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**Datasheet for the interlocutory decision
of 11 November 2024**

Case Number: T 1286/23 - 3.2.04

Application Number: 14735118.3

Publication Number: 2941163

IPC: A47K7/04, A61H23/02

Language of the proceedings: EN

Title of invention:

SKIN CLEANSER

Patent Proprietor:

FOREO AB

Opponents:

Beurer GmbH

GESKE GmbH & Co. KG

Headword:

Relevant legal provisions:

EPC Art. 61(1), 99, 99(1), 97(3), 100, 104(1), 104(3), 105, 105(1), 105(1)(a), 105(1)(b), 105(2), 107, 107 sentence 1, 107 sentence 2, 108, 112(1), 112(1)(a), 112(3)
EPC R. 79(4), 89(1), 99(2)
EPC 1973 Art. 105(2)
EPC 1973 R. 25, 57(4)
RPBA 2020 Art. 10(1), 13(2), 14, 21

Keyword:

Decisions cited:

G 0001/84, G 0002/91, G 0004/91, G 0008/91, G 0010/91,
G 0009/92, G 0003/93, G 0001/94, G 0002/04, G 0003/04,
G 0001/09, G 0001/18, G 0004/19, T 0202/89, T 1026/98,
T 1038/00, T 1007/01, T 1178/04, T 0452/05, T 0435/17,
T 0439/17, T 1839/18

Catchword:

Under Article 112(1)(a) EPC and Article 21 RPBA the following points of law are referred to the Enlarged Board of Appeal for decision:

After withdrawal of all appeals, may the proceedings be continued with a third party who intervened during the appeal proceedings? In particular, may the third party acquire an appellant status corresponding to the status of a person entitled to appeal within the meaning of Article 107, first sentence, EPC?



Beschwerdekammern

Boards of Appeal

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Case Number: T 1286/23 - 3.2.04

I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal 3.2.04
of 11 November 2024

Appellant: Beurer GmbH
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Party as of right: GESKE GmbH & Co. KG
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
9 May 2023 concerning maintenance of the
European Patent No. 2941163 in amended form.**

Composition of the Board:

Chairman	C. Heath
Members:	C. Kujat
	J. Wright
	G. Martin Gonzalez
	T. Bokor

Summary of Facts and Submissions

- I. European patent no. 2941163 concerns a device that can be described as an oscillating handheld skin cleanser. The patent was granted on 9 December 2020 to the predecessor of the patent proprietor, a private person, and subsequently transferred to the current patent proprietor Foreo AB (in the following 'Foreo').

- II. An opposition was filed by Beurer GmbH (in the following 'Beurer') based on a lack of novelty and inventive step (Article 100(a) EPC) and unallowable extension of subject-matter (Article 100(c) EPC).

- III. Prior to the oral proceedings before the Opposition Division, a (first) intervention under Article 105 EPC was filed by the intervener Geske GmbH & Co. KG (in the following 'Geske') on 23 November 2022 based on a warning letter (threat) Geske had received from Foreo on 23 August 2022. In that letter Foreo accused Geske of infringing the patent and demanded that Geske ceased the infringement, also threatening Geske with legal action.

The Opposition Division found that the mere existence of a threat without action for infringement was insufficient for an intervention under Article 105 EPC.

- IV. In reply to Foreo's above letter of August 2022, Geske requested assurances from Foreo that the latter would not further threaten with infringement action. As no such assurances were forthcoming, in February 2023 Geske filed a suit before the Düsseldorf District Court with the request for the court to hold that Geske did not infringe the European patent EP 2941163. Such

request for ascertainment of non-infringement ("negative Feststellungsklage") was based on sec. 256 German Code of Civil Procedure.

- V. This suit was the basis for Geske's second attempt to intervene to the pending opposition proceedings on 2 March 2023 (second intervention). Also this intervention was held inadmissible by the Opposition Division on the grounds that Article 105 EPC required a pending court action either for infringement or for a declaration of non-infringement. While the suit (for the declaration of non-infringement) had been initiated, it only became "pending" under German law upon receipt of the defendant, sec. 253 German Code of Civil Procedure, and thus they have not yet been "instituted" for the purposes of Article 105(1)(b) EPC.
- VI. The Opposition Division in the oral proceedings on 10 March 2023 thus decided on the opposition only on the basis of Beurer's opposition and upheld the patent in amended form based on a second auxiliary request. The written decision was issued on 9 May 2023 and was appealed by Beurer on 10 July 2023 (9 July being a Sunday). The grounds of appeal followed on 18 September 2023 (17 September being a Sunday).
- VII. Only after the Opposition Division had handed down its written decision was Geske's suit dispatched to Foreo in Sweden, the defendant of that suit. According to the court records, this happened on 15 May 2023. The suit was subsequently delivered to the defendant, although in the absence of a signed return slip, it is not clear when Foreo had been formally notified. Foreo reacted on 23 June 2023 and acknowledged receipt of the claim.

VIII. On 15 August 2023, Geske declared an intervention (the third intervention) to the pending opposition and filed an appeal against the decision of 9 May 2023 with the request to revoke the patent in its entirety. Fees for both opposition and appeal were paid. The relevant passage of this document reads as follows:

"...wird hiermit der

BEITRITT

der GESKE GmbH zu dem Einspruchsverfahren gegen das europäische Patent 2 941 163 von FOREO AB erklärt. Das Einspruchsverfahren befindet sich nunmehr bereits in der Beschwerde vor der Beschwerdekammer 3204 und trägt das Beschwerdeaktenzeichen T1286/23- 3.2.04, und es wird deshalb im Namen der GESKE GmbH zugleich auch

Beschwerde

gegen die Entscheidung der Einspruchsabteilung vom 9. Mai 2023 erhoben.

Demnach wird das Europäischen Patentamt beauftragt, von unserem Konto 28000148 sowohl die Beitritts- bzw. Einspruchsgebühr in Höhe von EUR 880, als auch die Beschwerdegebühr in Höhe von EUR 2.925,- abzubuchen.

Es wird beantragt,

1. das europäische Patent 2 941 163, nachstehend als "Streitpatent" bezeichnet, in vollem Umfang zu widerrufen, indem der Beschwerde der Einsprechenden/ Beschwerdeführerin Beurer GmbH sowie der diesseitigen Beschwerde vollumfänglich stattgegeben wird..."

- IX. The Board issued a summons on 13 February 2024 for oral proceedings to be held on 27 June 2024, whereupon Beurer on 11 April 2024 withdrew their appeal.
- X. The Board subsequently issued a communication on 30 April 2024 indicating that although Beurer as appellant had withdrawn their appeal, the Board was minded to discuss during the oral proceedings whether this would necessarily terminate the appeal proceedings, or whether appeal proceedings could continue with Geske as intervener/appellant. If the latter, the Board saw a conflict with decision **G 3/04** (OJ 2006, 118), making it necessary to refer the case to the Enlarged Board of Appeal.
- XI. Oral proceedings were held on 27 June 2024 where only the questions were discussed as to whether Geske's appeal and intervention was admissible, whether appeal proceedings should be continued and whether a referral to the Enlarged Board in this respect was necessary and/or admissible.
- XII. In the oral proceedings the patentee as respondent requested that the appeal be rejected as inadmissible, the intervention to be deemed inadmissible, and that the appeal proceedings be terminated. A referral to the Enlarged Board should not be made.

The intervener confirmed that they wished to continue proceedings, that they had joined appeal proceedings both as intervener and appellant and requested that the patent be revoked. Further, should the Board consider it appropriate to deviate from decision **G 3/04**, the Board should refer the question to the Enlarged Board of Appeal.

XIII. The respondent Foreo argued that first of all, the intervention was inadmissible. This was so because intervention was only open to third parties not already party to the opposition proceedings. However, Geske had already twice tried to become part of the opposition proceedings, refusal of which could be appealed. Regardless of whether Geske had not appealed the decision of the Opposition Division to refuse the intervention, or whether Geske's intervention/appeal of 15 August should be considered a late-filed appeal against the decision of the Opposition Division, Geske had been party to the opposition proceedings. It would seriously compromise a patentee's position if an intervener could have several, in this case, three bites of the cherry, in other words three chances to intervene. In support of their position, Foreo cited decisions **T 1178/04** of 27 February 2007, **T 435/17** of 19 March 2019 and **T 1038/00** of 27 February 2007.

