Dear Chair and Members of the Enlarged Board of Appeal,

The following questions were referred with decision T831/17 (OJ 2019 A51):

1. In appeal proceedings, is the right to oral proceedings under Article 116 EPC limited if the appeal is manifestly inadmissible (“auf den ersten Blick unzulässig”)?

2. If the answer to the first question is yes, is an appeal against the grant of a patent filed by a third party within the meaning of Article 115 EPC, relying on the argument that there is no alternative legal remedy under the EPC against the examining division's decision to disregard its observations concerning an alleged infringement of Article 84 EPC, such a case of an appeal which is manifestly inadmissible?

3. If the answer to either of the first two questions is no, can a board hold oral proceedings in Haar without infringing Article 116 EPC if the appellant objects to this site as not being in conformity with the EPC and requests that the oral proceedings be held in Munich instead?

1. I will discuss the third question first and propose that the question should address Article 113 EPC as well, not only Article 116 EPC. Otherwise, I have no comments on whether Haar is a lawful place for oral proceedings under the EPC.

   I will then discuss the first question and propose firstly that the question is inadmissible; secondly that the question needs to be clarified or reformulated. In the end, the answer to the first question should be “No” in my view (§5 ff.). This proposed answer makes the second question moot (§30 ff.).

2. The referring Board provided a detailed analysis of G1/97 and T1042/07. I additionally submit some comments on this analysis (§32 ff.). Briefly, I note that in G1/97 the “appeal” was not treated according to its formal appearance but according to its substance, and hence as a request for review rather than as an appeal. Accordingly, G1/97 did not hold that appeals can be disposed of without oral proceedings, it only said so for such requests for review (which did not exist at that time). In the present case, the underlying appeal is in substance protest of a third party against the grant of a European patent. I therefore propose that the present underlying “appeal” should perhaps in line with G1/97 be treated for what it essentially is, namely an opposition.
I. Third question: also Article 113 EPC

3. The third question asks if oral proceedings can be held in Haar under Article 116 EPC. In my view, the issue concerns Article 113(1) EPC as well.

In particular, a duly summoned party who is absent at the oral proceedings may be treated as relying only on its written case (Article 15(3) RPBA). For ex parte cases, if the appellant decides not to attend oral proceedings, the Board’s decision can be based on objections which are new to the appellant and which could not be communicated to the appellant due its absence at the oral proceedings; the requirements of Article 113 EPC are then met because the appellant could have attended the oral proceedings (CLBA, 8th ed., III.B.2.7.3). In other words, “if a duly summoned appellant does not attend the scheduled oral proceedings”, the appellant “waives the opportunity to present its comments on new grounds”; the waiver is of the right to be heard under Article 113(1) EPC (T1367/09, hn.II). This case law clearly assumes that the oral proceedings are held at a lawful place, i.e. the party’s absence is only a waiver under Article 113(1) EPC if the oral proceedings are duly held. The same applies for the provision in Article 15(3) RPBA that a duly summoned party who is absent may be treated as relying only on its written case.

4. The location of the oral proceedings is therefore relevant not only for Article 116 EPC (the right to request oral proceedings) but also for Article 113(1) EPC (the right to be heard). For Article 113(1) EPC, it does not matter at all if the oral proceedings were summoned on request of a party or by the Board of own motion. For instance, if a Board summons a party for second oral proceedings on the same subject (e.g. to ask further questions), the party has no right to request such second oral proceedings under Article 106(1), second sentence. Nevertheless, such second oral proceedings are only effective as “opportunity to comment” under Article 113(1) EPC if they are held in a lawful place.

II. The first question

II.A. Admissibility

5. The first question was asked as a preliminary question to the third question (T831/17, r.4). However, if the third question is reformulated so as to cover both Article 113(1) and Article 116 EPC (as proposed above), then the third question needs to be answered irrespective of whether the appellant has a right to request oral proceedings. In other words, the third question needs to be dealt with even if the answer to the first and second question is
both “yes”. Accordingly, the first question is not “essential to reach a decision on the appeal in question”, which is a requirement for admissibility of a question referred to the Enlarged Board (CLBA IV.F.2.3.3).

