



EUROPEAN PATENT AND  
TRADEMARK ATTORNEYS

## Lessons from the EPO's new rules on admitting evidence in appeals

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The European Patent Office's (EPO) new Rules of Procedure of the Boards of Appeal (RPBA) 2020 entered into force on January 1, 2020. The RPBA imposed more rigorous restrictions with regard to the admittance of new evidence, objections, arguments and claim requests than under the previous rules (referred to as RPBA 2007).

Although this legal framework applies to all these issues only when raised on appeal, the present article focuses on decisions on the admittance of new objections and new evidence.

The first decisions by the Board of Appeal wherein the new RPBA 2020 are applied have appeared, which indeed show the stricter regime, and also evidence that the admittance of new evidence and objections has a higher dependence on the specific stage of the appeal proceedings wherein those are brought forward for the first time.

### STAGE (1): Admittance of new evidence or objections in the grounds of appeal or in the reply thereto

Under the RPBA 2007, new objections or evidence presented in the grounds of appeal and reply thereto were admitted into the appeal proceedings as long as they related to the case under appeal and were reasoned.

The board could exercise its power not to admit new objections or evidence if these could have been presented earlier or were not admitted in the first instance (article 12[2] and 12[4] RPBA 2007). Therefore, new objections or evidence presented in the grounds of appeal (or reply) were generally admitted by default under the RPBA 2007, and only the board could prevent their admittance.

However, under the new RPBA 2020, new objections or evidence presented in the grounds of appeal are no longer admitted by default. Instead, only objections and evidence on which the decision under appeal was based, or objections or evidence for which the party can demonstrate they were admissibly raised and maintained in the proceedings leading to the decision under appeal (and therefore not new) are directly admitted (article 12[4] in conjunction with article 12[2] RPBA 2020). This stricter approach has the overall goal of preserving the goal of the appeal proceedings, now explicitly stated in article 12[2] RPBA 2020 as to "review the decision under appeal in a judicial manner".

If none of the aforementioned criteria applies (i.e., the objections or evidence are "new"), they will be considered as amendments to the appeal case (article 12[4] RPBA 2020). Evidence or objections incorporated into the grounds of appeal or reply as amendments will be accepted by the board only if reasons are provided explaining why they should be admitted into the appeal proceedings (article 12[4] RPBA 2020), which raises the burden on the parties to demonstrate the relevance of the newly filed objections or evidence to the case.

At this first stage of the appeal proceedings, the board can base its discretion of not admitting new evidence or objections on three criteria: (i) their complexity; (ii) their suitability to address the issues which led to the decision under appeal; and (iii) the need for procedural economy (article 12[4] RPBA 2020).

Besides, the board will not admit objections or evidence as amendments into the grounds of appeal or reply which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance (article 12[6] RPBA 2020, paragraph 1).

Similarly, the board will not admit objections or evidence as amendments if they should have been submitted, or were no longer maintained in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance (article 12[6] RPBA 2020, paragraph 2).

The transitional provisions under article 25[2] RPBA 2020 specify that article 12[4] to article 12[6] of RPBA 2020 shall not apply to any statement of grounds of appeal filed before 1 January 2020 or to any reply to it filed in due time. Hence, the decisions in 2020 and even in 2021 (e.g., [T 1956/17](#) in May 2021) still mostly reach conclusions on the admittance of new objections and evidence at this initial stage based on the former article 12[4] RPBA 2007.

Case law is only slowly starting to appear where the newly amended article 12[4] and article 12[6] RPBA 2020 are put into practice.

The most prominent decision so far wherein article 12[4] RPBA 2020 is applied is the decision of the legal Board of Appeal [J 3/20](#). The applicant filed an appeal against the decision of the examining division in which the request to include the designation of Great Britain was refused. In the oral proceedings before the board, the appellant raised a new argument concerning the protection of legitimate expectations, arguing that the EPO had communicated that Great Britain was a designated contracting state in this divisional application, although Great Britain had been withdrawn in the parent application before filing this divisional application in that case.

This argument was not admitted into the appeal because of its complexity. Assessment thereof involved several issues that would be detrimental to procedural economy, as well as introduced a new aspect on which the reasoning in the appealed decision was not focused (article 12[4] RPBA 2020). Additionally, in the same decision the board concluded that the new submissions cannot be admitted because the appellant could and should have known the relevant facts during the first instance proceedings, and thus should have submitted these facts at that stage (article 12[6] RPBA 2020, paragraph 2).

Although not specifically dealing with new objections or evidence, [J 3/20](#) clearly shows the high threshold for admissibility of new submissions, even at this early stage of the appeal procedure, which we expected to equally apply to newly introduced evidence and objections.

## STAGE (2): Admittance of new evidence or objections in the period between filing the grounds of appeal (or reply) and the expiry of the period set by the board in a communication under Rule 100[2] EPC or, where such a communication is not issued, notification of a summons to oral proceedings

Under RPBA 2007, the board already had the discretion not to admit new objections or evidence presented after the grounds of appeal or reply to these grounds. Reasons made explicit in rules are complexity of the newly submitted issues, the current state of the proceedings and the need for procedural economy (article 13[1] RPBA 2007).

