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The Enlarged Board of Appeal
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Attention: Mr. Nicolas Michaleczek

Via email: EBAamicuscuriae@epo.org

Re: Enlarged Board of Appeal Case G2/24

17 April 2025

epi Amicus Curiae Brief on G2/24

The present *amicus curiae* brief is submitted by the Institute of Professional Representatives before the European Patent Office (**epi**), which is the professional body of all European patent attorneys. Currently, **epi** has about 14,600 members from the 39 Contracting States to the European Patent Convention (EPC). European patent attorneys mainly work in private practice patent law firms or in industrial patent law departments. They represent a wide variety of users of the European patent system, from individual inventors to multinational corporations, from all parts of the world. European patent attorneys represent patent owners, opponents and interveners in opposition and opposition-appeal procedures.

The Referring Decision

The present referral to the Enlarged Board arose from interlocutory decision T 1286/23 of Technical Board of Appeal (TBA) 3.2.04 issued on 11th November, 2024. It is noted that the referring TBA had five members.

The circumstances which gave rise to the present referral were that a third party attempted three times to intervene in the opposition proceedings, twice before the opposition division and once just before the end of the period for filing an appeal statement. The third party paid both the opposition fee and the appeal fee, as well as filing a statement of grounds of appeal. The referring TBA summoned the parties to oral proceedings. After the issue of the summons, the opponent-appellant, which was originally the only appellant, withdrew its appeal. The referring TBA nonetheless proceeded with the oral proceedings to discuss whether the withdrawal of the appeal of the original opponent-appellant inevitably led to the closure of the proceedings. In this respect, the referring TBA was of the view that, if G 3/04¹ were correct, then the proceedings were inevitably terminated. However, the referring TBA was not convinced that G 3/04 is correct and therefore referred the matter to the Enlarged Board of Appeal.

epi notes that the situation in the referred case, with the three attempts at intervention made by the third party, is complicated. However, the referred question does not require consideration of the

¹ **Decision of the Enlarged Board of Appeal** of the European Patent Office, **G 3/04**, dated 22 August 2005.

complications of the situation of the case and so **epi** will not be commenting on that situation and agrees that the referred question is of much more general applicability.

The Referred Question

The referred question is:

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?

Admissibility of the Referral

The basis for the referral is essentially that the referring TBA considers that G 3/04 was incorrectly decided and intended to make a decision contrary to G 3/04. This would have led to a non-uniform application of the law and so the first requirement of Article 112(1) EPC is met. Moreover, for the reasons set forth below, **epi** considers that this is an important point of law and so the second requirement of Article 112(1) EPC is also met. An answer to the question is also necessary for the referring TBA to be able to deal with the appeal. **epi** is therefore of the opinion that the referral is admissible.

An Important Point of Law

epi agrees with the position set out in Section 2 of the referring decision that this is an important point of law.

epi would additionally point out that the point of law relates not only to Article 107 EPC, as referred to in the question, but also to Article 105 EPC, which is the only part of the EPC which refers to interventions. Article 105 EPC sets out two special circumstances where the requirement to initiate opposition proceedings within the nine-month time limit of Article 99(1) EPC or, as explained below, the requirement to file a notice of appeal within the two-month time limit and a statement of appeal within the four-month time limit of Article 108 EPC is replaced by the three-month time limit of Rule 89 EPC. The special circumstances are that either infringement proceedings against a third party have been instituted or that a third party has instituted proceedings for a declaration of non-infringement (DNI). These are relatively rare events but are nonetheless very important. One particular feature to bear in mind is that, in an infringement proceedings, a request for an interim injunction may be made. If an interim injunction is granted or a finding of infringement is made, it will have serious consequences for the third party, which may have to go out of business.

In many of the EPC states, such adverse consequences can be avoided by showing that the patent is invalid. In many member states, it is possible to counterclaim for revocation of the patent. If the counterclaim raises serious issues with validity, then it is unlikely that an interim injunction will be granted.

