

## Decision of the Enlarged Board of Appeal of 16 July 2019 G 2/19

(Translation)

### Composition of the board:

**Chairman:** C. Josefsson

**Members:** J. Gröning  
I. Beckedorf  
M. Sachs  
G. Weiss  
G. Eliasson  
P. Gryczka

**Appellant/Third party within the meaning of Art. 115 EPC:** Jostarndt  
Patentanwalts-AG

**Respondent/Patent proprietor:** IPCom GmbH & Co. KG

**Headword:** Right to be heard and correct venue for oral proceedings

**Relevant legal provisions:** Articles 6(2), 15, 16, 17, 84, second sentence, 106, 107, 112(1)(a), 113, 115, 116(1), first sentence, EPC

**Relevant legal provisions (EPC 1973):** Article 6(2) EPC 1973

**Keyword:** "Right of a third party within the meaning of Article 115 EPC to oral proceedings on appeal against a lack of clarity in granted patent claims – no" – "Examination by the Enlarged Board of Appeal of the grounds for admissibility of a referral under Article 112(1)(a) EPC" – "Suspensive effect of an appeal filed by a third party within the meaning of Article 115 EPC against a lack of clarity in granted patent claims – no" – "A means of redress is clearly inadmissible where a person without standing to file an appeal (here: a third party within the meaning of Article 115 EPC) relies on a grievance not recognised under the EPC (here: a lack of clarity to be removed from the patent claims for the purposes of Article 84 EPC)" – "Oral proceedings before the boards of appeal in Haar – permissible"

### Catchword:

1. A third party within the meaning of Article 115 EPC who has filed an appeal against a decision to grant a European patent has no right to have its request for an order that examination proceedings in respect of the European patent be reopened for the purpose of removing allegedly unclear claims (Article 84 EPC) heard at oral proceedings before a board of appeal of the European Patent Office. An appeal filed in such a way has no suspensive effect.
2. Oral proceedings before the boards of appeal at their site in Haar do not infringe Articles 113(1) and 116(1) EPC.

## Summary of Facts and Submissions

I. Proceedings in T 831/17, which concerns the grant of European patent No. 2 378 735 (hereinafter "contested patent") on 12 January 2017, are pending before Technical Board of Appeal 3.5.03. Mention of the grant was published in the European Patent Bulletin on 8 February 2017. The contested patent was granted on a divisional application resulting from the earlier European patent application No. 06113477.1 (hereinafter "parent application") and is directed to a method for operating a mobile wireless network defined in a number of parallel claims. Its claim 1 reads:

"Method for setting up a protocol instance (35) in a convergence protocol layer (1) of a first radio station (15), so that settings and operation of the protocol instance (35) in the convergence protocol layer (1) of the first radio station (15) correspond to settings and operation of a protocol instance in a convergence protocol layer (2) of a second radio station (16), comprising:

reception of a carrier configuration message (70), from the second radio station (16), wherein the carrier configuration message (70) is intended to be used to set up, reconfigure or release a carrier (45), and wherein the carrier configuration message (70) has a configuration request (40, 41, 42) included in it that can be used to set up, reconfigure or release the protocol instance (35) in the convergence protocol layer (1) of the first radio station (15), setup, reconfiguration or release of the carrier (45) of the first radio station (15), and setup, reconfiguration or release of the protocol instance (35) in the convergence protocol layer (1) of the first radio station (15)." The parent application also gave rise, by way of another divisional application, to European patent No. 2 890 082 (hereinafter "sister patent"), which goes hand in hand, so to speak, with the contested patent and is likewise directed to a method for operating a mobile wireless network.

During both sets of grant proceedings, Jostarndt Patentanwalts-AG (hereinafter "J.") filed third-party observations concerning patentability within the meaning of Article 115 EPC and latterly relating to clarity of the claims (Article 84 EPC) as regards the feature "carrier (45)". In that respect, the following addition was inserted into claim 1 of the sister patent No. 2 890 082: "... carrier (45), which connects the convergence protocol layer (1) with a[n] RLC connection control layer (10), ...".

II. By its appeal dated 6 March 2017 and received on 8 March 2017, J. requested that the decision to grant the contested patent be set aside and that an order be made for the examination proceedings to be resumed. As regards procedure, J. initially filed an auxiliary request for oral proceedings and, having been summoned to oral proceedings at the boards' site in Haar, then requested that they be held in Munich instead. It also requested a referral to the Enlarged Board of Appeal.

On the merits of its case, J. essentially argued that there had been an infringement of substantive law and of its right to be heard. The examining division, it contended, had breached the clarity requirement under Article 84 EPC by failing to take steps towards ensuring the same degree of precision as regards the carrier feature claimed in the contested patent as had been achieved for it in the sister patent, despite the overlap in the two patents' content, and had not addressed the merits of its related third-party observations within the meaning of Article 115 EPC.

In support of its request for a change of venue, J. initially argued that Haar was not specified in the European Patent Convention as a venue for performing legal acts or holding proceedings. Article 6(1) EPC stipulated that the European Patent Organisation's headquarters were in Munich; only the European Patent Office had an additional branch in The Hague, as provided in Article 6(2) EPC. In the oral proceedings before the Enlarged Board, it further argued that holding oral proceedings in Haar instead of Munich would infringe its right to be heard.

III. On receiving the request for a change of venue, the referring board cancelled the scheduled oral proceedings and issued its interlocutory decision of 25 February 2019 referring the following questions to the Enlarged Board:

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 European Patent Convention 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?

The board's main reasons for the referral were as follows:

The third question, on the correct venue for oral proceedings, was of fundamental importance for numerous appeal proceedings and would help to ensure uniform application of the law. Irrespective of its own view, as the referring board, on how the question of the correct venue should be answered, legal uncertainty could be expected to persist until the boards arrived at a common approach, and there would be considerable organisational problems too.

