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**Datasheet for the interlocutory decision
of 7 July 2025**

Case Number: T 0417/22 - 3.3.10

Application Number: 08762734.5

Publication Number: 2164428

IPC: A61L27/06, C23C30/00, B22F7/00,
A61L27/04, A61F2/30, A61F2/34,
B22F3/105, A61B17/86, A61F2/28

Language of the proceedings: EN

Title of invention:

PROSTHETIC ELEMENT AND RELATIVE METHOD TO MAKE IT

Patent Proprietor:

Limacorporate S.p.A.

Opponents:

Peter Brehm Holding GmbH & Co. KG
WALDEMAR LINK GmbH & Co. KG

Headword:

Stay of proceedings

Relevant legal provisions:

EPC Art. 24, 24(3), 24(4), 99(1), 105, 105(1), 105(1)(b), 107,
107 sentence 1, 107 sentence 2, 112, 112(1), 125
EPC R. 89(1), 89(2), 102(c)
RPBA 2020 Art. 21

Keyword:

Exclusion of Board member for suspected partiality (no)
Deviation from an earlier decision or opinion of the Enlarged Board under Article 21 RPBA
Stay of proceedings in view of a referral pending before the Enlarged Board (yes)

Decisions cited:

G 0001/94, G 0005/01, G 0003/04, G 0003/08, G 0001/21,
J 0015/04, T 0694/01, T 1108/02, T 0473/13, T 1286/23

Catchword:

Under the right circumstances, staying proceedings in view of an already pending referral is a legitimate alternative to the Board's own referral. As such, it is implicitly covered by Article 21 RPBA as a legally correct procedure where a Board intends to deviate from an interpretation of the Convention given in an earlier decision or opinion of the Enlarged Board of Appeal (Reasons 21.)



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Case Number: T 0417/22 - 3.3.10

I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal 3.3.10
of 7 July 2025

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 December 2021 concerning maintenance of the
European Patent No. 2164428 in amended form.**

Composition of the Board:

Chairman	M. Kollmannsberger
Members:	T. Bokor
	A. Zellner

Summary of Facts and Submissions

- I. The present proceedings before the Board arose from the appeals of the patent proprietor and the original opponent (opponent 1) against the decision of the Opposition Division, issued in writing on 2 December 2021, to maintain the European patent in amended form under Article 101(3)(a) EPC. The appeals of the patent proprietor and the opponent 1 were filed on 10 February 2022 and 14 February 2022, respectively. The corresponding appeal fees were timely paid and the statements of the grounds of appeal were also timely filed by both the patent proprietor and the opponent 1.
- II. The Board summoned the parties to oral proceedings scheduled for 8 November 2024.
- III. An intervention was filed by the intervener on 2 August 2024, filing its grounds of opposition at the same time. The intervener paid an appeal fee simultaneously. They stated that the grounds filed with their intervention constitute grounds for both opposition and appeal (see page 6, top, Chapter III). The fee for opposition was paid on 3 August 2024.
- IV. The Board invited the patent proprietor to respond to the opposition and re-scheduled the earlier summoned oral proceedings for 17 and 18 February 2025.
- V. Following a request for postponement from the patent proprietor, due to conflicting oral proceedings before the EPO that had already been summoned, the oral proceedings before the Board were re-scheduled for 7 July 2025.

- VI. The opponent 1 withdrew their appeal with letter dated 12 May 2025 and received on 13 May 2025.
- VII. The patent proprietor withdrew their appeal with letter dated and received 14 May 2025. In the withdrawal statement, they submitted that the proceedings should be closed and the oral proceedings cancelled, in view of the fact that the only other remaining appellant also had withdrawn their appeal so that the proprietor remained as the sole appellant.
- VIII. With letter dated 15 May 2025 the intervener pointed to the pending referral G 2/24, the positive opinion of the EPO President on the appellant party status of an intervener, and the fact that they had also filed an appeal and were adversely affected by the decision of the Opposition Division. They also put forward various procedural requests, all of which were directed at continuing the proceedings with the intervener in the position of an appellant: The proceedings should continue unconditionally, or alternatively the proceedings should be stayed in view of the pending referral, or the case should be remitted to the opposition division. They also requested separate oral proceedings on the issue of their party status.
- IX. The patent proprietor submitted with letter dated 21 May 2025 that the pending referral cannot change the still valid law, the party status of an intervener as held by G 3/04. They requested that the Board refuse the various requests of the intervener, and instead adhere unconditionally to the decision G 3/04, treating it as binding, and that the Board close the proceedings.