However, in some EPC member states, it is not possible to institute revocation proceedings if an opposition to the patent is pending before the EPO. In those states, it is necessary to wait until the

opposition proceedings at the EPO, including any opposition-appeal proceedings, are completed before revocation proceedings can be instituted. Moreover, in some EPC member states, whether a patent is valid is not considered in proceedings regarding interim injunctions. It is therefore possible for an interim injunction to be granted for a patent which is not valid. If any proceedings for revocation are instituted, they may take a long time and so the third party may decide to abandon its plans or may go out of business because of an invalid patent.

If there are EPO opposition proceedings in train when infringement or DNI proceedings are instituted, allowing a third party involved in the infringement or DNI proceedings to enter the opposition proceedings after the end of the opposition period or the appeal periods is a safeguard against the national litigation systems which do not allow validity issues to be raised or where little notice of validity issues is given in interim injunction proceedings. Thus, it is an important feature of the EPC system and so the question does give rise to an important point of law.

The importance of this point of law is also growing. As is well known, previously, opposition proceedings before the EPO, including any opposition-appeal proceedings, could take many years. However, the aim within the EPO is to finish opposition proceedings within 15 months and the aim of the Appeal Boards is to complete opposition-appeal proceedings much more quickly. Thus, intervention becomes more attractive, as obtaining a decision on validity by the EPO will in many cases precede a decision on validity in national proceedings.

Moreover, the referral raises fundamental questions about legal certainty and procedural fairness. Interventions under Article 105 EPC are also to ensure that parties with a legitimate legal interest in the outcome of opposition proceedings, including opposition-appeal proceedings, can have their arguments heard. The ability of an intervener to continue opposition-appeal proceedings following withdrawal of all other appeals is therefore crucial to ensuring that the rights of third parties, particularly those directly affected by national litigation, are not unduly prejudiced.

Further, the issue also touches on the broader principles of procedural economy and the effective administration of justice, already acknowledged by the Boards of Appeal as well as the Enlarged Board². If an intervention during appeal proceedings is not permitted to continue beyond the withdrawal of all appeals, it may lead to a requirement to continue multiple national litigations and/or before the Unified Patent Court, which could otherwise have been avoided. This could result in increased costs and inefficiencies, as well as inconsistent decisions regarding the validity of the same patent across different jurisdictions.

epi therefore considers that, for all these reasons also, this is an important question of law.

² In Case T 338/89 (Decision of 16 July 1990), cited by the Enlarged Board of Appeal in case G 1/94 (Decision of 11 May 1994), the Board held that intervention under Article 105 EPC is admissible during opposition-appeal proceedings. The reasoning partly emphasized that this provision serves to avoid unnecessary duplication of proceedings and the risk of conflicting decisions.

The Basis for Interventions in Opposition Proceedings

As noted above, the legal basis for interventions in opposition proceedings is Article 105 EPC, which reads:

Article 105 EPC

Intervention of the assumed infringer

- (1) Any third party may, in accordance with the Implementing Regulations, intervene in opposition proceedings after the opposition period has expired, if the third party proves that
 - (a) proceedings for infringement of the same patent have been instituted against him, or
 - (b) following a request of the proprietor of the patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent.
- (2) An admissible intervention shall be treated as an opposition.

This is the present version of this Article. In EPC 1973, it was somewhat longer but the basic idea has not changed. All that happened with EPC 2000 is that the formalities within the 1973 version were moved to the Implementing Regulations. However, it is still necessary to pay the opposition fee when filing an intervention.

In **epi's** view, the important point to note here is that Article 105(2) EPC indicates that, assuming that the intervention is admissible, it "... shall be treated as an opposition". Thus, once the intervention has been checked for admissibility, it becomes an opposition. It follows from this that the third party which filed the intervention becomes an opponent.

It is to be noted that the EPC does not introduce any new type of entity, such as an "intervener". This is a nomenclature which has been used over the years but does not take account of Article 105(2) EPC. The only mention of a legal entity is the "third party" but the third party which files an allowable intervention, which must be treated as an opposition, becomes an opponent.