It was therefore appropriate also to refer to the Enlarged Board preliminary questions on the need for oral proceedings in order to ensure that the law was applied uniformly.

On the one hand, the boards' everyday practice involved routinely scheduling oral proceedings as soon as a party requested them, even where the appeal appeared to be more or less clearly inadmissible or unfounded. On the other hand, in G 1/97 (OJ EPO 2000, 322), the Enlarged Board had developed the principle that an appeal against a final board decision on the merits of the case which – because it was based on a non-existent legal remedy – was manifestly inadmissible could be rejected without any further procedural formalities and, in particular, without first holding oral proceedings. The boards had applied this principle on a number of subsequent occasions, while a line of case law had also emerged (e.g. T 1042/07, not published in the OJ EPO) according to which a decision could be taken without oral proceedings where they had initially been requested but then no statement of

grounds of appeal had been filed.

Given this background, the first question was referred with a view to clarifying whether the Enlarged Board of Appeal regarded the case law it had initiated in G 1/97, and possibly also the additional group of decisions starting with T 1042/07, as establishing a principle which could be applied more generally in that the right to oral proceedings on appeal was conditional on the appeal's not being manifestly inadmissible; the second question then narrowed down the scope of that first question to the situation in hand.

IV. The President of the European Patent Office commented in writing on the referral, having been invited to do so by decision under Article 9 of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA).

In those comments, he took the view that any person, such as a third party within the meaning of Article 115 EPC, who had not been a party to the grant proceedings could not appeal against the decision taken in those proceedings and was not adversely affected, and that this also applied where the aim was to have allegedly unclear patent claims removed. An appeal by a third party within the meaning of Article 115 EPC did not result in pending appeal proceedings in a legal sense and, in the absence of any proceedings, the third party could not be a party to them. There was thus no right to oral proceedings under Article 116 (1) EPC in such circumstances.

This meant that one of the criteria for admissibility of a referral to the Enlarged Board was not met, namely the existence of pending appeal proceedings. Exceptions to this admissibility requirement were sometimes made if the referral concerned the very admissibility of the appeal, but no such exception was applicable here. The first and second questions related not to the admissibility of the appeal but to an isolated procedural aspect of the examination of admissibility, namely the right to oral proceedings. Besides, there were no diverging decisions of the boards on this point.

As regards the third question referred, Article 6(2) EPC had to be interpreted, in accordance with its spirit and purpose and in line with practice in the contracting states on the Administrative Council, as implying that "Munich" was not limited to that city's boundaries but allowed for the European Patent Office and its departments to be accommodated in premises in the greater Munich area and in any event within the administrative district ("*Landkreis*") of the same name.

V. In a notice published on its homepage on 9 May 2016, the Enlarged Board announced that oral proceedings had been scheduled for 16 July 2019 and invited third parties to file written statements in accordance with Article 10(1) RPEBA.

*Amicus curiae* briefs were filed by Peter de Lange and Roel van Woudenberg, both patent attorneys, and by the Intellectual Property Owners Association (IPO), the Institute of Professional Representatives before the European Patent Office (epi) and the Chartered Institute of Patent Attorneys (CIPA). Their submissions can be consulted in the documents publicly available in the boards' web section, under the heading "Pending referrals" before the Enlarged Board of Appeal.

## Reasons for the decision

### A. Admissibility

I. Article 112(1)(a) EPC provides that in order to ensure uniform application of the law or if an important point of law arises, a board of appeal must, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes.

An additional, unwritten prerequisite for admissibility of a referral is that appeal proceedings initiated by an admissible appeal are pending before the referring board, unless the referral concerns some aspect of the very matter of admissibility. The point of that exception is that the boards would otherwise have no way of referring questions of fundamental importance for the admissibility of an appeal to the Enlarged Board (G 2/04, OJ EPO 2005, 549, point 1.2 of the Reasons; G 1/12, OJ EPO 2014, A114, point 9 of the Reasons).

II. Under Article 112(1)(a) EPC, it is primarily up to the referring board to examine whether the admissibility requirements are met (see G 1/14, point 2 of the Reasons).

The Enlarged Board, however, is not bound by the outcome of that examination and verifies for itself whether and to what extent a decision by it is required in order to ensure uniform application of the law or settle a point of law of fundamental importance and the other conditions for the referral's admissibility are met (G 1/14, OJ EPO 2016, A95, catchwords 1 and 2 and point 2 of the Reasons).

In doing so, it may opt, where necessary, to reword the referred questions, for instance because it considers this appropriate and expedient with a view to answering the referred questions more precisely (for an example of rewording, see G 1/12, point 16 of the Reasons). Referred questions can remain unanswered in so far as they go beyond what genuinely needs to be clarified.

III. The interlocutory decision adequately sets out why the admissibility criteria are met for the second and third questions referred.

1. As set out above, the referring board has shown why it considers a decision by the Enlarged Board necessary to ensure uniform application of the law or settle a point of law of fundamental importance.

2. On the admissibility of the submission described as an "appeal" which is pending before the referring board, such admissibility being a condition for the admissibility of the referral to the Enlarged Board, it is apparent from the referring board's reasons for its interlocutory decision that it regards the request for a legal remedy initiated by J. as manifestly – that is, clearly – inadmissible (T 831/17, point 3.4 of the Reasons).

Its second question is thus aimed at clarifying whether, nevertheless, the right to oral proceedings under Article 116(1), first sentence, EPC is applicable – and, if so, whether it is limited – where a third party within the meaning of Article 115 EPC has filed a request contesting a decision to grant a patent.