6. Furthermore, even if the first question is limited to Article 116 EPC, it is observed that the referring Board intended to hold oral proceedings. The Board can hold oral proceedings of own motion, even in case the appellant has no right to request oral proceedings. However, also in case of oral proceedings held of the Board’s own motion, the question may be asked if the oral proceedings can be held in Haar without infringing on Article 116 EPC. Again, an answer to the first question is not essential for the decision on the appeal in question.

7. For completeness’ sake, I note that question 1 does not “derive” its admissibility from the admissibility of question 3. Admissibility must in my view be assessed for each question individually. Of course, if different issues are combined as sub-questions in one numbered question (as in co-pending case G3/19), admissibility is to be assessed for each sub-question individually.

II.B. Interpretation of the first question

8. If the first question is admissible, it needs to be clarified. The question asks whether “the right to oral proceedings is limited under Article 116 EPC”. However, a first limitation is given already in the second sentence of Article 116(1) EPC itself (namely, essentially no right to second oral proceedings). This limitation applies irrespective of whether the appeal is admissible or not. This limitation of Article 116 EPC is of course not what the first question is actually about.

9. In view of r.4 of the referral decision, the first question asks essentially whether a request for oral proceedings of the appellant may be refused under Article 116 EPC on the sole ground that the appeal is manifestly inadmissible.

10. The phrase that an appeal “is” manifestly inadmissible also requires further interpretation. Prior to the Board taking the actual decision on admissibility, the phrase can only mean that the Board has as (preliminary) opinion that the appeal is to be rejected as inadmissible. Most often, the appellant will at the same time be of the opinion that his appeal “is” admissible.

   Indeed, the referring decision states that “the appeal hence appears (“erscheint”) unambiguously inadmissible to the Board” (r.4.6) and that the underlying appeal belongs
to the “seemingly inadmissible appeals” (“ersichtlich unzulässiger Beschwerden”). Hence, question 1 concerns the situation before the appeal is rejected as inadmissible and therefore addresses cases wherein the preliminary opinion of the Board is that the appeal is to be rejected as inadmissible. Indeed the referring Board refers to “their preliminary assessment” (Ihrer vorläufigen Einschätzung) that the appeal is inadmissible (r.3.4).

11. Accordingly, question 1 asks essentially whether a decision to refuse a request for oral proceedings of the appellant complies with Article 116 EPC if it is taken on the sole ground that the board is of the opinion that the appeal is manifestly inadmissible.

12. Furthermore, the phrase “auf den ersten Blick unzulässig” in the (original) German version of the first question requires some interpretation as well. The phrase is certainly not a well-established term in the case law of the Boards (the case law database gives T 831/17 as the only result for the German phrase).

For the translation “manifestly inadmissible” a case law search gives three results. In T 460/95 of 20.10.1997, the Board only states that it had not found the appeal “manifestly inadmissible” in the earlier interlocutory decision on re-establishment. T 1090/08 avoids “the legal problems that might arise from manifestly inadmissible appeals” by deciding that the appeal is deemed to not have been filed. T 765/08 uses identical wording. Hence, there is no example of an appeal that is actually found to be “manifestly inadmissible”.

Moreover, it is not clear if the referring Board intended the term “auf den ersten Blick unzulässig” to mean “manifestly inadmissible” as used in these three decisions.

13. Starting with the provisions of the EPC, Rule 109(2)(a) EPC uses “clearly inadmissible” for petitions for review. This term appears only superficially similar. The practice of the Enlarged Board shows a rather in-depth examination of the admissibility of petitions for review already by the three-member panels under Rule 109(2)(a) EPC. In practice, “clearly inadmissible” seems to be given effect by the provision that the three-member panels can reject petitions only unanimously (Rule 109(2)(a) EPC); this applies equally to the rejection of petitions as “clearly unallowable”.