Further, even if the intervention was deemed admissible, the Board should follow decision **G 3/04**, as no circumstances had occurred meanwhile that would indicate that the decision was no longer good law. A referral was further not called for as none of the referral requirements under Article 112 (1) EPC were met: There was no conflicting case law, and the question was not of a fundamental nature.

XIV. At the end of the oral proceedings the Chairman stated that the Board intended to refer a question to the Enlarged Board of Appeal. The question would be aimed at whether appeal proceedings should be continued in the current circumstances, contrary to decision **G 3/04**. The proceedings would be continued in writing, and the parties be given opportunity to comment also in the proceedings before the Enlarged Board of Appeal. With

letter dated 12 July 2024, Geske made some further suggestions in regard of the interpretation of Article 105 EPC and the questions to be referred.

Reasons for the Decision

1. On the admissibility of Geske's appeal and intervention

1.1 The Board must first deal with the implications of Geske's appeal filed with its letter of 15 August 2023 ("*Beschwerde gegen die Entscheidung der Einspruchsabteilung vom 9. Mai 2023*").

1.1.1 In the Board's reading, the appeal is directed against two different issues. First, against the Opposition Division's decision that the (second) intervention of 2 March 2023 (cf. point V. above) was inadmissible. Second, against the division's findings on the substantive opposition grounds.

1.1.2 As for the inadmissibility of the second intervention, the Board already in its provisional opinion had indicated that the appeal was filed out of time and thus inadmissible. Geske had not contested this provisional finding, and the Board thus holds that Geske's appeal is inadmissible to the extent that it is directed against the opposition division's finding on the admissibility of the second intervention. In view of the procedural peculiarities of the present case, in particular with regard to the second issue mentioned above, the Board cannot immediately declare the appeal as deemed not to have been filed, unlike in the situation provided for in **G 1/18**, Headword 1(b).

1.1.3 The admissibility of the appeal in respect of the substantive issues depends on the admissibility of the

third intervention, and on the question whether an intervener entering the proceedings at the appeal stage may or may not acquire appellant status at all, as subsequently set out in detail.

- 1.2 The Board holds the third intervention admissible, for reasons set out below. Thus, the effective date of Geske's recognised intervention is 15 August 2023.
 - 1.2.1 On 15 August 2023, the appeal case was pending before the Boards of Appeal due to the admissible appeal filed by Beurer on 10 July 2023.
 - 1.2.2 The Board regards Geske's letter of 15 August as a declaration to intervene. The fact that the letter also contained an appeal against the Opposition Division's decision to deny Geske the status of intervener does not detract from this finding - the wording used in the letter ("*Beitritt*") is clear. Put differently, Geske's second not admitted intervention and its subsequent attempt to appeal the non-admission of its second intervention does not deprive Geske of its third-party status within the meaning of Article 105(1) EPC.
 - 1.2.3 Contrary to the patentee's submissions, the Board cannot see that Geske had three bites of the cherry, but, to stay with the patentee's metaphor, they tried three times to have one bite of the cherry.
 - 1.2.4 Due to the interplay between the rules of the European Patent Convention and those of national infringement proceedings, an intervener often finds itself between a rock and a hard place when trying to calculate the appropriate three months interval to intervene. According to case law, Article 105 EPC in this regard requires either a pending infringement action or a

pending action for a declaration of non-infringement. The term "pending" ("instituted proceedings" in the wording of Article 105 EPC) is generally interpreted in accordance with domestic law and thus has no uniform meaning. It could mean "when the action has been raised", or "when the defendant / respondent receives notice", or even something different. Some decisions of the Boards point to a more autonomous interpretation of the term (**T 452/05** of 30 August 2006: In case of an *ex parte* interim injunction, pendency cannot be affirmed before the court order is served on the respondent, as otherwise, the respondent/intervener could not have obtained knowledge). Under German law, a civil law suit is considered pending only once served upon the defendant (sec. 253 Code of Civil Procedure), while under German administrative law, raising a suit is sufficient to make it pending, see sec. 91 of the Code of Administrative Court Procedure (Verwaltungsgerichtsordnung, 'VwGO'). Had Geske raised the suit before an administrative court and at the same time requested referral to the competent civil court, the suit would have been considered pending at the time it was raised. The case gives rise to the suggestion that *de lege ferenda*, autonomous rules for the application of Article 105 could be incorporated into the EPC.

- 1.2.5 In the current case before the Board, Geske first tried to intervene after receipt of Foreo's warning letter. Under Article 105(1)(a) EPC, this is not sufficient. However, a threat and a request to cease infringement can justify an action of non-infringement that can be filed by the accused infringer (Article 105(1)(b) EPC). This happened also in the present case, and a second attempt to intervene was made after Geske had filed an action for ascertaining non-infringement in February

2023. This was still before the oral proceedings were held before the Opposition Division.

- 1.2.6 During the oral proceedings held on 10 March 2023 the Opposition Division rejected also the second intervention, and ruled that a "pending" lawsuit under German civil law required notification to the other party, and according to case law, only then had proceedings been "instituted" as required by Article 105(1)(b) EPC (points 23.1-5 of the Reasons of the impugned decision).
- 1.2.7 Notwithstanding the inadmissibility of Geske's late appeal on this issue (cf. point 1.1.2 above), the Board considers that this assessment of the Opposition Division is correct as such, yet does not categorically exclude that the division could have decided otherwise. As argued by the intervener, the division could possibly have postponed oral proceedings or could perhaps have admitted Geske on a provisional basis, as suggested by Bostedt, in: Singer/Stauder, *Europäisches Patentübereinkommen*, 8th ed. 2019, Article 105 note 19 (see point 23.3 of the Reasons of the impugned decision). However, the existence of these further and at least theoretically not implausible procedural possibilities does not mean that the decision of the Opposition Division not to recognise/admit the first or second interventions had been wrong and should be overturned by the Board on appeal. The provisions of Rule 79(4) EPC suggest that an intervention should, as far as applicable, not lead to an unnecessary prolongation of the opposition proceedings. In this respect the Opposition Division has a certain discretion, and it is not apparent that this discretion was exercised in a manifestly wrong manner.

1.2.8 It then took the German court a surprising three months to dispatch the claim to Foreo in Sweden. The German court in the absence of a return slip could not establish with certainty when and if the claim had been delivered on the defendant. Only Foreo's reaction in June 2023 indicated such receipt. As demonstrated also in the present case, a potential intervener is thus faced with legal and factual uncertainties, not to mention the law's delay.

1.2.9 The Board regards the term "third party" in Article 105 EPC as a party who had the opportunity to present their case in substance. That Geske by trying to intervene became a formal party to the opposition proceedings in regard of its party status does not make them a party to the opposition proceedings proper in the full capacity of an opponent, meaning that they would have ceased to be a "third party" within the meaning of Article 105(1) EPC. Rather, they were denied the effective party status of an opponent and therefore also unable to present their arguments in regard of opposition grounds under Article 100 EPC.

1.3 It is useful at this stage to return to the question of inadmissibility of Geske's appeal on the non-admittance of the second intervention. This finding has no further implications for the admissibility of the intervention: Geske's intervention of 15 August 2023 would only have been inadmissible as the second bite of the cherry had Geske's prior attempt to intervene at the stage of opposition allowed Geske to argue its opposition in substance, which was not the case. Thus, even if Geske had filed its appeal in time, it could not appeal against the Opposition Division's decision to (partially) uphold the patent, but only against the fact that it was not admitted as an intervener and thus

an effective party to the proceedings. In other words, for the admissibility of Geske's intervention, it makes no difference whether Geske had filed an admissible (but unsuccessful) appeal, an inadmissible appeal or no appeal at all against the opposition division's decision to find Geske's earlier (second) intervention inadmissible. Certainly, if Geske had succeeded in having its second intervention recognised, e.g. by means of a timely appeal, the third intervention would have become moot and Geske would have acquired full rights both as an opponent and as an appellant.