The problem addressed by this question is therefore whether it is compatible with the

provisions on appeal proceedings laid down in the European Patent Convention to decide on a request filed in the form of an appeal without holding oral proceedings, even though the filing party has requested them, where that request is evidently inadmissible as an appeal in view of the circumstances and context.

Contrary to the view put forward by the President in his comments, the referral thus relates to a question which the Enlarged Board, having regard to its case law (G 2/04, point 1.2 of the Reasons; G 1/12, point 9 of the Reasons), cannot let go unanswered on account of the inadmissibility of the initiated appeal.

The need for clarification stems from the particular circumstances resulting in the appeal's inadmissibility. The second question arises only if and because the initiated appeal is inadmissible owing to specific features or circumstances. In the present case, these are that the appellant is a third party within the meaning of Article 115 EPC and its appeal is aimed at rectifying an alleged lack of clarity in granted claims.

Were the Enlarged Board nevertheless to deny the possibility of that question being referred, on the basis that the filed appeal is inadmissible, the boards would have no way of obtaining its clarification of the proper procedure for handling such cases, which is the very scenario the previously mentioned exception to the need for an admissible pending appeal is designed to prevent (see A.I. above). How each case of this kind was handled would then depend on how the scope of Article 116(1), first sentence, EPC was interpreted by the individual department responsible for hearing it. That would not be a proper approach.

3. The second question is also of fundamental importance.

According to the Enlarged Board's case law, a point of law is of fundamental importance if the answer to it goes beyond the individual case at issue and will be relevant in a potentially large number of cases (G 1/12, point 11 of the Reasons).

In G 1/12, the Enlarged Board found that a question as to whether or not an appeal filed by a person apparently lacking standing to do so was a point of law of fundamental importance. The same applies, by analogy, to the second question referred to it here. The problem it addresses, too, may be relevant in an indeterminately large number of cases, especially since, as the President observed in his comments, the referral, irrespective of the specific questions, concerns fundamental issues relating to the participation of third parties in proceedings under the European Patent Convention.

4. Nor can the second question be found inadmissible on the basis that it has already been answered in the Enlarged Board's case law, i.e. in G 1/97 and G 3/14 (OJ EPO 2015, A102).

Considered together, those two decisions could be taken to suggest that the procedural rules in the European Patent Convention do not preclude rejecting a submission like J.'s without holding oral proceedings (see Rule 101 EPC). G 3/14 gives detailed reasons explaining why it is necessary to live with a claim which has been granted despite not meeting the requirements of Article 84 EPC (G 3/14, points 55 and 69 ff of the Reasons). In G 1/97, it was established that requests based on an alleged violation of a fundamental procedural principle and aimed at

revision of a final decision taken by a board of appeal of the European Patent Office are to be rejected as inadmissible and that the rejection decision may be issued immediately without any procedural formalities.

Whilst there may be certain parallels between that scenario and J.'s request that the pre-grant situation in the grant proceedings be restored, G 1/97 does not pre-empt the answer to the second question. It would do so only if the two scenarios were the same in essence, but they are not.

The case underlying G 1/97 had already been dealt with in wholly admissible appeal proceedings before a technical board of appeal, which had closed them, after holding oral proceedings, by issuing a decision on the appeal. The patent proprietor's subsequent request leading to the referral to the Enlarged Board was aimed at reopening those appeal proceedings and based on complaints of a kind for which a petition for review by the Enlarged Board of Appeal is available under the revised European Patent Convention (Article 112a EPC).

The present case, by contrast, turns, generally, on whether an alleged disregarding in examination proceedings of observations filed by a third party within the meaning of Article 115 EPC in relation to clarity of the claims is appealable and, specifically, on whether a board is bound to grant such a party's request for oral proceedings. G 1/97 did not give an answer settling those matters.

5. The referral of the third question is likewise admissible. For the purposes of establishing admissibility, it suffices that an answer to that question might be needed in a scenario covered by one of the possible – that is, more than merely conceivable in a purely theoretical sense – answers to the second question.

Since that is the case here, the need for clarification articulated in the form of the third question goes beyond the specific case at issue and may arise in an indeterminately large number of similar cases. The criteria the Enlarged Board has imposed in its case law as regards demonstrating the fundamental importance of a point of law (G 1/12, point 10 of the Reasons) are thus met here too.

IV. The same cannot be said, however, as regards admissibility of the first question; an answer to it is not required within the meaning of Article 112(1)(a) EPC for the purposes of the case at issue.

The need for clarification the referring board has identified for the purposes of the case before it is amply covered by the second question, which, as the board itself remarked in its interlocutory decision, is narrowed down in scope to the specific circumstances of that case (T 831/17, point 4.5 of the Reasons).

The first question, by contrast, amounts to a generalisation applying to all cases in which an appeal appears to be "manifestly inadmissible". Compared with what specifically needs to be clarified for the purposes of the underlying case, an answer to this question is only of extraneous and rather academic interest. That is insufficient to find the question admissible, especially as its reference to the criterion of a "manifestly inadmissible appeal" introduces an imprecise legal notion not taken from the European Patent Convention, which, therefore, does not offer a more detailed basis for defining it more precisely. Nor does the interlocutory decision

define it in more detail.

For the Enlarged Board to be able to give an opinion on such a generalised question, it would have to establish workable, generally applicable criteria for defining the notion of a manifestly inadmissible appeal or else come up with a list of the specific scenarios covered by it. However, there is no need to do so for the purposes of the underlying case.

