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**Datasheet for the decision
of 13 July 2006**

Case Number: T 1108/02 - 3.3.04

Application Number: 90308718.7

Publication Number: 0430402

IPC: C12Q 1/68

Language of the proceedings: EN

Title of invention:

Methods and compositions for chromosome-specific staining

Patentee:

The Regents of the University of California

Opponents:

- (01) Cytocell Ltd.
- (02) DakoCytomation GmbH
- (03) DakoCytomation Denmark A/S

Headword:

Chromosome/REGENTS

Relevant legal provisions:

EPC Art. 105, 112(3),
RPBA Art. 10a, 16

Keyword:

"Intervener 1 - admissibility of intervention during appeal proceedings (yes)"
"Intervener 2 - admissibility of intervention during appeal proceedings - first intervention (no) - second intervention (yes)"
"Decision G 0003/04 - immediately applicable (yes)"
"Exceptional circumstances needed for renewed referral of the same question - none present"
"Referral of question of law to Enlarged Board of Appeal (no)"
"Proceedings terminated by withdrawal of sole appeal by proprietor - despite interventions (yes)"

Decisions cited:

G 0001/84, G 0001/86, G 0002/91, G 0004/91, G 0008/91,
G 0009/91, G 0010/91, G 0009/92, G 0009/93, G 0001/94,
G 0003/04, T 1026/98, T 0694/01, T 1007/01

Catchword:

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Case Number: T 1108/02 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 13 July 2006

Appellant: The Regents of the University
(Patent Proprietor) of California
300 Lakeside Drive,
22nd Floor
Oakland,
California 94612-3550 (US)

Representative: Fisher, Adrian John
CARPMAELS & RANSFORD
43-45 Bloomsbury Square
London WC1A 2RA (GB)

Respondent: Cytocell Ltd.
(Opponent 1) Unit 6, Somerville Ct., Trinity Way
Adderbury, Oxon OX17 3SN (GB)

Representative: Lipscombe, Martin John
Nash Matthews
90-92 Regent Street
Cambridge CB2 1DP (GB)

Intervener 1: DakoCytomation GmbH
(Opponent 2) Hamburger Straße 181
D-22083 Hamburg (DE)

Representative: Zimmer, Franz-Josef
Grünecker, Kinkeldey
Stockmair & Schwanhäusser
Anwaltssozietät
Maximilianstraße 58
D-80538 München (DE)

Intervener 2
(Opponent 3)

DakoCytomation Denmark A/S
Produktionsvej 42
DK-2600 Glostrup (DK)

Representative:

Zimmer, Franz-Josef
Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
Anwaltssozietät
Maximilianstraße 58
D-80538 München (DE)

Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 August 2002 concerning maintenance of the
European Patent No. 0430402 in amended form.**

Composition of the Board:

Chairman: S. Perryman
Members: G. Alt
R. Gramaglia

Summary of Facts and Submissions

- I. European patent 430 402 entitled "Methods and Compositions for Chromosome-specific Staining" was granted to The Regents of the University of California (Proprietor/Appellant) on 27 January 1999 with four claims.
- II. The patent was opposed by Cytocell Limited (Respondent/opponent 1) on 26 October 1999 requesting revocation in full on the grounds of Article 100(a) (specifically under Articles 54 and 56 EPC) and 100(c) EPC.
- III. At oral proceedings before it on 20 March 2002, the Opposition Division gave the interlocutory decision, confirmed in its written decision posted 20 August 2002, that the patent could be maintained on the basis of claims 1-4 of first auxiliary request and the amended pages of the description, both filed on 20 March 2002. In the written reasons it indicated that claim 1 of the main request filed on 20 March 2002 did not meet the requirements of Article 123(2) EPC, but that the claims of the first auxiliary request filed on 20 March 2002 and the description with amended pages filed on 20 March 2002 did meet the requirements of Articles 123(2), 54 and 56 EPC.
- IV. On 29 October 2002 a notice of appeal was filed by the Proprietor impugning the decision under appeal to the extent that the claims of the main request were found to contravene the requirements of Article 123(2) EPC, and the appeal fee was paid. Grounds of appeal were filed on 24 December 2002.

V. On 3 June 2005 an intervention under Article 105 EPC was filed on behalf of DakoCytomation GmbH (Intervener 1/opponent 2) accompanied by a written reasoned statement setting out the grounds of invalidity on the basis of which Intervener 1 was requesting revocation of the patent and with supporting evidence showing that infringement proceedings before the Landgericht Düsseldorf (Az.: 4b O 476/04) had been instituted against Intervener 1 on 4 March 2005 under German patent DE 690 32 920 T2 corresponding to European patent 430 402. At the same time, the opposition fee and the appeal fee were paid. Oral proceedings were asked for if the Board could not follow the request for revocation.

