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Divisionals and Competition Law: Status Quo After the Teva Decision

In October 2024, the EU Commission issued a decision,[1] imposing a fine of €462.6 million on Teva for abusing its dominant position through, inter alia, misusing of divisional patents ("divisionals") to artificially prolong legal uncertainty for competitors, thus hindering their market entry. Even though the Commission's decision is not final and Teva has meanwhile appealed it to the Court of Justice of the European Union, the case marks a pivotal point in EU antitrust jurisprudence, particularly at the intersection of IP rights and competition law. While the concept of "abuse" under Article 102 TFEU is well established, the application of that concept to what is essentially a lawful procedural right – filing divisional patents – raises important questions of practical relevance. Alongside this, the Commission also identified a coordinated disparagement campaign targeting a rival generic medicine, further reinforcing the exclusionary nature of Teva's conduct. This article examines the Commission's reasoning, which was published in April 2025,[2] with a particular focus on where the boundaries are between a lawful use of divisionals and an unlawful misuse, for which the Commission coined the term "playing the divisional game".

I – The legal framework: Divisionals and dominance

Divisionals are, as such, legitimate procedural instruments under the European Patent Convention (EPC). Article 76 EPC allows an applicant to split a pending application into one or more "divisionals", which retain the original filing date. Such filings serve practical purposes like responding to lack of unity objections or organizing various inventions or inventive aspects into several applications. As they have a procedural life of their own, divisionals are also often used as a backup in cases where something unexpected happens to the parent application. However, a potential for abuse arises when divisionals are used as tools, through staggered filings and strategic withdrawals, to generate layers of legal uncertainty aimed not at protecting genuine innovation, but at obstructing competitors.

Under Article 102 TFEU, it is not the existence of a dominant position that is prohibited, but its abuse. The Commission defines dominance as a position of economic strength enabling a company to act independently of competitors and customers. Once dominance is established – as it was in Teva's case across seven EU Member States in a market (narrowly) defined as the market for Glatiramer Acetate (rather than all multiple sclerosis medicaments, a point which Teva appealed) – the focus shifts to whether the conduct distorts competition in a way that falls outside the scope of competition on the merits.

II – Overview of the infringement: Two separate abuses

The Commission's decision in the Teva case, centering around their product Copaxone (Glatiramer Acetate) for treating multiple sclerosis, rests on the finding of **two distinct and independently abusive practices**, each found to infringe Article 102 TFEU:

- The misuse of the patent system through a strategy of filing and tactically withdrawing divisional patents, thereby creating legal uncertainty and delaying generic market entry (the so-called "**divisional game**").
- A coordinated **disparagement campaign**, in which Teva spread misleading information to undermine confidence in a competing generic product, thereby discouraging substitution and weakening demand.

Each of these practices was found to constitute an abuse of dominance in its own right. The Commission

[1] Case AT.40588.

[2] For a more detailed analysis of the facts of the case we refer to these articles: Gruber/Simpson, HE Quarterly December 2024, p. 14 et seq. (https://www.hoffmanneitle.com/news/quarterly/he-quarterly-2024-12.pdf#page=14); Bausch/Gruber/Schain, GRUR Patent 2025, p. 135 et seq.

states that either of these conducts alone would have sufficed to trigger a finding of infringement. However, because the two abuses were part of a broader exclusionary strategy targeting the same competitor, they were assessed together as a **single and continuous infringement**. This classification is legally significant: it recognizes that a series of behaviors, though individually distinct, may constitute parts of a broader exclusionary strategy and allows to assess the full market impact of Teva's behavior and impose a consolidated fine.

III – The first abuse: Playing the divisional game

1. The Commission's core theory: When use becomes misuse

The Commission's decision centers on two interlinked practices that together formed what it termed a "comprehensive patenting conduct":

- **1. Staggered filing of multiple divisionals** with highly overlapping content and similar legal vulnerabilities. In doing so, Teva maintained a rolling portfolio of applications with similar scope, ensuring that even if one patent fell or was withdrawn, another stood in its place.
- **2. Strategically withdrawing these patents** – often at the appellate stage shortly before the EPO Technical Board of Appeal (TBA) could issue a reasoned decision – while keeping similar divisionals pending, thereby avoiding damaging precedents.

The combination of these strategies, according to the Commission, prevented or delayed generic market entry and constituted an anticompetitive exclusionary practice. Importantly, the conduct was not isolated but systemic, pursued over several years with internal documentation evidencing intent to delay or obstruct legal certainty by withdrawing patents before a final decision on the merits could be given.

While patent law naturally contains uncertainty (e.g. claims are interpreted, challenged, and adjudicated), Teva's conduct was different in that it was designed to keep competitors off the market by artificially prolonging legal uncertainty as a competitive weapon. By these methods, Teva kept competitors in a state of constant risk, unable to assess with certainty whether launching a generic would result in litigation, injunctions, or liability. The Commission concluded that this deterrent effect went beyond legitimate patent defense and into the realm of anticompetitive foreclosure.

2. Abuse without enforcement?

Moreover, the decision held that Teva continued to rely on preliminary injunctions based on patents that would, absent Teva's practice of filing divisional patents in a staggered manner, likely not have been in force. The decision accused Teva of exploiting the practice adopted by courts in some jurisdictions not to make an in-depth substantive assessment of the validity of the patent invoked in the request for preliminary injunctions and to grant these on a *prima facie* basis no matter how unlikely it is that the patent will be upheld in ongoing opposition or appeal proceedings. As a result, in some Member States (i.e. Czechia, Denmark and Portugal) preliminary injunctions remained in force on the basis of two patents (EP '962 and EP '172), even after one patent in the same family and with very similar claims (EP '335) had been revoked by the EPO.

While Teva did seek preliminary injunctions in several jurisdictions (notably also in Germany[3]), our impression is that the Commission mainly saw the abuse in the **creation and maintenance of legal uncertainty** by the staggered filing of divisionals at the last possible moment and strategically withdrawing them before the TBA could rule on them. Teva's attempts to enforce these patents appeared secondary only.

This approach aligns with previous case law where abuse was found in the **effects** of a conduct rather than in its formal legality. The Commission underlined that "competition on the merits", i.e. legitimate performance-based competition, does not encompass deliberate obstruction of legal review. Teva's withdrawals before TBA decisions could be rendered, not only eliminated the possibility of legal clarity, but also increased the burden on competitors, who had to challenge each new divisional independently – without the benefit of binding precedents. The decision cited the Commission's earlier pharmaceutical sector report, wherein the ability of generic entrants to effectively challenge the validity of patents was considered an

[3] See RC Munich I, December 14, 2017 – 7 O 17693/17, confirmed by the HRC Munich, April 4, 2018 – 6 W 164/18; RC Dusseldorf, June 14, 2019 – 4c O 22/19; HRC Dusseldorf, September 26, 2019 – 2 U 28/19.

essential part of the competitive process in the pharmaceutical sector.