V. The wording of the second question must therefore be adapted to make it comprehensible on its own, in the absence of the first question. In its third question, the referring board, in line with J.'s written submissions, has asked (only) about infringement of Article 116 EPC. Since J.'s request for a change of venue is now based on an infringement of the right to be heard too, that question must also be adapted accordingly. The two questions – still numbered as before in the interests of expediency – can be worded as follows:

2. Is the right to oral proceedings under Article 116 EPC before a board of appeal limited where a third party within the meaning of Article 115 EPC files an "appeal" against the grant of a patent, relying on the argument that there is no alternative remedy under the European Patent Convention against the examining division's decision to disregard its observations concerning an alleged infringement of Article 84 EPC?

3. Can a board of appeal hold oral proceedings in Haar without infringing Articles 113(1) and 116(1) EPC if it has been requested that they be held in Munich instead?

## **B. Opinion on question 2**

I. Article 116(1), first sentence, EPC provides very generally that oral proceedings are to take place if so requested by any party to the proceedings. The referring board assumes that J.'s filing of an appeal has made it a party to the appeal proceedings and that it is therefore entitled to require that oral proceedings be held even though its submission appears to be manifestly inadmissible because it lacks standing to appeal under Article 107, first sentence, EPC (T 831/17, point 3.4 of the Reasons). It observes that, in a similar case, concerning an appeal filed by a party who had not been a party to the examination proceedings against the refusal of its request for correction of the grant decision, the board in question likewise held oral proceedings before issuing its decision (T 1259/09, not published in the OJ EPO).

II. This view is too simplistic in that it takes involvement in appeal proceedings as the sole basis for establishing the required party status. On a reasonable interpretation, Article 116(1), first sentence, EPC does not dictate such an automatic procedural outcome but rather allows for exceptions. Making such an exception is justified in the circumstances of the case at issue.

1. What is prescribed by the provisions of the European Patent Convention must be determined in accordance with the general rules of interpretation consistently applied by the Enlarged Board of Appeal in its case law. Their interpretation must take account not only of their wording (in each of the possible languages of the proceedings) but also of the scheme of provisions of which they form part and their



object and purpose (on this, see G 3/08, OJ EPO 2011, 10, point 7.1 ff of the Reasons; see also Schachenmann, Die Methoden der Rechtsfindung der Großen Beschwerdekammer, Festschrift für Teschemacher GRUR Int 2008, 702 ff).

2. Article 116(1), first sentence, EPC is not specially tailored to appeal proceedings. Instead, it is one of the general provisions in Chapter I of the "Common provisions" grouped together in Part VII of the European Patent Convention. These provisions lay down basic rules governing the actions of all departments of the European Patent Office in the proceedings they respectively conduct.

In other words, Article 116(1), first sentence, EPC applies to a wide range of procedures which sometimes differ considerably not only in terms of their structure, design and purpose but also in terms of their parties. Some of them are purely administrative, for instance those conducted by the Receiving Section, before which requested oral proceedings are anyway held only if it considers them expedient or intends to refuse the European patent application (Article 116(2) EPC), and those before the examining divisions. Since both the opponent and the patent proprietor are parties to opposition proceedings (Article 99(3) EPC), those proceedings have elements of adversarial administrative proceedings aimed at dispute resolution before a higher-ranking authority competent to hear objections.

The appeals procedure (Article 106 ff EPC), by contrast, corresponds to a judicial procedure. In the patent system set up under the European Patent Convention, the boards of appeal (Article 23(3) EPC) have been assigned the role of an independent judiciary (G 3/08, point 7.2.1 of the Reasons; see also G 6/95, OJ EPO 1996, 649, point 2 ff of the Reasons).

Given the variety in the scope of application of Article 116(1), first sentence, EPC, its nature cannot be considered to be, as it were, absolute. The legislator clearly intended it to serve as a basic rule governing the typical cases facing the departments of the European Patent Office in their everyday practice. However, it cannot be ruled out that exceptions to this basic rule may be made where – as in the case underlying this referral – its application would make no sense in the specific circumstances of an individual case.

3. The request filed by J. in the form of an appeal made its way to the board of appeal in the ordinary course of its business. It is subject to the provisions governing the appeals procedure in Part VI of the European Patent Convention.

In accordance with those provisions, a board takes a decision on the merits only if the filed appeal meets certain admissibility requirements. One of those requirements is that this particular appellant must be entitled to file such an appeal. For that, Article 107, first sentence, EPC requires that the appellant personally meet two conditions. They must, firstly, have been a party to proceedings in which a decision was taken and, secondly, be adversely affected by that decision. Neither of those two conditions is met in the case at issue here.

(a) In the case underlying this referral, a decision within the meaning of Article 107, first sentence, EPC was taken in the grant proceedings. However, a third party within the meaning of Article 115, first sentence, EPC who files observations concerning the patentability of an invention for which a European patent is sought is not a party

to those proceedings, as is expressly stipulated in Article 115, second sentence, EPC.

J. therefore does not personally meet this requirement under Article 107 for entitlement to appeal. It is not a party to proceedings within the meaning of that provision. It is anyway doubtful whether it personally could have acquired such status, given that, as it explained in its statement of grounds of appeal of 18 May 2017, it had filed third-party observations during the grant proceedings on behalf of a client, whereas it had filed the appeal in its own name. The question thus arises whether, even in the absence of the provision in Article 115, second sentence, EPC, general principles would dictate that only that client, but not J. itself, as that client's legal representative (in patent matters), could be regarded as a party to the proceedings. However, there is no need to deal with that question more thoroughly since Article 115, second sentence, EPC in any event precludes J. from having acquired the status of a party to the grant proceedings.