- 1.4 In sum, being denied party status does not make an intervener an effective party. If the argument of the respondent were accepted, it would mean that Geske would have had to have pursued the case of its party status already based on the refusal of its first intervention, would have had to have appealed and if confirmed on appeal that Geske had no right to intervene, could not have intervened any more, already because they would have lost the three-months period.
- 1.5 Case law cited by the respondent does not support the respondent's position: decision **T 1178/04** of 27 February 2007 concerned the question whether the status of an opponent could and should be determined ex officio (affirmed); decision **T 435/17** of 19 March 2019 concerned the relationship between the opponent and two interveners, and whether their geographic, economic and legal proximity still permitted the interveners to be seen as third parties in the sense of Article 105 EPC (third party status recognised). These decisions are not relevant to the issue before the Board.
 - 1.5.1 The decision **T 1038/00** of 27 February 2007 concerned a situation where a regular opponent did not appeal

against a decision of the Opposition Division and later tried to intervene at the appeal stage (third party status not recognised and the intervention not admitted). Under these circumstances, the Board held that the intervener could not be considered a third party as they were able to present their case in opposition, could have appealed the decision in substance but chose not to do so. The Board would add that in these circumstances, the opponent/intervener indeed tried to have two bites of the cherry.

1.5.2 A case that can be directly compared to the current one is **T 439/17** of 7 May 2019 (cited by the intervener) where the intervener already during opposition proceedings tried to intervene based on proceedings to collect evidence. Intervention was denied because proceedings to collect evidence did not have the ultimate purpose of determining infringement by a court or similar authority, i.e. it could not be seen as "proceedings for infringement" within the meaning of Article 105(1)(a) EPC. The intervener then again declared its intervention at the appeal stage after the plaintiff had raised infringement proceedings. The second intervention was deemed admissible despite the former (unsuccessful) attempt to intervene.

1.5.3 Accordingly, these decisions do not contradict the definition of a "third party" as set out above, so that for the purposes of Article 105 EPC, the Board would thus define a "third party" in opposition and appeal proceedings as a party that has not yet had the opportunity to raise grounds of opposition and also to have the prospect to have them examined in substance. Geske did not have this opportunity until their (third) intervention/appeal on 15 August 2023.

1.6 The other requirements of Geske's intervention were not disputed. They were dealt with in the Board's provisional opinion as set out in the communication of 4 February 2024, see points 2 and 3.

1.7 The Board thus affirms its preliminary opinion that the (third) intervention, as declared on 15 August 2023, is admissible.

1.8 The question remains whether Geske's appeal against the substantive issues is admissible. This seems to depend on whether or not Geske can acquire the status of appellant within the meaning of Article 107, first sentence, EPC. This in turn requires the Board to take issue with the decision **G 03/04**.

2. *On the admissibility of the referral*

2.1 On this point, the respondent has argued that the reasons for a referral under Article 112 EPC are not fulfilled: There would be no apparent divergence in the case law, and the point of law was not of fundamental importance.

2.2 The Board concurs with the respondent patentee that there is no apparent non-uniformity in the case law, unsurprisingly so. It is hardly realistic to expect divergent case law once the Enlarged Board has ruled on the issue: *Roma locuta, causa finita*. Article 21 RPBA is particularly meant to address this situation.

2.3 The Board is also in agreement with the respondent that Article 21 RPBA does not and cannot provide an automatic justification for referral. Rather, an intention to deviate from an earlier decision of the Enlarged Board must still meet the requirements of

Article 112 EPC, which requires either non-uniform case law or the presence of a fundamental question of law. For this latter, divergence is not at all required. A point of law can be one of fundamental importance even without any conflicting case law (decision **G 4/19** (OJ 2022, 24), Reasons 12). There may be cases where a question that had been previously considered to be one of fundamental importance is no longer important, e.g. due to legislative changes or where a question has lost practical importance.

- 2.4 The Board however takes the view that the legal position of a party to appeal proceedings is normally one of fundamental importance, see also **G 03/04**, Reasons 1: "These are issues which concern the definition of the rights and obligations of a party to the proceedings - in this case, the intervener under Article 105 EPC - and pose questions of procedural law of fundamental importance ... (es handelt sich hier um ... Verfahrensfragen von grundsätzlicher Bedeutung)". Certainly, in case **G 03/04** the Enlarged Board also recognised that these issues were not only important but also uniform application of the law had to be ensured, given that the referring decisions clearly laid out that there had been a divergence in the case law. However, that does not detract from the fact that party status, whether before the first instance divisions or in appeal proceedings, is normally a fundamental question of law, as demonstrated by several decisions of the Enlarged Board, for example the status of an opponent in the case of transfer of the opposition (decision **G 02/04** of 25 May 2005), or the possibility of a patentee to become opponent to its own patent (affirmed in decision **G 1/84**, OJ 1985, 299, later denied in **G 3/93**, OJ 1994, 891).

2.5 The answer to the referred questions is also necessary for the Board's decision. If the decision **G 03/04** were to be revised and the intervener could continue the proceedings in its own right, the appeal proceedings would have to continue with the examination of the substantive issues, namely the opposition grounds raised by the intervener. If the conclusions of **G 03/04** were to be confirmed, the Board would no longer have competence to decide and the appeal proceedings would have to end without a decision on the substantive issues, with the consequence that the impugned decision of the Opposition Division would become final. In the present case, the Board's final decision would have to be restricted to the findings that Geske's third intervention is admissible, but its appeal in respect of the second intervention and the substantive opposition grounds is inadmissible.

2.6 For these reasons, the Board is of the opinion that the referral fulfils the conditions of an admissible referral within the meaning of Article 112(1) (a) EPC.

3. *On the question of referral*

The question to be addressed is thus how the withdrawal of the appeal by the appellant Beurer influences the course of appeal proceedings.

3.1 To illustrate the problem from a somewhat different angle, reference is made to decision **T 1026/98** of 13 June 2003, which first formulated the referral question that was later taken up again by decision **T 1007/01** (OJ 2005, 240), leading to **G 03/04** (the referral **G 04/03** initiated by **T 1026/98** terminated without a decision): "The question whether ... only the party who instituted appeal proceedings has the

authority to decide on their termination can be restated in terms of another question. Is the alleged infringer to be confined to intervening in proceedings concerning the patent's validity which are already pending, or should the fact that such proceedings have become pending be seen as sufficient to make them the alleged infringer's own proceedings in his own right?" (**T 1026/98**, Reasons 5.2.1)

3.2 The Enlarged Board of Appeal in case **G 03/04** has answered this question as follows:

" 9. The decision in G 9/92 (OJ EPO 1994, 875, Reasons 6) refers to G 8/91. It explains that the appeal proceedings are terminated when the sole, or each, appeal has been withdrawn, and adds that, in this case, "there is no power to continue the proceedings" to decision. This ruling goes further than the decisions in G 2/91 and G 8/91. It neither refers expressly to Article 107 EPC, nor does it say anything about a termination of proceedings with regard only to the substantive issues involved in the contested decision. It can be applied to all parties who are not appellants, ie also to interveners under Article 105 EPC where the proceedings have already reached the appeal stage.

10. The Enlarged Board of Appeal therefore concludes that the valid intervener only acquires the status of an opponent, irrespective of whether the intervention occurs during the proceedings before the Opposition Division or at the appeal stage. In either case his rights and obligations are the same as those of other opponents.

This means that an intervener in proceedings before the Opposition Division, where all the opponents have

withdrawn their oppositions, can continue the proceedings alone and, if need be, file an appeal, since he has the same status as an opponent under Article 99 EPC. For the same reason, if an appeal is filed by someone other than him, he is a party as of right according to Article 107, second sentence, EPC. If the intervention is filed during the appeal proceedings, the intervener, again because he can only acquire the status of an opponent, has the same rights and obligations - apart from the right to raise new grounds of opposition - as any opponent who has not filed an appeal. If in this case the sole, or each, appeal has been withdrawn, the appeal proceedings are terminated in respect of all the substantive issues, including the new grounds for opposition raised by the intervener, for all the parties.

11. The assumed infringer giving notice of intervention under Article 105 EPC will be treated as an opponent and therefore as a party to the proceedings (see point 5 above). An intervener in proceedings before the Opposition Division has a right of appeal under Article 107 EPC. For the appeal to be validly filed, he must pay the appeal fee under Article 108, second sentence, EPC.

