



30 September 2010

To:  
epi  
The President  
Mr. Kim Finnilä  
c/o epi secreteriat  
P. O. Box 260112  
D-80058 Munich  
Germany

Letter sent via e-mail to:  
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### Procedures before the EPO Boards of Appeal

Dear Mr. Finnilä,

The Association of IP Professionals in Swedish Industry<sup>1</sup> (SIPF) would hereby like to submit our comments regarding our view on national court procedures as compared with the procedures before the EPO Boards of Appeal. For the sake of simplicity the Swedish Court of Patent Appeals, Patentbesvärsträtten, will hereinafter be referred to as PBR.

#### Question 1

What are your views on the time it takes from the start of a procedure until a decision is delivered when comparing a national court case to an EPO appeal case?

#### **Comment on Question 1**

In general it is considered that the time from start of a procedure until a decision is delivered is acceptable, both in PBR and before the EPO Boards of Appeal. However, an attempt of decreasing the time would be seen as a positive driver from the users. Having said this it is however important that if the procedural time is shortened this is done in such a way that the legal rights of the parties is not compromised.

When looking at the differences between procedures before the EPO Boards of Appeal and before the PBR, the most noticeable difference is that the EPO Boards of Appeal take a decision at the closing of the oral proceedings whereas the PBR generally takes a decision

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<sup>1</sup> The Swedish name of the association is "Svenska Industrins IP Förening". The association was founded in 1939 and currently has more than 400 members working with intellectual property for a wide range of companies in Sweden.

**SVENSKA INDUSTRIERNS IP FÖRENING**  
*Association of IP Professionals in Swedish Industry*



long after the oral proceedings (often up to several months after the oral proceedings were held).

In view of this, procedures before the EPO Boards of Appeal currently seem to be shorter than those before the PBR. The PBR aims at a processing time of a case of around 1 year, at present this goal is not reached since statistics show that due to an increased flux of cases the processing time in Sweden has increased from 1,5 years in 2005 to 2,6 years in 2008 and 2009. The corresponding time before the EPO Boards of Appeal is at present 25 months. Accordingly both procedures appear to be of approximately equal length.

Although the processing time before both instances appear to be quite similar, we prefer that a decision is reached at the end of the proceedings since this has a positive impact onto the way oral proceedings are held and onto its preparation by the parties involved. A further advantage is that the members of a the EPO Boards of Appeal appear in general to be more interactive during the oral proceedings with the aim to address all necessary questions during the proceedings in order to be able to make a decision at the end thereof. The advantage of this procedure is that the final decision is not based on new arguments or facts to which the parties involved had no opportunity to express their view during the proceedings while – opposite hereto – it is not unlikely that this may occur in decisions coming from the PBR.

#### Question 2

Should the date for oral proceedings be set as early as possible?

What are your experiences with regard to national courts and EPO Boards of Appeal in this matter?

#### **Comment on Question 2**

In our view a date for oral proceedings should be set at an early phase of the proceedings but it should not be set before all parties have been given an opportunity to present their case and declare their standpoint. To fix a date for oral proceedings already at the beginning of an appeal case, as is sometimes done by the PBR today, is in our opinion too inflexible.

When setting a date for oral proceedings it should be communicated to the parties at least six months in advance. This is standard at the PBR whereas lately there have been some cases where the EPO Boards of Appeal have summoned to oral proceedings less than three months in advance and this is generally unacceptable unless the case is already prepared properly by the parties and that it requires no further substantive work.

One further advantage of the PBR is that it is rather easy to predict approximately when a case will be summoned, while at the EPO Boards of Appeal it depends on the general workload of the individual Board concerned and thus it is more or less impossible to predict.

#### Question 3

Are national judges less or more interactive in oral proceedings than EPO Boards of Appeal members?

### **Comment on Question 3**

It is difficult to provide a general statement regarding the PBR since there is a large variation as to how interactive the members are whereas all members of the EPO Boards of Appeal are considered to be very interactive. One reason for this may be that before the PBR the oral proceedings are only one part of the procedure leading up to a decision whereas the EPO Boards of Appeal generally strive to reach a decision at the closing of the oral proceedings. In general the interactivity of the PBR and the EPO Boards of Appeal is considered very positive since it increases the probability that all necessary issues have been addressed and that all parties have had a chance to comment on the issue, also it decreases the risk of misunderstandings amongst the parties involved.

