



1 July 2019

## Written statement of epi concerning case G 2/19

### About the epi

On 21 October 1977, the Administrative Council of the European Patent Organisation established the **epi** by adopting the Regulation on the establishment of an institute of professional representatives before the European Patent Office. The **epi** is the professional body representing all European Patent Attorneys. Currently the **epi** has about 12,300 European Patent Attorneys as members coming from each of the 38 Contracting States of the European Patent Convention who work either in industry or in private practice.

### G 2/19

The following comments are provided by **epi** in order to assist the Enlarged Board of Appeal (“the EBA”) in its consideration of the questions referred in G 2/19.

### Background

The reference to the EBA arose on the basis of the prosecution of a European patent application. During prosecution, a third party (“the Filer”<sup>1</sup>) filed observations under Article 115 EPC. These observations raised objections to the claims under Article 84 EPC. Despite these observations, the Examining Division decided to allow the application and grant a patent. The Filer then filed a purported appeal and requested oral proceedings before the Board of Appeal to which the purported appeal was directed (“the Board”). The main argument of the Filer is that it was adversely affected by the decision to grant and that it is therefore entitled to redress. According to the Filer, as Article 84 EPC is not a ground of opposition or revocation, there is no explicit mechanism in the EPC or national law for seeking redress in such a situation. The Filer therefore argued that, in such circumstances, since the Boards of Appeal are the second instance for persons who are adversely affected by decisions of the first instances of the EPO, the Filer is implicitly entitled to file an appeal and is entitled to have its case heard at oral proceedings.

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<sup>1</sup> This terminology is used to help in distinguishing between parties to the proceedings and third parties.

## **The Reference**

The Board decided that fundamental issues arose and so referred the following questions to the EBA. (The questions are given in the original German, followed by an unofficial English translation.)

1. Ist im Beschwerdeverfahren das Recht auf Durchführung einer mündlichen Verhandlung gemäß Artikel 116 EPÜ eingeschränkt, wenn die Beschwerde auf den ersten Blick unzulässig ist?

1. In appeal proceedings, is the right to oral proceedings under Article 116 EPC restricted where the appeal is *prima facie* inadmissible?

2. Wenn die Antwort auf Frage 1 ja ist, ist eine Beschwerde gegen den Patenterteilungsbeschluss in diesem Sinne auf den ersten Blick unzulässig, die ein Dritter im Sinne von Artikel 115 EPÜ eingelegt und damit gerechtfertigt hat, dass im Rahmen des EPÜ kein alternativer Rechtsbehelf gegen eine Entscheidung der Prüfungsabteilung gegeben ist, seine Einwendungen betreffend die angebliche Verletzung von Artikel 84 EPÜ nicht zu berücksichtigen?

2. If the answer to question 1 is yes, is an appeal against the decision to grant in this sense *prima facie* inadmissible, where the third party within the meaning of Article 115 EPC filed the appeal and justified it by arguing that within the framework of the EPC no alternative legal remedy is available against a decision of the examining division not to consider its objections regarding the purported non-compliance with Article 84 EPC?

3. Wenn die Antwort auf eine der ersten beiden Fragen nein ist, kann die Kammer ohne Verletzung von Artikel 116 EPÜ die mündliche Verhandlung in Haar durchführen, wenn die Beschwerdeführerin diesen Standort als nicht EPÜkonform gerügt und eine Verlegung der Verhandlung nach München beantragt hat?

3. If the answer to one of the first two questions is no, can the board hold oral proceedings in Haar without infringing Article 116 EPC if the appellant has complained that the location was not EPC-compliant and requested a transfer to Munich?

## **Legal Basis**

**epi** considers that the following provisions of the EPC are relevant to these questions.

### Article 6 EPC

(1) The Organisation shall have its headquarters in Munich.

(2) The European Patent Office shall be located in Munich. It shall have a branch at The Hague.

#### Article 107 EPC

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

#### Article 115 EPC

In proceedings before the European Patent Office, following the publication of the European patent application, any third party may, in accordance with the Implementing Regulations, present observations concerning the patentability of the invention to which the application or patent relates. That person shall not be a party to the proceedings.

#### Article 116(1)

Oral proceedings shall take place ... at the request of any party to the proceedings ...

