

G 2/24 – Decision regarding »Skin cleanser«

Outlining conditions under which a G-decision may be reversed

According to Article 99(1) EPC, anyone can file an opposition against a European patent before the European Patent Office (EPO) up to nine months after the patent is granted. In EP opposition proceedings, the opponent can then present their attacks against the validity of the patent in a notice of opposition (Rule 76 EPC). This allows the granted patent and its scope of protection to be reviewed by another instance of the EPO after grant. Once the opposition period has expired, it is no longer possible to file an opposition before the EPO and to thus become »an opponent«.

The only exception is an intervention by an alleged infringer in ongoing EP opposition proceedings. More specifically, this applies if, according to Article 105 EPC,

- i) proceedings for infringement of the same patent have been instituted against the alleged infringer (Article 105(1)(a) EPC), or
- ii) following a request of the proprietor of the patent to cease alleged infringement, the alleged infringer has instituted proceedings for a ruling that the alleged infringer is not infringing the patent (aka negative declaratory action) (Article 105(1)(b) EPC).



The time limit for an intervention is three months after such proceedings were initiated (Article 89(1) EPC). An intervention in opposition proceedings is supposed to allow the alleged infringer to independently pursue a review of the patent before the EPO, including their own arguments and documents by filing a notice of intervention, the content of which corresponds to a notice of opposition (Rules 89(2), 76 EPC). Hence, the alleged infringer is not bound by the submissions of the remaining opponent(s), but can submit fresh attacks with their notice of intervention.

Upon an admissible intervention, the alleged infringer is granted the role of an opponent. In the EPC, the position of an intervener in *opposition* proceedings is explicitly regulated, and Article 105(2) EPC states: »An *admissible intervention shall be treated as an opposition*«. Thus, an intervener is treated as an opponent and is placed on equal footing with all other opponents.



Intervention in opposition appeal proceedings

What does this mean for an intervention in second-instance opposition proceedings, i.e., in opposition appeal proceedings? Generally, only parties to the first-instance opposition proceedings can lodge an appeal. Thus, as a rule, only the patent proprietor and the opponent(s) in the first-instance proceedings can become appellants.

An intervention is generally possible in opposition appeal proceedings. However, an alleged infringer intervening in the appeal stage does *not* acquire the status of an appellant, but only that of an opponent that has *not* appealed (G 3/04).

Hence, the intervener is a party to the appeal proceedings, but, if the last remaining (or sole) appellant withdraws its appeal, the appeal proceedings are immediately terminated. It is established EPO case law (G 7/91 and G 8/91) that appeal proceedings are terminated when a sole (in case of a sole appellant) or all appellants (in case of multiple appellants) withdraw their appeal.

Accordingly, in line with established EP case law, a second-instance intervener cannot continue the appeal proceedings in such a case, even if they would like to do so.

The EPC lacks an explicit provision for intervening in the *appeal* proceedings. It is established case law that Article 105 EPC is to be applied analogously also for appeal proceedings, and thus intervening in the appeal proceedings is generally possible (G 1/94). However, the status of parties in the appeal proceedings is specified explicitly in Article 107 EPC. Herein, it is stipulated that an appellant must meet the requirements of Article 107, first sentence, EPC: »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*«, as pursuant to Article 107,