- X. The Board issued a communication under Article 15(1) RPBA dated 22 May 2025, analysing the procedural situation and the requests of the parties. The Board indicated that staying of the proceedings until the outcome of the pending referral seemed the only reasonable and pragmatic solution. The Board was not obliged to stay the proceedings, however it was under no formal obligation to accept the findings of G 3/04 either. On the contrary, the Board had the power under Article 21 RPBA to refer questions similar to those referred by T 1286/23 to the Enlarged Board, but this procedural possibility had only disadvantages as compared to the staying of the proceedings. The Board considered that the procedural situation before the Board was wholly comparable to that before the referring board, which led to the decision T 1286/23. The pending referral was not without merit, and the Board recognised the legitimate interest of the intervener to wait for the outcome of G 2/24. The summoned oral proceedings would be maintained for discussing the intervener's party position and the procedural options available for the Board, in particular whether the proceedings should be closed or stayed until the procedural status of the appellant intervener is clarified by the pending referral G 2/24, or continued in some other way. The parties were given the opportunity to comment.
- XI. The intervener submitted with letter dated 12 June 2025 that it supported the Board's assessment of the procedural situation. They also pointed to the changes in the wording of the German and French versions of Article 105 EPC in the course of the EPC 2000 revision, in their view supporting the stronger position of the intervener.

- XII. The patent proprietor submitted with letter dated 27 June 2025 extensive arguments why the Board should not stay the proceedings but rather follow the still binding decision G 3/04. These arguments are treated below in the Reasons for the decision.
- XIII. The intervener responded with letter dated 3 July 2025 and gave counter-arguments, supporting the Board's intention to stay the proceedings. These arguments are also treated below.
- XIV. With a further letter dated 4 July 2025 the patent proprietor requested to remove the legal member of the Board and to replace him with another legal member under Article 24 EPC. It was argued that his especially material participation in both the referring decision leading to the pending referral G 2/24 and the present proceedings gave rise to suspicion of partiality.
- XV. The oral proceedings were held on 7 July 2025. During the oral proceedings it was discussed whether the legal member should be replaced and how the Board should continue the proceedings. The parties's relevant arguments submitted in the oral proceedings are also discussed below. The Board's decision was announced at the end of the oral proceedings.
- XVI. The parties final requests were the following:

The intervener's main request was that the Board stays the proceedings and waits for the outcome of the referral G 2/24. The first auxiliary request was that the Board refers the same question on the status of the intervener to the Enlarged Board of Appeal. The second auxiliary request was that the Board remits the case to the opposition division for further prosecution.

The patent proprietor's first procedural request was the exclusion of the Board's legal member under Article 24(3) EPC and his replacement by a different legal member. The main substantive request on the matter was that the proceedings are terminated by application of the principles derivable from G 3/04.

The opponent 1, party to the proceedings, did not put forward any requests following the withdrawal of its appeal, and was also not represented in the oral proceedings.

Reasons for the Decision

Request for the replacement of the legal member under Article 24(3) EPC

1. Before the Board can proceed to decide on the parties' procedural requests before it and related to the admissibility of the intervener's appeal, the patent proprietor's objection of suspected partiality need to be decided.
2. According to Article 24(3), first sentence, EPC, members of a Board of Appeal may be objected to by a party if suspected of partiality. According to Article 24(3), second sentence, EPC, an objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step. Article 24(4) EPC stipulates that the affected Board of Appeal shall decide as to the action to be taken without the participation of the member concerned, and for this decision the member objected to shall be replaced by his alternate. However, it is settled case law of the Boards that the admissibility of the

objection is to be determined by the Board in its original composition (CLBA 10th Edition 2022, III. J. 3.1, also confirmed by the Enlarged Board lastly in decision G 1/21 of 28 May 2021, Reasons 10.).

3. Here the question arises as to what exactly constitutes in this case the reasons for objection within the meaning of Article 24(3), second sentence, EPC and when the patent proprietor became aware of the reasons for the objection for the purposes of this article.
4. In the Board's understanding, the patent proprietor's reasons for the objection against the legal member are stated to be based on two facts: the allegedly biased opinion formulated in the Board's preliminary opinion dated 22 May 2025 (see point X. above) and the fact that the legal member also sat on the referring decision T 1286/23 and inevitably must have played a decisive role, just like in the present case, given the point of law that was and is at the heart of the matter.
5. Concerning the point of time when the party became aware of the reasons for the objection, the patent proprietor submitted that they only became aware of the fact that the legal member in the present case also acted as legal member in the decision T 1286/23 on 4 July 2025. While they were aware of the contents of the decision already earlier from the online available version of the decision, they did not come across the composition of the deciding Board until they consulted the pdf version of the decision, carrying the names of the board members. Having learned of the coincidence, they realised that the Board's opinion in the present case was effectively biased against the patent proprietor. While the biased opinion of the Board was

already perceivable from the Board's communication, the reasons for this bias became only clear once they realised that the same legal member was involved. Furthermore, general procedural fairness dictated that the Board ought have called the parties' attention to the fact that the legal member was the same in both cases.

