

Latin in IP:

Res judicata and *ratio decidendi*

Two Latin terms every EPO practitioner should distinguish

Reflecting long-standing legal tradition, a number of Latin expressions continue to appear in IP case law. A Latin term can capture a complex procedural concept concisely and across the different languages of proceedings. After the first part¹ of this series on *reformatio in peius*, this article turns to two further Latin expressions that are particularly important in European Patent Office (EPO) appeal practice.

Res judicata* and *ratio decidendi

Among the Latin expressions that still do real work in European patent procedure, *res judicata* and *ratio decidendi* are particularly important. Both concern the effect of earlier decisions, especially decisions of the EPO Boards of Appeal. They are both often invoked after remittal. Yet they are not the same.

In simplified terms, *res judicata* means that a matter has been finally decided. *Ratio decidendi* means the decisive reasoning of a decision. Under Article 111(2) EPC, that reasoning binds the department of first instance after remittal, in so far as the facts are the same.

The distinction is not merely academic. It may determine, for example, whether a request can be refiled, whether a new objection can be pursued, whether a department of first instance has competence to decide, and whether an appeal fee may be reimbursed following a procedural violation.

***Res judicata*: the matter has been finally judged**

Res judicata literally means »a matter judged«. In procedural law, it denotes a matter finally settled by a court or tribunal of competent jurisdiction. Once a decision has the force of *res judicata*, the same parties cannot relitigate the same claim, request, demand, or cause of action.

Although the EPC does not expressly use the term *res judicata*, the Boards of Appeal recognize it as a generally accepted procedural principle under Article 125 EPC.



¹ MALinsight Vol. 6, April 2026, p.36-38

The classic formulation appears in early decisions such as **T 934/91**, where the Board referred to *res judicata* – citing Blacks Law Dictionary, 5th Edition – as:

»... a matter finally settled by a court of competent jurisdiction, rendering that matter conclusive as to the rights of the parties and their privies [...] constitute[ing] an absolute bar to subsequent legal action involving the same claim, demand or cause of action and the same parties or their privies.« (see T 934/91, Reasons 3)

Thus, a Board of Appeal decision is generally final when issued. There is no ordinary appeal from a Board decision under Article 106 EPC. The limited possibility of a petition for review under Article 112a EPC does not alter the general principle that Board decisions are final once issued².

Ratio decidendi: the reason that decides the case

Ratio decidendi literally means »the reason for deciding«. It is the legal or factual reasoning that determines the outcome of a decision.

It should be distinguished from the *order*, i.e., the formal operative part of the decision, or *obiter dicta*, i.e., comments or observations not necessary for the outcome, as well as from a general legal discussion that does not form part of the decisive reasoning.

At the EPO, *ratio decidendi* is particularly important because Article 111(2) EPC gives it binding effect after remittal:

»If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same.«

The *ratio decidendi* is normally found in the Reasons for the Decision, not only in the order. A remittal order may simply say that the decision is set aside and the case is remitted. The actual limits of what remains open are often found only by reading the reasons.

In practice, the operative part and the reasons must be read together. The order determines what has formally been decided. The reasons identify why it was decided and, after remittal, may define the boundaries of what remains open under Article 111(2) EPC.



² We note the lack of suspensive effect according to Article 112a(3) EPC, and the re-opening of the proceedings according to Article 112a(5) EPC.

The core distinction

The two doctrines overlap, but they operate differently.

Concept	Core idea	Source in EPO practice	Effect	Can changed facts matter?
<i>Res judicata</i>	The matter has been finally decided	General principle recognized under Article 125 EPC	Bars renewed pursuit of the same finally decided matter.	No , where the same matter has been conclusively decided. Yes , if the later matter is genuinely different. But a new argument or legal label does not avoid <i>res judicata</i> where the same matter has already been finally decided.
<i>Ratio decidendi</i>	The decisive reasoning binds after remittal	Article 111(2) EPC	Binds the department of first instance after remittal and may also shape any later appeal in the same case.	Yes. The binding effect applies only »in so far as the facts are the same«.

Thus, *res judicata* is about **finality of the matter decided**. *Ratio decidendi* is about **the binding force of the reasons**, within the same procedural framework and subject to the same facts.

Final Board of Appeal decisions and requests for revision

The Enlarged Board of Appeal's decision **G 1/97** is a cornerstone for understanding *res judicata* as applied under the EPC. The Enlarged Board of Appeal held that requests »...aimed at the revision of a final Board of Appeal decision having the force of *res judicata* had to be refused as inadmissible« (G 1/97, headnote I). At the time, the EPC did not provide a petition-for-review mechanism. The position has since been modified by the introduction of Article 112a EPC, which provides a strictly limited and exceptional petition-for-review mechanism. That mechanism, however, does not undermine the general principle that Board of Appeal decisions are final and cannot be reopened by ordinary procedural requests.

