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28 June 2019

Enlarged Board of Appeal
European Patent Office
80298 Munich
Germany
Attn. Mr Wiek Crasborn, registry
EBAmicuscuriae@epo.org

Re: Amicus Curiae brief regarding G 2/19, right to oral proceedings in case of prima facie inadmissible appeal, and right to a hearing at the correct place, resulting from T 0831/17, EP application no.: 10182497.7

Dear Sirs,

We are writing to provide Intellectual Property Owners Association (IPO)'s view on the question referred to the Enlarged Board of Appeal (EBA) in G 2/19. IPO is pleased to be able to provide its opinion on the questions referred.

Intellectual Property Owners Association is an international trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, executive, law firm, or attorney members.

The members of the IPO Boards of Directors, which approved the filing of this brief, are listed in the appendix of this letter. IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

In the above-mentioned decision, the following questions of law have been referred to the Enlarged Board of Appeal:

1. Ist im Beschwerdeverfahren das Recht auf Durchführung einer mündlichen Verhandlung gemäß Artikel 116 EPÜ eingeschränkt, wenn die Beschwerde auf den ersten Blick unzulässig ist?
2. Wenn die Antwort auf Frage 1 ja ist, ist eine Beschwerde gegen den Patenterteilungsbeschluss in diesem Sinne auf den ersten Blick unzulässig, die ein Dritter im Sinne von Artikel 115 EPÜ eingelegt und damit gerechtfertigt hat, dass im Rahmen des EPÜ kein alternativer Rechtsbehelf gegen eine Entscheidung der Prüfungsabteilung gegeben ist, seine Einwendungen betreffend die angebliche Verletzung von Artikel 84 EPÜ nicht zu berücksichtigen?

3. Wenn die Antwort auf eine der ersten beiden Fragen nein ist, kann die Kammer ohne Verletzung von Artikel 116 EPÜ die mündliche Verhandlung in Haar durchführen, wenn die Beschwerdeführerin diesen Standort als nicht EPÜ-konform gerügt und eine Verlegung der Verhandlung nach München beantragt hat?

In English:

(1) In appeal proceedings, is the right to oral proceedings under Article 116 EPC restricted if the appeal is prima facie inadmissible?

(2) If the answer to Question 1 is in the affirmative, is an appeal prima facie inadmissible in this sense, if the appeal is filed against the decision granting a patent, by a third party within the meaning of Article 115 EPC, and which has been justified by arguing that there is no alternative remedy under the EPC against a decision of the Examining Division not to take into account the third party's objections concerning the alleged violation of Article 84 EPC?

(3) If the answer to one of the first two questions is no, can the Board hold oral proceedings in Haar without violating Article 116 EPC, if the appellant complains that this location is not in conformity with the EPC and requests that the oral proceedings be moved to Munich?

Regarding this case, we respectfully observe as follows:

Background

In this case, a purported appeal against a grant decision by the Examining Division has been filed by a 3rd party who was upset that its Article 115 EPC observations on an alleged lack of clarity were not followed by the Examining Division.

Admissibility

Under Article 112 EPC, a Board of Appeal may submit a question of law to the Enlarged Board of Appeal if it considers that a decision by the Enlarged Board of Appeal is required in order to ensure uniform application of the law, or if a point of law of fundamental importance arises.

It is respectfully suggested that in this particular case, for the reasons set forth below, a decision by the Enlarged Board of Appeal on the questions referred to the Enlarged Board of Appeal is not required as these questions do not have to be answered in order to enable the referring Board to handle this purported appeal.

Pursuant to Article 107 EPC, only *parties adversely affected* by a decision have a right to appeal the decision, which results in two conditions: a first condition is

that an appeal is only open to *parties to the proceedings*, and a second condition is that the party must have been adversely affected by a decision. As explicitly provided by Article 115 EPC, a 3rd party who presented 3rd party observations under Article 115 EPC is not a party to the grant proceedings, so that any purported appeal by that 3rd party is non-existent.

If it were decided that a purported appeal filed by a 3rd party is an existing appeal until it is declared inadmissible by a Board of Appeal, then pursuant to Article 106(1) EPC, the appeal would have suspensive effect until that Board of Appeal decision. Then an appeal by a 3rd party against a grant decision would not only be against the clear intent of the legislator who has explicitly stipulated that 3rd parties having presented observations under Article 115 are not parties to the proceedings, but also have more impact than an opposition, which does not suspend the grant decision, so that the patent can be enforced in court notwithstanding an opposition having been filed, but merely exposes the patent to a potential retroactive full or partial revocation.

We respectfully submit that it was a deliberate decision by the legislator to arrange for a post-grant opposition rather than for a pre-grant opposition. In a pre-grant opposition system, a patent is only granted after the end of an opposition proceedings, or – absent an opposition – the end of the opposition period. This also explains why the EPC explicitly states that a 3rd party having presented 3rd party observations under Article 115 EPC shall not be a party to the proceedings. The legislator thus did not want the grant to be delayed pending the formal conclusion of a procedure started by somebody else than the applicant.

Further, under Article 116 EPC and Rule 115 EPC, only *parties* can be participants in oral proceedings. Again, pursuant to Article 115 EPC, a 3rd party presenting observations is not a party to the proceedings. As a result, a 3rd party is not entitled to participate in oral proceedings, and thus has no interest in either that oral proceedings are held, or – if oral proceedings are held – where any such oral proceeding are held.

