

**Interlocutory decision of Technical Board 3.5.03 of 25 February 2019
T 831/17**

(Translation)

Composition of the board:

Chair: F. van der Voort

Members: P. Guntz
A. Madenach

Patent proprietor/respondent: IPCom GmbH & Co. KG

Headword: Haar or Munich as venue for oral proceedings

Relevant legal provisions: Articles 6(2), 112, 115 and 116(1) EPC

Keyword: "Right to be heard at the correct venue" – "Referral to the Enlarged Board of Appeal – by the board of appeal – point of law of fundamental importance" – "Admissibility of appeal" – "Oral proceedings – before the board" – "Right to oral proceedings – even if appeal obviously inadmissible?"

Catchword:

Referred questions:

1. In appeal proceedings, is the right to oral proceedings under Article 116 EPC limited if the appeal is manifestly inadmissible?

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?

Summary of Facts and Submissions

I. The appellant, who was not a party to the examination proceedings but during them filed various observations as a third party, filed the appeal at issue here against the examining division's decision of 12 January 2017 to grant European patent No. 2 378 735 under Article 97(1) EPC.

II. It contests the examining division's disregarding its clarity objections to the granted patent claims under Article 84 EPC and contends that it must be afforded a right to appeal against the grant decision because, owing to the limited number of grounds for opposition, it would otherwise have no legal remedy against this disregard for its objections.

III. In two communications, of 25 May 2018 and 1 October 2018, the board informed the appellant that it was clear from the EPC that the legislative intent had been to confer a right of appeal only on parties to proceedings and not on authors of third-party observations. The boards, it explained, were bound by the EPC and could not independently create new remedies not provided for in the law. The appellant had to expect that its appeal would be rejected as inadmissible.

IV. Agreeing with the board's opinion, the patent proprietor invoked additional grounds for finding the appeal inadmissible (unclear who was supposed to be the appellant, missed time limit and contested decision not adequately specified). These objections, which the board provisionally regards as unfounded, are irrelevant for the purposes of this decision.

V. The appellant contends that its case reveals an unacceptable gap in legal protection and seeks a decision clarifying this fundamental point. It therefore requested oral proceedings on admissibility too but, having been summoned by the board to oral proceedings at the boards' offices in Haar on 25 January 2019, then requested that they be held in Munich instead, arguing that the European Patent Office's seat is there and that – unlike The Hague – Haar was "clearly not specified in the European Patent Convention as a venue for performing legal acts or holding proceedings".

VI. In response, the board postponed the date of oral proceedings pending clarification by the Enlarged Board of Appeal of the points of law set out below.

Reasons for the decision

In the board's view, it is appropriate to refer the question of the correct venue for oral proceedings (question 3) to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC because it is of fundamental importance for multiple appeal proceedings (see point 1 below), answering it will help to ensure uniform application of the law (see point 2 below) and the board considers that a decision on it is required (see point 3 below). Questions 1 and 2 on the need to hold oral proceedings where an appeal is obviously inadmissible are preliminary questions relevant to the decision to be taken. The answers to these questions are also needed to ensure uniform application of the law (see point 4 below).

1. The question of the correct venue for oral proceedings arises in all cases in which parties object to a summons to Haar and is therefore of fundamental importance within the meaning of Article 112(1)(a) EPC, second alternative. Neither a decision by the board not to move the venue of the proceedings nor one to hold them in Munich instead would be liable to dissuade parties to other proceedings from

requesting a change of venue. In the latter case especially, serious legal uncertainty could be expected to prevail until the various boards arrived at a common approach, and there would be considerable organisational problems too. The board therefore considers obtaining a decision of the Enlarged Board of Appeal to be the most suitable way of uniformly settling the fundamental question of the correct venue for appeal proceedings for all boards and cases.

2. The referral will also help to harmonise the case law, which is inconsistent on certain points, in particular as regards the extent of the boards' power to examine requests for a change of venue (see points 3.2.1 and 3.2.2 below and the board's opinion on this in point 3.2.3).

3. The board considers that a decision on the request for a change of venue is required for the following reasons:

3.1 As has been held several times before, the right to be heard in oral proceedings, as a specific component of the general right to be heard, encompasses not only the right to be heard at all but also the right to be able to present arguments at the correct venue (T 1012/03, Reasons 25; T 689/05, Reasons 5.1).

3.2 The correct venue is not automatically the European Patent Organisation's headquarters specified in Article 6(1) EPC; as a rule, it is the site mentioned in Article 6(2) EPC at which the Office department entrusted with the proceedings within the meaning of Article 15 EPC is located, so long as its location there is compatible with the provisions of the EPC (T 1012/03, Reasons 41 et seq.; T 689/05, Reasons 5.3).