3. Objective justification and the "competition on the merits" test

Teva argued that its use of divisionals was a legitimate form of IP strategy. The Commission rejected this defense:

- **Intent and internal communication**: Evidence from internal documents ("smoking gun" evidence) revealed that Teva's intent was not merely to preserve its rights, but to, so to say, "keep competitors in the dark" and avoid precedent-setting decisions that would jeopardize its portfolio.
- **Pattern and structure**: The systemic, orchestrated nature of the filings – timed to prolong uncertainty and multiplied across jurisdictions – distinguished this from a good-faith defense strategy. This was not about defending innovation but about weaponizing procedure.

What did this "smoking gun" evidence look like? The Commission cited a lot from Teva's internal documentation including e-mails, WhatsApp messages and slide decks (most of it is unfortunately redacted in the decision), which indeed seems to reveal a deliberate strategy to obstruct effective legal review and delay generic competition. According to the Commission, these documents would show that "Teva's patents were weak and would likely not survive validity challenges", and "a negative reasoned decision would both accelerate the revocation of Teva's remaining patents and reduce Teva's chances to obtain preliminary injunctions". Teva itself referred to the "Copaxone Continuation Project" internally, after its basic patent had expired.

The Commission did not assess whether the staggered filing of divisional patent applications could, in itself, constitute an infringement. In Teva's case, it seems that it was the **strategic withdrawals** that crossed the Rubicon, i.e. the line into abuse. The Commission identified the tipping point of the divisional game in 2015, when Teva withdrew approval of the text of the parent patent in the process patent family.

IV – Conclusion – Implications for pharmaceutical patent strategy

The Teva decision reminds life sciences companies operating in the EU of the limits of "strategic patenting", particularly when they hold a dominant market position and when those strategies are deployed to prevent or delay competition by disabling the generics' right to effectively challenge patents, thus creating or prolonging legal uncertainty.

While divisionals and patent portfolios remain lawful, they must not be used in ways that impede legal certainty or unduly burden competitors. More specifically a **combination** of the following can lead to a finding of anticompetitive conduct and infringement of Article 102 TFEU:

- **Withdrawing divisionals before a final ruling** to avoid precedent-setting decisions, particularly if done repeatedly and strategically.
- **Serial staggered filings of near-identical divisionals**, particularly if they are (and patentee knows they are) of questionable validity.
- **Exclusionary intent documented in internal documents**, particularly if patentee knows that its patents are weak. One document found by the Commission that apparently set forth such a strategy even warned Teva to obtain antitrust advice before implementing this strategy.

Conversely, the mere filing of a divisional in cases where the EPO requests so or where the subject-matter of the divisional is clearly different from that of the parent application and where its validity rests on different features or arguments will unlikely be considered a violation of antitrust law.

Applicants filing a divisional that is substantially identical to the parent application should be aware that they are entering a grey zone, at least if (a) applicant holds a dominant market position and if (b) the filing can be seen – based on verifiable facts and evidence - as an attempt to merely prolong legal uncertainty and to deprive generics of the possibility to effectively challenge the patent. This can be the case if this is done multiple times and, particularly, if the earlier cases are

dropped before a final decision is issued on any of them. Conversely, we think there can also be many legitimate reasons for the filing of a divisional, even one that it is relatively similar to the parent application. For example, some cases are "on the fence" and even a seemingly small difference may result in a different evaluation of inventive step. In other cases, there may be added matter problems that can no longer be cured in the granted parent application but can easily be resolved in a divisional. In yet other cases, new prior art may turn up that requires a reaction etc. etc. – In none of these cases we would think that the filing of a divisional would infringe Art. 102 TFEU.

The Commission's decision against Teva offers an authoritative application of Article 102 TFEU to a particular fact pattern where, following the expiry of Teva's basic patent for Glatiramer Acetate, multiple divisionals were filed and then withdrawn to delay legal finality and prolong legal uncertainty, and where in addition a disparaging campaign was used to generate uncertainty in the market. In the Commission's view, this went too far. The decision sends out the signal that dominance comes with responsibility, and that abuse of the patent system will not go unsanctioned.

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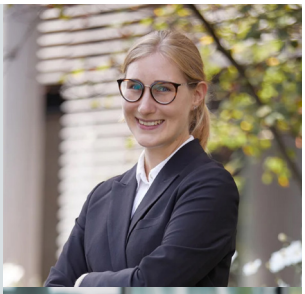

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The Prior Use Right as a Defence in UPC Infringement Proceedings

So-called prior use rights allow under certain requirements the continued use of patented inventions, even after the invention has been patented. In UPC proceedings, defendants must prove such rights separately in each Contracting Member State under respective national laws, in particular to meet the "good faith" requirements. This creates strategic challenges for both claimants and defendants in multi-jurisdictional patent enforcement.

1. Introduction

In general, a patent grants its holder the right to exclude others from using the patented invention, e.g. by producing, importing or offering it, in most jurisdictions. In the European Union, national legislations implementing the IP Enforcement Directive provide for effective, proportionate and dissuasive measures necessary to ensure the enforcement of patents. These measures include the possibility of claiming an injunction against alleged infringers.

The UPC was established by some member states of the European Union. This new court has jurisdiction over the current 18 Contracting Member States ("CMS") of the UPC Agreement. The claimant has the option of initiating an infringement case at the UPC, a process that allows them to establish infringement in every CMS in a single proceeding. The patent holder can seek injunctive relief throughout all CMS before the UPC, irrespective of whether the patent at issue is a European patent with unitary effect ("**EPUE**"), or a conventional European bundle patent ("**EP**"), provided that the EP is validated in every CMS and is still in force in every CMS. The claimant only needs to prove the infringement in one (validated) CMS, because proving a single infringement in one CMS demonstrates a potential risk of infringement in all of the remaining (validated) CMS. This represents a significant advantage in comparison to individual national infringement proceedings.

However, while bringing an infringement claim is always an option, enforcing IP rights against users of the patented invention is not always possible. There are certain circumstances in which such enforcement is not feasible, for example, if the user has a so-called prior use right ("**PUR**"). A PUR is generally established in the following circumstances: if, at the time of filing of the patent application or at the priority date (which is the date on which the invention was first filed with a patent office), a person had already put the invention into use or the necessary preparations for its use had been made, this person may continue to use the invention for the purposes of their own business operations. In other words, the patent becomes unenforceable against this person. Although this user infringes the patent, the patent would have no effect in respect of a person who has a PUR, meaning that the claimant would lose the infringement case.

A typical case in which a PUR might arise would be when one party independently develops and begins using an invention before the patentee files its patent application.

