

TREAD CAUTIOUSLY: PETITIONS FOR REVIEW

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Since EPC 2000 entered into force in December 2007, any party to an appeal proceeding that has been adversely affected by a decision of the European Board of Appeal can, pursuant to new Article 112a EPC, file a petition for review of the decision by the Enlarged Board of Appeal (EBOA).

In Committee on Patent Law minutes covering preparatory work for EPC 2000, it was generally acknowledged that the purpose of introducing Article 112a EPC is “to create a comparable, strictly limited possibility to apply for a further review of decisions of the boards of appeal of the EPO”, realising that “under certain circumstances many legal systems offer a possibility to review final decisions of a court which are *res judicata*”, with the possibility to set aside a decision of a board of appeal only if it suffers from a major defect, so that maintaining it without further review would be intolerable.

The petition may be filed exclusively on any of the grounds from the exhaustive list below:

- (a) a member of the Board of Appeal took part in the decision in breach of Article 24 paragraph 1, or despite being excluded pursuant to a decision under Article 24, paragraph 4
- (b) the Board of Appeal included a person not appointed as a member of the Boards of Appeal
- (c) a fundamental violation of Article 113 occurred
- (d) any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings, or
- (e) a criminal act established under the conditions laid down in the Implementing Regulations may have had an impact on the decision.

The deadline for filing the Petition for Review is two months after the decision of the Board of Appeal becomes final. The only exception is when Article 112a(2)(e) EPC is invoked, in which case the two-month time limit starts when the conviction by the criminal court becomes final. In the interest of legal certainty, the Petition for Review cannot be filed later than five years after a final conviction; the protection of a party suffering from criminal behaviour prevails over legal certainty for third parties. Currently, we have not found any published pending or decided Petitions for Review based on Article 112a(2)(e) EPC.

In order to counteract intentional prolongation of proceedings, the EBOA uses a quick screening procedure to strike out clearly inadmissible, insufficiently substantiated or ill-founded petitions for review. In these cases, the decisions are made by an EBOA composed of two lawyers and one technically qualified member. Their decision must be unanimous and only minimal reasons need be given. Without unanimity, the case will be referred to an EBOA composed of four lawyers and one technically

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qualified member. If the petition for review is admissible, the EBOA will consider whether a fundamental procedural defect has occurred or whether a criminal act has had an impact on the decision under review. The EBOA may also avail itself of a provision to shorten periods for replying to notifications, providing written submissions and translations, and attending to oral proceedings, etc.

At the time of writing, 30 cases have been decided by the EBOA and a further 14 are pending. A study of final decisions on Petitions for Review reveals that the majority are either deemed unallowable or inadmissible. Some are also withdrawn. Some cases that have been deemed unallowable attempted to remedy errors made in the course of patent prosecution, either during the examination, opposition or appeal proceedings.

Currently, R 07/09, invoking Article 112a(2)(c) EPC, is the only petition decided in favour of the petitioner. The EPO was not able to establish that a copy of the appellant’s statement setting out the grounds of appeal was notified to the proprietor by registered letter, as required. In the absence of any evidence, this statement was deemed not to have been communicated to the petitioner as prescribed by the EPC and the EBOA ordered the reopening of the proceedings before the Board of Appeal and the reimbursement of the fee for the petition for review.

Current case law reveals that the petitioner must have a good case occasioned by at least one of the exhaustive list of grounds, and he needs to present evidence and argue the violation against him beyond all reasonable doubt in order to have his case reopened. This restrictive approach limits abuse of Article 112a EPC in line with the recommendations set forth by the Committee on Patent Law to reduce the number of petitions relating to improving a petitioner’s position and the content of an application. Filing a Petition for Review after appeal might be worthwhile, but only in exceptional circumstances.

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