3.2.1 Thus, in the decisions cited above, the boards, having been asked after abolition of the geographical separation of search and examining divisions to decide whether examining divisions newly located at the Office's branch in The Hague could summon parties to oral proceedings there, reviewed whether the President of the Office had had the authority to locate them at that branch (T 1012/03, Reasons 41 et seq.; T 689/05, Reasons 5.3).

3.2.2 Similarly, while the board in T 1142/12 concluded that, because arrangements as to the venue, room and date of oral proceedings were organisational in nature and not decisions of an examining division on a patent application, they were not open to review by the boards (Reasons 2.7.1 to 2.7.3), it conceded elsewhere that this conclusion depended on its first being established that the underlying management decision had a basis in the EPC and did not infringe substantial procedural rights of the parties (Reasons 2.12).

3.2.3 This board disagrees with the first of those findings (Reasons 2.7.3): when conducting proceedings entrusted to them, the Office's departments do in fact take decisions on organisational matters that are nonetheless open to review on appeal, for example – as to the date – on whether or not oral proceedings were scheduled sufficiently in advance, and on whether to grant any request for their postponement; but also – as to the venue – on where evidence is to be taken (inspection, hearing of witnesses who refuse or are unable to travel to the department's offices). The various departments' power to conduct proceedings therefore includes deciding themselves on any requests for a change of venue too, and it cannot be ruled out that oral proceedings might be held somewhere else in special cases, for instance at the venue for taking evidence.

The board concurs, however, with the second finding reached in this decision

(Reasons 2.12), and so with the two decisions cited in point 3.2 above too, that it first has to be established whether situating an Office department at a particular site is compatible with the EPC before it can be decided whether summoning parties to that site is lawful and thus in keeping with their right to be heard.

In so far as it is implicit in the juxtaposition of the two findings cited from T 1142/12 that decisions taken in specific circumstances to hold oral proceedings somewhere other than a department's offices are likely to be rare and to be considered a separate matter from the fundamental point of where those offices could lawfully be located under the EPC, the board concurs with this distinction too.

The very purpose of the referral is to obtain a decision settling this fundamental point once and for all and

applying also to all future proceedings before the boards in Haar.

3.3 How it is settled will depend largely on whether the President of the Office or the Administrative Council of the European Patent Organisation, which authorised him to rent the boards' new offices and so to move them to the municipality of Haar, had the power to situate Office departments within the meaning of Article 15 EPC outside the venues specified in the EPC (Article 6(2)), including the Protocol on Centralisation (Section I(3)(a)), or whether "Munich" in Article 6(2) EPC is anyway to be interpreted as referring not to the city of that name but instead to a whole, not more precisely defined region or else the administrative district of the same name, which, together with the Dachau and Fürstenfeldbruck districts, borders the city (which forms its own administrative area and so does not belong to any of those districts).

On international organisations, Schermers and Blokker state in "International Institutional Law" (The Hague, 1995, ISBN: 90-411-0108-X, p. 319): *"The city in which the secretariat is established is usually called the 'seat' of the organization."* Similarly, under the national law applicable in all member-state jurisdictions the board is familiar with, the term used in a legal person's articles of association to specify where it has its seat is understood to denote the city or municipality and not a region or upper-tier administrative unit comprising a number of such areas. The board can see no reason why "Munich" should be interpreted differently for the purposes of Article 6(2) EPC than it is for Article 6(1) EPC. After all, the European Patent Office is also the "secretariat" of the European Patent Organisation, whose founding treaty, the EPC, was signed in Munich (see reference to the place of signature after Article 178 EPC).

In "Visser's Annotated European Patent Convention" (2018 edition, ISBN: 9789403506746, Wolters Kluwer), the author refers in point 1 of the section on Article 6 EPC to an oral statement allegedly made by the "legislator" when the EPC was being revised in 2000 that the names for geographical places mentioned in it were to be interpreted broadly and that, accordingly, "The Hague" meant the province of South Holland and "Munich" Bavaria. Visser unfortunately does not cite any source, and the board's own research has uncovered nothing to support the contention that such a legislative intent was expressed. It is in any case difficult to see how "the legislator", i.e. all the delegations at the November 2000 diplomatic conference as a whole, could even have stated it orally. The conference report (MR/24/00) makes no mention of any oral observation of this kind by even a single

delegation. Revision of Article 6 EPC was not on the agenda and the issue appears not to have been addressed even in the context of deleting "The Hague" from Articles 16 and 17 EPC with a view to introducing the new BEST procedure (conference report, points 61 and 62) or of discussing the Protocol on the Staff Complement (MR/PLD 5/00; conference report, points 321 to 341) or in the delegations' opening remarks (conference report, points 9 to 33). On the contrary, it can be gathered from the materials on the Patent Law Committee's preparation for the conference that the epi's fear "*that the removal of geographic references [from Articles 16 and 17 EPC] might eventually lead to a further dissemination of the locations of the Office*" was considered unfounded because the scope of the BEST project was clearly defined and did not include any plans to revise Article 6 EPC (CA/PL PV 6, points 19 to 22). The board has found nothing to suggest that any of those attending the conference itself alluded to, let alone adopted, a different stance on this.

