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D E C I S I O N
of 11 May 1994

Case Number: G 0001/94

Application Number: 86302987.2

Publication Number: 0202780

IPC: C02F 1/56

Language of the proceedings: EN

Title of invention:
Flocculation processes

Patentee:
Allied Colloids Limited

Opponent:
SNF Floerger

Intervener:
01) Cyanamid of Great Britain Limited
02) Chemische Fabrik Stockhausen GmbH

Headword:
Intervention/ALLIED COLLOIDS

Relevant legal norms:
EPC Art. 105

Keyword:
"Admissibility of intervention during appeal proceedings"

Decisions cited:
G 0004/91, G 0010/91,

Headnote:
Intervention of the assumed infringer under Article 105 EPC is admissible during pending appeal proceedings and may be based on any ground for opposition under Article 100 EPC.

Case Number: G 0001/94

D E C I S I O N
of the Enlarged Board of Appeal
of 11 May 1994

Appellant: (Opponent)	SNF Floerger 41, rue Jean-Huss F-42028 Saint-Etienne Cedex (FR)
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Intervener 01:	Cyanamid of Great Britain Limited Bowling Park Drive Bradford, West Yorkshire (GB)
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Intervener 02:	Chemische Fabrik Stockhausen GmbH Patentabteilung Bäkerpfad 25 D-47705 Krefeld (DE)
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Respondent:
(Proprietor of the patent)

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Referring decision: **Interlocutory decision of the Technical Board of Appeal 3.3.2 dated 20 December 1993 in case T 0169/92.**

Composition of the Board:

Chairman: P. Gori
Members: E. Persson
C. Andries
G.D. Paterson
J-C. Saisset
R. Schulte
P. van den Berg

Summary of Facts and Submissions

I. After rejection of the opposition against European patent number 202 780, the (sole) Opponent appealed against the decision of the Opposition Division, requesting full revocation of the patent. During the subsequent appeal proceedings in case T 169/92 before the Technical board of Appeal 3.3.2, two third parties gave, independently of each other, notices of intervention under Article 105 EPC. The Board considered that "the formal requirements" of said provision had been complied with in both cases. However, it noticed that there had in the past been taken opposite views within the Boards of Appeal on the principle issue, whether intervention under Article 105 EPC is admissible at the appeal stage of the proceedings before the EPO. Reference was in this context made to the decisions in appeal cases T 338/89 (EPOR 1991, 268) and T 390/90 (headnote published in OJ EPO 1994, III; EPOR 1993, 424). The Board further noticed that the circumstances of the case before it were on this point similar to those of case T 27/92, where the Technical Board of Appeal 3.2.1 by an interlocutory decision of 8 July 1993 (to be published in OJ EPO) had referred the above principle matter to the Enlarged Board of Appeal (case G 6/93). Since, due to the withdrawal of the intended intervention in case T 27/92, the proceedings before the Enlarged Board in case G 6/93 had been terminated without a decision of the Board, and since in the view of the Technical Board of Appeal 3.3.2 the matter still needed to be clarified in order to ensure uniform application of the law, the Board referred the following question to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC:

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

II. In response to a communication of 26 January 1994 of the Enlarged Board of Appeal, the proper parties to the appeal proceedings in case T 169/92 as well as the two intending interveners filed observations on the referred point of law. Oral proceedings took place on 21 April 1994, Mr. Andrew Waugh of Counsel and Mr. Gerhard Klöpsch respectively speaking for the intending interveners and Mr. Walter Maiwald and Mr. Peter Lawrence respectively for the Opponent (Appellant) and the Patentee (Respondent) in case T 169/92.

