at stake

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

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- **Rules applicable at any level of convergence**
- If a late submission is admitted the other party has the right to react  
Art 13(3) NRPBA
- Other parties shall be entitled to submit their observations
  - on any amendment
  - not held inadmissible by the Board ex officio

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- ***Rules applicable at any level of convergence***
- *If a late submission is admitted the other party has the right to react*  
Art 13(3) NRPBA
- **T 189/15**
  - A document **E 11** was filed by the appellant/opponent **with** its statement of **grounds** of appeal
    - As the document was **highly relevant** it was **admitted** in the procedure (see below)
  - The Board **decided not to remit** and did not grant the corresponding request from the appellant/proprietor
  - **Claim 1** of the request deemed allowable by the opposition division **lacked novelty** over E 11
  - In reaction to the admission of the late filed document the appellant/proprietor **filed a new auxiliary request 7**

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Rules applicable at any level of convergence**
- If a late submission is admitted the other party has the right to react  
Art 13(3) NRPBA
  
- **T 189/15** **II**
  - Auxiliary request 7 did **not induce** any complexity **nor** does it **raise** new objections
    - Auxiliary request 7 **corresponds** to the **argumentation previously presented** by the proprietor and cannot therefore surprise the opponent
    - In particular, the **amendments** carried out **do not** raise any issue that the Board or the other party cannot reasonably address **without** the oral proceedings being postponed
  - Auxiliary request 7 allowed the **patent** to be **maintained** in amended form

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- ***Rules applicable at any level of convergence***
- ***No mere copy-paste of reasoning submitted before the first instance***
- **T 918/17**
  - The decision under appeal was taken "according to the state of the file"
  - The Board held that, although the statement of grounds of appeal generally deals with the issue of inventive step, it does not deal with the specific reasons given in the impugned decision in respect of inventive step
  - The statement of grounds of appeal is identical to the arguments submitted in support of the amended claims filed in response to the extended search report

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- ***Rules applicable at any level of convergence***
- *No mere copy-paste of reasoning submitted before the first instance*
- **T 918/17** **II**
  - Accordingly, the statement setting out the grounds of appeal **does not enable the board** to understand immediately
    - **why** the decision is alleged to be incorrect and
    - **on what facts** the appellant bases its arguments
    - without first having to make investigations of its own
  - The **appeal** was rejected as **inadmissible**



# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- ***Rules applicable at any level of convergence***
- ***No mere copy-paste of reasoning submitted before the first instance***
- **T 39/12**
  - The appellant/opponent filed an appeal against the decision of the opposition division to **reject the opposition** against European patent
  - The **statement of grounds of appeal** which was filed is almost precisely **the same** as the **arguments** filed in support of the **notice of opposition**

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- ***Rules applicable at any level of convergence***
- ***No mere copy-paste of reasoning submitted before the first instance***
- **T 39/12** **II**
  - It **differs** therefrom **only** in that the heading has been changed from
    - "Arguments in support of opposition" to
    - "Statement of grounds in support of Appeal"
    - and in that the last passage in the opposition brief was deleted which read "**Additional prior art documents**"
  - The appeal was thus **rejected** as **inadmissible**
    - in spite of the attempt of the appellant to quote decisions of the Boards of Appeal allegedly supporting his point of view

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Rules applicable at any level of convergence**
- Non-admission in first instance Art 12(6) NRPBA
- The Board shall **not admit**
  - requests, facts, objections or evidence **which were not admitted** in the proceedings leading to the decision under appeal,
  - unless the decision **not to admit** them **suffered from an error in the use of discretion**
  - or unless the **circumstances** of the appeal case **justify** their admittance

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Rules applicable at any level of convergence**
- Non-admission in first instance Art 12(6) NRPBA
- The Board shall **not admit**
  - requests, facts, objections or evidence which **should have been submitted**,
  - or which were **no longer maintained**, in the proceedings leading to the decision under appeal,
  - unless the **circumstances** of the appeal case **justify** their admittance

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Rules applicable at any level of convergence**
- Combination of granted claims during oral proceedings before the Boards - Not any longer possible
- In the **past** it was **possible** even in appeal to **combine** an **independent** claim with a **dependent** claim **even at** a late stage of the appeal procedure
  - This practice has been brought to an end a while ago and is fully in accordance with present RPBA
- **Any combination** of an **independent** claim with a **dependent** claim as granted should at best be **filed in first instance**
  - **Otherwise** it will be considered as an **amendment**
- This is **even more** the case if **features from the description** are added **in order to limit** an independent claim as granted
  - Such an amendment has however **to be filed before** the **expiry** of the time limit under **R 116(1)**

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Rules applicable at any level of convergence**
- **G 4/92**
- Under the Rules of Procedure valid up to 31.12.2019 the **restriction** imposed by **G 4/92** is in principle **removed**
- In view of Art 12(4), 13(1) and 13(2) NRPBA,
  - there is little risk that the **situation envisaged** in **G 4/92** will ever **arise**
  - **G 4/92** can be said to be **superseded** by Art 13(2)NRPBA
- **T 1621/09** will probably **apply** mutatis mutandis

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- *Rules applicable at any level of convergence*
- *Absence of a party at Oral proceedings*
- **T 1621/09**
  - A **new argument brought** forward in appeal proceedings by a party which would have the effect of amending its case, even if the argument is based on evidence and facts already in the proceedings, **can only be introduced into the proceedings at the discretion of the Board** of Appeal by way of an amendment under Article 13 RPBA
  - To the extent that the decision of the Enlarged Board of Appeal in **G 4/92** deals with the **general admissibility of new arguments in appeal proceedings**, it must be taken to have been **modified** by the amendments to the RPBA introduced with effect from 1 May 2003

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- *Rules applicable at any level of convergence*
- *Absence of a party at Oral proceedings*
  
- **T 1621/09** **II**
  - Art 13(3) RPBA must be read subject to Art 15(3) RPBA,
    - with the result that **the absence of a duly summoned party does not prevent a Board from allowing an amendment** to another party's case and
    - reaching a decision on the basis of the amended case
  
  - The **absence** of the party is nevertheless a factor to be **taken into account** in the exercise of the **discretion**



# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Definition of the three rings of convergence**
- The NRPBA provide **three rings** of convergence
  - when entering appeal Art 12(4) NRPBA
  - once the appeal and the reply to the appeal have been filed Art 13(1) NRPBA
  - after a communication under R 110(2) or Summons to Oral Proceedings have been issued Art 13(2) NRPBA
- They **roughly correspond** to the existing situation
  - but the **conditions** in which an **amendment** can be **admitted**
    - have been **heavily strengthened**

# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence - Introduction

- **Effect of the rings of convergence**
- The Boards will **likely be stricter** on parties' amendments to their case
- However, in applying the convergent approach, the **Boards will safeguard and respect**
  - the parties' **right to be heard**, and
  - their right to fair proceedings
  - For **example**, when a Board **raises** an **issue** of its **own motion** in a communication under R 100(2) or in an annex to the summons under Art 15(1) NRPBA
    - the party's right to be heard must be respected
- **Submissions** of a party concerning only **interpretation of the law** are **not an amendment**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- An important aspect is that **not “everything which has been presented”** at the outset of the appeal procedures **will** be admitted
- In Art 12(4) NRPBA parts of the **statement of grounds** of appeal **or the respondent’s** reply, i.e. parts of a party’s appeal case,
  - which are **not directed to** facts, etc. on which the decision under appeal was based
  - are considered as an **“amendment”** and
    - will **only** be **admitted** at the **discretion** of the Board

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- This applies **not only to** amendments to the application or to the patent, **but to** any submission, i.e. requests, facts, objections, arguments and evidence which the party submitted before the department of first instance
  - but **on which** that department **did not base** its decision
- It applies notably to requests, facts, objections, arguments and evidence which have **not** been **pursued or withdrawn** in first instance

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Late filed arguments must always be admitted?
- **T 1914/12**
  - The Boards of Appeal have **no discretion** as to the **admissibility** of late arguments **based on** facts already in the proceedings
    - This Decision is **in contradiction** with **T 1621/09** (op cit.)
  - For the Board, there is the **difference between facts and evidence**,
    - that e.g. the **lack of novelty** is a **fact** established on the **basis of evidence**, a document,
    - where an **argument** is a **corroboration of the fact** already put forward

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Late filed arguments must always be admitted?
  