On the other hand, in some instances some parties involved may perceive that the EPO Boards of Appeal might have a rather strong opinion about the case already before the oral proceedings are held. In such cases the Boards interactivity might be perceived as an attempt of the Board to push the case towards a certain conclusion and not to provide the parties with a final chance to present their arguments. The oral proceedings are supposed to be the venue to discuss a case before a final decision is made and not just a pronouncement date where the decision is delivered to the parties.

Another possible downside is that since the EPO Boards of Appeal are supposed to reach a conclusion at the end of the oral proceedings the decision making is sometimes rushed. In cases where a very complex case is to be discussed or many parties are involved it would be desirable to, more often than is currently the case today, summon the oral proceedings for two days instead of only one day.

### **Question 4**

What aspects of a national court procedure or an EPO Boards of Appeal procedure make one preferable over another?

### **Comment on Question 4**

There are advantages with both the PBR and the EPO Boards of Appeal procedures.

#### **Advantages of the EPO Boards of Appeal compared to the PBR**

- Due to the fact that a decision must be reached at the end of the oral proceedings the EPO Boards of Appeal are very interactive during the oral proceedings and this is generally seen as something very positive.

#### **Disadvantages of the EPO Boards of Appeal compared to the PBR**

- The individual chairmen seem to have a very high influence onto the decisions of the EPO Boards of Appeal. It would be appreciated if the discussion and exchange

of opinions between individual Boards' to issues of more general nature could be intensified in order to achieve better harmonisation in decision making at the EPO. Examples of existing rather big differences in the interpretation of the law between Boards are (i) added subject-matter and (ii) claim interpretation; some Boards interpret the claims rather narrow using the description as explicit base whereas other Boards interpret the claims in a very broad manner. These variations make it difficult for the parties to prepare a strategy to meet the objections raised and also to predict the outcome of the proceedings since it depends on which Board will handle the case.

- The PBR tends to look at each claim on its own merits whereas the EPO Boards of Appeal instead often take a more general approach. If the Boards consider that a patent is of poor quality, they will revoke it, regardless of the limitations of the individual claims. They are often not prepared to closely examine a complicated case, and instead tend to “take the easy way out” and revoke a patent if the alternative would be to for example closely examine a lot of added subject matter issues. National courts, on the other hand, strive to reach a fair decision, based on what the person skilled in the art actually knew at the time of filing, with the patent being upheld in some form if it has patent merits, even if this means a lot of work. This is of course better for the patent proprietor. One of the reasons why the EPO Boards of Appeal take on a more general approach could be due to procedural efficiency and that a decision is generally supposed to be reached at the end of the oral proceedings. To avoid such “hurried” and generalized decisions we would like to see that where a very complex case is to be discussed or many parties are involved it would be desirable to, more often than is currently the case today, summon a two day hearing instead of only one.
- Some parties experience that the EPO Boards of Appeal can at times be quite formal and have excluded, otherwise allowable, auxiliary requests on the basis that said requests was filed at a late stage. This exclusion of requests has at times lead to revocation of a patent which might otherwise have been maintained had said request been filed at an earlier stage.

An example:

*A patent is upheld before the Opposition Division, and the opponent appeals this decision without stating any new facts. When responding to the grounds of appeal, the proprietor does not file any auxiliary requests, because it is impossible to predict what kind of requests could be warranted. The Board of Appeal later issues a negative opinion, and the auxiliary requests filed as a response to this opinion (before the due date for the final submission) are viewed as late filed, because they were not filed at the beginning of the appeal process.*

During the past few years, many patents have been revoked in this way. However, at times we feel that it is not possible for the proprietor to predict the direction an appeal procedure may take and in these specific instances some leeway for the patent proprietor should be given to file an auxiliary request(s). Such requests



should only be allowed at a later stage with the proviso that the new request(s) meet all requirements for patentability.

- The appeal fee before the EPO Boards of Appeal is 1180 Euro whereas there is no appeal fee before the PBR.

#### Question 5

How do you find that auxiliary requests are dealt with before national courts as compared with before the EPO Boards of Appeal?

#### **Comment on Question 5**

In both proceedings, before PBR and before the EPO Boards of Appeal, auxiliary requests can be filed and will be dealt with in turn. The difference between the systems lies in the filing of auxiliary requests at a late stage, where these are more likely to be accepted before the PBR than before the EPO Boards of Appeal. Although abuse of process should be avoided, we feel that in some instances the Boards have been overly strict when not allowing requests filed at a later stage.

Sincerely,

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

Maria Mellgren

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