



HOFFMANN EITLE

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Enforcing IP Rights at Trade Fairs in Germany

Trade fairs in Germany offer key opportunities for business exposure but can also give rise to intellectual property (IP) infringement. Powerful tools are available in Germany's legal system for swiftly enforcing IP rights, including on-site actions during trade fairs. Effective enforcement requires preparation, including strong IP portfolios, competitor surveillance, and logistical readiness for swift legal action.

Trade fairs are vital components of global commerce, offering a platform for showcasing innovations and launching new products. Germany is a major hub for international trade fairs, hosting hundreds of events annually across various sectors such as automotive, machinery, information technology, and consumer goods. However, the same factors that make trade fairs so valuable—public visibility, large gatherings of clients, and live product demonstrations—also make them hotspots for intellectual property (IP) infringement.

This article outlines the powerful tools available in Germany's legal system for swiftly enforcing IP rights, including on-site actions during trade fairs. With minimal cost and effort, IP holders can take decisive action to protect their patented innovations, designs, and trademarks, and thus their brand integrity and market position, by removing infringing products from circulation.

1. The legal framework: fast and effective IP enforcement

Germany's IP enforcement system is one of the most sophisticated in Europe. Due to the temporary and fast-moving nature of trade fairs, German judges, customs officers, public prosecutors, and event organizers are accustomed to taking swift action, often within hours or days. The Unified Patent Court (UPC) adds another route for swift and effective enforcement of European patents.

The main laws governing IP rights in Germany include:

- **Patentgesetz (Patent Act):**
Governs German patents (including German parts of European patents granted by the EPO).

- **Unified Patent Court Agreement (UPCA):**
Relevant for European patents with unitary effect and European bundle patents that have not been opted out from the jurisdiction of the UPC.
- **Markengesetz (Trademark Act):**
Covers trademarks and trade names.
- **Designgesetz (Design Act):**
Regulates registered designs.
- **Urheberrechtsgesetz (Copyright Act):**
Covers works of authorship and creative designs.
- **Gesetz gegen den unlauteren Wettbewerb (UWG – Unfair Competition Act):**
Protects unregistered trade dress, business secrets, and against misleading commercial practices.

German courts and customs authorities have developed specialized procedures for urgent IP enforcement, especially during short events like trade fairs. Furthermore, many trade fair organizers, such as **Messe Frankfurt** and **Messe Hannover**, have established close ties with local courts to facilitate the enforcement of preliminary injunctions and other IP protection measures.

2. Enforcement in practice: rapid relief and on-site actions

The main enforcement procedures for IP rights in Germany are **civil actions** (including preliminary injunctions granted in urgency proceedings), **criminal actions**, and **border seizures**. Each of these tools has distinct advantages and limitations, and understanding when to use each is crucial.

a. Civil action: preliminary injunctions

Preliminary injunctions (PIs) can be granted by German national courts or by the UPC and are one of the fastest and most effective ways to enforce IP rights in Germany. In urgent cases such as in the context of trade fairs, injunctions can be issued **ex parte** (i.e. without the defendant's knowledge), within 24–48 hours or even within a few hours if necessary.

Once granted, enforcement officers (court bailiffs), often escorted by customs officers or security staff, can execute the injunction on-site, immediately removing infringing goods, promotional materials, and catalogues from the exhibition stand. This immediate relief effectively halts further infringement.

However, a preliminary injunction is provisional, meaning the affected party can challenge the order. Under such circumstances, an oral hearing will be held after a few weeks, in which the justification of the PI order will be discussed and assessed by the court. If the court revokes the *ex parte* PI order, the IP holder may be liable for the damages caused by its execution during the trade fair. In practice, challenges and revocations of *ex parte* PIs are rare, as PIs are usually only granted in clear-cut cases of IP infringement.

Logistics can also be a challenge: coordinating with the court to get the order to the trade fair on the same day may be difficult, particularly for weekend events. Despite these challenges, a well-prepared IP holder can use this tool to act swiftly and decisively.

b. Criminal actions

In addition to civil actions, IP holders can use criminal law to seize infringing goods. German IP laws contain criminal provisions allowing for the confiscation of counterfeit goods and the imposition of fines or even prison sentences on infringers.

The criminal procedure can be very fast and efficient. Customs officers, working closely with public prosecutors, can seize infringing goods without the

need for court involvement, making this option more expedient than the civil route. Furthermore, the state handles prosecution, meaning the IP holder does not bear the financial burden of pursuing the case.

