

- (b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.
- (2) In the cases referred to in paragraph 1 (a) the parties to the appeal proceedings shall be parties to the proceedings before the Enlarged Board of Appeal.
- (3) The decision of the Enlarged Board of Appeal referred to in paragraph 1 (a) shall be binding on the Board of Appeal in respect of the appeal in question.

Comment:

Article 112 EPC sets out the basis on which points of law may be referred to the Enlarged Board of Appeal.

A Board of Appeal must refer questions arising from appeal proceedings, either at the request of one of the parties or at the Board's own motion, if it considers that an answer is required to ensure the uniform application of law or if the point of law is of fundamental importance (*Article 112 (1)(a) EPC*). The parties to the appeal then become parties to the proceedings before the Enlarged Board of Appeal (*Article 112 (2) EPC*). The Enlarged Board's decision is binding on the Board of Appeal making the reference (*Article 122 (3) EPC*).

The President of the EPO may also refer points of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on a matter (*Article 112 (1)(b) EPC*). If the EPO President exercises this power, the Enlarged Board of Appeal may reject the request if it considers that the earlier Board of Appeal decisions are not in conflict (see **G3/95**).

Article 112a

Petition for review by the Enlarged Board of Appeal

- (1) Any party to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review of the decision by the Enlarged Board of Appeal.
- (2) The petition may only be filed on the grounds that:
- 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;
 - the Board of Appeal included a person not appointed as a member of the Boards of Appeal;
 - a fundamental violation of Article 113 occurred;
 - any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings; or
 - a criminal act established under the conditions laid down in the Implementing Regulations may have had an impact on the decision.

Article 24 (1) – Board member may not take part in case in which he has a personal interest or in respect of which he previously acted as a representative, participated in the earlier decision or was excluded from the relevant Board of Appeal

Article 24 (4) – Decision on exclusion of Board member

Article 113 – Decisions may only be based on facts and evidence on which parties have had an opportunity to comment

Failure to hold oral proceedings when requested is a fundamental procedural defect – **Rule 104 (a)**

Failure to decide on relevant request is a fundamental procedural defect – **Rule 104 (b)**

Sufficient that a court establishes that a criminal act occurred; conviction is not required – **Rule 105**

Obligation to raise objections during appeal proceedings – **Rule 106**

2-month period for filing petition for review cannot be extended using further processing – **Article 121 (4)**

Application for re-establishment of rights must be filed within 2 months of missed deadline – **Rule 136 (1)**

Fees reduced by 20% for applicants who are nationals or residents of or who have a principal place of business in Contracting States with official languages other than English, French or German who file in such a language – **Rule 6 (3), RRF Article 14 (1)**

If petition for review not filed in English, French or German, translation must be filed within 1 month or by end of period for filing petition for review, if later – **Rule 6 (2)**

Content of petition for review – **Rule 107**

Examination of petition for review – **Rule 108**

Procedure for dealing with petition for review – **Rule 109**

Reimbursement of fee for petition for review – **Rule 110**

If proceedings re-opened, proprietor must pay any renewal fees that have fallen due since date of original decision – **Rule 51 (5)**

(3) The petition for review shall not have suspensive effect.

(4) The petition for review shall be filed in a reasoned statement, in accordance with the Implementing Regulations. If based on paragraph 2 (a) to (d), the petition shall be filed within two months of notification of the decision of the Board of Appeal. If based on paragraph 2 (e), the petition shall be filed within two months of the date on which the criminal act has been established and in any event no later than five years from notification of the decision of the Board of Appeal. The petition shall not be deemed to have been filed until after the prescribed fee has been paid.

(5) The Enlarged Board of Appeal shall examine the petition for review in accordance with the Implementing Regulations. If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision and shall re-open proceedings before the Boards of Appeal in accordance with the Implementing Regulations.

(6) Any person who, in a designated Contracting State, has in good faith used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the period between the decision of the Board of Appeal and publication in the European Patent Bulletin of the mention of the decision of the Enlarged Board of Appeal on the petition, may without payment continue such use in the course of his business or for the needs thereof.

Related Rules

Rule 104

Further fundamental procedural defects

A fundamental procedural defect under Article 112a, paragraph 2 (d), may have occurred where the Board of Appeal,

- (a) contrary to Article 116, failed to arrange for the holding of oral proceedings requested by the petitioner, or
- (b) decided on the appeal without deciding on a request relevant to that decision.

Rule 105

Criminal acts

A petition for review may be based on Article 112a, paragraph 2 (e), if a competent court or authority has finally established that the criminal act occurred; a conviction is not necessary.

New Rule

Article 112a (2)(d) – Further fundamental procedural defects laid down by Implementing Regulations

Article 116 – Oral proceedings must be held on request of any party

New Rule

Article 112a (2)(e) – A criminal act may have had an impact on decision

Rule 106**Obligation to raise objections**

A petition under Article 112a, paragraph 2 (a) to (d), is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.

