

**Enlarged Board of Appeal EPO, 11 November 2014, Siemens v Zenon (G 1/12)**

**PATENT LAW**

**It is possible to correct an error in the identification of the appellant**

- under Rule 101(2) EPC by request for substitution of the true appellant, provided the requirements of Rule 101(1) EPC have been met.

**Free evaluation of evidence**

- Proceedings before the EPO are conducted in accordance with the principle of free evaluation of evidence.

**Procedure for correcting error in appellant's name**

- is available under general procedure for correcting errors under Rule 139 EPC

Source: [www.epo.org](http://www.epo.org)

**Enlarged Board of Appeal EPO, 23 March 2023**

(W. van der Eijk, G. Weiss, T. Kriner, R. Menapace, U. Oswald, A. Pézard, C. Rennie-Smith)

Patent proprietor/Appellant: Zenon Technology Partnership

Opponent/Respondent: Siemens Industry, Inc.

[...]

**Summary of Facts and Submissions**

I. By interlocutory decision of 30 January 2012 in case T 445/08 (OJ EPO 2012, 588), Technical Board of Appeal 3.3.07 referred the following points of law to the Enlarged Board of Appeal for decision under Article 112(1)(a) EPC:

(1) When a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is a request for substituting this other legal or natural person admissible as a remedy to "deficiencies" provided by Rule 101(2) EPC?

(2) If the answer is yes, what kind of evidence is to be considered to establish the true intention?

(3) If the answer to the first question is no, may the appellant's intention nevertheless play a role and justify the application of Rule 139 EPC?

(4) If the answer to questions (1) and (3) is no, are there any possibilities other than restitutio in integrum (when applicable)?

II. In the proceedings giving rise to the referral, the application granted as European patent No. 1140330 was filed on 18 November 1999 in the name of ZENON ENVIRONMENTAL INC. The patent, once granted, was assigned to Zenon Technology Partnership on 30 May 2006. The transfer of ownership was registered by the EPO with effect from 10 February 2007.

The opposition division revoked the patent by a decision dated 28 December 2007. In this decision, Zenon Technology Partnership was cited as the name of the patent proprietor.

An appeal was filed in a letter received on 15 February 2008. The notice of appeal read as follows:

"European Patent No 1140330 (99955620.2-062)

Zenon Technology Partnership

We hereby give Notice of Appeal [underlined in the original] against the decision of the Examination Division [sic] dated 28 December 2007 to refuse the above patent application [sic]. Cancellation of the decision in its entirety is requested so that the patent may be maintained .....

The name, address and nationality of the Appellant is:

ZENON ENVIRONMENTAL INC

845 Harrington Court

Burlington

Ontario L7N 3P3

Canada

ZENON ENVIRONMENTAL INC is a Canadian Corporation.

In the event that the Board of Appeal wishes to make a decision detrimental to the Applicant's [sic] rights at any time, it is hereby requested that Oral Proceedings be held to discuss the matter."

In response to a communication issued by the Registrar of the Board, the patent proprietor Zenon Technology Partnership sent a letter, dated 13 March 2008 and received on 17 March 2008, confirming that "the appeal should of course have been filed in the name of the current proprietor, i.e. Zenon Technology Partnership" and requesting correction of this error.

III. In a letter dated 13 March 2008 the opponent (respondent) challenged the admissibility of the appeal on the ground that it had been filed by ZENON ENVIRONMENTAL INC., a company which was not the registered patent proprietor. The actual proprietor, namely Zenon Technology Partnership, and ZENON ENVIRONMENTAL INC., which had filed the appeal, were two different entities and therefore the latter was not entitled to file an appeal in place of the registered patent proprietor. It cited decision T 656/98 (OJ EPO 2003, 385) and remarked that it was more than unlikely that ZENON ENVIRONMENTAL INC. was in fact the successor of Zenon Technology Partnership.

IV. The representative of the patent proprietor (appellant), replying on 23 June 2008 to a communication by the Board dated 16 April 2008, stated that he was acting on behalf of Zenon Technology Partnership and specified that he was requesting a correction under Rule 139 EPC (Rule 88 EPC 1973) "or in the alternative a decision under Rule 101(2) EPC (Rule 65(2) EPC 1973) that the appellant is not (correctly) identified" and that the deficiency be corrected. He referred to decisions T 715/01 of 24 September 2002, T 460/99 of 30 August 2001 and T 97/98 (OJ EPO 2002, 183).

V. Written arguments were exchanged and then elaborated on during the oral proceedings before the

Board. On 30 January 2012, the Board decided to refer questions to the Enlarged Board of Appeal.

#### **VI. The referral decision**

Board 3.3.07 observed, first of all, that the notice of appeal as filed was not admissible pursuant to Article 107 EPC, because the appellant company had not been a party to the opposition proceedings and, accordingly, had not been adversely affected by the appealed decision. The request for correction had been filed only in reply to the Registrar's letter and so after expiry of the relevant two-month period referred to in Rule 101(1) EPC. Thus, the only remaining question was whether the correction as requested, which would result in admissibility of the appeal, was possible pursuant to Rule 101(2) or 139 EPC.

Furthermore, Board 3.3.07 observed that the appellant was fully identified in the notice of appeal, which complied with all the requirements of Rules 99(1)(a) and 41(2)(c) EPC.

It also expressed a preliminary view, concurring with the respondent's, that Rule 101(2) EPC, which authorises correction of deficiencies under Rule 99(1)(a) EPC, could only justify corrections of deficiencies that were directed to completing the appellant's identity, if this had not been fully provided in the notice of appeal, in cases where the appellant was already identifiable from the notice of appeal.

It examined the boards' established case law on questions of correction of the appellant's name and classified it in the following three categories.

*(A) Decisions in which correction of the appellant's name had been allowed under Rules 99(1)(a) and 101(2) EPC (Rules 64(a) and 65(2) EPC 1973) because, although there was a deficiency, it was possible to infer from the file who the real appellant was.*

The decisions analysed by the Board in this category were (in the following order): T 340/92 of 5 October 1994, T 483/90 of 14 October 1992, T 613/91 of 5 October 1993, T 1/97 of 30 March 1999, T 97/98 (OJ EPO 2002,183), T 867/91 of 12 October 1993, T 814/98 of 8 November 2000, T 15/01 (OJ EPO 2006,153), T 715/01 of 24 September 2002 and T 1421/05 of 18 January 2011.

The Board concluded that the common reasons for these decisions could be read in the sense that, under Rule 101(2) EPC (Rule 65(2) EPC 1973), the entire identification of the appellant could be replaced provided that the true intention to file an appeal in the name of the right person had been established, one of the possible means of evidence for establishing such a true intention being the fact that nobody else would have been entitled to appeal under Article 107 EPC (Reasons No. 5.5). Thus, what had been found decisive was the true intention leading the boards to decide that the indication was wrong and this true intention had been established with the help of information taken from the file or the fact that the representative had been the same (Reasons No. 5.7).

*(B) Decisions in which the request for correction had been refused because the notice of appeal contained no remediable errors but rather a mistake of law.*

The decisions analysed by the Board in this category were (in the following order): G 2/04 (OJ EPO 2005, 549), T 128/10 of 10 December 2010 and T 656/98 (OJ EPO 2003, 385).

The Board found that it could not conclude from [G 2/04](#) that the Enlarged Board had really endorsed the general statements in T 97/98 or their application in T 715/01, especially given its finding that "considering the overriding interest that a party must be identifiable, the [Enlarged] Board sees no reason for a broadening of the scope of application of Rule 65(2) or Rule 88, first sentence, EPC [1973]" (see Enlarged Board's decision in [G 2/04](#), Reasons No. 3.1). In other words, where there was no deficiency for the purposes of Rules 99(1)(a) and 101(2) EPC, there was no reason to search for the true intention. The Enlarged Board had left open the question of the relationship between Rules 101(2) EPC (Rule 65(2) EPC 1973) and 139 EPC (Rule 88 EPC 1973) (T 445/08, Reasons No. 5.9.3).

