

Enlarged Board of Appeal EPO, 24 July 1985, Mobil Oil - Opposition by Proprietor



PATENT LAW

Opposition by proprietor of the patent

- [A notice of opposition against a European patent is not inadmissible merely because it has been filed by the proprietor of that patent.](#)

The Board considers that the foregoing reasons are sufficient to give an affirmative answer to the question put. It is to be observed that giving an affirmative answer to this question leads to greater legal certainty, in as much as any amendment made in the course of opposition proceedings has effect *ex tunc*: cf. Article 68 EPC.

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Enlarged Board of Appeal EPO, 24 July 1985

(R. Singer P. Ford O. Bossung R. Kämpf M. Prélot G. Szabo W. Oettinger)

Decision of the Enlarged Board of Appeal dated 24 July 1985

Gr 01/84*

Composition of the Board:

Chairman: R. Singer

Members: P. Ford O. Bossung R. Kämpf M. Prélot G. Szabo W. Oettinger

Title of invention: Process for making sulfurized olefins

Proprietor of the patent/Respondent: Mobil Oil Corporation

Opponent/Appellant: Mobil Oil Corporation

Summary of the Procedure

I. In the course of examining an appeal against a Decision of the Opposition Division (Formalities Section) which found a Notice of Opposition filed in the name of the proprietor of the patent in question not to be admissible pursuant to Rule 56(1) EPC, the Technical Board of Appeal for Chemistry, by a Decision dated 3 September 1984**, has referred the following question of law to the Enlarged Board of Appeal for decision, in accordance with Article 112 EPC: May the proprietor of a European patent file an admissible notice of opposition against that patent?

II. In response to an enquiry made on behalf of the Enlarged Board of Appeal, the appellants' representative stated that he wished that the arguments that he had set out in the Statement of Grounds of the Appeal dated 26 July 1984 in the proceedings before the Technical Board of Appeal should be considered by the Enlarged Board of Appeal. They have been. In view of the conclusions reached by the Board after an extensive study

of the whole situation, it has not been found necessary to invite the appellants' representative to make further submissions.

Reasons for the Decision

The general background to the question put

1. The Board has first broadly considered the context in which the question put may arise, without reference to the particular facts of the case in which the question put was referred to the Board. In the opinion of the Board, it is to be noted that whilst an applicant for a European patent has opportunities to request the Examining Division to allow amendment of his application, in the light of objections to validity which come to his attention at quite a late stage in the processing of his application, there comes a point in time at which further amendment is not possible, so that there can be finality in the granting procedure. If, after the decision to grant a patent has been taken but before the decision has taken effect or within the nine months period for opposition, the proprietor of the granted patent becomes aware for the first time of objections to validity which appear to require amendment of the patent as soon as possible, he is then in a difficult situation. If some third party files an admissible notice of opposition which brings the objections into opposition proceedings, the proprietor will then be able to apply to amend his patent in those proceedings. If the opposition is based on grounds which do not include these objections, the Opposition Division or a Technical Board of Appeal may raise the objections of its own motion at some stage in the opposition proceedings. However, it is far from certain that any opportunity for amendment will arise unless the proprietor can either induce some other party to file an admissible notice of opposition or file the opposition himself.

2. If the proprietor of the patent is not allowed to file the opposition himself, he would, no doubt, hesitate to induce a third party with whom he was not on close and reliably friendly terms to file an opposition. The only practical thing that he might do is to try to employ the very ancient lawyers' device of having a "man of straw" as the opposing party. That procedure may reduce the proceedings to a sham, since the "man of straw" in this case is no real third party but the puppet of the proprietor. If the connection between the proprietor and his puppet is not known to the European Patent Office and the general public, possibilities of deceit and abuse of the opposition procedure for ulterior purposes, e.g. delaying procedure in other jurisdictions, exist. It is not necessary, for present purposes, that the Board should decide the question whether an opposition filed in the name of a "man of straw" is or is not admissible in any circumstances and the Board does not now do so. Suffice it to observe that the Board sees no reason to question the rightness of the Decision in Case T 10/82, "Opposition: admissibility/ BAYER" (OJ EPO 10/1983, p. 407) that a professional representative is not entitled to give his own name as opponent when he is acting for a client.

3. The problem arises in cases such as the present because:

(1) The EPC, unlike the Convention for the European Patent for the Common Market (CPC) (cf. Article 52 CPC), not yet in force, contains no provision entitling the proprietor of a European patent to request limitation of his patent, in the form of an amendment to the claims, the description or the drawings, by filing a request in writing at the European Patent Office.

(2) Consequently, if limitation in the course of opposition proceedings is not possible, in the case of a European patent the proprietor is left to such limitation proceedings as may be available to him under national laws in the designated States, whether in proceedings specifically intended for that purpose or possibly in the course of national revocation or infringement proceedings. Uncertainty, delay and extra expense seem inevitable.

(3) Even in the case of a Community patent, there would have to be a stay of limitation proceedings for the duration of any revocation proceedings (Article 52 (5) CPC).