In this article, we begin by briefly outlining the general requirements for invoking a PUR in UPC infringement proceedings. We then focus on the essential requirement of good faith and examine how it is applied. Finally, we summarize the key takeaways. During preparation of the article, we conducted community-wide research on the existence and application of good faith as a PUR requirement under different national laws. Our sincere thanks go to all law firms that contributed to this project.[4]

[4] Maximilian R. Schubert from the law firm GASSAUER-FLEISSNER, Isabelle Vermeyen from the law firm ALTIUS, Elena Miller from the law firm Bojinov & Bojinov, Nicolay Bording and Anders Schøning Frederiksen from the law firm Kromann Reumert, Paul Kaasik and Mari Must from the law firm Ellex Raidla, Fiora Feliciaggi from the law firm abello, Rainer Hilli from the law firm Roschier, Martins Gailis from the law firm Ellex Klavins, Ąžuolas Čekanavičius from the law firm Ellex Valiunas, Nicole Sciberras Debono from the law firm GVZH Advocates, Marta Alves Vieira from the law firm VIEIRA DE ALMEIDA, Vincenzo Jandoli from the law firm LEXSENTIAL, Anne Marie Verschuur and Stephanie de Beer from the law firm De Brauw Blackstone Westbroek, Igor Šetinc from the law firm ITEM, Karin Westerberg from the law firm Sandart & Partners.

2. Requirements for a prior use right

For a PUR to be constituted on the user's side, most CMS jurisdictions typically require three conditions to be fulfilled. As the PUR is a defence in infringement proceedings, the user claiming a PUR has the burden of proof to demonstrate its existence.

The prior user can continue to use the invention even after the patent has been granted, provided that:

- the invention has been used for the purpose of the person's business, or the person has made the necessary preparations for doing so;
- the use (or preparations) happened prior to the filing of the patent application or the priority date; and
- these actions were carried out in good faith, or under a similar legal condition.

Due to differences in national legislation, the requirements for "use" or "preparation" may vary slightly depending on the CMS. For instance, in some CMS, mere possession of an invention may be sufficient to constitute use, while in others possession is not a prerequisite. In some jurisdictions, the use must involve commercial exploitation, while in others actual use of the invention is not required. In this article, we set aside the specifics of these requirements and instead focus on the existence of good faith or, depending on the national laws, a similar standard.

3. Good faith

Prior to the establishment of the UPC, many patent infringement proceedings regarding European patents were dealt with before German courts. As an introduction to the concept of good faith, we first refer to the elaborations of the German Federal Supreme Court,[5] which held that:

> *"... a right resulting from prior use can also arise if possession of invention is derived from the inventor him/herself, ... As also already explained, this principle can only apply if possession of invention* ***was acquired and exercised in good faith****. In the case of a disclosure attributable to the inventor, this is generally only possible if the prior user, based on the circumstances, could consider himself/herself authorized to make use of the teaching recognized by him/her (Federal Court of Justice decision "Kasten für Fußabtrittsroste", loc. cit., GRUR 1964, 673, 675). To this end, it is not sufficient that possession of invention has been legally acquired. It is also required that* ***the prior user may, in good faith, consider himself/herself authorized to exercise possession of the invention on a permanent basis independently of a legal relationship underlying the assignment****. If the legal relationships between the inventor and the prior user are* ***governed by a contract, there is no legitimate basis for such an assumption from the outset if nothing to that effect is apparent from the contract****. The powers of the other party are then* ***based solely on the contractual agreements****, and not on Sec. 12 German Patent Act."*

While definitions and interpretations of good faith vary among the different CMS that recognize it as a requirement, the core principle remains mostly close to the above interpretation: anyone invoking a PUR must have reasonable grounds for believing that they are authorised to continue to use the invention without infringing the intellectual property rights of others.

4. Requirements for invoking a prior use right before the UPC

One of the issues before the UPC regarding invoking a PUR is whether the party asserting a PUR must prove prior use (including good faith) only in a **single** CMS to invoke the right with effect for all CMS, or whether the specific legal requirements for prior use under the national laws of **each** CMS where the right is claimed must be proven separately. In the latter case, this could — depending on the circumstances — result in a successful PUR defence only in some jurisdictions, and not others. In the context of UPC infringement proceedings regarding an EPUE, two provisions are mainly cited to address this question, which are:

- Art. 28 UPC Agreement ("**UPCA**"): Any person, who, if a national patent had been granted in respect of an invention, would have had, in a Contracting Member State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that Contracting Member State, the same rights in respect of a patent for the same invention.

[5] German Federal Supreme Court, Judgement of 10 September 2009, Xa ZR 18/08, margin no. 19 - Füllstoff, emphasis added by the authors of this article.

- Art. 5 (2) Unitary Patent Regulation ("**UPR**", Regulation (EU) No 1257/2012): The scope of that right and its limitations shall be uniform in all participating Member States in which the patent has unitary effect.

On the one hand, Art. 28 UPCA indicates that a PUR exists exclusively in those CMS in which, under national law, the criteria for a PUR defence would be fulfilled (if the EPUE was considered to be a national patent). Art. 5 (2) UPR, on the other hand, could be interpreted as implying that the existence of a PUR — which constitutes a limitation on the enforcement of a patent — in one CMS should have effect for all CMS. The wording would also allow for the interpretation that, although the PUR should have unitary effect, the requirements for the PUR could slightly differ.

Although this issue has not yet been definitively resolved, existing case law suggests that the first interpretation is currently prevailing at the UPC.[6] This applies not only to patents that are EPUE but also conventional European bundle patents (EPs), because EPs are governed solely under Art. 28 UPCA.

Taking the interpretation that a PUR exists exclusively in those CMS in which, under national law, the criteria for a PUR defence would be fulfilled, we then considered the consequences for the claimant and the defendant.

5. Consequences for claimant and defendant

Considering the above findings, a defendant wanting to invoke a PUR before the UPC in an infringement proceeding concerning an EP or EPUE must demonstrate and prove the existence of a PUR for each CMS according to the respective national laws separately.