G 1/97 confirms that, absent a specific statutory remedy, a party cannot reopen a final Board of Appeal decision by recharacterizing its challenge as a request for correction, re-establishment, further processing, reopening of proceedings, or other procedural device (G 1/97, Reasons 2(a)-2(f) and 6, Headnote and Order, points I and IV).

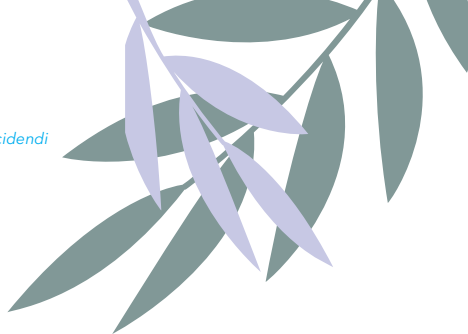
Res judicata as an absolute bar

Once the identity of the matter has been established, *res judicata* operates as an absolute bar. **The difficult practical question is often whether the later request, objection, or procedural demand is in substance the same as the one already finally decided.**

More recent decision **T 1285/23** provides a clear modern example of *res judicata* preventing a department of first instance from deciding a matter in substance. In the underlying case, the applicant sought to add Great Britain as a validly designated state for a European divisional application. An earlier request to that effect had been refused by the Receiving Section. The appeal was dismissed by the Legal Board of Appeal in **J 13/18**.

Later, the applicant filed a further request before the Examining Division, relying on the principle of legitimate expectations, or good faith. The Examining Division examined the request in substance and refused it.

The Technical Board of Appeal in T 1285/23 held that the Examining Division had no competence to decide the request in substance (cf. Headnote). The request to add Great Britain (GB) as a validly designated state had already been finally settled by the Legal Board of Appeal in J 13/18 (T 1285/23, Reasons 3).



The Board essentially held that the effect of *res judicata* could not be avoided by presenting the same request under a different legal heading. The matter finally decided was the request to add GB as a designated state. The fact that the applicant now relied on legitimate expectations and good faith did not reopen that matter, and the Board of Appeal concluded that *»[t]he effect of „res judicata“ emanating from J 13/18 cannot be limited by the Board’s reasoning on which this decision is based.«* (T 1285/23, Reasons 8)

The Examining Division’s decision was therefore *ultra vires* (Latin again, meaning »beyond the power«), void, and had to be set aside. The request itself was refused as inadmissible. The appeal fee was reimbursed because the Examining Division had committed a substantial procedural violation by deciding on a matter outside its competence.

In practice, T 1285/23 is a warning against treating a final Board of Appeal decision as merely one step in an ongoing debate. **Once the same request has been conclusively decided, a department of first instance cannot reopen it merely because the party advances a new argument or invokes a different legal doctrine.**

Ratio decidendi, remittal, and changed facts

T 2194/22 is a key recent decision for the interaction between *res judicata*, *ratio decidendi*, and post-remittal procedure.

In an earlier appeal, T 2371/18, a proprietor’s auxiliary request had not been admitted. The case was then remitted to the Opposition Division. After remittal, the Proprietor filed a substantively similar request. The Opponent argued that the Opposition Division was bound by the Board’s earlier non-admittance decision and could not admit the request.

The Board of Appeal in T 2194/22 drew a careful distinction that may be summarized as follows (T 2194/22, Reasons 2.4, 2.5.1 and 2.5.2, Catchwords 1 and 2):

First, a decision not to admit a request can have binding procedural significance. A party cannot usually avoid a non-admittance decision by refiling the same request with purely cosmetic amendments.

Second, however, not every non-admittance decision creates an absolute *res judicata* bar. A decision not to admit a request may have been an intermediate procedural decision based on a specific procedural situation.

Third, Article 111(2) EPC may still bind the department of first instance to the Board of Appeal’s *ratio decidendi*, but only if the relevant facts remain the same.

In the case underlying T 2194/22, the facts had changed. After remittal, the Opposition Division raised a new added-matter objection against the pending request. This changed the procedural framework. The later-filed request, although substantially corresponding to the earlier non-admitted request, was a response to that new objection (T 2194/22, Reasons 1.2).

The Board of Appeal argued that *»the strict application of the principle of res judicata is not adequate for decisions on the non-admittance of the parties’ submissions, such as a late-filed claim request, in as far as such decisions are intermediate conclusions based on a specific procedural situation. [...] Nevertheless, the „decision“ of admittance or non-admittance is usually not reflected in the order and usually remains an intermediate step in reaching the final decision. Therefore, if the circumstances that were relevant for the decision change in the course of the proceedings, it seems appropriate that the „decision“ of admittance remains open for reconsideration.«* (T 2194/22, Reasons 2.2.6).

