PRACTICE WITH REGARD TO CONSIDERATION OF LATE-FILED REQUESTS AND EVIDENCE

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1. The principle of having time limits is essential in every legal system. The philosophy of having a well controlled time table in any proceedings is based on the necessity to have a clear methodology of action which in itself determines the rights and obligations of parties. Rules about time are therefore contained in all legal instruments that deal with the substantial rights of people. Time limits aim primarily at preserving the need for certainty, precision and delineation of rights that may properly and validly be pursued or may be liable to dismissal.

   Time schedules, largely contained in civil and criminal procedures, rules and regulations made under any law, including bilateral or multilateral conventions, are therefore viewed as procedural requirements, but partake also of substantive law, as a right can be extinguished or not emerge in the legal sense if not processed within the allotted time period.

   Limitation of actions from a jurisprudential point of view is inherent in every system the idea being as from 1623 that a right or a potential action, especially where damage has occurred, cannot possibly

stand alive for ever[1]. Matters relating to the preservation of the necessary evidence for both the plaintiff and the defendant is but an essential tool in the proper administration of justice. The theory behind it is that persons with a good and valid claim should pursue their rights with due diligence, the maxim being "vigilantibus non dormientibus subvenit aequitas"

2. The inquisitorial nature of proceedings before the EPO as opposed to the accusatorial nature has its own consequences. The traditional common law system and the continental legal system differ in many respects that also affect the proceedings followed. Whereas in the common law system the judge is an umpire who has nothing to do with the way the parties before him are to present their case and does not traditionally view his role as one that obliges him to enter the arena of the proceedings or trial, in the continental system, this is the norm. By necessity this means that the judge steps into the arena and has a say in the management of the proceedings. He may enquire into the substance of the case and may enquire the parties about the evidential aspect of each assertion they make and ask for such evidence to be produced[2]. This whole way of dealing with the case has its own consequences upon the principles that affect the time schedules to be observed, the evidence to be produced as well as the stage in the proceedings that this is to be done.

[1] Sir G. W. Paton: A textbook of Jurisprudence, 3rd Ed., p. 452.
[2] For a philosophical exposition of the two systems see Albert A. Ehrenzweig: Psychoanalytic Jurisprudence, pp 219-235 (on civil procedure) and Glanville Williams: The Proof of Guilt: The Hamlyn Lectures (on criminal procedure).

3. Article 114 of the European Patent Convention enshrines and entrenches the inquisitorial principle. It has given rise to a considerable body of case-law as it is well known and will continue to do so. It is contained in PART VII of the E.P.C. under the general title of "Common Provisions" and the sub-title "Common provisions governing procedure". Article 114(1) gives the European Patent Office considerable power as it provides that it has the responsibility to "….. examine the facts of its own motion". This is a basic principle of an inquisitorial nature that puts the burden on the EPO to "enquire" in essence into the facts. It is supplemented by a second provision that complements and also augments the first in that it provides that the EPO "….. is not restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought". There is yet another principle to be found in Article 114(2) which states that the EPO may disregard facts and evidence not submitted in due time. These two principles are in contradiction as is evidenced by case law and various articles on the matter[3].

The first subsection of Article 114, marks a difference with the traditional common law system of UK, Ireland and Cyprus[4]. As far as time limits are concerned, it appears from the case law of the EPO and the various provisions of the EPC and the regulations made thereunder, that there is a considerable degree of discretion given to the various bodies of the EPO as well as the President and

[3] Michael Lewenton: "Time limits for submitting new facts and evidence in proceedings before the courts or patent offices". Special Edition of the Official Journal of the EPO 1999, p. 202.
[4] Although changes in civil procedure rules over the years have given an enhanced managerial role to the judge.

this holds true for all procedural stages, including the examination, the opposition, the oral proceedings and the appeal stage[5].

4. It appears from the development of the case law in the EPO that although the most important principle that runs through the cases with regard to the acceptance of late filed requests and evidence is the criterion of relevance, the stage involved in the proceedings makes a difference. First instance proceedings are considered to be of an administrative character[6] while appeal proceedings are of a judicial nature or do provide adequate judicial review[7]. It is easier to accept a late filed request and evidence because of its relevance in the first case rather than in the second case where the documents and evidence to be submitted should be considered to be highly relevant as opposed to just relevant. Other criteria that affect the acceptance of late requests which also interact with relevance in various ways are the factors of delay, the reasons for the delay, the nature of the late filed evidence, the complexity of the issues involved, the right to be heard, the possible change in the circumstances of the party or his representative and other circumstances extraneous to the proceedings, the possible abuse of the proceedings and the need to have finality.