### **Case Law**

**epi** considers that the following case law is relevant to these questions.

#### T 811/90

In this case, the Board held that, in some circumstances, even an opponent does not have a right to be heard. In this case, shortly before oral proceedings were scheduled to take place before an opposition division, the opponent withdrew its opposition. The opposition division then decided to cancel the oral proceedings, reject the opposition and maintain the patent as granted. However, the opposition division failed to notify the patentee of the cancellation and the decision. In preparation for the oral proceedings, the patentee filed amended documents but these did not reach the file until after the opposition division had made its decision. The patentee therefore requested that the amended documents be removed from the public part of the file. The Formalities Office decided not to do this and so the patentee appealed. During the appeal proceedings, the opponent made submissions. However, the board in that case held that, since the opponent was not a party to the decision not to remove the documents, it was not a party to the appeal and therefore had no right even to make submissions. The relevant part of the decision reads as follows:

Whether the Opponent has the right to be a party to the present proceedings

According to Article 107 EPC, any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings, as of right. In the present case, the impugned decision is that issued on 10 August 1990, to which the Opponent was not a party; consequently he is not entitled to be a party to the present proceedings.

In fact, the Opponent was only involved in the now concluded Opposition proceedings since he did not appeal against the decision of the Opposition Division to reject the opposition (i.e. to maintain the patent in unamended form), although on 5 February 1990 the new submissions filed by the Patentee with letter dated 25 January 1990 were communicated to him. Consequently he had enough time to consider them, that is, until 9 April 1990, the end of the time limit for lodging an appeal. Hence, his request dated 18 December 1990 is inadmissible.

It can however be considered as an observation by a "third party" according to Article 115 EPC.

This shows that the right to oral proceedings is not an absolute right and only exists where a party is or remains a party to the proceedings.

#### T 390/07

In this case, a Filer had filed observations during the appeal proceedings. These included experimental evidence which the Filer considered relevant but the observations were filed at a late stage in the proceedings. The patentee argued that the observations should not be admitted to the proceedings and the opponent argued that they should. It appeared to the board in that case from the arguments of parties (the patentee and the opponent only) that they had not properly appreciated the status of a Filer. The board in that case therefore held as follows in Section 4 of the Decision:

The parties, and appellant II in particular, appear to have misunderstood the procedural position with regard to evidence filed by third parties. A third party is, despite the use of the word "party", **not** a party to the proceedings and has no more than an opportunity to "present observations" (Article 115 EPC). It is clear from Article 115 EPC that, since a third party cannot be a party to any proceedings, it cannot be a party to appeal proceedings (see also Article 107 EPC). While it is well-established by case-law that third party observations can be considered, both at first instance and on appeal, there is no obligation on the board beyond such consideration and **no right of a third party to be heard** on the admissibility of its observations and of any evidence in support of observations ... (emphasis added)

This makes it clear that a Filer is not a party to the proceedings, does not have a right to file an appeal and does not have a right to be heard at oral proceedings. It is clear that the Board considered that a Filer only has the right to “present observations” and does not have any other rights.

#### T 1259/09

The board held that by filing a request for correction of the grant decision under R. 140 EPC a third party does not become a party to the examination proceedings.

#### T 1756/11

**epi** considers that this case is particularly relevant because the board in that case held that a third party has no right to be heard. In particular, the Board in Section 2.4 of the decision stated (in translation into English):

2.4 Procedural rights of parties to the proceedings, such as in particular the right to appeal, Article 107 EPC, and the right to be heard, Article 113(1) EPC, are in principle **not available to the third party due to its status**. See G 4/99, OJ 1989, 480, point 2 of the reasons. **A right of the third party to be heard** regarding his submission thus **does not exist at any time** of the opposition proceedings (emphasis added).

#### Is the Purported Appeal Really an Appeal?

It is **epi's** view that the purported appeal is not, in fact, an appeal. It is made clear in Article 116(1) that any person filing third party observations is **not** a party **to the proceedings**. This is confirmed by the cases referred to above. It is also made clear in Article 107 EPC that the only persons having a right to appeal are those who are parties **to the proceedings**.<sup>2</sup> Therefore, the Filer of the observations described above in the Background has no right to file an appeal. An appeal can only exist if the person filing the appeal has the right to appeal. Therefore, it should be held that no appeal existed as no right to appeal existed.