6. First of all, the Board observes that it had no obligation to point out to the parties that its members may have participated in decisions dealing with similar or even the same issues. Such facts alone cannot establish any suspicion of partiality (G 03/08, Reasons 2.4 and 2.5, not even for a member of the Enlarged Board of Appeal who may have participated in similar decisions in the capacity as member of a Board of Appeal, see G 05/01 dated 7 December 2006, Headnote II.). Indeed, if this were not so, and members could be objected to on the grounds that they have already decided a similar issue and therefore had to be seen as partial, members of a Board of Appeal could effectively never participate in more than one decision dealing with some specific issue, which the Board considers as a manifestly absurd outcome (see also J 15/04, Reasons 6. to 8.). From this it follows that parties need not be informed about earlier decisions of Board members.
7. The patent proprietor's argument that the partiality objection was filed before any procedural step was taken is unconvincing. As the intervener has correctly pointed out, if the Board's communication already gave rise to suspicion, given that it was perceived as biased, as submitted by the proprietor, they should have objected promptly after having received the communication, in any case before making a procedural step. However, their submissions dated 27 June 2025

indisputably qualify as a procedural step and therefore make a later objection, based on the earlier dated allegedly biased opinion of the Board inadmissible pursuant to Article 24(3), second sentence, EPC.

8. If, on the other hand, as submitted by the patent proprietor, the alleged bias in the Board's communication became apparent only once they realised the involvement of the same legal member in the referral decision T 1286/23, this still does not change that the objection should have been made before undertaking a procedural step on 27 June 2025. The relevance of the referral decision for the present case was known to the proprietor before, as is apparent from the fact that the decision as well as its relevance for the present case were discussed in great detail by the proprietor itself in its submission filed on 27 June 2025. The Board observes that on an objective view, the patent proprietor must be presumed to have been aware of the Board's composition in the case T 1286/23 and accordingly of the same legal member already at this point of time. The Board recognises that the wording of Article 24(3), second sentence, EPC suggests that factual, i.e. subjective knowledge of the reason for exclusion is required, as submitted by the patent proprietor in the oral proceedings. However, as also demonstrated by the present case, subjective knowledge of a party is effectively impossible to verify for either the Board or other parties. Thus accepting subjective awareness of a party as the admissibility condition for the application of Article 24(3), second sentence, EPC would lead to the result that a party could effectively raise an objection any time in the proceedings, simply by stating that even if the necessary facts were at their disposal, they subjectively did not recognise a

relevant relationship between them. This would effectively make Article 24(3), second sentence, EPC a provision without effect, which could not have been the legislative intention.

9. Thus the Board accepts the intervener's argument that the patent proprietor dealt with the decision T 1286/23 in great detail and therefore must be presumed to have known the decision in its entirety, including the composition of the deciding board, before they undertook a procedural step on 27.06.2025. The Board points out that the names of the Board members form part of the decision pursuant to Rule 102(c) EPC: "The decision **shall contain** ... the names of the Chair and other members of the Board of Appeal taking part" (Board's emphasis, in German: "Die Entscheidung **enthält:**", in French: "La décision **contient:**"). That the name of the legal member in the present case must have been known to the patent proprietor since the beginning of the proceedings, at least since the issuance of the Board's communication, was undisputed. Accordingly, the patent proprietor must be presumed to have been aware of the fact that the same legal member was involved in both cases by the time they filed their submissions dated 27 June 2025. From this it follows that an objection under Article 24(3), first sentence, EPC against the legal member on this basis is inadmissible, even if the Board were to accept, for the benefit of the patent proprietor, that the alleged bias in the Board's communication did not have to be apparent until they realised the involvement of the same legal member.
10. For these reasons, the Board holds that the patent proprietor's objection of suspected partiality is inadmissible. The Board refuses their request for

replacement of the legal member and does not initiate the proceedings foreseen in Article 24(4) EPC. The proceedings continue with the Board's original composition.

Admissibility of the intervention and the intervener's appeal

11. The original appeals of the opponent 1 and the patent proprietor were admissible, which was undisputed. The intervener proved that it has been served with an action for infringement in Germany on 3 May 2025, and filed their intervention within three months as required by Article 105(1) and Rule 89(1) EPC and also paid the opposition fee (Rule 89(2) EPC). At that time the appeals of both the opponent 1 and that of the patent proprietor were still pending. The intervention is admissible. This was also explicitly recognised by the patent proprietor (letter dated 27 June 2025, point 28), notwithstanding the patent proprietor's numerous arguments that the intervener ought have acted already earlier against the patent.
12. The admissibility of the intervener's appeal is the very issue that needs to be decided, as the continuation of the substantive proceedings, the substantive examination of the intervener's opposition, hinges on this issue. This was also undisputed.

The procedural options available to the Board for dealing with the admissibility of the intervener's appeal

13. The patent proprietor argued that the Board's only procedural possibility was the unconditional closure of the proceedings, given the still valid interpretation given by decision G 3/04. Continuing the proceedings would go against the undisputed legal principle that

the withdrawal of the sole (remaining) appeal terminates the proceedings.