More importantly, Article 116 EPC does apply “in the first stage of the proceedings”, hence under Rule 109(2)(a) EPC, as far as the petitioner is concerned (CLBA IV.F.3.8). Petitions for review are therefore rejected as “clearly inadmissible” only after oral proceedings if these are requested.
Furthermore, the phrase “clearly inadmissible” indicates the final decision on the admissibility of the petition, not a procedural situation prior to this decision. Hence, the term “clearly inadmissible” refers to a different legal concept which is specific for petitions for review.

14. In view of the term “auf den ersten Blick unzulässig” in the German original version of the first question, the term “prima facie” needs to be discussed as well, because that term is used extremely frequently in the case law of the Board.

15. The landmark decision is G9/91, r.16, holding that late grounds are only to be considered by opposition divisions “in cases where, prima facie, there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent”. The term “prima facie” itself is however not beyond the need of explanation. According to T2324/14, r.2.4, “[a] prima facie judgment is one which is made at first sight and is commonly understood to be one assumed to be correct until proven otherwise. Therefore, in making a prima facie judgment, the deciding body concedes that the judgment may not survive further scrutiny and may turn out to be incorrect on further investigation.”

In question 1 of the present referral, the term “auf den ersten Blick” is not used to indicate that the appeal is inadmissible based on a judgement that “may not survive further scrutiny”. At least in my view, it would be unheard of if Article 116 is curtailed based on assessments that “may not survive further scrutiny”.

In other words, the term “prima facie” is used in the case law when a body (Board or Division) exercises a discretionary power to admit (or not admit) something (request, evidence). The prima facie allowability is used as a criterion for how the discretionary power on admissibility is exercised. The present first question is however not at all about the exercise of a discretionary power, neither is it about prima facie allowability.

16. Using the terminology of the English translation of the first question, the referring Board considers the underlying appeal to be manifestly inadmissible. In other words, the Board is very certain of its opinion that the appeal is inadmissible. This is in line with the referring decision stating that “the appeal hence appears (“erscheint”) unambiguously (“eindeutig”) inadmissible to the Board” (r.4.9).

The similar phrase “obviously inadmissible appeal” has been used in the literature as a class of appeals which would lack suspensive effect under Article 106(3) EPC. For
instance, Visser’s *Annotated EPC*, Art.106(1):2 (2018) refers to *Münchner Gemeinschaftskommentar* (MGK vol. 20) Art.108, §39 for the position that not any inadmissible appeal lacks suspensive effect, but only “obviously inadmissible appeals” (and appeals that are deemed to not have been filed). The MGK, in turn, refers to Singer/Stauder *EPÜ*, which refers in Art.106, §26 (7th edition) to some handbooks on German patent law, *inter alia* Benkard *PatG*. Benkard *PatG* §75, rm.3 (11th edition) states that it has been proposed that, even though admissibility of an appeal is not a requirement for suspensive effect, “offensichtlich” inadmissible appeals lack suspensive effect (just as appeals which are deemed to not have been filed). This would be an “immer hochstreitigen Auffassung”; the author points out that the question of whether the appeal is “statthaft” and whether the appeal fee is timely paid can be difficult to answer in individual cases (*idem* Benkard *EPÜ* Art.106 §43, 3rd edition). It is therefore not at all settled in the literature whether appeals are only pending (and have suspensive effect) if the formal requirements for admissibility are met.

17. The literature cited above suggests that the term “obviously inadmissible” is used to indicate that the defect causing the inadmissibility is particularly severe, not so much that the presence of the defect is beyond doubt. As an example: if the Notice of appeal is late filed, this makes the appeal obviously inadmissible, even if the issue requires careful examination of the facts (e.g. under Rule 134(2) EPC). Hence, if a ranking of deficiencies is to be made according to their severity, “obviously inadmissible” sits between “deemed not to have been filed” (certainly no suspensive effect) and “inadmissible” (suspensive effect). However, for Art. 116 EPC, it is well established that oral proceedings are held, if requested, even if the Board is of the opinion that the appeal is to be rejected as inadmissible or even as deemed not to have been filed (e.g. T1946/15); in this way the EPC is different from German patent law (§79(2) second sentence PatG).¹ Hence, before the EPO, oral proceedings are held even for appeals with the most severe defects which make the appeal deemed to not have been filed (and, incidentally, the EPO does so on good grounds: e.g. in case of a purported transfer of a patent, application or opposition, a detailed examination of the facts and legal analysis can be indispensable to determine whether the appellant was