VI. On 23 June 2005 a first intervention under Article 105 EPC was filed on behalf of DakoCytomation Denmark A/S (Intervener 2/opponent 3) accompanied by a written reasoned statement setting out the grounds of invalidity on the basis of which Intervener 2 was requesting revocation of the patent. It was stated that Intervener 2 was entitled to join the appeal procedure since they had instituted proceedings for a court ruling that they do not infringe European patent 430 402 by serving a respective complaint to the Patentees Representative in Italy on March 23, 2005, accompanied by a copy of receipt from "Tribunale di Milano" indicating March 23, 2005 as the day when the complaint was served. Oral proceedings were asked for if the Board could not follow the request for revocation.

VII. By a communication dated 23 September 2005, the Board drew the parties attention to the following:

- Enlarged Board of Appeal Decision G 3/04 of 22 August 2005 (OJ EPO 2006, 118) was immediately relevant to the present interventions in that it held that someone intervening at the appeal stage need only pay the opposition fee as laid down in Article 105 EPC, but not any appeal fee. Thus there was no legal basis for the payment of an appeal fee by the interveners and any such appeal fee actually deducted pursuant to the respective debit orders would be repaid.

- Enlarged Board of Appeal Decision G 3/04 was potentially relevant as the Enlarged Board had held that appeal proceedings cannot be continued only with interveners who joined at the appeal stage, if the sole appellant withdraws his appeal.

- The appeal by the Proprietor appeared prima facie admissible.

- The intervention filed on behalf of Intervener 1 appeared prima facie to meet the requirements of Article 105 EPC.

- Doubts existed as to whether the intervention filed on behalf of Intervener 2 met the requirements of Article 105 EPC. No evidence had been submitted to show that infringement proceedings had been instituted against Intervener 2 or that the latter had been requested to cease an alleged infringement. While the infringement suit instituted against Intervener 1 mentioned also Intervener 2 there was nothing to

indicate that the suit had been served on Intervener 2. It was not clear that there had been a request to Intervener 2 to cease an alleged infringement. Further should for the purpose of Article 105 EPC any request to cease infringement relate to the same court jurisdiction as that in which proceedings had been instituted for a ruling that the intervener was not infringing the patent?

- The Proprietor, the Respondent (opponent 1) and the Interveners 1 and 2 were given a period of four months to comment on the issues raised by the Board.

VIII. On 11 January 2006 a second intervention under Article 105 EPC was filed on behalf of Intervener 2 accompanied by a written reasoned statement setting out the grounds of invalidity on the basis of which revocation of the patent was requested, and the opposition fee was paid. It was now stated that Intervener 2 was entitled to join the appeal procedure by virtue of the service on October 12, 2005 of a complaint relating to infringement proceedings before the Landgericht Düsseldorf (Az.: 4b O 476/04) relating to infringement of European patent 430 402, as shown by enclosures. Oral proceedings were asked for if the Board could not follow the request for revocation.

IX. On 18 January 2006 the Proprietor withdrew its appeal against the decision of the Opposition Division.

X. In a communication dated 19 January 2006, the Board indicated, referring to its communication of 23 September 2005 and Decision G 3/04 of the Enlarged

Board of Appeal, that the withdrawal of the appeal terminated the proceedings, including the interventions, and that it would be closing its file.

- XI. By letter of 1 February 2006 it was asked, with detailed reasoning (see XIX below) on behalf of Interveners 1 and 2 that the Board not follow the holding of decision G 3/04 or in the alternative to refer the case to the Enlarged Board of Appeal anew.
- XII. In a communication dated the 3 February 2006, the Board indicated its provisional opinion as being as follows:
- Enlarged Board of Appeal Decision G 3/04 to the effect that with the withdrawal of the sole appeal, the proceedings cannot be continued with an intervener who intervened during the appeal proceedings, was directly applicable to the present proceedings. The Board then had either to follow that decision and treat the present proceedings as terminated, or if it wished to deviate from decision G 3/04, refer the question anew to the Enlarged Board of Appeal.
 - It was noted, as argued on behalf of the Interveners, that in the referral case giving rise to decision G 3/04, it was an opponent who was the sole appellant. But the order made by the Enlarged Board, and its reasoning did not attach any significance and were not limited to the sole appeal being by an opponent, but applied equally to the case where the appeal is by the patentee. Given that the point of law involved had just been settled by the Enlarged Board of Appeal, in a way

with which this Board agreed, it saw no reason under Article 112 EPC to refer this just settled question anew, and thus cause legal uncertainty.

- The Board proposed to take a decision on whether decision G 3/04 applied, and whether any question should be referred to the Enlarged Board of Appeal. If any party wished first to be heard on this at oral proceedings, or make any written submissions these should be made within 2 months.

XIII. By letter of 28 March 2006 the Proprietor indicated that it agreed with the provisional view expressed in the Board's communication of 3 February 2006. Quite apart from the point of law already being settled by decision G 3/04, the Interveners' arguments were fundamentally flawed in that they were seeking a right which according to decision G 9/92 (OJ EPO 1994, 875) was not available to a Board of Appeal or to a non-appealing opponent as a party of right under Article 107 EPC. The Interveners were thus arguing that they were entitled to the rights of an appealing opponent, even though they themselves did not oppose the patent and even though the actual opponent in the case had not appealed. Oral proceedings were asked for should the Board differ from the preliminary opinion expressed in the communication of 3 February 2006.