5. Cyprus has been introduced into the Common Law System by the British during its colonial years from 1878-1960. Procedure wise it is an accusatorial system and not an inquisitorial one. This in practice means that the judge or tribunal will not enquire into facts or evidence nor will they take upon their shoulders the burden of

[5] See, for example, rules 56(2), 57(1), 57(a), 71a(1) and 72.
[6] Case T1002/92, O.J. 96, 605.
[7] Lenzing AG´s European Patent (UK) (1997) RPC 245 at p. 277.

requesting the production or submission of evidence or arguments. This leaves the handling of the case upon the opposing parties. The plaintiff or applicant, as the case may be, will submit his writ of summons or originating motion in the time he chooses to file a suit, his only restraint being any limitation period which by necessity must be observed. After filing the writ the defendant must enter an appearance within 10 days after service and also file his defence within 14 days after service of the statement of claim. All these are well regulated time wise.

Now, the mechanics of all these are not important for the purposes of this presentation except to stress that all these procedural measures necessitate the filing of pleadings, i.e. documents that set out in accordance with well defined rules the claim or defence as the case may be. Once a pleading is filed, a party is generally bound by it and no pleading, be it a statement of claim, a defence or counterclaim may be amended except for good cause. All time limits set out in the civil procedure rules complement the whole machinery of pleadings so that the whole process moves quickly enough, at least in theory.

Pleadings are likened to the rails upon which a train smoothly moves on. It is therefore necessary to define well in advance and with the utmost care and precision the set of facts that the pleader wishes to aver so that later, during the trial process, the claimant or the defendant may adduce his evidence within a well established factual framework. The parties, both plaintiff and defendant must prepare their case in a way that all material allegations and assertions, themselves conforming to the rules of pleadings, be stated in simple

terms. The same holds true for any counterclaims or pleadings exchanged between a defendant and any third party the defendant chooses with the leave of the court, to bring into the proceedings. Evidence adduced outside this basic factual framework will as a rule be disregarded as it will be considered to have moved outside the pleadings and the train is therefore said to be derailed. A series of decisions emphasize the need to follow the prescribed rules of pleading so as to aver only facts in simple terms and not evidence. The pleadings set out the parameters of the trial[8], while they delineate the triable issues. In civil actions the court should restrict itself to the issues that are in dispute and which are validly formulated at the close of the pleadings or lawfully added thereto by the trial time[9]. It is a mistake in law reversible on appeal for the court to deal with and decide issues that are not pleaded[10].

It is therefore quite important for a pleader to have decided what issues are to be fought out in court and what evidence is there to support them by the time he is ready to settle the claim or defence.

6. It often happens that pleadings need to be amended either prior or during the trial. The power to amend pleadings mitigates to a large extent the strict rule that a party is bound by his pleadings[11]. To this end one may properly correlate the amendment of pleadings in civil actions with late filed requests within the EPO procedure. The need to amend pleadings usually stems either from an incomplete or negligent pleading to begin with in the sense that the pleader has

[8] Loucaides v. Alithia Publishing Co. Ltd (2003)1 C.L.R. 22 (C.L.R. means Cyprus Law Reports).
[9] Merkis v. Intertobacco (Cyprus) Ltd (2003)1 C.L.R. 1091.
[10] Latifundia Properties Ltd v. Psakis (2003)1 C.L.R. 670.
[11] Bullen & Leake: Precedents of Pleadings, 12th Ed., p. 123.

either not thought out his case well enough on the substantive issues and the applicable law on the facts, or from the fact that he did not have enough information to formulate a complete statement of claim or defence. If the first is the case, the court will usually allow the amendment prior to the hearing of the action, as will be discussed further below, but not after the trial begins. If the second be the case, the amendment will be allowed if the applicant satisfies the court that he did not have all the necessary information at the time he first settled his pleading. Should a claimant or a defendant find out that his pleading needs to be amended, he should ask for it at the earliest possible moment and as promptly as possible for although an amendment is possible at any stage of the proceedings down to the trial or even, exceptionally on appeal, a timely application stands a better chance of success.

7. The overriding principle in common law is that all amendments ought to be allowed "for the purpose of determining the real question in controversy between the parties to any proceedings or of correcting any defect or error in any proceedings"[12], provided the amendment sought is relevant to the issues. The ultimate determining factor is that the court should have before it a complete picture of the triable issues, that is the issues that the parties select to bring before it in order to have the court´s decision finally and fully. In one of the cases it has been reiterated that: "The exact definition of the issues, as well as the setting out of the position of each party, together with their proof in a well defined framework is another important factor that comes into play in exercising the court´s discretion"[13]. An

[12] G. L. Baker Ltd v. Medway Building and Supplies Ltd (1958)1 W.L.R. 1216.
[13] Kallice Holding Co Ltd v. MTR Metals (Overseas) Ltd (1996)1 C.L.R. 162.

amendment, as a rule, is allowed at any stage of the proceedings as long as there is absence of mala fides on behalf of the applicant. An amendment however will not be allowed if it is considered that the other party cannot be satisfied by the payment of costs.