In both T 128/10 and T 656/98, the patentee-appellants had clearly made a mistake of law. They had overlooked that registration was a necessary requirement for recognition as patent proprietor in proceedings before the EPO, and therefore for standing to appeal. By contrast, in the case leading to the referral, the mistake was that an appeal had been filed in the name of a person who was not entitled to appeal (T 445/08, Reasons No. 5.9.7).

*(C) Decisions in which Rule 88 EPC 1973 (now Rule 139 EPC) had been used as a legal basis for the corrections:* The decisions analysed by the Board in this category were (in the following order): T 715/01, T 814/98, T 15/01, all cited above.

The Board noted that the board in T 715/01 had excluded Rule 88 EPC 1973, choosing instead to apply Rule 65(2) EPC 1973. In T 814/98, correction of the appellant's name had been allowed on the basis of Rule 88 EPC 1973 without any preliminary discussion about its applicability. Other decisions (for instance T 15/01) had mentioned the possibility of correction without any further comments.

From all these decisions, the Board concluded that admissibility of the appeal depended on the role allocated, or not, to the appellant's intention, either under Rule 101(2) EPC in conjunction with Rule 99(1)(a) EPC or under Rule 139 EPC (Reasons No. 6.2). The difficulty with some of the category (A) decisions was that the boards had accepted a very broad definition of "deficiency", having recourse to the notion of "true intention" to characterise such deficiencies, e.g. including discrepancies, as an unintentionally wrong identification (Reasons No. 7.1.2). In the case before the Board, it could be concluded that the notice of appeal had been filed on behalf of somebody not entitled to appeal and contained no deficiency with regard to Rule 99(1)(a) EPC, so that there was no reason to trigger the application of Rule 101(2) EPC. On the other hand, it remained an open question whether a wrong indication could be considered a deficiency open to correction under Rule 101(2) EPC because the appellant contended that the true intention had been to file an appeal in the

name of Zenon Technology Partnership, submitting arguments close to those admitted to establish true intention. It was therefore uncertain whether and, if so, subject to what requirements it was possible to have recourse to the true intention to assess whether there was a remediable deficiency under Rule 101(2) in conjunction with Rule 99(1)(a) EPC. This uncertainty concerned the admissibility of the appeal, which was an important point of law (Reasons Nos. 7.2 to 7.4).

VII. In a letter dated 29 June 2012, submitted in the proceedings before the Enlarged Board of Appeal, the appellant (patentee) set out its position on the four questions. Its conclusions as to questions (1) and (3) can be summarised as follows.

It first of all analysed the boards' case law and noted that established case law on Rule 65(2) 1973 (Rule 101(2) EPC) illustrated that "deficiencies" within the meaning of Rule 65(2) EPC 1973 (Rule 101(2) EPC) included errors of both omission and commission (e.g. initial provision of an erroneous appellant name and address). All the information in a notice of appeal was considered and this information was assessed, not in isolation from the proceedings in connection with which the notice of appeal was filed, but in the context of those proceedings. Some situations involved consideration of special factors - for example, whether "universal succession" automatically applied; issues relating to "joint appellants" or "group parties" - which gave rise to the question of the relevant established case law relating to Rule 65(2) 1973 (Rule 101(2) EPC). Of all the case law under consideration, T 1/97 and, in particular, T 97/98 could be considered representative, key decisions on the scope of Rule 65(2) EPC 1973. The patentee (appellant) submitted that, subject to conditions as exemplified in T 97/98, this case law allowed for the possibility of a correction under Rule 101(2) EPC (Rule 65(2) EPC 1973) whereby the name and address of the correct, entitled appellant were substituted for the name and address of an erroneously indicated, non-entitled appellant. The established case law provided for application of Rule 101(2) EPC (Rule 65(2) EPC 1973) in a balanced way which served the purpose of Rule 99(1) EPC (Rule 64 EPC 1973), while taking appropriate account of Article 107 EPC. There was no evident reason to consider this established case law to be flawed or contrary to legislative intent.

A more restrictive approach to application of Rule 101(2) EPC, such as that considered by the referring board, would appear to reduce Rule 101(2) EPC to a rather sterile exercise in bureaucracy (see point i), page 50). An approach to the effect that, if the result of an error was a nonetheless "complete" identity in the sense that it contained the standard formal administrative items required under Rule 41(2)(c) EPC, there was no deficiency within the meaning of Rule 99(1)(a) EPC, so that there was no basis for application of Rule 101(2) EPC, would be based on a wholly "introspective" consideration of an identity indicated in a notice of appeal, in isolation from the first-instance proceedings and decision to which the appeal related, and would discount the evident significance of Article 107 EPC

(see point ii), page 51). Finally, an approach to the effect that, where there was no "deficiency" within the meaning of Rule 101(2) EPC 2000, there was no reason to ascertain the "true intention", would be contrary to G 2/04, in which "true intention" had evidently been considered in determining that, in the circumstances, there was no deficiency which could be remedied under Rule 65(2) EPC (see point iii), page 52).

The appellant (patentee) then came to the conclusion that the answer to question (1) was yes.

As for the answer to question (3), it submitted that whether Rule 139 EPC could be applied did not depend on the answer to question (1). Whether such a request under Rule 139 EPC for correction of erroneous appellant identity information, for example in the notice of appeal, merited a favourable exercise of the board's discretion depended on the board's assessment. In accordance with the boards' established case law, the "true intention" had to be considered as part of this assessment.

VIII. In a letter dated 25 June 2012, the respondent (opponent) likewise set out its position on the referred points of law.

It pointed out that one of the general principles of any procedural law (whether in proceedings before the EPO or before the authorities in the contracting states) was that legal certainty for third parties had to be observed. In the context of filing an appeal against any decision, it therefore had to be unambiguously clear to a third party, after a specified and short period, whether the decision in question could be contested, whether it was actually contested and, if so, by whom it was contested, or whether it had become final. Rule 101 EPC dealt with two entirely different types of deficiencies, namely, in paragraph (1), deficiencies in requirements designed to ensure legal certainty for third parties and, in paragraph (2), formal deficiencies which came into play only after legal certainty for third parties had been observed, so that it was unambiguously clear that a decision of the EPO was actually admissibly contested, and by whom it was contested. The wording of Rule 101(1), with its reference to Article 107, and the wording of Rule 101(2), with its reference to Rule 99(1)(a), which in turn referred to Rule 41(2)(c), and the wording of those two rules was, in all three languages of the EPC, unambiguously clear, such that these provisions were not open to interpretation as such, and certainly not open to any kind of interpretation blurring the unambiguously and clearly defined borderline between Rule 101(1) und Rule 101(2) and, what is more, thereby omitting to observe the principle of legal certainty for third parties. The respondent (opponent) came to the conclusion that the answer to question (1) was that it was not possible to remedy the deficiency (wrong identification) under Rule 101(2) EPC.

As for question (3), the respondent (opponent) argued that Rule 101 EPC laid down specific rules on how to correct certain deficiencies in an appeal, namely those referred to in Rule 101 EPC. By contrast, Rule 139 EPC set out how to correct linguistic errors, errors of transcription and mistakes made in any document filed

with the EPO. Applying the general principle of *lex specialis derogat legi generali*, Rule 139 (*lex generalis*) could be applied for the purpose of correcting linguistic errors, errors of transcription and mistakes if - and only if - they were not deficiencies already dealt with in Rule 101 (*lex specialis*). It then came to the conclusion that the answer to question (3) had to be that it was not possible to remedy the deficiency (wrong identification) under Rule 139 EPC.

IX. In response to an invitation from the Enlarged Board pursuant to Article 9 of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA), the President of the European Patent Office filed comments, of which those pertinent to the present decision are summarised below.

First of all, the President explained in a detailed manner the practice of the departments of first instance concerning the correction of the identity of the applicant or the opponent under Rule 139 EPC, which was based on the pertinent case law of the boards of appeal and regarded as satisfactory.

A mistake could be said to exist in a document filed with the EPO if the document did not express the true intention of the person on whose behalf it had been filed. The mistake could take the form of an incorrect statement or it could result from an omission. A request for substitution of the applicant by a person who at the date of filing of the patent application was never intended to be named as applicant, even if the applicant's intention was based on false assumptions at the time of filing (e.g. a wrong assessment of the factual situation), did not fall within the scope of Rule 139 EPC. A genuine mistake therefore had to have been made when attempting to give effect to the original intention at the time of filing the application.