XIV. By letter received on 29 March 2006 oral proceedings were requested on behalf of the Interveners, and the opportunity to file a response to any brief filed by the Proprietor in response to the communication of 3 February 2006.

XV. On 7 April 2006 a Summons to oral proceedings set for 13 July 2006 was issued, accompanied by a communication in which the Board indicated that:

- The sole subject to be discussed was whether the Board should follow decision G 3/04 or refer a question of law to the Enlarged Board of Appeal.
- The preliminary view of the Board remained that it should follow decision G 3/04 and conclude that the present proceedings terminated on the withdrawal of the appeal. The reason, in a nutshell, was that Article 105 EPC was seen as being intended to give someone, who did not himself oppose but was later sued for infringement, the right not to be excluded from pending appeal proceedings, but not an independent right to have his case considered by the EPO if otherwise the appeal would be terminated.
- The argument that someone sued for infringement, might have to defend himself separately in each Contracting State in which he was sued, was not considered by the drafters of the EPC sufficiently weighty to give such a person an absolute right to file an opposition outside the normal opposition period of nine months. There thus seemed no strong reason to treat this argument as sufficiently weighty to keep the appeal proceedings pending when none of the parties to the original opposition proceedings wished this.

XVI. By letter of 19 May 2006 it was indicated that the Proprietor would not be represented at the oral

proceedings and the following additional comments were made:

- The only subject for the oral proceedings was whether to refer a question of law to the Enlarged Board of Appeal, the relevant question being whether the Enlarged Board's decision in G 3/04 should be applied to a case in which the sole appeal is by the proprietor. There was plainly no justification for referring this question to the Enlarged Board unless there was reason to believe that the Enlarged Board might not have intended its decision to be applicable to such a case.
- In G 3/04, the Enlarged Board of Appeal commented that G 8/91 (OJ EPO 1993, 346) did not answer the question whether an intervener having validly filed a notice of intervention during appeal proceedings before the withdrawal of the sole appeal can continue the proceedings, at least with regard to the new grounds for opposition which were not raised at first instance (see point 8 of the reasons, final sentence). However, in point 9 of the reasons for its decision, the Enlarged Board considered that this question was answered by G 9/92, which it described as going further than the decisions in G 2/91 (OJ EPO 1992, 206) and G 8/91. The Enlarged Board concluded that G 9/92 "can be applied to all parties who are not appellants, i.e. also to interveners under Article 105 EPC".
- G 9/92 dealt explicitly with the case in which the sole appellant was the patent proprietor. It was

therefore unimaginable that the Enlarged Board in G 3/04, having relied on G 9/92 in the crucial part of its decision, failed to consider the situation in which the sole appellant is the proprietor.

- For these reasons, it was submitted that the Enlarged Board in G 3/04 fully intended its ruling to be applicable to cases in which the sole appeal was withdrawn, including cases in which the sole appellant is the patent proprietor.

XVII. No submissions were made on behalf of the Respondent.

XVIII. By letter of 13 June 2006 further comments were made on behalf of the Interveners and the following two questions were put forward for referral to the Enlarged Board of Appeal:

1. "Does G3/04 also apply to any appeal proceedings where the sole appellant is the patentee who started a law suit in at least one of the designated countries against the intervening party and withdraws his appeal after the admissible intervention ?"

If the answer to (1) is no

2. "What are the criteria that the appeal proceedings may continue after withdrawal of the appeal by the sole appellant ?"

XIX. The submissions made on behalf of the Interveners in writing and at the oral proceedings, in so far as they

are relevant for the present decision, can be summarized as follows:

(a) G 3/04 need not be followed

- Decision G 3/04 should not be applied to the present case which was initiated before this decision issued. This would be in line with decision G 9/93 (OJ EPO 1994, 891) which acknowledges in item 6.1 that ". . .on purely procedural issues there may be reasons of equity for not applying to pending cases the law as thus interpreted". The intervener/defendant firmly believed when joining the pending appeal proceedings that he would have full appellant status independently of how the patentee might behave. The defendant was taken by surprise that the present appeal proceedings should be terminated for him in view of patentee's strategy to withdraw his appeal after having learnt of G 3/04.

- Decision G 3/04 was binding only for the referral proceedings T 1007/01 (OJ EPO 2005, 240) in which the question of law was asked and had no binding effect on the Appeal Board in the present case anyway (Cf. Art. 112(3) EPC).

(b) Situations justifying referral anew

- It would not be the first time that a previously given opinion by the Enlarged Board of Appeal would be modified or even completely reversed by a

younger opinion as for example the decision G 1/84 (OJ EPO 1985, 299) which allowed the filing of an opposition by the patentee and which opinion then was overruled by decision G 9/93 wherein it was held that the patentee cannot lodge an opposition against his patent. Several years of practice developed between opinion G 1/84 and G 9/93. The sooner "fine tuning" of a once given opinion was performed the better for legal certainty among the users of the EPO. The result of G 3/04 needed further "fine tuning" to the extent that it needed to be clarified that the appeal proceedings were not always terminated where the sole appellant was a patentee who first sued a party and then after the party had joined proceedings before the EPO patentee withdrew the appeal.

