

Decision of the Enlarged Board of Appeal dated 22 August 2005

G 3/04

(Translation)

Composition of the Board:

Chairman: P. Messerli
Members: J.-C. Saisset
J. C. Fasseur van Santen
U. Kinkeldey
A. Nuss
J.-P. Seitz
R. Teschemacher

Patent proprietor/respondent: EOS GmbH Electro Optical Systems

Intervener: Concept Laser GmbH

Appeal reference number: T 1007/01 - 3.2.5

Headword: Intervention/EOS

Article: 99, 100, 105, 105(2), 107, 108, 112, 112(1)(a), 125 EPC

Keyword: "Intervention in appeal proceedings" - "Continuation of proceedings after withdrawal of sole appeal" - "Payment of appeal fee"

Headnote

After withdrawal of the sole appeal, the proceedings may not be continued with a third party who intervened during the appeal proceedings.

Summary of facts and submissions

I. By interlocutory decision of Technical Board of Appeal 3.2.5 dated 27 October 2004 (OJ EPO 2005, 240), the following points of law in case T 1007/01 were referred under Article 112(1)(a) EPC to the Enlarged Board of Appeal for decision:

(1) After withdrawal of the sole appeal, may the proceedings be continued with a third party who intervened during the proceedings?

(2) If the answer to question 1 is yes:

Is entitlement to continue the proceedings conditional on the intervener's compliance with formal requirements extending beyond the criteria for an admissible intervention explicitly laid down in Article 105 EPC; in particular, does the appeal fee have to be paid?

II. In case T 1007/01 the appellant (opponent) filed an appeal on 21 August 2001 against the opposition division's decision of 22 June 2001, and paid the appeal fee at the same time.

III. On 30 January 2004, during the appeal proceedings, a notice of intervention was filed. The intervener paid the opposition fee and then the appeal fee. No objections were raised as to the admissibility of the intervention.

IV. On 6 February 2004 the appellant withdrew its appeal.

V. The oral proceedings scheduled for 20 April 2004 were cancelled, in view of the points of law referred to the Enlarged Board of Appeal by interlocutory decision T 1026/98 (OJ EPO 2003, 441).

VI. In a communication dated 23 July 2004, Board 3.2.5 informed the parties that the referral to the Enlarged Board of Appeal (case No. G 4/03) was no longer pending, following the withdrawal of the intervention in T 1026/98, and that the board intended to make a new referral to the Enlarged Board to clarify the legal position of an intervener in appeal proceedings where the appeal is withdrawn.

VII. In the proceedings before the referring board, the respondent (patent proprietor) did not comment on the points at issue. The intervener informed the board that it endorsed the intervener's submissions in case T 1026/98, to which it did not intend to add.

VIII. In its reasons for referral, the board explained that the circumstances of this case - intervention followed by withdrawal of the appeal - were the same as in T 1026/98 and thus raised the same issues as regards continuation of the proceedings after the appeal is withdrawn. Board 3.2.5 therefore considered it appropriate to refer anew to the Enlarged Board the points of law previously submitted in T 1026/98.

IX. As in T 1026/98, Board 3.2.5 submitted this point with reference to the Enlarged Board's ruling in G 1/94 (OJ EPO 1994, 787) that intervention of the assumed infringer under Article 105 EPC is admissible during pending appeal proceedings and may be based on any ground for opposition under Article 100 EPC.

X. In its referring decision, Board 3.2.5 explained:

(a) that, following the decision of the Enlarged Board in G 8/91 (OJ EPO 1993, 346), appeal proceedings are normally terminated when the sole appeal is withdrawn, and there is then no need to decide on the substantive issues. In the case giving rise to the referral, the question was whether the situation is different if there was a valid intervention during the appeal proceedings;

(b) that in G 4/91 (OJ EPO 1993, 707), regarded by the board as a landmark decision, the Enlarged Board had ruled that third parties were not entitled to intervene or to appeal against the opposition division's decision during the appeal period provided for in Article 108 EPC - even if the other conditions for intervention were satisfied;

(c) that the Enlarged Board in G 1/94 (*loc. cit.*) had remained silent about a number of other questions arising from the case at issue: in particular, the question as to whether the intervener must pay the appeal fee.