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¹ The remark in G9/92, r.8 that “[o]nly those parties that lodge an admissible appeal have the status of appellant” does not change it. In the cited passage the Enlarged Board only summarizes G2/91, r.6.1 which explains that non-appealing parties as of right do not acquire the status of appellant. Nothing in G9/92 indicates that the Enlarged Board wishes to deprive an applicant of the right to be heard and to oral proceedings on issues of admissibility or that the approach of §79(2) German Patent Act is to be adopted.
a party to the first instance proceedings, a successor in title, or merely a third party). If oral proceedings are held even in case of the appeal (possibly) suffering from the most severe defects (which make it deemed to not have been filed), oral proceedings are logically also to be held if the appeal is “obviously inadmissible”, if that term is understood as “inadmissible because of a particularly severe defect”. However, if the term “manifestly inadmissible” does not indicate the severity of the defect (note that T831/17 does not indicate so), then the term is not to be equated with the “obviously inadmissible” appeals in the literature.

18. I therefore assume that with the first question, the Board essentially asks whether a decision to refuse a request of the appellant for oral proceedings complies with Article 116 EPC if it is taken on the sole ground that the board is of the opinion that the appeal is “manifestly inadmissible”, this phrase meaning something else than the discussed phrases “clearly inadmissible”, “prima facie” inadmissible and “obviously inadmissible”.

II.C. Proposed answer: No

19. In view of the above and the referring decision, the appeal being “manifestly inadmissible” appears to indicate that the Board is highly convinced of its preliminary opinion that the appeal is to be rejected as inadmissible.

In my view, such a conviction is of its own insufficient to deny oral proceedings. A more objective threshold is required, if one were to accept such an exception to Article 116 EPC at all.

20. Possibly the term “manifestly inadmissible” can be understood as requiring that the Board is exceptionally certain of its preliminary opinion that the appeal is to be rejected as inadmissible even when all facts are assumed to be as asserted by the appellant (hence, no dispute in fact). Because the facts are assumed in favour of the appellant, the high degree

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2 Numerous examples are given in CLBA IV.C.2. I note that in these decisions, the appellants at least asserted to be a party to the first instance proceedings or a successor in title, unlike the appellant in the underlying appeal.

3 J28/03, r. 18 uses the term in a different way: “it being irrelevant whether the appeal might have been obviously inadmissible from the very beginning or if it was rejected as inadmissible at a later stage”. T765/08, r.9 uses “manifestly inadmissible […] appeals” to indicate deficiencies which make the “pending status” (i.e. the suspensive effect) doubtful. T765/08 adds that the sanction that the appeal at issue was deemed not to have been filed “avoids the legal problems that may arise from manifestly inadmissible […] appeals”.

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of certainty means more specifically that the Board is very certain that the legal rules which it intends to apply to the (assumed) facts are the correct rules under the EPC. At the same time, it can be assumed that, if the appellant maintains his case, the appellant has a different view of what the rules under the EPC are (as said, the facts are already assumed in his favour).

21. This raises the fundamental question: how can we objectively be (sufficiently) certain that a rule is the “correct law”? The law can be different from the plain text of the statute or treaty (e.g. G9/93 holding that self-opposition is not allowed despite Art.99(1) EPC referring to ‘any person’; G1/86 extending re-establishment to opponents in certain cases). The highest courts (and the Enlarged Board) can also come back from their earlier decisions (see again G9/93). The EPC does not have a rule of stare decisis.

22. Therefore, in my view, the phrase “manifestly inadmissible” does not sufficiently objectively delimit a class of appeals to form the sole basis for denying oral proceedings.

23. At this point, I note that the refusal of oral proceedings in T1042/07 and G1/97 was not, or at least not explicitly, based on “manifest inadmissibility” (see also §32 below). T1042/07 is based on the deemed abandonment of a request for oral proceedings based on the lack of any substantive response to a notification of the (preliminary opinion of) inadmissibility of the appeal. G1/97 is based on treating the purported appeal not according to its form (appeal) but according to its substance (request for review) and the fact that no such procedure for review existed under the EPC 1973.