A real-life example of a successful confiscation during Ambiente 2025 showcases the rapidity and efficiency of the procedure: on the first day of the trade fair, our enforcement team collected suspect samples from various stands and conducted a thorough technical analysis. Disassembly of these products confirmed the presence of patent-infringing components. Armed with this expert assessment, the team worked alongside German customs authorities to take immediate action. The second day saw customs officials inspecting the targeted exhibitors' booths, where they confirmed multiple violations of patent, trademark, and design rights, resulting in confiscation of the imitations.¹

Although criminal actions are fast and efficient, they require a high standard of proof, typically beyond reasonable doubt, and often require evidence of **intentional** infringement. For complex technologies, criminal enforcement might be less effective since customs officers may not have the expertise to evaluate the infringement properly. Additionally, the criminal process focuses on preventing further acts of infringement and sanctioning the infringer, so the IP holder may still need to pursue certain remedies, such as damages, in separate civil court proceedings.

Despite these limitations, criminal actions are a powerful tool for immediate confiscations, especially in cases of clear and/or large-scale counterfeiting.

c. Border seizures

Border seizures, governed by national IP law or the corresponding EU regulation, are another way to prevent the importation of infringing goods into Germany or the EU. By filing a request with German customs, IP holders can have goods intercepted before they even reach a trade fair.

¹ Find out more here: **Product seizure at Frankfurt Trade Fair Ambiente 2025**, Hoffmann Eitle web site, March 18, 2025.

This procedure is inexpensive and can be initiated by a simple request to the customs authorities, making it an attractive option compared to court proceedings. However, border seizures based on EU law are only effective for goods entering or leaving the EU; they do not address domestic infringement or products already circulating within Germany or the EU (e.g., those on display at a trade fair). While border seizures are useful for preventing infringing goods from entering the market, they require careful planning and coordination with customs authorities well in advance of the event. Furthermore, as customs authorities typically do not detect all infringing imports, border seizure requests are usually filed in addition to preparations for civil and/or criminal action against expected IP right infringements at a trade fair.

3. Preparation is key for IP holders

Effective enforcement begins well before the trade fair itself. To act swiftly and successfully, IP holders need to be prepared.

a. Strengthen your IP portfolio

A robust IP portfolio is the foundation of effective enforcement. Without registered patents, trademarks, and designs, there is no legal basis for taking action. Building and maintaining a strong set of IP rights is essential for any company looking to protect their products.

b. Gather intelligence on competitors

It is crucial to monitor competitors and gather intelligence on potentially infringing products long before the trade fair. While it is possible to act on short notice, trade fairs are crowded and hectic, making it challenging to identify infringements in real-time. Surveillance teams, IP investigators, or internal experts can help monitor the event and identify infringements early. Collecting evidence such as photographs, brochures, and witness statements is also essential for legal action.

c. Know key contacts and locations

Before the event, information on key players, such as local courts, judges, customs officers, and public prosecutors, has to be gathered. Identifying where

customs officials are located and understanding where infringing products may be located at the fair is also helpful. If large items need to be seized, arrangements for transport and storage must be made in advance.

d. Prepare documentation

The IP holder must also ensure that they have all relevant documentation ready, including IP registration certificates, product samples, and pre-drafted preliminary injunction requests. For criminal actions, customs authorities usually provide templates that can be filled out quickly at the fair. For complex issues like patent infringement, expert opinions may also be useful to expedite the process.

4. Preventive strategies for exhibitors

Given the potential for on-the-spot enforcement, exhibitors must also prepare carefully.

a. Conduct a freedom-to-operate (FTO) check

Before displaying a new product, exhibitors should verify that it does not infringe existing German or EU patents, trademarks, or designs. An FTO search helps reduce the risk of being targeted by competitors with injunctions or criminal actions.

b. File protective letters

Competitors who anticipate being the subject of an action can file a protective letter with the court, which may stop or delay a preliminary injunction.

5. After the trade fair: follow-up and litigation

If immediate relief is not obtained during the fair, IP holders can pursue ordinary civil proceedings before German courts. If successful, they can recover damages, demand the destruction of infringing goods, and secure a permanent injunction. In cases of wilful infringement or counterfeiting, criminal prosecution may follow under German law.

6. Conclusion

Trade fairs in Germany are both showcases for innovation and battlegrounds for IP enforcement. The German legal system offers fast, robust, and effective remedies for IP holders whose rights are infringed during these events. At the same time, exhibitors must take preventive measures to ensure their own displays are not subject to such measures based on accusations that they infringe others' rights.

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Impact of G 1/24 on the Assessment of Added Matter at the EPO

Landmark decision [G 1/24](#) doesn't refer to Article 123 EPC and instead expressly makes reference to Articles 52 to 57 EPC, so from the outset it was questionable whether it applies for assessing added matter. [T 2048/22](#) suggests that it does, and moreover indicates that in some specific cases, G 1/24 may soften the extremely strict added matter approach adopted by the Boards. That said, it seems that not all Boards agree as can be taken from [T 405/24](#).