However, neither in these Articles nor in any other provision of the EPC and its Implementing Regulations can a basis be found for demanding the payment of this fee by a party to the appeal proceedings who is not an appellant. Thus there is no legal basis for the payment of the appeal fee by an intervener in appeal proceedings. Fees paid by way of precaution but without a legal basis are reimbursed (see T 590/94 dated 3 May 1996, not published in OJ EPO, Reasons 2)."

- 3.3 The position as advanced by the above decision can be summarised as follows: Article 105 EPC allows an intervener to join as an opponent and as an opponent only (cf. points 3.4.5 and 3.7.1 below). Neither Article 105 EPC nor Article 107 EPC mention any position, and thus also of any possibly different position, of interveners joining at the appeal stage only (cf. point 3.5 below with sub-points). An intervener intervening at the appeal stage cannot be treated as an appellant because it does not fulfil the requirements of Article 107, first sentence, EPC, in particular it has not been party to the earlier proceedings (cf. points 3.6 to 3.8 below with sub-points). The provisions governing the payment of the appeal fee are also silent about the possibility of payment of an appeal fee by a person who is not an appellant (cf. point 3.8.2 below). Given that it is settled case law of the Enlarged Board that appeal proceedings cannot be continued where the (only) appellant has withdrawn the appeal, the intervener as opponent thus cannot by their own motion continue the appeal proceedings.
- 3.4 Before looking in detail at the above elements of the reasoning perceived to underlie **G 03/04** and the details of the relevant legal provisions of the EPC, the Board finds it useful to first look at the concept of the intervention under the EPC from a general perspective.
- 3.4.1 Intervention is an extraordinary procedural act that replaces the 9 months opposition period with a specific interest of the intervener: Raising an opposition does not require any specific, let alone legitimate interest. Opposition is primarily an instrument of public interest in enhancing legal certainty (**T 1839/18** of 15 March 2021, point 2.11 of the reasons). Any

limitation of the right to file an opposition is thus uncalled for. Yet legal certainty is also provided in that after the expiry of the opposition period, the patentee knows whether and by whom an opposition was raised. A subsequent transfer of the position of an opponent is possible only under very limited circumstances (**G 02/04** of 25 May 2005).

- 3.4.2 An opposition by its very nature does not require an actual or potential conflict between opponent and patentee. Oppositions can be raised "just in case". This is different for an intervention: The reason for an intervention is the real and manifest threat to the business interests of the intervener by the patentee exercising the patent right against an alleged infringer. This is no longer a "just in case" scenario, but the actual exercise of the patent by alleging infringement. It is here where it comes to the crunch: An alleged infringer facing injunctive relief fights with their back to wall; the whole business may be at stake. It is this private interest of the alleged infringer that the drafters of the EPC found sufficient to merit an out of time intervention in ongoing opposition (and for that matter, appeal) proceedings, see *travaux préparatoires*, BR/144e/71, paragraphs 75 - 83).
- 3.4.3 In other words, the legislator recognises the legitimate interest in intervening in opposition proceedings arising from the parties' conflict, which is now real rather than potential. Thus, the justification for an intervention is extraneous to the primary field of application of the EPC, i.e. the usual grant and opposition proceedings before the EPO. Rather, it resides in the patentee's exercise of their patent right against a third party. The right of the

third party, the potential intervener, to have the validity of the patent examined and possibly revoked while still in centralized proceedings coincides with the public interest that patents which are actually enforced should be thoroughly examined by the authority presumed to be most competent and best equipped for the purpose, at the same time preventing unnecessary parallel work of authorities and also ensuring uniform decision concerning the validity of the patent (cf. **T 1026/98**, Reasons 5.1).

- 3.4.4 The respondent in the case at issue has argued that as an extraordinary procedural act and in order to account for the legitimate interests of the patentee, the right to intervene should be interpreted narrowly. The Board is not convinced that this is the correct approach for interpreting the scope of Article 105 EPC in relation to the position of the patent proprietor. An intervention, be it due to an action for infringement or for a declaration of non-infringement after a warning letter (threat), finds its justification exclusively in acts by the patentee. It is the patentee's and only the patentee's decision whether and when to assert their patent right against third parties, and a pending opposition or appeal against the patent at issue is certainly part of this decision. According to case law by the Boards of Appeal (e.g. decision **T 439/17**), acts of the patentee that fall short of alleging infringement, namely acts of an informative nature (e.g. a saisie contrefaçon) cannot form the basis of an intervention. The patentee is thereby entitled to make an informed choice. But once they have made this choice and alleged infringement, the patentee has to be prepared to face the consequences, including an intervention, where

available. Here, just as elsewhere in life, one has to face the music one has orchestrated.

- 3.4.5 Article 105 EPC by its wording only mentions an intervention during opposition ("intervene in opposition proceedings after the opposition period had expired"). This first and foremost establishes a minimum requirement for an intervention: The latter can only be declared as long as the EPO has jurisdiction over a patent. If no opposition has been filed, or once opposition proceedings have been terminated, no intervention is possible any more (cf. **G 4/91** (OJ 1993, 707), Headnotes I to IV). To the extent that an intervention requires pending proceedings before the EPO and thus the EPO's jurisdiction, the phase of opposition proceedings is immaterial: There is jurisdiction both for opposition and appeal proceedings, and in this regard, no specific mention of appeal proceedings is required. It is thus unsurprising that the *travaux préparatoires* (BR 144e/71, points 78 et seq.), just as consistent jurisprudence of the Boards of Appeal (namely decision **G 1/94**, OJ 1994, 787), also envisage the possibility of an intervention during appeal. The question thus is not whether a third party can intervene at the appeal stage, but rather in which position and with which procedural options.

- 3.5 The applicability of Article 107 EPC for the party status of an intervener

- 3.5.1 The Enlarged Board in **G 03/04** derived its conclusion on party status of the intervener partly from the provisions of Article 107 EPC. Its current wording is the following:

Article 107 EPC: **Persons entitled to appeal and to be parties to appeal proceedings**

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.

This wording has remained unchanged with respect to the EPC 1973. On the face of it, Article 107 EPC determines the circle and the roles of those actors that can be potential parties in appeal proceedings. As such, prima facie it appears justified to rely on this provision for determining the party status of an intervener. On the other hand, the reference in the article to "party to the proceedings" appears to be directed at those parties that were parties to the proceeding leading to the decision subject to appeal, in other words opposition proceedings.

- 3.5.2 This is also how decision **G 03/04** interpreted Article 107 EPC: "Article 107, first sentence, EPC limits the right of appeal to **parties to the proceedings leading to the contested decision**. This is not the case with an assumed infringer filing notice of intervention during appeal proceedings, as the Enlarged Board confirmed in G 4/91... "(Reasons 6, first and second sentence, Board's emphasis). However, it is to be noted that nowhere did decision **G 4/91** analyse the scope and applicability of Article 107 EPC, even though the article was actually part of the referred question. It merely cited the referring decision **T 0202/89** (OJ 1992, 223) according to which Article 107 EPC limits the right to appeal to those parties which were also parties to the earlier proceedings leading to the appealed decision (and were also adversely affected), see **G 4/91**, Reasons 5, 2nd paragraph.

3.5.3 Accordingly, decision **G 03/04** seems to interpret the term "party to the proceedings" in Article 107, first sentence, EPC, as meaning "party to the proceedings leading to the appealable decision". The present Board sees no reason to disagree with this interpretation. On a consistent interpretation of Article 107 EPC, the same term (though in plural) "other parties to the proceedings" must be read in the same way throughout the article, i.e. meaning "other parties to the proceedings leading to the appealable decision". It thereby becomes clear that an intervener at the appeal stage cannot fulfil the conditions of Article 107, second sentence, EPC. From this it follows that on a purely literal and systematic interpretation, i.e. without taking into account the legislative intent as derivable from the *travaux*, Article 107 EPC simply does not leave any room for interveners to be parties to appeal proceedings at all, be it as appellants, respondents or just other parties. This conclusion however directly contradicts settled case law of the Enlarged Board and the undisputed legislative intent behind Article 105 EPC, as clearly set out in **G 1/94**, Reasons 8. Also the conclusion of the Enlarged Board that "the valid intervener only acquires the status of an opponent" (**G 03/04**, Reasons 10) plainly contradicts the provisions of Article 107, second sentence, EPC, at least as long as "status of an opponent" is read as "status of an opponent who had been party to the proceedings leading to the appealed decision (but is not itself an appellant within the meaning of Article 107, first sentence, EPC)". Still, it seems clear that the Enlarged Board in **G 03/04** understood an "opponent" in this sense.

