

How I read Board of appeal decisions

by Oliver Randl

Please note that what follows is a description of my personal practice; I certainly do not pretend that it is exemplary in any way. It has allowed me to read and digest more than 4000 Board decisions so far, but purists might be horrified. So please take this as a testimony rather than as an instruction on how it should be done.

- Obviously, **G decisions** should always be **read very carefully**. As a rule, however, I only read the questions, the complete reasons for the decision and the order. I do not spend much time on the referral history as well as on the submissions of the parties, possible *amici curiæ* briefs or the opinion of the President, if there is one, and I hardly ever felt the need to come back to those parts.
- In **J decisions** I read the facts of the case attentively, but I usually do not dwell on the parts of the decision that summarise the submissions of the parties. If needed, I come back to those parts later on. I read the entire reasons for the decision, from A to Z.
- Regarding **T decisions**, I have developed a method allowing me to detect any relevant passage very quickly. Some years ago, Jelle Terpsma published a method on his blog¹, which was quite similar to what I do. The following also applies, *mutatis mutandis*, to **R decisions**.
 - First, I identify the nature of the appeal (examination or opposition), of the decision (refusal, revocation, maintenance in amended form, rejection ...) and of the appellant(s). The Boards usually refer to the parties as ‘appellant’ and ‘respondent’, which is not always helpful to the reader, who needs to know whether this refers to the the patent proprietor or the opponent.
 - I jump right away to the reasons for the decisions. I read the headers of the sections, some of which are merely formal or very short and can be more or less ignored. If a section is relatively long, I read the first line of each paragraph, which allows me to understand where the decision is going. With some experience, one does not need more. If the passage turns out to be interesting, then I obviously slow down and read very carefully. Often the accumulation of case law citations (which are easy to spot) will help me find the core passages.
 - You will note that I have not read the claims so far. Depending on the nature of the decision, I may have to go back and read the relevant claims when they are discussed. This way of proceeding has the advantage that I will not have to read claims corresponding to requests which the Board has finally dismissed because they were found not to be admissible or for some other reason that is not particularly interesting in itself.
 - Typically, it takes me two minutes or so to read a decision that does not contain any passage that I find noteworthy. Beginners might need more time, but they will progress quickly.
 - I keep a list of the decisions I have read, because I do not want to do the work twice.
 - I then also annotate my personal (electronic) copy of the EPC, but that is another matter ...

¹ eqetools.blogspot.fr/2009/09/how-to-read-decisions.html