It is therefore **epi's** view that, once an admissible intervention has been filed, the third party should be treated in exactly the same way as an opponent is treated and so should have the right to appeal (providing that the third party pays the appeal fee) as well as having the right to be a party as of right to another party's appeal. This is also the view of the Enlarged Board in G 3/04 where, in Reasons 10, the Enlarged Board held that:

The Enlarged Board of Appeal therefore concludes that the valid intervener only acquires the status of an opponent ... his rights and obligations are the same as those of other opponents ... 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 ... (parts relating to appeal proceedings omitted)

The Basis for Interventions in Appeal Proceedings

The part of the EPC relating to appeals is Part VI of the EPC, which consists of Articles 106 to 112a EPC. However, there is no provision in this Part of the EPC regarding intervention in appeal proceedings. Thus, it could be said, but **epi** does not agree, that any intervention after the issue of a decision by an opposition division is inadmissible. **epi**'s view is that the appeal proceedings arising from a decision of an opposition division are still part of the opposition proceedings and so Article 105 EPC must apply in opposition-appeal proceedings.

It is well established that interventions **are** admitted during opposition-appeal proceedings, following the principles set out in G1/94³. The referred question in that case was:

Is an intervention, which otherwise complies with the conditions laid down in Article 105 EPC, admissible when filed during pending appeal proceedings?

This was answered as follows:

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 the reasoning in G1/94, it was decided that Article 105 EPC was not clear as written and so the Enlarged Board in that referral, as is proper, consulted the travaux préparatoires to the EPC, in particular BR 144d/71⁴, BR 177d/2⁵ and BR 209d/72⁶ and M/PR/I⁷, p. 49-50 and concluded that:

... as submitted by the intending interveners, Article 105 EPC must be interpreted in the sense, that the term opposition proceedings as used in that provision is not restricted to such proceedings before an Opposition Division but comprises also any subsequent pending appeal proceedings before a Board of Appeal. It follows that the answer to the question put to the Enlarged Board of Appeal in the present case must be in the affirmative. (Section 10 of the Reasons)

G 1/94 therefore established that Article 105 EPC applies in opposition-appeal proceedings. It follows that a third party filing an admissible intervention, including paying the opposition fee, in opposition-appeal proceedings must be treated at least as a party as of right (Article 107 EPC).

However, in **epi**'s view, this finding in G 1/94 has not been followed through rigorously. In **epi**'s view, because Article 105 EPC applies in opposition-appeal proceedings, if the third party filing the intervention **also** pays the appeal fee and files a notice and a statement of appeal, then the third

³ **Decision of the Enlarged Board of Appeal, G 1/94**, dated 11 May 1994.

⁴ **BR 144d/71** – Minutes of the 10th meeting of Working Party I of the Inter-Governmental Conference, Luxembourg, November 22–26, 1971.

⁵ **BR 177d/72** – Report on the 11th meeting of Working Party I of the Inter-Governmental Conference, Luxembourg, February 28–March 3, 1972.

⁶ **BR 209d/72** – Minutes of the second meeting of the Coordinating Committee, Brussels, May 15–19, 1972.

⁷ **M/PR/I, p. 49–50** – Minutes of the Diplomatic Conference, Munich, 1973.

party must be treated as an independent opponent-appellant with full rights to continue the appeal proceedings, even if any other appeals by any other opponents are withdrawn.

This view is not in agreement with the view of the Enlarged Board in G 3/04 where, in Reasons 10, when relating only to opposition-appeal proceedings, the Enlarged Board said:

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.

However, in **epi's** view, this statement is not consistent with what the Enlarged Board in that case said about interventions during the opposition stage. The Enlarged Board said that, at the opposition stage, the third party becomes an opponent with no restriction. However, the Enlarged Board added a restriction if the intervention is filed at the opposition-appeal stage. The view in G 3/04 seems to go against the clear meaning of Article 105 EPC, as set out in G 1/94, that the third party becomes an opponent without restriction.

