



## Oppositions newsletter

# Anonymous Third Party Observations in EPO Opposition and Opposition Appeal Proceedings

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The European Patent Office is clearly of the view that anonymous third party observations are not prohibited in first instance opposition proceedings. The President of the EPO decided in 2011 that in first instance opposition proceedings the Opposition Division will comment on the relevance of third party observations. This applied whether or not the observations are filed anonymously and still applies today.

Since the President's 2011 decision, Boards of Appeal have shown different attitudes with regard to the status of third patent observations, and in particular anonymous third party observations.

One Board of Appeal view is that:

- All anonymous third party observations, whether submitted in the first or the appeal instance, should be deemed not filed and thus be disregarded.

Another Board of Appeal view is that:

- Third party observations filed after the expiry of the opposition term, anonymous or not, should be treated as late filed submissions which may be ignored by the Opposition Division in the first instance. However, in view of the decision of the President of the EPO mentioned above, the Opposition Division should comment on the relevance of the observations. The observations need not be mentioned or considered in the decision of the Opposition Division.

The third party has no rights in the proceedings - not even to a reasoned exercise of discretion in the decision with regard to consideration, or not, of the observations.

- Third party observations filed during opposition appeal proceedings should generally be disregarded unless they relate to changes to claims or other parts of the patent made during the opposition or appeal proceedings. In that event, the observations may, or may not, be considered at the discretion of the Board.

A further view is that:

- Third party observations should not be given a more favourable status than submissions of a party to the proceedings. Whether to take the observations into consideration or to disregard them is a matter of discretion to be exercised in consideration inter alia of the relevance of the observations or at which stage of the proceedings they were filed.

Despite these different views, Boards of Appeal seem generally to recognize that:

- If third party observations are "adopted" by a party to the proceedings, or by the Opposition Division or the Board, or a party takes a position on the observations, there should be a reasoned exercise of discretion with regard to consideration, or not, of the observations.

## The different views - more detail

One reason why the status of anonymous third party observations is problematic could be that they might be viewed with suspicion. They could hide a procedural abuse, were they to originate from a party to the proceedings. It has been suggested that a party might be tempted to submit late observations and/or documents as anonymous third party observations in order to avoid negative procedural consequences such as apportionment of costs. Be that as it may, there are of course entirely proper reasons, such as avoiding open confrontation, why a third party might find the anonymous filing of observations to be an attractive proposition. It is difficult to see that abstract suspicion could justify general denial of the possibility of anonymous third party observations if this is otherwise allowed by the EPC.

The EPC does not contain any explicit statement of prohibition of anonymous third party observations, nor does it suggest that "third party observers" should satisfy identification requirements such as those imposed on applicants, opponents and appellants (see Rule 41(2)(c)).

The European Patent Office clearly does not recognize any prohibition of anonymous third party observations in first instance opposition proceedings (or in first instance examination proceedings).

The 2011 decision of the President of the EPO mentioned above provided an online form for the filing of third party observations (<http://tpo.epo.org/tpo/app/form/>).

The decision ("Decision of the President of the European Patent Office dated 10 May 2011 concerning the filing of third party observations under Article 115 EPC by means of an online form") includes this article:

*"Article 2 Signature*

*A signature is not required to file third party observations.*

The accompanying notice ("Notice from the European Patent Office dated 10 May 2011 concerning the filing of third party observations under Article 115 EPC by means of an online form") gives this information:

*"The EPO has also changed its practice to ensure that examining and opposition divisions comment explicitly on the relevance of third party observations."*

*"Observations may be filed anonymously."*

Evidently, the EPO decided that, within what might be seen as a general exercise of discretion, anonymous

third party observations will always receive some consideration (also) in opposition proceedings.

The online form itself now includes this statement:

*"You do not have to provide your personal details. However, if you do not provide them, it will not be possible for us to send you an invitation to correct formal deficiencies. It should further be noted that anonymous third party observations might not be accepted in second instance (T146/07, T1439/09).*

*Select the checkbox if you wish to make an anonymous submission"*

T146/07 (Prenatal diagnosis/ISIS) is an opposition appeal decision dated 13.12.2011 made by Board 3.3.08. The anonymous third party observations concerned were filed very late in the appeal proceedings but this is not the key point in the reasoning of the Board, which would treat anonymous third party observations in first and second instances simply as "not filed".