8. Depending on the stage of the application for an amendment and the reasons advanced the court may allow or decline the amendment. As a rule, prior to the hearing of the action leave is readily granted irrespective of the negligence shown in formulating the pleading. As stated in a well known case[14]: "Before the hearing leave is readily granted, on payment of the cost occasioned, unless the opponent will be placed in a worse position than he would have been if the amended pleading had been delivered in the first instance …." So it appears that prior to the beginning of the trial itself, before the parties start adducing evidence, examining and cross examining witnesses, an amendment may be allowed despite the fact that the pleading is bad in the sense that it has omissions and does not adequately and sufficiently set out all the necessary facts. So, no matter how negligent, careless and late an application for amendment, the principle is to allow it if by so doing the other party is not prejudiced to such an extent that he may not have a fair trial at the end of the day.

It is quite a different matter, however, where the trial has already begun and evidence has been unfolding, each party fighting out the merits of his case. The courts usually disallow applications for amendment during the trial where the allegation of fact applied for to be inserted in the pleadings, has been known to the applicant or

[14] Tildesley v. Harper 10 Ch. D. 393.

could, with due diligence, been known to him prior to the trial. Where the evidence to be introduced by the amendment was with the party applying for it long ago, the amendment will not be allowed in view of the fact that the trial itself will be derailed, the hearing will be protracted while the opponent will not have his rights and obligations determined at the earliest possible time. When such factors are at stake the opponent cannot be compensated by an award of costs or other terms[15], the trial will not be fair and thus the amendment cannot possibly be allowed. Where, for example, the trial was well on its way, and one party has completed his side of the evidence and the other party started calling his own witnesses, an application to amend at that late stage when the facts were known to the applicant, even before the trial began, was not allowed[16].

In one case involving damages for a road traffic accident the plaintiff introduced at various stages four different applications for amendment of the statement of claim in order to introduce matters relating to surgical operations and consequential special damage resulting to the plaintiff. However, the fourth and last application was not allowed with regard to three of the items since the court found that they could have been included in the second application for amendment. The application was allowed only with regard to an inconsequential amendment concerning facts that have arisen later than the second application[17].

[15] Such as security for costs, Budding v. Murdoch (1875)1 Ch D 42 or an adjournment of the trial.
[16] Strintzis Aegean Nautical Lines Company v. Always Travel Holidays Ltd (1995)1 C.L.R. 606.

[17] Dimitrov v. Ioannou (2003)1 C.L.R. 1645.

It sometimes happens, especially in damages actions, that there is a variance between the evidence adduced at trial without objection with the exact facts pleaded. In such a case, if the court accepts the evidence so introduced it will, at the end of the day, and as a prerequisite to the judgment being drawn up, order the statement of claim to be amended, so as to accord with the accepted evidence and the judgment[18].

9. It is incontrovertible that any amendment would by necessity affect the speedy trial and the adjudication of the rights and obligations of the parties involved. The principle of avoiding multiplicity of issues and proceedings, on the one hand (which might allow for necessary amendments), and the principle of speedy trial, on the other hand (a right included in the principle of fair trial), are in apparent contradiction. The right to be heard fully, which may allow amendments, must be subdued to the right of an overall fair trial, especially where an amendment or a series of amendments would prolong the trial beyond what would be considered reasonable in the circumstances. Various decisions stress the need to administer justice within a reasonable time which includes the right of the opponent to have a judgment at the earliest possible moment. Since the court is the ultimate manager of the case[19] retaining overall control of the proceedings, an amendment may not be allowed where the trial is unnecessarily lengthened violating the principle of fair trial[20]. The conduct of the parties themselves is taken into account in relation to the delay of a trial under Art. 30.2 of the

[18] Constantin v. Antoniades (2004)1 C.L.R. 1701.
[19] Koulermos v. Koumbaridou (2000)1 C.L.R. 493.
[20] Efstathiou v. Police (1990)2 C.L.R. 294, Gregoriou v. Bank of Cyprus Ltd (1992)1 C.L.R. 1222, Donna Damien: Short Guide to the European Convention of Human Rights, p.p. 58-59 (A Council of Europe Publication).