So, the right to oral proceedings is not merely restricted in this case, as it is completely non-existent for the 3rd party as there is no appeal, and as the 3rd party is not entitled to participate in any oral proceedings anyway. Consequently, the 2nd and 3rd questions do not need to be answered either.

The referring Board of Appeal is thus perfectly able to handle the purported appeal without an answer by the Enlarged Board of Appeal to the questions that have been referred to it.

Substance

Should the Enlarged Board of Appeal decide that the referral is admissible, it is respectfully suggested that the questions be answered as follows:

1. For the above-mentioned reasons, a 3rd party within the meaning of Article 115 EPC has no right to oral proceedings. Should nevertheless oral proceedings be held in which the 3rd party is provisionally admitted to participate because it has filed a purported appeal, the oral proceedings should be strictly limited to the existence of the purported appeal.

2. For the above-mentioned reasons, a 3rd party within the meaning of Article 115 EPC is not a party and cannot file an appeal against the grant decision. Also, it has been a deliberate decision of the legislator to restrict the grounds for opposition to those listed in Article 100 EPC. This particular purported appeal was only filed because the 3rd party could not raise an alleged lack of clarity as a ground for opposition. It would be at odds with the legislator's deliberate decision to exclude a violation of Article 84 EPC as a ground for opposition if 3rd parties (or better: non-parties or outsiders) had a right to appeal the grant decision on the ground of an alleged lack of clarity.

Clearly, accepting that appeals filed by entities having filed a third party observation under Article 115 EPC exist until declared inadmissible, may open a door to a large number of clearly inadmissible appeals because of the suspension of the grant of a patent to a competitor obtained as a result of such a clearly inadmissible appeal. We don't believe that the EPO Board or Appeals and patentees should be burdened by unnecessary additional workload. We therefore respectfully submit that such purported appeals should be considered as non-existing rather than as inadmissible, so that there is no suspensive effect.

3. In view of the previous answers, the third question does not need to be answered. Should the Enlarged Board of Appeal nevertheless believe that the third question needs an answer, we respectfully offer the following considerations. Any interpretation of Article 6 EPC that "Munich" just means the city of Munich would imply that "The Hague" also just means the city of The Hague, and that would be at odds with the factual situation that the EPO's branch in The Hague has never been located in the city of The Hague: it has always been located in Rijswijk, which is a different city. The EPO is the successor of the Institut International des Brevets (IIB) in that the IIB's tasks, assets and staff have been taken over by the EPO, and when the EPO took over the IIB, the IIB was likewise located in Rijswijk, not in the city of The Hague.

Under Article 31(1) of the Vienna Convention on the law of treaties, a treaty provision must be interpreted in its context and in the light of its object and purpose. The object and purpose of a seat provision is not to indicate the precise city, but just to ensure that a certain country is responsible for hosting an international organization, and that this country enjoys the economic benefits of having the international organization within its borders. As there is no reason why the EPC states would be interested in whether the EPO has its seats in the precise cities of Munich and The Hague rather than in suburbs thereof, or somewhere else in the host states, it must be concluded that Article 6 EPC when referring to

Munich and The Hague does not intend to precisely define the respective cities of Munich and The Hague, thereby excluding the respective suburbs Haar and Rijswijk.

Also, as from the date that the EPO started its operations, the EPO's branch in The Hague was located in the then IIB building in Rijswijk rather than in the city of The Hague, it is clear that the EPC states never intended the geographical locations to be precise indications of cities, and this practice should be taken into account under Article 31(3)(b) of the Vienna Convention on the law of treaties.

As a result, also all references to "Munich" are just general indications of the region Munich rather than precise indications of the city of Munich.

Further, the notion "Munich" is ambiguous: it could refer to the Landeshauptstadt München, or to the neighboring Landkreis München, which includes Haar.

The EPC does anyhow not prescribe that the EPO Boards of Appeal can only be located in the city of Munich, as under Article 10(2)(b) EPC the President may decide that the Boards of Appeal should be located in (the city of) The Hague, which also hosts the International Court of Justice, the Permanent Court of Arbitration, and the International Criminal Court, so that The Hague would thus be a quite suitable location for the EPO Boards of Appeal. We understand that this competence has now been delegated to the President of the Boards of Appeal. Also Berlin could be a perfectly lawful location for the EPO Boards of Appeal.

We respectfully submit that a tremendous lack of legal certainty would result from any decision that in Article 6 EPC, "Munich" just means the city of Munich, as:

- this would cast doubt on the validity of all Board of Appeal decisions taken in Haar, and
- this would necessarily imply that "The Hague" also just means the city of The Hague, so that it could be doubted whether European patents granted by examining divisions in Rijswijk have been validly granted, and whether European patents revoked by opposition divisions in Rijswijk have been validly revoked.

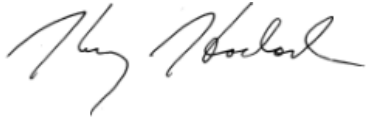
We therefore respectfully urge the Enlarged Board of Appeal to refrain from any such decision.

In view of the above, we respectfully submit that it is perfectly lawful for the Boards of Appeal to be located in Haar and to hold oral proceedings in Haar.

INTELLECTUAL PROPERTY OWNERS ASSOCIATION

We hope that the above suggestions are useful.

Yours faithfully,

A handwritten signature in black ink, appearing to read "Henry Hadad". The signature is fluid and cursive, with the first name "Henry" written in a larger, more prominent script than the last name "Hadad".

Henry Hadad
President

APPENDIX¹

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