14. These arguments of the patent proprietor overlook a decisive procedural detail. The intervener, in spite of the findings of G 3/04, decided to file an appeal against the decision of the opposition division, with all the necessary formalities, including the appeal fee in addition to the opposition fee. The Board notes that this was done similarly by the intervener in the case underlying the referring decision T 1286/23.
15. This means that there is a pending appeal that the Board needs to decide on, even if the decision may only concern the admissibility of the appeal. This would be the case even if there were no pending referral, and even if the idea of a referral to the Enlarged Board, or the question of the validity of G 3/04, had not arisen at all, whether raised by a party or the Board.
16. It follows from this that, even if the Board were to grant the patent proprietor's request and decide to follow the interpretation given by G 3/04, it could not close the proceedings without issuing a formal decision. Although the substantive proceedings would end with the withdrawal of the last admissible appeal, the Board would still be required to terminate the proceedings with a reasoned decision. In such a decision, the Board would have to address the inadmissible appeal, which would most likely have to be rejected as such, assuming that the validity of G 3/04 is undisputed. However, the Board's reasons would have to explain why the appeal is inadmissible. This differs procedurally from the procedure in cases where all appeals have been withdrawn, whereby the Board does not formally end the substantive proceedings with a

constitutive decision, but simply establishes that they have terminated by operation of law (i.e. with a declaratory decision), without providing particular reasoning according to standard practice.

17. In view of the necessity for the Board to rule on the intervener's appeal, the Board also has the procedural possibility to review whether the principles set out in decision G 3/04 are valid or require revision. The intervener drew the Board's attention to the pending referral G 2/24 before the Enlarged Board, but the Board was also aware of the referral. As set out further below, the Board considers the referral to have merit, in the sense that it is not deemed to be *prima facie* unsuccessful. This assessment is supported by the publicly available opinion of the EPO President and numerous amicus submissions. Therefore, the Board agrees with the referring board of T 1286/23 that the guiding decision G 3/04 may require revision. At the very least, additional reasoning is needed to accept it as a convincing interpretation of the law.
18. This procedure, whereby the Board is obliged to issue a formal, reasoned decision on the admissibility of the intervener's appeal, means that it is procedurally straightforward for the Board to make a referral to the Enlarged Board for the purpose of reviewing G 3/04, pursuant to Article 21 RPBA. The Board's formal powers to make its own referral were also undisputed. In fact, both parties put forward the Board's own referral as an auxiliary request during the proceedings, although the patent proprietor later withdrew it.
19. However, in view of the pending referral G 2/24, the Board has an additional option, as set out in the Board's communication (see point X. above). Rather than

referring the case itself, the Board can stay the proceedings until the outcome of the pending referral G 2/24 is known. The questions put to the Enlarged Board in the referring decision go to the heart of the matter, and G 2/24 is expected to address the question of whether an intervenor can admissibly appeal in such a situation, i.e. when joining opposition proceedings at the appeal stage. Therefore, the Board has no doubt that the outcome of referral G 2/24 will be decisive for the present case. The parties did not present any arguments against the Board's expectation in this regard. While the proprietor argued extensively that the present case was significantly different from that underlying the referring decision T 1286/23 and that the Board need not wait for the outcome of the referral, they did not argue that the Enlarged Board's response would not provide guidance on answering the question in the present case of the admissibility of the intervenor's appeal under the circumstances.

20. The patent proprietor argued, and the Board is aware, that there is no explicit legal basis in either the EPC or the RPBA for staying the appeal proceedings. This was noted in the Board's communication. There, the Board observed that, despite the lack of an explicit legal basis, staying the proceedings appeared to be a reasonable and pragmatic solution given that the Board's own referral would cause more problems without achieving any procedural benefit (see point 11 of the communication). The Board also notes that the case law recognises the stay of the proceedings as a viable procedural option for a Board in the event of a pending referral (see CLBA V.B.2.5.4). Furthermore, the Board is not aware of any case law that categorically denies the procedural possibility of staying the appeal

proceedings as a matter of principle, nor did the parties point to any such case law.