24. In sum, “manifestly inadmissible” is neither an established concept in the case law nor a workable definition for delimiting a class of appeals where the appellant has no right to oral proceedings.

25. I therefore propose that the first question is answered with: no, a request for oral proceedings cannot be refused under Article 116 EPC on the sole ground that the Board is of the (preliminary) opinion that the appeal is manifestly inadmissible.

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4 T1042/07 already allows dispensing with oral proceedings if the appellant does not maintain his case.

5 The need for the phrase “auf den ersten Blick unzulässig” to define a class of appeals is clear from r.4.6, where the Board indicates that the purpose of the second question is to ask if the underlying appeal belongs to the sub-class of “ersichtlich unzulässiger Beschwerden” where no oral proceedings are necessary, or to the sub-class where oral proceedings are to be held if requested. The former sub-class corresponds to the “auf den ersten Blick” inadmissible appeals of the first question.
II.D. An exception for manifestly inadmissible appeals is problematic

26. I note that the above reasoning applies equally to appeals which are “manifestly unallowable”. Suppose that an appeal is based solely on the argument that a certain document is not prior art because it was published in Japanese and skilled person is therefore not able to read it. Answering question 1 with “yes” raises the question whether such a manifestly unallowable appeal is to be treated differently under Article 116 EPC, or if oral proceedings can be refused in such a case as well. Preliminary opinions of Boards that an appeal (even though admissible) is bound to fail on the substance may be not so infrequent (the same may apply by analogy for first instance proceedings).

27. Under G1/97, the decision is issued immediately, i.e. without giving the requester the opportunity to comment (cf. T883/06). Accepting an exception to Article 116 for manifestly inadmissible appeals therefore raises the further question if the right to be heard under Article 113 EPC is curtailed as well, i.e. the right to reply in writing to a Communication of (the Registrar of) the Board informing the appellant that the appeal is likely to be rejected as inadmissible. If the exception to Article 116 EPC is accepted, then it seems desirable to also provide clarity about how Article 113 EPC is to be applied in such cases.

II.E. Oral proceedings do not pose an undue burden

28. On the other hand, even if a request for oral proceedings under Article 116 EPC is to be granted, the conduct of the oral proceedings is governed by the Board; this includes the available speaking time. Parties have no unrestricted right to speak as long as they wish. Furthermore, there appears to be no legal rule that oral proceedings always last at least half a day. Hence, in the underlying appeal, the referring Board can give the appellant a speaking time commensurate with the appellant’s case, just as in any other appeal.

29. Furthermore, in order to reduce the burden of the oral proceedings for respondents, it could be considered to summon only the appellant. This gives a guarantee to the respondent that, should the appellant unexpectedly convince the Board that the appeal is possibly admissible, second oral proceedings will be held (for which both parties are summoned) before a decision is taken that the appeal is admissible. Hence, the respondent can safely be absent from the (first) oral proceedings held on request of the appellant. Of course, the Board can reject the appeal as inadmissible already during such (first) oral proceedings (similarly to the streamlined petition for review proceedings under Rule 109(2)(a) EPC).
III. Second question

30. Since my proposed answer to the first question is (essentially) “No”, the second question is not relevant.

31. I only observe that the referring decision employs a rather subtle terminology in r.4.6, where the Board states that the appeal appears (“erscheint”) unambiguously (“eindeutig”) inadmissible. I would say that this is synonymous with the appeal being “auf den ersten Blick” inadmissible (to use the original German). Yet, whether or not the specific facts of the underlying appeal make it “auf den ersten Blick” inadmissible appears to be the gist of the second question. It is difficult to see how, if an appeal appears unambiguously inadmissible, there can be doubt about whether it is also “auf den ersten Blick” inadmissible, unless the latter term is defined in some special way. The second question indeed asks if the appeal (as described therein) is “auf den ersten Blick” inadmissible “in this sense”, but the only meaning given to the phrase in question 1 (if answered in the positive) is that the right to oral proceedings is limited. In my view, this almost invites circular reasoning.