- 3.5.4 It is observed that this obvious contradiction between the provisions of Article 105 and 107 EPC does not seem to have been elaborated in any detail in any of the two original referring decisions **T 1026/98** or **T 1007/01**.
- 3.5.5 From this, it follows directly that procedural conditions that intend to put limitations on the party status in Article 107 EPC cannot apply to interveners, at least as long as the so far undisputed legislative intent is respected. At the very least, the requirement of a party status in the earlier proceedings cannot hold for an intervener. This then begs the question why the other requirement for acquiring the party status of an appellant, namely the adverse effect, should apply to an intervener, or at the very least why it should be applied in strict combination with the party status in the earlier proceedings.
- 3.5.6 The above makes clear that the provisions of Article 107 EPC are not applicable one-to-one in case of an intervention, i.e. when the intervener under Article 105 EPC enters the opposition proceedings at the appeal stage. As a consequence, either the article is not applicable at all, or at the very least, those conditions of Article 107 EPC that evidently cannot be fulfilled by the intervener must be disregarded.
- 3.6 Requiring adverse effect (only) is no bar to the appellant status of the intervener.
- 3.6.1 Even if Article 107 EPC is disregarded in its entirety, the requirement of an adverse effect as a precondition for the continuation of appeal proceedings can be derived from general principles of law. If the intervener is not adversely affected by the appealed decision, it has no longer any legal interest in

continuing the appeal proceedings, since it also has no legal interest in preventing the appealed decision from becoming final, at least on the substantive issues.

3.6.2 Thus, the question is to be answered whether an intervener can be considered adversely affected by the appealed decision, depending on its outcome, and whether it is additionally required for the adverse effect that the party in question, here the intervener, had or had not been party to the proceedings leading to the appealed decision.

3.6.3 Even if deriving the adverse effect requirement from the letter of the law as set out in Article 107, first sentence, EPC, this does not seem to be inseparably linked to the effective party position in the earlier proceedings. The first sentence simply says that *any party to proceedings adversely affected by a decision may appeal*. On the face of it, this dictates that among those parties who have been parties to the earlier proceedings only those parties may appeal by virtue of Article 107, first sentence, EPC, who are also adversely affected. Otherwise the wording of the article does not suggest in any way that an adverse effect of the appealed decision can only arise for a party that was also party to the earlier proceedings. It is not the potential appellant position established by Article 107 EPC that defines the adverse effect of the appellant, but Article 107 EPC requires a (pre-existing) adverse effect of the appealable decision.

3.6.4 Thus, denying the adverse effect of an appealed decision for an intervener through the application of Article 107 EPC alone is in fact a circular reasoning. Reference is made to the argument of the respondent in **G 03/04**, point XIII of the Summary of facts and

submissions: an intervener intervening only at the appeal stage has not been party to the proceedings leading to the appealed decision and **therefore** cannot be adversely affected by such decision (Board's emphasis). The argument seems to be that irrespective of the wording of Article 107, first sentence, EPC, the concept of the adverse effect (by a potentially appealable decision) itself inherently contains the limitation that the adverse effect can only affect a party which have also been party to the proceedings leading to the decision.

- 3.6.5 While **G 03/04** does not appear to explicitly approve this latter argument - namely that adverse effect is inseparably linked to the earlier party position - mentioning it in the Facts and Submissions may well indicate that the Enlarged Board found it convincing. So the question arises whether this principle may be derivable from somewhere else, e.g. from general principles of law and/or legal procedure.
- 3.6.6 The Board recognises that it may seem counterintuitive to accept that a party which was not formally a party to the proceedings leading to a decision may be adversely affected by that decision. However, the adverse effect that a party may suffer depends primarily on the legal effect of the decision. Typically, in civil law, a decision will affect rights between individual parties, and the legal effect of a decision will create, modify or extinguish rights and obligations only of those parties who were parties to the proceedings. The legal effect of the decision is, so to speak, personalised.
- 3.6.7 This is not so in opposition proceedings. The subject of the proceedings is the patent, and for the opponents

there are no personal or individual rights that are at stake - whatever they achieve with the opposition, a limitation or a revocation of the patent affects not only the opponents, but the public at large. The same holds true when nothing is achieved because the opposition(s) is(are) rejected and the patent survives as granted, even if the typical order of such a decision would appear to be directed only at the opponents and not at the patent. Either way, the legal effect of the decision manifests itself in the rights derivable from the patent. These rights are property rights, absolute rights which can be enforced against everybody (*erga omnes*). Not only the opponent, but every member of the public - including the intervener - will be affected by the decision in exactly the same way, in that the rights derivable from the patent will limit their freedom to operate in a given field.

- 3.6.8 This can be further illustrated by contrasting the decision on the substance of the patent with other legal effects which may also be decided by the Opposition Division or a Board in opposition proceedings, but are personalised, in the sense that they indeed only affect the parties to the proceedings. A decision on apportionment of costs under Article 104(1) EPC can only bind the parties to the proceedings. It is noted that such legal effects are just as enforceable as patent rights, cf. Article 104(3) EPC. An appeal against such a cost apportionment decision by a party which itself had not been party - and therefore cannot be the subject of Article 104(1) EPC for this reason alone - would indeed appear as manifestly inadmissible for lack of adverse effect and therefore for lack of legitimate interest to overturn the decision.

- 3.6.9 Neither can the existence of the adverse effect be attached to the substantive matter treated in the appealed decision. The requirements of Rule 99(2) EPC that the appellant shall indicate the reasons for setting aside the impugned decision may appear to suggest that the adverse effect of the decision derives from the reasons of the decision, which need to be pinpointed by the appellant and corrected accordingly. However, the real problem of the opponent is not that the opposition division rejected their opposition, but that the patent is still there.
- 3.6.10 This is normally expressed in procedural terms, namely that the roles of those parties who can be parties to the appeal proceedings are determined in accordance with the outcome of opposition proceedings and the procedural acts undertaken in response to the Opposition Division's decision: Whose requests were fully allowed in opposition can but be a respondent; only such parties can be appellants who had refused (substantive) requests; partial allowance of an opposition allows a party to become either an appellant, or a respondent, or both, depending on the filing of an appeal by either party. The position of other parties (e.g. non-appealing opponents where other opponents have appealed) is such that they are parties as of right.
- 3.6.11 However, as explained above, interveners in appeal have not been party to the opposition proceedings, and consequently Article 107 EPC does not foresee any procedural role for them in the appeal proceedings. Worded differently, the procedural role of a third party only intervening at the stage of appeal is not and cannot be defined by Article 107 EPC alone, i.e. the usual guiding principles of appeal proceedings are

not necessarily applicable. Therefore, there is no apparent reason why certain procedural limitations of appeal proceedings, in particular the limitation of the subject matter (review of the first instance decision) should apply, given that the limitations of Article 107 EPC based on the party position in the previous proceedings obviously cannot apply, either.

3.6.12 This is consistent with decision **G 1/94** (Reasons 13.) taking the view that an intervener even at the appeal stage has unfettered rights to raise new grounds of opposition and to introduce new documents. The Enlarged Board in this decision even suggests that it would be appropriate to remit the case to the Opposition Division in such an event.

3.6.13 This seems to indicate that for an intervener during appeal, appeal proceedings are not limited to a review of first instance proceedings, and the substantive interests of an intervener thus find precedence over the usual procedural framework of an appeal, namely to give the losing party a possibility of challenging the decision of the Opposition division on its merits. But as held in **G 10/91**, new matter in appeal is possible even without intervention, even new grounds of opposition with the consent of the patentee. That new grounds of opposition could (or even should) be raised by an intervener, that the case could (or should) be remitted to the Opposition Division and that an intervention on appeal could cause delays was all taken into account by the legislator, as attested by the *travaux préparatoires* (BR 144e/71, points 78 and 81, BR 209e/72, point 58).

3.7 This far, the referring Board is at least not in disagreement with decision **G 03/04**. The referring Board

is however not in agreement that Article 105 EPC in combination with Article 107 EPC must be read in the sense that also a third party intervening only at the appeal stage can never become more than a non-appealing opponent.

