

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [X] To Chairmen
- (D) [-] No distribution

**Datasheet for the decision
of 19 September 2025**

Case Number: T 1285/23 - 3.2.02

Application Number: 17179765.7

Publication Number: 3266482

IPC: A61M16/06, A61M16/08

Language of the proceedings: EN

Title of invention:
PATIENT INTERFACE

Applicant:
Fisher & Paykel Healthcare Limited

Headword:

Relevant legal provisions:
EPC Art. 111(2), 106, 76(2)
EPC R. 139, 103
RPBA 2020 Art. 11

Keyword:

Res judicata

Binding effect of board of appeal decision on the department of first instance

Principle of the protection of legitimate expectations

Substantial procedural violation - (yes)

Reimbursement of the appeal fee (yes)

Decisions cited:

J 0013/18, J 0014/18, G 0001/97, T 0934/91, T 2194/22,

G 0009/92, T 0449/15, T 0843/91, T 2337/16, T 2371/18

Catchword:

In view of the principle of res judicata, the Examining Division is not competent to decide in substance on a request in respect of which the Legal Board of Appeal has issued a final decision in proceedings relating to the same patent application.



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 1285/23 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 19 September 2025

Appellant: Fisher & Paykel Healthcare Limited
(Patent Proprietor) 15 Maurice Paykel Place
2013 Auckland (NZ)

Representative: Gill Jennings & Every LLP
The Broadgate Tower
20 Primrose Street
London EC2A 2ES (GB)

Decision under appeal: **Decision of the Examining Division, posted on
21 March 2023, refusing the request dated
20 October 2020 to add Great Britain as a
validly designated state.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: Y. Podbielski
S. Dennler
A. Martinez Möller
C. Schmidt

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division to refuse the request dated 20 October 2020 to add Great Britain (GB) as a validly designated state for the application. The appellant requests that the decision of the Examining Division be set aside and GB be added as a validly designated state. The request is based on the principle of the protection of legitimate expectations ("the principle of good faith").
- II. A previous request to include GB as a validly designated state had been refused by the Receiving Section in its decision posted on 22 May 2018. The appeal against that decision was dismissed by the Legal Board of Appeal in J 13/18 of 19 May 2020. As this decision is relevant to the outcome of this case, the facts underlying that decision are also set out below.

Events leading up to the decision of the Receiving Section posted on 22 May 2018

- III. The present application no 17179765.7 was received by the EPO on 5 July 2017 and is a divisional application derived from the earlier application no 10774623.2 ("the parent application"). The appellant withdrew the designation of GB in the parent application on 2 March 2017. The parent application was granted and the patent published as EP 2 429 623 B1 on 12 July 2017. GB was not listed as a designated state.
- IV. The present application was published as EP 3 266 482 A1 on 10 January 2018. GB was not listed as a designated state. In a letter dated 23 February 2018 the appellant stated that they considered all EPC

states as designated for the application and requested a formal decision in relation to which designated states were considered not designated by the EPO.

- V. In its decision the Receiving Section refused to include the designation of GB as a validly designated state, because only contracting states designated in the parent application at the time of filing the divisional (i.e. present) application were deemed designated in the divisional application, and at the time the present application was received (5 July 2017), the designation of GB in the parent application had already been withdrawn (2 March 2017).

- VI. The appellant filed an appeal against that decision.

The appeal proceedings in J 13/18

- VII. In the statement setting out the grounds of appeal the appellant based its case on a request for correction. It had been an obvious error to withdraw the designation of GB in the parent application before the filing of the present application. As the parent application had been granted in the meantime this request for correction was pursued with regard to the present application. At a later stage in the proceedings the appellant also argued that the wording of Article 76(2) EPC did not exclude the designation of states in a divisional application even if the designation of these states had already been withdrawn in the parent application when the divisional application was filed.
- VIII. During the oral proceedings before the Legal Board of Appeal the appellant sought to rely for the first time on the principle of good faith. They stated that they

had relied on the communication dated 10 August 2016 concerning the application which was eventually the subject of decision J 14/18. This case concerned the then co-pending application no. 16174992.4 ("the co-pending application"). In that communication the EPO had listed GB as one of the designated states. According to the appellant, they had trusted this information and the principle of good faith required the designation of further contracting states also in the present application. This new objection could not have been presented earlier as the communication dated 10 August 2016 only came to light when preparing the oral proceedings (J 13/18, point XIII. of the summary of facts and submissions).

