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D E C I S I O N
of 25 May 2005

Case Number: G 0002/04
Application Number: 92305862.2
Publication Number: 0520794
IPC: C12Q 1/68
Language of the proceedings: EN

Title of invention:

Methods for detection of carcinoma metastases by nucleic acid amplification

Patentee:

F. HOFFMANN-LA ROCHE AG, et al.

Opponent:

- (1) Akzo Nobel N.V.
(2) Vysis Inc.

Headword:

Transfer of opposition/HOFFMANN-LA ROCHE

Relevant legal provisions:

EPC Art. 58, 99(1), 105, 107, 108, 112(1)(a), 114(2), 134
EPC R. 20, 60(2), 61, 64(a), 65(2), 88, 101(1), (4)

Keyword:

"Admissibility of the referral (yes)"
"Transfer of opponent status - free transfer (no) -
transfer to subsidiary in whose interest the opposition was
filed (no)"
"Correction of the appellant contrary to true intentions (no)"
"Auxiliary request concerning the person of the appellant in
case of legal uncertainty"

Decisions cited:

G 0004/88, G 0009/91, G 0010/91, G 0008/92, G 0009/93,
G 0001/97, G 0003/97, G 0003/99, J 0016/94, J 0027/94,
T 0563/89, T 0659/92, T 0670/95, T 0298/97, T 0097/98,
T 0964/98, T 0711/99, T 0009/00, T 0715/01, T 0854/02

Headnote:

(see Order)



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Case Number: G 0002/04

D E C I S I O N
of the Enlarged Board of Appeal
of 25 May 2005

Appellant:
(Opponent 01)

bioMérieux B.V.
Boseind 15
NL-5281 RM Boxtel (NL)

Representative:

Van Someren, Petronella F. H. M.
Arnold & Siedsma
Advocaten en Octrooigemachtigden
Sweelinckplein 1
NL-2517 GK Den Haag (NL)

Respondents:
(Proprietors of the patent)

F. HOFFMANN-LA ROCHE AG
Grenzacherstrasse 124
CH-4002 Basel (CH)

The Regents of the University of California
Oakland
California 94612-3550 (US)

Representative:

Bizley, Richard Edward
Hepworth, Lawrence, Bryer & Bizley
Merlin House
Falconry Court
Baker's Lane
Epping
Essex CM16 5DQ (GB)

Other Party:
(Opponent 02)

Vysis Inc.
Downers Grove
Illinois 60615-5400 (US)

Representative:

Ritter, Stephen David
Mathys & Squire
100 Gray's Inn Road
London WC1X 8AL (GB)

Referring decision:

Interlocutory decision of the Technical Board
of Appeal 3.3.4 dated 23 July 2004 in case
T 1091/02.

Composition of the Board:

Chairman:

P. Messerli

Members:

R. Teschemacher

W. Moser

A. Nuss

J.-C. Saisset

J.-M. Suárez Robledano

W. Wheeler

Summary of Facts and Submissions

I. In its decision T 1091/02 (OJ EPO 2005, 14 - Methods for detection/HOFFMANN-LA ROCHE), Technical Board of Appeal 3.3.4 referred the following point of law to the Enlarged Board of Appeal:

1. (a) Can opponent status be freely transferred?

(b) If question 1(a) is answered in the negative:

Can a legal person who was a 100%-owned subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates acquire opponent status if all its shares are assigned by the opponent to another company and if the persons involved in the transaction agree to the transfer of the opposition?

2. If question 1(a) or (b) is answered in the affirmative:

(a) Which formal requirements have to be fulfilled before the transfer of opponent status can be accepted? In particular, is it necessary to submit full documentary evidence proving the alleged facts?

(b) Is an appeal filed by an alleged new opponent inadmissible if the above formal requirements are not complied with before expiry of the time limit for filing the notice of appeal?