As regards the more specific issues of errors in the identification of the appellant, it was noted that the boards of appeal had consistently allowed the correction of the appellant's identity in the above circumstances. However, the boards' decisions were not unanimous as to whether Rule 101(2) EPC and/or Rule 139, first sentence, EPC formed the appropriate legal basis for rectifying a wrong designation of the appellant in the notice of appeal. The case law rightly focused on the importance of the party's true intention and therefore, on the one hand, allowed the correction of mistakes but, on the other hand, refused attempts to give effect to a change of mind. This case law should not be overruled by adopting a more formalistic approach. Irrespective of which of the two possible legal remedies (Rule 101(2) or Rule 139 EPC) was chosen, account had to be taken of the special features of the issues concerning the identity of a party in appeal proceedings. In first-instance proceedings, the correct identity of the applicant or the opponent was generally not easily derivable from the file, so that the burden of proving the true intention had to be a heavy one. In contrast, when an identity mistake occurred in the appeal procedure, the information available from the file, together with the expectation that parties intended to act in a reasonable manner and to avoid procedural statements which were

clearly inadmissible, usually led to a high degree of certainty as to the person by whom the appeal was intended to be filed.

X. In response to an invitation to third parties to file statements in accordance with Article 10(2) RPEBA, the Enlarged Board received three *amicus curiae* briefs. The first was filed, in a private capacity, by a Swiss citizen who is also a professional representative before the EPO. The second and third *amicus curiae* briefs were filed by European patent attorney firms. These include detailed analyses of the relevant provisions of the EPC and the case law developed by the boards of appeal. The national provisions submitted by one of the third parties have also been taken into account.

XI. On 17 October 2013, the Enlarged Board of Appeal sent a summons to attend oral proceedings on 6 February 2014, accompanied by a communication drawing attention to some potentially relevant legal issues. The appellant and respondent briefly restated their positions in letters received on 2 December 2013 and 13 January 2014 respectively.

XII. At the oral proceedings, the parties mainly elaborated on the arguments they had already submitted in writing.

#### **Admissibility of the referral**

Given that the question of admissibility of the referral had first been raised by one of the members of the Enlarged Board, this was the first opportunity for the parties to comment on the matter.

The appellant (patentee) considered that the referral could be held inadmissible, as it could see no conflict in the case law relating to the questions raised. The passages in G 2/04 (Reasons No. 3.1) clearly indicated that the case law developed by the boards following decision T 97/98 could be applied in this case and that the other aspects mentioned in G 2/04 were irrelevant, seeming instead to be peripheral issues touched on by the Enlarged Board in "obiter" remarks. There was thus no inconsistency in the boards' case law and no need to clarify the issues addressed in the questions referred to the Enlarged Board.

The respondent (opponent) submitted that the relevant case law did not cover all possible cases of errors in the appellant's name. G 2/04 had not answered the questions how "true intention" was to be taken into account and whether Rule 101(2) EPC or Rule 139 EPC applied in the case of an error as to the appellant's identity (see Reasons No. 3.1). Moreover, the Enlarged Board in G 2/04 had not commented on, let alone endorsed, the notion of "true intention" applied by the boards in a number of decisions relating to Rule 101(2) EPC. Finally, it could not be ruled out that applying this notion would result in allowing rectifications running counter to Article 107 EPC. In view of the existing legal uncertainty, the questions referred to the Enlarged Board were admissible.

#### **The questions**

On questions (1) and (2), the appellant (patentee) stressed that decision T 97/98 was not incompatible with any legal provision and had been consistently followed by the boards of appeal, so that the validity of this case



law could not be challenged. If the legislator had disapproved of it, it would probably have amended the EPC provisions. It observed that the President of the Office had not raised any objection to this case law in his comments. The respondent (opponent), on the other hand, contended that the provisions in question, namely Rules 101(1) and (2) and Rule 139 EPC, had to be interpreted in accordance with Articles 31 and 32 of the Vienna Convention, which the Enlarged Board had frequently applied in several decisions (see, in particular, G 5/83, G 1/91, G 1/97 and, more recently, G 3/08). The result of interpreting Rule 101(1) EPC, together with Article 107 EPC, in the light of its "object and purpose", as required under Article 31 of the Vienna Convention, was that, in the interests of legal certainty, third parties had to know who the appellant was when the two-month appeal period expired. Rule 101(2) EPC, by contrast, was concerned merely with simple errors in the name and/or address and, therefore, not with any deficiency in the identity of the appellant as defined in Article 107 EPC. Thus, rectification was no longer possible once the two-month period had expired, especially not by way of the mechanism under Rule 101(2) EPC.

On question (3), the appellant (patentee) referred to its written pleadings arguing that, regardless of the answer to question (1), the correction of errors under Rule 139 EPC merely complemented the provisions of Rule 101(2) EPC. The respondent (opponent) reiterated its written arguments, contending that Rule 101 was *lex specialis* and that, therefore, Rule 139 EPC was inapplicable in this case. This clearly followed from the preparatory documents relating to Rule 88 EPC 1973 (now Rule 139 EPC), as the notice of appeal was not a "document filed with the European Patent Office" but rather a procedural declaration. In support of this line of argument, it cited the statements made by the delegations in BR/135/71, pages 30 and 31, paragraphs 58-61, and M/PR/I No. 2405, in particular the comments of the Irish delegation, and expressly observed that the provisions of Rule 88 EPC 1973 originated from analogous provisions in the PCT which did not provide for either opposition or appeal.

XIII. At the end of the oral proceedings, the Chairman of the Enlarged Board of Appeal announced that the decision would be issued in writing.

#### **Reasons for the decision**

##### **Preliminary remarks on the applicable provisions - EPC and Implementing Regulations 1973 or EPC and Implementing Regulations 2000**

1. In the case underlying the referral, the opposition division decided to revoke the European patent after opposition proceedings initiated in January 2006 following publication of the mention of the grant on 6 April 2005, i.e. when the EPC 1973 was in force. The decision, however, is dated 28 December 2007 and was thus issued after the EPC 2000's entry into force on 13 December 2007. The appeal was filed within the prescribed period.

2. It must first be established, therefore, whether the EPC 1973 and its implementing regulations or the EPC 2000 and its implementing regulations are applicable.

3. Article 1.1, first sentence, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 (Special edition No. 1 of OJ EPO 2007, 197) states that revised Articles 106 and 108 EPC apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time. Since the European patent at issue here was granted before 13 December 2007, revised Articles 106 and 108 EPC are applicable, in accordance with the literal wording of that decision. By contrast, Article 107 EPC is not mentioned in Article 1.1, first sentence, of the Administrative Council decision; therefore, in accordance with Article 7(1), second sentence, of the Act revising the European Patent Convention of 29 November 2000 (see Special edition No. 1 of OJ EPO 2007, 196), Article 107 EPC 1973 continues to apply. However, this article was not changed by the EPC revision.

4. If the examination as to admissibility of the appeal in the present case is governed by the above-mentioned articles of the EPC 1973 and 2000, the same also applies to the provisions of the EPC Implementing Regulations which relate to and supplement those articles. Article 2, first sentence, of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 (Special edition No. 1 of OJ EPO 2007, 89) states that the Implementing Regulations to the EPC 2000 apply to European patents already granted at the time of their entry into force in so far as they are subject to the provisions of the EPC 2000 ("Die Ausführungsordnung zum EPÜ 2000 ist auf alle dem EPÜ 2000 unterliegenden europäischen ... Patente, ... anzuwenden"; "The Implementing Regulations to the EPC 2000 shall apply to all ... European patents, ..., in so far as the foregoing are subject to the provisions of the EPC 2000"; "Le règlement d'exécution de la CBE 2000 s'applique à l'ensemble des ... brevets européens, ..., dans la mesure où ils sont soumis aux dispositions de la CBE 2000"). This can only mean that a rule of the Implementing Regulations to the EPC 2000 is to be applied where, or in so far as, the European patent in question is subject to the article of the EPC 2000 related to and supplemented by that rule. The applicable implementing regulations are therefore Rules 99 and 101 EPC, which are linked to Article 108 EPC.

