



LATE EP OPPOSITION & APPEAL SUBMISSIONS

THE RISKS & WHY RESPONSIVENESS IS KEY

LAURA FE



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MURGITROYD

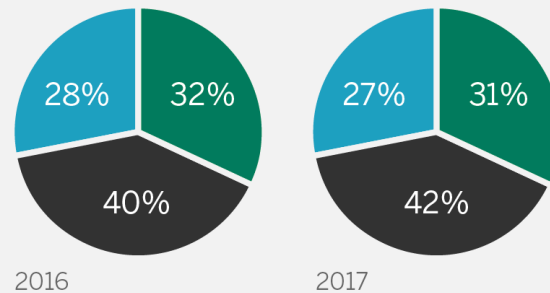


INTRODUCTION

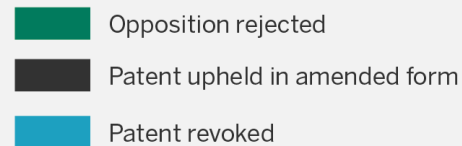
- In 2018 about 4000 patents were opposed, about 3% of the granted patents.

EPO Opposition Insights

Outcome of decisions



Between 2016 and 2017, the outcome of EPO opposition decisions remained relatively stable.

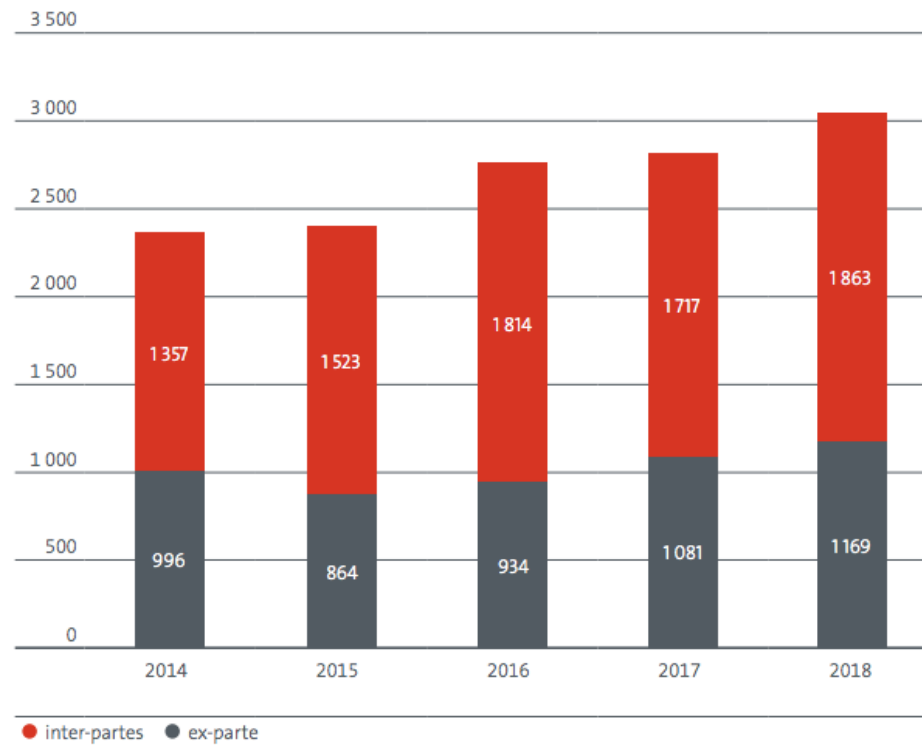


Source: EPO 2018, Five Year Overview



INTRODUCTION

- In 2018 about 1800 inter-partes OD decisions were appealed; 60% of the appeals were successful at least in part - EPO annual report 2018 – new cases





INTRODUCTION

- Factual framework, late submissions and Division/Board discretion
- Opposition and Appeal admissibility of
 - Late filed grounds (e.g. novelty, added subject matter)
 - Late filed facts and evidence (e.g. prior art documents, test results)
 - Late filed arguments (e.g. why a document anticipates a claim)
 - Late filed claim requests (e.g. new auxiliary claims sets)
- Proposed revision of the RPBA



FACTUAL FRAMEWORK

Legal measures in the EPC to facilitate procedural convergence to a final decision

- Opposition is POST-GRANT
- Grounds of Opposition restricted compared with pre-grant (e.g. lack of clarity and lack of unity of invention are not grounds of opposition under Art. 100)
- Time limits (9 months after grant)
- After expiry of 9 month opposition period, all submissions are prima facie LATE and may be disregarded



FACTUAL FRAMEWORK

EPO is not limited to facts, evidence and arguments raised by the parties (Art. 114(1) EPC), BUT may disregard facts or evidence which are not submitted in due time by the parties concerned (Art. 114(2) EPC)

After the 9 months opposition period the control of the FACTUAL FRAMEWORK effectively lies within the DISCRETION of the Opposition Division/Board of Appeal



DISCRETION

Exercise of DISCRETION to be reasoned on case-by-case basis (e.g. relevance, first or second instance, degree of procedural complication, objections from the other party)