21. As is apparent in the present case, if the Board deems it justified to revise a decision or opinion of the Enlarged Board of Appeal under Article 112 EPC, and if the referral is expected to address the same legal issues that the Board would refer to the Enlarged Board, then staying the proceedings offers significant procedural advantages over the Board's own referral under Articles 112(1) EPC and Article 21 RPBA. Therefore, the Board concludes that, under the right circumstances, staying proceedings in view of an already pending referral is a legitimate alternative to the Board's own referral. As such, it is implicitly covered by Article 21 RPBA as a legally correct procedure where a Board intends to deviate from an interpretation of the Convention given in an earlier decision or opinion of the Enlarged Board of Appeal. Thus even if the Board were to accept, for the sake of argument, the proprietor's position that already the staying of the proceedings would mean a deviation from the binding decision G 3/04, for the sole reason that the Board does not apply it immediately and without hesitation, the Board's intended course of action is still possible without contradicting the law.
22. Accordingly, the Board holds that it effectively has the three procedural options discussed during the proceedings. The Board can issue a decision without delay on the basis of the principles derivable from G 3/04, thereby effectively dismissing the intervenor's appeal as inadmissible and terminating the substantive proceedings. Alternatively, the Board could make a further referral to seek a change to the interpretation of the law given in G 3/04. Further, the Board could

stay the proceedings until the pending referral G 2/24 answers the question of whether and how an intervenor joining the appeal proceedings may obtain appellant status within the meaning of Article 107 EPC.

23. As neither the parties nor the Board itself favoured the Board's own referral, there is no need to discuss in detail all the conditions for such a referral. Instead, the Board must choose between staying the proceedings and applying G 3/04 unreservedly. For this, it is sufficient for the Board to establish that a hypothetical referral would fulfil the requirements of Article 112(1)(a) EPC for essentially all the reasons given in the referring decision (see T 1286/23, Reasons 2 with subpoints), given the relevant similarities between the cases. If the Board were not convinced of the admissibility of its own referral, not applying immediately the Enlarged Board's still-valid decision but staying the proceedings instead may have required a different reasoning from the Board.
24. The proprietor submitted numerous arguments why the Board should not stay the proceedings, both in the oral proceedings and in writing with their letter dated 27 June 2025.
25. During the oral proceedings, they argued that a stay of proceedings would cause significant delays that would be detrimental to the proprietor's legitimate interests, particularly with regard to enforcing its patent rights. This was particularly pertinent given that the patent was close to expiry. Decision T 1473/13 found that the interests of the parties should be weighed up, whereas decision T 1108/02 found that the proprietor's interests prevailed over those of the intervenor. The intervenor acted in bad faith by

joining the proceedings at a late stage despite having had the opportunity to do so earlier, given that it was aware of the patent. The Board's intention to stay focused solely on the intervener's interests and not on those of the proprietor. They also criticised the fact that the Board's preliminary opinion gave no substantive reasons as to why the binding decision G 3/04 required revision.

26. In their written submissions, they primarily argued that G 3/04 remains in force and must be applied until it is overturned. They also stated that the principle that withdrawal of an appeal terminates the proceedings is to be respected. The Board should not follow the referring decision T 1286/23, because the case underlying that decision had significant factual differences compared to the present case. Notably, the intervener in that case made significant efforts to intervene before finally succeeding, which must have been a decisive factor for the referring board in recognising their entitlement to continue the appeal proceedings. Another relevant factor in that case may have been the intervener's new opposition grounds. There were also amicus submissions in the referral G 2/24 that supported the existing interpretation.
27. The intervener argued in the oral proceedings that they could not have intervened earlier and the proprietor's own actions contributed to the delays. While it was undisputed that there was formal correspondence between the parties in December 2021 and January 2022, this was already after the proceedings conducted before the opposition division. No further actions were taken thereafter until the infringement suit was filed in April 2024 which lead to the pending intervention. The intervener had no reason to oppose the patent because

they estimated that the patent was anyway not infringed, unlike the broader patent resulting from a divisional application, which was duly opposed. Article 105 EPC contained no further requirements for an intervention. There were convincing arguments in the file why G 3/04 may have to be revised. No less delays would be the result if the Board were to follow G 3/04 without staying the proceedings, because in that case the intervener would initiate nullity proceedings against the patent on a national level.

28. The Board agrees with the patent proprietor that, if it intends to deviate from the still binding decision G 3/04, the Board must give reasons. The Board also agrees with the patent proprietor that the interests of the parties, as well as those of the public, must be considered when deciding on the procedural options before the Board. This is particularly relevant when considering whether to stay the proceedings for any reason, as set out in decision T 1473/13 (see Reasons 7.2.1 and 7.2.2, which discuss the arguments for and against staying in great detail, including the issue of delayed justice).

Reasons for deviating from G 3/04

29. The patent proprietor seems to take up the argument of G 3/04 that the intervener cannot satisfy the requirements of Article 107, first sentence, EPC (G 3/04, Reasons 6, mentioned in point 6 of the patent proprietor's submissions dated 27 June 2025 and treated by the amicus submissions of Prof. Dr. Ronny Hauck, submitted by the patent proprietor in their letter of 4 July 2025). The Board agrees that this is a central argument of G 3/04, and the final finding of G 3/04, namely that that the proceedings cannot continue with

the intervener, is based on this argument. In this regard the Board adopts the argument of T 1286/23 that the intervener also cannot satisfy the second sentence of Article 107 EPC, and G 3/04 simply does not explain how Article 105 EPC overrides the second sentence but not the first sentence of the article (see e.g. Reasons 3.8.5). This is one of the main reasons why the Board considers that G 3/04 may need a revision.