- IX. Decision J 13/18 was issued on 19 May 2020. The Legal Board of Appeal dismissed the appeal. It interpreted Article 76(2) EPC and concluded that adding GB as a designated contracting state would contravene that Article, because GB had been withdrawn as a designated contracting state in the parent application at the time of filing the present application. The Legal Board of Appeal also decided not to admit the submissions under Rule 139 EPC filed with the statement setting out the grounds of appeal (Article 12(4) RPBA 2007). Furthermore, it decided not to admit the new submissions made during the oral proceedings based on the principle of good faith (Articles 12(4), 12(6) and 13(1) RPBA 2020).

The proceedings before the Examining Division

- X. In a letter dated 20 October 2020 the appellant requested that the present application be updated such that GB was included as a designated state. It based this on the principle of good faith, arguing that this

reasoning had not been admitted by the Legal Board of Appeal in J 13/18 and requesting that it now be admitted. In its communication dated 22 February 2021 the Examining Division not only gave a preliminary opinion on the request to add GB as a designated state under the principle of good faith, but also on a request for correction. The Examining Division explained this conduct as follows: "For the sake of completeness, and taking duly account of the decision of the Legal Board of Appeal not to admit the request under Rule 139 EPC (see point 2 of J 13/18), the Examining Division will also examine whether the requirements for a correction under Rule 139 EPC are met." In its subsequent submissions before the Examining Division the appellant based its request then both on the principle of good faith and on the correction of an error.

- XI. In the decision under appeal the Examining Division decided that neither the principle of good faith could be applied nor that the request for correction under Rule 139 EPC could be granted. The request to include GB as a validly designated state for the present application was thus refused.

The present appeal proceedings

- XII. In the present appeal proceedings the appellant requests that the decision of the Examining Division be set aside and GB be added as a validly designated state. The request is based on the principle of good faith. The finding of the Examining Division concerning correction under Rule 139 EPC is not disputed by the appellant.

- XIII. In preparation for the oral proceedings, the Board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA, dated 15 May 2025, according to which the Examining Division had committed a substantial procedural violation by issuing its decision dealing in substance with the same request that had already been settled by the Legal Board of Appeal in J 13/18, and according to which the appellant's request to add GB as a validly designated state was inadmissible.
- XIV. The appellant responded to this communication with submissions dated 11 August 2025.
- XV. Oral proceedings before the Board took place on 19 September 2025. At the conclusion of those proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.
- XVI. The arguments of the appellant relevant for the decision are dealt with in detail below in the reasons for the decision.

Reasons for the Decision

1. The present appeal concerns the question as to whether the Examining Division is competent to consider in substance a request on which the Legal Board of Appeal had issued a decision, following an appeal against a decision of the Receiving Section.
2. The appellant did not dispute that a decision of a Legal Board of Appeal concerning a decision of the Receiving Section could in principle also have a binding effect, or an effect of res judicata, on an

Examining Division when the application proceeded to that division. However, it argued that its request was now based on the principle of good faith. In J 13/18 the Legal Board of Appeal had never considered that line of argument in substance, but had based the dismissal of the appeal, and thus the refusal of the request to add GB as a designated state, solely on the interpretation of Article 76(2) EPC. There could thus not be a binding effect, under Article 111(2) EPC, of that decision on the Examining Division when they considered that request on a different legal basis, namely the principle of good faith. For similar reasons, the appellant also argued that the principle of *res judicata* was also not touched by the Examining Division's examination of the request in substance.

3. The Board disagrees. In J 13/18 the Legal Board of Appeal dismissed the appeal. By doing so it upheld the finding of the Receiving Section not to include GB as a validly designated state in the application. Decision J 13/18 became final when it was issued at the end of the oral proceedings. There is no possibility to appeal against it under Article 106 EPC. As pointed out in G 1/97, a decision of a Board of Appeal can only be contested where there is an express provision to that effect in the EPC (G 1/97, Reasons 2(e) and 2(f)). There is no provision in the EPC that provides for final decisions of the Boards of Appeal to be set aside on the basis of the principle of good faith - that principle only protects parties from disadvantageous consequences of the omission of procedural steps, in relying on erroneous information from the EPO (Case Law of the Boards of Appeal, 11th edition 2025 ("CLB"), III.A.2). This in effect means that the decision J 13/18 has the authority of "*res judicata*".