III. The intending interveners, strongly supported by the Opponent, submitted that intervention under Article 105 EPC must be admissible even at the appeal stage of the proceedings before the EPO for a number of reasons. In particular, it was argued that such intervention was clearly in line with the main purpose of Article 105 EPC, which was said to be to avoid as far as possible costly and time-consuming revocation proceedings before various national courts by relying on the centralised procedure before the EPO as long as it was within the competence of the EPO to deal with the question of the validity of the patent concerned. It was also asserted that on its proper construction Article 105 EPC, although not explicitly referring to appeal proceedings, must be read to apply as much to the appeal stage of opposition proceedings as to the earlier stage of such proceedings before an Opposition Division. There was said to be clear support for this construction of Article 105 EPC in the *travaux préparatoires* to the Convention. Furthermore, it was contended that it must be in the public interest to admit intervention of the assumed infringer into the appeal proceedings, bearing in mind, *inter alia*, that the EPO would then benefit of being able to consider the evidence on validity which the assumed infringer possesses, which would generally strengthen its decisions and make the European patent system grow in stature.

IV. The Patentee, adopting the views expressed in the decision in case T 390/90 referred to above, contested that intervention under Article 105 EPC should be admissible at the appeal stage of the proceedings before the EPO. With reference being made to the Vienna Convention on the Law of Treaties of 23 May 1969 (the principles of which have been applied in the past by the Enlarged Board of Appeal and the Boards of Appeal) and in particular to the general rule of interpretation laid down in its Article 31, it was submitted that Article 105 EPC should in this respect be interpreted in accordance with the ordinary meaning to be given to the term "opposition proceedings", which in its context of Part V of the EPC could only mean proceedings before an Opposition Division. As to the reference made by the intending interveners and the Opponent to the *travaux préparatoires* to the EPC, the Patentee suggested that, in spite of the various statements made during the preparatory work in favour of admitting intervention at the appeal stage, this matter had in fact been left open to the discretion of the EPO ("Kissinger's compromise"). If the intention really had been to generally admit intervention at the appeal stage, this could easily have been made clear by adding just a few words to Article 105 EPC, which, however, was not done. Further, it was contended by the Patentee that it would not generally be in the public interest to admit intervention at the appeal stage. Article 105 EPC was said not to be the proper tool by which harmonisation of the application of European patent law should be achieved. Such intervention would inevitably delay the proceedings, in particular if "new issues" were brought up, which was said to be contrary to the general interest of speeding them up. The Patentee also submitted that by admitting intervention at the appeal stage, assumed infringers would be able to put a "blight" on European patents for a considerable time by an appropriate timing of interventions under Article 105 EPC. This could lead to serious problems in industry by preventing the proper enforcement of patent rights.

V. In particular at the oral proceedings, some aspects of intervention at the appeal stage were dealt with, which are not strictly covered by the point of law referred to the Enlarged Board of Appeal. One such issue concerned the question, whether an assumed infringer, if allowed in principle to intervene in the appeal proceedings, should be free to raise new grounds for opposition not considered in the previous proceedings. The intending interveners and the Opponent argued strongly in favour of the opinion that an assumed infringer should have a fully independent position in the appeal proceedings and should not be restricted in any way in attacking the patent concerned, while the Patentee submitted that there should in principle not be raised any "new issues" at the appeal stage of the proceedings and that, if nevertheless this should be admitted, the case must be remitted to the first instance for further prosecution.

Reasons for the Decision

1. In its decision in case G 4/91 (OJ EPO 1993, 339, corrected translation, 707), the Enlarged Board of Appeal touched upon the general aspects of intervention under Article 105 EPC at the appeal stage of the proceedings before the EPO as covered by the point of law referred to the Board in the present case. However, due to the limited scope of the question put to the Enlarged Board in case G 4/91, the Board's decision in that case was confined to the finding that if, after issue of a final decision by an Opposition Division, no appeal is filed by a party to the proceedings before the Opposition Division, a notice of intervention which is filed during the two-month period for appeal provided by Article 108 EPC has no legal effect.