As a consequence, the main challenge will often lie in meeting the good faith or functionally equivalent requirements under the law for each CMS. An analysis of the different national laws on this matter reveals that they essentially fall into five main groups:

- The good faith requirement is stipulated in the law itself:
  - Austria (Sec. 23 of the Austrian Patent Act)
  - Belgium (Art. XI.36 §1 of the Belgian Code of Economic Law)
  - Bulgaria (Art. 21 of the Bulgarian Law on Patents and Utility Model Registration)
  - Estonia (Sec. 17(1-2) of the Estonian Patent Act)
  - France (Art. L.613-7 of the French Intellectual Property Code)
  - Latvia (Art. 22(1) of the Latvian Patent Act)
  - Luxembourg (Art. 50(1) of the Luxembourg Patent Act)
  - Malta (Art. 29(1) of the Maltese Patents and Designs Act)
  - Portugal (Art. 105 of the Portuguese Industrial Property Code)
  - Romania (Art. 33(1)(b) of the Romanian Patents Act)
  - Slovenia (Art. 20 of the Slovenian Industrial Property Act)
- The good faith element is referred to as "no evident abuse":
  - Denmark (Sec. 4 of the Danish Patents Act: "no obvious misuse")
  - Finland (Sec. 4 of the Finnish Patents Act: "no evident abuse")
  - Sweden (Sec. 15(1) of the Swedish Patents Act: "no evident abuse")
- Other similar requirements:

  Under Art. 55(1) of the Dutch Patent Act there is no distinction between good and bad faith but the person claiming a PUR must have not obtained the knowledge from what was already manufactured or applied by the patent applicant, or from the patent applicant's descriptions, drawings or designs.

[6] Unified Patent Court, Düsseldorf Local Division, Judgement of 3 July 2024, UPC_CFI_7/2023, Headnote 1 – Kaldewei v Bette.

— Good faith required based on analogous legal provisions:

  Despite good faith not being a statutory requirement in Art. 40 of the Lithuanian Patent Act, it is likely that a good faith element would be considered when establishing the existence of a PUR. Case law relating to PURs in the field of industrial designs has established a good faith requirement.

— Good faith requirement in case law:

  — Germany (cf. German Federal Supreme Court, Judgement of 10 September 2009, Xa ZR 18/08 – *Füllstoff*)

  — Italy (cf. Italian Supreme Court, Decision of 5 April 2012, No. 5497 – *Fidia v. Chemi*)

6. Key takeaways

Whether the claimant asserts an EP or an EPUE, the defendant must demonstrate a PUR in each CMS. Therefore, it is possible that the claimant claims infringement across the entire territory of the CMS, but the defendant can only prove a PUR in one individual CMS. The countries in which infringement is claimed and for which a PUR can be proven may thus differ.

Furthermore, the defendant must provide the relevant facts regarding its activities within each CMS to substantiate the PUR defence, including a brief summary of the individual national legislation. This creates extra work in the front-loaded UPC proceedings, as the defendant may have to evaluate the situation in all 18 CMS.

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EU vs. Japan: What Truly Makes a Design?

The Riyadh Design Law Treaty, adopted by the WIPO member states on 22 November 2024, paves the way for streamlined and harmonized global design protection. The recent entry into force of the EU Recast Design Directive and Amended Regulation indicates that the EU is moving in a positive direction to restructure the current design framework to ensure it is future proof, but additional adjustments will be required to ensure legal and procedural convergence with other WIPO member states. An initial exercise should therefore include the identification of the commonalities and differences between the member states, starting with the definition of what is meant by "*design*". In this regard, we specifically look at the legal frameworks in the EU and in Japan.

Definition of "design" in the Recast EU Directive and Amended Regulation

The definition given in the Directive (EU) 2024/2823 which came into force in May this year is as follows:

> *""design" means the appearance of the whole or a part of a product resulting from the features, in particular the lines, contours, colours, shape, texture and/or materials, of the product itself and/or of its decoration, including the movement, transition or any other sort of animation of those features; "product" means any industrial or handicraft item, other than a computer program,* ***regardless of whether it is embodied in a physical object or materialises in a non-physical form,*** *including [...] graphic works or symbols, logos, surface patterns, typographic typefaces, and graphical user interfaces;"*
>
> (Article 3 Regulation (EU) 2024/2822, Article 2 Directive (EU) 2024/2823; emphasis added)

This definition encompasses a broad spectrum of design types and includes direct references to animated designs and digital designs.[7] Notably, with reference to digital designs, Article 2 (4) of the Directive explicitly states that the product need not be embodied in a physical object. This contrasts with the definition of "*design*" in other jurisdictions such as Japan.

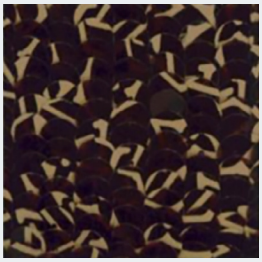
Definition of "design" in the Japanese Design Act

Article 2 of the Japanese Design Act 2019 provides the definition of a design as follows:

> *"design" means the shape, patterns, or colors, or any combination thereof (hereinafter referred to as "shape, etc.")* ***of an article (including a part of an article****), shape, etc., of a building (including a part of a building), or* ***images (limited to those provided for use in the operation of a device or displayed as a result of the device performing its functions****, including a part of such images) that create an aesthetic impression through vision"*
>
> *(emphasis added)*

Thus, whilst the Japanese Design Act provides similar protection for the appearance of a design, in principle, this design must be a physical article or be incorporated in a physical article, a concept akin to that of the "*article of manufacture*" in the US. This limitation does not exist under EU practice, as illustrated by the fact that repeated surface patterns, regardless of whether or not they are applied to a physical object, are design registrable.

[7] Robin De Meyere, Kei Enomoto, The New Face of EU Designs, Hoffmann Eitle Quarterly, March 2025, pp. 11-13.



JP Design Reg.
No. 1167147
"Fabric" with pattern

JP Design Reg.
No. 1167147
"Fabric" with pattern

Further, Article 3(1) of the Japanese Design Act stipulates that only designs with industrial applicability are eligible for registration.

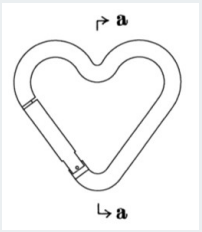
> *"A creator of a design that is **industrially applicable** may be entitled to obtain a design registration for the design"*
>
> (Article 3(1) of the Japanese Design Act)

This industrial applicability limitation means that the design must be reproduceable by industrial means, but also that the "*purpose and function*" of the object to which the design is applied are clearly defined. The purpose and function requirement is closely linked to the assessment of design similarity, in which the intended use and the condition of use of designs are considered from the perspective of consumers.

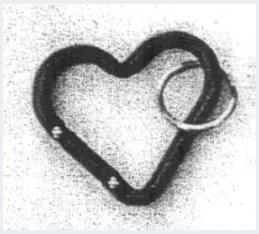
> *"Since a design is inseparably linked to the object, if the objects of the designs being compared are not identical or similar, the designs themselves cannot be considered similar."*
>
> (Examination Guidelines)

> *"The determination of whether a registered design and another design are similar shall be made based on the aesthetic impression created **through the perception of consumers**."*
>
> *(Article 24(2) of the Japanese Design Act)*

When assessing whether two designs are similar, the first step is to assess whether the objects are similar. In the 2005 Carabiner case,[8] the Japanese IP High Court held that a heart-shaped key holder was not similar to a heart-shaped carabiner, the first object being an accessory and the second, a mountain climbing equipment. It was held that the two objects had different purposes and functions, such that the consumers would not confuse a key holder with a carabiner. The key holder was found not to infringe the carabiner design registration.