3. If question 1(a) and (b) is answered in the negative:

Is an appeal admissible if, although filed on behalf of a person not entitled to appeal, the notice of appeal contains an auxiliary request that the appeal be considered filed on behalf of a person entitled to appeal?

- II. 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 B.V. It was submitted that bioMérieux B.V. now owned the diagnostic activities of Akzo Nobel N.V. 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 N.V.

In an accompanying declaration it was explained that the diagnostic activities of Akzo Nobel had been concentrated in its subsidiary Organon Teknika B.V. As a result of restructuring within Akzo Nobel N.V., an agreement effective as of 30 June 2001 had been reached to transfer the diagnostic activities of Organon Teknika B.V. from Akzo Nobel N.V. to bioMérieux S.A. The opposition had been instituted by Akzo Nobel N.V. in the interest of its European diagnostic business as conducted on its behalf by its business unit Organon Teknika B.V. All the shares of Organon Teknika B.V. had been transferred to bioMérieux S.A. which was now 100%

the owner of Organon Teknika B.V, now called bioMérieux B.V.

III. The decision of referral

Board 3.3.4 starts from the premise that the conditions required by the established case law for a transfer of the opponent status were not fulfilled. There was no case of universal succession which was acknowledged as basis for a transfer of an opposition in Rule 60(2) EPC and decision G 4/88 (OJ EPO 1989, 480 - Transfer of opposition/MAN, Reasons, point 4). Nor was there a transfer of the opposition as part of the opponent's business assets within the meaning of G 4/88 (*loc. cit.*, Reasons, point 6). Even if the sale and the assignment of the shares of a legally independent entity by a holding company could be regarded as the business exercised by this entity, the transferee would have been bioMérieux S.A. and not Organon Teknika B.V., later named bioMérieux B.V., which had filed the appeal.

Nevertheless, Board 3.3.4 took the view that the factual situation as alleged by the appellant was rather similar to the situation in which G 4/88 had allowed a transfer of opponent status, the only difference being the corporate structure of the opponent. The Board considered it appropriate to examine more closely the assumptions underlying the previous case law, i.e.:

- that opponent status was, as a matter of principle, not freely transferable, and

- that the situation addressed in decision G 4/88 constituted only a narrow exception to this principle which should not be broadened.

On consideration of the matter, Board 3.3.4 was inclined to accept a transfer of the opponent status when the original opponent sold and assigned its interest in a subsidiary to whose business the opposition pertained. Considering the divergent case law of the boards of appeal, it was, however, necessary to refer this question to the Enlarged Board of Appeal.

In the event that the Enlarged Board of Appeal did not consider bioMérieux B.V. as a person entitled to appeal for the purposes of Article 107 EPC, the further question arose whether the auxiliary request was allowable with the effect that the appeal could proceed in the name of Akzo Nobel N.V. The latter request might also be interpreted as a conditional request for correction of the name of the appellant. Therefore, the question arose whether the indication of the appellant could be regarded as a deficiency which could be rectified under Rule 65(2) EPC.

- IV. The written submissions of the parties and the submissions during the oral proceedings, held on 13 April 2005, may be summarized as follows:

Admissibility of the referral

The respondent questioned whether a decision of the Enlarged Board of Appeal was required within the meaning of Article 112(1)(a) EPC since it was self-evident that no admissible appeal had been filed.

- (a) There was no evidence that the appellant/opponent 01 had been properly represented when the opposition and the appeal had been filed. In the communication preparing the oral proceedings, the Enlarged Board of Appeal informed the parties that it had taken note of the fact that the persons acting for the appellant when filing the opposition and the appeal were professional representatives and, as a rule, not obliged to file an authorisation. In the oral proceedings, the respondent maintained its objection without further arguing this point.
- (b) In addition, there was no admissible appeal as required for an admissible referral since the appeal had not been filed by a person adversely affected within the meaning of Article 107, first sentence, EPC. In the absence of an admissible appeal, auxiliary requests could not be considered. The appellant replied that admissibility could not be assessed without considering any auxiliary request. The adverse effect was transferred together with party status to the transferee.