30. The Board also adopts other key reasons set out in T 1286/23: namely, that the creation of the extraordinary procedural possibility of intervention recognises the legitimate interest of the alleged infringer in joining the opposition proceedings. This legitimate interest arises from the conflict between the parties, which became real through the actions of the patent proprietor to enforce the patent, and from the recognised interest of the potential infringer to defend themselves against the patent in a centralised procedure. Lastly, intervention serves the public interest of having the patent examined by the most competent and best-equipped authority (T 1286/23, Reasons 3.4.2 and 3.4.3). Furthermore, it seems illogical to put the intervener in a weaker procedural position despite its stronger substantive position compared to an appellant opponent (Reasons 3.11.).
31. The arguments put forward by the patent proprietor in support of the continued application of G 3/04 do not address any of these reasons of T 1286/23. The decision T 1108/02, which was also cited by the patent proprietor, does not address these aspects of G 3/04 either. Therefore, the Board currently sees no reason to consider the arguments in T 1286/23 unconvincing, and that the pending referral is unlikely to change the law. Rather, the Board maintains its view that the

referring decision is not without merit, and therefore waiting for its outcome is justified.

32. Regarding decision T 1108/02, there is another point that distinguishes the underlying case from the present one, which the deciding Board considered to be relevant. In case T 1108/02, only the proprietor appealed and not the opponent, even though the opponent could have appealed as the patent was maintained in an amended form. Point 23 of the Reasons set out that revocation of the patent was not a possible outcome of the appeal in that case. The deciding Board concluded that the intervener could object to the patent being upheld on the broader basis sought by the proprietor on appeal, but could not object to the patent as upheld by the opposition division. The deciding Board saw its view to be supported by the reasoning in decision T 0694/01, which stated that intervention depended on the extent to which opposition/appeal proceedings were still pending (T 0694/01, Reasons 2.20; see also Reasons 2.18 and 2.19, which discuss the res judicata effect of decisions and whether Article 105 EPC can alter this effect). On this basis, the case underlying T 1108/02 differs from the present case. In the present case, there was a pending appeal for revocation by the original opponent at the time the intervener joined the proceedings. Following the arguments in T 0694/01, the intervener in the present case must also be entitled to request revocation given that the original opponent's request for revocation had been still pending. The res judicata argument against the intervener's appeal cannot apply here. Therefore, the patent proprietor's argument that G 3/04 requires no revision cannot be supported by the findings of decision T 1108/02.

33. The patent proprietor's additional arguments why the Board should refrain from staying the proceedings are also not convincing.
34. The patent proprietor argued that appeals terminate when all appeals are withdrawn. The Board does not dispute this principle; the referring decision did not call it into question either (see Reason 3.13 and its sub-points on the principle of party disposition). However, this argument overlooks the fact that there is a party to the proceedings who claims to be an appellant and has not yet withdrawn their appeal. The intervener is not seeking to 'recast' itself as an appellant, as suggested by the patent proprietor; rather, they claim to have joined the proceedings as an appellant from the outset, in addition to being an intervener. The question is whether they are entitled to act as both appellant AND intervener at the same time, even though they joined only at the appeal stage. If their appellant status is recognised, it will be evident that the patent proprietor was not the sole remaining appellant when they withdrew their appeal. However, the patent proprietor's arguments for denying the intervener's appellant status with the arguments provided in decision G 3/04 are in fact circular and as such unconvincing. The criticism of G 3/04 in the referring decision is precisely the argument that the reasons for G 3/04 do not explain why an intervener can join an appeal but not as an appellant.
35. The amicus submission of Prof. Dr. Ronny Hauck also does not bring in any new aspect. Its core statement is that the late joining intervener cannot appeal the decision of the opposition division because they have not been party to the proceedings leading to that decision. This may be a defensible position, but as

T 1286/23 pointed out, G 3/04 does not explain why this is so and it is arguable that Article 107 EPC alone does not exclude this possibility (T 1286/23, Reasons 3.6 with sub-points, in particular 3.6.3 to 3.6.5). The application of Article 125 EPC on the basis of German law also does not seem to provide a straightforward answer, as pointed out by the intervener in their submissions of 3 July 2025.