Legal basis for applying G 1/24 to added matter

G 1/24 refers to Articles 52 to 57 EPC and not Articles 76(1) and 123(2) EPC under which added matter is assessed:

*The claims are the starting point and the basis for assessing the patentability of an invention under **Articles 52 to 57 EPC**. The description and drawings shall always be consulted to interpret the claims when assessing the patentability of an invention under **Articles 52 to 57 EPC**, and not only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation.*

That said, the famous EPO gold standard expressly adopts the same approach for assessing added matter under Article 123(2) EPC as novelty under Article 54 EPC. This speaks against taking different interpretations when assessing these provisions. Harmonizing the approach for claim interpretation across the different EPC requirements would also be in line with G 1/24's aim of harmonizing practice across Europe. Thus, many practitioners assumed that the same approach would be applied for both.

It was therefore no great surprise that T 2048/22 assumed that it does, though the Board don't discuss the exact legal basis for applying G 1/24 to Article 123(2). T 405/24 on the other hand expressly questions this approach at reason 1.2.3, but also doesn't provide any legal justification for ignoring G 1/24, beyond the fact that G 1/24 was restricted to Articles 52 to 57 EPC: "even if the Order of the G 1/24 (related to assessing compliance with Articles 52 to 57 EPC only) could indeed be extrapolated to the assessment of compliance with Article 123(2) EPC..."

Divergence on applying G 1/24: T 2048/22 and the added matter escape route

In T 2048/22, the phrase "co-aligned" had been introduced into the claims, but had no express basis in the application as filed (see mark-up in **bold/strike-through** relative to claim 1 as filed):

*...the occlusive layer and the active agent releasing layer are sheet-like layers with ~~common~~ **co-aligned** pores or perforations that enable the passage of wound exudate through **the common pores or perforations of the** said two layers to reach the liquid-absorbing layer **and simultaneously enable the release of the active agent from the area between the pores or perforations to enter the wound site.***

Going to grant with non-verbatim claim language is already a risky business. But the situation for patentee was even worse here, because the original language "common pores or perforations" was still present in another section in claim 1. Oftentimes, such a constellation would lead the EPO to conclude that the "pores and perforations" are different since they are described separately using the different terms "co-aligned" and "common". Indeed, Board 3.3.02 at reason 1.2.1 accepted that this new phrase could introduce a different meaning, and may introduce ambiguity as to whether "the co-aligned pores or perforations" are the same as "the common pores or perforations". Such an introduction of ambiguity is often enough to lead to added matter, as it can no longer be said that the feature is derived "unambiguously" from the application as filed.

But surprisingly, applying G 1/24 and looking at three paragraphs of the description, the Board noted that the technical effect “enable the passage of wound exudate” ascribed to “co-aligned pores...” in the claims was ascribed in the description to the “common pores...”. They concluded that these different terms **have the same meaning so there is no added matter**.

Another added matter objection rested on opponent's interpretation based on the claim language that pores are different to perforations. The Board dealt with this at reason 1.2.2 by referring to several passages and the figures of the patent which make clear that these terms have the same meaning.

Divergence on applying G 1/24:

T 405/24 closes the escape route

This decision related to a claim to a method for rule-based network-threat detection for encrypted communications. Claim 1 had been amended to refer to “**routing**, by the packet-filtering system, **filtered packets to a proxy system** based on a determination that the filtered packets comprise data that corresponds to at least one of the plurality [of] network-threat indicators”. The original claim language rather disclosed a specific method of routing packets to the proxy system based on a domain name corresponding to the network-threat indicators. Just like in T 2048/22, this looked to be a difficult amendment in view of the very strict practice at the EPO which generally does not permit removing features from claims. Patentee argued that this amendment is allowable based on a broad construction of “routing” (not limited to network-layer routing only) which finds basis in Fig. 3B, thus relying on an interpretation of the claims based on G 1/24 to solve the added matter problems.

Added matter cases are generally fact specific, so presumably Board 3.5.05 could easily have justified their decision without expressly diverging from the approach in T 2048/22. It is therefore striking that they chose to deal with this argument at a general level of claim interpretation which clearly diverged from the approach of Board 3.3.02. As explained at reason 1.2.3:

*“[...] there is no indication in G 1/24 that “consulting” or “referring to” the description and drawings could translate to adopting a claim interpretation which ensures that the disputed feature is originally disclosed and thus necessarily complies with Article 123(2) EPC. Such **an approach which inherently assumes that there may be only one “correct” interpretation of a claim feature, namely the one derivable from the original description as its intended meaning** [...] would not lead to an objective assessment of compliance with Article 123(2) EPC and thus jeopardise legal certainty. It would be tantamount to interpreting a claim feature such that, in the end, virtually no violation of Article 123(2) EPC within the meaning of the well-established “gold standard” could arise. Rather, there is a significant body of case law holding that **all technically reasonable interpretations of a disputed claim feature are to be taken into account when assessing compliance with Article 123(2) EPC** (see e.g. T 945/20-3.4.02, Reasons 2.4; T 470/21-3.3.05, Reasons 2.1; T 2034/21-3.3.04, Reasons 11; T 193/22-3.3.06, Reasons 3.5).” (emphasis added)*