- 3.7.1 According to Article 105(2) EPC, an admissible intervention shall be treated as an opposition. This is different from the statement that "an intervener shall be treated as an opponent that is already party to the proceedings but is not an appellant", as apparently understood by the Enlarged Board in **G 03/04**, cf. Reasons 5 and 6. In the opinion of the Board, there is nothing in Article 105 EPC itself or in its legislative history that would support any limitation of the intervener's opponent status. As set out above, Article 107 EPC alone also cannot be the basis of such a limitation of the intervener's party status in the appeal stage of the opposition proceedings, at least not without immediately contradicting either the wording of Article 107 EPC itself or - when respecting the wording of Article 107 EPC - without immediately contradicting the clear legislative intent.
- 3.7.2 The Board is aware that the legislator did foresee differences between normal opposition proceedings and an opposition arising out of an intervention. It is to be noted that Article 105(2) EPC 1973 indeed contained a reference to exceptions as set out in the Implementing Regulations. Under the EPC 1973 this exception manifested itself in Rule 57(4) EPC 1973, presently Rule 79(4) EPC. The parts referring to exceptions were deleted in the EPC 2000 revision, while some other provisions of Article 105(2) EPC 1973 were transferred to the Implementing Regulations. Otherwise, there is no indication that the legal framework around

Article 105 EPC required any substantive change, see the explanations to the new Article 105 EPC in the Basic Proposal. To that extent it may be argued that even if no longer contained in Article 105 EPC, the idea of the more restricted opposition proceedings in case of an intervention is also present in the EPC 2000. However, when the exception established by Rule 57(4) EPC 1973 (or the essentially equivalent Rule 79(4) EPC 2000) is scrutinized, it becomes clear that the foreseen exceptions may have been adopted with the intention of protecting the patent, patentee and the original opponent(s) from the protraction of the proceedings, yet it is not the rights of the intervener but rather the rights of the patentee and the other opponent(s) that are more restricted. The exception resulting from Rule 57(4) EPC 1973 and Rule 79(4) EPC is that the parties of the original opposition proceedings may not be given an (additional) opportunity to react specifically to the intervention analogously to the procedure foreseen in Rule 79(1) to (3) EPC.

3.7.3 No other provision in the EPC is known to the Board that would directly limit the procedural options of the intervener in a similar manner when it comes to the substantive examination of its opposition grounds. Even less is there any hint that procedural provisions could not only put procedural limitations on the intervener's case but could effectively prevent the substantive examination of the intervener's opposition grounds, in that its opposition will have to terminate without any decision on the merits, effectively resulting in the rejection of its opposition.

3.7.4 Put differently, the present Board has serious doubts that an intervener, regardless of the state of

proceedings would always have to be treated as no more than a non-appealing opponent. After all, given the procedural dynamics of opposition/appeal proceedings, it would seem inappropriate to "lock" an intervener into the position of a respondent or party-to-the proceedings opponent even where the opposition phase has passed to the stage of appeal.

- 3.7.5 From a procedural point of view, it would be more logical for a party intervening at the appeal stage to require that party to "catch up" with the other parties to the suit by payment of the opposition fee, and to subsequently determine the available procedural positions of the intervener in accordance with the outcome of opposition proceedings rather than irrespective thereof.
- 3.7.6 The reasoning of decision **G 03/04** in regard of the intervener's position seems to be based on the following logic: The intervener does not fulfil the requirements of Article 107, first sentence EPC (cf. **G 03/04**, Reasons 6), accordingly its right to appeal cannot be derived from this provision. Article 105 EPC however accords it the status of the opponent. On the other hand, decision **G 2/91** decided that other parties to the proceedings within the meaning of Article 107, second sentence, EPC cannot continue the proceedings (cf. **G 03/04**, Reasons 7). Decision **G 8/91** discusses how proceedings terminate when an appeal is withdrawn, but leaves open the fate of new opposition grounds that may have been put forward by an intervener in the appeal stage (cf. cf. **G 03/04**, Reasons 8). Similar considerations are derivable from decision **G 9/92**, apparently also applicable to all non-appellant parties, even when conceding that also this decision did not specifically look at an intervener (cf.

G 03/04, Reasons 9). From these considerations it follows that the intervener entering the opposition proceedings at the appeal stage can only acquire the status of a non-appealing opponent, i.e. a party to the proceedings within the meaning of Article 107, second sentence, EPC (cf. **G 03/04**, Reasons 10).

3.7.7 Furthermore, it appears that this party position is achieved in two stages. First, the intervener is permitted to enter the proceedings (because the appeal of an earlier party kept the substantive opposition proceedings pending) by virtue of Article 105 EPC. Here, the Enlarged Board appears to recognise without reservations that Article 105 EPC also extends to the appeal stage, cf. **G 03/04**, Reasons 5, also in Reasons 6: *"Wie oben in Punkt 5 dargelegt, erwirbt er **im Beschwerdeverfahren, das von Artikel 105 EPÜ mit umfasst wird**, aufgrund dieser Bestimmung nur die Stellung als Einsprechender."* (Board's emphasis). Thereafter, once the intervener has entered the proceedings, it inevitably will have to assume the party position of the non-appealing opponent, and apparently by virtue of the appeal of another party (cf. **G 03/04**, Reasons 10: *"Aus dem gleichen Grund ist er, **wenn eine Beschwerde durch jemand anderen als ihn eingelegt wird**, im Beschwerdeverfahren ein Beteiligter **kraft Gesetzes nach Artikel 107 Satz 2 EPÜ**",* Board's emphasis). It is not spelled out why it is no longer a problem that the intervener initially also did not fulfil the provisions of Article 107, second sentence, EPC. Though not stated explicitly, it appears that this hurdle has been passed through the application of Article 105 EPC, which afforded the intervener a party position in the appeal proceedings, substituting its lacking party position in the earlier proceedings with the entitlement derivable from Article 105 EPC.

3.8 This logic appears unconvincing, for various reasons:

3.8.1 Article 105 EPC does not mention party position or party status. It merely stipulates that the intervention shall be treated as an opposition. This means first and foremost that the intervener is entitled to attack the patent with the opposition grounds available to it under Article 100(a) to (c) EPC, because this is the very purpose of an opposition. From this it may of course follow that the intervener will enter the proceedings in the party status of an opponent, but there is nothing in Article 105 EPC that would seem to bar the intervener from acquiring any party status that would normally be available to any opponent that has been party to the proceedings from the outset. On the other hand, as set out above, Article 107 EPC in itself does not leave any room for a party status of the intervener in the appeal proceedings. So it is clear that Article 107 EPC is not immediately applicable.

3.8.2 It is also clear that the legislator has not provided any guidance as to how the apparent contradiction between Articles 105 and 107 EPC is to be resolved. It is thus apparent that the legislator, while deciding that intervention should be possible at the appeal stage, has left open a number of procedural issues, in particular those arising from the specific nature of the appeal procedure, as shown by the explained contradiction between Articles 105 and 107 EPC. Consequently, any reasoning which draws consequences from the absence of provisions governing the particular case of intervention at the appeal stage (such as the reasoning concerning the absence of provisions on the payment of the appeal fee by the non-appealing party,

cf. **G 03/04**, Reasons 11, or the exclusion of the intervener from becoming an appellant on the ground that the time limit for filing an appeal has expired) is not convincing. As regards the lacking legal basis for the payment of the appeal fee by a non-appealing party, this principle need not be invoked in any event if the intervener is given the possibility to join the proceedings as an appellant and will consequently have the possibility, indeed the obligation, to pay the appeal fee.