4. Res judicata is a generally recognised principle in the contracting states which is acknowledged by the Boards of Appeal (Case Law of the Boards of Appeal, 11th edition 2025 ("CLB"), V.A.10.1.1 a)). It applies to final decisions and interlocutory decisions alike. In T 934/91 (OJ 1994, 184, Reasons 3) the Board referred to its well established meaning in the following terms:
 "...it defines "...a matter finally settled by a Court of competent jurisdiction, rendering that matter conclusive as to the rights of the parties and their privies" (see Blacks Law Dictionary, 5th edition). Such a final judgment by a court of competent jurisdiction therefore constitutes an absolute bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties or their privies."
5. The subject-matter of decision J 13/18 was the determination of whether the Receiving Section's refusal to add GB as a validly designated state to the application was correct or had to be overruled. In its decision the Legal Board of Appeal considered whether Article 76(2) EPC could be interpreted such as to allow the appellant's request, and decided not to admit the lines of argument presented by the appellant based on the correction of errors and on the principle of good faith. By dismissing the appeal the Legal Board of Appeal issued a conclusive decision on the request of the appellant to include GB as a validly designated state in the application, rather than admitting the late filed lines of argument (including that of the principle of good faith) and remitting the case to the department of first instance for further prosecution.
6. The appellant argued that res judicata applied to the reasoning of a decision, rather than to its order.

Given that its request was based on the principle of good faith and the Legal Board of Appeal had not considered this line of argument in substance, decision J 13/18 had no effect of res judicata on its current request. As long as the proceedings were still pending, any new line of argument in support of the same request could be brought and be considered by the competent department provided it did not contradict the earlier decision.

7. The Board agrees with the observation made in T 2194/22 that the conclusive decision on a specific request is an absolute bar for reconsideration, irrespective of whether the facts are the same (Reasons 2.2.4). The appeal proceedings are governed by the requests of the parties (G 9/92, Reasons 1). They determine the extent of the proceedings and are the matter on which the competent Board takes a decision. They are thus, in the context of res judicata, "the matter" which is "finally settled by a court" (see also T 449/15, Reasons 2.3 and 2.4). In the case in hand, this is the request for adding GB as a validly designated state in the application.
8. The effect of "res judicata" emanating from J 13/18 cannot be limited by the Board's reasoning on which this decision is based. If a party were allowed to pursue the request decided upon in that decision again, this time on the basis of new facts, it would open the possibility to render the legal effect of that decision null and void, a legal consequence specifically not foreseen for decision J 13/18, which cannot be appealed.
9. This result is also in line with the established case law of the Boards of Appeal, according to which a

finding by a Board of Appeal that the subject-matter of a specific claim request complies with the requirements of the EPC cannot be challenged in subsequent proceedings before the EPO (i.e. after remittal; CLB V.A.10.1.1 a), T 843/91 of 5 August 1993, headnote and Reasons 3.4.1 and 3.4.2). This ensures that parties cannot pursue another, new objection against such subject-matter, and thus force a reconsideration of the issue of patentability of that subject-matter.

10. In its written submissions of 11 August 2025 the appellant referred to two national decisions as evidence that the occurrence and revelation of new facts could be sufficient to override the principle of res judicata. That principle was thus allegedly somewhat "nebulous" and the Board should consider the appeal by focusing on Article 111(2) EPC instead.
11. The Board notes that the two national decisions cited - Ladd v Marshall [1954] 1 WLR 1489, of the England and Wales Court of Appeal, and a decision from the French Court of Cassation (Cass Civ 3rd, 14 November 2012, 11-21.901) - were rendered in a specific set of circumstances. The appellant has not shown how these decisions are relevant to the case in hand and the Board also does not see any relevance. On the contrary, the Board notes for example that Ladd v Marshall appears not to be concerned with the question whether a case can effectively be retried after a final, non-appealable decision. Thus these decisions cannot cast doubt on the well-established legal principle of res judicata.
12. The appellant then argued with reference to T 2337/16 that a Board was not entitled to ignore evidence taken into account by the department of first instance. As

the decision under appeal had considered the evidence presented by the appellant in support of the application of the principle of good faith, the Board had to consider this evidence. The Board agrees with the general principle that a Board needs to take the evidence into account on which an appealed decision is based and which is relied on by a party in the appeal proceedings. However, this only applies to matters on which the first instance department was competent to decide. Any decision taken by a department of first instance on a matter on which it was not competent to decide is *ultra vires*, rendering the decision void and unenforceable.