2. As noticed in the referring decision, opposite views have in the past been taken within the Boards of Appeal on the principle issue, whether intervention under Article 105 EPC is admissible during pending appeal proceedings. In case T 338/89, the Board considered that such intervention is admissible by virtue of the reference in Rule 66(1) EPC to the provisions relating to the proceedings before the department which has made the decision from which the appeal is brought (here: the Opposition Division), such provisions being applicable to appeal proceedings *mutatis mutandis*. In case T 390/90, the Board ruled out such application of the provisions of Article 105 EPC to appeal proceedings with reference to the different legal character of opposition proceedings and appeal proceedings, the former being administrative and the latter judicial, as explained by the Enlarged Board of Appeal in its decisions in cases G 7/91 and G 8/91 (OJ EPO 1993, 346), and held that intervention under Article 105 EPC in pending appeal

proceedings is inadmissible. In its interlocutory decision in case T 27/92, the Board stated that it did not fully concur with this ruling, which in the Board's view went too far in generalising the implications of the difference in legal character between proceedings before the Opposition Divisions and the Boards of Appeal respectively.

3. The intending interveners were reluctant to rely on Rule 66(1) EPC as a proper legal basis for admitting intervention under Article 105 EPC in appeal proceedings. This would be "very thin ice", as one of them (Cyanamid) put it. Thus, as appears also from the Summary of Facts and Submissions above, the intending interveners were arguing that on its proper construction Article 105 EPC itself provides a much more solid legal basis for admitting such intervention, having regard to the purpose of this provision as explained in the *travaux préparatoires*.

4. The Enlarged Board of Appeal shares the view that the reference in Rule 66(1) EPC to the provisions relating to the proceedings before the first instance, in this context the Opposition Division, is not a sufficient legal basis for the application of Article 105 EPC to appeal proceedings *mutatis mutandis*. The scope of said reference must in view of the structure of the EPC be considered to be limited to such provisions, which are contained in the Implementing Regulations. Thus, the basic provisions of Article 105 EPC are not covered by said reference. The only Rule which deals with intervention under Article 105 EPC is Rule 57(4) EPC. However, this Rule merely provides for a possibility to dispense with certain formal requirements in case of intervention in opposition proceedings and does not shed any light on the principle issue at stake. The question whether intervention under Article 105 EPC is

admissible, can therefore only be answered by means of interpretation of said provision itself.

5. The wording of Article 105 EPC is confined to "opposition proceedings" and does not mention the term "appeal proceedings". However, as emphasised particularly by one of the intending interveners (Cyanamid), this does not necessarily mean that said provision does not apply also to appeal proceedings, since under the structure of the EPC there are clear examples of provisions, which apply to appeal proceedings, although only the term opposition proceedings is explicitly mentioned. One such example referred to is Article 68 EPC, dealing with the effect of revocation of European patents. In its context, it is obvious that the reference in said provision to the extent that a patent has been revoked in opposition proceedings must extend to any subsequent appeal proceedings.

6. However, it is not equally clear as in the above example that the term opposition proceedings in Article 105 EPC must extend to appeal proceedings. In this respect, it is to be noted that Article 105 EPC is one of the provisions of Part V of the EPC, which is specially directed to the opposition procedure. It may therefore be argued, as indeed the Patentee did, that the provisions of this part of the EPC only apply to appeal proceedings if there is an explicit reference to such proceedings, as in the case of costs in Article 104(1) EPC.

7. As to the purpose of the provisions of Article 105 EPC, it is common ground that by relying on the centralised procedure before the EPO in cases where infringement and revocation proceedings otherwise would have to be simultaneously pursued before national courts, an

unnecessary duplication of work can be avoided, reducing also the risk of conflicting decisions on the validity of the same patent. This speaks no doubt with considerable force in favour of admitting intervention of assumed infringers even at the appeal stage of the proceedings before the EPO. However, the argument put forward by the Patentee, that such intervention may easily lead to procedural complications and delay in deciding upon the validity of the patent in suit, cannot be ignored either. Thus, even in the light of its object and purpose, there is still some ambiguity as to the interpretation of Article 105 EPC in respect of intervention in appeal proceedings.