Consequently, Article 111(2) EPC did not preclude reconsideration of the request’s admittance, **because after remittal the relevant facts were no longer the same.**

For opposition practice, T 2194/22 shows that after remittal the proceedings must build on the appeal decision, but they are not completely frozen. If a genuinely new factual or procedural development occurs, for example, a new objection, a party may be entitled to react, even with a request similar to one previously not admitted.

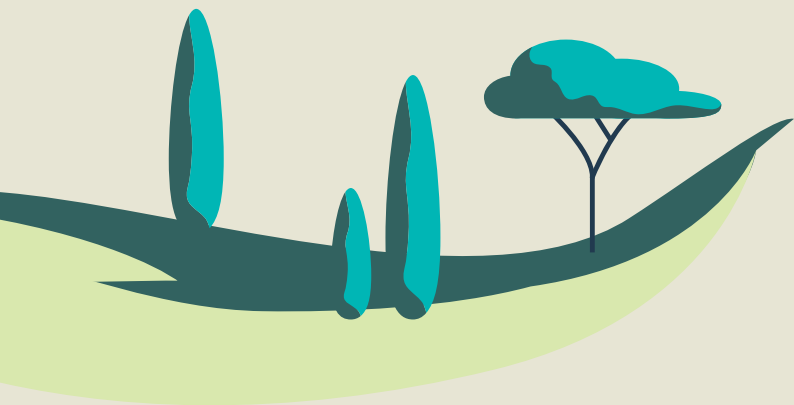
But the decision also makes clear that the difference between appeal and opposition procedure as such is not enough. A real change in the relevant factual or procedural circumstances must be identifiable.

Same case, same facts, and the limits of binding effect

The binding effect of *ratio decidendi* under Article 111(2) EPC is not a general system of precedent. It applies **in the same case after remittal.**

This does not mean that Board of Appeal decisions are irrelevant outside the case in which they were issued – they may be highly persuasive, and consistency of the case law is an important value in the EPO system. But their binding effect is not the same as the binding effect created by Article 111(2) EPC





after remittal. Likewise, a decision in examination proceedings does not normally bind a later opposition division or Board of Appeal in opposition proceedings. Opposition proceedings are separate from examination proceedings, involve different parties, and serve a different procedural function. This distinction was emphasized in the case law, including **T 1666/14** for *res judicata* (Reasons 2.3), and should apply, *mutatis mutandis*, also for *ratio decidendi*.

Binding effect for same subject-matter in a parent/divisional relationship

The situation can be different for divisional applications. In principle, a divisional application is an application independent of the parent application (**T 1254/06**, Reasons 1.1). Consequently, a decision on a parent application is not automatically binding on a divisional application merely because of the parent/divisional relationship.

However, there is an important caveat: where a final Board of Appeal decision in the parent application has already decided the same substantive request concerning the same subject-matter between the same applicant and the EPO, the principle of *res judicata* may prevent the applicant from pursuing that same subject-matter again in a divisional application. In **T 0051/08**, the Board argued that »[s]ince the aim of the *res judicata* maxim is to avoid relitigation of the same subject matter by the same parties, it must inevitably apply to a divisional application« (Reasons 3.1), later confirmed by **T 0790/10**. This »trans-procedural« effect of *res judicata* must be construed very narrowly (**T 2084/11**, Reasons 1.8, denying trans-procedural effect in opposition proceedings on parent and divisional application) and only if there is a final decision from the parent case on the same facts.

Outside the relatively narrow situation in which the same subject-matter has already been finally decided in the parent application, the parent decision is usually persuasive or influential, but not formally binding.

Strategic implications for applicants and proprietors

In view of the legal principles outlined above, applicants and patentees are generally well advised to:

- not assume that remittal gives a fresh opportunity to run the case from the beginning.
- preserve fallback positions early.
- if refiling a request after remittal, explain precisely why the facts or procedural situation have changed.
- where the Board has finally decided a request, not expect to reopen it before the Examining or Opposition Division under a new legal label.

Strategic implications for opponents

In view of the legal principles outlined above, it may similarly be advisable for opponents to:

- use Article 111(2) EPC to prevent relitigation of issues already decided by the Board.
- compare later-filed requests with previously refused or non-admitted requests in substance, not merely in wording.
- if a proprietor alleges changed facts, scrutinize whether there is a genuine new development or merely a reframing of an old argument.

Conclusion

Res judicata and *ratio decidendi* both protect legal certainty, but they do so in different ways.

Res judicata protects the finality of what has been conclusively decided. *Ratio decidendi* governs the further handling of the same case after remittal, but only in so far as the relevant facts remain the same.

For EPO practitioners, the distinction is not merely theoretical. It marks the boundary between legitimate further prosecution and impermissible relitigation. The case law shows that Latin still matters – particularly when it encapsulates complex procedural principles in a single, concise expression.



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