(c) *Travaux préparatoires*

- There was clear evidence in the *travaux préparatoires* that Article 105 EPC was intended to give the defendant in a patent infringement lawsuit the chance to fully defend himself by attacking the validity of the European patent in question by joining pending opposition proceedings before the EPO rather than having to go through several national invalidation proceedings.

- It was originally the French Delegation which made the proposal that an assumed patent infringer should be given the right to join opposition proceedings. According to the Report on the 10th Meeting of Working Group I in Luxembourg from

November 22 through November 26, 1971, the French Delegation was quoted (No. 75):

"Hiermit sollte erreicht werden, dass der vermeintliche Patentverletzer nicht gezwungen ist, vor den Gerichten der benannten Vertragsstaaten Nichtigkeitsklage zu erheben, während noch ein zentrales Einspruchsverfahren anhängig ist. Dadurch würde sowohl Zeit gewonnen als auch die Gefahr so weit wie möglich verringert, dass widersprüchliche Entscheidungen ergehen."

"By this, it should be achieved that the assumed patent infringer is not forced to raise nullity suits in the Courts of the designated country while a central opposition proceeding is pending. That way time would be saved and the risk would be excluded as far as possible that contradictory decisions were rendered."

- The Working Group agreed with the French proposal. It was also agreed (No. 79) that the assumed infringer shall have the right to join opposition proceedings if they are at the appeal stage, because the appeal proceedings were regarded to be part of the opposition proceedings.

- Also, in the report on the Munich Diplomatic Conference, Munich, September 10 through October 5, 1973, it was stated by the President (at No. 421):

"Artikel 104 sollte einen Dritten, gegen den der Patentinhaber erst nach Ablauf der Einspruchsfrist Verletzungsklage erhoben habe, davor bewahren,

Nichtigkeitsklagen vor mehreren nationalen Gerichten erheben zu müssen."

"Article 104 shall protect a third party, against whom the patentee has initiated infringement proceedings after the opposition period has expired, to file revocation actions in several national courts."

- No delegation of any government was against the respective provision and it was consequently accepted.

(c) Article 105 EPC and G 1/94

- The primary goals of Art. 105 EPC to assist the assumed patent infringer would be jeopardized if the patentee/appellant were provided with the right to withdraw the appeal, thus terminating also the appeal with respect to the intervening party. The history of the current Art. 105 EPC taught that the accused infringer shall be afforded a strong and effective means to have the EPO decide on the validity of the patent, instead of initiating revocation actions in the national courts.
- Decision G 1/94 (OJ EPO 1994, 787) was in line with these goals since it held that intervention was admissible during pending appeal proceedings and may be based on any ground for opposition under Art. 100 EPC. By doing so, costly and time-consuming revocation proceedings before various national courts were avoided as far as possible by

relying on the centralized procedure before the EPO.

- The preparatory work of the EPC clearly supported the position that the assumed infringer may also join during pending appeal proceedings (cf. the detailed analysis in G 1/94, Reasons 8). The Enlarged Board of Appeal in G 1/94 was even aware of the problem which could arise out of late intervention in respect of delay of the proceedings, but it was not accepted as a reason for rejecting such intervention even at the appeal stage.

- Even further in G 1/94 the Enlarged Board of Appeal held that the intervening party during appeal proceedings may raise new grounds for opposition which had not been considered in the previous proceedings before the Opposition Division. Even though acknowledging that raising of new grounds for opposition would certainly not fit with the basic concept of appeal proceedings, it nevertheless decided to allow the intervening party to raise them, because the purpose of intervention was 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 Art. 100 EPC not relied upon by the proper opponent, would run contrary to this purpose of intervention and 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. (G 1/94, Reasons 13)

- It was almost impossible to bring the holding of G 3/04 into conformity with the reasoning in G 1/94. Decision G 1/94 was convincing in that it interpreted Article 105 EPC by taking into consideration the travaux préparatoires to the EPC. As opposed to this, in G 3/04 no consideration of the *travaux préparatoires* to the EPC appears. Taking into consideration the aforementioned *travaux préparatoires*, decision G 3/04 should be re-examined by the Enlarged Board of Appeal, taking into consideration, in particular, that the purpose of intervention – as correctly described in decision G 1/94, Reasons 13 – cannot be achieved if the patentee/appellant, by withdrawing its appeal, is given an effective tool to take away the means of the assumed infringer to intervene in opposition proceedings and even raise new grounds for opposition under Art. 100 EPC.

