

# Learning path for patent administrators

## Appeal procedure after refusal: EPAC - intermediate level

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## Introduction

This publication, "Appeal procedure after refusal, EPAC - intermediate level", is part of the "Learning path for patent administrators" series is edited and published by the European Patent Academy. The series is intended for patent administrators who are taking part in training and certifications organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include: general aspects of the patent system; the European patent system and the European patent granting procedure; the International Patent System (PCT) and the PCT procedure; European and international publications; filing a European patent application and filing an international application; the formalities during the European and during the international search; the formalities during the European examination and during the international preliminary examination; the formalities during the appeal procedure after refusal (EPC), during the opposition procedure (EPC); national validation (EPC); entry into national/regional phases and entry into the European phase (PCT).

Each chapter focuses on one topic at entry, intermediate or advanced level, as appropriate. The series will be revised annually to ensure it remains up to date.

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All references to natural persons are to be understood as applying to all genders.

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## 1. Learning objectives

Participants to this course will learn:

- The definition of an appeal
- Which decisions can be appealed
- How to file an appeal
- Different decisions from the boards of appeal
- Articles and rules related to appeals

## 2. Filing an appeal after refusal by the receiving section

Any appeal against decisions of the receiving section will be dealt with by the Legal Board of Appeal (J decision).

These appeals relate to a refusal decision by the receiving section, in the following cases:

- Formal deficiencies not remedied in time (Art. 90(5) EPC).
- No representative appointed (EPCT applications, Rule 163(4) EPC).
- Missing of deficient sequence listing (Art. 90(5) EPC, Rule 30(3) EPC, Rule 163(3) EPC).
- No designation of inventor filed in due time (Art. 90(5) EPC, Rule 163(6) EPC).

### Examples

An appeal due to a formal deficiency not remedied in time by the applicant, e.g., no reply to EPO Form 1045 (no inventor).

### Legal references:

Art. 21(3), 90(5), 106, 107, 108, 109, 110, 111, 112 EPC

R. 163(3), (4), (6) EPC

OJ 10/2003, 419

## 3. Filing an appeal after decision by the examining division

Any appeal against decisions of the examining division will be dealt with by the competent technical board of appeal (T decision). All appeals must be filed in writing and have a suspensive effect. The time limit for filing an appeal is not extendable. Depending on the competent board of appeal, some decisions are taken by the Enlarged Board of Appeal (G decisions and opinions).

Some examples of appealable decisions issued during the examination procedure are,

- Decision of the examining division to refuse an application (Art. 97(2) EPC).
- Decision to grant a European patent (Art. 97(1) EPC).
- Decision of the formalities officer to reject a request for re-establishment of rights (Art. 122(2) EPC).
- Decision pursuant to Rule 112(2) EPC.

## Examples

An appeal filed after a refusal of the application by the examining division.

### Legal references:

Art. 21(1), 97(2), 106 EPC

OJ 10/2003, 419

## 4. Who may file an appeal?

Only the applicant or its representative are entitled to file an appeal against a decision. Any party to proceedings adversely affected by a decision may appeal. A "party" to the appeal proceedings will be considered to be those entered in the Register in the first-instance proceedings. Fees such as renewal fees are still due during the appeal procedure.

## Examples

Any party appearing in the bibliographic data contained in the Register.

### Legal references:

Art. 107 EPC

R. 41(2)(c), 99 EPC

Decision T. 656/98, r. 1

## 5. Content of an appeal

Notice of appeal must be filed at the EPO within two months of notification of the decision and must contain the appellant's name and address, an indication of the decision impugned and a request setting out the subject of the appeal. It will not be deemed to have been filed until the appeal fee has been paid.

A statement setting out the grounds of appeal must be filed at the EPO within four months of notification of the decision. It must contain the reasons why the impugned decision should be set aside, or the extent to which it should be amended, and the facts and evidence on which the appeal is based.

