



Abteilung V des Vorstands

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Referral to the Enlarged Board of Appeal - G 2/24

Amicus Curiae Brief by the Patentanwaltskammer according to Art. 10 (1) RPEBA

With its interlocutory decision T 1286/23 of November 11, 2024 (herein forth “referring decision”), the Technical Board of Appeal 3.2.04 has - in accordance with Art. 112 (1) (a) EPC - referred the following points of law 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?

I. Executive summary

It is the Patentanwaltskammer’s position that the appeal proceedings may be continued after withdrawal of all appeals with a third party who intervened during the appeal proceedings. The third party should - by virtue of the intervention at the appeal stage - be given appellant status.

This would not only be fair and equitable in view of the allegation of patent infringement made by the patent proprietor's side but also serve the public interest in legal certainty about the validity of the patent in suit as well as the continuation of the appeal proceedings. Furthermore, additional and possibly redundant validity proceedings before national courts or the Unified Patent Court could be avoided, thereby promoting efficiency. In order to further support this objective, the intervening third party should be allowed to make comprehensive submissions including new grounds of opposition. In case an appeal fee would have to be paid to allow the third party to acquire appellant status when intervening, payment of an appeal fee within the time limit mentioned in R. 89 (1) EPC should be made mandatory to render an intervention at the appeal stage admissible. The Patentanwaltskammer, therefore, suggests answering the referred points of law in the positive.

II. The referred points of law

The Patentanwaltskammer concurs with the Board's opinion expressed in the referring decision in that a third party admissibly intervening in opposition proceedings which are pending at the appeal stage should acquire appellant status after withdrawal of all appeals. Without repeating arguments supporting this view which are presented in the referring decision, the Patentanwaltskammer emphasises in particular with reference to reasons no. 3.4.3, 3.4.4, 3.10 and 3.12.2 of the referring decision that fairness and equity towards the third party justify such an appellant status, considering that it was the patent proprietor's side that gave rise to the intervention so that the patent proprietor can be expected to face continuation of appeal proceedings with a third party who intervened during the appeal proceedings as a consequence of its actions towards the third party.

The following points focus on aspects which appear to be additional to the reasons for the referring decision.

A third party intervening at the appeal stage should be given the opportunity of continuing the appeal proceedings after withdrawal of all appeals by any other party. This would avoid repeated and possibly duplicated validity proceedings before national courts or the Unified Patent Court which the third party would otherwise have to initiate in an effort to invalidate the patent in suit.

Normally, the third party will be determined to invalidate the patent in suit in consideration of the allegation of infringement put forward by the patent proprietor. If, upon withdrawal of all appeals by the other parties, the patent in suit is maintained as granted or in an amended form still endangering the third party's business, invalidation could - according to the legal status quo - only be achieved by initiating at least one validity procedure before a national court or the Unified Patent Court. The requirement for such an additional validity procedure would harm the public's interest in legal certainty about the validity of the patent in suit and be at the expense of efficiency. It is noted that national law of the EPC member states may not allow initiating or deciding validity proceedings while an opposition is pending before the EPO, including opposition proceedings pending at the appeal stage. Such an exclusion is defined for example in Sec. 81 para. 2, 1st sentence of the German Patent Act (§ 81 Abs. 2 S. 1 Patentgesetz). The German Federal Court of Justice (Bundesgerichtshof) ruled in its decision of December 6, 2022, X ZR 47/22 – Aminopyridin (headnote a)) that a German nullity action concerning a German national part of a European patent cannot be decided as long as an opposition is pending before the EPO, including the case of the opposition pending at the appeal stage. Thus, the need for a third party who intervened during the appeal proceedings, to initiate a German nullity action after withdrawal of all appeals by the other parties would lead to a severe delay in gaining legal certainty about the validity of the patent in suit, compared to the situation in which the appeal proceedings would be continued with the third party who intervened during the appeal proceedings and acquired appellant status. It is needless to say that the third party would consider initiating validity proceedings before a national court or the Unified Patent Court, in view of the

additional effort and costs involved, normally only after conclusion of appeal proceedings before the EPO.

In the interest of avoiding such a time delay until deciding on the validity of the patent in suit and to promote efficiency, remitting the case to the first instance for the sole reason that an intervention is filed at the appeal stage does not seem to be reasonable. Rather, the Board of Appeal should decide on the merits of the case, and the intervening party should be given the possibility of submitting comprehensive arguments, evidence and new grounds of opposition, which may be allowable under Art. 14 RPBA. This would give the third party the possibility of influencing the outcome of the opposition according to its needs in view of the allegation of infringement. Also, this would be equitable towards the patent proprietor who can be expected to face the full scope of the possible consequences of alleging infringement of the patent in suit by the third party.

In the Patentanwaltsskammer's opinion, this objective can be achieved only if the third party who intervened during the appeal proceedings acquires an appellant status corresponding to the status of a person entitled to appeal within the meaning of Article 107, first sentence, EPC.

It is noted that the UPCA and its Rules do not contain any statutory regulation on the admissibility of an action for revocation as long as an opposition is pending before the EPO. Art. 33 (10) UPCA merely governs that the parties shall inform the Unified Patent Court about any pending revocation, limitation or opposition proceedings before the European Patent Office, and of any request for accelerated processing before the European Patent Office, and that the Unified Patent Court may stay its proceedings when a rapid decision may be expected from the European Patent Office. There is no legal definition of a "rapid decision", and staying the proceedings lies within the Unified Patent Court's discretion, so that an unexpected closure of appeal proceedings before the EPO might lead to a delayed counterclaim for revocation before the Unified Patent Court. Since the defendant in infringement proceedings before the Unified Patent Court may, according to R. 25 RoP, be expected to lodge a

counterclaim for revocation with its statement of defence, it is presently unclear whether such a delayed counterclaim would be considered by the Unified Patent Court under its strict procedural regime. In order to avoid the potentially severe consequences for the alleged infringer, the third party intervening during the appeal proceedings should, therefore, be given the possibility of continuing the appeal proceedings after withdrawal of all appeals by any other party.

In the interest of harmonising proceedings before the EPO and national infringement courts as well as the Unified Patent Court, it should be possible to continue the appeal proceedings with a third party who intervened during the appeal proceedings after withdrawal of all appeals.

A third party intervening at the appeal stage should necessarily acquire an appellant status corresponding to the status of a person entitled to appeal within the meaning of Article 107, first sentence, EPC. This would serve legal certainty throughout the appeal proceedings about the status of each of the parties. Situations should be avoided in which the patent proprietor as the sole appellant cannot be sure about the consequence of withdrawing its appeal, for example if an intervening third party were allowed to change its status from that of only an opponent to appellant-opponent by late payment of an appeal fee if it becomes apparent that the patent proprietor might withdraw the only appeal.

Further to reason no. 3.16.1 of the referring decision, the Patentanwaltskammer is of the opinion that, if the Enlarged Board of Appeal answers the referred points of law in the sense that the third party can acquire appellant status only by payment of an appeal fee, payment of such an appeal fee should be mandatory to render an intervention at the appeal stage admissible. The time limit under R. 89 (1) EPC should then apply to payment of the appeal fee in addition to payment of the opposition fee.

In particular in view of the above, the referred points of law should, therefore, be answered as follows:

After withdrawal of all appeals, may the proceedings be continued with a third party who intervened during the appeal proceedings?

Yes.

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?

Yes.



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