- **T 1914/12** II
  - The Board found that the **English version** of Art 114(1) referred to **facts, evidence and arguments**,
    - whereas the **German and French** versions referred **only** to **facts and evidence**
  
  - For the Board, there is **no difference** between **"argument"** and **"line of argument"**
  
  - With regard to Articles 13(1) and 12(2) RPBA, the Board **first assumed** that a Board of Appeal had been granted the right,
    - not to admit a late amendment of one of the parties' arguments

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Late filed arguments must always be admitted?
- **T 1914/12** III
  - However, **by analysing** the preparatory work ("Travaux préparatoires") **which led to** Art 13(1) and 12(2) RPBA,
    - the Board **concluded** that the Boards of Appeal have **no discretion** when it comes to **admitting** late arguments
      - This was also in **line with** earlier case-law of the Boards of Appeal
  - By referring to the English version of Art 114(1), the Board also states that, pursuant to Article 23 RPBA, the **Rules of Procedure** are **binding on the Boards of Appeal**
    - **in so far as they do not lead** to a result **incompatible** with the spirit and purpose of the Convention

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Late filed arguments must always be admitted?
- **T 1359/14**
  - This decision **confirms T 1914/12**
  - In reason 2.1, the Board indicates that a Board has **no discretion** as to the admissibility of late arguments based on facts already in the proceedings
    - The Board referred to and followed Point 7.2.3 of **T 1914/12**
  - The Board observed that a combination of documents D1 and D3 with respect to the inventive step of the subject-matter of claim 1 has at least been suggested on page 6 of the opposition statement



# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Late filed arguments must always be admitted?
  
- **T 1359/14** II
  - The Board thus decided not to apply Art 12(4) RPBA
  
- **Comments**
  - It remains to be seen whether this view will still be valid under the NRPBA as of 01.01.2020 as the aim of the reform is to tighten the conditions under which late submissions are admitted into the appeal procedure
  
  - To settle the matter a referral to the Enlarged Board of Appeal might become necessary

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Maintenance in appeal of submissions filed and maintained in first instance but not examined
- Requests, facts, etc., **submitted** by a party **before** a department of first instance
  - but **on which** that department did **not** base its **decision**
  - are **not considered an amendment**
  - if the party demonstrates that those requests, facts, etc.
    - were **admissibly raised**, and
    - were **also maintained** until department took its decision

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Maintenance in appeal of submissions filed and maintained in first instance but not examined
- If for instance the **opposition** was **rejected** any **auxiliary request validly filed** by the proprietor before the opposition division
  - **maintained** when replying to the grounds of appeal by the respondent/proprietor will **not** be considered as **an amendment**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Identification of each amendment
- Within the first ring of convergence,
  - the party must clearly **identify** each **amendment**
  - and provide **reasons for submitting it** in appeal proceedings
- In the case of an **amendment to the application or the patent**,
  - the applicant or patent proprietor **must explain** why the **amended claim overcomes the objections** raised,
    - i.e. raised **in the decision** under appeal,
    - or **by the opponent** in its statement of grounds

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

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- **When entering appeal** Art 12(4) NRPBA
- Identification of each amendment
- The “**objections raised**” are those
  - raised in the decision under appeal, or
  - by the opponent in its statement of grounds of appeal

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Some criteria for assessing amendments by the Boards
- The **non-exhaustive list** of criteria for the Board's discretion can be summarised as follows
  - the **complexity** of the amendment
  - the **suitability** of the amendment to address the issues which led to decision under appeal
  - the need for **procedural economy**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Necessity to file auxiliary requests in first instance
- If a patent is **revoked** due to a **valid ground** of opposition and the proprietor has **not filed in first instance** an auxiliary request to **attempt to overcome** this ground
  - but has **waited** to enter appeal to do so the corresponding request is **only admitted** at the discretion of the Board
- If this request does **manifestly not overcome** the objection raised in the appealed decision
  - it will **not be admitted** at all

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Justification needed for resubmitted requests
- However merely **re-filing in appeal** some requests which were **already filed** before the first instance
  - but **without giving any** reasons **why** those requests would provide patentable subject-matter
    - **should** the appeal be allowed
    - can lead to those requests as **not** being **admissible**



# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = Request not admitted in appeal***
- **T 144/09**
  - **Objection** under **Art 123(2)** raised before the opposition division
    - **Auxiliary request** overcoming the objection **only filed** when entering **appeal**
    - The opposition Division had even asked the proprietor if he wanted to file an auxiliary request
      - The proprietor negated the opportunity given
    - The **auxiliary request** was deemed **not admissible**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = Request not admitted in appeal***
- **T 144/09** II
- **Petition** for review **R 11/11** not successful
  - The petitioner argued that the manner in which the Board exercised discretion means that no patent claims can be advanced in appeal proceedings which were not already filed in the first instance proceedings
    - This is clearly not correct
  - The same is true of the petitioner's argument that Art 12(4) RPBA should not be read so as to unduly restrict the freedom of a party to modify its requests in appeal proceedings, particularly in the light of what it has learned from the actual decision of the first instance department
  - The matter remains one of discretion to be exercised on the basis of the facts of the individual case

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = Request not admitted in appeal***
- **T 2078/15**
  - Appeal after **refusal** of the application
  - Before the examining division **one main** and **one auxiliary** request
  - **After summons** to Oral Proceedings before the examining division a **new main** and **no auxiliary** request
  - When entering appeal **one revised main** and **one revised auxiliary** request
    - whereby Claim 1 of the main request and the auxiliary request are identical
  - Those two requests **defined** the **relationship** between features **more broadly**
    - than in the requests on which the contested decision was based

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = Request not admitted in appeal***
  
- **T 2078/15** **II**
  - The requests were not admitted in the procedure under Art 12(4) RPBA
  
  - The Board reminded that the **purpose** of examination appeal proceedings could **not be to completely reopen** the examination proceedings by **admitting claims** defining **features more broadly**
    - if the **broader definitions** were **not suitable** for **overcoming** objections raised in the contested decision or by the board

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = Request not admitted in appeal***
  
- **T 2078/15** III
  - Furthermore the appellant **did not provide reasons** for this amendment **in** its statement setting out the **grounds of appeal**,
    - but **argued at the oral proceedings** that the amendment was to overcome the clarity objection raised in the contested decision
  - The amendment consisted in the **deletion** of the word "**preprogramed**" from the claims filed before the examining decision and
    - the board held that this **deletion cannot** be an **amendment** suitable for **overcoming** the objection raised in the contested decision

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = Request not admitted in appeal*
- **T 1300/15**
  - Auxiliary requests II and III were **filed together with the reply** to the statement setting out the grounds of appeal
    - and **corresponded to** auxiliary requests II and III **already filed** in opposition proceedings
  - **When submitting the auxiliary requests** together with the reply to the statement setting out the grounds of appeal
    - the respondent **did not indicate any reason why** these requests would provide patentable subject-matter
      - **should the appeal be allowed**
        - on the basis of the **substantiated arguments submitted** by the appellant with the appeal