8. In this situation, the Enlarged Board of Appeal considers it appropriate to have recourse to the *travaux préparatoires* to the EPC in order to arrive at a final conclusion. It appears that the preparatory work of the EPC clearly supports the submissions of the intending interveners as to the interpretation to be given to Article 105 EPC. Already when it was first decided to introduce a provision corresponding to the present Article 105 EPC, it was generally agreed that intervention in principle should be admissible also at the appeal stage of the proceedings before the EPC (see BR 144d/71), and this opinion was, although sometimes challenged by interested circles (see BR 177d/72), maintained throughout the preparation of the EPC by the delegates of the States participating to the Governmental Conference for the setting up of the EPC. The problem which could arise out of late intervention in respect of delay of the proceedings was considered during the preparatory work but it was not accepted as a reason for rejecting such intervention even at the appeal stage of the proceedings. However, in order to meet this problem, the present Rule 57(4) EPC was introduced, making it possible to apply a simplified

procedure (see BR 209d/72). Article 105 EPC was discussed and given its final text at the Diplomatic Conference in Munich in 1973; no change was made in respect of the issue at stake before the Enlarged Board in the present case (see M/PR/I, p. 49-50).

9. Against this background, the submission of the Patentee that the question of admissibility of intervention under Article 105 EPC in appeal proceedings was intended by the legislator to be left open and to be decided within the EPO, cannot be sustained. In the view of the Enlarged Board, there can be no doubt that the intention was to admit such intervention under the terms of that provision.

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

11. As indicated in paragraph V of the Summary of Facts and Submissions, some aspects of intervention in appeal proceedings were dealt with during the proceedings before the Enlarged Board in the present case, which are not strictly covered by the point of law referred to it. Most of these matters, such as whether an intervener in appeal proceedings has to pay an opposition fee as prescribed by Article 105(2) EPC or an appeal fee or possibly both, were only touched upon by the parties, and the Enlarged Board does not consider it appropriate in the present context to forestall a consideration of

such matters, should they arise in individual cases, by the Boards of Appeal on the basis of a full exchange of views of the parties concerned.

12. One point, however, which was fully argued before the Enlarged Board in the present case and which needs to be clarified in this context because of its close connection with the principle issue of intervention in appeal proceedings, is the question, whether an assumed infringer may raise new grounds for opposition, which have not been considered in the previous proceedings before the Opposition Division. As appears from paragraph V of the Summary of Facts and Submissions, the intending interveners and the Patentee took contrary views on this matter.

13. As explained by the Enlarged Board of Appeal in its opinion in case G 10/91 (OJ EPO 1993, 420), the purpose of the appeal procedure *inter partes* is mainly to give the losing party a possibility to challenge the decision of the Opposition Division on its merits, and it is not in conformity with this purpose to consider grounds for opposition on which such decision has not been based. The raising of new grounds for opposition by an assumed infringer, intervening in appeal proceedings, certainly does not fit with this basic concept of the appeal procedure. However, the purpose of intervention is to allow the assumed infringer to defend himself against the Patentee's action. Therefore, to prevent him from making use of all available means of attacking the patent, which he is accused of infringing, including the raising of new grounds for opposition under Article 100 EPC not relied upon by the proper Opponent, would run contrary to this purpose of intervention. Furthermore, this would involve the risk of conflicting decisions on the validity of European patents in the EPO and national courts, such decisions being based on different facts

and grounds. Therefore, the Enlarged Board takes the view that intervention under Article 105 EPC in pending appeal proceedings may be based on any ground for opposition under Article 100 EPC. However, in application of what has been stated by the Enlarged Board in case G 10/91 for the exceptional situation of the introduction of new grounds in ordinary appeal proceedings, if a fresh ground for opposition is raised by the intervener, the case should be remitted to the first instance for further prosecution, unless special reasons present themselves for doing otherwise, for example when the Patentee himself does not wish the case to be remitted.

Order

For these reasons, it is decided that:

The question of law referred to the Enlarged Board of Appeal is to be answered as follows:

> Intervention of the assumed infringer under Article 105 EPC is admissible during pending appeal proceedings and may be based on any ground for opposition under Article 100 EPC.

The Registrar: The Chairman:

J. Rückerl P. Gori