- 3.8.3 The reasoning behind **G 03/04** also appears to be that when the intervener enters the opposition proceedings which is already in the appeal stage by virtue of the appeal of the appellant, the party positions in the appeal proceedings are already pre-defined, so that only the party position of the non-appellant opponent is available to the intervener. The logic behind this reasoning is not spelt out very clearly in **G 03/04**, in particular why the appellant status should be denied to the intervener on that basis (for a possible explanation cf. also point 3.6.5 above).
- 3.8.4 The problem with this approach can best be illustrated with the quite normal case where several original opponents have the possibility of appealing, but only some choose to do so, while some others do not. It may also happen that there are several appellant opponents and several non-appellant opponents, which latter may be considered either as respondents or parties of right, depending on whether the patentee is also an (additional) appellant, and also depending on the extent to which their requests in opposition have been allowed by the impugned decision. E.g. some opponents may only have opposed a part of the patent, while others may have requested complete revocation. When the

intervener enters, there will be opponents in all different party positions, and none of the appellants, whether opponents or patentee, can claim that the intervener joined "their own" appeal proceedings. Also, none of the appellants has an exclusive control over the appeal proceedings, as set out in more detail below (see parts on the principle of party disposition). It is not apparent why the intervener should not be permitted to act also as an appellant in such a situation, and why they cannot acquire a status essentially equivalent to the status of another opponent that is already a party to the opposition and appeal proceedings. As set out in detail above, Article 107 EPC cannot serve as the basis for this exclusion. It would also appear arbitrary if the intervener's party status were to depend on the actual party status of other opponents already involved in the proceedings, i.e. an intervener could only become an appellant opponent if there was already another appellant opponent in the proceedings. This would mean that the status of the intervener as a potential appellant would depend not only on the relationship between its requests and the substantive outcome of the contested decision, but also on the procedural decisions of other opponents (assuming that not only the intervener but also other opponents are adversely affected by the decision and as such have a legal interest in an appeal).

- 3.8.5 In other words, it is not clear on what basis **G 03/04** accepts that Article 105 EPC is strong enough to override the provisions of Article 107, second sentence, EPC, but is not strong enough to override the provisions of Article 107, first sentence, EPC, when it comes to fulfilling the condition that parties in

appeal proceedings must also have been parties to the proceedings leading to the appealed decision.

3.8.6 **G 03/04** also referred to the findings of **G 4/91** (cf. **G 03/04**, Reasons 3 and 6). The present Board observes only in passing that also the conclusion of **G 4/91**, namely that an intervention filed during the two-month appeal period provided for in Article 108 EPC has no legal effect, is questionable in the light of the more recent decision **G 1/09**. In this latter decision of the Enlarged Board, it was held that an application is still pending for the purpose of filing a divisional application and that a divisional application can be filed even if no appeal is subsequently filed within the appeal period. However, **G 1/09** derived the requirement of a "pending application" within the meaning of Rule 25 EPC 1973 from substantive rights still pending in the application, and did not draw any comparison between a pending application and pending opposition proceedings.

3.9 The result of **G 03/04** is also questionable in view of the overall legal framework and the general purpose of an intervention.

3.9.1 It is the very nature of intervention that its justification must be found in proceedings extraneous to those before the Office: In case of an intervention under Article 105 EPC, the entitlement to the intervention (and thus participation in opposition proceedings) is not based on the usual provisions of the EPC regulating grant and opposition proceedings (after all, Article 105 EPC is in Part V of the Convention: Opposition and Limitation procedure), such as Articles 97(3) and 99(1) EPC (that allow for the filing of an opposition only within nine months from

the mention of grant), but on proceedings extraneous to the EPC, namely national infringement proceedings or their equivalent. Being sued for infringement or only threatened therewith through the request to cease infringement creates a legal interest that replaces the nine-months opposition period stipulated by Article 99(1) EPC. Entitlement to intervene in opposition proceedings and thereby become an opponent is thus determined by a legal interest extraneous to the EPO proceedings rather than a period of opposition.

3.9.2 The Board finds it appropriate to apply this reasoning also to the appeal stage and allow a third party that only intervenes at the appeal stage to obtain, or to choose, a position that corresponds to the very legal interest that allowed them to intervene. The Board is thus of the opinion that Article 105 EPC should be interpreted in such a way that both the requirements of Article 99 EPC (period of nine months to file an opposition and become an opponent) and of Article 107 EPC (being adversely affected AND being a party to the earlier proceedings in order to file an appeal) are replaced by a legal interest extraneous to the proceedings conducted before the European Patent Office. In fact, of this latter double requirement, only the requirement of the earlier party status need be replaced.

3.9.3 It is of course implicit that the same should apply to the time limits of Article 108 EPC, i.e. the expiration of these time limits should also be no bar to the appellant status of the intervener. It would seem logical that both a notice of appeal and the statement of the grounds of appeal should be filed within the time limit of Rule 89(1) EPC.

3.9.4 This extraneous legal interest is defined by Article 105 EPC, namely being sued for or suing for a declaration of non-infringement in regard of the opposed patent. In appeal, the intervener is effectively relying on the fiction that it has been party to the proceedings from the very beginning. From this it should follow that the intervener's opposition request together with the result of the decision in opposition will determine in what position a third party can intervene in appeal:

a) As a respondent where the patent has been revoked in opposition (upon payment of the opposition fee): new grounds of opposition can be adduced by the intervener;

b) As an appellant in all cases where the patent has been fully or partially upheld in opposition (upon payment of both opposition and appeal fee); new grounds of opposition can be adduced by the intervener. As explained above (cf. point 3.6.7), the "adverse effect" in such case is not so much the decision of the Opposition Division, but rather the (continued) existence of a patent the intervener is alleged to have infringed;

c) As a party of right where the intervener so chooses (upon payment of the opposition fee): new grounds of opposition can be adduced.

3.9.5 Such kind of elective disposition of a third party joining proceedings before the EPO is not unknown, see e.g. the three options given to a true inventor under Article 61(1) EPC.

3.10 The above solution accounts for the consideration expressed in the *travaux préparatoires* (BR 144e/71,

point 80) that the intervener should not have a position dependent upon the other opponent(s), as also argued by the intervener in the oral proceedings before the Board. After all, such dependency existed if the only appealing opponent could unilaterally terminate appeal proceedings by withdrawing the appeal with the consequence that the party being most affected by the continuing existence of the patent in suit and thus having the most interest in a continuation, namely the intervener, would be denied continuation. The Board's solution further mitigates the otherwise unsatisfactory situation that the position of an intervener, if different in opposition and appeal, would be dependent upon the aleatory vagaries of national laws and practice, as can be very well observed in the case at issue: Intervening during opposition was not possible because of first, German rules on when a lawsuit before a civil court should be considered pending, and, second, because it took the German court a full three months to send the claim to Sweden.

- 3.11 The conclusion of **G 03/04** also appears contradictory to the findings of **G 1/94**. This latter found that interveners in fact have more rights than appellants, in particular more substantive rights: they can put forward new opposition grounds not treated in the appealed decision. If the findings of **G 1/94** are not disputed (and they are certainly not disputed by **G 03/04**, cf. Reasons 8), it then appears contradictory to take away these additional substantive rights by procedural considerations that obviously put the intervener in a substantially weaker procedural position, a position so weak that it may effectively lead to the rejection of its opposition case without any substantive decision, including the generously admitted new opposition grounds.

3.12 These considerations lead the Board to the following conclusion:

3.12.1 First, Article 105(2) EPC should be interpreted as follows:

An admissible intervention shall be treated as an opposition, and the intervener enters the proceedings with full rights as if it had been a party to the proceedings from the very beginning. This follows from the fiction established by Article 105(1) (a) or (b) EPC that the intervener is an opponent in spite of filing its opposition after the 9-months time limit stipulated by Article 99(1) EPC.

3.12.2 Second, if the intervener is permitted to enter at the appeal stage, and the intervener is to be considered an opponent with full rights (consistent with the above-mentioned case law), then it is inequitable to demand from the intervener the impossible, namely to retroactively establish themselves as parties who have also been parties to the earlier proceedings, in order to satisfy the requirements of Article 107 EPC, either first or second sentence.

3.12.3 Based on the above, the intervener should thus be regarded as satisfying the requirements of Article 107 EPC alone by way of the fiction derived from Article 105 EPC: the intervener becomes either one of the parties of the "any party to proceedings adversely affected by a decision" or simply an "other party to the proceedings".

3.12.4 The adverse effect requirement can be retained and the expected adverse effect can also be defined in a

straightforward manner. This can be done without requiring the intervener to have been a party to the proceedings, namely by defining the adverse effect in substantive terms as the continued existence of the very patent the intervener is alleged to have infringed.