36. The patent proprietor also argued at length that there were significant differences between the case underlying the referring decision T 1286/23 and the present case. The Board disagrees, as the relevant aspect – namely, the intervener's formal appeal against the opposition division's decision, which was filed simultaneously with the intervention during the already pending appeal proceedings – is similar in both cases. The Board's communication also explicitly mentioned the formal filing of the appeal as a relevant fact of the proceedings (see point 2.).
37. The proprietor submitted that, in the case underlying the referral, the Board must have taken the intervener's previous attempts to join the opposition proceedings into consideration. However, the Board does not see how it can be inferred from T 1286/23 that the deciding Board intended to permit the intervener to obtain appellant status only as an exceptional possibility because they had to make extraordinary efforts to intervene. This circumstance did not appear to be relevant to the referral. Rather, what mattered was the underlying legal framework (including the preparatory works to the EPC) and the overall purpose of intervention, as set out in great detail in T 1286/23. The referring board's comments regarding the intervener's procedural history merely emphasise that

it would be particularly unfair to a party in exceptional cases if they were not allowed to continue their opposition to the patent. This is not the same as stating that an intervenor should only be entitled to appellant status under exceptional circumstances. The referring board's position is clear: entitlement to appellant status should depend solely on the outcome of the first-instance opposition proceedings and the intervenor's requests (T 1286/23, Reasons 3.9.4 and 3.12.4 to 3.12.6). The Board shares this position.

38. Essentially, the patent proprietor argues that Article 105 EPC should be interpreted as only allowing interveners to obtain appellant status if they can prove that they took all necessary steps to oppose the patent in time. However, this argument is unconvincing as no such provision is implied in Article 105 EPC. While it is true that T 1286/23 discusses the first two unsuccessful intervention attempts in detail, these had to be examined solely in order to establish that the third intervention was legally effective and successful. This was a necessary precondition for any further considerations by the referring Board (see Reasons 1.1.3 and 1.2, with sub-points). The intervenor's multiple attempts to intervene did not play a role in establishing an adverse effect for the intervenor either. In summary, it was not the unique procedural history of the case that provided the reasons for the referral. Rather, the reasons for the referral were the unconvincing arguments of G 3/04.
39. It is a separate issue that the intervenor's appeal in case T 1286/23 was procedurally quite specific due to their formal appeal, which made referring the case to the Enlarged Board for a review of G 3/04 possible. Similarly, the case before this Board permits the stay

of the proceedings because, as explained above in points 15. to 18., the Board could not terminate them automatically anyway.

40. The same applies for the new opposition grounds: The substantive opposition grounds of the intervener in the case T 1286/23, whether containing any new opposition grounds or not, did not appear to play any role in the assessment of their procedural status in the appeal. It was indeed a general argument from the referring Board that the potential new opposition grounds permitted by G 1/94 are also an argument supporting the intervener's stronger status (T 1286/23, Reasons 3.6.12 and 3.11), but in the decision there was no analysis at all of the intervener's substantive submissions. The Board nowhere stated either that an intervener should be entitled to continue the proceedings or to appeal depending on the filing of new opposition grounds in their opposition.
41. The patent proprietor also argued that reviewing an earlier decision of the Enlarged Board inevitably will cause non-uniform application of the law. The Board does not dispute this - this consequence is hardly surprising. It is only logical that the case law is uniform where an interpretation has been given by the Enlarged Board (see also T 1286/23, Reasons 2.2.), and a revision of the Enlarged Board's interpretation inevitably will give rise to case law that is not uniform with the earlier settled case law. But this has to be accepted, if the later decision of the Enlarged Board finds that the earlier law was not in conformity with the Convention. With this logic, again, a revision of an earlier decision of the Enlarged Board would be practically impossible and Article 21 RPBA would be meaningless.

42. In summary, the Board sees no convincing substantive argument that would support the patent proprietor's proposition that the case before the Board would be less suitable for the Board's own referral than the case underlying the decision T 1286/23 and therefore there would be no point in staying the proceedings and waiting for the outcome of G 2/24.

Weighing up the interests of the parties

43. While the proprietor is correct that the Board must weigh the consequences of staying the proceedings against not staying them, the legitimate interests of both parties must be considered. The proprietor set out a long list of grievances that it will suffer if the proceedings are stayed, yet disregards the legitimate interests of the intervener. For the Board, both parties are equal, and the intervener has a legitimate interest in not being threatened with a potentially invalid patent.
44. In the Board's view, all of the disadvantages that the patent proprietor will inevitably suffer as a result of the stay of proceedings essentially stem from lost time. The patent proprietor may also lose their patent through revocation still in the proceedings before the EPO, whereas it would be maintained if the proceedings were not stayed. However, this outcome is uncertain – the proceedings could also result in the rejection of all the intervener's substantive arguments or their appeal could be rejected as inadmissible if the pending referral upholds the current legal position set out in G 3/04. The patent proprietor's substantive arguments against revising G 3/04 have been addressed above. Thus, the Board considers that the patent proprietor's

only serious argument against the stay is the inevitable delay.