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = New evidence not admitted in appeal***
- **T 545/14**
  - The mere fact that the appellant naturally disagrees with the outcome of the contested decision
    - cannot be regarded by the Board as sufficient justification for the late submission of these new documents
    - only with the statement of grounds of appeal
  - The appellant submitted that it had been surprised by the narrow interpretation of claim 1 given by the Opposition Division in the contested decision

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = New evidence not admitted in appeal***
  
- **T 545/14** II
  - However, the Opposition Division had **already given a detailed opinion** on the interpretation of claim 1, the novelty in relation to E1 and the inventive step
    - in the **preliminary opinion** annexed to the summons to oral proceedings
  
  - Thus, the appellant **should** at least **have expected** that the ground for opposition under **Art 100 (a)** would **not conflict** with the granted patent
  
  - The appellant's argument that it was **surprised** by the contested decision **cannot** therefore be **convincing**



# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = New evidence not admitted in appeal*
- **T 2104/16**
  - **Two documents** had been filed only during the oral proceedings before the opposition division
  - The documents were **not admitted** on the grounds
    - that they had been filed **too late**,
    - were **not relevant** and that
    - the patent **proprietor** would have been **taken by surprise** and
      - did **not have the opportunity** to prepare a proper response

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- *When entering appeal* Art 12(4) NRPBA
- *Amendment = New evidence not admitted in appeal*
  
- T 2104/16 II
  - The opponent **did not dispute** that the opposition division had **correctly exercised** its discretion in deciding **not to admit** these documents
    - **but argued** that the documents should be treated as having been **submitted with** the statement of grounds of appeal and **admitted** to the procedure
  - The Board held that the **position** of the opponent is **contradictory**
    - In the decision the opposition division made clear why the documents were not admitted
    - The same documents should now be admitted although the circumstances leading to the decision had not changed

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- *When entering appeal* Art 12(4) NRPBA
- *Amendment = New argumentation not admitted in appeal*
- **T 221/13**
  - The appellant submitted **for the first time** in the statement of grounds of appeal that the subject-matter of the **granted claim 1** was **not inventive** on the basis of **E1** as the closest prior art **in combination** with **E8** or **E10**
  - In opposition proceedings its submission was limited to the fact that
    - the subject-matter of the granted **claim 1** was **not novel** in relation to the machine disclosed in document **E1** and
    - that **no inventive step** existed on the basis of document **E2** as the closest prior art

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = New argumentation not admitted in appeal*
- **T 221/13** II
  - As far as lack of inventive step is concerned, the **appellant**
    - **did not use** documents **E8** and **E10 as evidence** in the opposition proceedings and
    - **did not present the related facts either** on the basis of **E2** **or** on the basis of **E1**
  - Document **E10** was only used in an **attack** against the granted patent **claims 2 to 8**
    - with **E2** as closest prior art and in combination with Fig. 1 of E10
  - Document **E8** was only used in an **attack** against the granted patent **claim 9**
    - with **E1** as closest prior art and in combination with E8

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = New argumentation not admitted in appeal***
  
- **T 221/13** **III**
  - The **mere fact** that a document has **already been used** in opposition proceedings and that **certain passages** or figures from it have been **cited as evidence** for certain facts
    - **does not preclude new facts** based on that document and the designation of the document or of certain passages from being admissible **as evidence for those new facts** in appeal proceedings
  
  - Under Art 114(2) and Art 12(4) RPBA, it is **not a question of whether a document is filed late**
    - but of **whether evidence or a fact is produced late**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = New argumentation not admitted in appeal***
  
- **T 221/13** **IV**
  - A document does not become evidence in itself by its mere designation in the proceedings or by its submission
    - Rather, it is necessary to specify
      - which fact is to be substantiated
      - by which concrete content of the document
  
  - Accordingly, a party cannot limit himself
    - to submitting a set of documents without substantiating
      - which facts are to be substantiated
      - by which specific passages or figures
    - of the respective documents

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = New requests admitted in appeal*
- **T 408/14**
  - Auxiliary requests 4, 4(A), 4(B), 5, 5(A), 5(B), 6 and 7 were **filed** for the first time by the appellant **with the statement setting out the grounds of appeal**
    - together **with** a respective **substantiation** concerning their patentability
  - The **respondent** did **not** raise any **objection** to the admissibility of these requests in its written submissions
  - The Board thus **decided to admit** auxiliary request 4, 4(A), 4(B), 5, 5(A), 5(B), 6 and 7 into the appeal proceedings pursuant to Art 12(4) RPBA
    - The case was remitted for further prosecution

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = New requests admitted in appeal*
- **T 180/14**
  - For the Opposition Division the **patentee had had sufficient opportunities** both in writing and at the oral proceedings to file a further request
  - The Board came however to the conclusion that the **decisive aspect** of the reasoning for the lack of novelty of the subject matter of auxiliary requests 6 and 7 only **became apparent** during the oral proceedings
  - When the division **decided** that there was a **lack of novelty**, the proprietor **requested** 10 minutes to **prepare and file** a further auxiliary request
  - This **request** was **not** granted



# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = New requests **admitted in appeal***
- **T 1112/15**
  - For the Opposition Division the patentee had had sufficient opportunities both in writing and at the oral proceedings to file a further request
  - The Board came however to the conclusion that the decisive aspect of the **reasoning for the lack of novelty** of the subject matter of auxiliary requests 6 and 7 only came apparent during the oral proceedings
  - When the division decided that there was a **lack of novelty**, the proprietor request 10 minutes to prepare and file a further auxiliary request
  - This request was not granted

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Amendment = New requests admitted in appeal
- **T 1112/15** II
  - When **entering appeal**, the proprietor filed a **further auxiliary** request, even more limited,
    - which was considered by the Board as a **legitimate reaction** to the decision of the opposition division
  - In the present case, **failure to give reasons** as to why the new auxiliary request satisfies the requirements of **inventive step**
    - does **not** constitute **a reason** for considering that auxiliary **request** as **not substantiated**,
    - since the contested **decision** is **not** based on a **lack of inventive step**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = New evidence admitted in appeal*
- **T 189/15** (op cit.)
  - During Oral proceedings before the opposition division feature (A) considered unclear was replaced by its mode of implementation (B) as described in the patent at stake
  - Document **E11** was **submitted for the first time** with the appellant's grounds for appeal
  - Opponent/Appellant I **did not succeed** in the first instance, since the Opposition Division considered that the **patent** at stake, **amended** according to auxiliary request 2, satisfies the requirements of the EPC
  - It is therefore **not surprising** that Applicant I is **trying** to succeed by **providing a new** document E11

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = New evidence admitted in appeal***
  
- **T 189/15 (op cit.)** II
  - According to established case law
    - this type of document is generally admissible
  
  - Moreover, this document appears **prima facie relevant**
    - and has lead to the **request** deemed **allowable** by the opposition division **lacked novelty**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Amendment = New evidence admitted in appeal*
- **T 328/14**
  - Together with their respective statements setting out the grounds of appeal, appellants II, III and IV
    - **filed additional documents** D35 to D38
    - in order to **challenge** the **inventive merits** of certain features of the independent claim
  - According to the established case law, the **filing of new facts and evidence** before the board of appeal **can be justifiable if**
    - it is an **appropriate and immediate reaction** to developments in the last phase of the previous proceedings

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = New evidence admitted in appeal***
  
- **T 328/14** **II**
  - Hence, an **appellant who has lost the opposition** proceedings should be **given the opportunity** to fill the gaps in its arguments by presenting further evidence in this regard
  
  - The challenged **features** which were **decisive** for the question of inventive step
    - did **not form part** of the claims as **granted**
  
  - They were **inserted from the description** into the claim about **one month before** the date of the oral proceedings,

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Amendment = New evidence admitted in appeal***
  