Cyprus Constitution or its counterpart Art. 6 of the European Convention of Human Rights[21].

It must be understood that the introduction of new evidence is possible only upon an amended pleading where the matter was not properly introduced in the first place. After all the very reason for amending a pleading is to enable the party to rely on such evidence supportive of his new allegations. One basic factor in accepting amendments is their relevance to the issues. Therefore, if the matter to be introduced is highly relevant for the proper adjudication of the issues, it will usually be allowed even if the amendment would necessitate introducing a new cause of action, altering the capacity in which a party sues or is sued, putting forward a point of law or a new view of the law or adding, but only if thought unavoidable, fraud allegations. Such amendments are highly relevant since their introduction might dispose of the case on legal matters at an early stage. Pleading, for example, a point of law that disputes the capacity of the party to sue or the territorial or substantial jurisdiction of the court must be decided, usually upfront, as they are likely to dispose of the case without necessarily going to the merits[22]. Amendments which are thought to be dishonest and mala fides are not allowed, even if the matter to be introduced is relevant. Where an application for amendment is not made in good faith, that is the amendment sought is not substantial or true and is made for an ulterior motive or it tries to introduce matters of fraud which were not pleaded in the first instance, without good reason, it will be refused.

[21] Municipal Council of Aglantzia v. Chariclides (2001)1 C.L.R. 1608, Union Alimentaria Sanders S.A. v. Spain Series A 157, Publication of the European Court of Human Rights, par. 35 (1989).
[22] For example, all equitable defences must be specifically pleaded: Sutcliffe v. James 40 LT 875, Ioannou v. Charalambides (1998)1 C.L.R. 555.

Likewise, immaterial or useless amendments are not allowed as such an amendment will halt the flow of the trial without good cause. Abuse of proceedings is yet another good reason for disallowing an application to amend the pleadings. Abuse of process might arise in a variety of circumstances including pursuing the same cause or result with various means or by a multiplicity of applications[23].

10. Amendments themselves have to conform to certain time limits, i.e. an amendment properly allowed by the court must be filed within a certain period of time usually set out by the civil procedure rules or decided upon by the court itself. An amended claim takes effect from the time the original claim was filed. Any subsequent pleading must also be filed within the prescribed period and if either the amended claim or defence are not filed they will be considered ipso facto void. However, the court may extend or enlarge the time in the interests of justice and such enlargement may be ordered although the application for the same is not made until after the expiration of the time so allowed. The principle is that the court has the discretion either to extend and enlarge the time, or even abridge the time in order to avoid injustice to the parties. The reasons for extending the time must be given by the applicant and he will ordinarily be made to pay the costs occasioned. Any time limits are calculated on the basis that Saturdays, Sundays, public holidays, as well as the day the order is made are excluded. In other words, when an order is given specifying the time within which an amendment should be filed, the days given should be clear days[24]. Should the applicant fail to proceed promptly or within any extended or enlarged period of

[23] In re Jennaro Perrella (Habeas Corpus Application) (1995)1 C.L.R. 217.
[24] See the similar provisions in Rule 83 of Regulations EPC.

time with his amendment, the other party is free to apply to dismiss the action for want of prosecution. Failure to proceed within a reasonable time might also be considered as an abuse of the proceedings[25].

11. A comparison may now be attempted between the principles obtained in a common law country and those in the EPO: It should be pointed out at the outset, however, that the word “comparison” might be unfair as one compares in essence two conceptually different systems each designed to promote its own end. It would therefore be more accurate to say that what follows is just a few highlights that stand out. As stated before, there is almost a direct parallel between late filed requests and applications for amendment. It is crucial, since the title encompasses evidence, to stress once again that neither system will allow new evidence to be taken into account unless there has been a prior successful request or amendment to redefine, so to speak, the framework of an application for granting a patent or of proceeding with an action in court. Certain basic differences may immediately be discerned. They stem from the inquisitorial system of the EPO and the characterization of proceedings. The EPO bodies have clearly a duty to enquire into facts which gives them substantial managerial powers. Acting mainly under Art. 114(1), the EPO ex officio examines the scope of an application, opposition, etc. (see, for example, T387/89 (OJ 1992, 583) and admits into the proceedings whatever material may have a bearing on the outcome of the case (see T588/89). The case law of the EPO has established that the principle of Art. 114(1) takes precedence over the exclusionary rule of Art. 114(2) (see T158/84

[25] Iacovides v. Georghiou (1999)1 C.L.R. 1048.