III.A. The analysis of G 1/97 and T 1042/07 in the referral decision

32. From the referral decision, r.4.4, it is clear that the Board asks essentially whether there is a class of appeals, encompassing G 1/97 and T 1042/07, where the right to oral proceedings does not apply. The referring Board proposes that G 1/97 and T 1042/07 have as commonality that the appeal is manifestly (“auf den ersten Blick”) inadmissible and asks if this commonality supports a general rule. In my view, G 1/97 and T 1042/07 do not have such a commonality at all. Hence, they do not form a basis for the suggested general rule.

33. G 1/97 deals with appeals against decisions of the Boards. G 1/97 indeed refers to a decision “on inadmissibility” that is issued “immediately and without further procedural formalities” (G 1/97, hn.II; the “procedural formalities” include oral proceedings in view of r.6). However, importantly, G 1/97 does not say that an appeal is to be rejected in such a way. Rather, the Board states that “requests aimed at the revision of a final decision of a board of appeal having the force of res judicata” should be rejected in this way. The preceding key step (in G 1/97, r.1) is that all requests, “irrespective of how [the party] had defined them” were treated as “requests aimed at obtaining a review of the latter decision after it had become final”. It is this step of treating the requests not according to their form or title, but according to their substance (i.e. as a request for review), that allowed the Enlarged Board to conclude that the requests were for “a remedy (in the broad sense)
which is non-existent”. Clearly, the requests under their formal appearance (appeal, re-establishment, and request for correction of error in G1/97) were directed to existing remedies. It would be strange for the Enlarged Board to have said in G1/97 that an appeal is a “non-existent” remedy.

In sum, there is no holding in G1/97 that appeals can be rejected “immediately and without further procedural formalities”. G1/97 only says so for requests for review.

34. I note that G1/97 does not use the phrasing that the request is “auf den ersten Blick unzulässig”, “manifestly inadmissible”, or any similar phrasing. G1/97 only states that “the inadmissibility is of a very particular kind” because “the situation is that of a remedy (in the broad sense) which is non-existent”.

35. T1042/07, on the other hand, deals with cases where the appellant does not reply to the “notification of the inadmissibility of the appeal”. This lack of substantive response “is considered as equivalent to an abandonment of the request for oral proceedings”, on the condition of “the absence of anything that can be regarded as a statement of grounds of appeal” (r.3, hn.). In my view, the conclusion in T1042/07 that the lack of response is “equivalent to an abandonment of the request for oral proceedings” is the legal basis for the dispensing with the oral proceedings. The “absence of anything that can be regarded as a statement of grounds of appeal” is a further condition, but is not sufficient of its own.

The referring Board (T831/17, r.4.3) however proposes that the disposal of the case without oral proceedings in T1042/07 (and the subsequent appeals mentioned in r.4.3) was actually based on the oral proceedings being a mere formality (“reine Förmelei”, T831/17, r.4.3) in case the inadmissibility of the appeal is clear at first sight.

36. Just to be clear, T1042/07 does not use “mere formality” or any similar term. In T1042/07, the Board rather considers “the initial auxiliary request for oral proceedings to have become obsolete as a consequence of the subsequent course of action taken”.

37. The referring Board comes to this proposal for a different legal basis for T1042/07 because “qui tacet consentire videtur” would not be a general principle under the EPC, as would follow from G1/88 and e.g. T2687/17. However, the legal reasoning in T1042/07 cannot retroactively be changed. If the legal reasoning T1042/07 and following decisions is doubted, this rather indicates that this line of case law should not be generalized further.

38. Hence, there is no basis in the case law for merging T1042/07 together with G1/97 into a novel class of appeals that are “at first sight inadmissible” or “manifestly inadmissible”.
IV. Applying the reasoning of G1/97 to the underlying appeal

39. The above does not mean that the request for oral proceedings before the Board must be granted in the underlying appeal. In particular, the reasoning of G1/97 provides a legal basis for refusing the oral proceedings.