Rule 107**Contents of the petition for review**

- (1) The petition shall contain:
 - (a) the name and the address of the petitioner as provided in Rule 41, paragraph 2 (c);
 - (b) an indication of the decision to be reviewed.
- (2) The petition shall indicate the reasons for setting aside the decision of the Board of Appeal, and the facts and evidence on which the petition is based.
- (3) Part III of the Implementing Regulations shall apply mutatis mutandis to the petition for review and the documents filed in the proceedings.

Rule 108**Examination of the petition**

- (1) If the petition does not comply with Article 112a, paragraphs 1, 2 or 4, Rule 106 or Rule 107, paragraph 1 (b) or 2, the Enlarged Board of Appeal shall reject it as inadmissible, unless any defect has been remedied before the relevant period under Article 112a, paragraph 4, expires.
- (2) If the Enlarged Board of Appeal notes that the petition does not comply with Rule 107, paragraph 1 (a), it shall communicate this to the petitioner and shall invite him to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Enlarged Board of Appeal shall reject the petition as inadmissible.
- (3) If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision of the Board of Appeal and order the reopening of the proceedings before the Board of Appeal responsible under Rule 12, paragraph 4. The Enlarged Board of Appeal may order that members of the Board of Appeal who participated in taking the decision set aside shall be replaced.

New Rule

Article 112a (2)(a) – Participation of Board of Appeal member in case in which he has a personal interest or in respect of which he previously acted as a representative, participated in the earlier decision or was excluded from the relevant Board of Appeal

Article 112a (2)(b) – Participation of non-Board member

Article 112a (2)(c) – Decision based on facts or evidence on which parties have not been given opportunity to comment

Article 112a (2)(d) – Failure to hold oral proceedings on request or to decide on relevant request

New Rule

Rule 41 (2)(c) – Form of name and address

Part III comprises **Rules 35 – 54** relating to form and content of application

New Rule

Article 112a (1) – Petition can only be brought by a party adversely affected by decision

Article 112a (2) – Petition must state allowable grounds

Article 112a (4) – Petition must be filed within 2 months of notification of decision or of date on which criminal act established

Rule 106 – Obligation to raise objections during appeal proceedings

Rule 107 (1)(b) – Indication of decision

Rule 107 (2) – Statement of reasons for setting aside decision of Board of Appeal

Rule 107 (1)(a) – Name and address of appellants

Time periods set by EPO must be at least 2 months and may be extended on request –

Rule 132 (2)

Rule 12 (4) – Allocation of duties to Boards of Appeal

New Rule**Article 112a** – Petitions for review**Rule 115 (1)** – Parties given 2 months notice of oral proceedings**Rule 118 (2)** – Parties given 2 months notice of summons to give evidence**Rule 132 (2)** – Other time limits at least 2 months**Rule 4 (1)** – At least 1 month's notice required for use of language other than language of proceedings**Rule 109****Procedure in dealing with petitions for review**

(1) In proceedings under Article 112a, the provisions relating to proceedings before the Boards of Appeal shall apply, unless otherwise provided. Rule 115, paragraph 1, second sentence, Rule 118, paragraph 2, first sentence, and Rule 132, paragraph 2, shall not apply. The Enlarged Board of Appeal may specify a period deviating from Rule 4, paragraph 1, first sentence.

(2) The Enlarged Board of Appeal

(a) consisting of two legally qualified members and one technically qualified member shall examine all petitions for review and shall reject those which are clearly inadmissible or unallowable; such decision shall require unanimity;

(b) consisting of four legally qualified members and one technically qualified member shall decide on any petition not rejected under subparagraph (a).

(3) The Enlarged Board of Appeal composed according to paragraph 2 (a) shall decide without the involvement of other parties and on the basis of the petition.

Rule 110**Reimbursement of the fee for petitions for review**

The Enlarged Board of Appeal shall order the reimbursement of the fee for a petition for review if the proceedings before the Boards of Appeal are re-opened.

New Rule**Other Relevant Rules**

Rule 4	Language in oral proceedings	See Article 14, page 7
Rule 6	Filing of translations and reduction of fees	See Article 14, page 8
Rule 12	Presidium of the Boards of Appeal	See Article 21, page 14
Rule 35	General provisions	See Article 75, page 50
Rule 41	Request for grant	See Article 78, page 55
Rule 42	Content of the description	See Article 78, page 56
Rule 43	Form and content of claims	See Article 84, page 73
Rule 46	Form of the drawings	See Article 78, page 57
Rule 48	Prohibited matter	See Article 78, page 58
Rule 49	General provisions governing the presentation of the application documents	See Article 78, page 58
Rule 50	Documents filed subsequently	See Article 94, page 95
Rule 51	Payment of renewal fees	See Article 86, page 77
Rule 115	Summons to oral proceedings	See Article 116, page 134
Rule 118	Summons to give evidence before the European Patent Office	See Article 117, page 136
Rule 132	Periods specified by the European Patent Office	See Article 120, page 142
Rule 136	Re-establishment of rights	See Article 122, page 147

Comment:

New Article 112a introduces limited judicial review of Board of Appeal decisions where a fundamental procedural defect or criminal act is alleged to have occurred. Such review by the Enlarged Board of Appeal is intended to remedy intolerable deficiencies occurring in individual appeal proceedings. The new petition for review procedure therefore overcomes the legislative limitation identified in **G1/97**, in which the Enlarged Board of Appeal held that the EPC provided no means for reviewing a final decision of a Board of Appeal.