In practice, new objections or evidence were admitted in case they were *prima facie* relevant to the appeal proceedings. Thus, if the newly submitted objection or evidence can reasonably be expected to change the outcome of the appeal, and is thus highly likely to prejudice the maintenance of the European patent (see [T 1306/09](#) and [T 2542/10](#)), boards typically admitted the new submission.

The RPBA 2020 provide two additional hurdles. First of all, the new objections or evidence presented at this stage of the appeal proceedings shall be admitted by the board only if the party properly justifies this amendment with reasons for its submission only at this stage of the appeal proceedings (article 13[1] RPBA 2020).

***“At this first stage of the appeal proceedings, the board can base its discretion of not admitting new evidence or objections on three criteria.”***

Therefore, a proper justification is imposed on parties if they want to avoid the non-admittance of their objections or evidence. In addition, article 13[1] RPBA 2020, combined with article 13[1] RPBA 2007, means that the board may not admit new evidence on the grounds of its unsuitability to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the board.

Article 13[1] RPBA 2020 applies to any appeal pending on, or filed after January 1, 2020 without further exceptions (article 25[1] of RPBA 2020, transitional provisions). Therefore, this article has already been applied in recent decisions on the admittance of new objections or evidence at this stage of the proceedings.

Submitting evidence in a timely manner appears to be an important factor to consider. For instance in [T 446/16](#), new data (a document complementing another document filed earlier in the reply to the grounds of appeal) submitted by one of the opponents after their reply to the grounds of appeal but before the communication of the summons, was admitted into the proceedings under article 13[1] RPBA 2020, because it was properly argued that the results in this new document could not have been submitted earlier according to article 13[1] RPBA 2020.

However, in [T 2688/16](#), the opponents (appellants) submitted evidence supporting their case only one month prior to the oral proceedings. The board considered that it would be unreasonable for a patent proprietor to check the results of the experiments in such short period of time before the oral hearing through time-consuming experiments, and thus did not admit the new evidence into the proceedings.

Even though the board referred to article 13[1] RPBA 2020, the decisions on admissibility taken in [T 140/15](#), [T 2227/15](#), and [T 1217/17](#) actually concern a new objection raised during the hearing where article 13(2) RPBA 2020 would be applicable. These decisions are thus discussed in more detail further below, but they do provide some insight on the application of article 13[1] RPBA 2020. In both decisions, a newly raised inventive step objection was not admitted for jeopardising procedural economy.

**STAGE (3): Admittance of new evidence or objections after the expiry of the period set by the board in a communication under Rule 100[2] EPC or, where such a communication is not issued, after notification of a summons to oral proceedings.**

The RPBA 2007 did not explicitly distinguish between the two stages discussed above. Yet, even under the RPBA 2007, the board already followed a strict approach for admitting new evidence or objections at this late stage of the appeal proceedings.

Normally, the board admitted new evidence or objections only after the expiry of the period set in a communication under Rule 100[2] EPC or after a summons to oral proceedings had been notified only if these new pieces of evidence or objections would not lead to complexities large enough for the oral proceedings to be postponed, thus being guided by the principle of procedural economy of article 13[1] RPBA 2007.

However, under the new article 13[2] RPBA 2020, this third stage, with accompanying third level of strictness, is separately defined. New objections or evidence presented at this third stage would not be taken into account, unless there are “exceptional circumstances” justified with compelling reasons by the party concerned. This article thus provides an even higher burden to admit new objections or evidence at this late stage in the proceedings than in the earlier stages, and also when compared with RPBA 2007.

The transitional provisions under article 25[3] RPBA 2020 specify that if the summons to oral proceedings or a communication of the board under Rule 100[2] EPC has been notified before 1 January 2020, article 13[2] of RPBA 2020 shall not apply but article 13 of RPBA 2007 should be applied instead.

***“It is therefore important to submit the new evidence or objection as early as possible, i.e., as soon as becoming aware of it.”***

Therefore, some of the decisions issued in 2020 and 2021 still reach conclusions on the admittance of new objections and evidence based on article 13 RPBA 2007 (e.g., [T 1533/15](#) and [T 1900/17](#)). However, there are also some recent decisions where new article 13[2] RPBA 2020 is applied, which give some guidance on the interpretation of “exceptional circumstances”.

In [T 1483/16](#), the patentee (respondent) filed comparative experiments one month before the oral proceedings, arguing that these experiments were produced in reaction to the negative assessment of inventive step for auxiliary requests in the preliminary opinion



accompanying the summons to oral proceedings. However, the board considered that this lack-of-inventive-step objection had already been raised by the appellant more than two years before. Thus, the filing of these experiments was not considered to fall under the “exceptional circumstances” stipulated in article 13[2] RPBA 2020.