The relevant part of the reasons for the decision reads as follows:

*"3. . . According to Rule 114(1) EPC, any observations by a third party shall be filed in writing. This requirement implies that the observations have to be signed (see Rules 50(3) and 86 EPC) in order to allow an identification of the third party (see Schachenmann in: Singer/Stauder, Europäisches Patentübereinkommen, 5th ed., Art. 115 marg. no. 13). Identification is particularly important in the context of opposition proceedings in order to allow the competent organ of the EPO to verify whether the observations are indeed filed by a third party rather than by a party to the proceedings. Otherwise, a party might be tempted to submit late observations and/or documents by means of anonymous third party observations in order to avoid negative procedural consequences such as apportionment of costs.*

*4. When a party to the proceedings submits an unsigned document, the document is deemed not to have been filed if, after a corresponding invitation has been sent out by the EPO, it is not signed in due time (see Rule 50(3) EPC). Since unsigned anonymous third party observations do not allow the EPO to send out such an invitation at all, they necessarily remain unsigned. This has the consequence that they are deemed not to have been filed.*

*5. The board is aware that anonymously filed third party observations may nevertheless be adopted by a party to the proceedings as its own or may even trigger objections by the competent organ of the EPO of its own motion (see decision T735/04 of 13 September 2007, point 2 of the reasons, dealing with the exceptional situation that a highly relevant patent application of one of the patent proprietors had been submitted by an anonymous third party). However, in the absence of such a further procedural act, anonymous third party observations are to be disregarded altogether. This view is in line with the decisions G1/03 and G2/03 (OJ EPO 2004, 413 and 448)*

in which the Enlarged Board of Appeal refused to take into account an anonymously filed third party statement (see Section VI(3) of the decisions).

6. Thus, the anonymous observations under Article 115 EPC received on 18 January 2011 are deemed not to have been filed and are disregarded by the board.”

It might be said that the Board of Appeal in T146/07 attempts to “engineer” a prohibition of anonymous third party observations based on lack of a signature. However, the Board of Appeal involved in the following decision is clearly of the view that the “engineering” is flawed.

T1336/09 is an examination appeal decision dated 14.12.2011, made by Board 3.4.02. The decision, delivered a day after the T146/07 decision to which it refers, was plainly made in full knowledge of the detailed reasoning in T146/07. In T1336/09, reasons for the decision read as follows:

“2.2 In respect of the anonymous character of the observations under Article 115 EPC, the Board notes that a Decision of the President of the EPO and a Notice from the EPO, both dated 10 May 2011 and concerning the filing of third party observations under Article 115 EPC by means of an online form made available on the website of the EPO, have been published in OJ EPO 2011, pages 418 and 420 respectively. The Decision in particular allows for third party observations being filed without signature (see Article 2 of the Decision), the Notice states that “Observations may be filed anonymously” (see the 4th paragraph under point “Formal requirements”)

Indeed, the boards of appeal of the EPO are bound only by the EPC, but the above dispositions in relation to anonymous third party observations are in line with earlier decisions of the boards, which did admit such observations both in ex-parte and in inter partes appeal proceedings, without apparent misgivings in relation to their anonymous character (see T258/05, point 3.3 in combination with point V, and T735/04, point 2).

Since the observations in the present case have been made under Article 115 EPC in an ex parte appeal before a technical board of appeal and are limited to the citation of pieces of prior art and the indication of the correspondences between their content and certain claimed features, which essentially are statements of facts, the present situation is also quite different from that in the decisions G1/03 and G2/03 (OJ EPO 2004; 413 and 448) in which the Enlarged Board of Appeal without further explanations did not take into account an anonymously filed statement made within the frame of the referral of a point of law in relation to the allowability of disclaimers.

The only requirements imposed on third party observations by Rule 114(1) EPC are that they be filed in writing in an official language of the EPO and state the grounds on which they are based. The written form of the observation and the use of an official language indeed constitute the minimal conditions for allowing them to be communicated to the applicant or proprietor and to be commented upon by the latter, as provided for in Rule 114(2) EPC.

Rule 50(3) EPC and by analogy Rule 86 EPC, which establish the requirement that documents filed in the examining or opposition procedure be signed, do not in the board’s opinion directly apply to third party observations. As a matter of fact, the reference in Rule 50(3) EPC, in relation to the case of a missing signature, to “the party concerned” indicates that the rule addresses the filing of documents by parties to the procedure, which a person who files third party observations clearly is not, as is expressly stated in Article 115 EPC (see the last sentence)

The board is aware of decision T146/07, dated the day before the date of the present decision and made public later, in which the deciding board disregarded third party observations because of their anonymous character, on the basis inter alia of a different appreciation of the relevance to this issue of Rule 50(3) EPC and of decisions G1/03 and G2/03 (see points 3 to 6).”