Question 1(a)

- (a) The appellant's proposed answer to this question was:

Oppositions should in any case be freely transferable.

The appellant concurred with the considerations in the referring decision as far as the substantive

requirements for transfer of opponent status are concerned. The appellant submitted that in the case law following G 4/88 (*loc. cit.*) that decision was interpreted too narrowly. The decision dealt with a specific situation and did not give general directions for any transfer of opponent status. Decision G 3/97 (OJ EPO 1999, 245 - Opposition on behalf of a third party/INDUPACK), stating that an opponent did not have the right to dispose over its party status, also stated that there could be an end to the opponent's involvement in the opposition, and this meant therefore that another party could acquire the status of opponent.

It had been the opponent's business decision to file all oppositions in its own name, irrespective of the subsidiary to which the relevant business belonged. It appeared unreasonable that an opposition once filed by a company in accordance with its company policy could no longer be transferred because the EPC or the case law prescribed rules for the transfer which could not be met. In the oral proceedings, the appellant cited case T 563/89 (decision of 3 September 1991, not published in OJ EPO) in which a transfer had been allowed in the same situation.

(b) The respondent proposed the following answer to question 1(a):

A free transfer of oppositions should not be allowed. Opponent status could only be transferred if there was evidence to a standard of beyond reasonable doubt of a transfer of real or intangible property under the applicable laws of one or more of the Contracting States and where the original opposition could be seen to protect and thereby be linked to the property being transferred. Such a transfer should be seen as automatically conferring transferability on opponent status if, and only if, all of the relevant property protected by the opposition could be seen to have been transferred.

The respondent considered the proposed answer to be in line with previous decisions of this Board regarding opponent status, in particular G 4/88 (*loc. cit.*), but offering a somewhat broader concept than G 4/88. This concept would entail adequate solutions to a number of possible situations, maintaining essential fairness and balance between the interests of the opponent, the patentee and the public at large. The absence of specific provisions for recording opposition transfer was *prima facie* evidence that completely free and independent transfer was not envisaged by the legislator. The respondent questioned whether it was appropriate for the Enlarged Board of Appeal to create a new form of transfer of a property right which might require the creation of new rules of procedure.

Question 1(b)

- (a) The appellant's proposed answer to this question was:

If question 1(a) was answered in the negative, question 1(b) should be answered in the affirmative.

The reasons given by the appellant largely correspond to the arguments given in respect of question 1(a). In addition, it was submitted that an opponent could not foresee a possible change in its corporate structure.

- (b) The respondent proposed the following answer to question 1(b):

A legal person who was 100% owned by the opponent when the opposition was filed (and who carried on the business to which the opposed patent related) could not acquire opponent status if 100% of its shares were purchased by another party (and if all persons involved in the transaction agreed to the transfer of the opposition).

The respondent submitted that the sale of a subsidiary concerned only the parent company and the third party. The subsidiary was object of the transfer and not a party to the transaction. Hence, it could not acquire opponent party status as a result of the transaction. The situation was quite different from the facts in G 4/88 (*loc. cit.*) where the business in respect of which the opposition had been filed formed a division of a company and was without legal personality. A broadening of the ambit of G 4/88 to encompass the

facts underlying the referral would require overturning the general principle of law stated in G 3/97 (*loc. cit.*) that a party had no disposition over its party status.

Question 2(a)

(a) The appellant's proposed answer to this question was:

If the facts were such that it was clear that all parties agreed to the new situation, there was no need to submit full documentary evidence. In case the information in the notice of appeal was insufficient to establish with a sufficient degree of probability the alleged facts, i.e. whether the alleged appellant was the adversely affected party as required by Article 107 EPC, an invitation from the Board should be issued to file further evidence pursuant to Rule 65(2) EPC.