- **T 328/14** III
  - **Under these circumstances,**
    - the filing of documents D35 to D38 by the appellants
    - **at an early stage** of the appeal proceedings
    - has to be considered a **legitimate reaction**
    - **to the developments in** the last phase of the **opposition proceedings** and
    - **to the impugned decision**

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

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- **When entering appeal** Art 12(4) NRPBA
- Exercise of discretion by the first instance
- Mainly, it is **only in case** the first instance did **not exercise** its discretion correctly
  - that **submissions** might be **admitted**
    - **provided** they have **not** been **abandoned or withdrawn** in first instance procedure



# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- **When entering appeal** Art 12(4) NRPBA
- Exercise of discretion by the first instance
- According to case law, **if** the way in which the opposition division has **exercised its discretion** when deciding on a procedural matter is **challenged** in an appeal,
- It is **not the function** of a board to review all the facts and circumstances of the case **as if it** were in the place of the opposition division
  - and to decide **whether or not** it would have exercised such discretion **in the same way** as the opposition division

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

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- **When entering appeal** Art 12(4) NRPBA
- Exercise of discretion by the first instance
- A board will **only overrule** the way in which the opposition division has exercised its discretion,
  - **if the board concludes** that it has done so according
    - to the **wrong principles** or
    - in an **unreasonable** way
- See also **G 7/93**, OJ EPO 1994, 775

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Correct exercise of the discretion of the first instance*
- *Request not admitted*
- **T 228/15**
  - The former **Auxiliary request 1**, now the **main request** in appeal was **filed during** Oral Proceedings before the Examining Division
  - Beside being **late filed**,
    - the Examining Division considered the **new request** as **not converging** with the main request
  - The Board held that the **criterion of convergence**
    - was an **acceptable criterion**
    - for deciding upon the admissibility of a late request

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Correct exercise of the discretion of the first instance*
- *Request not admitted*
- **T 228/15** II
  - The amendment which led to the lack of convergence
    - deletion of or in an and/or formulation
    - was **neither** resulting from the observation of third parties **nor** by the objections raised in the annex to the summons
  - Furthermore, the **amended claim** is again directed to a **subject matter similar** to that already claimed at an **earlier stage** of the proceedings
    - **but abandoned** with the filing of the amended main request

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Incorrect exercise of the discretion of the first instance*
- *Request not admitted*
- **T 1929/13**
  - The decision of the examining division **not to admit** a request under **R 137(3)** resulted from an **incorrect exercise** of the discretion of the division
  - The Examining Division argued that the **main request** before it did **not prima facie** meet the requirements of Art 84 and Art 123(2) and that, therefore, it was reasonable not to admit it under R 137(3)
- For the Board, “**prima facie**” can be understood as “immediately apparent, with little investigative effort”
  - However, the **argumentation** of the Examining Division is based on several passages of the description and close interpretation and comparison of the description and the claims

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- ***Incorrect exercise of the discretion of the first instance***
- ***Request not admitted***
- **T 1929/13** **II**
  - The Board reminded that the Guidelines for Examination deal, cf. H-II, 2.3, deal with the admissibility of amendments under R 137(3) during examination after receipt of the first communication, mentioning a number of factors to be considered
    - (a) the amendments remedy a deficiency in response to the preceding communication, provided they do not give rise to new deficiencies
    - (b) the amendments improve the clarity of the description or claims in a clearly desirable manner
    - (c) need to avoid unnecessary delay and excessive and unjustified additional work for the EPO.

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- *When entering appeal* Art 12(4) NRPBA
- *Incorrect exercise of the discretion of the first instance*
- *Request not admitted*
  
- **T 1929/13** **III**
  - By **not taking** into consideration criteria (a) to (c) into account
    - the Board considered the Examining Division **incorrectly exercised its discretion** under R 137(3)
      - in **not admitting** the main request into the proceedings

# New Rules of Procedure of the Boards of Appeal

## The first ring of convergence

- ***When entering appeal*** Art 12(4) NRPBA
- *Incorrect exercise of the discretion of the first instance*
- *Evidence not admitted*
  
- **T 1929/13**
  - By **not taking** into consideration criteria (a) to (c) into account
    - the Board considered the Examining Division **incorrectly exercised its discretion** under R 137(3)
      - in **not admitting** the main request into the proceedings



# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- **Limitation on a party amending its appeal case after the initial stage of the proceedings** Art 13(1) NRPBA
- A **reasoned request** for admittance of any “**amendment**” at this stage of the appeal proceedings is **mandatory**
  - The admittance is subject to the **Board’s discretion** alone
- Where an amendment to **an application or patent** is concerned, the **onus** is on the applicant or patent proprietor **to demonstrate both**
  - **why** the amendment **overcomes** the objections raised,
    - cf. first level of the convergent approach
  - and **why** the amendment **does not give rise to new objections**

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

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- **Limitation on a party amending its appeal case after the initial stage of the proceedings** Art 13(1) NRPBA
- The **criteria** set for the admissibility of amendments in the **second ring** of convergence
  - are **stricter than** for the **first ring** of convergence
- Not only a **justification** for the amendment has to be **provided**
  - but **reasons** have to be provided as to **why** the amendment is submitted **at this stage** of appeal proceedings

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- **Limitation on a party amending its appeal case after the initial stage of the proceedings** Art 13(1) NRPBA
- The non-exhaustive list of criteria for the Board's discretion can be summarised as follows
  - the current **state of proceedings**
  - the **suitability** of amendment **to resolve issues**
  - whether the **amendment** is **detrimental** to the **procedural economy**
  - does **not** give rise to **new** objections

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1492/13**
  - The **opposition** was **rejected** by the Opposition Division and the opponent appealed the decision
  - The **respondent** (patent proprietor) requested that the **appeal** be **dismissed** (main request), **alternatively** the decision be set aside and **maintenance** of the patent as amended on the basis of an auxiliary request filed one month before the oral proceedings
  - For the Board of Appeal, **claim 1** as granted was **not allowable** for lack of inventive step
  - The **admissibility** of the auxiliary request was examined and denied in accordance with Art 13(1) RPBA

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1492/13** II
  - According to the Board of Appeal, the **respondent had to expect** that in view of the appeal
    - the **positive outcome** of the opposition proceedings in first instance could change,
    - as the **Board** was **in no way bound** by that decision
  - The **argument** put forward at the oral proceedings that the **defendant could not foresee** the Board of Appeal's **view**
    - and that the **auxiliary request** could therefore **only be submitted** in response to the Board's communication giving its preliminary view
      - **was not convincing** for the Board

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1492/13** **III**
  - In its **annex** to the summons, the Board **did not raise any new questions** which could justify such the late submission of a not insignificantly amended request containing features not yet discussed in the procedure
  - That the **amended claims** were based only on a **combination of granted** dependent claims
    - was **irrelevant**

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1869/15**
  - A **given issue** had been **raised**
    - at the **outset** of the opposition proceedings by Respondent/Opponent OII and
    - had been **identified as an issue** relating to Art 123(2) for discussion **in the annex to the summons** of the opposition division
  - Although **not forming part of the reasons** underlying the decision under appeal,
    - this matter **was again raised** by respondent/opponent OII **in its rejoinder** to the statement of grounds of appeal

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1869/15** II
  - Accordingly **there would have been a reason** to submit the amendment made in the present main request
    - **during** the opposition proceedings,
    - or **at the very latest**, following the reply of respondent/opponent OII to the statement of grounds of appeal
  - There is therefore **no justification** for the filing of that request after the communication of the Board,
    - in particular as **the Board did not raise any new issue** in that respect but merely gave a preliminary opinion based on the arguments advanced by the parties on that point



# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1869/15** III
  - The submission of this amendment at the **very end of the written** appeal **proceedings** in the form of the newly filed main **request introduces a new issue** to the appeal proceedings as it is now necessary - for the first time - to address the matter of Art 123(3)
  - This constitutes a **change of case** which, due to its nature **complicates the proceedings** both procedurally and substantively
  - Under these circumstances, the Board considers it appropriate to make use of the **discretion** permitted pursuant to Art 12(4) and 13(1) RPBA **not to admit the request** to the proceedings.