(b) Nor, contrary to what J. contends, does a third party tacitly become a party to proceedings once the examining division addresses its observations. The appellant in G 1/97 argued similarly that, in revoking a granted patent, a technical board of appeal (effectively) acted as an opposition division and that its decision therefore had to be open to appeal (G 1/97, point IV of the Facts and Submissions). The Enlarged Board of Appeal rejected that argument, and the same applies by analogy here: a third party within the meaning of Article 115 EPC does not become a party to proceedings by virtue of its comments having been considered in those proceedings.

(c) It ties in with the fact that J. does not personally meet the requirement for entitlement to appeal, namely the status of a party to the foregoing proceedings, that the European Patent Convention does not permit a challenge to an alleged lack of clarity in granted claims by way of opposition (Article 99 EPC) or any other means of redress aimed at obtaining a review by another department entrusted with the procedure (Article 15 EPC). The Enlarged Board has already held that, should a granted claim turn out not to comply with Article 84 EPC, such non-compliance must be lived with (G 3/14, point 55 of the Reasons). Figuratively speaking, that a third party within the meaning of Article 115 EPC lacks the status of party to proceedings and that the Convention rules out correcting allegedly unclear but already granted claims are two sides of the same coin.

(d) Nor is J. adversely affected within the meaning of Article 107, first sentence, EPC by the grant of the contested patent with allegedly unclear claims.

For legal reasons, only a party to the proceedings can be adversely affected in the legal sense by a decision taken in those proceedings. As a rule, a party who has filed a request is adversely affected if the decision falls short of what was requested, while the counterparty is, by the same token, adversely affected to the extent that the request is granted. A party can also be adversely affected purely substantively, that is, without having filed its own request, but that still presupposes that it has become a party to the proceedings, for instance because it has been served with a third-party notice or has intervened in the proceedings.

A third party's lack of status as a party to the proceedings thus goes hand in hand with a lack of any adverse effect, for legal purposes, ensuing from the decision taken

in those proceedings. That is consistent with the object and purpose of Article 115, first sentence, EPC, which protects the public interest in ensuring that no European patent is granted which does not meet the requirements of the European Patent Convention and, to that end, permits third parties to act as, so to speak, the public's "mouthpiece" by providing additional information to support the expertise within the European Patent Office.

It is true that third parties who go to this effort are often motivated by their own interests, for example in that they themselves run a business in a sector for which the invention in question is relevant. In such cases, they will have a certain interest in having their observations taken into account by the relevant department of the European Patent Office, but that alone no more affords them the status of party to the proceedings than disregarding their observations can be considered to amount to an adverse effect for legal purposes.

(e) Besides, account is taken of the interests of third parties. Article 115, first sentence, EPC must be interpreted to mean that the examining divisions are obliged to take note of any third-party observations concerning patentability.

Irrespective of the extent to which a failure to do so is actionable, it is apparent from the file on the grant proceedings at issue that the examining division took note of J.'s observations, in particular those in its written submissions of 26 October 2016, the content of which is at issue in the appeal proceedings. That did not, however, mean the examining division was obliged towards that third party within the meaning of Article 115 EPC to address the merits of those observations in whatever form. For that, it would have to have been a party to the proceedings, which – as explained above – is excluded.

4. The condition laid down in the European Patent Convention for the admissible filing of an appeal, i.e. that the appellant must have been a party to proceedings in which a decision adversely affecting them was taken, is in keeping with generally applicable procedural principles.

Unlike, for instance, opposition under Article 99 EPC, which any person can file, appeals are typically not designed to be remedies available to the public at large. As a rule, therefore, it is not open to just any outside party to appeal against an administrative or judicial decision but rather that is open only to those who were a party to the foregoing proceedings or who, owing to special circumstances or rules, are entitled to intervene, including for the purposes of lodging an appeal.

The European Patent Convention does make provision for a subsequent intervention in proceedings which confers the status of a party to those proceedings. Subject to specified conditions, it permits certain third parties, namely assumed patent infringers, to intervene in opposition proceedings after the opposition period has expired or during opposition appeal proceedings (Article 105(1) EPC; G 1/94, OJ EPO 1994, 787), whereby they also acquire the status of a party to the proceedings within the meaning of Article 107, first sentence, EPC (see Article 105(2) EPC). However, there is no equivalent provision for appeal proceedings.

5. Where, although a clarity objection based on Article 84, second sentence, EPC is

not a valid ground for opposition (Article 100 EPC), a third party within the meaning of Article 115 EPC chooses to file an "appeal" in order to have this objection nevertheless heard at a higher instance, this amounts to an attempt to circumvent the rules and is thus a clearly inadmissible means of redress. A means of redress is clearly inadmissible where, for example, it is initiated by a person who has no standing to do so (here: a third party within the meaning of Article 115 EPC) or with the aim of seeking relief for a grievance which the European Patent Convention not only does not recognise but in fact excludes as a subject of appeal under Article 106(1) EPC (here: an alleged lack of clarity to be removed from the patent claims for the purposes of Article 84 EPC).

6. The referring board rightly considered J.'s appeal to be such an inadmissible means of redress, observing that a lack of clarity in granted patent claims could be rectified only by way of an extraordinary remedy not provided for in the European Patent Convention, which, in view of the Enlarged Board's decision in G 1/97 (point 3(b) of the Reasons), it could not itself create (see T 831/17, point 4.6 of the Reasons).

Nor indeed is there any need for such an extraordinary remedy.

(a) The Enlarged Board has – as J. itself observed – already clarified in its decision in G 3/14 that an allegation that granted claims are not clear within the meaning of Article 84, second sentence, EPC is not a ground for opposition and that such claims can be reviewed for compliance with the requirements of Article 84 EPC only if and to the extent that an amendment made in opposition proceedings gives rise to a lack of clarity.

It would run counter to this legal position if an extraordinary right to appeal were to be conferred with a view to having a board review after all whether granted claims were unclear.