The relevant case law of the boards of appeal was not uniform (see Case Law of the Boards of Appeal of the European Patent Office, 4th ed., 2001, VII.D.5.4.2).

Most of the decisions concluded that the appeal fee does not have to be paid to make intervention during appeal proceedings admissible (see, for example, T 27/92, OJ EPO 1994, 853).

On the other hand, it had been decided that an intervener in appeal proceedings must pay both the opposition and the appeal fee if he is seeking appellant status in his own right, in the sense that he can continue the proceedings even if the sole appeal is withdrawn (T 1011/92 dated 16 September 1994, cit. in Case Law of the Boards of Appeal of the EPO, loc. cit.).

In some decisions, however (eg T 27/92), the question whether the intervener can acquire this status had been left open, and in others, the possibility had been rejected (eg T 144/95 dated 26 February 1999, cit. in Case Law of the Boards of Appeal of the EPO, loc. cit., Reasons 2.8).

XI. On 23 December 2004 the Enlarged Board of Appeal invited the respondent and the intervener to present their comments, and told them that the notification of the communication to the intervener did not imply a preliminary decision on the points of law to be decided by the Enlarged Board.

XII. In a letter of 31 March 2005, the respondent reiterated that it endorsed the patent proprietor's submissions in T 1026/98. In the latter case, and in G 4/03 during the proceedings before the Enlarged Board of Appeal, the patent proprietor had set out the following main arguments:

(a) that opposition appeal proceedings were judicial proceedings;

(b) that, according to general principles, these were instituted by the appellant, who could also terminate them by withdrawing his appeal;

(c) that the decision in G 1/94 made it clear that without the appellant's appeal there could be no intervention; nor was payment of the appeal fee sufficient to confer independent party status.

XIII. The respondent added that the intervener at the appeal stage was not adversely affected by the decision at first instance, since he had not been a party to the opposition proceedings. Article 107 EPC distinguished between persons entitled to appeal and other parties to the proceedings, which included the intervener in the present case. From the decision in G 4/91 it was already clear that third parties were not entitled to intervene or to appeal against the opposition division's decision during the appeal period if none of the parties to the opposition proceedings had challenged that decision. A third party was entitled to have its objections to a patent examined in proceedings which were still pending, but at the same time it did not dispose over the rights of an appellant. This followed from, inter alia, the principles of procedural law generally recognised in the contracting states, which were to be taken into account under Article 125 EPC. As an example, the respondent cited the role of the "intervening third party" under the German law of civil procedure and the "interested third party" according to Section 65 of the German Code of Administrative Court Procedure. In neither of these cases could the third party impose its will on the main parties to the proceedings or dispose over the matter at issue. This view was supported by the relevant literature on the rights of the intervener. Moreover, Article 105 EPC was a provision applying by way of exception and as such was to be narrowly interpreted.

XIV. Regarding the second referral question, the respondent maintained that it was immaterial whether or not the intervener had paid the appeal fee, as he was only "any other" party within the meaning of Article 107, second sentence, EPC. He could not acquire the status of an appellant via this route. The fee, as payment for a public service at the request of an individual was merely a formal requirement for the admissibility of an appeal; it could not establish a change in a party's substantive status.

XV. On 4 April 2005, without further comment, the intervener requested a decision on the basis of the file as it stood.

XVI. No observations by parties under Article 11a of the Rules of Procedure of the Enlarged Board of Appeal have been received.

Reasons for the decision

1. As noted in the referral decisions T 1007/01 and T 1026/98, the Enlarged Board of Appeal held in G 1/94 (*loc. cit.*) that intervention of the assumed infringer under Article 105 EPC is admissible during pending appeal proceedings and may be "based on any ground for opposition under Article 100 EPC". In this decision, however, the Enlarged Board refrained from addressing any further procedural issues relating to intervention and left it to the boards of appeal to deal with such cases as and when they arose.

As the analysis in the referral decision T 1007/01 shows, the decisions of the technical boards of appeal in the wake of the Enlarged Board's decision have differed, particularly with regard to the question whether the intervener must pay the appeal fee. 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 important questions of procedural principle, where uniform application of the law must be ensured. The referral therefore meets the requirements of Article 112 EPC and is admissible.