Besides, when it comes to interpreting "Munich" and "The Hague" for the purposes of Article 6(2) EPC, the board doubts that the same criteria can be applied in both cases. It is perhaps important to bear in mind here that, when Munich and The Hague were agreed on as the sites for the future European Patent Office in June 1972 (see *travaux préparatoires*, BR/219/72, points 173 to 181) and October 1973 (Article 6 EPC 1973), the departments of the International Patent Institute (IIB) to be integrated into it (see Centralisation Protocol, sections I(1) and V(1)) were spread out over several sites in The Hague and the neighbouring Rijswijk area, whereas the only place ever discussed for the Munich site in the lead-up to its establishment was the city itself, where the German Patent Office had its seat too. Thus, in the seat agreement the European Patent Organisation later concluded with the Kingdom of the Netherlands, the branch referred to in Article 6 EPC was defined as "*the branch of the European Patent Office at The Hague (Rijswijk)*" (Article 1 of the agreement), while in the preamble to the one concluded with the Federal Republic of Germany the recital "*whereas, pursuant to Article 6 of the cited Convention [the EPC], the European Patent Office shall be set up in Munich*" mentions only the City of Munich, it then being stipulated that it was to be housed temporarily in the Motorama building but that the Isar building, then still under construction, would be its definitive premises (Article 11(1) and (2) of the agreement). Since sites in neighbouring municipalities were never discussed, the fact that one of the three districts surrounding Munich has the same name as the city is presumably irrelevant for a historical interpretation.

The board is not aware of what precisely the President argued in support of his position in 2016 that moving the boards to a place outside the boundaries of the City of Munich was compatible with the EPC; it has therefore not yet formed any final opinion on this. Nor does it need to for the purposes of formulating a question for referral and that is why it has refrained from first inviting the President to comment under Article 18 of the Rules of Procedure of the Boards of Appeal. If the Enlarged Board of Appeal so wishes, it may do so under Article 9 of its Rules of Procedure.

3.4 The board takes the view that, despite its provisional opinion that the appeal is inadmissible, the question of the correct venue for oral proceedings is relevant even in this case. On this point, it concurs with the prevailing case law (see point 4.1 below), according to which an appellant's request for oral proceedings is generally to be granted, even if the appeal is obviously inadmissible. Although the appellant in this case was not a party to the examination proceedings (see Article 115,

sentence 2, EPC), its filing of an appeal makes it a party to the appeal proceedings. As such, it must, as a rule, be considered to have a right to oral proceedings under Article 116(1) EPC even though its appeal is likely to be held manifestly inadmissible because it lacks standing to appeal under Article 107 EPC. The circumstances appear to be similar to those in T 1259/09, in which a different board held oral proceedings on an appeal filed by a third party who, although not a party to the examination proceedings, had requested a correction of the grant decision and was now appealing against the refusal to make it.

4. Since the case law on the right to oral proceedings where the appeal is obviously inadmissible is inconsistent, the board has decided also to refer the preliminary questions arising as to the need for them in such cases to the Enlarged Board of Appeal for decision in order to ensure that the law is applied uniformly in future.

4.1 In their everyday practice, the boards presume that an appellant's request for oral proceedings must always be granted irrespective of whether the matters for discussion at those proceedings concern the merits or the admissibility of the appeal and irrespective of the degree of any obvious inadmissibility. In the following cases, for instance, the need for or expediency of oral proceedings was never questioned even though only admissibility was at issue: J 9/04, J 9/11 and J 10/15 (no right of recourse to the boards), J 2/93, J 24/94 and J 22/12 (no appealable decision), T 656/98 and T 1259/09 (appellant lacked standing to appeal), T 1633/18 (appeal validly filed but not sufficiently substantiated; see Facts X), J 12/83, T 591/05 and T 84/16 (appellant not adversely affected), J 16/94 (intention to appeal conditional and so not definite), J 10/88 and T 1950/09 (no statement of grounds), T 150/11 and T 2054/15 (statement of grounds filed late), J 10/11, T 502/02 and T 1407/17 (insufficient statement of grounds). In some decisions (see e.g. T 189/06, Reasons 18; T 263/07, Reasons 2.1; T 1426/07, Reasons 4; and T 1251/08, Reasons 2.2), the boards have spoken of an "absolute right" to oral proceedings. According to the board in T 383/87 (see Reasons 9), the threshold for refusing a request for oral proceedings would be reached, if at all, only in very exceptional circumstances amounting to an abuse of law. The boards in T 1829/10 (see Reasons 2.3) and T 2687/17 (see Reasons 2) considered that they had to hold the requested oral proceedings and had no room for discretion on this.