Reasons justifying new referral

- The intervening party in decision G 3/04 had, for whatever reason, not submitted any arguments (Facts XV.).
- It cannot be justified that an assumed infringer who joins during appeal proceedings is granted less rights than an assumed infringer who joins the opposition proceedings at the first instance opposition stage. If the decision of the

Opposition Division adversely affects the intervening party, said party may appeal in accordance with Art. 107 EPC (cf. G 3/04, Reasons 4.); in any case, that is even if the decision rendered by the Opposition Division does not adversely affect the intervening party, it is – automatically – "any other party" in the meaning of Art. 107 Sentence 2 EPC (cf. G 3/04, Reasons 4).

- Decision G 1/86 (OJ EPO 1987, 447) is understood as teaching that in appeal proceedings subject to the EPC, as far as factual or legal situations are comparable, all parties to proceedings were to be treated equally. According to this decision (Reasons 13) it is one of the fundamental principles prevailing in all EPC Contracting States that all parties to proceedings before a Court must be accorded the same procedural rights. In essence, this finding derives from the general principle of equality before the law. Although decision G 1/86 said that there may be reasons for differentiation between applicants, patent proprietors and opponents, it was not justifiable to distinguish between intervening parties depending on when they joined the opposition proceedings (i.e., during the first instance opposition stage or during the second instance appeal stage).

- It was important to note that the three-month period according to Art. 105(1) EPC commenced on the date on which the infringement proceedings were instituted. Consequently, the intervening party (assumed infringer) did not have a choice to

either join during opposition or appeal proceedings, but rather this was under the control of the patentee depending on when the latter instituted proceedings for infringement. As a consequence, to distinguish between an intervening party joining during opposition proceedings and one joining during appeal proceedings was arbitrary, as joining was outside of the control of the intervener.

- Decision G 3/04 produced different results for an intervener joining during the proceedings before the opposition division if a sole opposition was withdrawn, namely the intervener could continue as opponent, compared to the effect on an intervener joining only during appeal proceedings where the withdrawal of the sole appeal by an opponent ended the proceedings also for an opponent. This seemed arbitrary as intervener had no influence whatsoever on when it can join the proceedings.

- Decision G 3/04 strongly relied on decision G 9/92 which indeed held that appeal proceedings were terminated when the (sole) appeal had been withdrawn, in which case there was no power for the Board of Appeal to continue the proceedings (cf. Reasons 6). This decision should not have been treated as relevant as no account had been taken in G 9/92 of proceedings where there was an intervener.

- Decision G 3/04 (cf. Reasons 6) also regarded decision G 4/91 (OJ EPO 1993, 707) to be an important precedent in that the latter is

interpreted to state: "Art. 107 Sentence I EPC does not provide to the party intervening during appeal proceedings the right to appeal, and consequently neither the status of an appellant". Decision G 4/91 does not teach the above, the only question to be decided in G 4/91 being whether an assumed infringer may validly initiate proceedings by filing the notice of intervention during the period for appeal in circumstances where neither the patentee nor the (only) opponent filed an appeal.

- In decision G 3/04, it was the opponent who lodged – and later withdrew – the appeal, whereas in the case at hand it was the patentee who filed – and later withdrew – it. This made a substantial difference. If one allowed the patentee/appellant to terminate the appeal proceedings also with respect to an assumed infringer who was sued by the very same patentee during appeal proceedings (and joined the opposition proceedings at the appeal stage), then the right to intervene would be worth little, if nothing. The patentee/appellant would gain full control over the appeal proceedings and could easily deprive the intervening party of the rights it shall have according to the *travaux préparatoires*, simply by withdrawing the appeal. This would have the unfortunate and unfair effect for the interveners that they needed to file entirely new revocation proceedings with the national courts. The patentee/appellant should not be allowed to take away the rights granted to the alleged infringers under Art. 105 EPC as this would conflict with the

strong position that was sought to be given to the intervening party.

- The patentee/appellant, on the other hand, merits no protection. When the patentee/appellant filed the law suits, the outcome of case G 3/04 was still pending, i.e. the plaintiff/patentee needed to anticipate that if it sued two parties during appeal proceedings, these parties would eventually (in accordance with prior decision G 1/94) not only join the appeal proceedings, but also take the opportunity to raise new grounds of opposition, as done by the Interveners.

- Moreover, the plaintiff/patentee always needed to anticipate that – in accordance with decision G 1/94, Reasons 13 – the case could be remitted to the first instance for further prosecution since both assumed infringers/intervening parties raised new grounds of opposition. That is the patentee/appellant needed to anticipate that the Board of Appeal would remit the case to the Opposition Division because the Opposition Division has not had the opportunity to discuss the lack of an enabling disclosure, as is argued for the first time ever during appeal. Had the Appeal Board remitted the case to the Opposition Division before withdrawal by the patentee/appellant, then, quite clearly, we would deal with an opposition proceeding, so that the holding of decision G 3/04 would not apply. Rather, then, the assumed infringers needed to be treated as opponents, and the patentee would not have any chance whatsoever to drive the assumed infringer

out of the proceedings. There was no reason why the rights of the intervening party should depend on whether the Board of Appeal remits the case quickly enough to the Opposition Division, thus avoiding that the appellant/patentee terminates the appeal proceedings for good.