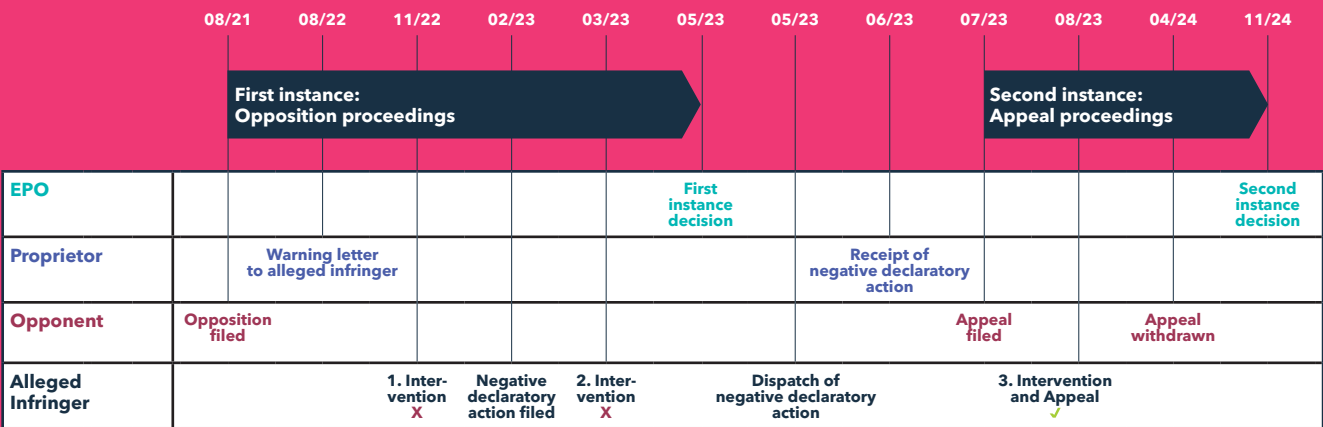
second sentence, EPC. Hence, a party according to Article 107, *first* sentence, EPC is an appellant, or *independent* party, to the appeal proceedings, which can drive the appeal proceedings on their own motion, while a party according to Article 107, *second* sentence, EPC is only a party as of right, i.e., a *dependent* party to the appeal proceedings. An example of such a dependent party in the appeal proceedings would be a first-instance opponent who did not lodge an appeal.

In G 3/04, the Enlarged Board concluded that *only* those who were involved in the first-instance proceedings could be considered parties to the proceedings within the meaning of Article 107, *first* sentence, EPC. This requirement was assumed not to be met by a party who only intervenes in the appeal proceedings, since they were not a party in the first-instance proceedings. However, given that an intervention should in principle be possible under the EPC, it was recognized in G 3/04 that an intervener instead meets the conditions for a party as of right, but not an appellant, under Article 107, *second* sentence, EPC. Referring to the above noted example, an alleged infringer who intervenes in opposition appeal proceedings at the appeal stage could accordingly only be considered an opponent who did not lodge an appeal.

Case T 1286/23

The Board of Appeal in opposition appeal proceedings T 1286/23 sheds light on this discrepancy in the role of a party joining proceedings in European opposition and appeal proceedings (see figure below).

European patent EP 2 941 163 held by Foreo Ltd. (Proprietor) relates to an oscillating handheld device for skin cleansing (»skin cleanser«). Beurer GmbH (Opponent) filed an opposition to the patent. During the opposition



proceedings, the Proprietor issued a warning to Geske GmbH, the alleged infringer, for alleged patent infringement. The alleged infringer then attempted to intervene in the first-instance opposition proceedings, but their attempts to do so were held inadmissible twice. These attempts are detailed in the following:

With reference to the requirements under Article 105(1) EPC set out above, an intervention under the EPC requires a *pending* lawsuit. In the first attempt to intervene, the alleged infringer referred to the warning letter issued by the Proprietor against them. However, the mere issuance of a warning letter does not constitute a pending lawsuit, and admissibility of the intervention was therefore denied.

In response, the alleged infringer filed a negative declaratory action at the Düsseldorf Regional Court shortly before the oral proceedings before the Opposition Division and attempted to intervene in the opposition proceedings on the basis of Article 105(1)(b) EPC. In the present case, it took the Court three months to dispatch the negative declaratory action to the Swedish Proprietor and it took another month until a proof of service was received. Since the alleged infringer's second attempt to join the proceedings was made shortly after filing the action, the lawsuit had been filed with the court, but had not yet been served on the Proprietor at that moment in time.¹ Therefore, the second attempt to join the proceedings was also rejected as inadmissible.

In conclusion, the alleged infringer was unable to effectively intervene in the opposition proceedings and therefore did not become an opponent. Thus, all of the alleged infringer's attacks against the patent, including all requests, arguments, and documents presented, were disregarded in the Opposition Division's decision and the Opposition Division merely decided on the inadmissibility of the interventions.

The patent was upheld in the first instance with the scope of Auxiliary Request 1, which included an unamended independent claim 1 and cancelled dependent claim.