In respect of the formal requirements for the transfer of opponent status, the appellant submitted that national law governed the actual succession of the assets to which the party status was accessory and that the EPC was only concerned with registering this transfer. Considering the principle of free evaluation of evidence, corresponding declarations of the parties concerned should be sufficient.

(b) The respondent proposed the following answer to question 2(a):

Full documentary evidence proving the factual transfer of opponent status had to be submitted.

According to the respondent, the formalities pursuant to Rule 20 EPC should as far as possible be applied when recording transfer of opponent party status. Accordingly, the production of documents satisfying the EPO that the transfer had taken place was required. In order to avoid the need to undertake investigations as to the existence of an alleged transfer, it would be sensible to call for documents proving any transfer according to standards recognised under relevant national laws.

Question 2(b)

- (a) The appellant's proposed answer to this question was:

It should be possible to file documentary evidence, for example on invitation of the Board, after expiration of the appeal period.

As to the relevant point of time, the submission of evidence for establishing a transfer should not be treated differently from the situation when a deficiency under Rule 64(a) EPC was remedied. In both cases the identity of the appellant was unclear for some time after the expiry of the time limit for filing the appeal. Even if Rules 64(a) and 65(2) EPC were not considered as exceptions to the principle that the appellant had to be identified at the end of the time limit for filing the appeal, the case law of the boards of appeal had accepted that mistakes were made and might be corrected as long as it was clear what was intended. In the case underlying the referral, there

was no uncertainty as to who could be the appellant, since the old as well as the new appellant were known.

(b) The respondent proposed the following answer to question 2(b):

If an alleged new opponent did not comply with formal requirements before the expiry of the time limit for filing a notice of appeal, then the appeal was inadmissible.

According to Rule 20(3) EPC, a transfer only had effect when and to the extent that the documents satisfying the EPO had been filed. The opposition right was to be considered as a bundle of individual rights which could only be exercised within certain time limits. In the interest of fairness and certainty of procedure, the individual rights could only be exercised by the person recorded on the register at the relevant time.

Question 3

(a) The appellant's proposed answer to this question was:

Question 3 should be answered in the affirmative.

The appellant agreed with the referring decision as to the admissibility of the appeal in view of the subsidiary request in the notice of appeal. For the proprietor there was no uncertainty because he knew from the subsidiary request that either of the two parties would be the appellant.

- (b) The respondent proposed the following answer to question 3:

An appeal could not be admissible via an auxiliary request on behalf of a person rightly entitled to appeal.

At the outset, the respondent took the view that there was no apparent lack of harmony in the case law concerning question 3, implying thereby that the requirements for a referral are not fulfilled for this question. In any case, the question should be answered in the negative because auxiliary requests could only be made by a person entitled to act in the course of pending proceedings initiated by an admissible appeal which required a definite and unconditional satisfaction of the formal requirements pursuant to Articles 107 and 108 EPC and Rules 64 and 65 EPC.

- V. Opponent 02, party as of right to the appeal proceedings, has abstained from filing any comments.
- VI. No statements have been filed by third parties.
- VII. At the end of the oral proceedings, the Chairman closed the debate and announced that the decision would be given in writing.

Reasons for the Decision

1. The referral is admissible.

- 1.1 The respondent's objections to the proper representation of the appellant do not give rise to any doubts on the part of the Board.
 - 1.1.1 There was no need to prove the qualification of the persons acting for the appellant. Whether or not a person is a professional representative pursuant to Article 134 EPC is evident at any given time from the list maintained by the EPO which is available to the public in printed and electronic form. Entries, amendments and deletions are published in the Official Journal of the EPO. From this information it is clear that the appeal was filed by a professional representative.
 - 1.1.2 As a rule, a professional representative is not obliged to file an authorisation (Rule 101(1), first sentence, EPC in conjunction with the Decision of the President of the EPO dated 19 July 1991 on the filing of authorisations, OJ EPO 1991, 489). Thus, the professional representative is deemed to be entitled to act in the name of the respective party, unless he fails to file an authorisation in due time if invited to do so in a specific case (Rule 101(4) EPC).
- 1.2 The other objections to the admissibility of the appeal are related to the referred point of law. As a rule, it is true that a referral presupposes an admissible appeal. However, this does not apply if the referred point of law concerns the admissibility of the appeal (G 3/99, OJ EPO 2002, 347 - Admissibility of joint opposition or joint appeal/HOWARD FLOREY, Reasons, point 4, referring to G 8/92 of 5 March 1993, not published in OJ EPO, Reasons, point 3).