Therefore, the Board seems to take the view that 3.3.02 was incorrect to use the description to arrive at a claim interpretation before assessing added matter on that basis. Rather, they take the view that if a technically reasonable interpretation of a claim feature arising from an amendment can be made which does not find basis in the application as filed, then added matter will be found.²

² Board 3.5.05 subsequently adopted a similar approach in its recent decisions **T 1394/23**, reason 2.2: “[...] for the “gold standard” in relation to Article 123(2) EPC to be fulfilled, all interpretations of a particular claim that would objectively occur to a skilled reader, i.e. all technically sensible constructions that are objectively derivable from the claim, must have a direct and unambiguous disclosure in the application as filed (see also T 405/24, Reasons 1.2.3). [...]” and 2.4: “[...] claim 1 as granted is open to technically sensible [...] interpretations [...] that are not disclosed in the original application.”; and **T 2047/23**, reasons 2.5, second paragraph: “As explained in Reasons 1.2.3 of T 405/24, an approach that forces a choice for a single “correct” interpretation, such as the one derivable from the description, would jeopardise legal certainty. [...] The board thus holds that all technically reasonable interpretations are to be taken into account instead.”

Conclusion

It will be interesting to see which of these approaches are adopted in the long run. So far, Board 3.3.02 seems to be in the minority in taking G 1/24 to heart, and relying on various passages and figures to interpret the claims. That said, they seem better aligned with the national courts and the UPC, so would seem to be closer to the harmonising approach favoured by G 1/24.

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T 878/23 – How a Dependent Claim Can Bring Down a European Patent for Insufficient Disclosure

The Board of Appeal's decision [T 878/23](#) is a stark reminder that it is important to make sure that the claims of a European patent are all in line, do not contradict each other, and cannot give rise to issues which could put in question that they can be technically carried out over their entire scope. The decision also once more emphasizes the necessity to file all potentially helpful auxiliary requests at the earliest possibility.

1. The patent under dispute in T 878/23

The patent (EP 3 317 395 B1) belongs in the field of probiotics and purported to provide a specific combination of ingredients with optimized activity to protect microorganisms in probiotics, with the granted claims relating to compositions comprising a carrier, an antioxidant, and specific combinations of amino acids.

Specifically, claim 1 as granted read as follows:

A composition comprising a carrier material comprising a polysaccharide, at least one antioxidant and an amino acid combination selected from
cysteine and alanine;
cysteine, lysine and alanine;
lysine and arginine;
cysteine and arginine;
cysteine, lysine and arginine;
lysine, alanine and arginine; and
cysteine, arginine and alanine;
wherein the amino acids lysine, alanine and arginine are each present in an amount of 8 to 20 wt.% based on total dry weight of the composition and wherein cysteine is present in an amount of 2 to 10 wt.% based on the total dry weight of the composition.

The claim thus puts forward specific amino acid combinations of at least two amino acids, which need to be present in an amount of at least 8 wt.% (or in the case of cysteine, at least 2 wt.%). Consequently, the **minimum** weight percentage for the amino acid combinations in claim 1 was 10 wt% or 16 wt% (depending on the respective combination of two amino acids).

However, dependent claim 4 as granted stipulated that the **total amino acid concentration** in the composition should be between **3.5** and 36.5 wt%.

2. Oppositions

The patent was opposed by two opponents.³ After the Opposition Division maintained the patent based on an auxiliary request, both the Patentee and the first opponent (i.e., O1) appealed the decision. The main issue on appeal was sufficiency of disclosure under Article 100(b) EPC.

3. The sufficiency question

3.1. Sufficiency (Article 83 EPC) vs. clarity (Article 84 EPC)

Article 83 EPC requires that the European patent application "discloses the invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art." Importantly, EPO case law generally requires that the disclosure must allow the invention to be performed over substantially the whole range claimed. Yet, for a sufficiency objection to succeed, the Board of Appeal must be convinced that there are "serious doubts, substantiated by verifiable facts" that the claim in question does not comply with Article 83 EPC. Sufficiency is a ground for opposition and can thus lead to revocation of a patent in opposition and opposition appeal proceedings.

³ The first opponent (O1) was represented by Hoffmann Eitle and specifically by the author of the present article.

On the other hand, clarity is regulated by Article 84 EPC and is not a ground for opposition. Hence, if a sufficiency objection is raised but found by the Board to be "only" a clarity problem, the patent would not be revoked on that ground. Under Article 84 EPC, the claims "shall define the matter for which protection is sought [and they] shall **be clear and concise** and be supported by the description". It is already apparent from the wording of this article ("supported by the description") that there might be grey areas between the sufficiency and the clarity provisions which can be critical in view of the potential different outcomes in opposition proceedings.