13. During the oral proceedings, the appellant relied on numerous passages of decision T 2194/22. Accordingly, that decision provided support for the view that a new line of argument, which had not been admitted, could be taken into account in substance in subsequent proceedings. When assessing whether this could be allowed, one important consideration was allegedly whether the Board's reasoning in its decision not to admit the new line of argument was purely of a procedural nature or not (T 2194/22, Reasons, 2.4.4). In J 13/18 that was the case. Hence, the Examining Division had been competent to decide on the request to add GB as a validly designated state in the application, based on the principle of good faith.
14. There are two important factual issues which distinguish T 2194/22 from the case in hand. The first is that T 2194/22 is not concerned with a case where the Board had finally settled a request. The discussion concerned the binding effect, under Article 111(2) EPC, of the first board of appeal decision T 2371/18 on the opposition division, and in particular whether a claim

request, which had not been admitted by the competent Board, could be considered in substance by the opposition division in subsequent proceedings. Thus the considerations made in points 3-9 above are not applicable in T 2194/22, and cannot be put into question by the considerations in T 2194/22. The second is that the facts underlying the competent Board's decision in T 2371/18 for not admitting the claim request in question were not the same as the facts before the opposition division after remittal, because a new objection was introduced in the post-remittal proceedings. In the case in hand, no such change in the factual situation occurred. The Board notes that either of these factual issues which distinguish T 2194/22 from the case in hand, even taken separately, lead to the conclusion that the appellant's arguments which rely on that decision are not convincing.

15. It is uncontested that the submissions which were sought to be introduced before the Legal Board of Appeal and those which were considered by the Examining Division in the decision under appeal are in essence the same. The appellant contended that the facts in the present case were different in that the new facts on which these submissions were based had only come to light shortly before the oral proceedings in J 13/18, and the submission of these facts late in the appeal proceedings meant that there was a different procedural situation from that before the Examining Division, which had considered the facts at the beginning of the proceedings.
16. The Board, however, agrees with the considerations in T 2194/22 (Reasons 2.4.4) that the mere fact that the first instance proceedings before and after remittal are not identical, and that the Rules of Procedure of

the Boards of Appeal are not directly applicable in the first instance proceedings, cannot as such be regarded as "facts which are not the same" that would suspend the binding effect under Article 111(2) EPC. Thus, even if the Board applied Article 111(2) EPC to the case in hand, this would not have altered the Board's conclusion.

17. For the reasons set out above, the Examining Division was not competent to decide in substance on the appellant's request to add GB as a validly designated state in the application. The decision is void and is formally to be set aside.
18. Under Article 11 RPBA the Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. The appellant has not requested that the case be remitted to the Examining Division for further prosecution and the Board does not see any special reasons for doing so.
19. The Board concluded above that in view of the effect of res judicata emanating from J 13/18 the Examining Division was not competent to decide in substance on the appellant's request in question. The Board is equally bound by this effect. As a consequence, the appellant's request to add GB as a validly designated state in the application is inadmissible.
20. The Board considers it equitable to reimburse the appeal fee. By issuing a decision on a matter in respect of which it was not competent, the Examining Division committed a substantial procedural violation. Whilst the appellant did not obtain the full legal

redress sought by its appeal, the Board nevertheless had to set aside the impugned decision.

21. Furthermore, the Board concurs with the body of case law according to which reimbursement of the appeal fee may be ordered based on the principle of good faith, even if the appeal was not allowed and thus one of the conditions of Rule 103(1)(a) EPC was not met (CLB, V.A. 11.14). Any party to proceedings has a legitimate expectation that an EPO department only decides on requests in substance if it is competent to do so. By issuing the decision under appeal the Examining Division gave the appellant the expectation that it was competent to decide as it did, and in reliance on that, the appellant filed an appeal. Whether the appellant would have filed an appeal had the Examining Division decided that the appellant's request was inadmissible is a matter of pure speculation which cannot be taken into account when deciding whether or not to reimburse the appeal fee. In these circumstances the Board decided, ex officio, to reimburse the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The request to add Great Britain as a validly designated state in the application is refused as inadmissible.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



A. Chavinier-Tomsic

M. Alvazzi Delfrate

Decision electronically authenticated