The “different appreciation” in T146/07 is, basically, considered to be wrong. However, T1336/09 apparently seeks to avoid direct conflict with T146/07 by means of the following comments:

“Contrary to the present instance, decision T146/07 concerned an inter partes appeal, and it emphasised that “Identification is particularly important in the context of opposition proceedings in order to allow the competent organ of the EPO to verify whether the observations are indeed filed by a third party rather than by a party to the proceedings. Otherwise, a party might be tempted to submit late observations and/or documents by means of anonymous third party observations in order to avoid negative procedural consequences such as apportionment of costs.”

In ex parte proceedings however the appellant is the sole party and it can at any time raise new issues or submit new prior art - and so can the board of its own motion by virtue of Article 114(1) EPC. Accordingly the risk of anonymous third party observations providing a cover for procedural abuse can be largely excluded in ex parte proceedings.

For these reasons the board considered that in the present circumstances the anonymous character of the third party observations did not bar them from being admitted into the procedure.”

T1439/09 (Sclerostin/UCB PHARMA) is another opposition appeal decision, dated 16.4.2013, made by Board 3.3.08 (the same Board as T146/07 but in an entirely different composition). In T1439/09 the anonymous third party observations were filed 18 months before the oral proceedings in the appeal – hardly “very late”. T1439/09 refers to T146/07 (under the incorrect number T146/09) and largely follows its reasoning:

“Third party observations

1.6 Anonymous, unsigned third party observations were filed during the appeal proceedings.

1.7 In decision T146/09, this board, in a different composition, held that the identification of a third party in the context of third party submissions in opposition proceedings was particularly important in order to allow the competent organ of the EPO to verify whether the observations were indeed filed by a third party rather than by a party to the proceedings. Otherwise, a party might be tempted to submit late observations and/or documents by means of anonymous third party observations in order to avoid negative procedural consequences such as apportionment of costs. Moreover, unsigned submissions by a party to the proceedings were deemed not to have been filed if, after a communication according to Rule 50(3) EPC has been sent out by the EPO, they are not signed in due time. Since unsigned anonymous third party observations did not allow the EPO to send out such an invitation, they necessarily remained unsigned. As a consequence, they were deemed not to have been filed.

1.8 In the present case, the board sees no need to depart from this line of reasoning. Therefore, the anonymous observations filed under Article 115 EPC are deemed not to have been filed and are disregarded by the board.”

T1756/11 is an opposition appeal decision, dated 14.1.2015, by Board 3.2.04. In this decision the Board refers to T146/07 in connection with anonymous third party observations filed at a very late stage of opposition appeal proceedings. In T1756/11 the (anonymous) third party observations were filed about two years before the appeal oral proceedings – again hardly “very late”. However, in T1756/11 it is plain that T146/07 was not followed. Rather, the Board took the view that third party observations (anonymous or not) filed after the expiry of the 9-month opposition term are to be regarded as “late submissions”. The Board took the view that the third party observer has no rights in the proceedings so that there was no right to have third party observations considered. The Board, however, recognized the commitment made by the EPO in the notice of 2011 that the first instance Opposition Division would comment explicitly on the relevance of third party observations). The Board took the view that should the Opposition Division decide to take the third party observations into account it must make a decision to admit them on the basis of their relevance, despite their late submission.

The Board also took the view that third party observations filed only during opposition appeal proceedings must as a rule be disregarded by the Board, unless they relate to changes in the claims or other parts of the patent during the opposition or appeal proceedings. In that case the Board might pay regard to the late observations and admit them to the proceedings. Further, the parties may at any time take a position with regard to the third party observations.

If a party does so, the Opposition Division or the Board of Appeal must make a decision regarding the admission or non-admission of the observations. (See reasons for the decision, points 2.1 to 2.11)

T923/10 is an opposition appeal decision, dated 16.6.2015, by Board 3.3.04. In this case what might be called “straw man” third party observations – signed by a patent attorney in private practice but not identifying a principal – were filed about three years before the appeal oral proceedings. The decision does not suggest that such “straw man” observations qualify as “anonymous”. That the third party observations were signed seems to mean that they escape T146/07 (which is not mentioned in T923/10). The reasons for the decision in T923/10 say:

“2. Third party observations were filed during the appeal proceedings.

3. The boards have discretion to take such observations into consideration or to disregard them. When exercising their discretion the boards normally take criteria into account which they consider when they decide about the admissibility of submissions by parties to the proceedings that are considered “late-filed” in view of Article 114(2) EPC and Articles 12(1), (2), (4) and 13(1), (3) RPBA. These criteria include the relevance of the submissions filed (see for example decisions T1137/98, point 6 of the reasons; T390/07, point 4 of the reasons; T544/12, point 11 of the reasons).

