Auxiliary requests on appeal

Convergence, carry-over, and procedural discipline

On 1 January 2024, the EPO's new Rules of Procedures of the Boards of Appeal (RPBA) entered into force and significantly limited the parties' ability to amend their cases on appeal. According to Article 12(2) RPBA, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based. This provision is accompanied by Articles 12(4) RPBA and 13(1) RPBA. The former specifies that any part of a party's appeal case which does not meet the requirements of Article 12(2) RPBA is to be regarded as an amendment, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal. The latter specifies that any amendment to a party's appeal case after the filing of the grounds of appeal or reply is subject to the Boards' discretion. In particular, introducing new means of attack as well as new means of defense (like auxiliary requests) are considered amendments of a party's case.

Article 12 RPBA – Basis of appeal proceedings

(1) **Appeal proceedings shall be based on**

(a) **the decision under appeal** and minutes of any oral proceedings before the department having issued that decision;

....

(2) In view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, **a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based**.

(3) The statement of grounds of appeal and the reply shall contain a party's complete appeal case.

...

(4) Any part of a party's appeal case which does not meet the requirements in paragraph 2 is to be regarded as an **amendment, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal**. Any such amendment may be admitted only at the discretion of the Board.

Article 13 RBPA – Amendment to a party's appeal case

(1) Any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to the party's justification for its amendment and **may be admitted only at the discretion of the Board**.

The new RPBA have been in force for over two years now. This article analyses the Boards' practice pertaining to auxiliary requests.

The overall picture is: The Boards are strict where a party files late requests that change the line of defense, revives abandoned requests, or »moves the target«. However, the Boards are more receptive where a request was timely filed and maintained in the first instance, or where a late request is a genuine reaction to a changed procedural situation and stays on the same technical path.

The discussion used to circle around whether or not a set of auxiliary requests was **convergent** and, if not, at what point of the proceedings it had to be convergent (i.e., with the Grounds of Appeal or at the oral proceedings before the Board). Now, the most current issue is how **»carry-over« requests** (i.e., auxiliary requests that were already filed in the first instance but are not part of the decision because the patent was maintained based on a higher-ranking request) are to be treated on appeal and what counts as the correct reference point relative to which the amendment of a party's case under Articles 12 and 13 RPBA is to be assessed.

»Carry-Over« Requests

When it comes to »carry-over« requests, two lines of case law have developed.

The strict case law

T 0246/22 is the starting point for the stricter line. The Board held that the party bears the burden of demonstrating that »carry-over« requests were admissibly raised and maintained in the first instance (headnote I). The Board concluded that the minimum requirement for demonstrating that claim requests were »admissibly raised« is twofold (headnote II). First, the party needs to show that the requests were filed in due time, typically before the expiry of the time limit set by the Opposition Division under Rule 116(1) and (2) EPC, and, second, the party must also demonstrate that it was made clear, either explicitly or by way of unambiguous implication, for what purpose the requests were filed, i.e., which objections raised by the other party or the Opposition Division they are trying to overcome and how this is actually achieved. The Board also refused several requests filed on appeal because they were considered not suitable to address the relevant issues and not convergent.

This strict line was also applied in T 2124/21, where the Board emphasized and reinforced procedural discipline. In a written reply to the Board's communication under Article 15(2) RPBA, the appellant withdrew the Main Request

and the First Auxiliary Request and requested the grant of a patent based on a previously lower-ranking request. However, the request underlying the appealed decision had been abandoned on appeal and later re-submitted only after the Board's communication under Article 15(2) RPBA. The Board treated that reversion as an amendment under Article 13(2) RPBA, found no exceptional circumstances, and refused to take it into account. In practical terms, this decision warns against »toggling« between auxiliary requests once the appeal case has been defined.

T 1135/22 is also important for »carry-over« requests as it confirms that **there is no automatic admission of requests filed in the first instance into the proceedings of the second instance**. The Proprietor filed twelve auxiliary requests in a timely manner, i.e., before the expiry of the time limit set by the Opposition Division under Rule 116(1) and (2) EPC. However, the patent was maintained as granted and the requests were not discussed before the Opposition Division. The Proprietor argued that these requests were part of the appealed decision because the requests were listed as requests in the decision. The Board disagreed with the proposition that auxiliary requests filed in opposition and pursued unchanged on appeal were automatically part of the appeal proceedings and rejected any simple automaticity. Nevertheless, the Board made use of its discretion and nonetheless admitted one of the auxiliary requests. This case points away from an automatic-rule theory, while still accepting that a »carry-over« request may be admitted on the facts.

