



Europäisches
Patentamt

Große
Beschwerdekammer

European
Patent Office

Enlarged
Board of Appeal

Office européen
des brevets

Grande
Chambre de recours

Case Number: R 0001/11

D E C I S I O N
of the Enlarged Board of Appeal
of 27 June 2011

Petitioner I:
(Patent Proprietor)

Gemalto SA
6, rue de la Verrerie
F-92190 Meudon (FR)

Petitioner II:
(former Patent Proprietor)

XIRING
25, Quai Galliéni
F-92150 Suresnes (FR)

Representative:

Debay, Yves
Cabinet Debay
126 Elysée 2
F-78170 La Celle Saint Cloud (FR)

Other Party:
(Opponent)

Molnia, David
Asgardstr. 24
D-81925 München (DE)

Representative:

D'Halleweyn, Nele Veerle Trees Gertrudis
Arnold & Siedsma
Sweelinckplein 1
NL-2517 GK The Hague (NL)

Decision under review:

**Decision of the Technical Board of Appeal
3.4.01 of the European Patent Office of
10 December 2010.**

Composition of the Board:

Chairman: P. Messerli
Members: M.-B. Tardo-Dino
T. Kriner

Summary of Facts and Submissions

- I. The petition for review concerns the decision T 128/10 of the Board of Appeal 3.4.01 announced at the end of the oral proceedings held on 10 December 2010. The parties were notified of the decision in written form on 18 February 2011.
- II. The decision under review rejected as inadmissible the appeal filed against the decision of the opposition division to revoke the European patent No 0 766 190, on the ground that the "alleged appellant" as called in the decision, was not entitled to appeal at the time when the notice of appeal was filed. The petition was filed on behalf of the alleged appellant Gemalto SA, (hereafter Petitioner I) and the former patent owner (XIRING, hereafter Petitioner II).
- III. The facts underlying the decision of the Board of Appeal and the proceedings, as far as they are relevant for the decision, can be summarized as follows.
- (a) The European Patent Bulletin 2005/32 of 10 August 2005 and the decision of the opposition division mentioned Petitioner II as patent proprietor.
 - (b) The notice of appeal dated 23 January 2010 was filed on behalf of Petitioner I, on 24 January 2010. This notice was accompanied by an assignment document signed by Petitioner I as the transferee and Petitioner II as the assignee.
 - (c) With a communication of 16 February 2010 under the heading "Indication of deficiencies in a request

under Rule 22 EPC and invitation to correct them", the Client Data Registration informed the petitioners' representative that his "request dated 23 January 2010" (quotations marks in the decision under review) for entry of a change in the European Patent Register concerning the name of the patent proprietor contained a deficiency, namely that the administrative fee had not been paid. Petitioner II was still indicated as the patent proprietor. The petitioners' representative was given a two-month period from the notification of the communication to remedy the deficiency and warned that until the deficiency had been remedied, the entry of the change under Rule 22 EPC could not take place.

- (d) The administrative fee was paid on 25 February 2010 and the statement of grounds of appeal filed on 10 March 2010.
- (e) With a letter of 1 April 2010 the Client Data Registration sent a communication confirming that the registration of the transfer to Petitioner I had taken effect on 25 February 2010.

IV. The respondent (opponent) with a letter of 19 July 2010 objected to the admissibility of the appeal on the ground, *inter alia*, that there was no evidence on file that a transfer of the patent from Petitioner II to Petitioner I had been recorded before the expiry of the appeal period. During the appeal period Petitioner II was the sole patent proprietor and, in the absence of a registration of a transfer in due time Petitioner I was not entitled to file an appeal.

V. The Board of Appeal sent a communication on 2 September 2010 to the parties drawing attention to the admissibility issue. Both parties filed written submissions before the date of the oral proceedings before the Board of Appeal. With a letter of 21 September 2010 Petitioner I requested the correction of its name and an amended notice of appeal against the decision of the opposition division was filed on behalf of Petitioner II.

