

# Kluwer Patent Blog

## T 1006/21: you say admissible, I say inadmissible – let's call the whole thing off?

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It is well known that the EPO Boards of Appeal take a strict line on admissibility of new elements of the appeal case under Articles 12 and 13 RPBA. But if the request to hold new elements inadmissible is itself filed late, the admissibility of the inadmissibility request may be questioned, see e.g. T 500/16 reason 6.2. And why stop there? Discussion of the inadmissibility of a request to hold inadmissible a request to hold a new element inadmissible is not unheard of.



If all this is making your head spin, then help may be at hand with T 1006/21. While mainly focussing on admissibility of requests for remittal, it held at reasons 27 and 29 that:

27. *Procedural requests on questions that have to be taken up ex officio may relate to remittal, as in this case, or to referral to the Enlarged Board of Appeal (Article 112(1)(a) EPC), the admissibility of the appeal (Article 110 EPC), (non-)admission and consideration of claim requests, allegations of facts or evidence (Article 114, Rule 116(1) EPC), interruption of proceedings (Rule 142 EPC), exclusion of board members (Article 24(1) and (2) EPC), or the appointment of oral proceedings if expedient (Article 116(1) EPC)...*

29. *None of these procedural requests are subject to the provisions of Articles 12 and 13 RPBA 2020. They can therefore be made at any time during the appeal proceedings and must be considered by the board, regardless of when they are made.*

On the face of it, if widely adopted, this decision could put an end to the discussions summarized above: the Board should analyse the admissibility of new case elements ex officio, regardless of the point in the proceedings at which inadmissibility is raised. It is therefore useful for parties who have not questioned the inadmissibility of new elements on appeal in a timely manner. It might also help reduce the volume of written appeal submissions, if it is no longer necessary to expressly address inadmissibility at length in writing. The downside is that it may decrease legal certainty, potentially allowing parties to ambush one another as late as the oral proceedings with inadmissibility requests.

### **What about the other types of requests mentioned?**

As to the other procedural requests, such as a request to remit the case to the first instance or a request to refer a question to the Enlarged Board of Appeal (Article 112(1)(a) EPC), it still remains advisable to submit such procedural requests as early as possible in the appeal proceedings. Indeed, nothing appears to prevent a Board, even following T 1006/21, to take into account the point in time a procedural request was made when deciding on the merits of the procedural request, or to simply reject a procedural request as inadmissible based on other provisions than the RPBA (for example, Art. 24(3), second sentence, EPC provides that objections against board members, these objections being explicitly referred to in T 1006/21, reasons 28, “shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step”).

### **Possible criticisms of T1006/21**

Another big question is whether this decision will be widely adopted. As noted above by reference to T 500/16, it goes against the current practice of at least some Boards. Its authority is also undermined by the fact that the Board didn’t actually have to decide on admissibility of an inadmissibility request, but rather made a statement on this during a discussion on remittal.

It also doesn’t sit so easily with the wording of Articles 12 and 13 RPBA, which expressly restrict the admissibility of new “requests” during the appeal proceedings. The Board takes the view that “procedural requests” aren’t restricted by Articles 12 and 13 RPBA, which reason 25 suggests are

rather concerned with claim requests. But this distinction between procedural and claim requests isn't clear from Articles 12 and 13 RPBA and is hard to reconcile with the explanatory remarks to Article 12(2) RPBA 2020, which expressly identified that “*The term “requests” in this context is not limited to amended texts of patent applications or patents*”. Article 15(2) RPBA even uses the same term “request” from Article 12 RPBA in the context of the procedural request regarding the change of date fixed for oral proceedings.

### Final thoughts

Discussions about the inadmissibility of a request to hold inadmissible a request to hold a new element inadmissible doubtless sound like a thought experiment. But it is not unusual for the fate of EPO opposition appeal proceedings to turn on the admissibility of new elements on appeal, and hence on the timely filing of requests to hold new elements inadmissible. This is why we'll be following closely whether other Boards follow the principles set out in T 1006/21 in agreeing to “call the whole thing off”.

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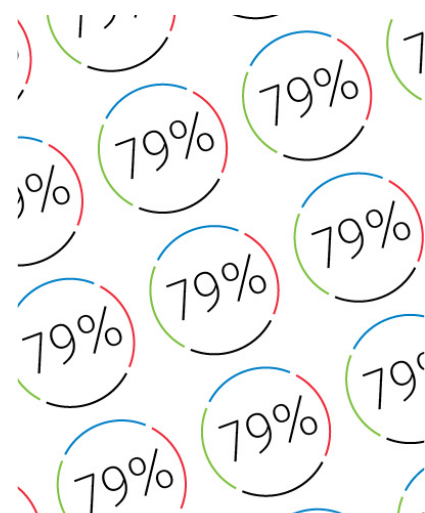
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