- The consequences of G 3/04 are particularly hard for alleged infringers in jurisdictions which do not allow them to be heard before the infringement court with the argument that the allegedly infringed patent is invalid, e.g. in Germany. Further, at least in Germany, the alleged infringer has no choice but to join a pending appeal proceeding before the EPO in order to attack the validity of the patent as a defence to the law suit installed against him. Both such proceedings, the Appeal Proceedings and the infringement proceedings, were started by the patentee. There is no reason why in such a case the patentee should have the sole right to determine how the assumed infringer may defend himself. If the question of validity is getting too critical for the patentee, he may simply take away this defence for the assumed infringer by withdrawing the appeal. This outcome of following G 3/04 is certainly not what the legislator had intended when making Article 105 part of the EPC.

- The principle of procedural economy, which is recognized in the EPO, see for example Article 10b(1) Rules of Procedure of the Boards of Appeal, should be applied to allow interveners to fully defend themselves in a centralized

proceeding before the EPO, rather than having to have the issues decided separately by various national courts.

XX. Oral proceedings took place on 13 July 2006. The Interveners requested that the two questions stated in the letter filed on 13 June 2006 be referred to the Enlarged Board of Appeal.

XXI. At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

Admissibility

1. The appeal of the Proprietor met the requirements of Article 106 to 108 And Rule 64 EPC and so was admissible.
2. The intervention by Intervener 1 met the requirements of Article 105 EPC and so is admissible.
3. The first intervention of 23 June 2005 by Intervener 2 stated that Intervener 2 was entitled to join the appeal procedure since they had instituted proceedings in Italy for a court ruling that they do not infringe the European patent in suit. However Article 105(1) EPC second sentence also requires proof that the proprietor has requested that such intervener cease alleged infringement. No evidence has been submitted indicating what request of the proprietor is relied on or when such request was made. In the absence of such evidence

this first intervention on behalf of Intervener 2 cannot be considered as meeting the requirements of Article 105(1) EPC and so is inadmissible. The questions of law of whether for the purposes of Article 105 EPC second sentence, by its back reference to Article 105 EPC first sentence, imposes a three month limit on the filing of the intervention calculated from the date of the request of the proprietor to cease alleged infringement or calculated from the date of the institution of court proceedings for a ruling that the European patent in suit is not infringed, and of whether the request to cease infringement must relate to activities in the state in which the court ruling is being asked for, thus need no answer in this case.

4. The second intervention by Intervener 2 on 11 January 2006 stated that the Intervener 2 was entitled to join the appeal proceedings by virtue of service of a complaint relating to infringement proceedings concerning the patent in suit on 12 October 2005, accompanied by evidence of this. Prima facie the evidence submitted met the requirements of Article 105 EPC, and the Proprietor has not challenged the entitlement of Intervener 2 to intervene on this basis. The second intervention of 11 January 2006 by Intervener 2 is thus found admissible.

Need to follow decision G 3/04 or refer anew

5. In decision G 3/04 the Enlarged Board of Appeal held that after withdrawal of the sole appeal, the proceedings may not be continued with a third party who intervened during the appeal proceedings.

6. While, as remarked on behalf of the Interveners, Article 112(3) EPC lays down only that the decision of the Enlarged Board of Appeal shall be binding on the referring Board of Appeal in respect of the appeal in question, Article 16 of the Rules of Procedure of the Boards of Appeal states that "Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier decision of the Enlarged Board of Appeal, the question shall be referred to the Enlarged Board of Appeal".

7. The Interveners seek to rely on a partial quotation from G 9/93, Reasons 6.1 as a basis for this Board not to apply G 3/04. The very passage relied on when considered in full shows that this is not possible. Reasons 6.1 of G 9/93 reads:

"In principle, any interpretation of the EPC by the Enlarged Board implies that the law has always been in conformity with that interpretation. However, on purely procedural issues there may be reasons of equity for not applying to pending cases the law as thus interpreted. In cases currently pending before the EPO and relying on decision G 1/84, which has now been followed for many years, obviously patent proprietors had every reason to expect that self-opposition would be considered admissible. In the present Board's opinion, it would be inequitable now to prevent them from continuing proceedings they embarked on in good faith and which cannot adversely affect the rights of any third party. Its ruling that, contrary to the earlier interpretation of the EPC, self-opposition is inadmissible, should

therefore not be applied to notices of opposition filed before publication of the present decision."

8. Exceptions to an interpretation of the EPC by the Enlarged Board of Appeal being immediately applicable are thus confined to cases where the only affected persons are the EPO and the party immediately concerned, and where no other parties would be adversely affected. Further there had to be a well-established practice on which the party had relied. Delayed application would here adversely affect the Proprietor and for this reason alone it cannot apply.
9. Further, decision G 3/04 itself contains no indication that its decision as to what the law is on the question should not be applied immediately in all subsequent cases in accordance with the general rule. Nor is decision G 3/04 overturning any established practice. Rather the situation was unclear. Where the Enlarged Board of Appeal settles a point of law which was previously unclear then the view of the Enlarged Board of Appeal needs to be followed in all subsequent cases, otherwise a chaotic legal situation would ensue.
10. It was further submitted in support of not applying decision G 3/04 to the present case that the intervener in this case firmly believed when joining the pending appeal proceedings that he would have full appellant status independently of how the patentee might behave, and that he was taken by surprise that the present appeal proceedings should be terminated for him by withdrawal of the appeal.