4. In the present case the board considers that the observations filed by the third party are less relevant than the submissions made by the parties to the proceedings.

5. Also, none of the parties took up any of the arguments or evidence of the third party. The board therefore decided to disregard the observations of the third party.”

T1181/12 is an opposition appeal decision, dated 9.10.2015, by Board 3.3.05. In this case anonymous third party observations were filed 18 months before the appeal oral proceedings. No direct reference is made to T146/07 but T1756/11 is referenced. In T1182/12 point 2 of the reasons for the decision reads:

“2. Third-party observations

Third-party observations were submitted anonymously during appeal proceedings after the reply of the respondent. In reply to the summons to oral proceedings, the appellant argued that the third-party observations confirmed what they had already submitted in their statement of grounds of appeal. The appellant did not specifically rely on any of the documents cited by the third party to present its case and did not provide any arguments why these documents were relevant for the decision and should be admitted into the proceedings.

Therefore, in agreement with T1756/11 (reasons 2.9 to 2.11), the third-party observations have not been taken into consideration.”

T694/10 (Behandlung von RTK-Überfunktionsbedingten Störungen/MAX-PLANCK) is an opposition appeal decision, dated 10.12.2015, by Board 3.3.02. What might be considered to be “straw man” third party observations (signed by a patent attorney in private practice but not identifying a principal) were filed about three months before the appeal oral proceedings. The decision does not suggest that such “straw man” observations qualify as “anonymous”. No reference is made to T146/07. In the decision the Board simply dismissed the observations as irrelevant for the decision (Roughly translated from the reasons for the decision:

*“3. Observations by third parties*

*3.1 After the summons to oral proceedings anonymous third party observations were raised under Article 115 EPC concerning the patentability of the claimed invention.*

*3.2 In the present case, the third party observations were not relevant to the decision and were therefore not considered.”*

T379/13 (Fällungskieselsäure/Evonik) is an opposition appeal decision, dated 8.1.2016, by Board 3.3.05. This case refers to, and follows, T146/07. Anonymous third party observations filed about 4 months before the appeal oral proceedings are simply dismissed (see point VIII of “Sachverhalt und Anträge”; roughly translated:

*“VIII. Third party observations under Article 115 EPC are on hand before the Board. Since these observations were filed anonymously, the Board does not admit them to the proceedings, in line with decision T146/07.”*

T1348/11 (Multileaf lettuce/RIJK ZWAAN) is an opposition appeal decision, dated 15.1.2016, by Board 3.3.04. This case does not refer to T146/07. In this case two sets of third party observations were filed during the appeal proceedings. One set identified the “observer” and was filed more than two years before the appeal oral proceedings. The other set was anonymous and filed 10 days before the appeal oral proceedings. In the reasons for the decision, the Board commented:

*“5. Article 114(1) EPC, pursuant to which the EPO shall consider facts of its own motion, is to be applied in a more restrictive manner in inter partes appeal proceedings because they are considered to be less investigative than (administrative) opposition proceedings (see decision G9/91, OJ EPO 1993, 408, point 18 of the reasons). In addition, submissions provided by a third party should not be given a more favourable status than submissions of a party to the proceedings to whom Article 114(2) EPC applies. Hence, the boards have discretion to take third-party observations into consideration or to disregard them.*

*When exercising this discretion the boards consider inter alia the relevance of the observations or at which stage of the proceedings they were filed.*

*6. In the present case, the first observations suggested that patentability should be denied in the light of the respondent’s withdrawal of the corresponding Dutch patent granted on the priority application. The board considered this fact as being of no relevance to the case pending before it. The second observations were filed only some days prior to the oral proceedings, concerned a ground of opposition which was not within the scope of the appeal and relied on a post-published document. The board therefore decided to disregard the observations.”*

In its comments with regard to the exercise of discretion the Board drew no distinction between anonymous third party observations and those that identify the “observer”.

## Conclusion

Boards of Appeal still do not have a uniform position with regard to the status of anonymous third party observations.

To minimize risk that anonymous third party observations will be deemed “not filed” and thus be disregarded:

- Consider providing third party observations bearing the signature of a patent attorney (without mention of a principal), so that they do not count as “anonymous”.
- Draft the observations in such a way as to encourage a party to the proceedings to take a position on them. The position should amount to more than a bland statement that “the observations support my position” or “the observations are no more relevant than matter already in the proceedings”. Rather than, or in addition to, a new line of argument, perhaps directing references to details of parties’ submissions might encourage them to take more detailed positions.

## Contact us



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