The Opponent was the only party who appealed the decision of the Opposition Division. The alleged infringer now attempted to join the appeal proceedings again. Since the negative declaratory action had been effectively served to the Proprietor in the meantime, the requirement for instituted proceedings under Article 105(1)(b) EPC was now fulfilled and the alleged infringer could effectively

intervene in the appeal proceedings. Simultaneously with the intervention, the alleged infringer lodged an appeal against the decision.

Two months before the date for which oral proceedings were scheduled, however, the Opponent withdrew its appeal. According to established EPO case law (G 3/04), this should have ended the appeal proceedings. Nevertheless, the Board decided to proceed with the upcoming oral proceedings to address the question of whether or not the alleged infringer should be able to continue the proceedings.

After the oral proceedings, the Board came to the conclusion that the alleged infringer, contrary to established case law and in particular decision G 3/04, should be allowed to continue the appeal proceedings despite the withdrawal of the appeal by the sole appellant.

The reasons for this decision and the referral to the Enlarged Board of Appeal (G 2/24) are set forth in the following.

Referral G 2/24

In the grounds for its Decision, the Board analyzed conflicting decision G 3/04 and discussed in particular the reasoning given therein as to why an intervening party in opposition proceedings is granted a fully-fledged opponent status, but why an intervening party in opposition appeal proceedings is denied a fully-fledged appellant status in appeal proceedings.

The Board was not convinced by the reasoning of G 3/04 and considered it to contain an inconsistent interpretation of Article 107 EPC. It argued that both sentence 1 and sentence 2 relate to a »party to the proceedings«. G 3/04 denied that an appellant can be a »party to the proceedings« according to sentence 1, because »party to the proceedings« is to be interpreted as »party to the proceedings leading to the appealable decision«, which was deemed not to apply to an intervener in the appeal stage. However, at the same time, G 3/04 concluded that an appellant *can* be a »party to the proceedings« according to sentence 2. The referring Board objected that – in a consistent interpretation – also sentence 2 would have to be interpreted relating to a »party to the proceedings leading to the appealable decision«, and actually would *not* apply to an intervener in the appeal stage either.

¹ Under the relevant German national law, the mere filing of an action at a court does not automatically result in a pending lawsuit. Generally, as long as the court has not served the proprietor with the action, no lawsuit is pending. Specifically, an action before German civil courts is effectively instituted only when the action has been served on the defendant (Section 253(1) of the German Code of Civil Procedure).

Furthermore, the referring Board objected to an undue interpretation in the analogous application of Article 105 EPC in appeal proceedings. It referred to established case law (G 1/94), wherein a party joining opposition proceedings in the appeal stage pursuant to Article 105 EPC is granted the status of an opponent *as a matter of principle*. The Board explicitly referred to Article 105(2) EPC, which generally constitutes without any restrictions that *»[an] admissible intervention shall be treated as an opposition.«* According to the Board, the same unrestricted and equal rights should accordingly apply for an intervener in the appeal stage. However, in G 3/04, Article 105(2) EPC was not analogously interpreted as *»An admissible intervention shall be treated as an appeal«*, but as *»An intervener shall be treated as an opponent that is already party to the proceedings but is not an appellant«*. This was, in the referring Board's view, undue.

The Board noted that, for an intervener in the appeal stage, the appeal does not represent a review of the first instance decision as for the other parties. In contrast, the substantive interests of an intervener 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. The Board further argued that the special role of the intervener under the EPC is also reflected *inter alia* by the time limits an intervener does not need to observe while the other parties do. This special role should, in the Board's view, be considered when assessing the requirement of being *»adversely affected by a decision«* for the party to the proceedings according to Article 107, first sentence, EPC. In particular, this should not be construed in the usual way to mean that one or more first-instance requests have not been complied with. Instead, an *»adverse effect«* for an intervener is already constituted by the (continued) existence of a patent the intervener is alleged to have infringed.

