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T 1621/09 – Late filed Arguments

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In the decision T 1621/09 of the Boards of Appeal of the EPO the question arose whether the appellant's new argument amounts to an amended case within the meaning of the RPBA (Rules of Procedure of the Boards of Appeal), with the result that it is only admissible at the Board's discretion under Article 13(1) RPBA.

In the particular case, the answer was yes. Moreover, having found so, the Board, exercising its discretion, did not admit the new arguments into the proceedings.

1. Short History of Late Filed Arguments

1.1) Before May 1, 2003

Before 2003, case law was available which in the majority of cases made a distinction between late filed arguments and late filed facts or evidence.

In G 4/92 the Enlarged Board discussed the question whether, if one party chooses not to attend oral proceedings, a decision against that party can be based on new facts and evidence and/or new arguments put forward the first time during the oral proceedings. The Enlarged Board concluded that a decision may not be taken based on new facts or evidence. It referred to the requirements of Article 113(1) EPC establishing the provision that a decision may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In contrast, in the Enlarged Board's view, new arguments did not constitute new grounds or evidence, but were reasons based on the facts and evidence which have already been put forward. Thus, in principle a decision can be based on new arguments presented at the oral proceedings, even in the case of the other party being absent.

Subsequent decisions of the Boards of Appeal such as T 432/94, T604/01, T 131/02 and others were in line with the principles developed in G 4/92. Thus, in summary, before 2003 the appellant was not bound to the line of argumentation first presented in his statements of grounds for the whole appeal proceedings.

1.2) May 1, 2003: New RPBA

With effect from May 1, 2003, the Rules of Procedure of the Boards of Appeal (RPBA) were amended by introducing some elements of case law. Among others, the provisions corresponding to what are now Articles 12, 13 and 15 were introduced. One intention of the amendments was to

achieve more efficient and shorter appeal proceedings, i.e. to prevent “ping pong” submissions and “salami” tactics. Nevertheless, the new Rules (in the newest version of October 25, 2007) do not expressly address the question whether admissibility of late filed new arguments is a matter of the Board’s discretion.

According to Article 13 RPBA,

any amendment to a party’s case after it has filed its grounds of appeal or reply may be admitted and considered at the Board’s discretion.

Article 13 RPBA quite generally refers to amendments of the party’s case, without distinguishing between arguments on the one hand and facts or evidence on the other hand. Article 13(1) RPBA also includes some guidelines as to how the Boards should exercise their discretion, namely in view of, inter alia, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

In at least the majority of decisions after the 2003 amendment of the RPBA, the Boards admitted late filed new arguments, while only in rare cases (if any at all) newly submitted arguments were (successfully) challenged with reference to Article 13 RPBA.

2) T 1621/09 – A special Case

In the case underlying T 1621/09 the appellant (opponent) contested novelty on the basis of a presentation which was in the proceedings from the beginning of the proceedings. The presentation consisted of 15 slides. In the written proceedings novelty was contested based on slide No. 7 of the presentation and supported by affidavits from technical experts. At the oral proceedings, the appellant for the first time referred to slides Nos. 6 and 13.

When considering the relevant case law the Board concluded that this only consisted of either obiter dictum statements and/or statements made without reference to the RPBA. Hence, they did not see anything in the case law which, as far as relating to their ability to change a party’s case, would justify a general distinction between late filed arguments and late filed facts and evidence. The Board therefore concluded:

(a) A new argument brought forward in appeal proceedings by a party which would have the effect of amending its case, even if the argument is based on evidence and facts already in the proceedings, can only be introduced into the proceedings at the discretion of the Board of Appeal by way of an amendment to the party’s case.

(b) To the extent that the decision of the Enlarged Board in G 4/92 deals with the general admissibility of new arguments, it must be taken to have been modified in accordance with (a) above by the Rules of Procedure of the Boards of Appeal introduced with effect from 1 May 2003.

The Board further held that it must remain a matter for the Board’s discretion to allow an amendment to a party’s case even in the absence of the prejudiced party and, exercising their discretion, the Board for the following reasons did not allow the appellant’s new line of argumentation into the proceedings.

(i) The new argument presented the appellant’s case on novelty in such a manner that it did not only amend (supplement) the case but rather was in contradiction to the appellant’s previous

submission.

(ii) The new argument was raised at the latest possible stage of the appeal, namely during oral proceedings, while there was no reason why the new argument could not have been raised earlier.

(iii) Last, but not least, the new argument was found not to be based on a simple, incontrovertible piece of evidence, i.e. while the explanation seemed plausible to the Board, the Board was not able to say that it was clearly correct (point 45.(g) of the reasons for the decision).

3) Conclusion

T 1621/09 (to our best knowledge) for the first time expressly states that late filed arguments in principle can amend a party's case to such an extent that their admittance lies within the Board's discretion, even if the new arguments are based on facts and evidence already in the proceedings.

In practice, the rejection of new arguments as being late filed might require the accumulation of several unfavorable circumstances, and thus might remain the exception rather than the rule in future cases. Nevertheless, the decision shows that the manner how the Boards exercise their discretion will depend, among others, on the complexity of the new argument and whether the Board actually feels confident to decide on this issue without obtaining additional technical information. In complex cases requiring further clarification of the merits of the new argument, procedural economy might stand against its admittance.

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