The appellant can withdraw the appeal in part or in full. However, the board of appeal may decide to continue with issues related to the appeal, such as a request for reimbursement of the appeal fee.

### Legal references:

Art. 104, 108, 110 EPC

R. 2(1), 41(2)(c), 50, 99, 101 EPC

## 6. Appeal fees

If the appeal fee is not paid, the notice of appeal is deemed not to have been filed. The time limit for paying the appeal fee is the same as for filing the notice of appeal. If the amount paid falls short by

a small amount (around 10%), the fee is regarded as having been paid in time. The outstanding fee amount must still be paid.

By Decision of the Administrative Council of 13 December 2017, a reduction of the appeal fee was introduced as of 1 April 2018 for appeals filed by natural persons or certain entities (i.e. small and medium-sized enterprises, non-profit organisations, universities and public research organisations). For all other entities, the amount of the appeal fee was not reduced.

### Examples

For an appeal filed by a natural person or an entity referred to in Rule 6(4) and (5) EPC the appeal fee will be €2 015.00 instead of €2 785.00 (fee amount as at 4 May 2022).

### Legal references:

Art. 14(2), 108 EPC

R. 6(4), (5) EPC

OJ EPO 2018, A5

## 7. Reimbursement of an appeal fee

The appeal fee will be reimbursed in full in the event of interlocutory revision or where the board of appeal deems an appeal to be allowable and if reimbursement is equitable by reason of a substantial procedural violation, or if the appeal is withdrawn before the statement of grounds of appeal is filed and before the period for filing that statement has expired.

The appeal fee will be reimbursed at 75% if, in response to a communication from the board of appeal indicating its intention to start substantive examination of the appeal, the appeal is withdrawn within two months of notification of that communication.

The appeal fee will be reimbursed at 50% if the appeal is withdrawn after expiry of the period under R. 103(1)(b) EPC, provided withdrawal occurs:

- if a date for oral proceedings has been set, within one month of notification of a communication issued by the board of appeal in preparation for these oral proceedings; or
- if no date for oral proceedings has been set, and the board of appeal has issued a communication inviting the appellant to file observations, before expiry of the period set by the board for filing observations;
- in all other cases, before the decision is issued.

The appeal fee will be reimbursed at 25% if the appeal is withdrawn after expiry of the period under R. 103(3)(a) EPC but before the decision is announced at oral proceedings, or if the appeal is withdrawn after expiry of the period under R. 103(3)(b) EPC but before the decision is issued, or if any request for oral proceedings is withdrawn within one month of notification of the communication issued by the board of appeal in preparation for the oral proceedings, and no oral proceedings take place.

The appeal fee can be reimbursed under only one of the provisions mentioned above. Where more than one rate of reimbursement applies, reimbursement will always be at the higher rate. The department whose decision is impugned orders the reimbursement if it revises its decision and considers reimbursement equitable by reason of a substantial procedural violation. In all other cases,

matters of reimbursement are decided by the board of appeal. An appeal fee paid late will be refunded for lacking a legal basis, even of the EPO's own motion, without request.

**Legal references:**

R. 103(1)(a), (b), (2) EPC

Art. 108 EPC

OJ 2014, A3

## **8. Types of remittal from the Boards of Appeal**

When the board of appeal has decided on the notice of appeal referred to it, the appeal is remitted to the examining division or to the formalities officer. This legally binding kind of disposal can be found on the last page of the decision of the board of appeal under the section "Order" and it has a binding effect only in the individual case which the board has remitted to the department of first instance.

### **Examples**

Remittal from the boards of appeal to the examining division to proceed with the grant of the application subject to appeal.

**Legal references:**

Art. 111, 112 EPC

R. 102, 103 EPC

## **9. Beyond the course**

You can deepen what you have learned during this course with the following further reading:

- [The Official Journal of the EPO](#)
- [The European Patent Convention](#)

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