Becoming an Opponent-Appellant by Intervention in Opposition-Appeal Proceedings

If a third party is to have the same rights as an opponent-appellant, as intended by Article 105 EPC, that third party must do all the things that an opponent-appellant must do to file a valid appeal. (The third party must also show that the conditions of Article 105(1)(a) or (b) EPC are met but does not have to meet the appeal deadlines.)

Article 105 EPC allows the third party to replace the time limits imposed by Article 99 EPC with the time limit provided by Rule 89 EPC as long as the proceedings are still with the opposition division. As the same rationale should be applied to interventions filed in opposition-appeal proceedings, the third party must also be able to replace the deadlines set by Article 108 EPC with the deadline set by Rule 89 EPC.

Thus, it is **epi's** view that an intervention filed during opposition-appeal proceedings can only endow the third party with independent opponent-appellant status if both the opposition fee and the appeal fee are paid (and all the other requirements are met).

Otherwise, the third party can only be on the same footing as any opponent who did not file an appeal.

G 3/04

The Enlarged Board decision with which the referring TBA disagrees is G 3/04. As noted above, in G 3/04, the Enlarged Board made a distinction between a third party at the opposition stage and a third party at the opposition-appeal stage. In the view of **epi**, this is in contradiction with the legislative intention of Article 105 EPC as set out in G 1/94.

If there were any basis for the opinion expressed in G 3/04, it was based on the then Enlarged Board's view of Articles 107 and 108 EPC. It is the view of **epi** that the G 3/04 Enlarged Board in that case took too restrictive a view of these Articles and did not look at them in the context of the legislative intention of Article 105 EPC.

Article 107 EPC reads:

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.

The view taken by the G 3/04 Enlarged Board was that the “party” to proceedings can only be a party to the proceedings from which the appeal arose. **epi** agrees that, in general, this should be the case, otherwise any third party could file an appeal against any decision of the lower instances of the EPO as long as they could show that they were adversely affected.

However, the G 3/04 Enlarged Board did not take into account the special circumstances set out in Article 105 EPC. Article 105 EPC in particular sets out that, provided that certain conditions are met, a third party should be allowed to intervene in opposition proceedings, even if the opposition proceedings are at the appeal stage. As noted in G 3/04, a third party making an admissible intervention acquires the same rights and obligations as an opponent. One of the obligations of an opponent is to pay the appeal fee if that opponent wants to be able to continue the opposition proceedings through the appeal stage.

Article 105 EPC sets a new time limit (3 months after the date of initiation of the infringement or DNI proceedings (Rule 89 EPC)) for acquiring the rights and obligations of an opponent. One of these rights is to be a party without restriction to the opposition proceedings, which includes the right to file an appeal. Thus, on making an admissible intervention, even during the appeal stage, the third party becomes a party to the proceedings which gave rise to the decision under appeal, in the same way that the third party becomes an opponent.

The fact that the intervention is admissible, which requires that the requirements of Article 105 EPC are met, shows that the third party is adversely affected by the decision.

Thus, the fact that the third party did not file an opposition in the nine-month time limit set in Article 99 EPC and/or did not file an appeal within the time limits set in Article 108 EPC **fails** to mean that the third party cannot satisfy the requirements of Article 107 EPC. When Article 107 EPC is read in the context of Article 105 EPC, it is clear that a third party filing an admissible intervention during opposition-appeal proceedings becomes, by virtue of the admissible intervention, as of the date of the intervention, a “party to proceedings adversely affected by a decision” as the third party has acquired the status of an opponent. As such, the third party has also acquired the right to file an appeal.

G 3/04 also refers to Article 108 EPC. This sets the deadlines for filing an appeal, in particular the deadline for paying the appeal fee. However, this reference also has been interpreted too strictly by the G3/04 Enlarged Board. It takes no account of Article 105 EPC. One of the main effects of Article 105 EPC is to allow a third party to replace the time limits for opposition proceedings with the three-month time limit set by Rule 89 EPC. Thus, in the case of a third party intervening under Article 105 EPC, the time limits in Article 108 EPC are overruled by the time limit in Article 105 EPC as specified in Rule 89 EPC.