1.3 Questions 1 and 2 are referred in order to ensure uniform application of the law. This follows from the lack of clear case law indicated in the referring decision.

In respect of question 3, it is apparent that clear legal principles are necessary for assessing who may be a party to the proceedings before the EPO (for the opponent, cf. G 3/99, *loc. cit.*, Reasons, point 12). At any given time throughout the proceedings, there should be no doubt as to who may validly exercise procedural rights and to whom official actions by the EPO are to be addressed. Therefore, the question to which extent deficiencies in identifying the appellant may be remedied is an important point of law.

1.4 The respondent submitted that a decision of the Enlarged Board of Appeal was not necessary since the legal situation was clear considering the respective provisions of the EPC and previous case law of this Board. Such an approach conflates the procedural question of admissibility of the referral with the substantive question of how the referred point of law is to be answered. There is no doubt that the referred point of law is relevant for deciding the case underlying the referral.

2. The referring decision contains two argumentations in support of allowing a transfer of the opposition in the situation giving rise to the referral, resulting in questions 1(a) and (b).

2.1 *Question 1(a) -*

Free transferability of opponent status?

- 2.1.1 Whereas it may be said that in G 4/88 the question was left undecided whether opponent status can be freely transferred (*loc. cit.*, cf. Reasons, point 5), the Enlarged Board of Appeal took position in this respect in G 3/97 stating that the "opponent does not have a right of disposition over his status as a party" (*loc. cit.*, Reasons, point 2.2; see also T 659/92, OJ EPO 1995, 519 - Transfer of opposition/SCHWEISFURTH; T 670/95 of 9 June 1998 - Zementzusammensetzung/SIKA, cited in Case Law of the Boards of Appeal of the EPO, 4th ed. 2001, VII.C.5 and VII.D.5.2; T 298/97, OJ EPO 2002, 83 - Detergent composition/UNILEVER, Reasons, point 5 et seq.). There is no reason to deviate from this position.

The appellant tried to give that statement in G 3/97 a restricted meaning arguing that the decision left the possibility of an end of the involvement of the opponent open. As with any party to proceedings, the opponent can give up his procedural position by withdrawing the opposition, withdrawing the appeal or by withdrawing from a group of common opponents, as the case may be. Nothing else is addressed in the above phrase in G 3/97. That is evident from the subsequent sentence according to which the opponent cannot offload his status onto a third party. This expressly excludes the appellant's interpretation that the end of the opponent's involvement could give a third party the possibility to take over the opponent's status.

2.1.2 The main argument considered by the referring Board for free transferability of opponent status is the principle of equal treatment of proprietor and opponent (T 1091/02, Reasons, point 2.5.1).

The referring decision does not fail to appreciate that the situations of the proprietor and the opponent are different. In the case of the proprietor, the industrial property right may be transferred and such transfer may have effect *vis-à-vis* the EPO if it is registered in accordance with Rule 61 in conjunction with Rule 20 EPC. This allows the new proprietor to defend his patent in opposition proceedings before the EPO. Hence, the procedural status of the proprietor cannot be transferred without the substantive title. In the case of the opponent there is no substantive title. Therefore, the question whether the procedural status may change with the ownership does not arise and both situations are fundamentally different.