In the Board's view, the intervener's special role is also reflected by the fact that certain conditions defined in the EPC for other parties, such as deadlines or requirements for paying fees in a certain time limits, do *not* apply for an intervener (cf. nine-months deadline for filing an opposition), which should consequently extend to the appeal stage. Instead, the Board highlights that the requirements defined in the EPC for an intervention are linked to national legal proceedings, and in particular to a *»legal interest extraneous to the proceedings conducted before the European Patent Office«* (cf. T 1286/23, margin no. 3.9.2). This *»legal interest«* should, in the referring Board's view, replace the time limits and prerequisites stipulated in the EPC for other parties in opposition and appeal proceedings, and therefore the admissibility of the intervention and the acquisition of a fully independent appellant status should not be denied based on such time limits and prerequisites.

The Board therefore concluded that, by joining the appeal proceedings and filing the appeal, the intervener effectively became an appellant under Article 107, first sentence, EPC, and should therefore be allowed to continue the appeal even after the Opponent, who no longer was the sole Appellant, withdrew its appeal.

Since this view, however, contradicts decision G 3/04, the Board formulated the following questions for referral to the Enlarged Board of Appeal (G 2/24):

1. *After withdrawal of all appeals, may the proceedings be continued with a third party who intervened during the appeal proceedings?*
2. *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 referred questions sought to revisit G 3/04 and thus raised the question whether decisions by the Enlarged Board of Appeal, which so far had been regarded as providing absolute legal certainty on the addressed questions, can simply be opened for revision if a referring Board disagrees with that decision. Nevertheless, several *amicus curiae* briefs were submitted in this matter, *inter alia* from the Compagnie nationale des conseils en propriété industrielle (CNCPI), the Patentanwaltskammer (PAK) and the European Patent Institute (epi) and there appeared to be a consensus that the referral touched questions of fundamental procedural importance, and thus should be deemed admissible for review before the Enlarged Board of Appeal.

Decision G 2/24

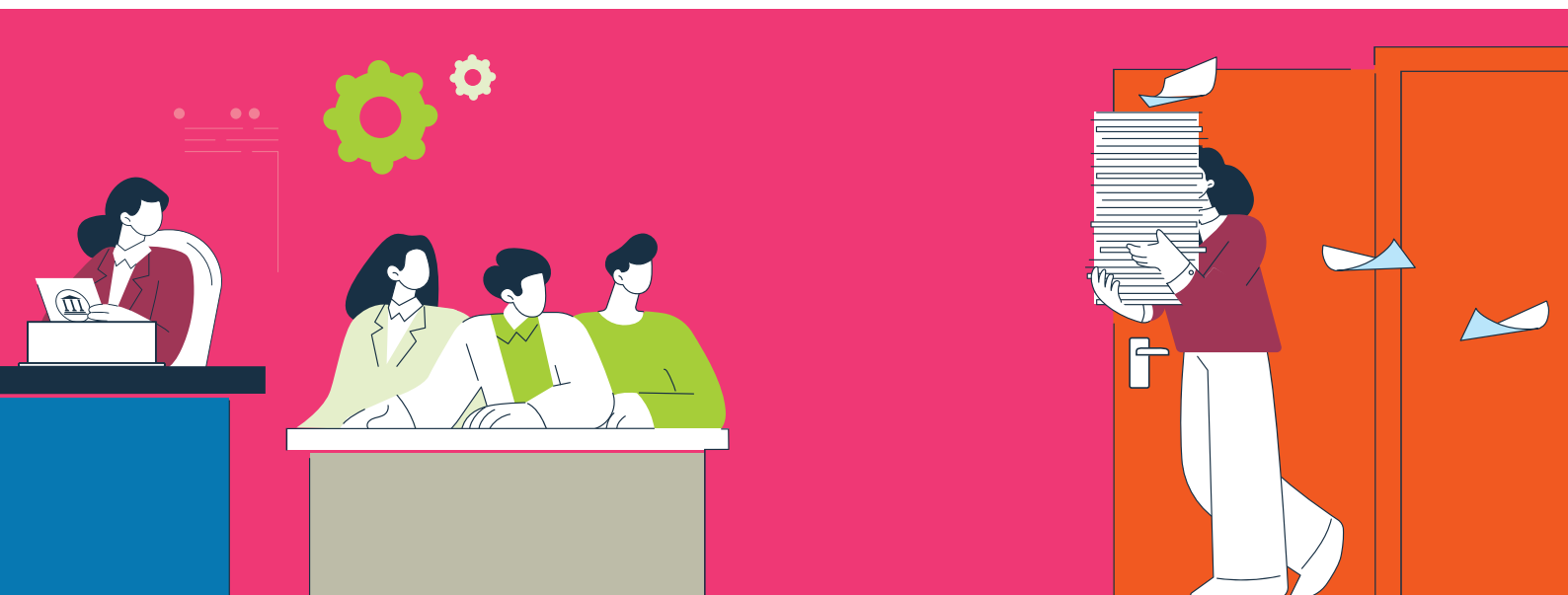
The Enlarged Board of Appeal agreed that the referred questions concern an aspect of fundamental importance (Reason 7) and held the referral is admissible given that Article 21 RPBA requires any board considering a deviation from the interpretation of the EPC laid out in an earlier decision by the Enlarged Board of Appeal to refer to the Enlarged Board once more (Reason 6). The Enlarged Board however noted that it *»does not find the prospect of a board of appeal referring a question of law solely because it disagrees with an earlier G-decision or opinion to be particularly appealing in terms of safeguarding consistent case law«* (Reason 9).