VI. The final requests were:

- for Petitioner I (alleged appellant): that the appeal be found admissible and the appeal proceedings be continued as to the substance of the appeal or, as an auxiliary request, that the following point of law be referred to the Enlarged Board of Appeal:

"Is it sufficient to provide documentary evidence in relation to the transfer of a patent under appeal which was in fact submitted before the expiry of the period for filing the notice of appeal, according to Rule 20(3) [EPC 1973] or 22(3) [EPC], so that a transfer shall have effect vis-à-vis the European Patent Office? If yes, is the appeal receivable? If No, should the Board of Appeal have drawn attention of the appellant on incorrect designation of the Appellant and have invited the representative to modify the incorrect designation of the Appellant?

Is there in EPC 1973 or 2000, a Rule stating that to be an entitled-Appellant you should be recorded on the Register of European Patent, and in such cases what is the utility of Rule 22(3) [EPC]?"

- for the respondent that the appeal be declared inadmissible or, as an auxiliary request that the following point of law be referred to the Enlarged Board:

"Can the unambiguous identification of a non-party as the appellant in a notice of appeal be considered an error for which correction under Rule 101(2) EPC or Rule 139 EPC is available, if said non-party is a purported transferee of the European Patent for which, at the expiry of the period for filing the notice of appeal, documentary evidence had been submitted but the requirements of Rule 22(2) EPC had not been fulfilled?"

VII. The decision under review:

- (a) concluded in paragraph 3.8 that the effective date of transfer of the patent to Petitioner I was the date of payment of the administrative fee pursuant to Rule 22(2) EPC, which fell outside the period for filing a notice of appeal as laid down in Article 108 EPC. Thus the appeal was not filed by a party to the proceedings.
- (b) rejected as inadmissible the notice of appeal filed by Petitioner II because it was filed outside the time period for filing an appeal and because Petitioner II was no longer adversely affected (paragraph 3.9).
- (c) dismissed the request for correction of the name because there was neither a deficiency concerning the name of the appellant in the notice of appeal

pursuant to Rule 139 EPC first sentence nor a deficiency which could have been corrected under Rule 99(1)(a) EPC in conjunction with Rule 101(2) EPC first sentence (paragraph 5.4).

- (d) rejected the request to refer to the Enlarged Board questions involving points of law because according to the Board of Appeal the case law was consistent with respect to both issues and there was no need to refer a question to the Enlarged Board of Appeal to ensure uniform application of the law, nor did the Board see that a point of law of fundamental importance arose that would need clarification by the Enlarged Board (paragraph 6.2).

VIII. A petition for review was filed on 31 January 2011, before the reception of the written decision, by the representative acting on behalf of both the new patent proprietor (Petitioner I) called "alleged appellant" in the decision under review and the previous patent owner (Petitioner II). The relevant fee was paid on the same day.

Petitioners I and II requested that either the decision under review be set aside with the order to decide on the merit of substantive issues, or that the Enlarged Board order the review of the decision (sic) after having acknowledged the existence of the followings alleged deficiencies:

- (i) the decision does not comply with Rule 102(f) and 102(g) EPC because it is not reasoned

and does not make a summary of the contentious facts,

- (ii) the decision does not comply with Article 112(1)(a) EPC because it does not give the reasons why the request for a referral to the Enlarged Board was refused,
- (iii) the decision does not comply with Rule 104(b) EPC because it does not decide on the auxiliary requests relevant to that decision,
- (iv) the decision does not comply with Article 112a(2)(c) EPC because the "appeal proceedings did not take position on the admissibility of the request for correction of the appeal" (sic) and thus does not comply with Article 113 EPC,
- (v) the decision does not comply with Article 112a(2)(d) EPC as a fundamental procedural defect occurred because of the breach of Rule 104(b) EPC,

If the decision were maintained, the uniform application of the law would not be ensured in breach of Article 112(1) EPC.

The petitioners further requested under Article 112a(1) EPC that the Enlarged Board answers the following questions:

- (vi) Is the production of the documents providing evidence of the transfer of the patent under

appeal, before the expiry of the period for filing the notice of appeal, sufficient under Rule 22(3) EPC so that the transfer has effect vis-à-vis the EPO?

(vii) If yes, is the appeal admissible?

(viii) If no, what is the purpose of Rule 22(3) EPC?

Should the board of appeal allow a request for correction of the notice of appeal? To which extent is the decision T 97/98 to be considered when assessing the admissibility of an appeal filed by an appellant whose identification is incorrect and whose representative is the same as in the first instance proceedings?