4.2 In G 1/97 (Reasons 6, last paragraph), however, the Enlarged Board of Appeal developed the principle that an appeal against a board's decision, which – because it is based on a non-existent legal remedy – is manifestly inadmissible, is to be rejected by the board without any further procedural formalities and, in particular, without first holding oral proceedings, in order to swiftly restore legal certainty. This principle has since been applied in such circumstances in a number of subsequent board decisions (see, among others, T 402/01 of 4 October 2005, Reasons 3.2; T 431/04, Reasons 4; and T 883/06, Reasons 3).

4.3 In another group of decisions (including T 1042/07, T 234/10, T 179/11, T 1575/16, T 2575/16 and T 95/17), the boards found that oral proceedings could be dispensed with where an appellant who had requested them in its notice of appeal but then failed to file a statement of grounds of appeal did not respond to notice from the board that its appeal would have to be treated as inadmissible. The reason they gave was that the request for oral proceedings had become obsolete, the lack of response having to be considered equivalent to abandoning it. Since the Roman law maxim "*qui tacet consentire videtur*" is not reflected in the EPC, other than in those

provisions explicitly specifying a loss of rights as the consequence of a failure to respond (see G 1/88, Reasons 2.1 and 3; T 861/16, Reasons 2.4.3; and T 2687/17, Reasons 5; diverging from but also not addressing G 1/88: T 655/13, Reasons 2.4.2(b); as an exception to be distinguished from G 1/88: T 1449/05, Reasons 2.9), the idea underlying these decisions also seems to be that it would amount to nit-picking on formalities to hold oral proceedings where the appeal's inadmissibility is manifest.

4.4 Given this background, the first question is referred with a view to clarifying whether the Enlarged Board of Appeal regards the case law it initiated in G 1/97, and possibly also the additional group of decisions starting with T 1042/07, as a principle which may be applied more generally in that the right to oral proceedings on appeal is conditional on the appeal's not being manifestly inadmissible.

4.5 The second question then narrows the scope to the specific circumstances at issue here: a third party who, in observations filed under Article 115 EPC, unsuccessfully alleged during examination proceedings that the patent claims fell foul of Article 84 EPC goes on to invoke an extraordinary right to appeal against the grant decision on the basis that, following the decision in G 3/14, there is no alternative remedy against the examining division's alleged infringement of Article 84 EPC.

4.6 In the board's view, the EPC is clear on standing to appeal and on the fact that the grounds for opposition are listed exhaustively. Even if this ultimately deprives third parties of any opportunity to have an opposition division or a board scrutinise their own arguments on Article 84 EPC and the contrary position adopted by the examining division, it can see no way for it independently to create an extraordinary remedy not provided for in the EPC.

On this point, the Enlarged Board of Appeal has already held in G 1/97 (Reasons 3(b), first paragraph): *"In a codified legal system such as the EPC, the judge cannot simply decide, as the need arises, to substitute himself for the legislator, who remains the primary source of law. He may certainly find occasion to fill lacunae in the law, in particular where situations arise for which the legislator has omitted to provide."* The board can see no unintended gap in the law here that it could then close by analogy. It also concurs with the ruling in G 1/97 (Reasons 3(a)) that Article 125 EPC also cannot be invoked as a basis for creating new remedies.

The circumstances at issue here therefore appear to be similar to those described by the Legal Board in J 10/15 (Reasons 6): *"The board finds instead that the appeal concerns a matter of legal policy for which the contracting states are responsible, namely whether an (additional) remedy should be introduced, be it in a new international agreement or by revising an existing one."*

The board therefore considers the appeal to be clearly inadmissible, which brings the second question into play, i.e. whether the circumstances at issue are to be classed with those cases of obviously inadmissible appeals in which oral proceedings were held to be unnecessary or with the other cases in which oral proceedings must be held on request.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal under

Article 112(1)(a) EPC for decision:

1. In appeal proceedings, is the right to oral proceedings under Article 116 EPC limited if the appeal is manifestly inadmissible?

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?