Neither does the referring decision fail to appreciate that, according to general principles of procedural law, it is not within the discretion of a party to court proceedings to transfer its party status to another person (Reasons, point 2.5.6). Whereas the EPC has made provision for the requirements under which the status of the applicant or proprietor in the proceedings before the EPO may change, there are no corresponding provisions for the opponent. As an exception, the situation of the heir as universal successor is addressed in Rule 60(2) EPC. Apparently the legislator did not want to provide for cases of transfer apart from universal succession. No *lacuna* in the law has become apparent which the jurisprudence might be called

upon to fill (cf. G 1/97, OJ EPO 2000, 322 - Request with a view to revision/ETA, Reasons, point 3 b).

2.1.3 The appellant submitted that free transfer of the opponent status was justified due to the public interest in having invalid patents revoked. Indeed, it is the purpose of opposition proceedings to give the public the opportunity to challenge the validity of the patent (G 9/93, OJ EPO 1994, 891 - Opposition by patent proprietor/PEUGEOT AND CITROEN, Reasons, point 3). This possibility may serve the individual interest of the opponent who wants to remain free from being subject to limitations in his commercial activities, although such an interest is not necessary. In any case, opposition proceedings are in the interest of the public, in particular to have circumstances arguing against patentability considered which were not revealed in grant proceedings (G 3/97, *loc. cit.*, Reasons, point 3.2.3). According to the appellant, this purpose justifies a free transfer, e.g. in a situation where the original opponent lost its interest in the opposition and another person is interested in continuing the proceedings. Referring to G 3/97, the appellant submitted that the proprietor did not have a legitimate interest in knowing the opponent.

2.1.4 The Board cannot agree. Opposition proceedings are conceived as a simple, speedily conducted procedure. On the one hand, relevant objections should be given appropriate consideration, on the other hand a decision should be reached as quickly as possible. This serves not only the interests of both parties (G 3/97, *loc. cit.*, Reasons, point 3.2.3) but also the interest of the public at large in having clarified as soon as

possible the question of whether an exclusive right has to be respected. For that reason, opposition is subject to a time limit, and third party participation is restricted in Article 105 EPC. It would be contrary to this concept to allow a third party who has failed to oppose within due time to take over the procedural position of an opponent who has lost interest, thereby lengthening proceedings which would otherwise be finished (see also T 298/97, *loc. cit.*, Reasons, point 7.1).

Decision T 563/89 (*loc. cit.*), cited by the appellant, cannot support its position for the following reasons. Firstly, unlike the situation underlying the referral, a transfer was acknowledged in that case from a company which had filed the opposition to the purchaser of the company. In addition, the underlying facts are not very clear from the decision. It is stated that the purchasing company acted as successor in title which could mean that the original opponent no longer existed. Finally, the transfer had not been contested and in accepting the transfer the Board restricted itself to a reference to the reasons of G 4/88.

Neither does the appellant's reference to G 3/97 justify the conclusions drawn therefrom. When stating that an interest in knowing the identity of the person at whose instigation the opposition has been filed is not legally protected (*loc. cit.*, Reasons, point 3.2.1), G 3/97 deals with a situation in which the opponent is acting in the interest of a third party. The decision treats only the formally authorised person as party to the proceedings and it states also that, with this approach, doubts about the position of the parties

cannot arise (Reasons, point 3.2.5). That means that the proprietor has no procedural means to learn who the third party is. It is, however, indispensable that the identity of the opponent is clear, even if he is a man of straw.

2.2 *Question 1(b) -*

Broadening the finding in decision G 4/88?