OJ 1988, 372), although later Art. 114(1) has been applied more restrictively at least in appeal proceedings[26]. In the first instance proceedings, due to their administrative character, relevance is mainly the criterion for late-filed requests, relevance in essence meaning the bearing the late request and material might have on the maintenance of the patent. The less investigative nature of appeals, however, considered as of a judicial nature, sets the criterion for acceptance of late-filed requests much higher and only very exceptionally are such requests admitted. This dichotomy and possibly the emergence of different standards of acceptance does not exist in the common law system where all stages and procedures are of a judicial character applying the same principles and standards.

Another difference that does not hold true for the common law courts, is that under Art. 114(1) reasons need be given but not so if the board decides not to admit new citations filed late under Art. 114(2), where no detailed reasons are necessary (see T71/86, T11/88).

The examination/opposition process with its inquisitorial nature paves the way for yet another difference. The applicant for a patent might react to various observations made by the rapporteur or the opponent (see T626/90, T1059/92), or, at various stages of the proceedings. As stated before in the system of pleadings, at least in the Cyprus experience, the pleader has to be very careful right from the beginning as regards the settlement of his client´s case. There is in general no observation made by anyone so as to put the

[26] M. Lewenton – supra – p. 1999.

claimant on his guard in the judicial proceedings before any court, first instance or appellate. Any averments in defence be they a denial or a confession and avoidance are part of the formalities of pleadings serving quite a difference purpose.

It appears from a study of the case law of the EPO that to the main criterion of relevance, new criteria have been added such as belated requests, delay of proceedings, abuse of process, etc, thus bringing the overall criteria closer to the common law principles of amendment. One could also count as a difference the way such notions as “restitutio in integrum” and “volenti not fit injuria” are applied in the EPO proceedings. The restitutio principle is expressly set out in Article 122 and it is designed to accommodate late submissions and other applications filed out of time. The volenti principle has been used in T259/94 as to allow, two years after filing the appeal, new evidence and documents. Both notions, as applied at least in the common law countries, deal with substantive tortious or contractual rights and have nothing to do with procedural aspects or tactics.

It appears that there are also a number of similarities. First of all, the matter to be introduced as an amendment should be relevant to the issues. Secondly, the request or application for amendment must be filed or asked for timely. The later the stage at which it is applied for the lesser the chances of success. The complexity of the case is also a factor for consideration. If the case is highly complicated, then an amendment or request will be refused if the amendment will introduce matters which will complicate the case even further. This is particularly true in the EPO system, where a technical board may

have before it a complicated and novel technical or scientific invention and the applicant might wish to introduce the outcome of further experiments which will not give enough time to the other party to make its own experiments. The necessity of having a speedy trial and a final adjudication of the rights and obligations of the parties at the earliest possible moment is also a criterion that holds true in both systems. The right to be heard also includes the right of the opponent to have a judgment pronounced as soon as possible.

It is not always easy to reconcile the principles with the actual case law. One finds upon a study of the subject that there are many cases that are decided differently apparently applying the same principles and one might come to the conclusion that there are conflicting principles instead of conflicting case law. However, as with any legal application, also in the field of amendments or late filed requests, a lot depends upon the particular circumstances of each case. A slight variation in a given set of facts might produce a different outcome. One therefore cannot properly speak of conflicting principles, but of different applications according to the circumstances. The end result, however, might be the same in that both systems have as a common denominator to do justice in the circumstances of a case, the purpose being to give a decision on the merits having heard everything that can be said for and against. The new rules of procedure of the Boards of Appeal are to be interpreted so as to enable a patentee to file any auxiliary requests "….. during the course of the written procedure as well as within a

reasonable time period before the oral procedure", maybe allowing for one or two months[27].

Finally, it could perhaps be said that in a system in which finality of proceedings and the need to see that there is no undue delay are of primary concern, better regulated time limits as regards appeals could strengthen the whole substratum of procedure within the administration of the EPO. Reference here is particularly made to the provision of Art. 110, which gives the power to the Board of Appeal to invite the parties "as often as necessary to file observations within a period to be fixed by the Board of Appeal ….." a provision that adheres to the inquisitorial nature of the proceedings but which, perhaps, leaves too much at the discretion of the Boards and might delay the proceedings, although it is noted that amendments to a party´s case will be viewed with "procedural economy" in mind in accordance with Art. 10b(1) of the Rules of Procedure of the Boards of Appeal.

As a general remark one could say that time limits are always tricky. It has rightly been observed that these very time limits are partly responsible for the complexity of the whole system of patent application and registration[28].

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[27] Axel Casalonga: Attitude of the Boards of Appeal toward Auxiliary requests filed shortly before the Oral Procedure.
[28] Cornish & Llewlyn: "Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, 5th Ed., p. 157, par. 4-23.