

Interlocutory decision of Technical Board of Appeal 3.2.5 dated 27 October 2004

T 1007/01 - 3.2.5

(Translation)

Composition of the board:

Chairman: W. Moser
Members: W. Widmeier
P.E. Michel

Patent proprietor/respondent: EOS GmbH Electro Optical Systems

Opponent/appellant: 3D Systems, Inc.

Headword: Intervention/EOS

Article: 105, 107, 108, 112(1)(a) EPC

Keyword: "Intervention in appeal proceedings" - "Continuation of proceedings after withdrawal of sole appeal" - "Referral to Enlarged Board of Appeal"

Headnote

Under Article 112(1)(a) EPC the following points of law are referred to the Enlarged Board of Appeal for decision:

I. After withdrawal of the sole appeal, may the proceedings be continued with a third party who intervened during the appeal proceedings?

II. If the answer to question I is yes:

Is entitlement to continue the proceedings conditional on the intervener's compliance with formal requirements extending beyond the criteria for an admissible intervention explicitly laid down in Article 105 EPC; in particular, does the appeal fee have to be paid?

Summary of facts and submissions

I. On 21 August 2001, the appellant (opponent) filed an appeal against the opposition division's interlocutory decision, posted on 22 June 2001, maintaining European patent No. 0 734 842 in amended form. It paid the appeal fee at the same time.

II. On 30 January 2004, a written reasoned notice of intervention under Article 105 EPC was filed, together with proof that on 3 December 2003 a licensee duly authorised to do so by the respondent (patent proprietor) had instituted infringement proceedings against the intervener. The latter paid the opposition fee when filing the notice of intervention, and the appeal fee on 5 February 2004.

III. On 6 February 2004, the appellant withdrew its appeal.

IV. The oral proceedings scheduled for 20 April 2004 were cancelled, given the points of law referred to the Enlarged Board of Appeal by interlocutory decision T 1026/98 (OJ EPO 2003, 441).

V. In a communication dated 23 July 2004 the board informed the parties that the referral to the Enlarged Board of Appeal (case No. G 4/03) was no longer pending following withdrawal of the intervention in case T 1026/98, and that the board intended to make a new referral to the Enlarged Board to clarify the legal position of an intervener in appeal proceedings if the appeal is withdrawn.

VI. On 24 September 2004 the respondent informed the board that it agreed to such a new referral, but did not otherwise comment on the points at issue.

VII. On 5 October 2004 the intervener informed the board that it endorsed the intervener's submissions in case T 1026/98, to which it did not intend to add.

Reasons for the decision

1. At the time of the intervention, the appeal proceedings were pending. The intervention also fulfils the requirements of Article 105 EPC and is therefore admissible.

2. The circumstances of the present case – intervention followed by withdrawal of the appeal – are the same as in T 1026/98, and thus raise the same issues as regards continuation of the proceedings after the appeal is withdrawn.

3. As already stated in interlocutory decision T 1026/98 (Reasons 1), appeal proceedings are normally terminated when the sole appeal is withdrawn, and there is then no need to decide on the substantive issues (G 8/91, OJ EPO 1993, 346). The question in the present case, as in T 1026/98, is whether the situation is different if there was a valid intervention during the appeal proceedings.

The case law does not give a clear answer to this question.

4. The board endorses the statement in interlocutory decision T 1026/98 (Reasons 2.1) that recent rulings have been based on G 4/91 (OJ EPO 1993, 707) in which the Enlarged Board decided that third parties were not entitled to intervene or to appeal against the opposition division's decision during the appeal period provided for in Article 108 EPC – even if the other conditions for intervention were satisfied – if none of the parties to the opposition proceedings had challenged that decision, because in the absence of such an appeal the proceedings were no longer pending when the notice of intervention was filed.

In G 1/94 (OJ EPO 1994, 787) the Enlarged Board ruled that intervention during appeal proceedings was admissible. It is silent as to whether the intervener must pay the appeal fee.

5. As further stated in interlocutory decision T 1026/98 (Reasons 2.2), after the question referred in G 1/94 had been answered, the appeal fee in the case which had led to referral G 6/93 (settled without a decision) was refunded because it was not needed to make the intervention valid (T 27/92 dated 25 July 1994, quoted in "Case Law of the Boards of Appeal of the EPO", 4th (2001) edition, VII.D.5.4.2); for the sake of legal certainty, intervention could not be made subject to any requirements other than those laid down in Article 105 EPC.

6. In T 1011/92 dated 16 September 1994 (cited in "Case Law", loc. cit.), the board ruled that an intervener in appeal proceedings – just like an opponent adversely affected by an opposition division's decision – must pay both the opposition and the appeal fee if he is seeking appellant status in his own right so that he can continue the proceedings even if the sole appeal is withdrawn (Reasons 3.3 ff). However, in the present board's view, that does not mean that this decision held that a valid intervention during appeal proceedings was conditional upon payment of both the opposition and appeal fees.

7. The board refers further to the decisions cited in T 1026/98 (Reasons 2.3), which conclude that the appeal fee does not have to be paid to make intervention during appeal proceedings admissible (T 195/93 of 4 May 1995, cited in "Case Law", loc. cit. (Facts II ff); T 467/93 of 13 June 1995, not published in OJ EPO (Reasons 2); T 684/92 of 25 July 1995, not published in OJ EPO (Reasons 2); T 471/93 of 5 December 1995, cited in "Case Law", loc. cit. (Reasons 2.5 ff); T 590/94 of 3 May 1996, cited in "Case Law", loc. cit. (Reasons 2.5); T 144/95 of 26 February 1999, cited in "Case Law", loc. cit. (Reasons 2.8); T 1001/97 of 25 January 2000, not published in OJ EPO (Reasons 6); T 989/96 of 5 July 2001 and T 886/96 of 6 July 2001, both cited in Case Law of the Boards of Appeal of the EPO in 2001, Special edition of the Official Journal 2002, p. 76), and to the decision concluding that the intervener must pay the appeal fee (T 517/97, OJ EPO 2000, 515, Facts IV, and Reasons 2 and 9).

Lastly, as stated in T 1026/98 (Reasons 2.4), the question arises of whether an intervener can acquire independent appellant status by voluntarily paying the appeal fee. T 27/92, T 471/93, T 590/94 and T 1001/97 touched on this, but left it open because it was not material to the decision. T 144/95, T 989/96 and T 886/96, on the other hand, rejected this possibility on the grounds that the intervener did not meet the requirements of Article 107, first sentence, EPC and that the time limit for paying the appeal fee set out in Article 108 EPC had expired.

8. In the present case, as in T 1026/98, the case law affords no clear answers as to the legal status of an intervener in appeal proceedings after withdrawal of the appeal.

With the case law still either silent or contradictory on the status of interveners in appeal proceedings, legal uncertainty continues to prevail. The board is therefore referring anew to the Enlarged Board the points of law previously submitted in T 1026/98.

Order

For these reasons it is decided that:

Under Article 112(1)(a) EPC the following points of law are referred to the Enlarged Board of Appeal for decision:

I. After withdrawal of the sole appeal, may the proceedings be continued with a third party who intervened during the appeal proceedings?

II. If the answer to question I is yes:

Is entitlement to continue the proceedings conditional on the intervener's compliance with formal requirements extending beyond the criteria for an admissible intervention explicitly laid down in Article 105 EPC; in particular, does the appeal fee have to be paid?