The above requests are the translation by the Enlarged Board of the following original text:

(i) *"Cette décision est non-conforme aux règles R.102f) CBE et R.102g) CBE car n'étant pas motivée et n'exposant pas de façon sommaire les faits reprochés,*

(ii) *Cette décision est non-conforme à l'Article 112(1)a) CBE car le refus de présenter une requête de décision (sic) à la Grande Chambre de Recours n'est pas motivé,*

(iii) *Cette décision est non-conforme à la Règle 104b) CBE car la Chambre a statué sur le recours sans statuer sur les requêtes subsidiaires pertinentes pour cette décision,*

(iv) Cette décision est non-conforme à l'Article 112bis(2)c) CBE car la procédure de recours n'a pas pris position sur la recevabilité de la demande de correction du recours(sic) et n'est donc pas conforme à l'Article 113 CBE,

(v) Cette décision est non-conforme à l'Article 112bis(2)d) CBE car la procédure est entachée d'un vis(sic) fondamental de procédure pour non respect de la Règle 104b) CBE.

Enfin si cette décision est maintenue, une application uniforme du droit ne serait plus effective et contraire aux dispositions de l'Article 112(1) CBE".

(vi) "La fourniture à l'Office Européen des seuls documents prouvant le transfert du brevet avant l'expiration du délai de recours est elle suffisante pour que ce transfert ait effet à l'égard de l'Office conformément à la Règle 22(3) CBE?

(vii) Dans l'affirmative, le recours ainsi formé est il recevable?

(viii) Dans la négative, quel (sic) est la finalité de la Règle 22(3) CBE? La Chambre de Recours doit elle permettre au requérant de corriger l'acte de recours? Dans quelles mesures la décision T 97/98 doit être prise en considération pour juger de la recevabilité d'un recours déposé par un requérant dont l'identification est erronée et dont le mandataire/représentant est identique à celui de la procédure de première instance?"

IX. In a communication dated 11 April 2011 pursuant to Articles 5 and 13 of the Rules of Procedure of the Enlarged Board of Appeal (RPBEA) the Enlarged Board informed the petitioners of its non-binding opinion that the petition was clearly inadmissible regarding Petitioner II and clearly unallowable with respect to Petitioner I because the written reasons for the decision, which were notified after the filing of the petition, deprived the alleged deficiencies of relevance.

X. The petitioners, with a letter received on 27 April 2011, renewed their petition for review based essentially on the same alleged deficiencies - except for the alleged absence of a summary of facts. Their further submissions in support of their petition can be summarized as follows:

(a) They were misled by the sending of the minutes of oral proceedings which contained all the features of a decision but for the reasons and they thought it was the final version of the decision.

(b) The arguments of the petitioners can be summarised as all originating from, and revolving around, the Board's interpretation of Rule 22 EPC:

- This interpretation was made possible by the combination of Rule 85 EPC (which provides that Rule 22 EPC applies to any transfer during the opposition proceedings) and Rule 100(1) EPC (unless otherwise provided, the procedural rules relating to proceedings before the department which took the impugned decision shall apply to

appeal proceedings) which combination was broached for the first time in the decision under review. In the preliminary opinion the Board had only referred to Rule 85 EPC which only concerns the opposition proceedings. Thus the petitioners could not bring forth their arguments on the combination of this rule with Rule 100(1) EPC; nor could they put forward the view that this rule did not foresee that the status of a party (here the appellant) can only be recognized when its assignment right had been recorded in the Register. This amounted to a violation of the right to be heard (Article 113 and 112a(2)(c) EPC).

- The interpretation also surprised the petitioners because they were misled by paragraph VII.D.5.2 of the "Case law of the Boards of Appeal of the European Patent Office", 5th edition 2006 (hereinafter "Case law"). Relying on this paragraph, they thought that the transfer took effect at the date on which the documents were received by the Office. The Board presented this argumentation with respect to the date of transfer for the first time in the reasons for the decision.