2. Article 105 EPC gives the assumed infringer the possibility of intervening in pending opposition proceedings, provided certain requirements are met. According to paragraph 2 of the provision, if the assumed infringer meets these requirements, in particular by paying the opposition fee, his intervention is treated thereafter as an opposition. He therefore acquires the status of an opponent.

The EPC contains no specific provision regarding intervention of the assumed infringer in opposition appeal proceedings.

3. In G 4/91 the Enlarged Board held that a notice of intervention filed during the two-month period for appeal provided by Article 108 EPC has no legal effect if no appeal is filed by a party to the opposition proceedings before the opposition division. It was subsequently decided in G 1/94 that "intervention of the assumed infringer under Article 105 EPC is admissible during pending appeal proceedings".

4. Article 105 EPC enables the assumed infringer to acquire the status of an opponent after the expiry of the nine-month period provided for under Article 99 EPC. His aim, like that of a person acting on the basis of Article 99 EPC, is to challenge a patent, although in this case the motivation comes from the attack by the patent proprietor. If the assumed infringer validly intervenes in the opposition proceedings, he acquires the status of an opponent, in accordance with Article 105(2) EPC, which states: "Thereafter, the intervention shall ... be treated as an opposition". This means that his status corresponds to that of an opponent under Article 99 EPC. In particular, he is entitled to appeal, if need be, under Article 107 EPC or to be a party to the appeal proceedings as of right under Article 107, second sentence, EPC.

5. In G 1/94 (see Order and Reasons 4 to 9), express reference is made to Article 105 EPC as a basis for ruling that intervention of the assumed infringer during appeal proceedings is admissible. Although the Enlarged Board refrained from commenting on further aspects of intervention during appeal proceedings, it explained in point 10 of the Reasons that the term "opposition proceedings" also comprises any subsequent pending appeal proceedings. Thus the requirement for a valid intervention during the appeal proceedings is that the assumed infringer has fulfilled all the conditions of Article 105 EPC, which includes paying the opposition fee. Under Article 105(2), third sentence, EPC, such intervention at the appeal stage of the proceedings confers, in these proceedings, opponent status on the intervener.

6. 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 (see point 3 above). Article 107, first sentence, EPC therefore does not confer a right of appeal on an intervener in appeal proceedings and thus does not grant him the status of an appellant. Nor, contrary to the view taken in some appeal decisions, can an assumed infringer acquire this status by intervening during appeal proceedings. As explained in point 5 above, in appeal proceedings, which are also covered by Article 105 EPC, the only status the intervener can acquire is that of an opponent. This leads to the question whether the assumed infringer who can acquire the status of an opponent in appeal proceedings by validly intervening in accordance with Article 105 EPC is also entitled, by virtue of this status, to continue the proceedings after the sole appellant has withdrawn his appeal.

7. Referring to the principle of party disposition, a generally recognised procedural principle with the effect, *inter alia*, that proceedings are terminated on retraction of the procedural step which gave rise to them, the Enlarged Board decided that, if the appellant withdraws his appeal, the proceedings cannot be continued by the other parties to the proceedings under Article 107, second sentence, EPC who have not themselves filed an appeal (G 2/91, OJ EPO 1992, 206, Reasons 6.1). The decision in G 2/91 does not mention the issue of intervention during appeal proceedings, as it did not arise in the case concerned.

8. Subsequently, the Enlarged Board decided on the same basis, but without expressly referring to Article 107 EPC, that, in so far as the substantive issues settled by the contested decision at first instance are concerned, appeal proceedings are terminated, in *ex parte* and *inter partes* proceedings alike, when the sole appellant withdraws the appeal (G 8/91, *loc. cit.*). The decision in G 8/91, where the question of intervention also did not arise, refers only to the termination of proceedings concerning the substantive issues involved in the contested decision. However, an intervener in appeal proceedings has the possibility of raising new grounds for opposition which were not relied upon during the proceedings before the opposition division (G 1/94, *loc. cit.*). Obviously, such grounds cannot be a subject of the contested decision. The decision in G 8/91 therefore does not answer the question whether an intervener having validly filed notice of intervention during appeal proceedings before the withdrawal of the sole appeal can continue the proceedings at least with regard to the new grounds for opposition which were not raised at first instance.

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).

Order

For these reasons it is decided that:

After withdrawal of the sole appeal, the proceedings may not be continued with a third party who intervened during the appeal proceedings.