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1932/12**
  - In its statement of grounds of appeal, the proprietor/appellant has **reserved the right "to submit auxiliary requests** in time for the oral hearing before the Technical Board of Appeal"
    - However, it has **not provided any information** on their content
  - Auxiliary requests 1 and 2 were submitted **one month before** the oral proceedings
    - They therefore constitute **a change in the appellant's case** after filing its statement of grounds

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request not admitted***
- **T 1932/12** II
  - It is true that the auxiliary requests were **submitted before the expiry** of the period of one month specified in the summons before the oral proceedings
  - However, the **setting** of this time limit **may not be interpreted as a call for** the submission of new evidence or other documents
    - which **deviate from the legal and factual framework** of the questions and justifications which were **raised and substantiated** throughout the proceedings up to the oral proceedings in the appeal proceedings
  - Auxiliary requests 1 and 2 were **not admitted** in the procedure

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- *Limitation on a party amending its appeal case after the initial stage of the proceedings* Art 13(1) NRPBA
- *Amendment = new request not admitted*
- T 1932/12 III
- Comment
- Art 13(1) NRPBA has **de facto superseded** the **time limit** under R 116(1)
  - when there is **no change** in the legal and factual framework of the **appeal** proceedings

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new evidence not admitted***
- **T 1058/15**
  - The appellant/opponent did **initially not pursue** the objection of **novelty** raised in the opposition proceedings in the appeal proceedings,
    - but asserted it for the **first time shortly before** oral proceedings on the basis of a **new document D8**

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new evidence not admitted***
- **T 1058/15** **II**
  - The appellant/opponent did **initially not pursue** the objection of **novelty** raised in the opposition proceedings in the appeal proceedings,
    - but asserted it for the **first time shortly before** oral proceedings on the basis of a **new document D8**
  - The novelty objection on the basis of D8 is **not a completely new ground** for opposition
    - because **novelty** had **already** been **objected** to in the opposition proceedings
      - on the basis of **another document D1**

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- **Amendment = new evidence not admitted**
- **T 1058/15** III
  - The situation is nevertheless similar to that in **G 9/91** as the respondent/proprietor **does not have to expect** that a **further ground** for opposition will **only be raised** in appeal proceedings
  - Since the **respondent did not agree** to the admission of the new document D8 and in view of the **careless and very late submission** of this document and the related **very late reopening** of the objection of novelty
    - which **until then** had **not** been the **subject** of the appeal proceedings
    - the Board **decided**
      - **irrespective** of the relevance of the new document
      - to **exercise** its discretion under Art 13(1) RPBA
        - **not to admit** document D8 to the proceedings

# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request*** admitted
- **T 180/14**
  - The proprietor/appellant filed a **new main** request **shortly before** oral proceedings before the Board
  - The main argument to **justify** the **late filing** of the new main request was that the **new representative**
    - had only **taken over** the case recently and
    - had **become aware** of the erroneously filed main request **when preparing** for oral proceedings before the board
  - The board **does not** consider a **change in representative** to be an **acceptable justification** for filing the new main request at this very late stage of the appeal proceedings, namely **one month prior** to the oral proceedings before the board
    - This is also established case law of the boards of appeal



# New Rules of Procedure of the Boards of Appeal

## The second ring of convergence

- ***Limitation on a party amending its appeal case after the initial stage of the proceedings*** Art 13(1) NRPBA
- ***Amendment = new request*** admitted
- **T 180/14** II
  - The proprietor/appellant had first of all **requested** that the **amended main request** as well as the amended first to fourth auxiliary requests
    - should be considered as **obvious corrections** under R 139
  - Even if the original intention when filing the requests had been proven by the appellant
    - **corrected requests** could and should have been **filed immediately after** the appellant had become aware of the alleged error,
      - i.e. after receipt of the respondent's reply at the latest
  - A **corrected version** of the requests was however **not submitted until four and a half years later**,
    - after the appellant had been made aware of the error for the second time, this time by the board

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

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- **After a communication under R 100(2) or Summons to Oral Proceedings have been issued** Art 13(2) NRPBA
- The **basic principle** of the third ring of the convergence is that,
  - **at this stage** of the appeal proceedings,
    - **amendments** to a party's appeal case are
      - as a **matter of principle**
        - **not to taken into consideration**

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- **After a communication under R 100(2) or Summons to Oral Proceedings have been issued** Art 13(2) NRPBA
  
- Only two **exceptions** are foreseen
  - when the **Board expressly invites** a party **to file** observations within a period specified by the Board,
    - and the party **limits** its submissions **to the points** raised by the board
  - or
  - if **a party** is able to present **compelling reasons** which justify clearly why the **circumstances** leading to the **amendment** are indeed **exceptional**

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 100(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- ***Amendment = new requests not admitted***
- **T 1459/11**
  - The **purpose** of the communication of a board of appeal pursuant to **Art 15(1) RPBA** is to
    - it is **not an invitation** to the parties to
      - make further submissions or to
      - file further requests
- **T 475/14**
  - Similar content

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- ***Amendment = new requests not admitted***
- **T 1283/14**
  - The sole request of the applicant/appellant was **filed during** oral proceedings
  - There was **no apparent reason why** it could not have been filed earlier
    - A feature disputed under Art 83 and Art 84 was contained in all requests filed before the oral proceedings
  - A **high workload** of person in charge and a **short-term change** of said cannot be regarded as an excuse for late submissions

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- *After a communication under R 110(2) or Summons to Oral Proceedings have been issued* Art 13(2) NRPBA
- *Amendment = new requests not admitted*
- **T 1283/14** **II**
  - In addition, the belated request **should prima facie overcome** the present objections **without** raising new questions
    - **This criterion** for the admission of late submissions is also **not fulfilled**
    - **Replacing** an unclear feature **by** a negative statement which moreover is **not originally disclosed** raises new questions

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- ***Amendment = new evidence not admitted***
- **T 2180/16**
  - The opponent submitted **experimental** data in **reply** to the annex to the summons
  - The Board noted that the **experimental** data was **available 19 months before** being submitted at the EPO
    - It was very complex and voluminous (88 pages)
  - The experimental data was **not admitted**
  - Their admission would have led to a **postponement** of the oral proceedings in order for the proprietor to assess the validity of the data

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- ***Amendment = new evidence not admitted***
- **T 662/14**
  - More than **five months after** receiving the summons to oral proceedings and **only few weeks before** the date for which the oral proceedings had been scheduled,
    - the respondent put forward a **new line of attack** to the novelty of the claimed subject-matter **based on a new document**
  - The respondent **admitted** that the new evidence was **filed late**, but argued that the document could not have been submitted earlier because the respondent had been **unaware of it until shortly before** the oral proceedings



# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- ***Amendment = new evidence not admitted***
- **T 662/14**
  - For the Board, this **circumstance does not justify** the late filing of the new evidence as said document was a scientific publication
  - There is **no apparent reason** why said document could **not have been retrieved** by a search for the relevant state of the art carried out **when preparing the opposition or the response to** the appellant's statement of grounds of appeal, **at the latest**

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- *Amendment = new request* *admitted*
- **T 908/16**
  - A new main request was **filed during oral proceedings**
  - For the Board, contrary to appellant's view that the filing was not justified by any new objections,
    - the filing of the new main request **represents a reaction to the objections** raised for the first time by the Board in its annex to the summons and during the oral proceedings
  - This request **could thus not have been filed**
    - before the Opposition Division, nor
    - nor with the reply to the statement of grounds of appeal