11. The mere existence of such a firm belief cannot assist an intervener if there is no objective justification for such belief based on an established practice. There was no established practice that an intervener would be able to ask for revocation of the patent even if all appeals had been withdrawn. The actual position is reflected in decision T 1026/98 (OJ EPO 2003, 441) which stated in points 1 and 2 of the 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 is whether the situation is different because there was a valid intervention during the appeal proceedings.

2. Case law offers varying answers to this question."

12. The Board concludes that it must either apply decision G 3/04 or refer a question of law anew.

Circumstances in which renewed referral justified

13. Where a question of law has been answered in a decision of the Enlarged Board of Appeal, it is the view of this Board that only exceptional circumstances would justify renewed referral of the same or a very similar question. Such a renewed referral would tend to decrease rather than increase legal certainty, and so should generally be avoided on this ground alone.

14. For the renewed referral leading to the overturn by decision G 9/93 of the previous view allowing a

proprietor to oppose his own patent given in decision G 1/84, the exceptional circumstances were that such self-opposition had already been considered in two earlier Enlarged Board of Appeal decisions G 9/91 and G 10/91 (OJ EPO 1993, 408 and 420, see in each case Point 2 of Reasons) as incompatible with the view taken in these decisions that opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposing interests.

15. No such doubts have been thrown by any later Enlarged Board of Appeal decisions on the decision G 3/04.

16. Another exceptional circumstance might be where a party convinced a board that the Enlarged Board of Appeal had not had before it some material legal aspect, and the referring board were itself convinced that taking this new material legal aspect into account would lead to the question being answered in a different way. A third exceptional situation might be one where other related questions of law to which the Enlarged Board of Appeal had not yet provided an answer did require referral, and in this context the Enlarged Board of Appeal might be asked also to include in its review the existing answer.

Consideration of reasons put forward for referral

Case for Intervener not put in G 3/04

17. Decision T 1026/98 was a referral to the Enlarged Board of Appeal, published several years before the present interventions in the present case, of a virtually identical question as put in referral decision T 1007/04 giving rise to decision G 3/04. The proceedings in case T 1026/98 were terminated by withdrawal of the intervention before the Enlarged Board of Appeal gave an answer, but the arguments of the intervener in T 1026/98 were adopted by the intervener in G 3/04 (see Facts and Submissions VII). Decision G 3/04 is thus not open to the charge that the case for the Intervener had not been put.

Withdrawal of sole appeal being by proprietor

18. The Interveners seek to suggest that because the referral leading to decision G 3/04 concerned the withdrawal of a sole appeal by an opponent, whereas the present case concerns withdrawal of a sole appeal by the proprietor, this should make a difference. As decision G 3/04 relied in particular on the relevant procedural principles considered applicable in decision G 9/92, which covered cases both of a sole appeal by an opponent and a sole appeal by a proprietor, this Board must presume that in decision G 3/04 the Enlarged Board of Appeal quite deliberately used wording and reasoning applicable to both types of case. That the present case concerns the withdrawal of an appeal by the proprietor cannot thus be a justification for a further referral.

Travaux préparatoires

19. The arguments put forward on behalf of the Interveners on the basis of the *travaux préparatoires* and the passages therein relied on are set out in XIX(c) and (d) above. As appears from the discussion in the *travaux préparatoires* and from the wording of Article 105 EPC the alleged infringer is given the right to join in existing opposition proceedings outside the opposition period. If no such opposition proceedings exist the alleged infringer is given no right to initiate them out of time for his own benefit. An intervention can take place also during pending appeal proceedings. This is acknowledged in decision G 3/04. The question of what is to happen when the sole appeal is withdrawn is not discussed in the *travaux préparatoires*, nor is it regulated in the EPC. Such a question of procedural law is left to the instances of the EPO to decide.
20. Decision G 3/04 is concise. It does not refer to the *travaux préparatoires* but relies on recognized principles of procedural law in coming to its conclusion that the proceedings cannot be continued after the withdrawal of the sole appeal. However decision G 3/04 discusses decision G 4/91 and mentions referral decision T 1026/98, both of which decisions extensively referred to the *travaux préparatoires*. This Board can only conclude that while having considered the *travaux préparatoires* the Enlarged Board of Appeal did not consider them of assistance in answering the question put. The contents of the *travaux préparatoires* cannot be considered a new material legal aspect not taken into account by the Enlarged Board of Appeal.

