

# Decision of the Administrative Council of 25 October 2007 approving amendments to the Rules of Procedure of the Boards of Appeal of the European Patent Office (CA/D 35/07)

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention, and in particular Article 23, paragraph 4, thereof,

Having regard to the amendments to the Rules of Procedure of the Boards of Appeal, adopted on 12 September 2007 under Rule 10, paragraph 3, of the Implementing Regulations to the European Patent Convention,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

The amendments to the Rules of Procedure of the Boards of Appeal, as shown in the Annex to this decision, are hereby approved.

Done at Munich, 25 October 2007

For the Administrative Council  
The Chairman  
*Roland GROSSENBACHER*

## **ANNEX**

### **DECISION**

Amendments to the Rules of Procedure of the Boards of Appeal, OJ EPO 1983, 7 as amended in OJ EPO 1989, 361, OJ EPO 2000, 316, OJ EPO 2003, 61, OJ EPO 2003, 89 and OJ EPO 2004, 541

In accordance with Rule 10, paragraph 3, of the Implementing Regulations to the European Patent Convention, the Presidium amends the Rules of Procedure of the Boards of Appeal. These amended Rules of Procedure read as follows:

#### **Article 1**

Business distribution and composition

(1) The Presidium referred to in Rule 12, paragraph 4, EPC, shall before the beginning of each working year draw up a business distribution scheme for the distribution among the Boards of Appeal of all appeals that may be filed during the year, designating the members who may serve on each Board and their respective alternates. The scheme may be amended during the working year.

(2) The Chairman of each Board of Appeal shall determine the composition of the Board for each

particular case in accordance with the business distribution scheme.

## **Article 2**

### Replacement of members

- (1) Members shall be replaced by alternates if they are prevented from participating, particularly as a result of sickness, excessive workload, and commitments which cannot be avoided.
- (2) Any member requesting to be replaced by an alternate shall inform the Chairman of the Board concerned of his unavailability without delay.
- (3) The Chairman of the Board may designate another member of the Board to replace him or her as Chairman in a particular appeal in accordance with the business distribution scheme.

## **Article 3**

### Exclusion and objection

- (1) If a Board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings, then the procedure of Article 24, paragraph 4, EPC shall be applied.
- (2) The member concerned shall be invited to present his comments as to whether there is a reason for exclusion.
- (3) Before a decision is taken on the exclusion of the member, there shall be no further proceedings in the case.

## **Article 4**

### Procedural compliance

- (1) The Chairman shall for each appeal designate a member of the Board or himself to consider the admissibility of the appeal.
- (2) The Chairman or a member designated by him shall ensure that the parties comply with these Rules and with directions of the Board and shall propose action to be taken as appropriate.

## **Article 5**

### Rapporteurs

- (1) The Chairman of each Board shall for each appeal designate a member of his Board, or himself, as rapporteur. If appropriate in the light of the subject-matter of the case, the Chairman may designate an additional rapporteur.
- (2) If an additional rapporteur is appointed, the steps referred to in paragraphs 3 to 5 shall be taken by the rapporteur and additional rapporteur jointly unless the Chairman directs otherwise.
- (3) The rapporteur shall carry out a preliminary study of the appeal and may prepare communications to the parties subject to the direction of the Chairman of the Board. Communications shall be signed by the

rapporteur on behalf of the Board.

(4) The rapporteur shall make the preparations for meetings of the Board and for oral proceedings.

(5) The rapporteur shall draft decisions.

(6) If a rapporteur or additional rapporteur considers that his knowledge of the language of the proceedings is insufficient for drafting communications or decisions, he may draft these in one of the other official languages. His drafts shall be translated by the European Patent Office into the language of the proceedings and the translations shall be checked by the rapporteur or by another member of the Board concerned.

## **Article 6**

### Registries

(1) Registries shall be established for the Boards of Appeal. Registrars shall be responsible for the discharge of the functions of the Registries. One of the Registrars shall be designated Senior Registrar.

(2) The Presidium referred to in Rule 12, paragraph 1, EPC may entrust to the Registrars the execution of functions which involve no technical or legal difficulties, in particular in relation to arranging for inspection of files, issuing summonses to oral proceedings and notifications and granting requests for further processing of applications.

(3) The Registrar shall report to the Chairman of the Board concerned on the admissibility of each newly filed appeal.

(4) Minutes of oral proceedings and of the taking of evidence shall be drawn up by the Registrar or such other employee of the Office as the Chairman may designate.

## **Article 7**

### Attendance of interpreters

If required, the Chairman of any Board shall make arrangements for interpretation during oral proceedings, the taking of evidence or the deliberations of his Board.

## **Article 8**

### Change in the composition of the Board

(1) If the composition of a Board is changed after oral proceedings, the parties to the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. Fresh oral proceedings shall also be held if so requested by the new member and if the other members of the Board concerned have given their agreement.

(2) Each new member shall be bound to the same extent as the other members by an interim decision which has already been taken.

(3) If, when a Board has already reached a final decision, a member is unable to act, he shall not be replaced by an alternate. If the Chairman is unable to act, the member of the Board concerned having the longer or longest service on the Boards of Appeal, or in the case where members have the same length of service, the elder or eldest member, shall sign the decision on behalf of the Chairman.

## **Article 9**

### Enlargement of a Board of Appeal

If a Board of Appeal consisting of two technically qualified members and one legally qualified member considers that the nature of the appeal requires that the Board should consist of three technically qualified members and two legally qualified members, the decision to enlarge the Board shall be taken at the earliest possible stage in the examination of that appeal.