T 0449/23 marks one of the strictest interpretations of the term **»any amendment to a party's appeal case« in Article 13(2) RPBA**. The Board contrasted amendments of a party's appeal case referred to in Articles 12(4) and 13(2) RPBA. The Proprietor filed Auxiliary Requests 2 to 8 the day before the oral proceedings before the Board and argued that, having already been filed during first instance proceedings, these requests were »carry-over« requests. Therefore, to determine whether such requests represented an amendment to its appeal case in the sense of Article 13(2) RPBA, the criteria set out in Article 12(4) RPBA were to be applied. The Board disagreed and held that the reference point for Article 13(2) RPBA is the party's earlier appeal submissions, not the wider first-instance record under Article 12(4) RPBA. Indeed, the amendment referred to in Article 12(4) RPBA is an amendment of the party's case relative to its requests, facts, evidence, arguments and objections **on which the decision under appeal is based**. This is distinct from »amendments to a party's appeal case« in Article 13(2) RPBA, carried out at a later stage of the appeal proceedings relative to earlier submissions in appeal. The Board even held that **deleting independent claims can amount to an amendment of a party's case** because it creates a new object and »moves the target« of the appeal discussion.

The more lenient case law

In contrast to the above decisions, T 1686/21 shows the countervailing, more lenient line of recent case law. Its catchword states that exceptional circumstances may justify admission of a request first filed at oral proceedings before the Board **even where the relevant added-matter objection to be overcome by the request had been raised long before**. The Board reasoned that the Opposition Division had already construed the claim, albeit erroneously, to implicitly comprise the feature of the amendment which had appeared in several first-instance auxiliary requests and was re-submitted in response to the objection on appeal to address the objection raised by the Appellant. The Board concluded that the request was not surprising, and that the number of auxiliary requests for providing *»appropriate fall-back positions for every possible outcome of the assessment of compliance with Article 76(1) EPC would have been extremely high and, as therefore not compliant with procedural efficiency«* (Reasons 1.5). Therefore, the Board concluded that the admittance of the request was justified.

A similar approach was followed in T 1522/20, moving the case law in a more permissive direction. The Board concluded that Auxiliary Request 4 was *»admissibly raised and maintained in the proceedings leading to the decision under appeal«*. Even though this request was not discussed in the first instance (because the patent was maintained based on a higher-ranking request), the Board concluded

that it had no power to disregard it in the appeal proceedings under Article 12(4) RPBA (Reasons 5.1.4). Hence, at least some Boards are prepared to treat a properly preserved first-instance auxiliary request as already belonging to the appeal case rather than as a fresh amendment, even if this request was not discussed in the appealed decision.

T 1178/23 sharpens that approach and is probably the most important pro-admittance decision after the strict line of case line discussed above was introduced in T 0246/22. The Board concluded that the decisive question for »admissibly raised« under Article 12(4) RPBA is whether the first-instance department would have admitted the request under the rules and practice applicable at the time (Headnote). The Board criticized post-factum »minimum requirements« as potentially undermining legal certainty, relied on the first-instance perspective and the then-current Guidelines, and concluded that a request filed by the deadline set under Rule 116 EPC and maintained in opposition was not an amendment of the appeal case (Reasons 49 and 50).

Convergence

Even though the focus has shifted away from the »convergence requirement«, this requirement has not fully disappeared. **While T 1463/22 is one example of the Board refusing to treat »non-convergence« as decisive, T 0691/24 relied on the »convergence criterion«**. In detail:

In T 1463/22 the Board concluded that the amendment stayed on the same technical line and thus the »convergence criterion« was not to be taken into account. Although the Opponents argued that the new request was not convergent and pertained to an intermediate generalization, the Board admitted it because it was a reaction to a new claim interpretation first presented by the Opposition Division at oral proceedings, addressed the same central issue, did not shift the focus of the case, and was neither complex nor detrimental to procedural economy (Reasons 2.7 and 2.8).

In contrast, the Board in T 0691/24, which is one of the clearest recent decisions expressly addressing non-convergence, concluded that the »convergence criterion« may be used to not admit auxiliary requests (Reasons 1.1.3 to 1.1.6). The decision upheld the Opposition Division's exercise of discretion and thereby confirms that lack of convergence remains a legitimate admissibility criterion, especially in the context of late-filed requests.

Summary and Outlook

The Boards' practice may be summarized as follows: »Carry-over« requests are not automatically safe. Recent case law shows a real split in emphasis: T 0246/22 insists on a party-driven demonstration that the request was admissibly raised and maintained, while T 1178/23 and T 1522/20 are more willing to ask how the first-instance department would have treated the request and to regard such requests as already part of the appeal case. Late-filed requests can still get in, but usually only where they are a proportionate response to a procedural development and remain on the same narrowing path. However, late requests are usually refused and even deleting claims may be objected to because even a »mere deletion« can be an amendment if it alters the object under debate.

Convergence still matters, especially once a request is filed late or after the appeal case has crystallized. Requests that branch off, sit at intermediate scope without a clear justification, or change the focus of debate are vulnerable.

To be on the safe side on appeal, proprietors are advised to continue to aim for a single, clearly narrowing auxiliary-request ladder, expressly identify any »carry-over« requests in the grounds of appeal or the reply, and explain why each request either belongs to the appeal case already or, if filed later, does not shift the focus and is prompted by a concrete procedural development.

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