Similarly, in [T 908/19](#) the opponent 2 (appellant) justified the late submission (only at the oral proceedings) of both new evidence and a new attack on inventive step by arguing that neither the document nor the objections could have been raised earlier since they were filed in reply to the board’s preliminary opinion annexed to the summons to oral proceedings.

However, the board stated that this preliminary opinion was based exclusively on the submissions made by the parties in their grounds and reply, and therefore the board saw no exceptional circumstances that justify the late filing of these submissions. Thus, the board rejected the admittance of the evidence and objections following article 13[2] RPBA 2020.

In [T 2024/16](#), the opponent (appellant) raised an inventive step objection during the oral proceedings, submitting that it was already present in the notice of opposition. However, the appellant had not repeated this objection either before the opposition division or in the statement of grounds of appeal. The board thus considered the objection not part of the appeal and thus an amendment to the case for which no exceptional circumstances were presented.

Therefore, the inventive step objection was not admitted under article 13[2] RPBA 2020. This decision emphasises the need to reiterate all objections in the statement of grounds of appeal, or reply thereto, as otherwise may not be part of the appeal, and would need to overcome the higher burden for admittance.

The “exceptional circumstances” burden of stage (3) appears to be especially difficult to overcome. To date, the board has not found any submission of a new objection of evidence to meet the exceptional circumstances of article 13[2] RPBA 2020. It remains to be seen what will be needed to exceed this hurdle.

As mentioned above, several decisions ([T 140/15](#), [T 2227/15](#) and [T 1217/17](#)) deny admission of a new objection under article 13[1] RPBA 2020, while they concern a newly raised objection at the hearing, i.e., during stage (3). Hence, these decisions are discussed here.

[T 140/15](#) concerns a new inventive step objection raised by the opponent (appellant) at the oral hearing. The board could not find any convincing reason for the late change in the appellant’s submissions, and also considered that having to deal with the newly raised objection at the extremely late stage of the oral hearing did not meet the requirements on procedural economy.

Similar concepts were applied to deny the admittance of a new inventive step attack, again raised by the opponent (respondent) during the oral hearing, in [T 1217/17](#). The board considered the new objection not suitable to solve the problems raised, unsubstantiated and to have a negative impact on the economy of the proceedings.

Likewise, in [T 2227/15](#) the board considered that the opponent (appellant) did not present any substantiated argumentation regarding the lack of inventive step until the oral proceedings, and that the admittance of this objection would jeopardise procedural economy in view of the complexity thereof.

In these three decisions, the board did not admit the newly raised objection under article 13[1] RPBA 2020. The board did not refer to the “exceptional circumstances” of article 13[2] RPBA 2020, which should govern admissibility at this stage (3), but even the apparent lower hurdle of article 13[1] RPBA 2020 was not considered to be met.

Where, prior to entry into force of RPBA 2020, the *prima facie* relevance of a new submission was a major factor in determining the admissibility at stages (2) and (3) of the appeal proceedings, this seems no longer the case. Substantiation of the late filing and procedural economy now are the crucial factors.

## RECOMMENDATIONS

Overall, the aforementioned decisions do show a more restrictive approach in the admittance of new evidence or objections under the new RPBA 2020, when compared to the already strict but more open approach under the RPBA 2007. In that light, we believe the following guidance is prudent to adhere to:

- It is important that all evidence and (thoroughly explained) objections are filed with the initial appeal submissions, as otherwise they will be considered amendments, even if they appeared in the first instance proceedings. Thus, any submissions from the first instance proceedings that may become relevant in the appeal is best reiterated in the grounds of appeal or reply thereto.
- The rules get stricter the later the new evidence or objection is presented in the proceedings, until the point of being admissible only under “exceptional circumstances”. It is therefore important to submit the new evidence or objection as early as possible, i.e., as soon as becoming aware of it, and, with the filing thereof, thoroughly explaining why this could not have been filed earlier. This principle appears of greater importance than the *prima facie* relevance which used to set the tone.
- It appears from the case law discussed above for the second and third stages, that new evidence or objections may be admissible in a reaction to a new event that has happened in the procedure (e.g., a new objection raised by the board). This new evidence or objection should be submitted as soon as possible after this event has happened, and should be accompanied with a proper argumentation for the late filing. Waiting a year or more until summons for oral proceedings are issued before submitting the new evidence or objection may very well eradicate any chance on admission thereof.

The new rules may result in a smoother and more predictable appeal procedure, from which all parties may benefit. It remains to be seen whether these new rules are consistently adopted by all boards.

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I joined NLO as a trainee patent attorney in 2011 and have since developed into an all-round advisor on patents. As well as easily being able to switch from one field of technology to another, I can also switch from being a strategic advisor with a helicopter view to being a sparring partner. All with the aim of protecting your new technology as effectively as possible. One of the aspects I personally enjoy most in my work is luckily what I do on a regular basis: defending or opposing patents during a hearing at the European Patent Office.

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