- To justify the deficiencies alleged under Article 112a(2)(d) and Rule 104(b) EPC, the petitioners submit that the Board, in its interpretation of Rule 22 EPC as a whole, confused the effect of the transfer and the registration. This distorting approach to Rule 22 EPC was a way to elude the questions of the petitioners and amounted to a breach of the law and Article 125 EPC, because unlike the Client Data

Registration which had implicitly interpreted the sending of the documents as an implicit request for registration of change the Board refused to interpret the third paragraph of Rule 22 EPC independently from the two preceding paragraphs without justifying on which legal basis it had so decided.

- Another complaint is that the Board should have made use of the possibility offered by Rule 101(2) and 99 EPC and should have invited the petitioners to remedy the deficiency because it had been clear from the beginning that there had been a transfer of rights from Petitioner II to Petitioner I and that it had always been the intention to file an appeal on behalf of the patent proprietor. The Board let the petitioners know for the first time in its decision that Rule 101(1) EPC applied to the case and not 101(2) EPC. Regarding this issue the Board took a different view to that of the Client Data Registration and did not give a complete argumentation of how Article 107 EPC was combined with Rule 85, 22 and 101(1) EPC. This also amounted to a deficiency under Article 112a(2)(c) and (d), Article 113 and Rule 104(1)(b) EPC because, in deciding in that way, the Board eluded the question of the application of Rule 101(2) EPC on which the petitioners had had no opportunity to comment.
- Finally, there was a breach of Article 112(1)(a) EPC because the refusal to refer the question to the Enlarged Board was not reasoned and "since all the above requests were not taken into

consideration and treated in compliance with the EPC" .

- XI. The petitioners did not request oral proceedings.
- XII. The final requests before the Enlarged Board according to the petitioners' submission following the notification of the written decision are:

To set aside the decision of the Board of Appeal and to order the examination of the merits of the appeal deemed to be admissible, or to order the review of the decision after acknowledging that:

- 1- This decision does not comply with Article 112(1)(a) EPC because the refusal to remit a request for decision to the Enlarged Board was not reasoned,
- 2- This decision does not comply with Rule 104(b) EPC for the Board decided upon the appeal without deciding upon requests relevant for this decision,
- 3- This decision does not comply with Article 112(2)(c) EPC and Article 113 EPC,
- 4- This decision does not comply with Article 113a(2)(d) EPC for the proceedings are tainted with a procedural violation for non compliance with Rule 104(b) EPC.

These requests are the translation by the Enlarged Board of the following original text:

"D'annuler la décision de la Chambre de Recours et d'ordonner l'examen au fond du recours réputé recevable, soit d'ordonner la révision de cette décision après avoir reconnu que:

- Cette décision est non-conforme à l'Article 112(1)a) CBE car le refus de présenter une requête à la Grande Chambre n'est pas motivé,

- Cette décision est non-conforme à la Règle 104b) CBE car la Chambre a statué sur le recours sans statuer sur les requêtes pertinentes pour cette décision,

- Cette décision est non-conforme à l'Article 112(2)c) CBE (sic) et à l'article 113 CBE,

- Cette décision est non-conforme à l'Article 112bis(2)d) CBE car la procédure est entachée d'un vis (sic) fondamental de procédure pour non respect de la Règle 104b) CBE."

Further, the petitioners still request the Enlarged Board pursuant to Article 112a(1) EPC to answer the following questions:

- If the filing before the European Office of the sole documents proving the transfer of the patent before the expiry of the time limit for filing an appeal is sufficient to render the transfer effective regarding the EPO Register pursuant to Rule 22(3) EPC, why does this effect not extend to

the appeal as no provision in Rule 85 or 100(1) goes against it? How are such applications different from Rule 22(3) consistent with a uniform application of the law? This is the translation by the EPO of the following original text:

- *"Si la fourniture à l'Office Européen des seuls documents prouvant le transfert du brevet avant l'expiration du délai de recours est suffisante pour que ce transfert ait eu un effet à l'égard du Registre Européen de l'Office conformément à la Règle 22(3) CBE, pour quelle raison cet effet ne s'étend -t-il (sic) pas à l'appel alors qu'aucune disposition dans la règle 85 ou 100(1) ne s'y oppose? En quoi de telles applications différentes de la règle 22(3) sont elles conformes à une application uniforme du droit?"*

Reasons for the Decision

1. Admissibility of the petition for review
 - 1.1 The formal requirements of Article 112a(4) EPC with respect to the time limit, the reiterated petition having been filed within the two month time limit, and the fee are met.
 - 1.2 Also, the requirement of Article 112a(1) EPC that the Petitioner be adversely affected for a petition to be admissible, is fulfilled with respect to petitioner I, irrespectively of its party status before the Board of Appeal, since the adverse effect results from the

refusal to acknowledge that it has the status of appellant.