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- ***Amendment = new request* *admitted***
- **T 908/16** **II**
  - Moreover, since the **amendments** made in the main request
    - **did not** make the claimed subject matter **complex**,
    - nor **raised issues** that the Board or the appellant could not reasonably address without postponement of the oral proceedings,
    - nor **prevented the appellant** from being able to present promptly all its observations/objections against these amendments
  - the Board **decided to admit** this request in the appeal proceedings

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
- ***Amendment = new evidence admitted***
- **T 1830/13**
  - After the summons to oral proceedings the opponent/appellant requested **admission of document D 21** which had been filed by a third party under Art 115
  - The document had **not gained much interest** after it was filed
  - In the annex to the summons the Board had indicated that it wanted to **dismiss** the documents filed by the third party
  - The Board changed its opinion, decided that Art 13(1) and 13(3) would not be applied and admitted D 21 in the procedure
  - The file was remitted to the first instance for further prosecution

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- ***After a communication under R 110(2) or Summons to Oral Proceedings have been issued*** Art 13(2) NRPBA
  
- **Situation in first instance** T 1543/12
  - The Appellant/Opponent argued that D 33 should have been admitted, because it has been filed **in direct response** to the **argumentation** given **in the summons** by the Opposition Division.
  
  - The fact that the Opposition Division expressed a preliminary opinion in its communication annexed to the summons of oral proceedings **does not necessarily justify the filing of new evidence**
    - **unless** this is **in reaction** to new aspects raised in the communication

# New Rules of Procedure of the Boards of Appeal

## The third ring of convergence

- *After a communication under R 110(2) or Summons to Oral Proceedings have been issued* Art 13(2) NRPBA
- Situation in first instance T 1543/12
  - As there were **no new aspects** raised in the communication,
    - and the document was **not considered prima facie relevant**
    - it was **not admitted** into the procedure by the opposition division
  - The Board also held that the **right to be heard** of the opponent had **not** been **violated**

# New Rules of Procedure of the Boards of Appeal

## Video or telephone conferences

- **Possibility foreseen but no modus operandi proposed**  
Art 12(1,e) NRPBA
- This Article mentions **video or telephone conferences** between a Board and parties,
  - but **no specific rules** of procedure for such video or telephone conferences are to be **found in** the NRPBA
- **Oral proceedings** in the form of video conferences are certainly not on the agenda

# New Rules of Procedure of the Boards of Appeal

## Transitional provisions

- **Very limited**
- The NRPBA will apply to all pending appeals with **two exceptions** Art 25(1) NRPBA
- **Art 12(4-6) NRPBA** – first ring of convergence- will **not apply** retrospectively **to** grounds of appeal or replies **filed before** the date of entry into force of the revised version,
  - **irrespective** of whether this period expires before, on or after the date of entry into force of the revised version  
Art 25(2) NRPBA



# New Rules of Procedure of the Boards of Appeal

## Transitional provisions

- **Very limited**
- The NRPBA will apply to all pending appeals with **two exceptions** Art 25(1) NRPBA
- **Art 13(2) NRPBA** – third ring of convergence- will **only apply** to a submission **filed after** the statement of grounds of appeal or a reply thereto if,
  - **at the date** of entry into force of the NRPBA,
    - **summons** to oral proceedings or a communication of the Board under R 100(2), **has not** been notified
  - Instead, Article 13 RPBA in the **version valid until** the date of the entry into force shall **continue** to apply

Art 25(2) NRPBA

# New Rules of Procedure of the Boards of Appeal

## Transitional provisions

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- **Very limited**
- **Any submission** which is **already on file**
  - **before** the entry into force of the revised version,
  - and which is **subsequent to** the statement of grounds of appeal **or** the reply thereto
  - will however be **subject to all the provisions** of new Art 13(1)
    - including the **analogous application** of new Art 12 (4) to (6)

# New Rules of Procedure of the Boards of Appeal

## The effect of the rings of convergence

- **The parties have to be pro-active at any procedural stage before the EPO**
- Submissions in first instance
- The **introduction** of the three rings of convergence has **increased the necessity** for the parties **to be pro-active** at any time during the procedure before the EPO
  - The longer a party waits for filing submissions the lower are the chances for those to be admitted
- **Independently** of the rules of convergence before the Boards of Appeal
  - submissions **can be late** even **before** the **first instance** and the latter can refuse to admit them
  - **Unless** the discretionary power in this matter has been **incorrectly exercised** the decision on admissibility **will not be overruled** by a Board of Appeal

# New Rules of Procedure of the Boards of Appeal

## The effect of the rings of convergence

- **The parties have to be pro-active at any procedural stage before the EPO**
- Submissions before the Boards of Appeal
- Failure to file appropriate submissions **in front of the first instance** cannot be overcome **when** entering appeal
  - **First** ring of convergence
- Any submission filed **after** the period for filing the statement of grounds of appeal or the reply thereto **will be severely scrutinised** as far as its admissibility is concerned
  - **Second** ring of convergence

# New Rules of Procedure of the Boards of Appeal

## The effect of the rings of convergence

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- **The parties have to be pro-active at any procedural stage before the EPO**
- Submissions before the Boards of Appeal
- Any **submission filed** after oral proceedings have been **summoned** or a communication has been issued by a Board
  - **is likely to be dismissed at once**
  - unless **exceptional circumstances** duly justified
  - or a **Board has invited the parties** to file a submission

# New Rules of Procedure of the Boards of Appeal

## The effect of the rings of convergence

- **Increase of the number of auxiliary requests in the procedures of first instance**
- In the explanatory notes the drafting committee acknowledges that as a **consequence** of the **convergent approach** implemented in Art 12 and 13 NRPBA,
  - it is to be **expected** that more issues will be raised and dealt with in the proceedings at first instance
  - Hence, this should reduce the need to remit cases
- It is manifest that the **number of auxiliary requests** filed in first instance will **increase**
  - **Even at present**, not filing, or worse, withdrawing a request in first instance, means that the chances for it to be admitted during appeal are very remote
    - They will be **even less** in the future

# New Rules of Procedure of the Boards of Appeal

## The effect of the rings of convergence

- Overall increase of the procedure for the EPO?
- Whether the efficiency of the whole procedure before the EPO will be increased remains thus to be seen
- During the discussion, the President of the Boards of Appeal indicated that the Boards have been in discussion with DG1 when revising the RPBA,
  - and that in any case, the President of the EPO is represented in the Board of Appeal Committee

# New Rules of Procedure of the Boards of Appeal

## You should not have waited

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- **Actions to be carried out until 01.01.2020**
- All cases should be **completely substantiated** in first instance
- Parties should **not expect** the Boards to **admit any change** in a case unless those are **duly justified** and properly reasoned
- **After summons** to Oral Proceedings having been issued
  - it will be **very difficult** to amend a case