5. The referral in T 445/08 relates to the admissibility of the appeal. The provisions applicable are thus: Articles 106 and 108 EPC 2000, Article 107 EPC 1973, which was not amended when the EPC was revised, and Rules 99, 101(1) and (2) EPC 2000. As Article 107 EPC 1973 was not amended by the EPC 2000, this provision will hereinafter be referred to as "Article 107 EPC".

##### **Admissibility of the referral**

6. According to Article 112(1)(a) EPC, a board of appeal, "in order to ensure uniform application of the

law, or if a point of law of fundamental importance arises: ... shall ... refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes". It is clear from the wording of this provision that points of law may be referred to the Enlarged Board only if they require clarification to ensure uniform application of the law or are of fundamental importance and the referring board takes the view that, for those reasons, it needs a ruling on them by the Enlarged Board in order to settle the case.

7. In this case, the points referred to the Enlarged Board relate to the admissibility of an appeal filed by a person appearing at first sight not to have standing to do so and to the EPC mechanisms for remedying deficiencies which may be applicable if that person claims this is due to deficiencies in the indication of the appellant's name.

8. As the points of law referred in the present case also relate to the admissibility of the appeal, the Enlarged Board must examine, in the following order, whether the following conditions for admissibility of the referral are met: "referral on admissibility of the appeal", "uniform application of the law / point of law of fundamental importance" and "need for a decision". The Enlarged Board has first established that, in this case, the referring board is a board of appeal within the meaning of Article 21(4)a) EPC, that appeal proceedings are pending and that it is being asked to decide the admissibility of the appeal.

#### **"Referral on admissibility of the appeal"**

9. The points of law referred relate to the admissibility of the appeal. The question therefore arises whether a referral relating to an appeal not yet found admissible by the referring board is itself admissible. As a general rule, a referral presupposes an admissible appeal. However, as already stated in decisions G 8/92 of 5 March 1993, Reasons No. 3, and G 3/99 (OJ EPO 2002, 347, Reasons No. 4), even if the Enlarged Board considers as a matter of principle that, for a referral to be admissible, the appeal has to be admissible, this does not apply if the referral itself concerns the admissibility of the appeal. Without this exception, in cases like this one, the boards would be denied the opportunity to refer questions on important points of law concerning the admissibility of an appeal. This would contradict Article 112(1)(a) EPC, where no restrictions of that kind appear. Consequently, a board of appeal within the meaning of Article 21(4)(a) EPC may admissibly refer to the Enlarged Board points of law concerning the admissibility of the appeal.

#### **"Uniform application of the law / point of law of fundamental importance"**

10. Under Article 112 EPC, there are two grounds on which questions may be referred to the Enlarged Board. The first is "uniform application of the law" and applies where the boards have given diverging decisions or where a board intends to deviate from an interpretation or explanation of the EPC given by one or more boards in previous case law. The second ground "point of law of fundamental importance" - only the English wording of which was changed in the revised EPC 2000 (from "important" to "fundamental importance") in order to bring it into line with the French and German versions -

requires that a board consider that the question cannot be answered directly and unambiguously by reference to the EPC. A point of law is also to be regarded as of fundamental importance if its impact extends beyond the specific case at hand. Such importance is established if it could be relevant to a large number of similar cases.

11. In the present case, almost all questions in the referral decision fulfil the requirement that they raise points of law of fundamental importance concerning the admissibility of the appeal and the two legal procedures, i.e. Rule 101(2) EPC and Rule 139, first sentence, EPC, potentially applicable for remedying deficiencies in the indication of an appellant's name. The Enlarged Board of Appeal takes the view that the question concerning the admissibility or inadmissibility of an appeal filed by a person appearing at first sight not to have standing to do so relates to a point of law of fundamental importance because it will be relevant in a potentially large number of cases and is therefore of great interest not only to the parties to the specific appeal proceedings in question. Moreover, settling this point of law is important not only to the users of the European patent system but also to all the boards of appeal and the EPO itself, i.e. to the department of first instance in examination proceedings when it comes to applying the provisions on interlocutory revision (Article 109 EPC), under which a decision can be rectified only if, among other requirements, the appeal has first been found admissible, and also to the department of first instance in opposition proceedings, given that the provisions on admissibility of the opposition (Rule 76(1) and (2) EPC) have a similar wording to the provisions in Rule 101(1) and (2) EPC. Indeed, on this last point, both the parties to the appeal proceedings and the President of the Office, in his observations, noted the similar wording of Rule 76(1) and (2) and Rule 101(1) and (2) EPC and presented lines of arguments on both legal situations.

12. The requirement of uniform application of the law is also fulfilled in the present case:

In the analysis of the referring board, some decisions in the case law have allowed deficiencies in the appellant's name to be remedied under Rule 101(2) EPC, by applying a broad definition of "deficiency", by having recourse to a subjective notion of "true intention" requiring thorough investigation by the board and by introducing the possibility of deriving "from the information in the appeal, if necessary, with the help of the information on file, with a certain degree of probability by whom the appeal should have been filed" (see, to that effect, Reasons No. 7.2 to 7.4 of the referral decision). By contrast, in other decisions on analogous situations, the boards have applied Rule 139, first sentence, EPC, without making any finding as to the procedure for remedying defects under Rule 101(2) EPC (see e.g. T 964/98 of 22 January 2002). In these cases, the error was rectified solely on the basis of the requester's "true intention".

13. Furthermore, the referring board intended to take a line which may deviate from the case law applying the Rule 101(2) EPC procedure for remedying an incorrect name. In point 3 of its reasons for the decision, it

indicated that "[t]he Board tends to concur with the respondent that in the circumstances of the case at hand there are no deficiencies with respect to the requirements of Rules 101(2) and 99(1)(a) EPC. This latter rule, by incorporation of Rule 41(2)(c) EPC, defines the standard formal administrative items of information required to fill out the notice of appeal, which will permit the identification of the appellant. Article 107 EPC on the other hand, once the appellant has been identified, defines an admissibility requirement to be fulfilled by the appellant in order to be entitled to appeal."

#### "Need for a decision"

14. According to Article 112(1)(a) EPC, a referral to the Enlarged Board should only be made if a decision by the Enlarged Board is considered to be necessary. Such a decision is necessary if the referring board's decision on the specific appeal before it depends on the Enlarged Board's ruling. In this case the referred questions relate to the admissibility of the appeal. As the referring board will inevitably have to decide on this issue, the Enlarged Board is satisfied that a decision on the referral is needed.

15. In view of the above, the referral is admissible.

A minority of the members of the Enlarged Board of Appeal take a different view on the admissibility of the referral. Their opinion is set out below at the end of this decision.

#### Referred questions

##### 16. Question (1)

"When a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is a request for substituting this other legal or natural person admissible as a remedy to "deficiencies" provided by Rule 101(2) EPC?"

Interpreting the question in the light of Reasons No. 7.3 to 7.11 for the referral decision, the Enlarged Board considers that what is actually being asked is:

When a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is it possible to correct this error under Rule 101(2) EPC following a request for substitution by the name of the true appellant?

The referred question therefore concerns not only the request's admissibility as such; it also concerns whether such a request is a possible response to a communication under Rule 101(2) EPC and so, indirectly, whether, in the event of such an error, the board can send a communication under Rule 101(2) EPC.

#### Analysis of the provisions governing admissibility of the appeal

17. Articles 106, 107 and 108 EPC lay down the conditions for admissibility of the appeal. Article 106 EPC (Decisions subject to appeal) sets out what

decisions of which EPO departments are appealable. Article 107 EPC (Persons entitled to appeal and be parties to appeal proceedings) - which is the article most relevant to the present referral - provides that any party to proceedings adversely affected by a decision may appeal. Article 108 EPC (Time limit and form) sets out how, and especially by when, the notice of appeal and the statement setting out the grounds of appeal must be filed.