The Enlarged Board of Appeal summarily disagreed with the referring Board, several *amicus curiae* briefs, and the opinion of the President of the EPO regarding the substance of the referral and held that decision G 3/04 continues to apply without amendments or changes. It answered both referred questions in the negative, holding that:

»After withdrawal of all appeals, appeal proceedings may not be continued with a third party who intervened during the appeal proceedings in accordance with Article 105 EPC.

The intervening third party does not acquire an appellant status corresponding to the status of a person entitled to appeal within the meaning of Article 107, first sentence, EPC.«

To arrive at this order, the Enlarged Board first considered whether Articles 99(1), 105, and 107 EPC had been amended in their substance with the entry into force of the EPC 2000, which occurred after G 3/04, stating that *»an amendment to any of these articles could potentially prompt a reconsideration of the Enlarged Board's earlier conclusions and reasons when analysing the referred questions«* (Reason 22).



While all three articles had been amended in at least some of the official languages², the Enlarged Board found that the amendments were not of a substantive nature and thus did not prompt a reconsideration of their interoperation and the resulting findings in decision G 3/04 (Reason 26).

Next, the Enlarged Board considered the legal concept of appeals under the EPC and found that 1) appeal proceedings are of a judicial nature and not a continuation of the proceedings before the administrative departments of the EPO, 2) appeals are designed as a remedy on both facts and law for parties to proceedings before the administrative departments of the EPO with the aim to eliminate an »adverse effect« of the impugned decision, 3) the scope of the appeal proceedings is primarily determined by the decision under appeal, the appellant's requests submitted with the notice of appeal and the statement of grounds of appeal, and, in *inter partes* proceedings, the submissions of the other party or parties in reply to the appellant's statement of grounds of appeal, and 4) the appeal procedure is not an *ex officio* procedure of the EPO but instead depends on the appellant to initiate, determine the scope of, and conclude the procedure within that party's power of disposal, in accordance with the principle of party disposition (Reason 34).

The Enlarged Board then went on to consider what qualifies a party to proceedings, taking into account not only the relevant provisions of the EPC 1973 and 2000, but also of the *travaux préparatoires* for the EPC 1973 with its explanatory comments (Reasons 41-44). Based thereon, the Enlarged Board held that 1) a party entitled to appeal within the meaning of Article 107, first sentence, EPC is only the person who had formally participated in the proceedings before the administrative department that

issued the impugned decision, 2) a third party that has not been admitted as a party to the proceedings before the administrative department is therefore not entitled to appeal, unless its entitlement to participate was ignored due to procedural error or incorrect application of the law, 3) an adverse effect only exists if a decision of an administrative department falls short of the request of a party to the proceedings or deviates from it without their consent, and 4) any other negative or disadvantageous impact of a ruling by an administrative department of the EPO on a third party that has not formally participated in the proceedings does not fulfill the legal threshold required by Article 107, first sentence, EPC (Reason 45).