In their original opposition statement, O1 already raised the objection that dependent claim 4 would be insufficient in view of its range encompassing embodiments which could not be carried out in view of the teaching in claim 1.

The question posed to the Patentee was how a composition could have a total amino acid content as low as 3.5 wt% (claim 4) when the claim it depends on (claim 1) requires it to have at least 10 wt%? Clearly, the definition of claim 1 did not cover a substantial part of claim 4, as also confirmed by the Board of Appeal (BoA), which noted that *"the compositions specified in claim 4 that are explicitly excluded from the concentration ranges specified in claim 1 represent[ed] a significant proportion of the range claimed"*.

Patentee argued that the discrepancy was a simple clarity issue and could thus not be raised during opposition. Patentee argued that the issue was one of an unclear "forbidden area", that typically arises not from a technical impossibility to perform the invention, but from an ambiguity in the claim language. According to the established case law of the Boards, such ambiguity comes under the provisions of clarity, rather than sufficiency.

3.2. The Board's decision on sufficiency

However, the BoA found that the effect of the dependent claim was not just an unclear boundary. They considered both claim 1 and claim 4 perfectly clear. Instead, the problem was that the claims were also *"mutually exclusive, i.e. incompatible, over a substantial part of their ranges"*. In view of this contradiction, the BoA found that *"the skilled person cannot technically prepare the composition as defined in [the dependent claim] across substantially the whole breadth claimed"*.

This is in line with the principles that dependent claims influence the interpretation of the claim on which they depend, and that dependent claims relate to sub-embodiments of the invention as defined in the claim on which they depend (G 3/14).

As all auxiliary requests admitted into the proceedings included the same problematic dependent claim, all auxiliary requests were considered insufficient (Art. 83 EPC).

4. Simply deleting dependent claim 4? The late filing question

It is well known that it can be very difficult to admissibly introduce new auxiliary requests in opposition proceedings, in particular at the appeal stage. Several stages are foreseen in the convergent approach set out in the Rules of Procedure of the Boards of Appeal (RPBA), according to which ever more stringent rules are applied the later the requests are introduced.⁴

In the present case, the BoA had indicated in their preliminary opinion accompanying the summons to oral proceedings that they considered dependent claim 4 (as present in all pending requests) to be insufficient. Patentee reacted by filing further auxiliary requests in which this claim 4 was deleted.

⁴ In this respect, see also Johannes Osterrieth, Nicolas Douchamps, Morten Garberg, **The EPO Rules of Procedure of the Boards of Appeal (RPBA) - An Update Two Years After the Entry Into Force of the RPBA 2020 (part I)**, Hoffmann Eitle Quarterly, December 2021, pp. 2-5.

The admissibility of these further auxiliary requests was discussed in the oral proceedings after the Board had decided that dependent claim 4 as granted was indeed insufficient. However, the Board held that, as the objection against claim 4 had been raised already in the opposition statement of O1 and Patentee could therefore have filed a request addressing this objection at the latest in reply to the Grounds of Appeal of O1, the new requests were not admitted into the proceedings and the patent was revoked.⁵

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⁵ This may have been aggravated by the fact that claim 4 was the claim that was considered to be decisive for acknowledging patentability in the first instance proceedings by the Opposition Division.

Intervention During EPO Appeal Proceedings: G 2/24 upholds G 3/04

The EPO's Enlarged Board of Appeal (EBoA) in its decision G 2/24 confirmed its earlier finding in decision G 3/04 that, after withdrawal of all appeals, the proceedings may not be continued with a third party who intervened during the appeal proceedings. That is, an intervener at the appeal stage does not acquire an appellant status, but only acquires a status equivalent to that of an opponent who would not have filed an appeal against the first-instance decision.

Background

In T 1286/23,⁶ Board of Appeal 3.2.04 referred questions to the EBoA concerning the procedural status of an intervener in opposition appeal proceedings. Specifically, in the opinion of Board 3.2.04, an intervener should have been able to enter the EPO opposition appeal proceedings with full rights, without any limitation, contrary to what the EBoA decided twenty years ago in G 3/04.⁷ Specifically, Board 3.2.04 referred the following questions to the EBoA:

"After withdrawal of all appeals, may the proceedings be continued with a third party who intervened during the appeal proceedings? In particular, may the third party acquire an appellant status corresponding to the status of a person entitled to appeal within the meaning of Article 107, first sentence, EPC?"