- Case law of the Boards of Appeal IV.C.1.2 – 1.3 (T 1002/92)
- Guidelines, Part E VI-2 - General Procedural Matters
- Rules of Procedure of the Boards of Appeal especially Articles 12-15



LATE FILED GROUNDS

Opposition stage

According to G10/91, **exceptionally**, the opposition division can consider late filed grounds provided they are *prima facie* prejudicial to the maintenance of the patent

e.g. a document is novelty destroying without any further evidence being needed, but in case of implicit disclosure no *prima facie* relevance



LATE FILED GROUNDS

Appeal stage

The criteria of prima facie relevance does not apply in appeals

New grounds for opposition may be considered in appeal proceedings **only** with the approval of the patentee (G10/91)



LATE FILED GROUNDS

Appeal stage

...however

A late filed ground, not admitted by the OD but forming part of the OD decision may be admitted without the consent of the proprietor (T620/08)

A ground raised against an independent claim in OP and raised in AP against a different independent claim may be admitted (T1959/09 claims in the same category, T514/04 claims in different category)



LATE FILED GROUNDS

Appeal stage

A ground substantiated within the opposition period, not maintained during oral proceedings in opposition

if it is not mentioned in the OD decision it is a new ground;

if mentioned in the OD decision it is not a new ground and it may be taken up also by other appellants (T520/01).



LATE FILE GROUNDS

Recommendations as opponent

- invoke all grounds in the notice of opposition in spite of the unconvincing arguments you may have
- submit a new ground only with extensive explanation on why it is prima facie relevant
- refile in the notice of appeal any non admitted late filed ground, mentioning that the ground was already filed in OP



LATE FILED FACTS AND EVIDENCE

Opposition stage

Late submission may be admitted when filed in reply to an argument newly made by the other party or by the opposition division

e.g. experimental data to react to claims amended with a feature taken from the description

Late filed documents in support to common general knowledge are usually admitted



LATE FILED FACTS AND EVIDENCE

Opposition stage

In case the new submission is not a direct reaction to a new fact, **exceptionally**, the opposition division can admit late filed facts and evidence provided they are *prima facie* relevant to the maintenance of the patent (T1002/92)



LATE FILED FACTS AND EVIDENCE

At the Appeal stage decisions on admissibility are based on the RPBA

According to Art. 12(2) RPBA the statement of ground of appeal and the reply must contain a party's complete case (facts, evidence, arguments)

According to Art. 12(4) RPBA the board may hold inadmissible facts and evidence which could have been filed earlier (first instance) or were not admitted in first instance



LATE FILED FACTS AND EVIDENCE

Appeal stage

According to Art. 13(1) RPBA any amendment to a party's case may be admitted and considered at the board discretion (complexity of the new subject matter, procedural economy)

According to Art. 13(3) RPBA amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which cannot be expected to be dealt with without adjournment of the oral proceedings



LATE FILED FACTS AND EVIDENCE

T0662/14

New very relevant document filed after receiving the summons (not found before)

Document not admitted – In exercising the discretion under Art. 13(1) RPBA the Board has considered the late stage of proceedings, the need for procedural economy, the fact that the appellant objected to the admission. The alleged highly relevance of the document is a factor which **only in exceptional cases** justifies the admission of a new evidence



LATE FILED FACTS AND EVIDENCE

Recommendations as opponent

Invest enough time and recourses in filing the opposition

Submit a relevant document as soon as it is found

Submit a new document only with extensive explanations on why it is prima facie relevant

Timely consider whether experimental data are necessary



LATE FILED FACTS AND EVIDENCE

Recommendations as opponent or proprietor

Read carefully each letter from the other party and from the Division/Board and check if it contains new facts requiring your reaction and act immediately (e.g. new experiments may be required)



LATE FILED ARGUMENTS

Opposition stage

New arguments within the factual framework
may be brought in at any time

G 4/92 - GL E-II 8.3.3.2



LATE FILED ARGUMENTS

Appeal stage

A new argument which would have the effect of amending a party's case can only be introduced into the proceedings at the discretion of the Board – T 1621/09

Board has to admit new arguments – T 1914/12



LATE FILED ARGUMENTS

T0047/18

Appellant raised for the first time after oral proceedings were summoned objections to clarity and support of the amended set of claims allowed in opposition

New arguments were not admitted because they constituted an amendment to the party's case (T996/15 – T 682/11), they could have been raised earlier, they are not only new arguments they bring up new legal issues



LATE FILED CLAIM REQUESTS

Opposition stage

Claim requests filed in direct reaction to a new fact are usually admitted. However if an attack was made in the notice of opposition, repeated by the OD in the preliminary opinion and only then the patentee files an amended set of claims, the request may be refused

Further criteria of admissibility applied are clear allowability, complexity and convergence of amendments



LATE FILED CLAIM REQUESTS

Appeal stage:

Art.12(2) RPBA

The statement of grounds of appeal and the reply shall contain a party's complete case

Art.12(4) RPBA

During the entire proceedings the board has the discretion not to admit claim requests that could already have been filed in the opposition proceedings