## **Article 10**

### Consolidation of appeal proceedings

- (1) If several appeals are filed from a decision, these appeals shall be considered in the same proceedings.
- (2) If appeals are filed from separate decisions and all the appeals are designated to be examined by one Board in a common composition, that Board may deal with those appeals in consolidated proceedings with the consent of the parties.

## **Article 11**

### Remission to the department of first instance

A Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

## **Article 12**

### Basis of Proceedings

- (1) Appeal proceedings shall be based on
  - (a) the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC;
  - (b) 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;
  - (c) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board.
- (2) The statement of grounds of appeal and the reply shall contain a party's complete case. 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 facts, arguments and evidence relied on. All documents referred to shall be
  - (a) 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;
  - (b) filed in any event to the extent that the Board so directs in a particular case.
- (3) Subject to Articles 113 and 116 EPC the Board may decide the case at any time after filing of the statement of grounds of appeal or, in cases where there is more than one party, after the expiry of the time limit in (1)(b).

(4) Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2).

(5) Extension of time limits may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request.

### **Article 13**

Amendment to a party's case

(1) Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

(2) Other parties shall be entitled to submit their observations on any amendment not held inadmissible by the Board ex officio.

(3) Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

### **Article 14**

Interventions

Articles 12 and 13 shall apply mutatis mutandis to interventions commenced while an appeal is pending.

### **Article 15**

Oral Proceedings

(1) If oral proceedings are to take place, the Board may send a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings.

(2) A change of date for oral proceedings may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request made as far in advance of the appointed date as possible.

(3) The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case.

(4) The Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct.

(5) When a case is ready for decision during oral proceedings, the Chairman shall state the final requests of the parties and declare the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to re-open the debate.

(6) The Board shall ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary. Before the oral proceedings are closed, the decision may be announced orally by the Chairman.

## **Article 16**

### Costs

(1) Subject to Article 104, paragraph 1, EPC, the Board may on request order a party to pay some or all of another party's costs which shall, without limiting the Board's discretion, include those incurred by any

(a) amendment pursuant to Article 13 to a party's case as filed pursuant to Article 12, paragraph 1;

(b) extension of a time limit;

(c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings;

(d) failure to comply with a direction of the Board;

(e) abuse of procedure.

(2) The costs ordered to be paid may be all or part of those incurred by the receiving party and may *inter alia* be expressed as a percentage or as a specific sum. In the latter event, the Board's decision shall be a final decision for the purposes of Article 104, paragraph 3, EPC. The costs ordered may include costs charged to a party by its professional representative, costs incurred by a party itself whether or not acting through a professional representative, and the costs of witnesses or experts paid by a party but shall be limited to costs necessarily and reasonably incurred.

## **Article 17**

### Communications to the parties

(1) In the written phase of proceedings, replies to requests and directions on matters of procedure shall be given by means of communications.

(2) If a Board deems it expedient to communicate with the parties regarding a possible appreciation of substantive or legal matters, such communication shall be made in such a way as not to imply that the Board is in any way bound by it.

## **Article 18**

### EPO President's right to comment

The Board may, on its own initiative or at the written, reasoned request of the President of the European Patent Office, invite him to comment in writing or orally on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the President's comments.

## **Article 19**

### Deliberation and voting

(1) If the members of a Board are not all of the same opinion, the Board shall meet to deliberate regarding the decision to be taken. Only members of the Board shall participate in the deliberations; the Chairman may, however, authorise other officers to attend. Deliberations shall be secret.

(2) During the deliberations between members of the Board, the opinion of the rapporteur shall be heard first, followed by that of the additional rapporteur if one has been appointed and, if the rapporteur is not the Chairman, the Chairman's last.

(3) If voting is necessary, votes shall be taken in the same sequence; even if the Chairman is the rapporteur, he shall vote last. Abstentions shall not be permitted.

## **Article 20**

Deviations from an earlier decision of any Board or from the Guidelines

(1) Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention given in an earlier decision of any Board, the grounds for this deviation shall be given, unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board of Appeal. The President of the European Patent Office shall be informed of the Board's decision.

(2) If, in its decision, a Board gives a different interpretation of the Convention to that provided for in the Guidelines, it shall state the grounds for its action if it considers that this decision will be more readily understood in the light of such grounds.

## **Article 21**

Deviation from an earlier decision or opinion of the Enlarged Board of Appeal

Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board of Appeal, the question shall be referred to the Enlarged Board of Appeal.

## **Article 22**

Referral of a question to the Enlarged Board of Appeal

(1) If a point is to be referred to the Enlarged Board of Appeal, a decision to this effect shall be taken by the Board concerned.

(2) The decision shall contain the items specified in Rule 102, sub-paragraphs (a), (b), (c), (d) and (f), EPC and the point which the Board refers to the Enlarged Board of Appeal. The context in which the point originated shall also be stated.

(3) The decision shall be communicated to the parties.

## **Article 23**

Binding nature of the Rules of Procedure

These Rules of Procedure shall be binding upon the Boards of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention.

## **Article 24**

Entry into force

These Rules of Procedure shall enter into force upon entry into force of the revised text of the European Patent Convention in accordance with Article 8 of the Revision Act.

Done at Munich on 12 September 2007

For the Presidium

The Chairman

*Peter MESSERLI*