In the March 2025 issue of the *Hoffmann Eitle Quarterly*, we discussed the background of the referral and its practical significance.⁸ Now, the EBoA issued its decision in G 2/24 and answered the questions referred to it by maintaining the *status quo* existing since G 3/04, i.e. an intervener at the appeal stage does not acquire an appellant status, but only acquires the status of a party to the appeal proceedings as of right in accordance with Article 107, second sentence, EPC. In other words, an intervener at the appeal stage only acquires a status equivalent to that of an opponent

who would not have filed an appeal against the first-instance decision. Thus, if all appeals are withdrawn, the opposition appeal proceedings cannot be continued with the intervener who intervened at the appeal stage.

The reasoning in G 2/24, and discussion thereof

As part of their decision, the EBoA first underlines that the relevant provisions under consideration, i.e. Articles 99(1), 105, and 107 EPC, have not been amended since the decision in G 3/04 was issued,⁹ that the appeal proceedings are of a judicial nature and does not constitute a continuation of the first-instance, administrative proceedings, and that the appeal proceedings depend "on the appellant to initiate, determine the scope of, and conclude the procedure within that party's power of disposal, in accordance with the principle of party disposition."¹⁰ Further, the EBoA discusses the requirements for qualifying as a party to the appeal proceedings, notably with reference to the travaux préparatoires for the EPC 1973, and concludes as follows:

- 1) A party entitled to appeal within the meaning of Article 107, first sentence, EPC is only the person who had formally participated in the proceedings before the administrative department that issued the impugned decision.

⁶ T 1286/23, 11 November 2024.

⁷ G 3/04, 22 August 2005.

⁸ Nicolas Douchamps, "Intervention During EPO Appeal Proceedings: G 3/04 Called Into Question", *Hoffmann Eitle Quarterly*, March 2025, pp. 20-21.

⁹ G 2/24, reasons 21 to 26.

¹⁰ Ibid., reasons 34.

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- 2) A third party that has not been admitted as a party to the proceedings before the administrative department which issued the impugned decision is therefore not entitled to appeal, unless the third party's entitlement to participate in the proceedings was ignored due to procedural error or incorrect application of the law.
 - 3) An adverse effect is determined with regard to the procedural situation of a party participating in the proceedings that led to the decision under appeal and only exists if a decision of an administrative department falls short of the request of a party to the proceedings or deviates from it without their consent.
 - 4) Any other "negative" or "disadvantageous" impact or effect of a ruling by an administrative department of the EPO on a third party that has not formally participated in the proceedings before the administrative department does not fulfil the legal threshold required by Article 107, first sentence, EPC."¹¹

The EBoA then expresses the view that the concept of "intervention" within the meaning of Article 105 EPC has a special character and is of an "exceptional nature", "preclud[ing] an extensive interpretation and application of this legal remedy",¹² while acknowledging that an intervener "enjoys **all the rights** and obligations of a party to the proceedings"¹³ and must be able "to defend themselves against the patent proprietor's action with **all available means** of attacking the patent".¹⁴

On the interplay between appeal and intervention, the EBoA then takes the view that an intervener who intervened at the appeal stage only becomes "a party as of right in accordance with Article 107, second sentence, EPC".¹⁵ While this seems to be the cornerstone of its decision, the EBoA unfortunately does not appear to explain how exactly it arrived at this conclusion.¹⁶ In essence, the EBoA seems to take the view that the need to constrain the intervener into "the particular legal and procedural framework of the boards of appeal as the first and final judicial instance in the

proceedings under the EPC"¹⁷ prevails over the intervener's ability to enjoy all rights of a party to the proceedings with all available means of attacking the patent.

Finally, the EBoA concludes that, absent an explicit legal provision in the EPC (as it stands) for "awarding an intervener an independent party status", amending the EPC would be required to allow an intervener at the appeal stage to enjoy full rights.¹⁸ Therefore, until an amendment to this effect is successfully placed on the agenda of a future Conference of the Contracting States for the revision of the EPC, an intervener at the appeal stage will not be able to enjoy full appellant legal status.

Practical significance

G 2/24 means that the following remains applicable. That is, when EPO opposition proceedings are pending, a third party not being opponent in these proceedings may still find themselves in a procedurally very uncomfortable situation resulting from the following, not uncommon scenario (already discussed in our March article):

After an Opposition Division has maintained a European patent in granted or amended form, and while the opposition appeal proceedings are pending, the patent proprietor institutes an infringement action in Germany against the third party not involved in the EPO opposition proceedings. In reaction, the third party intervenes during the opposition appeal proceedings under Article 105 EPC. Later, the proprietor concludes an agreement with the original opponent, granting the latter a free or discounted licence, and both the original opponent and proprietor withdraw their appeal. This abruptly ends the opposition appeal proceedings without a substantive decision, forcing the third party – the defendant in the German infringement proceedings – to initiate a nullity action in Germany at a time when the infringement proceedings may already be well advanced, thus generally to the advantage of the patent proprietor.

¹¹ Ibid., reasons 45.

¹² Ibid., reasons 47 and 55, item (1).

