

**Enlarged Board of Appeal EPO, 24 april 1989,
Transfer of Opposition**



PATENT LAW

Transferability of pending opposition proceedings

• *An opposition pending before the European Patent Office may be transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition was filed.*

6. The Enlarged Board considers that, in such a situation, the opposition constitutes an inseparable part of those assets. Therefore, insofar as those assets are transferable or assignable under the applicable national laws, the opposition which is part of them must also be regarded as transferable or assignable in accordance with the principle that an accessory thing when annexed to a principal thing becomes part of the principal thing.

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Enlarged Board of Appeal EPO, 24 April 1989

(P. Gori, C. Payraudeau, O. Bossung, P. Delbecque, P. Ford, K. Lederer, G.D. Paterson)

Case Number: G 0004/88

O P I N I O N

of the Enlarged Board of Appeal
of 24 April 1989

Summary of the proceedings

I. In 1985, MAN Maschinenfabrik Augsburg-Nürnberg Aktiengesellschaft assigned to MAN Nutzfahrzeuge GmbH its operations in the commercial vehicle field together with the related industrial property rights. It subsequently merged with Gutehoffnungshütte Aktienverein Aktiengesellschaft which then changed its name to MAN Aktiengesellschaft.

II. Following an EPO Opposition Division decision to reject an opposition entered by MAN Maschinenfabrik Augsburg-Nürnberg Aktiengesellschaft on behalf of its commercial vehicles division, MAN Aktiengesellschaft, the universal successor in title to the original opponent, lodged an appeal, at the same time requesting that the opposition be transferred to MAN Nutzfahrzeuge as assignee of the division to which the opposition related.

III. At the appellant's request and by a decision dated 29 April 1988, the competent Technical Board of Appeal referred the following point of law to the Enlarged Board of Appeal:

Is an opposition pending before the European Patent Office transferable only to the opponent's heirs or can it be transferred freely either with the opponent's enterprise or with a part of that enterprise operating in a technical field in which the invention to which the patent in suit relates can be exploited?

IV. In reply to a communication from the rapporteur of the Enlarged Board, the appellants referred to the submissions they had made before the Technical Board of Appeal, according to which only the assignee of that part of the business on behalf of which the opposition had been entered had an interest in continuing the opposition and was therefore entitled to replace the original opponent.

The patent proprietor made no comments and none of the parties requested oral proceedings.

Reasons for the Decision

1. Under Article 99(1) EPC any person, without restriction, has the right to give notice of opposition to the European patent.

2. This right available to any person, only gives rise to a subjective right for the opponent through actual institution of the proceedings. A bundle of procedural rights is then created in respect of the opponent because, in contrast to the third party who presents observations under Article 115 EPC, the opponent becomes a party to the opposition proceedings (Article 99(4) EPC). As a party he has, in particular, the right to be heard (Article 113(1) EPC), the right to request oral proceedings (Article 116 EPC) and the right to appeal against the decision of the Opposition Division (Article 107 EPC). The opponent may furthermore, if appropriate, be ordered to pay the patentee's costs (Article 104 EPC), etc.

3. In order to answer the question put, it is necessary to decide whether the status of party to the opposition as defined in this way is transmissible or assignable.

4. The transmission of the opposition to the opponent's heirs is acknowledged implicitly in Rule 60(2) EPC which stipulates that the opposition proceedings may be continued even without the participation of the deceased opponent's heirs. Part D, Chapter I.4, of the Guidelines for Examination in the European Patent Office also allows, by analogy, for the opposition to be transmitted to the opponent's universal successor in law.

5. The Enlarged Board considers that it falls outside the scope of the reply to the question at issue to examine whether an opposition could be transmitted or assigned independently of the existence of an interest in instituting the opposition, taking into account the provisions of Article 99(1) EPC. It only appears to be necessary to examine the situation in which the opposition has been instituted in the interest of the opponent's business or part of that business. In this context the term "business" must be understood in a broad sense as describing an economic activity which is or could be carried on by the opponent and which constitutes a specific part of his business assets.

6. The Enlarged Board considers that, in such a situation, the opposition constitutes an inseparable part of those assets. Therefore, insofar as those assets are

transferable or assignable under the applicable national laws, the opposition which is part of them must also be regarded as transferable or assignable in accordance with the principle that an accessory thing when annexed to a principal thing becomes part of the principal thing.

ORDER

For these reasons, it is decided that:

The point of law submitted to the Enlarged Board of Appeal is to be settled as follows:

"An opposition pending before the European Patent Office may be transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition was filed."