Design Reg.
No. 1156116 Carabiner



Alleged infringement
key holder

Comparison between EU and Japanese scope of protection

Since the scope of protection of a EU design is not limited by the object it is applied to, a EU court may well have reached a different decision. Indeed, provided the alleged infringing design is identical or produce the same overall impression as a registered design, a positive decision on infringement would be found regardless of whether the design is applied to a carabiner or a key chain. The Carabiner case highlights the necessity, in Japan, to define the purpose and function of each article to which the design is intended to be applied, and thus to file separate design applications for each article.

As indicated in Article 2 of the Japanese Design Act, images are registrable designs but must be provided for use in the operation of a device or displayed as a result of the device performing its functions – thus, digital designs do not escape the purpose and function requirement. As a result, images from films or videogames, desktop wallpapers with no function cannot be registered in Japan, but actionable icons and images can.

[8] Heisei 17 (NE) 10079.

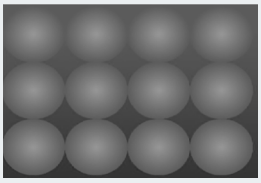


Image of desktop wall-paper (not a registrable design in Japan because it does not meet the purpose and function requirement; i.e., not actionable)

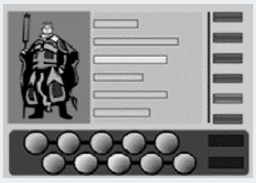
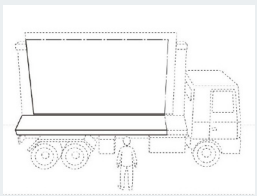
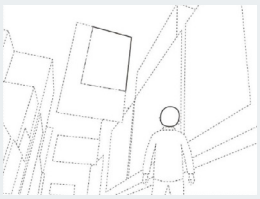


Image from videogame (not a registrable design in Japan because it does not meet the purpose and function requirement; i.e., not actionable)

By contrast, the two designs below were found to be registrable by the Japanese Patent Office, since their purpose and function is to provide a space to display information in virtual reality.



Reg. No. 1738399 "Image for Displaying Information in Virtual Spaces" (registrable design in Japan because it meets the purpose and function requirement)



Reg. No. 1749607 "Image for Displaying Information in Virtual Spaces" (registrable design in Japan because it meets the purpose and function requirement)

Again, this contrasts with EU practice, where functionality is not a requirement but may lead to exclusion from design protection. Article 2 of the Directive (EU) explicitly excludes computer programs, such that an animated design requiring a human intervention to flow from one image to the other may be considered to amount to a computer program. Furthermore, Article 7(1) explicitly states that design rights do not subsist in *"features of appearance of a product which are solely dictated by its technical function"*. Therefore, a fine balance must be found between the Japanese purpose and function requirement and the EU functionality exclusion, especially when preparing the design title and accompanying written description.

Conclusion

As illustrated above, while both the EU and Japanese legal frameworks provide IP protection for designs, subtle differences in definitions lead to greater differences in the registration procedures and in the scope of protection afforded by design registrations. Meaningful procedural alignment is not possible, until and unless a common harmonized definition of "*design*" is adopted. In the meantime, it remains essential to adopt a proactive, forward-looking approach and develop a global strategy before the first design is even filed, in order to anticipate potential hurdles to registration in other jurisdictions.

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Use of AI-Generated Content as Evidence for Claim Interpretation at the EPO and in China

Claim interpretation is important not only during examination proceedings, when assessing novelty and inventive step, but also in legal disputes about the meaning and scope of patent claims. With the widespread use of artificial intelligence (AI) and, in particular, large language models (LLMs), one might wonder to what extent AI-generated content can be used in that context.

1. Claim interpretation at the European Patent Office

At the European Patent Office (EPO), the claims "must be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning".[9] The extent to which the description should play a role in the interpretation of claims is currently subject to a referral to the Enlarged Board of Appeal.[10]

How to interpret the claims was also a point of contention between the parties (patent proprietor and opponent) in T 1193/23.[11] The invention underlying T 1193/23 relates to the safe starting and/or stopping of a rotor of a rotor spinning machine for the production of yarn. At the oral proceedings before the Board of Appeal, the patent proprietor interpreted various terms used in claim 1 by referring to responses received from the chatbot ChatGPT.

The Board found the responses received from ChatGPT to be irrelevant, as the interpretation of the claims should be based on the understanding of the skilled person. The increasing spread and use of chatbots based on LLMs and/or AI alone does not justify the assumption that a response received - which is based on training data unknown to the user and highly depends on the context and the exact formulation of the question(s) - necessarily correctly reflects the understanding of the skilled person in the respective technical field and at the relevant time. Evidence of how certain terms in the claim of a (patent) application are interpreted by the skilled person can, for example, be provided by appropriate technical literature.

This is in line with the conclusion in T 206/22.[12] Here, the Board held that, apart from the fact that a chatbot cannot be equated with a skilled person in a well-defined technical field, the information used by the chatbot to determine its interpretation is based, at least in principle, on all the information available to it, including documents published well after the priority date. It is therefore not an interpretation that necessarily corresponds to what the skilled person would have understood at the priority date.

2. AI-generated content at the China National Intellectual Property Administration

So far, there are no guidelines provided by the China National Intellectual Property Administration (CNIPA) on the extent to which AI-generated content is relevant for claim interpretation.

However, in early May 2025, the CNIPA issued an Office Action in which the examiner cited an AI model

[9] Guidelines for Examination, Part F-IV, Section 4.2, Interpretation.

[10] Referral to the Enlarged Board of Appeal – G 1/24; Christian Schreiber, Adam Lacy, Shall I Stay or Shall I Go – How to Interpret Claims Before the EPO, Hoffmann Eitle Quarterly, September 2024, pp. 14-15.

[11] Decision T 1193/23 of the Technical Board of Appeal 3.2.06 of 15 April 2025, item 1.1.1.

[12] Decision T 206/22 of the Technical Board of Appeal 3.2.05 of 15 March 2024, item 1.

(DeepSeek) to support their argument that a formula defined in the claims lacked sufficient disclosure in the specification.[13,14] Specifically, the examiner stated that the formula lacked logical soundness based on the AI's analysis.[15] This direct citation of an AI-generated analysis in an Office Action triggered significant attention within the intellectual property community. From the examiner's perspective, using AI to help interpret a complex formula may seem reasonable if the formula is not immediately clear from the patent application.[16]

To date, CNIPA has not issued formal guidance on whether AI-generated content may be directly referenced in examination proceedings. However, the quick removal of this Office Action from the CNIPA's website after public reaction suggests a cautious—or even skeptical — attitude toward citing AI directly.[17] At the same time, CNIPA officials have mentioned that they are exploring how to use LLMs to improve patent search and examination systems.[18] This suggests that AI tools might already be playing a quiet but growing role at the CNIPA.

