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Att.: Mr. Finnilä, President

30 September 2010

Procedures before the EPO Boards of Appeal

Dear Mr. Finnilä,

Thank you for your letter dated 24.08.2010 regarding the above matter. Below please find the answers of the Association of Danish Patent Agents to the questions raised:

1. What are your views on the time it takes from the start of a procedure until a decision is delivered when comparing a national court case to an EPO appeal case?

Most EPO appeals are decided within 18 to 36 months from the moment of lodging a notice of appeal until delivery of the decision, unless the Board remits the case to the first instance. In that case, it may take 5-8 years from the date an appeal is filed for the first time, until it is finally decided. The time frame before the Board is acceptable in most cases, as it guarantees the parties' right for a two-instance hearing of the decisive issues of a case, but when a case is remitted to the first instance, the Examining or Opposition Division should give priority to the case and preferably finalise it within a year as it is difficult for some clients to accept the long duration and to defer commercial decisions for such a long period of time. In the cases where a parallel national court action has been lodged there is a need for faster decisions, and the Opposition Division and the Board concerned should preferably accelerate the fixing of oral proceedings if a party to the national court action requests it, even if that party is not a party to the EPO opposition or appeal proceedings.

Danish court decisions in respect of patent matters are rarely decided in less than 18 months, and the cases often take more than 3 years, in particular in the vast majority of cases, which involve court-appointed experts. The time it takes to appoint a court-appointed expert and to obtain the parties' and the Court's approval of the questions to be asked to the expert as well as the time it takes for the expert to deliver the written report often accumulates to 1-2 years on its own. Preliminary injunction cases in the 24 city courts are usually conducted within a time frame of 2 – 6 months.

It should be noted that the responsibility for hearing of patent cases moved from the High Courts to the Copenhagen Maritime and Commercial Court in 2007, and that the latter court has only heard relatively few patent cases so far. The Copenhagen Maritime and Commercial Court has instituted a possibility for requesting fast track handling with the aim of finalizing a first instance patent litigation in less than two years, but as of now it is not possible to conclude in general on how this will shorten the court proceedings.

2. Should the date for oral proceedings be set as early as possible? What are your experiences with regard to national courts and EPO Boards of Appeal in this matter?

EPO appeals constitute a second instance review, and the EPO appeal procedure is not intended to constitute a continuation of the examination or opposition procedure. Accordingly, the nature of EPO appeals allows that a date for oral proceedings be set early. Given that Article 13 RPBA requires the parties to state their full case early in the proceedings, it would from the viewpoint of the parties seem rather uncontroversial to set the date for oral proceedings as early as possible in EPO appeal proceedings.

First instance court cases are different in nature, because at least the plaintiff usually builds his case during the course of proceedings. Accordingly, the interest of the parties to have sufficient time to produce evidence and build their case must be fairly balanced against the general desire to terminate proceedings as quickly as possible. The Copenhagen Maritime and Commercial Court normally sets a date for the main court hearing a few months in advance of the hearing after having consulted the parties. This procedure functions satisfactorily in first instance national court proceedings, but would be unsuitable for EPO appeal proceedings.

In injunction proceedings, a date for oral proceedings is usually set rather early in the proceedings, i.e. shortly after the defendant's filing of his response to the motion for preliminary injunction.

3. Are national judges less or more interactive in oral proceedings than EPO Boards of Appeal members?

Danish judges are generally less interactive. The judges only ask questions with a view to objectively clarifying facts. The judges are extremely cautious not to interfere in the parties' presentation of their case.



4. What aspects of a national court procedure or an EPO Boards of Appeal procedure make one preferable over another?

A comparison of the advantages of one procedure over the other implies that there is a choice, and this is only so for national invalidity proceedings. Most national court procedures are initiated as infringement proceedings, and the claim for revocation of the patent is here raised as a counterclaim. In the latter case there is typically no choice of venue because many infringement complaints are filed after the expiry of the opposition term. However, if opposition has been filed, then the national court procedures would be less complicated and less costly if the opposition and appeal proceedings were completed in a more speedily manner.

We have some cases where the national invalidity procedure was preferred over filing opposition. The main reason to prefer the national court procedure over the opposition was the possibility to have the matter considered by court-appointed experts. These experts are typically a team of a well reputed technical expert with practical experience in the relevant technical field and a European patent attorney. The technical expert is able to read the prior art with the general knowledge relevant to the particular technical field, and the European patent attorney is able to balance the contribution of the technical expert against the relevant patent standards.

The parties pose written questions to the court-appointed experts, and they reply in a written declaration to the court. During the hearing the experts are cross-examined by the parties. This national court procedure works very well in cases where the technical issues are of high importance.

The costs involved in defining the questions to be posed and in the reply by the court-appointed experts and in the cross-examination of the experts are a disadvantage in comparison to the procedure before an EPO Board of Appeal.

The EPO rules of procedure prevent one of the parties from delaying proceedings for an unreasonable time. We consider this as an advantage of EPO appeal proceedings over Danish court proceedings.

One advantage of Danish court proceedings is that parties are free to call witnesses. We consider it a disadvantage of EPO proceedings that witnesses and experts can only be heard at the discretion of the EPO pursuant to Rule 117 EPC, which is seldom given. Further, court hearings in Danish court proceedings often take from 3 to 10 days, allowing a thorough presentation of the case to the court. In invalidity proceedings, the Danish courts do not decide separately on each ground for invalidity invoked. All grounds for invalidity are examined, and the Court's decision is only taken after all grounds for invalidity have been presented to the Court. We consider this to be an advantage of Danish court proceedings, because 'bouncing' of cases between the first and second instance is prevented.

5. How do you find that auxiliary requests are dealt with before national courts as compared with before the EPO Boards of Appeal?

This question may hardly be answered because Danish courts do not decide separately on each ground for invalidity invoked during the proceedings, but instead takes a decision only after the complete case has been presented.

Yours sincerely,



Anne Schouboe

Secretary