The question put

1. The answer to the question of law put essentially depends on the interpretation of Article 99 (1) EPC in its context, applying where appropriate the principles of treaty interpretation previously approved by the Board in seven cases, including Gr 01/83, Gr 05/83 and Gr 06/83 ("Second medical indication") of 5 December 1984, OJ EPO 1985, pp. 60-70.

2. In accordance with Article 99 (1) EPC, opposition to the maintenance in force of a granted European patent may be filed within nine months of the publication of the mention of the grant by "any person". This expression is in no way qualified in that Article. What has been suggested by the Opposition Division (Formalities Section) is that the notional addition of "save for the proprietor of the patent" is made unavoidable by reading the preliminary documents to the EPC as indicating that it was intended that opposition procedures should be opened to third parties only. No identified passages from these documents are cited in support of this proposition and the Board has not found any which could be. In any case, the principles of interpretation which this Board has said should be applied (see above) require that the text of Article 99 (1) EPC should first be considered in the context of the EPC as a whole (including the Preamble and the Implementing Regulations) and that the preparatory documents and the circumstances of the conclusion of the treaty may be taken into consideration in order to confirm the meaning resulting from the main rules of interpretation or to determine the meaning, when applying those rules either leaves the meaning ambiguous or obscure or leads to a manifestly absurd or unreasonable result.

3. Starting at the correct point, therefore, it becomes immediately apparent that the elaborate provisions in the EPC for substantive examination and opposition are designed to ensure that only valid European patents should be granted and maintained in force, so far as it lies within the power of the European Patent Office to achieve this. This fundamental principle seems to be supported by the absence of any qualification of the

term "any person" in Article 99 (1) EPC. It can be deduced that, except in cases of manifest abuse of procedure, the overwhelming public interest lies in each opposition being examined on its merits. The motives of the opponent are in principle irrelevant (otherwise, no doubt, the phrase "any person" would have been rendered as "any person interested"), whilst his identity is of primarily procedural importance.

4. Even though opposition proceedings give the public the opportunity to be parties to proceedings challenging the validity of granted European patents, it would be wrong to regard such proceedings as essentially contentious proceedings between warring parties where the deciding body takes a neutral position, as would be the case in revocation proceedings before a national court. Opposition proceedings in the European Patent Office are designed to be investigative in nature as the appellant points out (oppositions are "examined": Article 101 EPC) and once an opponent has launched an admissible opposition he may play a completely passive role or even withdraw from the proceedings without thereby bringing them to an end (Rule 60 (2) EPC). It goes without saying that the procedural Rules of the Implementing Regulations have to be and are in practice applied in a modified form in any case in which an opposition is continued after the opponent has withdrawn. It follows that no support for the views of the Opposition Division (Formalities Section) can be derived from the fact that the Implementing Regulations do not expressly regulate the situation in which an opposition is carried on on an ex parte basis.

5. Having regard to the observations made in the Decision of the Opposition Division (Formalities Section) that if a proprietor can oppose his own patent this will give rise to difficulties over the application of Article 107 EPC (appeals), the Board wishes to state that it sees no such difficulties, in view of the ex parte nature of the proceedings.

6. The appellant has drawn attention to the use of the expression "any person" in the English text of Article 115 (1) EPC as having a different meaning from the use of the same expression in Article 99(1) EPC. It seems clear that it does have a different meaning, both from the expressions "jeder Dritte" and "tout tiers" employed in the German and French texts respectively and from the heading to Article 115 EPC in all three languages, which refers explicitly to third parties. Evidently the use of "any person" in the English text of Article 115 EPC gives no cause to understand also Article 99 (1) EPC as meaning only "any third party". It can be concluded that when the legislator wished to distinguish "any person" from "any third person" it did so.

7. In relation to the comment by the Opposition Division (Formalities Section) that the appellant in its capacity as opponent has not shown that national laws in a Contracting State also give the proprietor a right to file oppositions against his own patent, the Board has made a study of the situation and has not found a court decision of a Contracting State excluding an applicant for a patent or a proprietor of a granted patent from filing opposition against his own application or patent, as

the case may be. It is to be observed that, in the past, most Contracting States provided for opposition only before grant and, at that stage, the national industrial property office could allow or require amendment of the application to deal with late discovered objections to validity.

8. The Board considers that the foregoing reasons are sufficient to give an affirmative answer to the question put. It is to be observed that giving an affirmative answer to this question leads to greater legal certainty, in as much as any amendment made in the course of opposition proceedings has effect *ex tunc*: cf. Article 68 EPC.

9. At the same time, the Board desires to add that opposition procedure is not designed to be, and is not to be misused as, an extension of examination procedure.

10. It is not thought that it is either necessary or opportune to express any opinion on any other matter mentioned by the Opposition Division (Formalities Section) or by the appellant.

ORDER

For these reasons it is decided that the question of law referred to the Enlarged Board of Appeal is to be answered as follows:

A notice of opposition against a European patent is not inadmissible merely because it has been filed by the proprietor of that patent.