# New Rules of Procedure of the Boards of Appeal

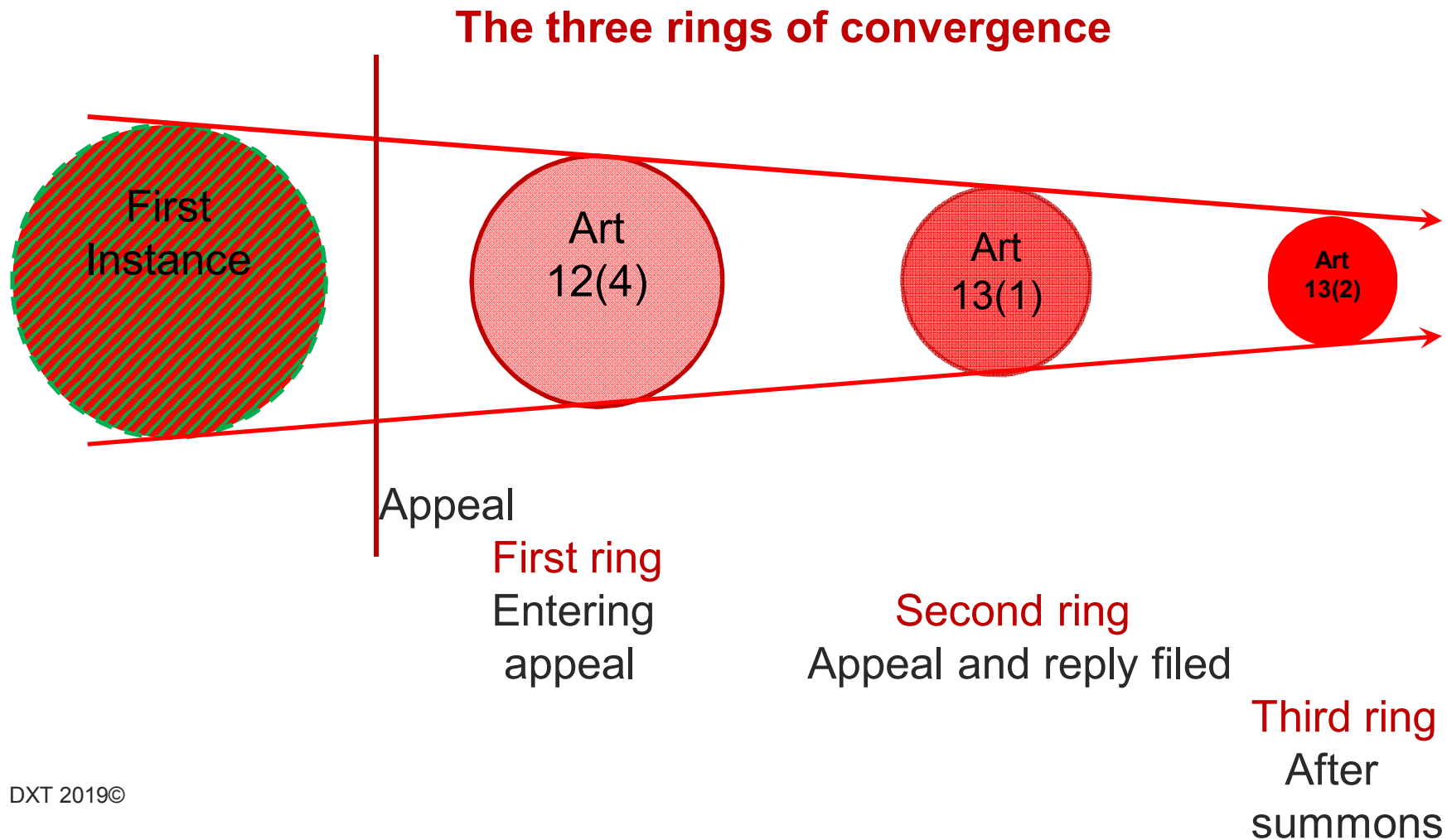
## You should not have waited

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- **Actions to be carried out until 01.01.2020**
- The advice given by the Boards of Appeal is to **review** the appeal **cases** from the beginning of 2019 onwards, and
  - **make all amendments** deemed necessary before January 2020,
    - so that a **smooth transition** for them and their clients
      - **is guaranteed** when the New Rules of Procedure actually enter into force on 01.01.2020

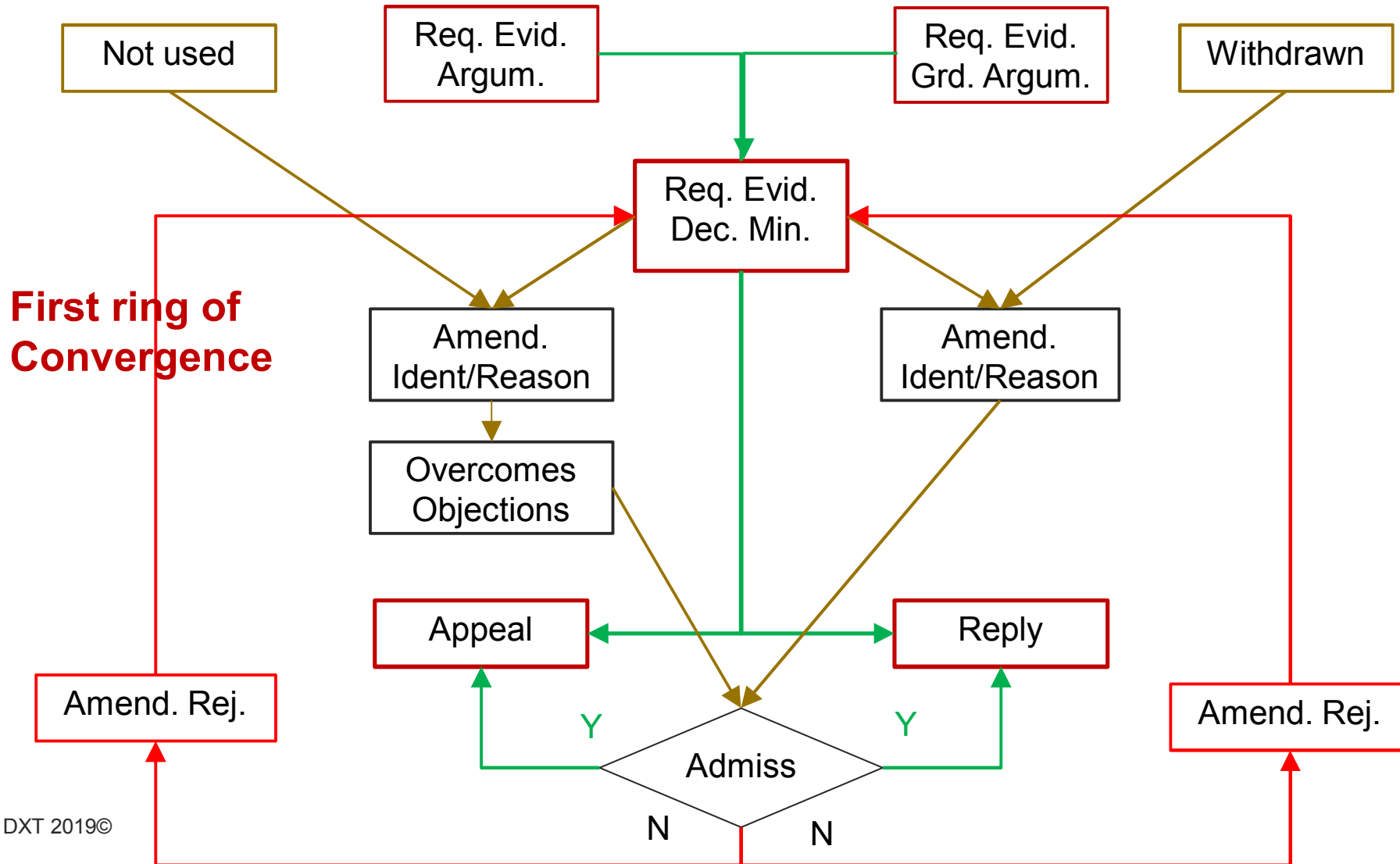
# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence



# New Rules of Procedure of the Boards of Appeal

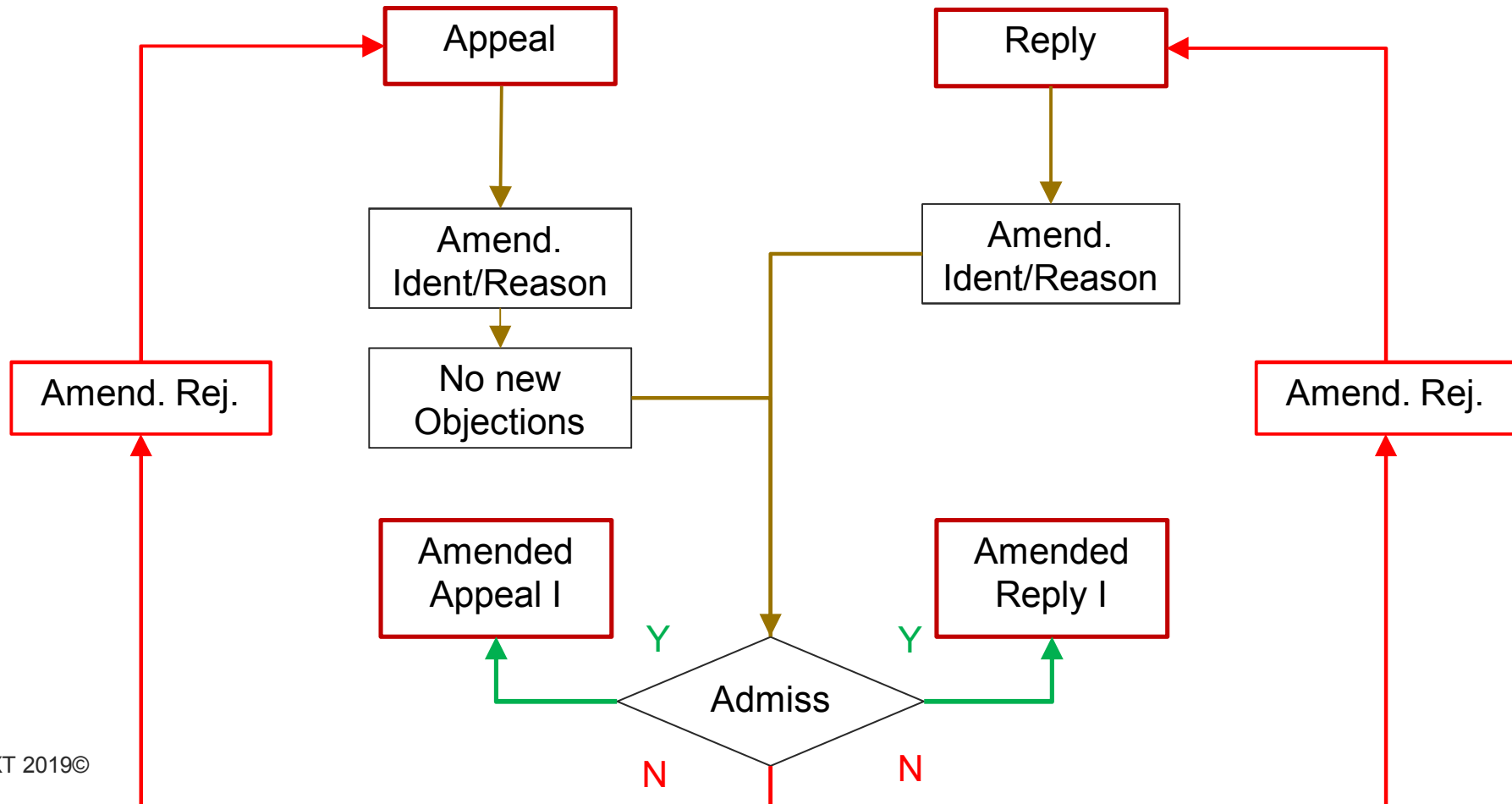
## The three rings of convergence – Flowchart I



# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence – Flowchart II

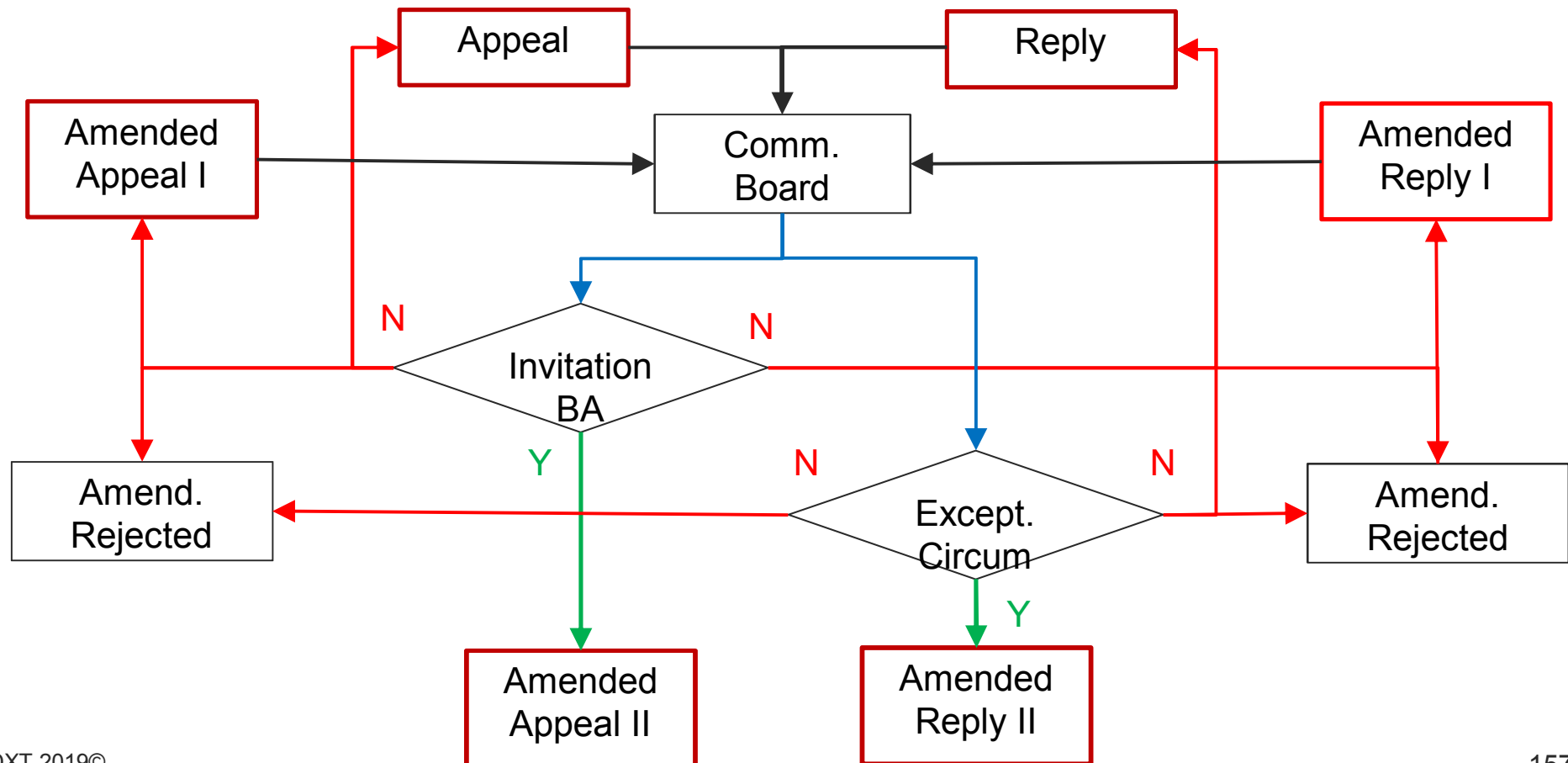
### Second ring of Convergence



# New Rules of Procedure of the Boards of Appeal

## The three rings of convergence – Flowchart III

### Third ring of Convergence



# **New Rules of Procedure of the Boards of Appeal**

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**Thank you for your attention**