

Handwritten Amendments in Oral Proceedings

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1. Introduction

Representatives as well as the members of the examination divisions, of the opposition divisions and the Boards of Appeal are interested in basing the oral proceedings upon handwritten amendments of the application or patent. The reason for this interest is that handwritten amendments streamline the process of amending the documents and of checking the amendments with respect to a violation of Art. 123 (2) EPC. However, handwritten amendments intervene with the interest of the European Patent Office (EPO) to automatically capture the amended documents as a part of an automated printing process. The present contribution is direct to an investigation of the admissibility of handwritten amendments in oral proceedings.

2. Situation until December 31, 2013

Since the beginning of the European Patent Convention it used to be established case law that handwritten amendments were admitted in oral proceedings at the EPO.² Subsequently, the admissibility of handwritten amendments had also been entered into the Guidelines for Examination in the European Patent Office (see e. g. A-III, 3.2; A-VIII, 2.1; H-III, 2.3 in the editions until September 2013).

3. Situation since January 1, 2014

With simple notice dated November 8, 2013 (see official journal EPO, 12/2013, p. 603, 604) the EPO intended to change the established practice without any change of the related case law or of the related rules or articles of the EPC. As the motivation for the intended change of the established practice the notice names

- the intended improvement of the quality of the publications and
- the introduction of an automatic system to electronically produce the *Druckexemplar* with an electronic capture of submitted documents.

Motivated by these considerations the EPO announced that handwritten amendments in docu-

ments replacing parts of the European patent application will no longer be accepted. According to the notice, the change of practice should also apply in oral proceedings.³

4. Critical analysis of the present situation

Based on the notice summarized above in fact opposition divisions forced the patent owner to prepare printed amended documents without permitting handwritten amendments in oral proceedings. In order to be able to do so, the representative of the patent owner has to carry around a storage device and/or a laptop computer containing the electronic files of the relevant documents. Thus equipped, in a short break of the oral proceedings the representative has to work with his laptop and the printing facilities of the EPO to amend the documents and print them. As already anticipated by the early decision T 0113/92, the risk that the representative of the patent owner unintentionally introduces an amendment violating Art. 123 (2) EPC is increased. Further, the opponent and the opposition division are obliged to check any amended document in its entirety.

5. Decision T 0037/12

In the appeal proceedings T 0037/12, the opponent requested not to consider handwritten amendments presented for the first time in the oral proceedings. This request was based upon the fact that Rule 99 (3) EPC (which relates to appeal proceedings) in the same way refers to formal requirements of the third part of the Implementing Regulations (including Rule 49 EPC directed to printed or typed amended documents) as Rule 86 EPC (which is related to opposition proceedings). If according to the above notice by the EPO Rule 49 EPC in connection with Rule 86 EPC should be interpreted that handwritten amendments should no longer be accepted, this should apply *mutatis mutandis* in connection with Rule 99 (3) EPC in the appeal proceedings.

In decision T 0037/12, para. 3., the Board of Appeal analyses the admissibility of handwritten amendments in oral proceedings under consideration of Rules 86, 99 EPC referring back to Rule 49 EPC:

a) As stated in G 1/91, a generic referral to a chapter of the Implementing Regulations as included in Rule 61a

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2 In the early decision T 0113/92 the Board of Appeal "...considers the submission of a completely redrafted specification instead of a revised version of the printed patent publication ... as not appropriate because major parts of the patent publication have not been changed. Accordingly the Board and all of the parties of the proceedings have had to perform a time-consuming comparison of these unchanged parts of the specification with the printed patent publication instead of concentrating upon the only relevant question of whether the changes of the specification accommodate the changes of the claims. The submission of unnecessary complete reprints obviously violates the principle of process economy according to which proceedings should be performed as fast as possible, as purposeful as possible and as cost-efficient as possible." (see paragraph 3 of T 0113/92)