18. Articles 106, 107 and 108 EPC govern the requirements to be met by the date of expiry of the two-month period for filing the appeal and the four-month period for filing the written statement setting out the grounds of appeal, in order that the appeal may be considered admissible. If these requirements are not met before the time limits expire, the appeal is rejected as inadmissible; see Rule 101(1) EPC. The purpose of setting time limits for complying with the admissibility requirements specified in these provisions is to ensure that, on their expiry, the board can determine whether the appeal is admissible and, if so, proceed to examining whether it is allowable. Therefore, the decision as to whether an appeal can be considered admissible in accordance with the relevant provisions, which are designed to ensure fulfilment of the requirements for admissibility within a specific, legally defined period, depends entirely on the substantive and legal position on expiry of the time limits.

19. Rule 101(1) and (2) EPC sets out the provisions on implementing, among others, Articles 106 to 108 EPC, including specific rules on assessing the admissibility of appeals. With regard to the rejection of an appeal as inadmissible and to overcoming any ground of inadmissibility arising from, in particular, non-compliance with the conditions laid down in those articles, Rule 101(1) EPC states that, if the appeal does not comply with Articles 106, 107 and 108 EPC, the board of appeal shall reject it as inadmissible, unless any deficiency has been remedied before the relevant period under Article 108 EPC has expired.

20. However, Article 108 EPC prescribes two different time limits. The first, set out in the first and second sentences, allows the appellant to initiate an appeal by filing notice of appeal within two months of notification of the decision. A number of essential requirements must be met by expiry of that two-month period. These are laid down in Articles 106 to 108 EPC: indication of the decision impugned (Article 106 in conjunction with Rule 99(1)(b) EPC), indication of the appellant (Article 107 in conjunction with Rule 99(1) (a) EPC) and filing of the notice of appeal in accordance with the conditions prescribed in the Implementing Regulations, together with payment of the appeal fee. As a second time limit, the third sentence of Article 108 EPC requires that the statement setting out the grounds of appeal be filed within four months of notification of the decision. Given that it is explicitly required that the notice of appeal identify the appellant (name and address), it is clear that status as a party to the proceedings has to be established within the two-month period under Article 108, first sentence, EPC, this being the relevant period within the

meaning of Rule 101(1) EPC. Otherwise, the appeal will be found inadmissible "... unless any deficiency has been remedied before the relevant period under Article 108 [EPC] has expired." In other words, the identity of the true appellant, i.e. the person on whose behalf the appeal was actually filed, must be established by expiry of the two-month period prescribed in Article 108, first sentence, EPC at the latest.

21. There are various reasons for the need for the appellant to be identifiable within the two-month period under Article 108, first sentence, EPC. The EPC requires that the appellant be immediately identifiable within this period in order for some provisions to apply. Depending on who the appellant is, he may be entitled to file the notice of appeal in a language other than an official EPC language (Article 14(4) EPC) and he may be subject to requirements as to representation under Article 133(2) or (3) EPC. The general requirements as to the person's legal capacity and standing to appeal must also be met. Whether those requirements are met and whether the above provisions apply cannot depend on subsequent provision of evidence as to his identity, so he must be identifiable within the period for filing the appeal. This not only follows from the applicable EPC provisions but has also been unanimously endorsed in the boards' case law.

22. In contrast, Rule 101(2) EPC states that, if the board of appeal finds that the appeal does not comply with Rule 99(1)(a) EPC, it must inform the appellant accordingly and request him to remedy the deficiencies noted within such period as it may specify. If those deficiencies are not corrected in good time, the board shall reject the appeal as inadmissible. Rule 101(2) EPC, which concerns the procedure for correcting the appellant's name and address to meet the requirements under Rule 41(2)(c) EPC, may be applied where there is a deficiency in the notice of appeal, statement setting out the grounds of appeal or any document subsequently produced by the appellant (which is clear from the term "appeal" in Rule 101(2) EPC, which has to be interpreted to mean "the appeal as a whole" - see T 715/01, loc. cit., Reasons No. 10), provided the appellant's identity has already been established within the two-month period as set out above. In other words, it applies to deficiencies which do not affect the establishment of the true appellant's identity as such, e.g. spelling errors or incomplete indication of the appellant's name.

23. It can be concluded from this analysis of the provisions that:

(a) Given the explicit reference in Rule 101(1) EPC to Article 107 EPC and the possibility of remedying deficiencies only within the two-month appeal period under Article 108, first sentence, EPC, the identity of the appellant, i.e. the person entitled to appeal, must be established by expiry of the two-month period prescribed in Article 108, first sentence, EPC at the latest.

(b) Thus, a person who brings an appeal before a board of appeal must show that he has locus standi within the two-month period prescribed in Article 108, first sentence, EPC, otherwise the appeal will be declared

inadmissible. That person has the right to remedy, on his own initiative, any ground of inadmissibility within the same period.

(c) Rule 101(2) EPC concerns deficiencies concerning the indication of the appellant's name and address as prescribed by Rule 99(1)(a) EPC. They may be remedied irrespective of the time limits pursuant to Article 108 EPC, upon invitation by the board of appeal

#### **Case law of the boards of appeal and interpretation of Rule 101(2) EPC**

24. In the boards' case law, Rule 101(2) EPC (formerly Rule 65(2) EPC 1973) has been interpreted so as to allow for a correction of the appellant's identity, under the conditions set out there and within a period to be specified in the communication, after expiry of the appeal periods prescribed in Article 108 EPC.

25. This case law was established in three decisions cited in the referral: T 340/92, loc. cit., T 1/97, loc.cit., and T 97/98, loc.cit.; it has been followed in several other decisions, which, as a rule, cited T 97/98, the decision published in the EPO's Official Journal.

The rationale for this case law is as follows:

26. According to Rule 99(1)(a) EPC, the notice of appeal must contain the name and address of the appellant in accordance with the provisions of Rule 41(2)(c) EPC. Besides the administrative purposes, the purpose of this provision is to ensure that the appellant can be identified and so make it possible to establish whether or not the appeal was filed by a party to the proceedings within the meaning of Article 107 EPC (see T 97/98, loc. cit., Reasons No. 1.3). Deficiencies including the need for substitution of the name of the indicated person by another and omissions regarding the appellant's name or address may be remedied under Rule 101(2), first sentence, EPC by invitation of the board of appeal, even after expiry of the two-month time limit under Article 108 EPC (see T 1/97,loc.cit., Reasons No. 1.1, and T 97/98, loc. cit., Reasons No. 1.3). However, according to the boards' case law, the correction of the deficiency or the omission is possible only if it "does not reflect a later change of mind as to whom the appellant should be" (see T 97/98, loc. cit., Reasons No. 1.3), i.e. the appellant must be sufficiently identifiable within this period for filing an appeal (see T 1/97, loc.cit., Reasons No. 1.1, and T 97/98, loc. cit., Reasons No. 1.3). This is the case if "it is possible to derive from the information in the appeal with a sufficient degree of probability, where necessary with the help of other information on file, e.g. as they appear in the impugned decision, by whom the appeal should be considered to have been filed" (T 97/98, loc. cit., Reasons No. 1.3; see also T 1/97, loc.cit., Reasons No. 1.1 and the other decisions cited there).

27. In other words, an incorrect designation of the appellant in the notice of appeal may be corrected under Rule 101(2) EPC, provided that the appellant was identifiable, i.e. the provisions on the adversely affected party in Article 107 EPC and Rule 101(1) EPC were met, on expiry of the two-month period, so that the correction



only expresses what was intended when the appeal was filed within that period.

28. From the rationale of T 97/98 it follows that, in the event of a deficiency as to the appellant's identity, the board must establish the true intention of the appellant on the basis of the information in the appeal or otherwise on file, i.e. ascertain who must be deemed in all likelihood to have filed the appeal and, consequently, replace the name indicated in the appeal with that of another natural or legal person.