45. The Board does not dispute that all delays in the proceedings are undesired. However, the legislator was certainly aware that intervention might cause delays. Thus the argument of a delay alone cannot be decisive.
46. The Board also accepts that the delay may cause substantial harm to the patent proprietor's interests, because enforcing its patent rights will, in all likelihood, be procedurally more difficult. The proprietor may also suffer a significant economic loss, in that losses due to the infringement activity taking place before a final decision (assuming that the patent survives and infringement will be finally found by a court) are going to be difficult, if not impossible to prove later. The patent approaching expiration is another aggravating circumstance. Thus the proprietor has a legitimate interest in preventing any further delay of the proceedings.
47. The patent proprietor also submitted that the intervenor consciously refrained from opposing the patent and did nothing to enter the opposition proceedings as early as possible, even though it must have been aware of the existence of the patent long time ago.
48. However, the Board accepts the intervenor's argument that the patent proprietor themselves contributed to the intervenor's delayed entry into the opposition and/or appeal proceedings, knowingly doing so. As the intervenor submitted, the patent proprietor was also aware of the intervenor's activities much earlier, as evidenced by their letter of 23 December 2021 (the

'Berechtigungsanfrage') addressed to the intervener. This letter unmistakably stated that the patent proprietor considered the intervener's commercial activities to be within the scope of the patent. The intervener was invited to explain their entitlement to use the patent. The intervener responded immediately in January 2022, stating that not all features of the patent were realised in their product.

49. The Board notes that the patent proprietor's 'Berechtigungsanfrage' stopped short of requesting that the intervener cease the alleged infringement. Instead, it merely invited the intervener to explain why they considered themselves entitled to use the patented solution. The Board's assessment of the contents of the 'Berechtigungsanfrage' was confirmed by the intervener and not disputed by the patent proprietor during the oral proceedings. Accordingly, even if the intervener had initiated legal proceedings to establish that they are not infringing the patent – for example, by filing a "Negative Feststellungsklage" under Article 256 of the German Code of Civil Procedure (ZPO) – this could not have triggered the legal consequences of Article 105(1)(b) EPC. This is because the "Berechtigungsanfrage" did not contain the proprietor's request for the alleged infringement to cease, as required by that article. Therefore, even if the intervener might have initiated such action, it would not have entitled them to intervene.
50. Any other circumstance that would have permitted the intervener to intervene earlier was not brought to the Board's attention. As observed above in point 11., the patent proprietor did not formally object against the admissibility of the intervention. Article 105 EPC also does not require as a pre-condition that the intervener

must have had good reasons for not opposing the patent still within the 9 months opposition period under Article 99(1) EPC.

51. The Board adds that the stay is not expected to cause excessive delay, let alone indefinite delay. Furthermore, as set out in the Board's communication, the Board's own referral would most likely take more time. As the intervener submitted, another delay through national invalidity proceedings would result, so some delay for the proprietor is inevitable anyway.
52. It is clear that both parties will lose time as a result of the Board's decision to stay the proceedings. However, the Board deems it more important that neither party will lose their case without an examination of the merits. Instead, they will remain in an uncertain situation for longer, but this is arguably equally unfavourable. In the meantime, both the proprietor and the intervener can make informed decisions about their actions. The intervener runs a certain risk too, not only the proprietor. They must also calculate with the possibility that the patent will be upheld, in which case they will be liable for any infringement committed before a final decision on the patent's validity is issued.
53. Conversely, if the proceedings are not stayed, the proprietor gains time and wins its case, while the intervener loses its case before the EPO without any examination of the merits. As for the intervener, it is unclear what they might have gained by not losing time, just like the proprietor. While losing time can be accepted to be more unfavourable for the proprietor, the delay alone does not prevent them from suing for infringement at a later date. The expiry of the patent

also does not prevent a claim for damages for infringement that occurred during the patent term.

54. The Board does not dispute that, compared to obtaining a timely injunction against the infringer to prevent further infringement, collecting evidence about the scope of the infringement afterwards is more difficult, which puts the patent proprietor at a disadvantage compared to the intervener. However, even in this case, the question arises as to whether the patent proprietor should have any procedural advantages over an alleged infringer based on a potentially invalid patent.
55. As explained above, the Board sees no reprehensible conduct on the part of the intervener that contributed more to the protraction of the proceedings than the actions and conduct of the proceedings by the patent proprietor. Accordingly, the Board holds that the disadvantage caused to the patent proprietor by the additional delay as a result of the staying of the proceedings does not outweigh the legitimate interest of the intervener in waiting for the outcome of G 2/24.
56. Overall, the Board concludes that it is more equitable to stay the proceedings, which results in limited disadvantages for both parties, but does not affect their substantive position in the opposition proceedings. This is preferable to giving the proprietor an unreserved advantage over the intervener, who would otherwise immediately and irrevocably lose their opposition case in the proceedings before the EPO. Furthermore, the latter course of action would be based on an interpretation of the Convention that the Board currently considers to be doubtful.

Order

For these reasons it is decided that:

The appeal proceedings are stayed until the proceedings in the referral G 2/24 before the Enlarged Board of Appeal are terminated.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

M. Kollmannsberger

Decision electronically authenticated