It is also submitted that there can be no appeal because the Filer is not aggrieved by the decision.<sup>3</sup> A party can only appeal if a request to exercise its rights was not considered or not met. However,

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<sup>2</sup> Under R. 14(1) EPC, the EPO must stay the proceedings for grant ex officio if a third party provides it with evidence that he has instituted proceedings against the applicant seeking a decision within the meaning of Art. 61(1) EPC. An appeal may be filed against the Legal Division's decision adversely affecting the applicant, proprietor or third party respectively. **This seems to be an exception in which a third party becomes a party to the proceedings.**

<sup>3</sup> If one would adopt a broad view on being affected by a decision, it could be argued that whilst the Filer may not be a party to the proceedings for grant, he would be adversely affected by a decision (not to allow his

as is made clear in T 390/07, the only right a Filer has is to “present observations”. T 390/07 makes it clear that it is not necessary for the observations to be admitted into the proceedings, for instance if they are filed too late (see also T 1756/11). In the present case, the Filer’s rights were observed as the Filer was able to make observations. The Filer therefore is not aggrieved and so could not file an appeal even if it were a party to the proceedings (which it is not).

Thus, the present purported appeal did not come into existence and so it is not an appeal.

It follows from this that no right to oral proceedings exists because there are no pending proceedings.

The present case should be distinguished from cases where a party to the proceedings (an applicant, patentee, opponent or intervener) had a right to file an appeal, did file what was purported to be an appeal but did not fulfil all the substantive and formal requirements for filing an admissible appeal. In such circumstances, and assuming that the requirements were not fulfilled in time to meet the deadline for doing so, then the appeal must be held to be inadmissible (or not filed, depending on the outcome of G 1/18). However, as the party filing the appeal did have a right to appeal but did not do so properly, it should be open to that party to argue that the appeal is, in fact, admissible.

#### Right to Oral Proceedings

Even if, contrary to the view set forth above, it is concluded that an appeal exists, **epi** considers that the Filer of the observations still does not acquire a right to oral proceedings. This is made clear in T 1756/11. This makes it clear that a Filer of observations does not have any right to oral proceedings.

Moreover, T 811/90 makes it clear that even parties to proceedings do not necessarily have a right to oral proceedings. In that case, the opponent was not allowed to attend oral proceedings where the question was only whether documents provided by the patentee were to be placed on the public part of the file. It was held that the opponent had no legitimate interest in the outcome of these proceedings and so did **not** have a right to oral proceedings in this matter.

In the present case, the circumstances are such that the Filer did not have any rights which would be affected by any oral proceedings which take place. This is because the Filer does not have any rights to be affected. The Filer exhausted its rights by filing the observations.

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appeal) and thus could/should have the right to comment (thus to oral proceedings). Admittedly, these oral proceedings would then be strictly limited to the admissibility. However, the case law mentioned above does not support this view.

In proceedings where an appeal has been filed by one of the parties **to the proceedings**, but the board considers that the appeal is inadmissible, it is common practice within the boards to hold oral proceedings and to allow the party or parties **to the proceedings** to make oral submissions. However, in such situations, the party or parties **to the proceedings** *prima facie* has or have a right to file an appeal and so there is a possibility that the preliminary view of a board that the appeal is inadmissible could perhaps be wrong.

Again, this should be contrasted with the situation set out in the Background above where it is abundantly clear from the Articles quoted above that the Filer is **not a party to the proceedings** and therefore without any doubt has no right to appeal and is not adversely affected by the decision to grant. In such circumstances, the purported appeal has absolutely no chance of being even considered an appeal, and certainly not an admissible appeal.

It is therefore the case that the Filer has no right to oral proceedings.

The Filer argues that it has been aggrieved in that its request for the application to be refused has not been met. However, since the Filer is not a party to the examination proceedings, the Filer has no right to make any requests. The only party to the examination proceedings is the applicant and so it is only the applicant which has a right to make requests.

The Filer may be aggrieved in a general sense by the fact that the application was granted. Clearly, the Filer did not want this to happen. However, that merely puts the Filer in the same position as any other person with an interest in the application and who considers that it should not have been granted. Such other persons also were unable to make any requests in the application proceedings. The only difference is that such persons did not exercise their right to present observations. In light of this, such persons may be aggrieved in a general sense but are not aggrieved in the sense of Article 107 EPC and so have no right to file an appeal. The same is true for the Filer.