29. The Enlarged Board fully endorses this case law, in which it is considered that an incorrect indication of the appellant's identity is a deficiency which can be remedied, provided "its correction does not reflect a later change of mind as to whom the appellant should be, but on the contrary only expresses what was intended when filing the appeal" (see T 97/98, loc. cit., Reasons No. 1.3). As is well-established case law, the board may point out the deficiency in the communication under Rule 101(2) EPC, which relates to deficiencies in the name and address given in the notice of appeal or also the statement setting out the grounds of appeal. The Enlarged Board has no reason not to allow correction in response to a Rule 101(2) EPC communication pointing out deficiencies as to the appellant's name and address. In response to such a communication the original indication of the appellant's identity may be brought in line with its correct name, for example by way of a request to correct a wrongly quoted name by replacing it with the true appellant's correct name. It goes without saying that evidence of the true intention as to who is the natural or legal person on whose behalf the appeal was intended to be filed must be produced and evaluated by the board concerned. This is also in line with the relevant ruling in G 2/04 (loc. cit., Reasons No. 3.1). The Enlarged Board therefore has no reason to deviate from the case law followed by the boards.

30. Thus, the answer to question (1), as reformulated above - namely whether when a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is it possible to correct this error under Rule 101(2) EPC by a request for substitution by the name of the true appellant - is yes, provided the requirements of Rule 101(1) EPC have been met.

### 31. Question (2)

"If the answer is yes, what kind of evidence is to be considered to establish the true intention?"

The referred question concerns what kind of evidence is needed to establish true intention. In general terms, it must be emphasised that proceedings before the EPO are conducted in accordance with the principle of free evaluation of evidence. This also applies to the problems under consideration here. As the Enlarged Board of Appeal pointed out in G 3/97 (OJ EPO 1999, 245, Reasons No. 5) and G 4/97 (OJ EPO 1999, 270, Reasons No. 5), "(t)he principle of free evaluation would be contradicted by laying down firm rules of evidence

defining the extent to which certain types of evidence were, or were not, convincing". The Enlarged Board of Appeal sees no reason not to apply this principle in the present case and to provide guidance on its application.

### 32. Question (3)

"If the answer to the first question is no, may the appellant's intention nevertheless play a role and justify the application of Rule 139 EPC?"

Even though the answer to question (1) was yes, the Enlarged Board of Appeal wishes to respond to question (3) on whether Rule 139, first sentence, EPC can apply if the name of the appellant was incorrect and the correction to be allowed involves "substitution" of the appellant, a question on which the appellant (patentee) and the respondent (opponent) have commented extensively and argued in support of differing points of view.

33. First of all, it is important to point out that Rule 139 EPC provides for the correction of errors in documents filed with the EPO. This appears in Chapter VI of Part VII of the Implementing Regulations to the EPC, which covers Rules 137 to 140 EPC. Part VII of the Implementing Regulations relates to Part VII of the EPC (Articles 113 to 134a EPC), which is headed "Common provisions".

34. Rule 139, first sentence, EPC allows the correction of "linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office". This list and the rule's heading ("Correction of errors in documents filed with the European Patent Office") make clear that the rule deals with cases in which an error of expression in a declaration has occurred or a mistake in a document is the consequence of an error.

35. Since it applies to any document filed with the EPO, the Enlarged Board of Appeal sees no reason why it should not apply to appeals.

36. The first sentence of Rule 88 EPC 1973, or now (with the same wording) of Rule 139 EPC, applies generally (see J 4/85, OJ EPO 1986, 205, and subsequent case law). This follows clearly from the EPC structure as intended by the legislator, Rule 139 EPC having been left in the part relating to "Common provisions", where it had already been in the EPC 1973.

37. The boards of appeal, in particular the Legal Board of Appeal, have developed a large body of case law on corrections under the first sentence of Rule 88 EPC 1973 (first sentence of Rule 139 EPC) and established the following principles:

(a) The correction must introduce what was originally intended. For example, an applicant wishing to add a designation not originally intended on filing cannot rely on the first sentence of Rule 88 EPC 1973 (J 8/80, OJ EPO 1980, 293, in particular Reasons No. 7). The possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans (J 8/80, loc. cit., Reasons No. 6; J 6/91, OJ EPO 1994, 349). It is the party's actual rather than ostensible intention which must be considered.

(b) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one (J 8/80, loc.cit., Reasons No. 6).

(c) The error to be remedied may be an incorrect statement or an omission.

(d) The request for correction must be filed without delay.

Furthermore, an allowable correction under Rule 139 EPC has retrospective effect (J 4/85, loc. cit., Reasons No. 13; as endorsed in several subsequent decisions, for example J 2/92, OJ EPO 1994, 375, Reasons No. 5.2.2; J 27/96 of 16 December 1998, Reasons No. 3.2; J 6/02 of 13 May 2004, Reasons No. 2; J 23/03 of 13 July 2004, Reasons No. 2.2.1 and J 19/03 of 11 March 2005, Reasons No. 3).

38. Consequently, if correction of the error is allowed, the appeal will be found admissible and the condition of Article 107 EPC will have been satisfied within the two-month period according to Article 108, first sentence, EPC.

39. The Enlarged Board of Appeal cannot subscribe to the argumentation put forward by the respondent (opponent) according to which, applying the general principle of *lex specialis derogat legi generali*, only Rule 101 EPC is applicable, since this is "*lex specialis*" in relation to Rule 139 EPC, which has to be considered "*lex generalis*". Leaving aside the explanations set out above, the Enlarged Board of Appeal cannot find in the wording of Rule 139 EPC any indication that this generally applicable provision refers to exceptional provisions. The EPC drafters did not in the wording of Rule 139 EPC make use of any introductory or final formula which, by definition, would have referred to a specific provision excluding the general provision. This is the case, for example, in Rule 100(1) EPC (formerly Rule 66(1) EPC 1973), which provides that the provisions relating to proceedings before the department which has taken the decision impugned apply to appeal proceedings, "unless otherwise provided". In this respect, in G 6/95 (OJ EPO 1996, 649) the Enlarged Board of Appeal decided that the provisions of Rule 71a(1) EPC 1973 (now Rule 116(1) EPC) relating to the first-instance procedure are not applicable within appeal proceedings, since the procedure before the boards of appeal is otherwise provided for, namely in the Rules of Procedure of the Boards of Appeal (RPBA). Other EPC provisions, for example Rules 5, second sentence, 109(1), first sentence, 131(2), second sentence, 132(2), first sentence and 137(1) EPC, refer to special provisions and clearly indicate that the legislator wanted to add to a general provision one or more special provisions "derogating" from it. It is clear that the legislator did not include in Rule 139 EPC a formula permitting the conclusion that it included one or more specific provisions that derogate from the general provision. The Enlarged Board of Appeal concludes that Rule 139 EPC is generally applicable as indicated above. In its decision J 4/85 (loc. cit., Reasons No. 13) the Legal Board of Appeal moreover stated that another provision (in that case, Rule 43 EPC 1973) cannot supplement the provisions of Rule 88 EPC 1973.

40. For the above reasons, the Enlarged Board of Appeal's response to question (3) is that, in cases of an error in the appellant's name, the general procedure for

correcting errors under Rule 139, first sentence, EPC is available. The well-established case law of the boards of appeal on the application of Rule 88, first sentence, EPC 1973 and/or Rule 139, first sentence, EPC provides the necessary guidance on its application in the event of an error in the appellant's name.

#### 41. Question (4)

"If the answer to questions (1) and (3) is no, are there any possibilities other than *restitutio in integrum* (when applicable)?"

Given the answers to questions (1) and (3), there is no need to answer question (4).

#### Minority opinion on admissibility of the referral

42. In the opinion of the minority, the present referral is inadmissible for the reason that the referring decision shows no need for a decision of the Enlarged Board of Appeal either to ensure uniform application of the law or to determine a point of law of fundamental importance.

43. The minority considers that the law has been clear at least since decision T 97/98 (loc. cit.). The referring board's analysis of that decision and others which have followed it and which in some cases have developed its principles (see Reasons No. 5.3 to 5.8 of the referring decision) is an excellent appraisal of the relevant case law and shows (see in particular Reasons No. 5.8) how the referring board could have reached a decision on the basis of the case law without making the present referral. The referring board then states in its decision (see Reasons Nos. 5.9 to 5.9.7) that the case law also shows another trend and in this connection mentions three cases, namely G 2/04 (loc. cit.), T 128/10 (loc. cit.), and T 656/98 (loc. cit.). In the opinion of the minority, these three cases do not show another trend, because they are concerned with quite different issues.