Still, relying more heavily on AI could bring significant changes. For example, an "AI-empowered skilled person in the art" might be better at connecting ideas from different technical fields and might possess a broader knowledge base. This may elevate the standards for determining clarity and sufficiency of disclosure, the obviousness of distinguishing technical features, and whether an amendment is directly and unambiguously derivable from the original application.[19]

3. Conclusion

- Currently, the EPO rejects the idea that AI-generated content from, e.g., chatbots correctly reflects the understanding of the skilled person in the relevant technical field and at the relevant time.
- The use of AI in Chinese patent examination is still evolving, with ongoing debates about its role and impact on examination proceedings. So far, CNIPA has not provided any guidance on the extent to which AI-generated content can be relevant for claim interpretation.

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[13] Han, Baikejun, 2025, A CNIPA Office Action Citing DeepSeek Emerged—Then Disappeared… [引用 DeepSeek 观点的专利审查意见，出现了！然后又下架了…], Baikejun's IP Talk (WeChat Official Account). https://mp.weixin.qq.com/s/qzpind4pv_xgAoRVm2rwcA .

[14] Yuan, Ju-Ling, 2025, China Patent Examiner Uses AI Tool to Question Patent | LinkedIn.

[15] Ibid.

[16] Hao, Ningjing, 2025, Courage! A Patent Examiner Uses DeepSeek to Question Sufficiency of Disclosure—Innovation or Risk? [勇气！这位审查员首次用 DeepSeek 辅助"质疑"某专利申请公开不充分，创新还是冒险?]. Patent Invalidity Search (WeChat Official Account). https://mp.weixin.qq.com/s/INH5MS9Qj3vu-XfQnByoYg.

[17] See note 5.

[18] Jian, Xiao'ai, 2025, Patent Examination Undergoes Radical Reform—AI Is Reshaping the Rules. Are You Ready? [专利审查大变革！AI 正在改写行业规则，你准备好了吗?], Jian Ai Digital Intelligence (WeChat Official Account). Section 3. https://mp.weixin.qq.com/s/p8Ndi6PCKU21W_gxPbdd-g.

[19] Li, Yantao, 2019, Challenges and Responses of Artificial Intelligence to the Patent System [人工智能技术对专利制度的挑战与应对]. https://sls.org.cn/webfile/upload/2019/01-15/11-00-5303761157316115.pdf.

T 1874/23 et al: The Right to Oral Proceedings at the EPO Under Attack

Article 116(1) EPC prescribes that oral proceedings shall take place either at the instance of the European Patent Office (EPO) if it considers this to be expedient or at the request of any party to the proceedings. Hence, a party to the proceedings who has requested oral proceedings expects the EPO to grant the request, as the purpose of Article 116(1) EPC is to safeguard the party's right to be heard. In case T 1874/23, the Board rejected both the appellant's request for re-establishment in the time limit for filing the appeal, as well as the appeal itself without holding oral proceedings, despite the appellant having requested them.

Case background

The case underlying decision T 1874/23 concerns an appellant's request for re-establishment of rights into the time limit for filing the notice and grounds of appeal, following a decision of the Examining Division to refuse the applicant's patent application.[20] In their request for re-establishment, the appellant presented the grounds on which the request was based, indicated that the omitted acts had been completed by way of filing the notice and grounds of appeal as well as paying the appeal fee, and requested, as an auxiliary measure, oral proceedings under Article 116 EPC. In their grounds of appeal, the appellant repeated their request for oral proceedings.

The decision of the Board

Despite the request for oral proceedings, the Board rejected the request for re-establishment immediately in a written decision, without holding oral proceedings. As the request for re-establishment was rejected, the notice and grounds of appeal were late filed and the appeal was rejected as inadmissible.

Specifically, the Board held that the request for re-establishment had not been immediately and completely substantiated within the time limit for filing it.[21] In the Board's view, no factual assertion had been made at least on the provision of an independent cross-check mechanism for monitoring time limits, a requirement for allowability of a request for reestablishment in accordance with the case law of the EPO Boards of Appeal. Therefore, the Board considered that no further procedural steps were permissible, notably no further communication from the Board and no appointment of oral proceedings since, in the Board's view, those would have served no legitimate purpose.[22] In proceedings for re-establishment, the purpose of oral proceedings would not be to give the appellant a (further) chance to substantiate their factual assertions or to provide evidence despite the absence of factual assertions at the outset.[23]

The Board further discussed the right to oral proceedings under Article 116(1) EPC in a more general context, i.e. as being a cornerstone of proceedings before the EPO. Although the Board acknowledged that the jurisprudence of the EPO Boards of Appeal generally assumed an "absolute" right to oral proceedings upon request, it opined that this right was subject to restrictions inherent in the EPC and the procedural principles recognised by the Contracting States.[24]

To substantiate this finding, the Board notably cites as examples: (i) the optional character of oral proceedings in appeals against decisions of the Receiving Section;[25] (ii) the EPO practice that a statement of an intention not to attend oral proceedings is normally considered equivalent to a withdrawal of the request for oral proceedings;[26] (iii) the case of an appellant not

[20] Decision T 1874/23 (Limits to oral proceedings on request) dated 14 March 2025.
[21] Ibid., reasons 20 and 23.
[22] Ibid., reasons 24.
[23] Ibid., reasons 25.
[24] Ibid., reasons 26 and 27.
[25] Ibid., reasons 28.
[26] Ibid., reasons 30.

responding to a Board's communication pointing to a missing statement of grounds of appeal and the resulting inadmissibility of appeal, this rendering the initial conditional request for oral proceedings obsolete;[27] (iv) the non-appointment of oral proceedings when the appeal is filed by a non-entitled third party;[28] and (v) the case of a Board reaching a positive conclusion in the requester's favour, meaning that oral proceedings would serve no purpose.[29]

The Board then moved on to discuss the need for a dynamic interpretation of the EPC in light of the Convention's object and purpose.[30] A dynamic interpretation would be required where considerations that might cause a conflict between the literal interpretation of the wording of the relevant provision and the legislator's aims have arisen since the Convention was signed. This could lead to a result that diverges from the wording of the law.[31]

In the Board's view, several such considerations have arisen. The first is the evolution of re-establishment procedure into a front-loaded procedure.[32] While this may be specific to the re-establishment procedure, the Board elaborated on further considerations that appear to relate to the EPC and function of the Boards in general.