3 "To amend such documents in oral proceedings, the EPO recommends bringing a laptop or a similar device on which the amendments can be prepared. It will also provide suitable technical or other facilities. The rooms made available for patent agents generally contain computers which can read CD-ROMs, USB sticks, etc., together with printers which normally allow documents to be printed direct from USB sticks. The EPO recommends that parties bring electronic copies of documents likely to be amended, on a medium free of computer viruses or malware. It will also provide applicants and patent proprietors with electronic copies of their *Druckexemplar* or patent specification (EP-B)." (see official journal EPO, 12/2013, p. 603, 604)

EPC 1973 (now Rule 86 EPC, see the same wording in Rule 99 (3) EPC) does not necessarily mean that any rule contained in the chapter referred to is applicable. Instead, the Enlarged Board of Appeal underlined that it was obvious that some of the rules in the chapter referred to are in fact not applicable.

b) The decision T 0037/12 also cites documents dating back to the formation of Rule 61a EPC 1973 (now Rule 86 EPC), wherein the interim committee responsible for the introduction of Rule 61a EPC 1973 underlines that (due to the complexity of the present subject) in the opinion of the interim committee it was better to choose a general wording for the referral than to use a specific referral to single rules (dok.CI/Final 11/77 of October 14, 1977).

c) The decision further cites the document CA/PL 29/06 relating to the introduction of the amendment of paragraph 3 of Rule 99 EPC:

"Rules 76(3), 86, 92(1), 99(3) and 107(3) EPC refer to Part III of the Implementing Regulations. This means that the provisions of Part III are to be applied mutatis mutandis in opposition, limitation, revocation, appeal and review proceedings. Close analysis shows that numerous provisions in the third part of the Implementing Regulations can play an important role in these proceedings. Ample references are needed to ensure comprehensive coverage. In cases where Part III is generally to be applied mutatis mutandis, it will be necessary to establish whether and how a rule is actually applicable to a particular set of circumstances. Consequently, it will not matter if the reference is irrelevant in the case of one or the other provision."

(CA/PL 29/06 Add. 1, page 3).

d) As cited by the Board of Appeal, in the meeting of the Patent Law Committee of 19th to 21th September 2007 the EPO argued against respective opposing arguments of the epi:

"[D]etailed references in isolated cases would be less safe to use. Mutatis mutandis refers to formal requirements. In both case law and EPC, we have made good experience with wide references."

(CA/PL PV 30, page 19).

e) According to the Board of Appeal, in written proceedings the applicant is able to use adequate office devices for preparing amended documents to be submitted. The burden of the applicant to fulfil formal requirements by submitting printed or typed documents is balanced by the need of unambiguous clear documents used for the production of the patent publication (see Rules 50 (1), (2) and 49 (12) EPC). Instead, according to the Board of Appeal the situation is different in oral proceedings wherein any amendment has to be immediately identified in order to analyse the relevance and the admissibility of the amendment. Typed or printed amended documents require a word-by-word analysis, which collides with the economy of the proceedings. Furthermore, the representative has no access to the usual office facilities. Any typed or printed amendment necessarily requires a break of the proceedings with a

loss of time. According to the Board of Appeal, the interest of unambiguous and clear documents can be fulfilled by strict requirements concerning the legibility of the handwritten amendments.

f) The Board of Appeal underlines that there was no reason to change an established practice.

g) Further, the Board of Appeal states that the EPO had no legislative competence, which, however, would be required for a change of the established practice.

h) Finally, the Board of Appeal refers to T 1635/10 wherein it has been stated that the change of the established practice in appeal proceedings would deteriorate the efficiency of oral proceedings at the Board of Appeal.

On this basis, the Board of Appeal came to the conclusion that handwritten amendments were admissible for amended documents submitted in the oral appeal proceedings.

In T 0037/12 the Board of Appeal additionally stated:

"The question whether these arguments should not apply to the opposition proceedings in a comparable way may remain open because this question is not subject to the present decision. Instead, conversely it is to be analysed if it would be required to adapt the practice of the Boards of Appeal to that of the first instance. Due to the grounds given, this is not the case."

