

Enlarged Board of Appeal EPO, 21 January 1999, GENENTECH



PATENT LAW

Raising grounds for inadmissibility during appeal

- **The admissibility of an opposition on grounds relating to the identity of an opponent may be challenged during the course of the appeal, even if no such challenge had been raised before the opposition division.**

Straw man

- **An opposition is not inadmissible purely because the person named as opponent according to Rule 55(a) EPC is acting on behalf of a third party.**
- **Such an opposition is, however, inadmissible if the involvement of the opponent is to be regarded as circumventing the law by abuse of process.**

Circumvention of the law – abuse of process

- **Such a circumvention of the law arises, in particular, if: (i) the opponent is acting on behalf of the patent proprietor; (ii) the opponent is acting on behalf of a client in the context of activities which, taken as a whole, are typically associated with professional representatives, without possessing the relevant qualifications required by Article 134 EPC.**

Source: epo.org

Enlarged Board of Appeal EPO, 21 January 1999

(P. Messerli, R. Teschemacher, C. Andries, J. Brinkhof, G. Davies, J.C. Saisset, P. van den Berg)
EG0004.97-990290015

Decision of the Enlarged Board of Appeal dated 21 January 1999

G 4/97*

(Language of the proceedings)

[...]

Patent proprietor/Respondent: Genentech, Inc.

Opponent (03)/Appellant: Naohito Oohashi

Opponent (01)/Other party: Delta Biotechnology Limited

Opponent (02)/Other party: Riatal GmbH

Headword: Opposition on behalf of a third party/GENENTECH

Summary of facts and submissions¹

[...]

Reasons for the decision¹

[...]

Order

For these reasons it is decided that:

The questions of law referred to the Enlarged Board of Appeal are to be answered as follows:

1 and 2: The admissibility of an opposition on grounds relating to the identity of an opponent may be challenged during the course of the appeal, even if no such challenge had been raised before the opposition division.

3(a): An opposition is not inadmissible purely because the person named as opponent according to Rule 55(a) EPC is acting on behalf of a third party.

3(b): Such an opposition is, however, inadmissible if the involvement of the opponent is to be regarded as circumventing the law by abuse of process.

3(c): Such a circumvention of the law arises, in particular, if:

- the opponent is acting on behalf of the patent proprietor;

- the opponent is acting on behalf of a client in the context of activities which, taken as a whole, are typically associated with professional representatives, without possessing the relevant qualifications required by Article 134 EPC.

1 Cases G 3/97 and G 4/97 have been consolidated. The "Summary of facts and submissions" and "Reasons for the decision" in G 4/97 are the same as in G 3/97 (see this issue, p. 245 ff).

3(d): However, a circumvention of the law by abuse of process does not arise purely because:

- a professional representative is acting in his own name on behalf of a client;

- an opponent with either a residence or principal place of business in one of the EPC contracting states is acting on behalf of a third party who does not meet this requirement.

4: In determining whether the law has been circumvented by abuse of process, the principle of the free evaluation of evidence is to be applied. The burden of proof is to be borne by the person alleging that the opposition is inadmissible. The deciding body has to be satisfied on the basis of clear and convincing evidence that the law has been circumvented by abuse of process.

5: This decision is to be applied to all pending proceedings.

* Cases G 3/97 and G 4/97 have been consolidated. The German translation of **decision G 4/97** (language of the proceedings: English) corresponds to the text of decision G 3/97 (language of the proceedings: German) published in this issue (p. 245 ff); only the "Orders" of the two decisions differ.