¹³ Ibid., reasons 54 (emphasis added).

¹⁴ Ibid., reasons 58 (emphasis added).

¹⁵ Ibid., reasons 57 and 101.

¹⁶ Ibid., reasons 66.

¹⁷ Ibid., reasons 67, item (2).

¹⁸ Ibid., reasons 102.

To avoid finding themselves in such a situation, third parties are advised to carefully consider, during the opposition period (i.e., within nine months of the publication of grant) pertaining to a European patent that is potentially relevant to their activities, whether to file an opposition against that patent.¹⁹ Especially if the unitary effect has not been requested and if the European patent has been opted out from the jurisdiction of the UPC (so that the patent proprietor can initiate infringement proceedings before German courts as far as the German part of the European patent is concerned), it remains wise to prepare and file an opposition at the EPO.

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¹⁹ The EBoA indeed considers that the fact that anyone may file an opposition within the opposition period primarily and sufficiently safeguards the public interest (G 2/24, reasons 61), this apparently outweighing any difficult situation in which an intervener at the appeal stage may find themselves if the original parties to the opposition proceedings settle during the appeal proceedings.

UPC Substantive Law - Comparisons With the EPO and National Courts

This article is a continuation of a series in the *Hoffmann Eitle Quarterly*, in which we compare substantive law at the UPC with that of the EPO and national courts. More details can be found in the [News section](#) of the Hoffmann Eitle website, which is regularly updated.

How many attacks are too many for the UPC?

In *bioMérieux Austria GmbH, et al. v. Labrador Diagnostics LLC*, the Central Division in Milan had to deal with a significant number of attacks against the patent in suit, namely *"about 50 invalidity attacks, more than 12 added matter attacks, 3 novelty attacks, 1 insufficiency attack, and 6 different starting points for 30 inventive step attacks"* (Reasons 1.2).

The Court requested that the claimant indicate which attacks they considered most important. Based on these attacks, the Main Request and the first two Auxiliary Requests were found to be invalid, while the claims of Auxiliary Request 3 were considered sufficiently disclosed and inventive. The attacks selected by the claimant as the most promising were thus not successful (Reasons 1.6).

The Court then considered that *"the attacks not identified by bioMérieux as (most) promising [did] not warrant further investigation on the merits"* (Reasons 1.7 and Headnote).

The Court reasoned that the number of attacks was *"not compatible with the resources available to the Court, which is required to deliver a high-quality decision within a year"* (Reasons 7.1). Accordingly, the Court requested the claimant to rank their attacks because *"[i]f the number of arguments proves unmanageable or overly complex for the panel, the party that filed them must, if not reduce them, at least arrange the legal pleadings in order of importance and likelihood of success"* (Reasons 1.10). It should not be expected that the Court take up the task of selecting the attacks, because *"it is not the Court's role to indicate*

which attacks it considers to be the most promising or likely to be successful" (Reasons 1.10).

The remaining attacks were not analyzed, because *"if the attacks the party considers most likely to succeed fail, those considered less effective would also fail"* (Reasons 7.2).

The Court also noted that presenting *"such a high number of undifferentiated attacks suggests a lack of strategy"* (Reasons 7.1). While the Court did not provide general guidance on how many attacks were too many, for the case at hand it considered *"that an assessment based on (a maximum of) two different documents to challenge the novelty and three different starting points to argue for non-inventiveness [...] was indeed appropriate"* (Reasons 7.3).

This decision may remind European patent attorneys of the EPO's view that opposition proceedings are not *"a forum in which the appellant (opponent) could freely develop various attacks based on diverse prior art documents in the hope that one of them would succeed"* (Case Law of the Boards of Appeal, 11th Edition, I.D.2.1). However, the EPO's approach of not admitting certain attacks is generally limited to the discussion of inventive step when multiple starting points are proposed (ibid., I.D.3.7.1). This decision suggests that the UPC, on the other hand, might request claimants to limit their whole case to a *"manageable number"* of attacks, apparently extending this issue to every type of attack including novelty, added matter and sufficiency.

How soft is the UPC on added matter really?

Ever since *Abbott v. Sibio*, the UPC Court of Appeal (CoA) has enjoyed a reputation for being considerably more patentee friendly on added matter than the EPO Boards of Appeal. *Expert e-Commerce v. Seoul Viosys* illustrates the limits of the UPC CoA's generosity on this point, and provides a simple illustration of when amendments add matter.

The patent in dispute concerned a light-emitting diode (LED) and was based on a chain of several divisional applications. The defendants argued that granted claim 1 (which covers both LEDs with multiple mesa structures and LEDs with only one mesa structure) went beyond the content of the parent application. The CoA agreed with this argument: the original disclosure of the parent application disclosed only LEDs with multiple mesas, and LEDs with only one mesa were not part of the originally disclosed subject matter. There was no such explicit disclosure, nor was the subject-matter implicit (a clear and unambiguous consequence of what was explicitly mentioned).

