

Appeals Before the European Patent Office

Who can Appeal?

Any party adversely affected by a decision of the European Patent Office (EPO) is entitled to appeal that decision. Appeals therefore lie from decisions of the Receiving Section, Examination Division, Opposition Division and the Legal Division.

During examination, it will only be the applicant who can appeal. In opposition proceedings, it is possible for either patentee or opponent to appeal. Moreover, in some circumstances both parties can appeal. If, for example, an opposed patent is allowed to be maintained in amended form by the Opposition Division, the patentee may want to appeal the decision to reject its patent as granted and an opponent may wish to appeal the decision to maintain any patent at all.

It is almost always the case however that an appellant cannot be put in a worse position after an appeal than if he had not appealed at all. Thus, if, for example, a patent is maintained by the Opposition Division in amended form and only the patentee appeals that decision, the Appeal Board are obliged to accept nothing less than the claims found allowable by the Opposition Division.

Appeals have a suspensive effect, which means that the decision appealed cannot become final until the appeal is heard. Where there are other parties to the proceedings, such as in opposition proceedings, they become party to any appeal even if they have not themselves appealed.

Timing

A notice of appeal must be filed within two months of the written decision from the EPO which is the subject of the appeal. When filing that appeal, the necessary appeal fee has to be paid and information has to be given about the decision being appealed and the party making the appeal.

Within four months of the date of the adverse decision, a complete written statement setting out the grounds of appeal must be filed. It is very important that the Appellant's entire case is set out within that written statement. The Appeal Boards are now reluctant to admit further submissions after the grounds of appeal are filed.

In inter-partes proceedings, once an appeal is filed the other parties to the appeal will have the opportunity to comment on any appeal. They will typically be given a four month time period in which to do so. Again, the respondent should ensure that their entire case is present in the response to Appeal if possible.

Once all parties have had the opportunity to comment, it would be normal for the Appeal Board to arrange an oral hearing to listen to the arguments of the parties. Such hearings can, however, take years to be appointed. An oral hearing can be appointed much more rapidly however, if there are national court proceedings in progress.

The Appeal Board

The Appeal Board typically consists of three members. The chairman will be an experienced EPO Examiner qualified in the technical field to which the patent relates. The chairman will sit with a rapporteur who will also be technically qualified in the field in question and will have read the papers in the case thoroughly. There will also be one legal member of the Appeal Board who is not technically qualified but sits to deal with any legal points that may arise. Hearings almost always take place at the EPO's Erhardtstrasse address in Munich.

Appeal Decision

If the Appeal Board decides that the first instance decision was correct then any appeal will be rejected and the first instance decision enforced. The Appeal Board may also decide to reverse the first instance decision and remit the case to the appropriate department with an order on how the case is to be further handled. If the Appeal Board considers that the first instance decision constituted a substantial procedural violation of the rights of an appellant then they can also order reimbursement of the appeal fee.

Note that in opposition proceedings, the Appeal Board will almost always limit themselves to hearing grounds considered at the opposition division. Any ground not considered by the Opposition Division will not be discussed. If, therefore, a patent is revoked by the Opposition Division for added matter, then the Appeal Board will consider added matter only and remit the case to the first instance for a discussion of further grounds for opposition. This means that cases can pass to the Appeal Board on more than one occasion.

Enlarged Board of Appeal

In almost all instances, the Appeal Board represents the highest jurisdiction in which a party's case can be heard before the EPO. It is however possible on rare occasions to appeal to the Enlarged Board of Appeal from the Appeal Board. The grounds on which this can be done are very limited and the chances of overturning an Appeal Board's decision are very small but if an appellant feels, for example, that their right to be heard has been fundamentally violated, then assuming they meet the stringent formalities requirements, an Enlarged Board of Appeal may lie. Such Appeals have been possible since December 2007 and to date almost no Enlarged Board appeals have been successful.

Withdrawal

If at any stage, the sole Appellant withdraws an appeal, then the decision of the first instance becomes final. The Appeal Board cannot continue an appeal of its own volition.

Further advice

This note provides only a very brief overview of appeal procedure and should further more detailed information be required then any of the attorneys at Dehns will be willing to help.



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