Secondly, the Board considered the circumstances in which the Boards operate, emphasizing the significant number of appeals filed with an increased focus on their timely adjudication. This challenges the provision of timely and effective justice to all parties.[33] The Board also considered relevant, that as "an essential judicial body under the EPC", the Boards are obliged to apply their resources carefully and fairly to where they can best be used.[34]

Thirdly, national and international procedural law has undergone tremendous developments over the years.[35] The Board points out that the European Court of Human Rights (ECHR) has identified occasions where oral proceedings could or even should be dispensed with and that the ECHR regularly dynamically interprets its own case law. The same could be said for the EPC, which operates in a highly dynamic and innovative area.[36]

Thus, the Board concludes that a literal interpretation of Article 116(1) EPC has to give way to a dynamic understanding of the legislator's intentions.[37] The purpose of Article 116(1) EPC is to guarantee the right to be heard only in so far as the oral proceedings serve a legitimate purpose and do not undermine the need for legal certainty in a timely manner, as an essential element of a fair trial for all parties.[38]

Impact on practice

Oral proceedings allow parties to present their case to the Board and to clarify points which may have been unclear. In the case underlying T 1874/23, the appellant requested oral proceedings. The Board nevertheless considered that the request for re-establishment had not been completely substantiated within the time limit for filing the request and thus refused the request for re-establishment without appointing oral proceedings.

When assessing the degree to which a party has initially substantiated their case, it may be necessary to consider the merits of the case, which may be open for discussion and subject to differing views among the parties involved. If oral proceedings had been appointed in the case underlying T 1874/23, the appellant could have explained during the hearing why their case had been duly substantiated at the outset, contrary to the Board's view. The circumstances of T 1874/23 also differ substantially from the examples[39] provided by the Board to support its conclusion.

The extent to which this decision might impact in general the conduct of proceedings before the EPO is

[27] Ibid., reasons 31.
[28] Ibid., reasons 33.
[29] Ibid., reasons 34.
[30] Ibid., reasons 47. The Board specifically refers to Article 31(1) and (3) of the Vienna Convention on the Law of Treaties (1969).
[31] Ibid., reasons 49.
[32] Ibid., reasons 51. The Board specifically refers to the principle of "Eventualmaxime" being gradually adopted.
[33] Ibid., reasons 52.
[34] Ibid., reasons 67.
[35] Ibid., reasons 53.
[36] Ibid., reasons 59.
[37] Ibid., reasons 60.
[38] Ibid., reasons 61.
[39] Examples (i) to (v) discussed above.

still unclear. For example, if a Board is deeply convinced, based on the submissions made in the written proceedings, that there is no patentable subject-matter in a patent application, could the Board consider not holding oral proceedings, given the limited resources of the Boards and the need for legal certainty in due time for all parties? The Board could be convinced that the oral proceedings would serve no legitimate purpose and would therefore be detrimental to other parties by delaying their cases. More than ever, parties are well advised to completely and convincingly substantiate their appeal cases upfront, to avoid tempting the Boards to directly reject the case without holding oral proceedings.

Pending petition for review

Following T 1874/23, it seems that the appellant has chosen not to file a petition for review of the case by the Enlarged Board of Appeal under Article 112a EPC. However, in related case J 6/22 (the Boards in charge of J 6/22 and T 1874/23 share one member), the appellant has filed a petition for review, which is pending under R 16/23.[40] Oral proceedings for this case have been scheduled by the Enlarged Board of Appeal for November this year. We will report on the Enlarged Board's decision once it is available.

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[40] EPO public file of EP 3 008 767.

Carry-Over Elements at the EPO: Admissibly Raised and Maintained?

Although the EPO Guidelines state that auxiliary requests filed in response to the summons to oral proceedings cannot, as a rule, be considered as late filed, this statement may give proprietors in opposition proceedings a false sense of security, in view of the RPBA. We also address what it means for opponents to raise and maintain objections and arguments in the first instance oral proceedings.

Background

The Rules of Procedure of the Boards of Appeal (RPBA), which underwent a significant revision in 2020, contain legal provisions governing the appeal proceedings at the EPO, whether they follow first instance examination ("ex parte") or opposition ("inter partes") proceedings. The RPBA matter not only for the appeal proceedings *per se*, but also for conducting first instance proceedings at the EPO. This article focuses on the impact of Article 12(4) RPBA, introduced in 2020, on the first instance proceedings.

Article 12(2) RPBA notably provides that "[...] a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based".

Article 12(4), first paragraph, further provides that "[a]ny part of a party's appeal case which does not meet the requirements in paragraph 2 is to be regarded as an amendment, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal." The Board has the discretion to decide whether to admit any such amendment.

What about the requests, facts, objections, arguments and evidence on which the decision under appeal was not based, because the first instance deciding body (for example the Examining or Opposition Division) was able to resolve the case without dealing with these elements, and those are then "carried over" in the second instance? Those are called "carry-over elements", i.e. carry-over requests, facts, objections, arguments and evidence. Carry-over elements are not automatically part of the appeal proceedings.[41] According to Article 12(4) RPBA, these elements are regarded as an amendment, unless the party maintaining those demonstrates that these elements were admissibly raised and maintained in the first instance proceedings that have led to the decision under appeal.

When encountering carry-over elements, the Boards are therefore required to assess whether these elements were admissibly raised and maintained during the first instance proceedings. How this assessment is to be carried out and to which extent the Boards are to put themselves in the shoes of the first instance department in this respect is subject to case law, which does not appear to be fully uniform.

Admissibly raised: The divergence

In the case underlying T 1178/23, published in March 2025, the Opposition Division had maintained the patent in an amended form according to an auxiliary request 1, which became the proprietor's main request in the appeal proceedings. In appeal, after holding that the subject-matter of this main request lacked inventive step, Board 3.2.05 then moved on to assess whether a carry-over request, i.e. auxiliary request 4, which had been submitted in the first instance proceedings but had remained unexamined, ought to be admitted into the appeal proceedings.[42]

Applying Article 12(4), first paragraph, RPBA, the Board assessed whether the request had been "admissibly raised" during the first instance proceedings. For this assessment, the Board adopted the perspective of the first instance department, considered "which practice

[41] See for example T 1800/20, reasons 3.2, first sentence: "Although the present auxiliary request 2' was already filed in the proceedings at first instance, its admission to the appeal proceedings is not automatic." (translation); T 1913/21, reasons 38; and T 1659/22, reasons 2.2.

[42] T 1178/23, reasons 44 to 49.

applied at the time when the decision on admittance would have been taken", and held that, to do so, the Guidelines[43] needed to be considered, for legal certainty. As a result of a statement contained in the Guidelines – in the version that would have been applicable at the time when the Opposition Division would have had to exercise its discretion – the Board then held that the request had been admissibly raised in the first instance proceedings so that it did not constitute an amendment to the proprietor's appeal case. Hence, the request was part of the appeal proceedings.

