

The President of the Boards of Appeal and  
The Boards of Appeal Committee  
European Patent Office  
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30 April 2018

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## **Response to the consultation on the proposed revised Rules of Procedure of the Boards of Appeal first published draft dated 1 February 2018**

The Chartered Institute of Patent Attorneys (CIPA) is the professional and examining body for patent attorneys in the UK. CIPA represents virtually all the 2,400 registered patent attorneys in the UK, most of whom are also European patent attorneys, whether in industry or in private practice. Total membership is over 4,000 and includes judges, barristers, trainee patent attorneys and other professionals with an interest in intellectual property. CIPA represents the views of the profession to policy makers at national, European and international level, with representatives sitting on a range of influential policy bodies and working groups in the UK and overseas.

### **Introductory Comments**

CIPA welcomes the proposal to revise the Rules of Procedure of the Boards of Appeal (“the Rules”), and supports revisions which have the effect of:

- reducing the pendency and backlog of appeal cases;
- increasing efficiency, clarity and fairness of proceedings for all parties;
- maintaining the independence of the Boards of Appeal;
- increasing consistency between Boards, for both *ex parte* and *inter partes* appeals; and
- increasing consistency between Boards and first instance Divisions,

whilst maintaining the high quality of the Boards’ decisions.

The Explanatory Remarks are helpful and CIPA wonders whether parts could be incorporated into the Rules themselves rather than in the form of an additional document. Specific suggestions are set out below, but are not exhaustive.

CIPA agrees with expressing the primary object of appeal proceedings as set out at proposed revised Article 12(2), but feels that “to judicially review” is unclear and suggests reference to “to review of the correctness of” or similar.

CIPA supports the view of IP Inclusive that the wording of the Rules should be gender neutral.

In addition to the commentary below on specific proposals for revision, CIPA supports the general principle of the concept of enhanced case management as discussed, for example, in Mr Chris Mercer and Mr Maarten Nollen's article<sup>1</sup> regarding these proposals, and would urge further development of an appropriate process.

## **Specific Comments**

The numbering below refers to proposed revised Rules.

### **Article 4**

(1) This article should confirm that the decisions on admissibility are made by the Board.

### **Article 10**

CIPA would support the introduction of a publicly available "list" of pending appeals within which individual appeals could be moved depending on for example acceleration status. This could provide transparency in cases such as the overload of a Board foreshadowed in the Explanatory Remarks. Examples of criteria for acceleration are set out in the Explanatory Remarks but should be recited as non-exhaustive examples in the Article itself, to avoid abuse. The Article should indicate the need for balance between parties in the case of *inter partes* proceedings. A case management conference could be used to achieve procedural efficiency and fairness in relation to discussions of acceleration.

### **Article 12**

(1)(a) Reliance on the first instance minutes is welcomed. For clarity of proceedings, and consistency between Boards and Divisions, the minutes of any first instance decision should be formulated so as to permit simplified application of Article 12(4) (identification of "amendment" of submissions).

(2) As discussed above, CIPA finds the phrase "to judicially review" unclear and instead suggests reference to "to review of the correctness of" or similar.

(3) The term "objections" should be clarified as set out in the Explanatory Remarks.

(4) The underlying purpose of the proposal to have three levels of convergence is supported to the extent that it permits the Boards to meet the objectives identified in the Introductory Comments above. However, especially in *inter partes* appeals, there is a risk that proceedings could be prolonged and made more complex by wrangling between parties and the Boards over admissibility. Identification of an amended "argument" may be particularly challenging. Effective use of enhanced case management, possible in conjunction with a more vigorous costs regime, could mitigate this risk. We would suggest consolidating the provisions in a single note.

<sup>1</sup> epi Information 01/18, March 2018, pages 14 to 17

### **Article 13**

(2) The wording is not clear enough. The rule should state explicitly that the Board may issue a communication setting a period after which the third level conditions apply.

### **Article 15**

(1) Mandatory issuance of pre-hearings comments is essential and welcomed. If these are representative of the entire Board's preliminary views, the time taken in preparing them is likely to be more than regained in the subsequent efficiencies achieved. For example, they could serve as the basis of a highly effective case management procedure. Generally, close observance of Rule 116 EPC is, we believe, essential.

(2) Omission of religious holidays is significant and potentially discriminatory. The Guidelines for Examination set out a list of criteria that appears to meet with general support; can this list not be replicated? Additionally, if the party is represented, as the serious reasons must relate to the representative and not the party, this could disadvantage parties who wish to attend oral proceedings but are unable to do so for one of the serious reasons.

(7) It is not clear that the option of an abridged written decision, even with all parties' consent, is in the public interest, both in relation information regarding the appeal in question, nor for creating jurisprudential guidance for future appeals.

(9)(a) Further significant shortening of the period for issuing the written decision could improve efficiency. It should not be necessary to reflect on the decision which has already been made, nor its reasoning; on the other hand, writing it up in the immediate aftermath of the hearing while it was still "fresh" would seem procedurally wise. We believe that it should be mandated that the minutes should be provided at the same time, as a matter of best practice and in case a petition for review by the Enlarged Board is filed.

### **Article 16**

(1) The amendment is welcomed. CIPA understands that costs provisions are invoked only rarely, and recognises that procedurally they are complex to enforce. However, the abuses referred to in (1)(e) may increase as more procedural "tricks" now become available (disputes over admissibility etc.) such that an investigation into more robust costs imposition and enforcement may be merited.

### **Article 25**

In view of the impact of the proposed changes to the Rules on first instance procedures, for example the increased difficulty of introducing "new" requests at appeal, greater lenience in the transitional provisions may be merited, for example in relation to acts committed at first instance prior to entry into force of the revised rules.

## **Conclusion**

CIPA would be happy to provide additional detail on any points raised above, in any appropriate form, and would welcome the opportunity for continued interaction and consultation on this important revision.

Yours faithfully

A handwritten signature in black ink, appearing to read 'S. Jones', written in a cursive style.

Stephen Jones  
President, CIPA