(b) J.'s supporting submissions do not go beyond what has already been discussed to date as regards the appealability of unclear claims.

(aa) J. contends that it is unacceptable for a skilled person with a mind willing to understand to be unable to determine unequivocally the scope of protection conferred by a granted patent because its claims are worded unclearly.

The seriousness of this objection must be qualified from the outset. Whether or not a claim is clear can only ever be established by evaluating it, and the outcome can therefore differ depending on how the interests at stake are affected. Besides, it should be borne in mind that clarity is not the only and absolute requirement under Article 84 EPC. Rather, Article 84, second sentence, EPC also requires that the claims be concise. Experience shows that meeting both requirements equally can sometimes entail compromising on the linguistic quality of the claim wording. While those compromises may be at the expense of clarity, that does not mean the result is open to objection in view of what Article 84 EPC aims to guarantee.

(bb) It is true that the Guidelines for Examination in the European Patent Office stress that clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought (Guidelines, F-IV, 4.1).

However, it would be to misunderstand that passage in the Guidelines to regard it as indicating that the clarity of the claims is to be treated "in practice" as an absolute requirement and that any shortcoming in this respect is open to appeal. Rather, its purpose is to call on the examining divisions to be especially meticulous in examining the clarity of claims because their subsequent correction is not provided for and therefore excluded.

In this connection, the Enlarged Board has already observed in G 3/14 that, as shown by the *travaux préparatoires*, the possibility of including a lack of clarity as a ground for opposition in the European Patent Convention 1973 was discussed, but the idea did not make it into the final version. That a ground for opposition based on Article 84 EPC was not included in the Convention was at least partly because other grounds for opposition, in particular Article 100(b) EPC, were considered adequate to deal with the problem. The Enlarged Board further considered the decision to deal with the matter in this way to reflect the legislator's conclusion that lack of clarity should not be introduced as a ground for opposition so as to streamline the procedure and not unduly delay it (see G 3/14, point 69 ff of the Reasons).

Moreover, as the Enlarged Board observed in the same decision (G 3/14, point 70 ff of the Reasons), Article 84 EPC was again cited as a basis for amendment proposals put forward during the negotiations on revising the Convention. However, those proposals concerned only its requirement that the claims be supported by the description, which is irrelevant here, and were in any event not adopted in the end. Instead, having thoroughly examined the proposals and concluded that the list of admissible grounds for opposition and revocation under Articles 100 and 138 EPC reflected world-wide standards, the European Patent Office had proposed that neither lack of clarity of the claims nor lack of support for the claims in the description should be added to the grounds for opposition and revocation (see CA/PL 27/99).

Since the existing provision was left unamended after the Convention's revision, the Enlarged Board concluded that the legislator had rejected all proposals ever made to elevate the Article 84 EPC requirements aimed at preventing a lack of clarity to a ground for opposition (G 3/14, point 71 of the Reasons).

(c) That still applies. Generally speaking, unclearly worded claims may well pose a certain abstract risk to the public interest, but it is uncertain whether and to what extent this could ever be to the detriment of third parties in a specific case. In any event, the Convention's legislative history outlined above shows that the legislator weighed up this abstract risk against other interests and ultimately decided not to cater for it in the form of a ground for opposition.

This legislative decision is not open to any serious doubt. As a result, contrary to J.'s contention, the right to a hearing before a lawful judge is not impaired. The Enlarged Board has in any event established that some means of dealing with unclear claims are available both under the Convention itself and to the national courts (G 3/14, point 71 in conjunction with points 55 and 59 of the Reasons).

For instance, the case law of Germany's Federal Court of Justice confirms this finding for its field of jurisdiction. It has found that any lack of clarity in the claims is to be overcome by interpreting the patent. All that can be done where there is a lack of clarity in the wording is to interpret that part of the claim narrowly, even going so far

as to give it the narrowest meaning possible if there is no other way of duly satisfying the requirement, laid down in the Protocol on the Interpretation of Article 69 EPC, that a patent's interpretation ensure a reasonable degree of legal certainty for third parties (German Federal Court of Justice judgment of 31 March 2009 – X ZR 95/05, BGHZ 180, 215, point 16 f – *Straßenbaumaschine*).

(d) There is similarly no need to introduce an extraordinary legal remedy to guarantee equal treatment.

On this point, J. considers it contradictory that an applicant who insists on retaining unclear claims despite the examining division's invitations to amend them (Article 94(3) EPC) and so takes the risk that the application will be refused can file an appeal, whereas that same lack of clarity, if tolerated by the examining division, is not then open to review. This objection is not convincing.

For different treatment to be legally relevant, it is generally required that like has not been treated as like and that different legal consequences are attached unjustifiably to like sets of circumstances. Neither of those two requirements is met here.

The grant of a patent in a particular version shows that the examining division found its claims to be sufficiently clear. In the reverse scenario of an appeal by the applicant, its assessment led it to the opposite conclusion and it refused the application accordingly. Given the different result arrived at by the examining division, it is not inconsistent to confer on the applicant a right of appeal in the latter case.

Besides, it is an oversimplification to seek to establish inequality of treatment as regards the availability of an appeal solely on the superficial basis that, if necessary, an applicant can bring a disputed lack of clarity before a board of appeal, whereas a reverse finding by the examining division that the claims are sufficiently clear must be accepted. As pointed out above (see B.II.6(b)(bb)), the arguments against making lack of clarity a ground for opposition included the need for general streamlining of the procedure (see G 3/14, point 69 of the Reasons). If an opposition – or an appeal too – could be based on this ground, the grant of many patents could be delayed more or less indefinitely, irrespective of the potential risk for the public interest genuinely posed by unclear claims. Conversely, the risk that a significant number of applicants might persist in pursuing claims in the face of clarity objections by the examining division must be regarded as comparatively low, if not indeed rather theoretical.