### **Article 84 EPC is Not a Ground of Opposition**

The Filer has argued that, because Article 84 EPC is not a ground of opposition or revocation, it has no other recourse and so it is implicit that there must be a right of appeal. **epi** considers that this is incorrect for two reasons.

First, the law is abundantly clear and so there is no scope for adding an implicit provision into such clear law.

Second, the Filer does have recourse. The Filer can file an opposition. It may be that it is not possible to oppose on the ground of Article 84 EPC. However, if a claim is actually unclear, then this by itself may mean that a granted patent is invalid, for instance because a feature in a claim is

so unclear that it must be disregarded entirely or because the claim is given a much broader meaning than the one the applicant argued for during prosecution. This may mean that the claim, as properly construed, lacks novelty or lacks inventive step. Thus, it is possible within EPO proceedings for the Filer as an opponent to argue that the failure to meet the requirements of Article 84 EPC should lead to the revocation of the patent. The Filer could alternatively make the same arguments in national revocation proceedings. Even if the Filer cannot show in opposition or revocation proceedings that the patent is invalid or requires restriction, the Filer can still argue in national infringement proceedings that the claim cannot be enforced because it is too unclear. Thus, the Filer does not need an implicit right to an appeal because the Filer has recourse in other ways.

It is also to be pointed out that it has been known since 1979, when the EPC came into effect, that Article 84 EPC is not a ground of opposition. It was extensively debated in the Travaux Préparatoires for EPC 1973. It was decided then that this would be the case and it was at the same time decided that Filers should not become parties to the proceedings. The question of whether Article 84 EPC should become a ground for opposition was raised again in the preparations for EPC 2000 and again it was decided that it should not. There was also no change in the status of Filers. It has thus been accepted for many years that Filers do not have a right to file an appeal. The first Appeal Board case referred to above was from 1990 and has not been challenged. If it is accepted case law that an opponent, who once was a party to the proceedings, can lose the rights to file an appeal and have an oral hearing, it cannot be seen how it could be considered that a Filer can acquire these rights.

### **Article 125 EPC**

The application of this provision appears *prima facie* not required.

### **Munich and Haar**

The **epi** welcomes a clarification if the EBA wishes to address question 3. In this regard, the **epi** refers to its earlier position, which called for a legal review:

“Before a decision is taken on premises, as noted above, **epi** would also suggest that the AC should have a sound view on the legal basis for moving the BoA to a different location, without the need to change either Articles 6 and 7 EPC or the Protocol on Centralisation.” (**epi** comments in CA/98/15)

### **The Answers to The Questions**

#### **Question 0**

**epi** considers that there should be a question zero, which is:



“If a purported appeal is filed by a legal person who was not a party to the proceedings which gave rise to the decision, does an appeal proceedings come into existence?”

**epi** considers that the question should be answered in the negative.

#### Question 1

In appeal proceedings, is the right to oral proceedings under Article 116 EPC restricted where the appeal is *prima facie* inadmissible?

**epi** considers that the answer to this question should be that, **provided that** the party filing the appeal was a party to the proceedings which gave rise to the decision under appeal and therefore had the right to file an appeal, the party to the proceedings should be afforded the opportunity to have oral proceedings.

#### Question 2

If the answer to question 1 is yes, is an appeal against the decision to grant in this sense *prima facie* inadmissible, where the third party within the meaning of Article 115 EPC filed the appeal and justified it by arguing that within the framework of the EPC no alternative legal remedy is available against a decision of the examining division not to consider its objections regarding the purported non-compliance with Article 84 EPC?

**epi** considers that, in the circumstances set out in the question, the “third party” has no right to file an appeal because the “third party” was not a party to the proceedings which gave rise to the decision and so the appeal does not exist. Even if it does exist, then it is inadmissible for the reasons set out above.

#### Question 3

If the answer to one of the first two questions is no, can the board hold oral proceedings in Haar without infringing Article 116 EPC if the appellant has complained that the location was not EPC-compliant and requested a transfer to Munich?

**epi** welcomes a clarification on the legal basis if the EBA wishes to address question 3.