Next, the Enlarged Board considered the legal concept of interventions, once again turning to the *travaux préparatoires* for the EPC 1973 as well as previous G-decisions G 1/94 and G 4/91 (Reasons 49-54). The Enlarged Board concluded that 1) the legal remedy of an intervention is governed by a special legal framework which, due to its exceptional nature, inherently precludes an extensive interpretation and application, 2) the intervention is intended to grant third parties to have the validity of the European patent they are alleged to infringe examined after the opposition period has elapsed, 3) an intervener enters into the proceedings at the stage they are at on the date of the intervention, and 4) an intervener at the opposition stage enjoys all the rights and obligations of a party to the opposition proceedings (Reason 55).

Considering the interplay of appeal and intervention, the Enlarged Board of Appeal held that 1) an intervener at appeal cannot procedurally benefit from any status in the preceding administrative proceedings and thus becomes a party as of right in accordance with Article 107, second

² Article 107 EPC remained unchanged from its EPC 1973 version in English, but was reworded for editorial improvement in German and French.



sentence, EPC, 2) an intervention at appeal needs to fit into the particular legal and procedural framework of the boards of appeal as the first and final judicial instance under the EPC, 3) the principle of party disposition, together with the binding nature of the parties' requests and the prohibitions of ruling *ultra petita* and *reformatio in peius*, limits the option for procedural action of all involved in appeal proceedings, 4) these limits are equally applicable to third parties entering into pending appeal proceedings by virtue of an intervention, 5) the legal status of a party as of right is not the same as that of the appellant, whereby only the latter has the right to dispose of the appeal they have lodged, 6) if the sole or all appeals are withdrawn in opposition appeal proceedings, the proceedings end and cannot be continued with an intervener at the appeal stage or any other non-appealing party (Reason 67).

The Enlarged Board further reviewed the case law of the boards of appeal, finding no decisions that did not follow G 3/04 (Reason 68), and interventions in proceedings before the courts of the EPC contracting states and the UPC in order to ensure harmonized application of the EPC (Reason 71), concluding that the procedural treatment of an intervener essentially depends on the specific regulation applicable and that, in the absence of a specific statutory provision stating that an intervention is independent of the main parties' procedural actions, it is considered an accessory and ceases to have effect if the proceedings are terminated by the main parties (Reason 97).

The Enlarged Board therefore concluded that *»in the absence of any substantive change to the relevant legal framework after the Enlarged Board issued decision G 3/04, and in view of the similar factual and procedural situation underlying the earlier and the present referral the considerations and findings of decision G 3/04 continue to be in line with the legal concept of appeals, the qualification of a party, the legal concept of interventions, and the principles guiding the interplay of appeal and intervention«* (Reason 98). As a result, the Enlarged Board stated that *»following and implementing the general, abstract, and to some extent, rather political observations of the President of the Office, four amicus curiae briefs (epi, Patentanwaltskammer, Mr Exner and Mr Thomas) and, to a certain extent, the referring board, would thus require amending the legal framework, i.e. the EPC and/or Implementing Regulations«* (Reason 102).

G 2/24 thus confirms G 3/04 in that, if the sole or all appeals are withdrawn in opposition appeal proceedings, the appeal proceedings end with regard to all substantive issues for all parties involved and cannot be continued with an intervener at the appeal stage.

Outlook and takeaways

The situation for interveners who only intervene during appeal proceedings remains unchanged in view of G 2/24. This means that if the sole or all appeals are withdrawn in opposition appeal proceedings, the appeal proceedings end with regard to all substantive issues for all parties involved and cannot be continued with an intervener at the appeal stage.

The Enlarged Board's statement that it finds referrals based solely on a disagreement with earlier G-decisions »not particularly appealing«, along with its upholding G 3/04 shows clearly that the Enlarged Board seeks to stay consistent in its interpretations of the EPC. A reversal of an existing G-decision by a new G-decision thus only seems possible if the legal bases of the EPC or the Implementing Rules on which that existing G-decision was based were meanwhile amended in substance. It thus appears that one can continue to rely on G-decisions as providing absolute legal certainty (if the EPC and the Implementing Regulations were not substantively revised in the meantime).



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