7. J.'s objection that its right to be heard was infringed because the examining division did not address the merits of its last observations concerning clarity overlooks the procedural reality.

In certain circumstances, a failure to address submissions which are, as such, relevant can be an indication that the decision-making department failed either to take note of them or to properly appreciate their relevance and that it may thereby have infringed the party in question's right to be heard.

However, an infringement of the right to be heard is by its very nature tied from the outset to status as a party to proceedings (Article 113(1) EPC). Only a party to

proceedings can be adversely affected by the decision-making department's failure to take note of its submissions. However, as already explained above, a third party who has filed observations concerning patentability is not a party to the (grant) proceedings and so has no procedural rights of its own in this respect and, in particular, has no entitlement to be heard (see Benkard/Schäfers/Unland, EPC, 3rd edition, 2019, Article 115, point 12). As already set out above (B.II.3(e)), such a third party is protected only in so far as the department of the European Patent Office concerned is obliged to take note of its observations.

8. Even if J. is ultimately considered a de facto party to the proceedings pending before the technical board of appeal following the filing of its appeal dated 6 March 2017, that alone is not sufficient to confer a right to the scheduling of oral proceedings.

Instead, Article 116(1), first sentence, EPC is to be interpreted narrowly, such that a purely formal position as de facto party to appeal proceedings is not enough to confer a right to require that oral proceedings be held if the person requesting them has no standing to appeal, because they were not a party to the foregoing proceedings in the legal sense, or if – as is also the case here – the grievance they invoke is not appealable. Instead, a board called on to examine their request may immediately refuse it as inadmissible in writing and, as the Enlarged Board put it in G 1/97 (see point 6, last paragraph, of the Reasons), without further procedural formalities.

9. Moreover, it logically follows that the initiation of a means of redress which, owing to such circumstances, is clearly inadmissible can have no suspensive effect.

Article 106(1), second sentence, EPC provides generally that appeals have suspensive effect but, like Article 116(1), first sentence, EPC, has basic character (see B.II.2 above). It is tailored to the standard case of an appeal filed by a party to the preceding proceedings who was adversely affected by a decision issued in them and who is seeking redress for a grievance which is appealable as such. There is, however, no legitimate interest in also lending suspensive effect to a means of redress, such as an appeal filed by a third party against unclear claims, which has no basis in the European Patent Convention and which is therefore clearly inadmissible. Accordingly, an exception to the general rule in Article 106(1), second sentence, EPC must be made.

### **C. Opinion on question 3**

I. As set out above in answer to the second question, the boards are not bound under Article 116(1), first sentence, EPC to grant a request for oral proceedings where the appeal is clearly inadmissible.

On the other hand, there is nothing to stop a board from nevertheless scheduling oral proceedings in a case in which it could lawfully refuse the related request. Article 116(1), first sentence, second clause, EPC empowers the European Patent Office to schedule oral proceedings of its own motion if it considers them expedient. A board will seldom consider holding oral proceedings in a case where the appeal is clearly inadmissible, and then only in the light of special circumstances in that specific case, but there is no procedural bar to its doing so. It is in view of those

cases that the third question should be addressed. Besides, this question may equally arise in an indeterminately large number of appeal proceedings pending as a result of admissible appeals.

II. The boards' move from the Isar building in Munich to their premises in Haar in 2017 was the result of a series of decisions and acts of the organs of the European Patent Organisation which followed – besides criticism from the outside world – the Enlarged Board's interlocutory decision R 19/12 of 25 April 2014 (not published in the OJ EPO) finding, in particular, that the boards' spatial and organisational ties with the European Patent Office presented a certain shortcoming in terms of the rule of law (R 19/12, interlocutory decision, point 19 of the Reasons). This led the Administrative Council to ask its Board, as set up under Article 28 EPC, to discuss the decision's possible consequences for the boards' organisational and managerial autonomy and the President of the European Patent Office to make suitable proposals (see CA/16/15 of 6 March 2015).

The proposals for structural reform subsequently put forward by the President of the European Patent Office included the possibility of a geographical separation. Having looked into various locations, he finally suggested the site in Haar (CA/82/16 of 7 October 2016, point 6) and was authorised by Council decision to take out a lease on the premises there (CA/PV 150, point 181).

III. That the boards have since performed their judicial function at the Haar site is thus the result of organisational acts adopted and implemented by the mandated organs of the European Patent Organisation in exercise of their powers. It is therefore not readily apparent what might justify a request that oral proceedings before a board be held in Munich instead.

1. J.'s argument in its written submissions that Haar is not specified in the European Patent Convention as a venue for performing legal acts or holding oral proceedings amounts, essentially, to a contention that the boards' move to the site there was contrary to the Convention's provisions and so to a certain extent unlawful.

This objection does not per se fall within the boards' jurisdiction. Their duty under the Convention is to contribute to performance of the task of granting patents assigned to the European Patent Office (Article 4(3) EPC) by exercising judicial powers (Article 23 EPC). That does not include, at least not directly, reviewing an organisational matter such as whether choosing to locate the boards in Haar is in keeping with the objective institutional provisions of the European Patent Convention. At best, such a matter can be reviewed in appeal proceedings under Article 106 ff EPC in the context of whether the boards' move to Haar is liable to impair the protected or protectable subjective standing of a party to proceedings to exercise its rights before them.

2. At the oral proceedings, J. alleged such an impairment on the basis that holding oral proceedings in Haar instead of in the city of Munich infringed its right to be heard.

