

Appeal proceedings at the EPO

Knowing a little about the procedure can make matters run more smoothly if you find yourself involved in filing and prosecuting an appeal at the European Patent Office (EPO).

A little background

An appeal can be filed to dispute almost any decision taken by the EPO. The appeal may be *ex parte* (between the EPO and the applicant only) or *inter partes* (between the applicant, the EPO, and one or more third parties, E.g., following an opposition).

Appeal proceedings are conducted before a Board of Appeal, which consists of at least three members of the EPO who are completely unrelated to the members of the EPO whose decision is being appealed.

Appeal proceedings are the last instance of proceedings before the EPO. This means that the decision the Board of Appeal reached is final and cannot be appealed.

The Enlarged Board of Appeal

Occasionally, a Board of Appeal will refer a question to the Enlarged Board of Appeal. The enlarged board is not a higher instance court, and a referral should not be considered a further avenue for appeal. The enlarged board can only decide questions relating to the uniform application of law or the interpretation of law and not questions relating to the particular issues of a case.

Appeal proceedings will be suspended while the enlarged board reaches a decision. Once it has reached an answer to the Board of Appeal's question, the answer will be remitted to the board to allow appeal proceedings to continue.

When considering filing an appeal, the following is important

Only a person who was a party to the first instance proceedings may appeal against a decision. Successors in title to a patent/patent application/party to the proceedings must be considered carefully, as they can significantly impact the filing of an appeal.

A party must be adversely affected by the decision to be able to file an appeal. The EPO take this to mean that the decision must disagree with an explicit request of that party.

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The word 'decision' is important, as a document that does not decide anything cannot be appealed.

Step one: file notice of appeal

Notice of appeal from a decision must be filed within two months from the date the decision is notified. This is the date on the letter from the EPO, plus the EPO's ten-day postal rule. This period is not extensible.

A notice of appeal must detail the name and address of the party filing the appeal and set out in brief the decision being appealed and the extent of the appeal, for example, all or part of the decision.

The notice of appeal carries an official fee, and both the fee and the notice of appeal must reach the EPO before the deadline, or the appeal is deemed not to have been filed.

The cost for this first stage of the appeal process is of the order of £2,000-£2,500. A reduced official fee is payable to private individuals and certain non-profit organisations, such as universities.

Step two: prepare and file grounds for appeal

The notice of appeal must be supported by a statement of grounds, which must be filed within four months from the date the decision is notified. It is vital to set out as complete a case as possible initially. It is not sufficient to state that the decision is wrong – legal and factual reasons why the decision should be set aside must be included.

New arguments, amendments and even prior art can be raised on appeal, but the Board of Appeal will always determine whether these should be admitted, and fairness to all parties is something they must consider.

In *inter partes* proceedings, if only one party appeals (E.g., the opponent), then the other party will be automatically joined in the appeal proceedings and entitled to respond to the arguments put forward by the appealing party. However, where the patentee is the non-appealing party, the patentee will not be permitted to make amendments to the claims during the appeal that would put them in a better position than before the appeal was filed.

Typically, the cost of preparing and filing grounds of appeal is in the order of £2,000-£8,000, depending on the complexity of the issues.

A summary of the procedure and some estimated costs

The division that made the decision under appeal (E.g., the Examining Division) will review the appeal initially and their own decision. If the appeal addresses all the issues that lead to their adverse decision, that division can allow the appeal and overturn the earlier decision (interlocutory revision).

More commonly, however, the appeal will only address some of the issues and will be sent to a Board of Appeal to be considered in full.

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The Board of Appeal will assess the appeal's admissibility and allowability. If the appeal does not meet the minimum formal requirements (E.g., if the appeal fee was not paid in time), it will be rejected without substantive review.

If the appeal is deemed admissible, the Board of Appeal *"shall invite the parties, as often as necessary, to file observations"*. This usually means the Board will send the applicant an opinion on the appeal, and the applicant will be allowed to comment on the Board's opinion. Typically, the cost of commenting on the Board's opinion will vary depending on the complexity of the issues and whether the initial opinion is in the appellant's favour. The cost can, therefore, vary between zero, if no further comments are needed, to around £5,000 if a detailed analysis and rebuttal is required.

Appeal proceedings usually terminate in an oral hearing if one or both parties have requested oral proceedings. However, the proceedings can take place in writing if both parties agree.

The Board may issue further opinions before summoning the applicant to oral proceedings or a summons immediately after the first opinion. Several years can, therefore, pass between filing the initial notice of appeal and a date being scheduled for an oral hearing.

Proceedings can be accelerated, but only if the applicant can give a legitimate reason why acceleration might be preferable. For example, a pending infringement action might be considered a legitimate reason.

If oral proceedings are requested, written submissions may be filed before the proceedings occur. Usually, this costs between £1,000 and £5,000. About £3,000 is typical.

Should you wish to attend oral proceedings, it usually costs around £3,000 to £10,000. This includes preparation beforehand, travel and attending the proceedings at the EPO. £5,000 is typical.

Total cost

Overall, the total cost for a typical appeal will usually be around £10,000 to £35,000, with a typical figure being £15,000 to £20,000. This cost covers filing and prosecuting the appeal, usually spread out over up to four years.

In dollars, this is about \$15,000 to \$55,000, with a typical figure being \$20,000 to \$30,000, usually spread out over up to four years.

Decision time

Once the Board of Appeal considers all issues fully, it will issue a final decision. The Board has the power to grant any remedy that could have been granted by the Division whose decision is under appeal (such as grant or refusal of a patent application).

Each party usually pays its own costs.

What next?

If you would like more information, then please get in touch.

You can email us info@barkerbrettell.co.uk or call us on **+44 (0)121 456 0000**.

Where mentioned, and unless otherwise specified, costs exclude VAT and include any official fees and costs and timescales are approximate.

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