Thus, in **epi's** view, the reliance on Articles 107 and 108 EPC in G 3/04 is misplaced and does not mean that a third party making an admissible intervention during the opposition-appeal proceedings cannot acquire full rights as an opponent-appellant.

Under the EPC, a third party is granted the right to participate in opposition proceedings if they have a legitimate interest. A third party joins the proceedings to protect its own rights. The third party's rights to participate are not inherently tied to the actions of any other party to the proceedings.

In the case where, as **epi** considers is allowable, the third party files an appeal, whether the intervention was made before or after the date of the decision of the Opposition Division, withdrawal by all the other opposing parties should not extinguish the third party's rights.

The right to continue proceedings is a matter of procedural fairness. If a third party has a direct and legitimate interest in the outcome of the opposition proceedings and has filed an appeal, it should be allowed to pursue its interests even after all the other opposing parties withdraw. Denying a third party which has filed an appeal the right to continue would frustrate the principle of effective justice, as it would leave unresolved issues that affect the third party's legitimate rights and the third party might be unjustly harmed by the withdrawal of any other opposing appellant. This in turn might lead to a situation where the third party is forced to conduct national /UPC litigations when the issue could have been decided in a single EPO proceedings. This could result in increased costs and inefficiencies, as well as inconsistent decisions regarding the validity of the same patent across different jurisdictions.

It is also the case that legal clarity on patent validity can affect a large number of stakeholders, not just the parties involved in the dispute. By allowing the third party to continue its appeal, the Enlarged Board would ensure that relevant legal issues are fully addressed and clarified, thereby contributing in the public interest to the legal certainty of the patent system.

Consequences of **epi's** View

It follows from the above that, as with opponents, when it comes to the appeal stage, a third party filing an admissible intervention may become an opponent-appellant or merely an opponent party as of right, depending on whether the third party pays the appeal fee and files a notice and statement of appeal. This is the case whether the intervention was filed before or after the issuance of the decision of the opposition division. If the intervention is filed before, the third party can file its own appeal or can merely become a party of right if any other party files an appeal. If the intervention is filed after, the third party can merely become a party of right by not filing an appeal or can become an independent opponent-appellant by filing an appeal, including paying the appeal fee.

Answer to the Question

Thus, it is **epi**'s view that the question should be answered as follows:

After withdrawal of all appeals by other opposing parties, the proceedings may be continued by a third party who admissibly intervened during the appeal proceedings, provided that the third party paid the appeal fee and filed a notice and statement of appeal. If the third party did not pay the appeal fee, the third party cannot continue the appeal proceedings if all opposing appeals are withdrawn. In particular, if the third party files an admissible appeal and, in particular, pays the appeal fee, the third party shall acquire opponent-appellant status under Article 107, first sentence, EPC.

Alternative Approach

Were the Enlarged Board to consider that **epi**'s view is incorrect, it is suggested that this would have the adverse effects referred to above. However, such adverse effects should be avoided. A more complicated and more time-consuming, and therefore in our view less preferred, alternative is set out below. **epi** does not favour this procedural alternative because of the significant delay it would cause. In addition, this alternative would increase the risk of attempts, wherein the system could be misused by initiating an intervention only to trigger a mandatory remittal to the first instance to strategically delay the final resolution of the case.

epi's proposal is that, if the Enlarged Board should consider it impossible for an intervener in appeal proceedings to become an independent opponent-appellant, it should be an established rule that, if any admissible intervention is filed during the opposition-appeal proceedings, the case is automatically remitted to the first instance. This would allow the third party to participate fully in the opposition proceedings before the first instance, ensuring that their rights are properly considered and avoiding procedural complications that may arise from interventions during the appeal stage. Such a solution would not only safeguard the procedural fairness for the third party but also uphold the principle of legal certainty and procedural economy within the framework of the EPC.

Summary

epi is of the view that the referred question should be answered as set out above and that the alternative solution is not required.

If **epi** can further assist the Enlarged Board, please let us know.

Yours sincerely,



Peter R. Thomsen
President