

### 3. Admissibility of requests

#### 3.1. Party's responsibility to define subject-matter by filing appropriate requests

In T 506/91 the board held that filing requests and deciding if several alternative requests were appropriate or not was a matter that in the end could only be decided by the party concerned and it should be routine for representatives to decide independently how to pursue their cases, including what requests to submit.

In T 382/96 the board stressed that one of the fundamental principles of European patent law was that responsibility for defining the subject-matter of a patent rested with the applicant (patent proprietor). The applicant (patent proprietor) could not offload this responsibility de facto onto the EPO or any other parties to the proceedings by filing a multitude of requests, let alone incompletely formulated request variants. Doing so constituted an abuse of procedure, as it overburdened the EPO and any other parties to the proceedings with work not originally theirs to perform and thereby hampered the orderly conduct of proceedings. Auxiliary requests which had not been verbally specified in more detail were inadmissible for the purposes of R 64(b) EPC 1973 (now R 99(2) EPC) because they did not identify the extent to which amendment or cancellation of the contested decision was requested; the same went for auxiliary requests for which no grounds had been set out (i.e. not substantiated) within the meaning of the third sentence of Art. 108 EPC 1973.

T 446/00 concerned a case in which a large number of requests was filed with an offer to amend the claims further if the board so wished; the board held that a party could not in that manner abdicate its responsibility to present its case to the board and that such requests were both inadmissible and an abuse of procedure.

In T 745/03 the board pointed out that it was up to a party to decide on the presentation of its case. When filing several sets of claims, a party usually listed them in order of preference, the least limited claims being a main request, the more limited versions auxiliary requests, so that if a higher order request should fail, then a lower, more limited request would still have a chance of success. In the case before the board this had changed to an approach which could more aptly be designated as "**pick and mix**", as independent claims present in higher order requests were also to be found in lower order requests in differing permutations of independent claims. The "pick and mix" approach can both give an impression of fishing around for something patentable and mean that some independent claims are not even the subject of a decision. See also T 221/06.

In R 11/08 the Enlarged Board confirmed that adopting a "pick and mix" approach could run the risk of requests being found inadmissible, abuse of procedure, and disadvantages for the party in question.

In T 1138/12 the board decided that an auxiliary request for maintenance of a patent on the basis of the claims it considered grantable from among those in a claim set was insufficiently defined and therefore inadmissible.