44. G 2/04 was not concerned with the question of the identity of the appellant *per se* but with the question whether, contrary to previous case law, opponent status could be freely transferred. The relevant facts of the case underlying the referral to the Enlarged Board (T 1091/02, OJ EPO 2005, 14) were that:

*"In the proceedings giving rise to the referral, two oppositions were filed in the name of Akzo Nobel N.V. and Vysis Inc., respectively. After rejection of the oppositions, an appeal was filed on 25 October 2002 in the name of bioMérieux BV. It was submitted that bioMérieux BV now owned the diagnostic activities of Akzo Nobel NV to which the opposition pertained. As a precautionary measure in case the appeal in the name of bioMérieux B.V was considered inadmissible, it was requested that the appeal be treated as being in the name of Akzo Nobel NV.*

*In an accompanying declaration it was explained that the diagnostic activities of Akzo Nobel had been concentrated in its subsidiary Organon Teknika BV. As a result of restructuring within Akzo Nobel NV, an agreement effective as of 30 June 2001 had been reached to transfer the diagnostic activities of Organon Teknika BV from Akzo Nobel N.V. to bioMérieux S.A. The opposition had been instituted by Akzo Nobel NV in the interest of its European diagnostic business as*

conducted on its behalf by its business unit Organon Teknika BV. All the shares of Organon Teknika BV had been transferred to bioMérieux S.A. which was now 100% the owner of Organon Teknika BV, now called bioMérieux BV" (see G 2/04, section II).

44.1 The present referring board then refers to and draws the following conclusions from the views of the Enlarged Board in Reasons No. 3.1 of G 2/04:

*"The Enlarged Board noted that the opponent Akzo Nobel NV, clearly identified as the opponent in the declaration of opposition, was not indicated as the appellant but bioMérieux was (point 3.1 of the Reasons). This was in conformity with the true intention of the author of the declaration. The Enlarged Board went on to state that it was the established case law that in such circumstances there was no deficiency which might be remedied in accordance with Rule 64(a) in conjunction with Rule 65(2) EPC 1973, nor was there an error which might be corrected in accordance with Rule 88 EPC 1973 (point 3.1 of the Reasons).*

Thus the [referring] Board cannot conclude from these statements that the Enlarged Board really endorsed T 97/98 in its general statements, or T 715/01, applying these statements: Indeed the Enlarged Board then concluded that "considering the overriding interest that a party must be identifiable, the [Enlarged] Board sees no reason for a broadening of the scope of application of Rule 65(2) or Rule 88, first sentence, EPC [1973]' (point 3.1 of the Reasons)" (see the referring decision, Reasons Nos. 5.9.1 to 5.9.2).

44.2 The minority considers that this reasoning contains two legal non sequiturs. The Enlarged Board did indeed state in Reason No. 3.1 of G 2/04:

*"The declaration in the opposition concerning the legal personality of the (first) appellant is quite clear and not open to interpretation. The opponent Akzo Nobel NV is not indicated as the appellant but bioMérieux BV is. This was in conformity with the true intentions of the author of the declaration. According to consistent case law, in such a situation, there is no deficiency which may be remedied in accordance with Rule 64(a) in conjunction with Rule 65(2) EPC (see in detail T 97/98, OJ EPO 2002, 183 - Spinning process/MINNTECH, Reasons, point 1.3 et seq.) nor an error which might be corrected in accordance with Rule 88, first sentence, EPC (T 964/98 of 22 January 2002, not published in OJ EPO - Purines/MERRELL, Reasons, point 1)."*

That is nothing less than a demonstration of the application of the principle in T 97/98 – since the identity of the appellant had been made "quite clear and not open to interpretation", there was no deficiency to be remedied and no error to be corrected, unlike the position in T 97/98. As set out in T 97/98, the true intention was considered and, that intention being clear as to the precise identity of only one possible party as the intended appellant, no other possibility could be considered. The referring board observes that it "cannot conclude from these statements that the Enlarged Board really endorsed T 97/98 in its general statements", but this is the first non sequitur. The Enlarged Board simply said that, on the facts of the underlying case in G 2/04,

the approach in T 97/98 could not be applied: no question of endorsing or not endorsing T 97/98 arose (though, if any inference is to be drawn from its observations, it is that by saying T 97/98 did not apply the Enlarged Board was at least accepting it as applicable in situations, other than in the case before it, where there was a deficiency which could be remedied).

44.3 The referring board then refers to the remaining passage in Reason No. 3.1 of G 2/04, which reads:

*"Considering the overriding interest that a party must be identifiable, the [Enlarged] Board sees no reason for a broadening of the scope of application of Rule 65(2) or Rule 88, first sentence, EPC. Therefore, bioMérieux B.V. cannot be replaced by Akzo Nobel NV by way of correction and for the purposes of the present referral, the relation between these provisions (cf. T 715/01 of 24 September 2002 - Glycosides/COGNIS, not published in OJ EPO, Reasons, point 9) need not be discussed."*

Of this the referring board says:

*"In the [referring] Board's interpretation this only means that where there is no deficiency in the sense of Rules 99(1)(a) and 101(2) EPC there is no reason to search for the true intention, the Enlarged Board leaving open the question of the relation between Rules 101(2) EPC (Rule 65(2) EPC 1973) and 139 EPC (Rule 88 EPC 1973)"* (see the referring decision, Reasons No. 5.9.3).

In a literal sense the referring board is of course correct – if, as the Enlarged Board held in G 2/04, the true intention of the appellant is so clear that there can be no deficiency, then there can be no reason to search for the true intention. However, the referring board's interpretation cannot be read into the Enlarged Board's statement and this is the second non sequitur. The Enlarged Board only said that, having established that the intended identity of the appellant was made quite clear, there was no reason to reinterpret Rule 65(2) EPC 1973 in a broader manner than the then existing case law. (Again, if any inference is to be drawn, it is that the Enlarged Board considered the interpretation offered by T 97/98 to be correct.)

44.4 The minority thus sees no inconsistency between T 97/98 and G 2/04, but rather consistency. It follows that the later statements in the referring decision (see Reasons Nos. 7.8 and 7.10, emphasis below added) that "allowing the correction only on the basis of the true intention would not result in broadening the scope of application of Rule 101(2) EPC in a manner which was prohibited by G 2/04" and that "while the Enlarged Board in G 2/04 had no reason to discuss the relationship between Rules 65(2) and 139 EPC 1973, now Rules 99(1)(a) and 101(2) EPC, for the purpose of the referral at hand, it admitted implicitly that it was an issue" are, in the minority's opinion, misconceived. The minority sees no such prohibition and no such implicit admission.

45. Equally, the minority cannot see any basis in decisions T 656/98 and T 128/10 for an inconsistency with T 97/98 and its related case law. The referring board's correct summary of these two cases reads thus:

*"In T 128/10 of 10 December 2010, the mistake as in T 656/98 was held to be a mistake of law as to who was entitled to appeal."*



*The circumstances these two cases have in common are that the notice of appeal was filed on behalf of an identified person and was intended to be filed on behalf of this person, but it transpired afterwards that this person was not entitled to appeal (after a transfer of rights it happened that the appellant had not yet become the registered patent owner at the time of filing the notice of appeal).*

*In these cases where it was submitted that the real intention was to file the notice of appeal on behalf of the patent proprietor, the Boards concluded that the intention as to the identity was clear and that there was neither a deficiency nor a mistake (Reasons, point 7.1 of T 656/98 and point 5.4 of T 128/10)" (see the referring decision, Reasons Nos. 5.9.4 to 5.9.6).*

45.1 Each of these two cases concerned the transfer of ownership of the patent in suit from the proprietor which had been party to the first-instance proceedings to a new proprietor. In each case the new proprietor was named, quite intentionally, as appellant in the notice of appeal but had not been recorded as proprietor by the expiry of the time for filing that notice. The minority agrees with the referring board that these cases are different from the case underlying the present referral:

*"The only difference between the case at hand and T 128/10 or T 656/98 is that in the latter cases there was a clear mistake of law: the patent proprietors had overlooked the fact that registration was a necessary requirement for being recognised as patent proprietor in proceedings before the office and therefore for being entitled to appeal, while in the present case the mistake consists in having filed an appeal in the name of a person who was not entitled to appeal, when there had been no change which could have introduced a possible hesitation about who was entitled to appeal. Accordingly, if there were not the reservations made in point 5.8 supra, and the question about the possible role of the intention, the present case could correspond to the situation as described in points 7.1 to 7.3 of the Reasons of T 656/98, where the Board then concluded that there was no deficiency, hence no room for any application of Rule 65(2) EPC 1973" (see the referring decision, Reason No. 5.9.7).*

45.2 The "reservations in point 5.8" referred to are in fact the referring board's clear and, to the minority, convincing summary why in the present case the principle in T 97/98 can and should be applied:

*"This is why the question arises in the present case whether, in view of this possible broad interpretation, this Board should consider the alleged incorrect indication in the notice of appeal as a deficiency pursuant to Rules 99(1)(a) and 101(2) EPC. In fact the parameters used to establish the true intention in the decisions analysed above point to an error qualifying as such a deficiency in the identity of the appellant: from the file and the appealed decision it is immediately clear that Zenon Technology Partnership is the only party adversely affected, the same representative has been acting for this company since the opposition procedure, no transfer of rights has occurred, the appeal fee had been paid in the name of Zenon Technology Partnership,*

*in addition the anomaly was immediately seen by the Registrar - all of which could plead in favour of a genuine error."*

45.3 Thus the referring board itself makes the distinction which the minority believes to be perfectly clear from the case law that, on the one hand, cases of uncertain identity of an appellant (which give rise to a remediable deficiency) are to be resolved by the application of Rule 101(2) EPC and, following T 97/98, this should include consideration of the appellant's true intention and, on the other hand, cases of transfer of ownership of a patent in which the new proprietor is quite intentionally named as appellant before the necessary formalities have been completed (which gives rise to a non-remediable deficiency). As the referring board says, if it were not for those differences the present case could correspond to the situation as described in points 7.1 to 7.3 of T 656/98. It follows that the reverse is equally true – since those differences do exist, the present case does not so correspond. As point 7.1 of T 656/98 clearly states:

*"The notice of appeal did comply with the requirements of Rule 64(a) EPC that the name and address of the appellant be stated. Accordingly, there was no basis for an invitation by the board to remedy any deficiency as referred to in Rule 65 EPC: there was no deficiency."*

45.4 The fact that some decisions of boards of appeal have allowed deficiencies in the appellant's name to be remedied under Rule 101(2) EPC, whereas in other decisions on analogous situations the boards of appeal have applied Rule 139, first sentence, EPC without making any finding as to the procedure under Rule 101(2) EPC (see point 12 above), does not lead to an inconsistency or contradiction in the case law of the boards of appeal either. It merely demonstrates that, as long as the removal of the deficiency does not lead to a change of the (original) appellant's true identity, both procedures are available according to the consistent case law (as is confirmed by the answers given in the present decision to questions (1) and (3) of the referral).

46. Accordingly, in the opinion of the minority, there is no inconsistency in the case law and the legal position is clear.

46.1 This is demonstrated by the events in the proceedings before the referring board. The notice of appeal (see section II above) contained in its heading the correct name (Zenon Technology Partnership) of the party which was both the patent proprietor and the unsuccessful party in the opposition proceedings and in the body of the notice the name (Zenon Environmental Inc.) and address of the party which was the original applicant for and previous proprietor of the patent in suit, a change of ownership having been recorded during the opposition proceedings. Apart from that obvious inconsistency, it was clear on the face of the notice of appeal that it was at least in part incorrect since it referred erroneously to the decision of "the examining division dated 28 December 2007 to refuse the patent application" whereas it was clear, and no-one has questioned, that the decision under appeal was that of the opposition division of that date to revoke the patent.



46.2 The existence of a deficiency was apparent to the registrar, who added an annotation to the standard letter dated 7 March 2008, noting the two different names and asking the patentee (appellant) to "clarify" the situation. That clarification was supplied six days later by the appellant's letter of 13 March 2008 stating that the appeal should have been filed in the name of the current proprietor (Zenon Technology Partnership), which statement clearly meant in the context of the notice of appeal (see the text in section II above) that the representative when filing the appeal acted on behalf of Zenon Technology Partnership. That exchange of correspondence thus remedied any deficiency in the notice of appeal leading to non-compliance with Rule 99(1)(a) EPC. It is true that the registrar's letter did not specify a period for remedying the deficiency but, since any such period would have had to be at least two months (cf. Rule 132(2) EPC), a remedying reply within six days was clearly adequate. This was thus a straightforward example of the use of Rule 101(2) EPC in operation and, in the light of the prior case law, the referring board should have had no difficulty identifying the true appellant. Indeed, in point 5.8 of its referring decision (see point 45.2 above), the referring board explains quite correctly how it could have done so.

47. There is also no situation "where a board intends to deviate from an interpretation or explanation of the EPC given by one or more boards in previous case law" (see point 10 above). In the referral decision no reason is given why either of the two available procedures (under Rules 101(2) and 139 EPC) or their mere coexistence would be legally problematic. As is clear from the questions and the reasoning in the referral decision, the referral was also prompted by a purported (but actually non-existent – see points 43 to 45.4 above) inconsistency of the case law on the relationship between Rule 102(1) and (2) EPC. Under these circumstances the minority cannot see that the referring board had the specific intention to deviate from the case law because it considered it to be problematic on a ground other than inconsistency. Even if that was its intention, the referring board has not in fact presented any such ground with the consequence that the referral would be unsubstantiated in this respect. Thus in the minority's opinion the admissibility requirement "for ensuring uniform application of the law" (Article 112(1) EPC) is also not met (in contrast to the finding of the majority – see point 12 above).

48. As to the further possible ground for a referral by a board pursuant to Article 112 EPC, namely "if a point of law of fundamental importance arises", the minority concurs with the majority's view that this ground is established if a board considers that the question cannot be answered directly and unambiguously by reference to the EPC (see point 12 above). However, it cannot see, and it was not argued, that this is true of the point of law at issue. The minority does not share the view that "a point of law is also to be regarded as fundamental, if its importance extends beyond the specific case in hand" and that "Such importance is established if the point of law could be relevant to a large number of similar cases"

(see point 10 above). This view implies that "importance" within the meaning of Article 112 EPC is nothing more than mere relevance, the number of cases affected then being neither a suitable nor an appropriate criterion for establishing the admissibility of a referral to the Enlarged Board of Appeal. Apart from the fact that it is impossible to ascertain the number of cases in which a point of law was, is or might become relevant, it remains also totally unclear where the line between a small and a large number of cases has to be drawn and whether the location of that line depends on the point of law concerned. Thus the alternative mentioned in Article 112(1) EPC, namely that an important point of law arises, has not been shown and the admissibility of the referral cannot be based on that ground either.

49. For these reasons the minority concludes that in the present case none of the questions in the referral decision fulfils the specific requirements of Article 112(1)(a) EPC, which requirements cannot be replaced by the presence of a degree of uncertainty surrounding the issues put forward in a referral decision. In contrast to the relevant finding of the majority (see point 14 above), the minority does not accept that the referring board needs the opinion of the Enlarged Board on the referred questions in order to ensure uniform application of the law, or because a point of law of fundamental importance has arisen, and/or in order to dispose of the case before it. For the avoidance of any doubt it should be added that, while the minority considers for those reasons that the referral is inadmissible, it agrees with the answers to the referred questions.

#### **Order**

For these reasons it is decided that:

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

Question (1):

The answer to reformulated question (1) - namely whether when a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is it possible to correct this error under Rule 101(2) EPC by a request for substitution by the name of the true appellant - is yes, provided the requirements of Rule 101(1) EPC have been met.

Question (2):

Proceedings before the EPO are conducted in accordance with the principle of free evaluation of evidence. This also applies to the problems under consideration in the present referral.

Question (3):

In cases of an error in the appellant's name, the general procedure for correcting errors under Rule 139, first sentence, EPC is available under the conditions established by the case law of the boards of appeal.

Question (4):

Given the answers to questions (1) and (3), there is no need to answer question (4).

-----