



31 August 2023

Honorable Jorma Hanski
Chairperson of the Boards of Appeal Committee
European Patent Office
Richard-Reitzner-Allee 8 | 85540 Haar | Germany

Honorable Carl Josefsson
President of the Boards of Appeal
European Patent Office
Richard-Reitzner-Allee 8 | 85540 Haar | Germany

Submitted via email (RPBAonlineconsultation@epo.org)

Re: User Consultation on the Proposed Amendments to the Rules of Procedure of the Boards of Appeal

Dear Chairperson Hanski and President Josefsson:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the user consultation on the draft proposed amendments to the Rules of Procedure of the Boards of Appeal (RPBA).

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO's mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

Below please find IPO's comments on the proposed changes to the RPBA. Thank you for this opportunity to comment.

Art 12(1)(c)

IPO supports the stated aim of pursuit of more ambitious timeliness objectives, but would support maintaining the current four-month period for filing a reply to an appeal, rather than reducing this period to two months (as is proposed), for a number of reasons.

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Art 12(3) RPBA, which is not proposed to be amended, provides that the statement of grounds of appeal and the reply shall contain a party's complete appeal case. Those documents are therefore of critical importance to the outcome of the appeal.

Under the current RPBA Art 12(1)(c), the period for responding to an appeal is four months, which is symmetrical with the four-month period for filing grounds of appeal set by Art 108 EPC. In reality, the appellant also has the period between announcement of a decision in opposition oral proceedings and issuance of a written decision in which to start work on preparing the grounds of appeal. That period is often around two months, but may even be longer. The appellant therefore already enjoys an advantage in preparation time over the respondent.

In contrast, a respondent is unable to undertake substantive work on a reply until the grounds of appeal have been filed, because only then can the respondent know that an appeal has been validly filed and understand the appellant's arguments. The proposed change would severely reduce the time available to prepare a reply to an appeal and therefore increase the imbalance in preparation time between appellant and respondent.

IPO also is concerned that a period of two months is not generally commensurate with the work involved in preparing a reply to an appeal. Whether the respondent is a large corporate body with often time-consuming but necessary internal procedures for making decisions and allocating resources, or a smaller entity relying on very limited resources to make decisions and prepare a response (with employees who may not be immediately available, e.g. over a holiday period), a two-month period would be likely to present great challenges for the completion of the reply.

Unfortunately, the proposed power for a Board to extend the period for a reply up to four months would not necessarily remedy the above-mentioned problems. The power would be discretionary and could therefore lead to uncertainty and perceived inequity, especially if the approach is not consistent across all the Boards. Secondly, preparing reasoned requests for an extension will add further to the burden on respondents and adjudicating such requests will add to the workload of the Boards.

IPO believes any positive effect on reducing the duration of appeal proceedings arising from the proposed change would be small relative to the overall length of proceedings, and that the disadvantages described above outweigh any such advantage. IPO believes other approaches to reducing the duration of appeal proceedings, such as increasing the capacity of the Boards of Appeal to reduce the backlog of cases, would be likely to be more effective in increasing timeliness.

Art 12(7)

IPO has no comment.

Art 13(2)

IPO agrees with the rationale given in the consultation document of 15 June 2023 and supports this change.

Art 15(1)

If the proposed change to Art 13(2) is adopted, IPO has no comment on the deletion of the second sentence of Art 15(1). If the proposed change to Art 13(2) is not adopted, IPO does not support the proposed deletion because it would be unnecessary and would open the door to application of the most strict level of the convergent approach very soon after the filing of the reply to the appeal.

With regard to the proposed new final sentence, while IPO welcomes the mandatory nature of the time period, IPO believes that the proposed one-month period would be too short to allow proper consideration of the reply to the appeal and preparation of any extra submissions in response thereto. Even the current minimum two-month period is very short, and IPO believes it should not be reduced further.

Art 15(9)

IPO has no comment.

Art 25(4)

IPO has no comment.

IPO again thanks the Boards of Appeal for the opportunity to provide these comments for consideration.

Sincerely,

A handwritten signature in black ink, appearing to read 'Karen Cochran', is written over a light grey rectangular background.

Karen Cochran
President