1.3 As far as Petitioner II is concerned, the petition is clearly not admissible because, not being the current proprietor, it is not adversely affected by the impugned decision. It put in a late appearance in the appeal proceedings, and now in the petition for review, only as an attempt to rescue the admissibility of the appeal. Petitioner I is the only party with an interest and concerned by the different steps of the proceedings leading to the decision under review.

1.4 As concerns Rule 106 EPC, the complaints address mostly the reasoning given in the decision. Therefore, the benefit of the doubt is given to Petitioner I as to its possibility to raise an objection before the end of appeal proceedings, and thus the petition is at least not clearly inadmissible.

2. Allowability of the petition for review

As far as the Enlarged Board understands the petition, it seems to be based on two kinds of deficiencies related to Article 112a EPC: a breach of the right to be heard (Article 112a(2)(c) EPC) and an absence of a decision on relevant requests (Article 112a(2)(d) and Rule 104(b) EPC).

Petitioner I also seems to submit that the refusal to refer questions of law to the Enlarged Board is a violation of Article 112(1) EPC, since it prevents a uniform application of law.

2.1 The right to be heard

Under this allegation, Petitioner I complains about the combination of Rules 100(1), 22 and 85 EPC which appeared for the first time in the written decision while it had relied on a particular interpretation of Rule 22 EPC prompted by the 5th edition of the "Case law" book which misled it and prevented it from submitting its own view (see above paragraph X). It also alleges that it could not comment on the application of the first paragraph of Rule 101 EPC instead of the second paragraph as it had submitted in its written submissions.

As to the first issue, the Enlarged Board does not understand how the petitioner could be surprised.

- Rule 100(1) EPC simply states that the provisions governing the proceedings before the department of the first instance (and thus eg Rule 85 EPC) also apply in appeal proceedings. It is a rule which a professional representative should be expected to know without the need to be reminded of it in a communication.

- In paragraph VII.D.5.2.2 of the "Case law" book, 5th edition 2006, to which Petitioner I itself refers, it is stated: "For a transferee of a patent to be entitled to appeal the necessary documents establishing the transfer, the transfer application and the **transfer fee** (emphasized by the Enlarged Board) pursuant to Rule 20 EPC [corresponding to Rule 22 EPC 2000] must be filed **before** (emphasized in the case law book) expiry of the period for appeal under Article 108 EPC. Later

recordal of the transfer does not retroactively validate the appeal (T 656/98 OJ 2003, 385)" .

- From the above quotation Petitioner I should have been aware of the application also in appeal proceedings of Rule 20 (now 22) EPC. Accordingly, the Board of Appeal did not use any text in a way which could have surprised the petitioner. This also sounds the death knell of any attempt to allege the benefit of legitimate expectations as that could be implicitly deduced from certain petitioner's assertions especially from the alleged inconsistency between the position of the Client Data Registration and the omission by the Board of Appeal of an invitation to correct the name of the appellant in application of Rule 101(2) EPC (see above paragraph X).

- The application of paragraph (1) of Rule 101 EPC instead of paragraph (2) is the subject-matter of the second complaint, namely that the Board of Appeal mentioned for the first time in its decision the first paragraph of this Rule 101 EPC.

It seems that Petitioner I alleges that this is a violation of the right to be heard as well as an absence of a decision on a request (Article 112a(2)(c) and (d) and Rule 104(b) EPC). Again it cannot be seen how the right to be heard may have been affected as the Board of Appeal in its communication sent prior to oral proceedings wrote in the last paragraph: "it follows that the respondent's conclusion that the appeal should be rejected as inadmissible (Rule 101(1) EPC) appears to be correct."