40. G1/97 assumes somewhat implicitly that not any kind of letter addressed to the Boards gives a right to oral proceedings. This can be understood by taking into account that Article 116 EPC gives the right to oral proceedings only to parties to “the proceedings”. Herein, the term “proceedings” must be understood in a legal sense, namely as referring to proceedings established by the EPC. It is this requirement, which makes that not any kind of (complaint) letter of a person to a Board of Appeal gives that person a right to oral proceedings: not any letter establishes “proceedings” in the sense of Article 116(1) EPC. In that sense, G1/97 illustrates that requests for remedies which are “non-existent” under the EPC do not give rise to “proceedings” in the sense of Article 116 EPC. This applies irrespective of whether the response to the request is an administrative or a judicial measure (G1/97, r.6, §3).

41. Whether a letter establishes appeal proceedings is governed not by the form but by the substance. Hence, merely giving a complaint letter to the Board the title “Notice of appeal” and attaching a debit order for the appeal fee does not automatically cause the letter to establish (appeal) proceedings in the sense of Article 116 EPC. This is again exemplified by G1/97 (F&S.II) stating as a matter of fact that a “Notice of appeal” was filed (it can be assumed that the appeal fee was paid and the Statement of grounds was filed as well).

42. Hence, even though formally a Notice of appeal was filed in G1/97, this appeal was deemed to be a request for a “non-existent” remedy. This was so because in substance the appeal was a request for review (G1/97, r.1); this kind of request did not exist under EPC 1973. The Enlarged Board found that “the conclusion is […] inescapable that the texts of the EPC do not provide for requests of the kind [at issue]”. The same can be said of the underlying appeal because the EPC does not provide for appeal by third parties against grant decision – rather Article 99 EPC provides for opposition.

V. Treatment according to the substance: Notice of opposition

43. A second approach, perhaps even more in line with G1/97, r.1, is, therefore, to ask if the underlying ‘appeal’ should perhaps be treated according to its substance rather than its
formal appearance. In particular, the underlying "appeal" appears to be in substance a Notice of opposition.

44. As a general rule, an incorrect title of a request does not make the request invalid, rather the objectively discernible will of the requester must be taken into account (J6/08). Moreover, the rule of treating requests according to their substance (rather than their form) is not restricted to cases wherein the requester is mistaken or cases where the rule works to the benefit of the requester. Consent of the request is also not required. A prime example of this is G1/97, where all formally distinct requests (including a request for re-establishment of rights and a notice of appeal) were treated according to their substance rather than their form. In the underlying decision J3/95, r.3, the Legal Board found “that the purpose of all the requests submitted […] was to obtain a review of the decision and the suspension of the effects of the decision pending that review. That is true irrespective of how they have been defined.” The requests were dealt with accordingly. Neither J3/95 nor G1/97 indicates that the requester agreed to this.

45. In the present case, the request (titled ‘appeal’) is in effect a protest (filed with the EPO) against the grant of a European patent by a member of the public. This is the essential characteristic of an opposition under Article 99 EPC. Hence, treating the request according to its substance, i.e. as a Notice of opposition, appears possible (and the request can be forwarded to the Opposition Division).

46. In the present case, the request is for the greater part based on the alleged lack of clarity of the claims which is not a ground of opposition. If lack of clarity was the only ground, this could lead to the inadmissibility of the opposition.

However, §2.4 of the Statement of grounds actually also includes an attack of lack of novelty and inventive step over a German patent publication. As the Statement of grounds was filed well within the nine-month opposition period, the opposition may for this part be admissible and possibly also successful.

47. If the request is treated as a Notice of opposition, the opposition division can order a cost apportionment under Article 104 EPC (against the opponent) if it considers that equity demands so, for example if the filing of a manifestly inadmissible appeal/opposition is seen as an abuse of procedure. In this way, the costs incurred by the proprietor during the complete procedure can be compensated and an equitable outcome can be arrived at in the underlying case without refusing any request for oral proceedings.
48. The above observations are my personal views only.

Respectfully submitted,

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