The referring board explored this allegation of an infringement of the right to be heard in its interlocutory decision. Citing older case law of the boards, it considered the right to be heard at oral proceedings to be a specific component of the right to be



heard and found that compliance required not only that a party be heard at all but also that it be able to present its case at the correct venue (T 1012/03, not published in the OJ EPO, point 25 of the Reasons; T 689/05, not published in the OJ EPO, point 5.1 of the Reasons).

Again citing those decisions, the referring board took the view that the correct venue is not automatically the European Patent Organisation's headquarters but, as a rule, the site at which the department entrusted with the proceedings within the meaning of Article 15 EPC is located, so long as its location there is compatible with the provisions of the EPC (T 831/17, point 3.2 of the Reasons; T 1012/03, point 41 of the Reasons; T 689/05, point 5.3 of the Reasons).

There is some similarity between the matters in dispute in the cases cited by the referring board and those in the case underlying its referral. In view of the provisional applicability of amended Articles 16 and 17 EPC and the bringing together of search and examination on the basis of administrative orders on business distribution issued by the President of the European Patent Office (on this, see T 1012/03, point 50 of the Reasons), the oral proceedings at issue in those cases had been scheduled to take place before examining divisions in The Hague, whereas the appellants wished them to be held in Munich instead. The boards held that whether The Hague was the correct venue with a view to ensuring the right to be heard depended, among other things, on whether the President had had the power under the provisions of the European Patent Convention to locate examining divisions in The Hague (T 1012/03, point 43 of the Reasons; T 689/05, point 5.3 of the Reasons).

IV. Despite these similarities in the underlying circumstances, and considering what is truly at stake when the right to be heard is infringed, the Enlarged Board has reservations about whether it is appropriate to establish that choosing an "incorrect venue" results in such an infringement by looking, solely and in isolation, at whether, in institutional terms, there may have been deficiencies in the procedure whereby that venue was specified. In any event, it has serious doubts that a party's right to be heard is infringed by holding oral proceedings before a board in Haar rather than in the city of Munich.

1. At first glance, there may well appear to be a connection between observing or infringing the right to be heard and the geographical location and timing of a judicial hearing. Parties seeking justice may perceive the choice of an entirely unusual place or date as an unwillingness to address their concerns and so regard it as adversely affecting them in the exercise of their rights to a degree that is unacceptable for legal purposes.

However, such a situation, or even a remotely comparable one, cannot seriously be considered to arise as a result of moving the venue for oral proceedings before the boards of appeal from Munich to Haar, especially since, in the context of the European Patent Convention, the scale of reference for establishing whether the venue chosen for proceedings is unreasonable in terms of the right to be heard would be the territory of all the contracting states.

What J. has submitted in support of its allegation that holding oral proceedings in Haar infringes its right to be heard amounts to nothing more than perceived inconveniences.

2. Where, in view of the actual (geographical) situation or the other circumstances, the choice of a given venue for proceedings cannot be considered to infringe the right to be heard, there is no legal reason to go on to investigate whether such an infringement can nevertheless be identified on the sole basis that the organisational acts underlying the choice of venue are vitiated by other legal defects not affecting subjective party rights.

There is consequently no need to rule definitively on the points the referring board considered were likely to be crucial (see T 831/17, point 3.3 of the Reasons). It can remain unanswered whether the President or the Administrative Council, which authorised him to take out the lease on the new premises, had the power to move the boards to Haar and whether that site is covered by Article 6(2) EPC in conjunction with Section I (3)(a) of the Protocol on Centralisation.

It should nevertheless be observed here that, when setting up the European Patent Office in Munich and drafting Article 6(2), first sentence, EPC 1973, the legislator is unlikely to have envisaged the possibility of controversy over whether "Munich" is to be understood narrowly as meaning only that city or given a more elastic interpretation. Awareness that, as the judicial arm of the European Patent Office, the boards should have the same independence as national courts grew only gradually and the decision to highlight this by separating them geographically from the Office's administrative departments was likewise the result of a process which did not start until long after the Office had been set up.

If, however, it is right, on the one hand, to give the boards' independence a geographical dimension by separating them from the Office departments conducting administrative proceedings in Munich (besides those anyway situated in The Hague) in the interests of more closely mirroring the principle of the separation of powers applicable at state level, it is not particularly convincing to insist, on the other hand, that this can be done only within the boundaries of the city of Munich.

Given the outlined change in views on the degree of independence needed by the boards of appeal as a judiciary, it would seem compatible with an objective interpretation of Article 6(2), first sentence, EPC for the European Patent Office's administrative departments conducting their business in Munich to remain within the boundaries of the city, so that the grant of European patents in the strict sense takes place there, while the boards, as the judicial authority supervising those administrative departments, are located slightly outside those city boundaries solely to guarantee their geographical separation for the objective reasons mentioned above.

The outcome would be the same if the issue of the choice of the correct venue for oral proceedings were to be assessed in the context of the principle of the protection of the legitimate expectations rather than of the right to be heard. Users of the European Patent Organisation's services can legitimately expect that the European Patent Office's departments will not perform acts at whatever other place they choose. As regards Munich, however, the protection of that legitimate expectation does not go so far as to mean that its city boundaries form an inherent geographical barrier.

## **Order**

### **For these reasons it is decided that:**

1. A third party within the meaning of Article 115 EPC who has filed an appeal against a decision to grant a European patent has no right to have its request for an order that examination proceedings in respect of the European patent be reopened for the purpose of removing allegedly unclear claims (Article 84 EPC) heard at oral proceedings before a board of appeal of the European Patent Office.

An appeal filed in such a way has no suspensive effect.

2. Oral proceedings before the boards of appeal at their site in Haar do not infringe Articles 113(1) and 116(1) EPC