

EIP



T 0458/22 – EPO Board of Appeal considers Rolex's inadmissibility attack to be inadmissible!

In T 0458/22 (which has a "B" distribution code indicating it is significant enough to be distributed to all Members of the EPO's Technical Boards of Appeal), the Board of Appeal appears to have gone against reasonably established case law that essentially says that inadmissibility attacks can be raised at any stage.

Rolex had successfully opposed Omega's patent EP2757423 relating to a "pivot pin" (a precise component of a mechanical watch) before the EPO Opposition Division and Omega appealed. In their appeal pre-hearing submissions, Rolex argued that Omega's appeal arguments hardly related to the decision at issue, and therefore the appeal should be considered inadmissible due to lack of substantiation under Art 108 and Rule 99(2) EPC. This admissibility attack came two and a half years after Omega's Grounds of Appeal, and one month before the appeal hearing.

The previous case law on this topic, which is collected in the Case Law of the Boards of Appeal CLBA V.A. 2.7, mostly supports the position that admissibility attacks can be raised at any time. The Board in this case rejected this view and insisted that admissibility should be raised in a timely manner. The Board reviewed this body of case law in detail to explain its position, and it is worth looking at each case briefly to see why.

T 0289/91 is the earliest case (March 1993) and in Reasons 2.1 states:

~~... in the Board's judgment, an objection that the opposition is inadmissible, e.g. as in the case at issue, because the opponent is not entitled to file an opposition, can be raised at any stage of the proceedings, i.e. even at a late stage, because the admissibility of the opposition is an indispensable procedural requirement for any substantive examination of the opposition submissions, and it must therefore be examined by the EPO of its own~~

motion. This also applies to the proceedings before the Board of Appeal.

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T 0015/01 in June 2004 came to similar conclusions in Reasons 1:

... Since this issue was raised only at a rather late stage of the appeal proceedings, appellant I objected to its introduction into the present proceedings. ~~However, admissibility issues can and have to be examined at every stage of the appeal procedure. According to established case law, the admissibility of an opposition must be checked ex officio in every phase of the opposition and ensuing appeal proceedings (T 522/94 , point 3, OJ EPO 1998, 421). The same principles apply a fortiori to the examination of the admissibility of an appeal. Appellant I's procedural objection against the late introduction of the [inadmissibility] issue cannot therefore succeed.~~

These decisions indicate that, if admissibility is raised, it ~~must~~ be assessed by the EPO ex officio / of its own motion. The term ex officio is generally used to refer to scenarios where the EPO assesses grounds such as added subject matter (Art 123 EPC) without being prompted by an opposing party (see e.g. CLBA V.A-3.3.1). However, in the decisions discussed in the preceding two paragraphs, the Boards appeared to be taking an expansive view of their responsibility to examine admissibility ex officio in order to consider objections to admissibility raised by a party.

The Board in T 0670/09 took a different approach in December 2011, more reflective of the current decision T 0458/22, see Reasons 1: According to Article 12(2) of the Procedural Code, the reply to a complaint must contain the complete factual submissions. Especially since they are the prerequisite for the investigation of the facts, ~~objections to the admissibility of an appeal or to the competence of a board must in principle be raised in limine litis, i.e. before the substantive defence of a party.~~

But this reasoning of T 0670/09 was not carried forward. T 0198/15, decided in March 2018 stated in Reasons 1.1-1.2:

1.1 The admissibility of the appeal was only cast in doubt by the respondent ~~at the start of the oral proceedings.~~ This is indeed a very late stage of the proceedings for raising such an objection.

1.2 However, it is established jurisprudence of the Boards of Appeal that the ~~admissibility of the appeal is to be examined ex officio at every stage of the appeal proceedings~~ (see T 15/01, OJ 2006, 153, Reasons 1), and thus also at the oral proceedings (T 501/09, Reasons 2, T 2223/10, Reasons 1). ~~The appellant's objection that the respondent's request was filed too late in the proceedings cannot therefore succeed.~~

In the present case, T 0458/22, the Board agreed that the law and case law supported the

view that a board can raise admissibility of its own motion at any stage. However, they felt that there was no restriction on the Board's discretion under Articles 12 and 13 of the RPBA to exclude submissions from the parties relating to admissibility. They expressed that a submission as to whether an appeal is admissible under Art 106, Art 108, and Rule 99 EPC contains both questions of fact as well as arguments (Reasons 1.5, particularly 1.5.4). It should be noted that the Rules of Procedure of the Board of Appeal (RPBA) were updated in 2020 to further front load EPO appeal proceedings and to dissuade parties from amending their case at later stages.

Additionally, the Board decided that even though admissibility is very important (since the opposition/appeal relies upon it), this does not justify the Board having to consider an inadmissibility objection at any stage. Hence, the Board disagreed with the view given in T 0289/91 (the earliest cited case discussed above) that inadmissibility being "an indispensable procedural requirement" means the EPO must assess it any stage when requested (Reasons 1.5.5-1.5.8).

They further considered that all of the facts and evidence required to assess the admissibility of an opposition or appeal are available at the start of the procedure, so late requests cannot be justified in this way (Reasons 1.5.9).

Finally, the Board felt that even if they had permitted the inadmissibility objection, the Omega's Grounds of Appeal were substantive enough that they were admissible (Reasons 1.8).

The Board, dealing with the substantive issues of patentability, decided to remit the opposition to the Opposition Division to decide on issues relating to auxiliary requests.

The key takeaway from decision T 0458/22 is that, even though case law is not fully settled yet, parties should raise admissibility objections at the earliest possible stage in appeal proceedings. The lack of settled case law also raises the possibility of an Enlarged Board referral if a case turns on the issue of admissibility. For now, most cases have decided the opposite of this one, with T 0670/09 being the only exception.

Nonetheless, this is the first case on this issue since the 2020 revisions to the RPBA, streamlining the appeal process into so-called "convergent approach" that severely limits amendments to a party's case in appeal. Perhaps this case reflects this overall shift to improve procedural efficiency and signals the approach that will be taken by Boards going forward.