- 3.12.5 Accordingly, depending on the outcome of the appealed decision, the intervener must be given the choice of entering the proceedings in any party position open to them, as above. In particular, they must be given the opportunity to file their own appeal in a given case, of course upon payment of the appeal fee.
- 3.12.6 This would seem to solve the perceived procedural problems of the appeal proceedings: the party positions of all parties would be clear, they would correspond to the usual party positions, withdrawal of appeals by other parties would not affect an intervener that had chosen to appeal, and the proceedings could continue as if nothing had happened (apart from a possible remittal if new grounds are raised, but this is again nothing extraordinary from a procedural point of view). Dealing with new grounds without remittal is not impossible, not even where the new submissions would formally fall under the provisions of Article 13(2) RPBA because of their timing, cf. Article 14 RPBA.
- 3.13 The principle of party disposition is not incompatible with the intervener's appellant status.
- 3.13.1 The referral decision leading to **G 03/04** formulated the referral question as follows: „After withdrawal of the **sole appeal**, may the proceedings be continued with a third party who intervened during the appeal proceedings?“ (Board's emphasis). Of course, this „sole

appeal" can also be understood to mean „the only remaining appeal" where in the original proceedings several appeals have been filed, but subsequently withdrawn, so that only one appeal is still pending when the critical procedural question, namely the continuation of the appeal proceedings, arises.

- 3.13.2 The Enlarged Board considered that the principle of party disposition, as an important procedural principle also needs to be taken into account for the question of the procedural rights of the intervener. The Enlarged Board made reference to decision **G 2/91** (OJ 1992, 206), Reasons 6.1, which found - albeit without regard to a possible intervention under Article 105 EPC - that after the withdrawal of an appeal the other parties to the proceedings could not continue the proceedings and that the proceedings were thereby terminated (**G 03/04**, Reasons 7). The principle of party disposition was further elaborated with reference to other decisions of the Enlarged Board (**G 03/04**, Reasons 8 and 9).
- 3.13.3 The present Board does in no way call into doubt the validity of these decisions of the Enlarged Board of Appeal (**G 2/91**, and further **G 8/91** (OJ OJ 1993, 346), **G 9/92** (OJ 1994, 875)). However, the rights of the appellants as derivable from the principle of party disposition should be qualified.
- 3.13.4 Certainly, there may be procedural situations where a sole appellant can exert certain control over the continuation of the proceedings. But that does not mean that an appellant always has more control over the proceedings than other parties. In the general case in opposition proceedings where the patent is upheld in an amended form, typically both the patent proprietor and the opponent can appeal. Several opponents can appeal

separately against a decision to reject their oppositions. In all these situations it cannot be stated that this or that appellant „started“ the appeal proceedings and the later appellants „joined“ the already pending appeal proceedings of the first appellant. The rights of the different appellants are practically independent of the time of filing their appeal (presuming the observation of the applicable time limits, fees, etc.). Their appeals are consolidated in a common appeal (Article 10(1) RPBA). In this case, an appellant has no guarantee, and in particular no legitimate expectation, that by withdrawing their appeal the appeal (and consequently the opposition) proceedings will terminate. Other parties to the proceedings may have pending and independent legal requests that need to be decided.

- 3.13.5 On the other hand, the filing of an appeal in opposition proceedings will not only have the procedural legal effect of starting the appeal stage of the proceedings, but it will also have the legal effect of keeping the substantive opposition proceedings pending. It is this continued pendency of the substantive opposition proceedings that gives the intervener the entitlement to enter the proceedings as a party with their own and independent legal requests. So the situation after the intervention is in substance not very different from the situation of several appellants, and demonstrates that appellants regularly must accept that withdrawal of their own appeals is not going to terminate the proceedings. What is more, parties must regularly be prepared to file appeals without knowing in advance if they will be the only masters of the proceedings or the rights of other parties will prevent them from terminating the appeal proceedings unilaterally. Of course, original

appellants are always entitled to terminate their own appeal at any point in time.

- 3.13.6 Put differently, the principle of party disposition itself does not guarantee special rights to appellants and therefore should also be no bar to afford a stronger party status to an intervener than merely a respondent in appeal. Parties to the proceedings, i.e. the patent proprietor and opponents need to be aware that their appeal will keep the substantive opposition proceedings pending, and must be prepared to accept that an intervener may enter the proceedings, possibly affecting their procedural possibilities.

- 3.14 Additional considerations in view of recent developments of the European patent system
 - 3.14.1 Interventions, particularly at the appeal stage, may - from the point of view of procedural economy, very well put a spanner into the smooth-running course of proceedings, and it is legitimate to ask whether the advent of the Unified Patent Court may make the changes in the perception of interveners redundant. Not least based on the *travaux préparatoires*, the Board does not take this view.

 - 3.14.2 Proceedings before the EPO, even at the appeal stage, are essentially administrative proceedings and as such simpler and regularly less costly than court proceedings proper, including those before the UPC. It was apparently the legislative intent to permit a party threatened with an infringement action to conduct validity proceedings still before the EPO, even where a common or unitary patent court, comparable to the UPC, would also be available for such actions (BR 144e/71 point 76 mentions an EU patent court). It is to be

noted that when the EPC was adopted, the prospect of a unified patent court appeared much more realistic, and it was not expected that it would take such a long time to establish a centralised patent court. Thus, there is no reason to assume that the drafters of the EPC may have envisaged a fundamentally different common patent system than at present where the UPC is already operational. Rather, it is more probable that the right to intervene under Article 105 EPC was adopted already in view of a possibility that a party may have other options to contest the validity of the European patent, not only before the individual national courts, but also in a centralised court procedure, see point 76 in BR 144e/71. In addition, the drafters of the EPC were specifically concerned with non-EU members to the EPC that could not benefit from the scheme of a common court. This consideration appears even more pertinent now in that the United Kingdom has left the European Union and several other EU member states have chosen not to participate in the UPC.

3.15 In the Board's view, it follows from the above that the intervener Geske by advancing their grounds of opposition and by properly paying the opposition and appeal fee within the three-months time period of Article 105 EPC is entitled to continue appeal proceedings even upon a withdrawal of Beurer's appeal. This result is however at odds with decision **G 03/04**.

3.15.1 The respondent in this regard has advanced the argument that, bar special circumstances, a deviation from a decision of the Enlarged Board is not possible. This argument may have some force in a common law system, yet is not supported by the European Patent Convention: According to Article 112 (3) EPC, decisions of the

Enlarged Board are only binding on the Board of Appeal for the specific case referred to the Enlarged Board.

3.16 The necessity to pay the appeal fee

3.16.1 In case it is found that an intervener can be entitled to appellant status, it appears logical that the payment of an appeal fee is also necessary if the intervener also wants to make effective use of their entitlement. In order to avoid any misunderstanding, it is not the payment of the appeal fee which establishes the entitlement to the appellant status of the intervener, but a consequence of the intervener making use of such entitlement. The entitlement to appellant status must be derived from other provisions of the Convention, including other means of interpretation, in the present case the preparatory works as the explanation of the legislative intent. Accordingly, the present Board does not consider that both original questions of the referring decision **T 1007/01** leading to **G 03/04** need a referral to the Enlarged Board.

3.16.2 However, the Board does not exclude that the problem of the continuation of the proceedings for the purposes of examining the intervention can also be handled without the payment of an appeal fee. Instead of requiring from the intervener to have a formal appellant status, a pending intervention following the withdrawal of all appeals could, in theory, also result in an essentially automatic remittal of the case to the Opposition Division. It is noted that already the legislator considered an essentially automatic remittal where the intervention is filed at the appeal stage, see BR 144/71, point 81.

4. For all these reasons, the Board decides to refer a question to the Enlarged Board of Appeal for decision, as set out in the order. It is understood that the term "all appeals" is intended to cover all appeal situations, irrespective of the number of original appellants, whether only one or several, so that the question referred encompasses the situation of the "sole appeal" within the meaning of **G 03/04**.

Order

For these reasons it is decided that:

Under Article 112(1) (a) EPC and Article 21 RPBA the following points of law are referred to the Enlarged Board of Appeal for decision:

After withdrawal of all appeals, may the proceedings be continued with a third party who intervened during the appeal proceedings? In particular, may the third party acquire an appellant status corresponding to the status of a person entitled to appeal within the meaning of Article 107, first sentence, EPC?

The Registrar:

The Chairman:



G. Magouliotis

C. Heath

Decision electronically authenticated