6. Conclusion and discussion

The answer to the question whether handwritten amendments are admissible should consider both the interests

- of the representatives, opponents and the members of the examination divisions, opposition divisions and Boards of Appeal (favouring the admissibility of handwritten amendments) and
- of the EPO favouring printed amended documents for an automated capture and printing.

The careful consideration of these interests might lead to different results in different states of proceedings:

a) In written proceedings it seems to be acceptable that handwritten amendments are not admitted because the involved parties have enough time and the required facilities for a thorough preparation and analysis of the amended documents.

b) However, handwritten amendments should be admitted in oral proceedings from the reasons specified in the decision T 0037/12.

Unfortunately the related rules (in particular Rules 49 (8), 49 (12), 50 (1), 86, 99 (3) EPC) leave a broad space for interpretations which might require a clarification by amending the Rules.

The involved different interests as summarized above might be completely satisfied by codifying the admissibility of handwritten amendments in oral proceedings with the additional obligation for the applicant or patent owner to submit confirming printed documents within a given term of e. g. two month after the date of the oral proceedings.

Unless any clarifying amendment is introduced into the Rules the cited decision T 0037/12 gives legal certainty for the representatives that handwritten amendments are admitted in oral proceedings in front of the Board of Appeal. However, concerning the admissibility of handwritten amendments in oral examination or opposition proceedings a clarifying notice of the EPO (overruling the former notice of November 8, 2013) would be highly appreciated.

(Deutsche Übersetzung)

6. Zusammenfassung und Diskussion

Die Antwort auf die Frage, ob handschriftliche Änderungen zulässig sind, sollte den Interessen

- der Vertreter, Einsprechenden und der Mitglieder der Prüfungsabteilung, Einspruchsabteilung und der Beschwerdekammern (welche die Zulässigkeit handschriftlicher Änderungen favorisieren) und
- des Europäischen Patentamts, welches gedruckte geänderte Dokumente für eine automatische Erfassung und den Druck favorisiert,

Rechnung tragen. Die sorgfältige Abwägung dieser Interessen kann zu unterschiedlichen Ergebnissen in unterschiedlichen Stadien der Verfahren führen:

- a) Im schriftlichen Verfahren erscheint es akzeptabel zu sein, dass handschriftliche Änderungen nicht zugelassen werden, da die Beteiligten genug Zeit haben und über die erforderlichen Einrichtungen für eine sorgfältige

Vorbereitung und Analyse der geänderten Dokumente verfügen.

- b) Hingegen sollten aus den in der Entscheidung T 0037/12 spezifizierten Gründen handschriftliche Änderungen in mündlichen Verhandlungen zugelassen werden.

Leider lassen die zugeordneten Regeln (insbesondere Regel 49 (8), 49 (12), 50 (1), 86, 99 (3) EPÜ) Raum für Interpretationen, was eine Klarstellung P durch Änderung der Regeln erfordern könnte.

Die oben zusammengefassten unterschiedlichen Interessen könnten vollständig befriedigt werden, wenn die Zulässigkeit handschriftlicher Änderungen in mündlichen Verhandlungen kodifiziert würde mit der zusätzlichen Verpflichtung für den Anmelder oder Patentinhaber, bestätigende gedruckte Dokumente innerhalb einer vorgegebenen Frist von beispielsweise zwei Monaten nach dem Datum der mündlichen Verhandlung nachzureichen.

Ohne jedwede klarstellende Änderung der Regeln gewährleistet die zitierte Entscheidung T 0037/12 Rechtssicherheit für die Vertreter dahingehend, dass handschriftliche Änderungen in mündlichen Verhandlungen vor der Beschwerdekammer zulässig sind. Hinsichtlich der Zulässigkeit von handschriftlichen Änderungen in mündlichen Verhandlungen vor der Einspruchsabteilung oder der Prüfungsabteilung wäre eine klarstellende Mitteilung des Europäischen Patentamts (unter Aufhebung der vorhergehenden Mitteilung vom 8. November 2013) wünschenswert.