2.2 Deficiencies under Article 112a(2)(d) and Rule 104(b)
EPC

The Enlarged Board would like to emphasize that what is submitted by the petitioner under this alleged deficiency (Article 112a(2)(d) and Rule 104(b) EPC) borders on the limits of the understandable. On page 6 of the reiterated petition of 27 April 2011 it is written that the Board of Appeal does not answer the questions of the representative but justifies through distorting the application of the law, a decision which breaches the law. The general principles recognised in the member states are that the decisions shall not breach the law and the EPO should respect this principle pursuant to Article 125 EPC.

The conclusion which seems to be drawn by the petitioner from this general declaration is that the reasoning given by the Board simply eludes the real questions put by the petitioner, in an attempt to link the matter to a deficiency listed in Rule 104 EPC.

However, it is immediately apparent that all the alleged deficiencies and questions concern the application of Rule 22 EPC in the way the Board of Appeal applied it. This amounts to requesting the review of the merits of the decision, which simply followed established case law. But the scope of Article 112a EPC was immediately clearly defined by the first decisions R 1/08 of 15 July 2008 (paragraph 2.1) and R 2/08 of 11 September 2008 (paragraph 5): The petition for review was created and was intended as an extraordinary legal remedy to fundamental procedural deficiencies as restrictively defined by

Article 112a EPC in combination with Rule 104 EPC. The petition for review is an extraordinary legal remedy the filing of which does not affect the force of *res judicata* of the decision under attack (MR/2/00 of 13 October 2000, Explanatory remarks to Article 112a(3) EPC point 10, OJ Special edition 4, 2007). Under no circumstances may the petition for review be a means to review the application of the substantive law (Explanatory remarks to Article 112a point 5, OJ Special edition 4, 2007). Accordingly, it is clear that a petition cannot become a vehicle to review the merits of the decision of a Board of Appeal.

3. The refusal to refer a question to the Enlarged Board

Petitioner I contends that the lack of reasons for refusing to refer questions to the Enlarged Board amounts to a breach of Article 112(1) EPC.

The Enlarged Board is not clear about what is meant under this contention because there is no logical link between the lack of reasons alleged and the violation of Article 112(1) EPC. Article 112(1) EPC would rather concern the refusal to refer *per se*, while the lack of reasons might be seen as a potential procedural defect under Article 112a(2) EPC or Rule 104 EPC.

As concerns the latter aspect, it is clear from the decision under review that the Board of Appeal did decide on this issue and that it gave the reasons why it refused to refer the questions to the Enlarged Board (see paragraph 6 of the decision).

Insofar as Petitioner I seems to contend that the refusal to refer itself might be considered to be a

breach of Article 112(1) EPC because it hinders the uniform application of the law (cf. in this direction his submission dated 21 January 2011, bottom of page 9), the Enlarged Board notes that neither Article 112a nor Rule 104 EPC include in their list of deficiencies the refusal to refer questions to the Enlarged Board.

4. The question of uniformity of the application of the law also underlies the questions the Enlarged Board is asked by Petitioner I to answer. It is immediately apparent that they overlap the questions submitted to the Board of Appeal as a request for referral to the Enlarged Board, which request was rejected by the Board of Appeal (see paragraph 3 above). The treatment of such questions pertains to a different procedure governed by a completely different legal framework and thus falls outside the ambit of the present proceedings (see Explanatory remarks to Article 112a EPC point 5 where it is clearly stated that the function of the petition for review is to remedy intolerable deficiencies occurring in individual appeal proceedings, not to further the development of EPO procedural practice or to ensure the uniform application of the law, OJ Special edition 4, 2007).

5. The Enlarged Board, after a careful scrutiny of the entire submissions filed as a petition for review is unable to find anything which could correspond to a definition of a deficiency listed in Article 112a and Rule 104 EPC, let alone a deficiency in the decision. Furthermore, the Enlarged Board has no obligation to broach issues expressed through such general considerations that do not call for any legal answer

(the time allocated to each party during oral proceeding for instance). It follows from the foregoing that, with respect to Petitioner I, the petition has to be rejected as being clearly unallowable.

Order

For these reasons it is unanimously decided that:

The petition for review filed on behalf of Petitioner II is rejected as clearly inadmissible.

The petition for review filed on behalf of Petitioner I is rejected as clearly not allowable.

The Registrar:



P. Martorana

The Chairman:



P. Messerli