Even the argument that the product arose from a well-known cutting process was not convincing, because there was no direct and unambiguous disclosure of a single-mesa diode resulting from such a process or corresponding details pertaining to how the cutting step would occur in the original parent application. The CoA noted that the defendant had provided no substantiation to support this argument. Specifically, in the absence of a clear statement in the application and without substantiation e.g., through a third-party expert opinion, the argument remained only a theoretical possibility and could not amount to a direct and unambiguous disclosure.

While this strict approach is generally in line with EPO practice, the decision still alludes to a potentially more patentee-friendly approach to added matter than the EPO, given their openness to hearing expert opinions on whether a feature is implicitly disclosed. The decision thus suggests that the CoA takes a similar but slightly more patent-friendly approach to the EPO with regards to questions of unallowable extension of subject-matter.

The distinction between direct and indirect/contributory patent infringement

In *bellissa HAAS GmbH v. Windhager GmbH* the LD Mannheim dealt with the distinction between direct and indirect patent infringement.

The asserted patent claim 1 concerns an "enclosure for beet and grassland areas consisting of **at least two** sheet metal strips which can be connected to one another at the end face". Some features of the claim refer to the state in which the strips are connected to each other, such that the LD Mannheim held that the claim was directed to the enclosure in its assembled state (points 43–45 of the decision).

Nonetheless, for direct and literal infringement of claim 1, the LD Mannheim considered it irrelevant that the enclosure according to the attacked embodiment was only offered and delivered by Defendant in an unassembled state (point 108 of the decision). The court reasoned that the sheet metal strips were specifically designed as a "modular system" to be assembled at the place of use in a straightforward and intended manner, without the addition of further objects.

This reasoning appears generally consistent with case law of the German Federal Court of Justice (FCJ X ZR 95/18 - Schutzverkleidung), which holds that manufacturing a protected product requires combining all claim features. Still, manufacturing individual components may constitute manufacture of the patented product, if completion of the protected product can be attributed to the party producing the individual components, specifically when completion of the patented product is certain, or at least to be expected with certainty. Thus, a manufacturer of components directly uses the patent when the parts can only be assembled in a technically and economically meaningful way into the patented combination, even if assembly is done by a third party. The Munich District Court I (Judgement dated 13.12.2018 - 7 O 19301/17, BeckRS 2018, 41093) had previously found in another case direct infringement where the purchaser must perform only a final manufacturing step as directed by the supplier, when the missing element is immaterial to

the inventive concept and its addition by the purchaser is self-evident, noting that otherwise nearly any apparatus claim could be circumvented by delivering a "kit of parts". The reasoning of the LD Mannheim under point 108 of the decision reads directly onto this judgement of the Munich District Court I.

While the facts in *bellissa HAAS GmbH v. Windhager GmbH* differ to the extent that the enclosure marketed by Defendant can also be used individually, screenshots of the Defendant's website presented by Claimant emphasized that the enclosure was "easy to assemble", "extendable at will", and allowed for individual design options. This may be understood as an instruction to purchasers to assemble the metal strips in the patented manner.

Under point 122 of the decision, the LD Mannheim even considered the **offering and sale** of a **single** individual sheet metal strip of the attacked embodiment to constitute a direct patent infringement under Art. 25(a) UPCA. This appears to go a step further than the aforementioned case law, according to which the delivery of individual components of an apparatus generally gives rise only to indirect infringement. It seems that the present case differs from the above case law in that the claimed apparatus consists of two identical, connectable components. Multiple individual sales of the same component amount to supplying all components of the protected apparatus. Under these circumstances, the court deemed it sufficient for direct infringement that an assembly of these components is indicated or is otherwise obvious.²⁰

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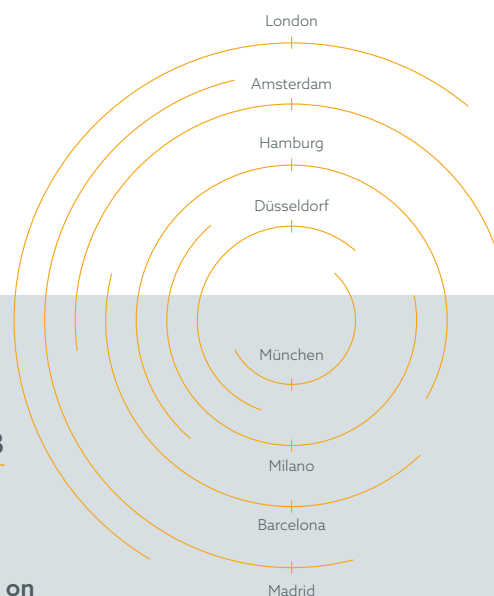
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