The grounds for a petition for review by the Enlarged Board are set out in Article 112a (2) and Rule 104 EPC as follows:

- involvement of a Board of Appeal member in a decision in which the Board member has a personal interest or where the Board member previously acted as a representative or was involved in the decision at first instance (*Article 112a (2)(a) EPC*);
- participation of an excluded Board member or a non-Board member in a Board of Appeal decision (*Article 112a (2)(a) and (b) EPC*);
- a fundamental violation of the right of a party to comment on grounds or evidence forming the basis of a decision by a Board of Appeal (*Article 112a (2)(c) EPC*);
- failure to hold oral proceedings when requested by a party (*Article 112a (2)(d) and Rule 104 (a) EPC*);
- failure to decide on a relevant request (*Article 112a (2)(d) and Rule 104 (b) EPC*);
or
- a criminal act may have had an impact on a Board of Appeal decision (*Article 112a (2)(e) EPC*).

Other than where a criminal act has occurred, a petition for review is only admissible if an objection to the defect was raised during the appeal proceedings but rejected by the Board of Appeal, unless it was not possible for such an objection to be raised (*Rule 106 EPC*).

Article 112a (4) EPC sets the time limit for filing a petition for review as 2 months from the date of notification of the decision. This applies in all cases except those based on a claim that a criminal act has occurred. For the latter, the time limit is 2 months from the date on which a court establishes that a criminal act took place, regardless whether a conviction results (*Rule 105 EPC*), subject to an absolute limit of 5 years from the date of notification of the decision being challenged. These time limits cannot be extended using further processing (*Article 121 (4) EPC*). In the event that the deadline for filing a petition for review is missed despite all due care having been taken, re-establishment of rights under Article 122 EPC is possible. However, an application for re-establishment of rights must be filed within 2 months of the missed deadline (*Rule 136 (1) EPC*).

A petition for review is only considered filed when the petition fee has been paid (*Article 112a (4) EPC*). This fee is currently €2,500 (*Article 2 (11a) of the Rules Relating*

to Fees). The fee is reduced by 20% for nationals or residents of, and persons with a principal place of business in, a Contracting State having an official language other than English, French or German who initially file a petition for review in that language (*Rule 6 (3) EPC and Article 14 (1) of the Rules Relating to Fees*). If a petition is filed in a language other than English, French or German, a translation into one of those languages must be filed within a month or before the end of the 2-month period for filing a petition for review, whichever is later (*Article 14 (4) and Rule 6 (2) EPC*).

Unlike an appeal against a decision at first instance, a petition for review does not cause the Board of Appeal's decision to be suspended (*Article 112a (3) EPC*). Rather, the decision remains in force and only ceases to have effect if the Enlarged Board of Appeal decides to allow the petition for review (*Rule 108 (3) EPC*).

Rule 107 EPC provides that a petition for review must contain the name and address of the petitioner; an indication of the decision to be reviewed; a statement of the grounds on which the petition is based; and an indication of the facts, evidence and arguments that support those grounds. Formal compliance is checked by a 3-member board consisting of two legally qualified members and one technically qualified member. Decisions to reject a petition by the 3-member board must be unanimous (*Rule 109 (2)(a) EPC*).

If a petitioner is not a party adversely affected by the challenged decision, or if he fails to state a suitable basis for review or fails to pay the petition fee, the petition is rejected unless it is amended or the petition fee is paid within the usual term for filing a petition for review (*Rule 108 (1) EPC*).

If a petition does not include the petitioner's name and address in the correct form, the petitioner is given an opportunity to remedy the deficiency. Failure to correct in due time when requested results in the petition for review being rejected as inadmissible (*Rule 108 (2) EPC*).

If the petition is formally allowable, its substance is considered by a 5-member board consisting of 4 legally qualified members and 1 technically qualified member (*Rule 109 (2)(b) EPC*). The board may issue a summons for oral proceedings and/or a summons to give evidence. When doing so the board is not required to provide the usual 2 months notice of the date of any hearing (*Rule 109 (1) EPC*).

If the Enlarged Board allows the petition, the Board of Appeal decision is set aside and proceedings are re-opened, if necessary with members of the earlier Board of Appeal having been replaced (*Rule 108 (3) EPC*). If the Enlarged Board orders proceedings to be re-opened, the fee for the petition for review is reimbursed (*Rule 110 EPC*). At the same time, if any renewal fees have fallen due since the original decision of the Board of Appeal, those fees become payable (*Rule 51 (5) EPC*).

If a patent or application is restored as a result of a successful review, third parties who have used or made good faith preparations to use the claimed invention in the period between the original Board of Appeal decision and the re-opening of proceedings following the petition for review can continue such use without having to make any payment to the patent proprietor (*Article 112a (6) EPC*).