Intent of legislator

21. On behalf of the Interveners it is argued that as evidenced by the *travaux préparatoires* Article 105 EPC was intended to give the alleged infringer a strong position and give him all available means to attack the patent in a centralized procedure before the EPO, and that therefore the proceedings had to continue for the benefit of the intervener even if the latter only joined at the appeal stage and all appeals had been withdrawn. The Board considers that this overstates the strength of the position intended for the alleged infringer, who was merely not to be excluded from pending EPO opposition proceedings. The convenience for the alleged infringer of a centralized procedure cannot have been a dominant objective, as this convenience for the alleged infringer was not considered sufficient to give an intervener an independent right to initiate opposition proceedings outside the nine month opposition period.

Equality before the law

22. Reliance by the Interveners on the general principle of equality before the law and on decision G 1/86 seems misplaced, as it appears to the Board that they are seeking a specially privileged position for interveners, better than that of actual opponents, and a worse position for proprietors who are sole appellants than in cases where there are no interveners. The position where there are no interveners is set out in decision G 9/92, Reasons 14, as follows:

"The first case involves a sole appeal by the patent proprietor against an interlocutory decision by the Opposition Division to maintain the patent in amended form. The amended text is not covered by the appellant's appeal request, that is its statement setting out the scope of the appeal (Art. 108, first sentence, and Rule 64(b) EPC). The aim of such an appeal is to replace the text of the patent as maintained by the Opposition Division, or, if this request is not allowed, that is if the appeal is rejected, that the patent be maintained in the form allowed by the Opposition Division.

- The scope of the appeal defined in an appellant's request is exceeded if the non-appealing opponent files a request for revocation of the patent. The opponent can thus no longer effectively file such a request once the time limit for appeal has expired."

23. According to the above principles of procedural law, revocation of the patent was thus not a possible outcome of the appeal in the present case. While in view of the withdrawal of the appeal a decision on this point by this Board is not necessary, this Board would have followed the view in G 3/04 that the intervener filing an intervention has only the status of opponent and not the status of appellant to its logical conclusion that the intervener can only object to the patent being maintained on the broader basis sought by the proprietor on appeal but cannot object to maintenance of the patent as allowed by the Opposition Division. This would also be consistent with the view already taken by another Board of Appeal in decision

T 694/01 (OJ EPO 2003, 250, Reasons 2.20) that an intervention is dependent on the extent to which the opposition/appeal proceedings are still pending, and refusing to allow an intervener who joined during appeal proceedings where the only question was amendment of the description to intervene in the procedurally completed part of the opposition which concerned the validity of the wording of the claims.

24. By getting the proprietor to withdraw the appeal, the Interveners in this case have already, in the Board's view, achieved all they were entitled to achieve. The one privilege that the Interveners would have had would be, consistent with decisions G 1/94 and G 3/04, also to rely on new grounds to obtain rejection of the proprietor's appeal and thus prevent an extension of the scope of the patent beyond that maintained by the Opposition Division.

Procedural economy

25. All the arguments by the Interveners on procedural economy by avoiding multiple national proceedings, presuppose that the Interveners would succeed in obtaining revocation in EPO proceedings and in the meantime obtain a stay of national proceedings. If this were not the case multiple national proceedings might yet be continued in parallel to EPO proceedings or come into being once the EPO proceedings are concluded in some years time. By applying the ordinary rules of procedural law that the withdrawal of the sole appeal terminates the proceedings, there is at least the certain gain that EPO proceedings are terminated, and

that any national proceedings can be started earlier than would otherwise be the case.

Fairness to parties

26. Fairness to the parties must include fairness to the proprietor. The Board does not see that fairness requires a proprietor to be deprived of the ordinary rights of a sole appellant to terminate the proceedings and this for the benefit of alleged infringers who have not exercised the option of filing oppositions but seek by intervening at the appeal stage to have a new case for revocation considered, which might incidentally greatly extend the length of the EPO proceedings.

27. Whether or not an alleged infringer who has not himself filed opposition proceedings in the due period will have the opportunity to join in such proceedings as an intervener will obviously be outside the control of such alleged infringer. The Board fails to see why this should amount to any sort of reason to treat the alleged infringer particularly favourably.

Conclusion

28. The Board agrees with decision G 3/04 and its reasoning which is directly applicable to the present case and leads to the conclusion that the appeal proceedings terminated with the withdrawal of the appeal on 18 January 2006. For the reasons stated above none of the arguments put forward on behalf of the Interveners have persuaded the Board otherwise, or that a referral of the questions of law set out in XVIII above or any other question is necessary for a decision in this case.

29. Consequently, the request for referral of questions to the Enlarged Board of Appeal is refused.
30. Consistent with decision G 3/04 that appeal fees are not payable by interveners these are to be repaid.

Order

For these reasons it is decided that:

1. The request for referral of a question to the Enlarged Board of Appeal is refused.
2. It is declared that the appeal proceedings terminated with the withdrawal of the appeal on 18 January 2006.
3. The appeal fees paid on behalf of the interveners DakoCytomation GmbH and DakoCytomation Denmark A/S insofar as debited and not yet repaid are to be repaid.

Registrar:

Chair:

P. Cremona

S. Perryman