

CHARTERED INSTITUTE OF PATENT ATTORNEYS

Enlarged Board of Appeals Referral G 2/19

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1. The Chartered Institute of Patent Attorneys (CIPA) is the professional and examining body for patent attorneys in the UK. CIPA represents virtually all the 2,400 registered patent attorneys in the UK, most of whom are also European patent attorneys, whether in industry or in private practice. Total membership is over 4,000 and includes judges, barristers, trainee patent attorneys and other professionals with an interest in intellectual property. CIPA represents the views of the profession to policy makers at national, European and international level, with representatives sitting on a range of influential policy bodies and working groups in the UK and overseas.
2. The following questions were referred to the Enlarged Board of Appeal with Decision T 831/17 (EPO OJ 2019 A51):
 1. *In appeal proceedings, is the right to oral proceedings under Article 116 EPC limited if the appeal is manifestly inadmissible?*
 2. *If the answer to the first question is yes, is an appeal against the grant of a patent filed by a third party within the meaning of Article 115 EPC, relying on the argument that there is no alternative legal remedy under the EPC against the examining division's decision to disregard its observations concerning an alleged infringement of Article 84 EPC, such a case of an appeal which is manifestly inadmissible?*
 3. *If the answer to either of the first two questions is no, can a board hold oral proceedings in Haar without infringing Article 116 EPC if the appellant objects to this site as not being in conformity with the EPC and requests that the oral proceedings be held in Munich instead?*
3. CIPA wishes to address the first two questions of the referral together.

4. In the present case, the purported “appellant” is a third party who filed third party observations under Article 115 EPC, presenting clarity objections under Article 84 EPC. This third party purports to appeal against the grant of the patent, arguing that no other legal remedy is available since Article 84 EPC is not a ground of opposition.
5. Article 107 EPC reserves the right of appeal to “Any party to proceedings adversely affected by a decision”. However, Article 115 EPC, last sentence, is absolute: a third party who presents observations “shall not be a party to the proceedings.”

Therefore, in answer to question 2 of the referral: yes, any purported appeal against a decision to grant by a third party is manifestly inadmissible, whatever arguments it relies on. The only relevant parties to proceedings before the EPO who may appeal are the first and (where applicable) second parties, namely applicants/patentees and opponents.

6. Article 116(1) EPC likewise reserves the right to request oral proceedings to “any party to the proceedings”. Since third parties are not parties to the proceedings, neither do they have a right to request oral proceedings.¹

It is this which directly precludes the third party’s right to oral proceedings, not just because the appeal is manifestly inadmissible as suggested in question 1 of the referral.

Therefore, in answer to question 1 of the referral: yes, the right to oral proceedings under Article 116 EPC is limited to any party to the proceedings.

7. In the *travaux préparatoires* of the EPC, clarity under Article 84 EPC was deliberately omitted from Article 100 EPC as a ground of opposition. Decision G 3/14 of the Enlarged Board commented (at point 69 of the Reasons):

“It can therefore be concluded that a ground of opposition based on Article 84 EPC was not included in the EPC 1973 at least partly because other grounds for opposition (Article 100(b) EPC in particular) were considered largely adequate to deal with the problem. It seems likely that it was also thought unwise to enable an opponent to assert (perhaps numerous) clarity objections in opposition proceedings and thus delay them, although this cannot be said with quite the same degree of confidence. However, the President states in his comments that the reason for not introducing lack of clarity as a ground for opposition was ‘to streamline opposition proceedings’, and in this the Enlarged Board considers he is likely to be correct.”

¹ If third parties did have a right to oral proceedings, this could result in vexatious requests for them, and additional costs for applicants. That seems unfair given that no fee is charged for filing third party observations.

8. The present appeal attempts to circumvent that by providing an alternative to post-grant opposition. Whatever one's view about whether Article 84 EPC should have been included as a ground of opposition, allowing such circumvention would be highly likely to have unforeseen and undesirable consequential effects. These consequential effects would not necessarily be limited merely to clarity objections. Patents whose claims lack clarity can instead be addressed under Article 83 EPC, as G 3/14 suggested, or under Article 56 EPC if the lack of clarity suggests they might be too broad, or by arguing non-infringement in any infringement action.
9. As question 3 is dependent on a negative answer to at least one of the first two questions and we propose affirmative answers to both, we believe that the Enlarged Board should give no answer to the third question.

Tim Jackson

Chair, Patents Committee
Chartered Institute of Patent Attorneys