In T 823/23, also published in March 2025, Board 3.2.03 had to deal with a carry-over objection (here, a sufficiency of disclosure objection) and also held that the perspective of the first instance department had to be adopted.[44] As in T 1178/23, the Board also considered the Guidelines applicable at the time the first instance proceedings would have exercised its discretion, and it concluded that the objection had not been admissibly raised in the opposition proceedings.[45] The objection was eventually not admitted into the appeal proceedings.[46]

In contrast, in T 364/20 published in November 2023, Board 3.3.02 had to deal with 16 carry-over requests, three of which had been filed in response to the notice of opposition and the remaining 13 had been filed in response to the summons.[47] All of them were eventually considered to have been admissibly raised in the first instance proceedings and thus regarded as part of the appeal proceedings. However, the Board reached that conclusion without considering as decisive the contents of the Guidelines applicable at the time the first instance department would have exercised its discretion. Rather, the Board expressly indicated its disagreement with the Guidelines. That Board thus clearly did not consider it necessary, when stepping into the shoes of the Opposition Division, to accept the contents of the Guidelines.

In T 246/22, Board 3.5.03 also rejected the idea of taking the Guidelines into account when assessing the admissibility of carry-over requests under Article 12(4) RPBA.[48] The Board instead proposed "another approach, namely that of defining minimum requirements for the demonstration of "admissibly raised" which could be more conducive to legal certainty and fairness [...]".[49] This approach considers not only the point in time at which the carry-over request was filed, but also insists that the purpose of the amendments must be clear at the time of filing.

Since the Guidelines are not binding on the Boards,[50] and Article 23(3) EPC provides that "[i]n their decisions the members of the Boards shall not be bound by any instructions and shall comply only with the provisions of the [EPC]", an application of Article 12(4), first paragraph, RPBA that is not influenced by the Guidelines appears to be a reasonable approach. It is also at least questionable whether the Boards can take for granted that the Guidelines necessarily comply with the EPC and the established case law of the Boards of Appeal in all respects,[51] for example with regard to principles such as that of equal treatment of the parties during opposition proceedings.[52]

Raising and maintaining objections in first instance oral proceedings

Many opponents are selective about which of their arguments and objections raised in writing they discuss in the first instance oral proceedings. The established case law makes clear that this strategy may deprive them of the opportunity to rely on these elements on appeal.

In T 526/21 the Board held that attacks raised in writing but not "*actively maintained*" at the first instance oral proceedings can be considered to have been "*implicitly abandoned*" and inadmissible on appeal.[53]

[43] That is, the Guidelines for Examination in the European Patent Office (EPO), adopted by the President of the EPO under Art. 10(2)(a) EPC.

[44] T 823/23, reasons 7.13.

[45] Ibid., reasons 7.20.

[46] Ibid., reasons 7.25.

[47] T 364/20, reasons 5 to 7.3.

[48] T 246/22, reasons 4.13: "This approach [consisting in taking the Guidelines into account] [...] fails to convince this board since the Guidelines are not binding on the Boards [...]".

[49] Ibid., reasons 4.14.

[50] Case Law of the Boards of Appeal of the European Patent Office, 10th edition 2022, section III.W.1.

[51] At least one Board thinks this is the case, though. See T 1913/21, reasons 43, last sentence: "[...] the Guidelines for examination reflect the consolidated jurisprudence of the Boards of Appeal on the criteria for admittance of requests to be applied in opposition proceedings."

[52] See e.g. T 1776/18, reasons 4.5.10, fifth sentence: "[...] to ensure the equal treatment of opponents and patent proprietors in respect of the admittance of their submissions [...]".

[53] T 526/21, reason 3.1.2. See also Case Law of the Boards of Appeal of the European Patent Office, 10th edition 2022, Section V.A.4.3.4.h.iii.

T 773/21 takes this a step further by not admitting a novelty objection against auxiliary request 3B, which was first filed by the proprietor during first instance oral proceedings. Opponent didn't expressly raise this objection during the oral proceedings because novelty had already been acknowledged by the OD for the broader auxiliary request 2, meaning that novelty must also be acknowledged for auxiliary request 3B as a matter of logic.[54] The Board didn't accept that this means the objection was maintained, or justifies raising it on appeal, holding that:

> *The board finds that an objection raised with regard to other requests previously dealt with or still pending cannot be tacitly transferred to a newly submitted request. As long as an objection is not explicitly stated or submitted, it cannot be considered to have been raised or filed.*[55]

Practical significance

The first instance EPO Guidelines provide that auxiliary requests filed in response to the summons "cannot, as a rule, be considered as being late-filed".[56] Yet, proprietors in opposition proceedings should expect that, if such auxiliary requests become "carry-over requests" in appeal, i.e. requests not decided upon by the first instance department but becoming relevant in the second instance proceedings, some Boards may ignore the Guidelines when assessing whether these requests were admissibly raised in the first instance proceedings.

It is therefore advisable for proprietors to file, already in response to the notice of opposition, auxiliary requests that address all objections that could reasonably be expected to be taken up by the Opposition Division and to explain clearly for which purpose the amendments are made. Contrary to what the first instance Guidelines state, waiting until the response to the summons to file auxiliary requests may be too late. The same is true for other types of carry-over elements, i.e. facts, objections, arguments and evidence, whether filed by opponents or proprietors.

Meanwhile, parties need to be very careful about which elements of their case they explicitly mention in the first instance oral proceedings. Failure to expressly rely on all arguments and objections for all requests, even where these have no prospects of success in the first instance, may make it impossible to rely on these on appeal.

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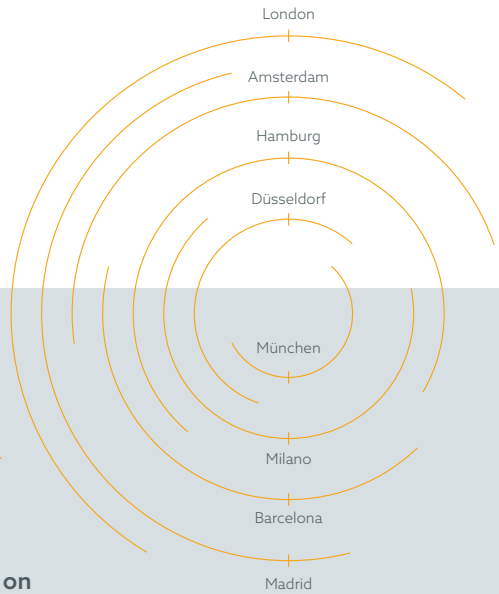
[54] T 773/21, see reason 8.2.

[55] Ibid., reason 8.5.

[56] Guidelines (2025 edition), E-VI, 2.2.2, second paragraph, second sentence: "Amendments submitted before the date set under Rule 116(1) cannot, as a rule, be considered as being late-filed."



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