LATE FILED CLAIM REQUESTS

Appeal stage

Art.13(1) RPBA any amendment to a party's case may be admitted and considered at the board discretion

Admissibility dependent on

- Complexity of the amendments (procedural and technical)
- State of the proceedings, procedural economy
- Clear allowability
- Convergence of the amendments



LATE FILED CLAIM REQUESTS

Appeal stage

After the summons to oral proceedings also Art. 13(3)RPBA comes into play

Claims requests that would require adjournment of the proceedings will not be admitted



LATE FILED CLAIM REQUESTS

Appeal Stage

These rules are usually followed strictly by the Boards of Appeal. In practice, however, some Boards of Appeal do allow a patentee to introduce new sets of claims during the course of an appeal, provided the amendments are straightforward and are in answer to an issue which has been recently raised for the first time in the proceedings.



LATE FILED CLAIM REQUESTS

Recommendations as proprietor

Consider carefully claims sets you file and withdraw in OP

New claim requests in appeal should be introduced with the grounds of appeal or in reply to those

When filing a new claim request make sure it is clearly allowable and convergent, the later in the proceedings the more important



LATE FILED CLAIM REQUESTS

Recommendations as proprietor

Analyse each opponent's objection and if it has some merits file an auxiliary request that overcomes the objections immediately, without waiting for the preliminary opinion of the Division/Board

Analyse each objection raised by the Division/Board and if it has some merits file an auxiliary request that overcomes the objections immediately



REVISION OF THE RPBA

In 2007, the Rules of Procedures of the Boards of Appeal (RPBA) were approved by the Administrative Council. In 2017, a project was launched to revise these Rules. A new draft was made available in 2018 and a consultation was done on December 5, 2018

EPO website/ Law & Practice/ Boards of Appeal / Communications

The draft RPBA will be finalised and presented to the Administrative Council for approval in the course of 2019. They may be expected to enter into force at the beginning of 2020.



REVISION OF THE RPBA

Proposed new **Art. 12(2)** clarifies that the object of appeal proceedings is to **judicially** review the decision under appeal, and states that a party's case should be directed to the arguments and evidence on which the first instance decision was based

Any arguments in the statement of grounds of appeal which extend beyond the facts and evidence on which the first instance decision was based are considered to be an amendment to the case and are only admitted at the discretion of the Board - **Art. 12(4)**



REVISION OF THE RPBA

Any amendment to a party's case after the initial stage (i.e. the grounds of appeal or reply) is subject to a party's justification - **Art. 13(1)**

Any amendment to a party's case at an advanced stage of proceedings (e.g. after issuance of a summons to oral proceedings) will only be taken into account in exceptional circumstances - **Art. 13(2)**

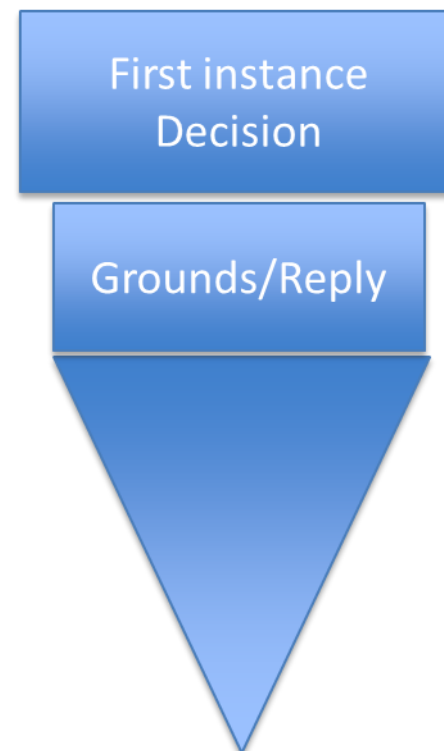


REVISION OF THE RPBA

Art. 12 – Basis of appeal
(decision/minutes,
grounds/reply) Amendment
when filing/replying to appeal

Art. 13(1) – Amendment before
summons or time-limit expiry of
a communication (R.100(2)
EPC)

Art 13(2) – Amendment after
summons or time-limit expiry of
a communication (R.100(2)
EPC)





REVISION OF THE RPBA

In essence

Appellants will have to put their complete case forward from the start, not just in the grounds of appeal but in the first instance proceedings, broadening the scope of the appeal later on will be even more difficult when the proposed changes come into force



CONCLUSIONS

As opponent

Invest enough time and resources in drafting the notice of opposition, performing a prior art search, producing experimental data, including all facts, evidences, and all grounds



CONCLUSIONS

As proprietor

React promptly to the opponent submission, experimental data may needed to be produced, submit as early as possible auxiliary requests that overcome the objections

Responsiveness is key in any opposition/appeal proceedings



**THANKS TO THE
AUDIENCE!**



Laura Fè
Senior Patent Attorney
Munich, Germany

T: +49 (0) 89 3090 7100
E: laura.fe@murgitroyd.com



Graham Murnane
Director, Patents
Glasgow, UK

T: +44 (0)141 307 8400
E: graham.murnane@murgitroyd.com

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