



HOLLY IP

Tips for Success in EPO Appeal

1. The EPO Boards of Appeal are prepared to take a different view from that expressed in the decision. They are therefore a very good forum for addressing mistakes or unfairness that might have happened at first instance. They are also very good at objectively assessing the first instance decisions, and can take a very sophisticated approach to complex matters.
2. In theory the Boards of Appeal do not consider the entire case, but only whether the decision is correct or not. Therefore be prepared for them to only focus on the decision, and the appeal should therefore be written with the same focus.
3. Appeal practice is becoming stricter in admitting amendments. Try to ensure all possible amendments are submitted at first instance, and in appeal try to file amendments as early as possible.
4. Be prepared for anything to happen, especially at Oral Proceedings. The Boards of Appeal make case law at the EPO and therefore will be open to arguments which might go against the case law. Case law is important at the EPO, but it can occasionally be reversed and one can succeed by showing why one's case is an exception to the case.
5. Make sure that you think carefully about strategy. There are no hard and fast rules as to how an appeal should be structured. As mentioned above the appeal should be focused on the decision. After that one needs to write in the way that best presents your case. You will need to consider the extent to which you wish to make the same arguments again, and the best balance between attacking the decision and reiterating your case.
6. Make sure in your own mind you are aware of what a reasonable outcome is and tailor your strategy accordingly. It can be advantageous to come across as being very reasonable, avoiding arguments which are too ambitious.
7. Be mindful to address the concerns of the Board during the proceedings. The specific issues they raise need to be focused on in case they end up determining the outcome, even though in your opinion they might not be important.
8. Do not expect the impossible. Be aware that the Board of Appeal will need to reach a decision they are happy with. They will be wary of going too far beyond the existing case law or of issuing a decision which might have a lot of repercussions for future cases.
9. Boards of Appeal can be very practical in the decisions they issue. Sometimes first instance departments can be too rigid on deviating from case law and usual European practice. However



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Boards of Appeal can be good judges of where a little leniency is appropriate, particularly if it results in a fairer decision.

10. Boards of Appeal have a deeper understanding of case law and European practice. They will therefore be more open to cases which require a consideration of why case law and practice are as they are, and can take a less formalistic attitude when required.