The referring decision voices doubts about whether the transfer of a part of a company's own business can be equated with the sale of a subsidiary company itself doing business (Reasons, point 2.3.2). In fact, a difference exists between a legal person and a part of its business carried out by a simple department without legal personality (T 9/00, OJ EPO 2002, 275 - Opposition/HENKEL, at p. 289). The sale of a subsidiary does not change the status of the companies involved, whereas the sale of a mere department entails a splitting of the company selling a part of its business. However, Board 3.3.4 suggests that the situation giving rise to the referral and the situation for which the Enlarged Board of Appeal in G 4/88 accepted a transfer of opposition are very similar with respect to the interests involved. In both cases, due to a major business transaction the original opponent had a legitimate interest in transferring the opposition. The breaking up of the ties between the opponent and its subsidiary appeared to be comparable to the transfer of relevant business assets (*loc. cit.*, Reasons, point 2.4).

- 2.2.1 At the outset, the referring Board correctly states that in the first situation the opposition could have

been filed directly on behalf of the subsidiary to whose business the opposition related. This was not possible in the case dealt with in G 4/88 in which only after the filing of the opposition a separate legal person came into existence by a split-off of a part of the enterprise of an, until then, single legal person. This establishes an essential difference between the two situations:

In G 4/88 the Enlarged Board of Appeal was faced with a situation in which it was for legal reasons not from the outset possible to attribute the procedural status of opponent to the business in whose interest the opposition was filed, whereas the referral is concerned with a situation in which the holding company did not want to attribute the procedural status of opponent to the entity in whose interest the opposition was filed. Choosing the legal forms in which parties organise their legal relations, in particular in taking part in legal proceedings, means balancing the advantages and disadvantages of the available possibilities.

There are certainly good reasons why it may be preferable to centralise all industrial property matters of a group of affiliated companies within a central unit of the holding company. These reasons have to be balanced against possible disadvantages. The evident consequence of a centralisation is that legal rights are gathered by the holding company. The disadvantage may arise therefrom that a transfer of legal rights may often be costly and sometimes not be possible at all, as the present case shows.

However, the opponent could easily have made provision for a future eventuality that its subsidiary should take over the responsibility for the opposition. If the holding company and subsidiary had filed the opposition as common opponents, the holding company could have withdrawn from the opposition at any time, leaving the subsidiary as the sole opponent (G 3/99, *loc. cit.*, Reasons, point 13).

This shows that the available possibilities for organising industrial property matters within a group of affiliated companies entail different legal consequences and different possibilities as to how to safeguard a party's interests. Such differences alone, however, are no reason deliberately to ignore the legal consequences of the specific course of action chosen. Rather, there should be convincing reasons why such consequences might be not acceptable in a specific situation.

- 2.2.2 In the case law of the Boards of Appeal subsequent to G 4/88 (*loc. cit.*), the rationale of G 4/88 was not extended to other situations. In addition to the cases of universal succession, a transfer of the opposition was only allowed when a relevant part of the opponent's business was transferred (T 670/95, *loc. cit.*, summarizing the previous case law; T 711/99, OJ EPO 2004, 550 - Transfer of opposition/L'OREAL).

The interests involved do not justify applying the rationale of decision G 4/88 *mutatis mutandis* to the case of the sale of a subsidiary company in whose interest the holding company filed the opposition.

(a) *Legal certainty and efficiency of procedure*

Legal certainty requires that it is clear at any given time who the parties to the proceedings are (*supra*, point 1.3). If the sale of a subsidiary were considered as a reason justifying a transfer of the opponent status, each such transfer would raise the question of whether the holding company wants to remain party to the proceedings or whether it wants to request a transfer. Whereas it was clear before that there was only one single opponent, the sale of a subsidiary would open a choice of who will act as the opponent for the further proceedings. If the opposition is transferred, the additional question arises of who is the legitimate assignee, the new holding company (in the case underlying the referral bioMérieux S.A.) or the subsidiary (in the case underlying the referral Organon Teknika / bioMérieux B.V.) which was sold. The first alternative can hardly be considered analogous to G 4/88, the latter would be contrary to the express intention of the original opponent.

A further factual question would be whether the opponent can produce sufficient evidence to satisfy the opposition division or board of appeal that the sale has actually taken place. For tax reasons, sales of companies quite often involve transactions via tax havens with the consequence that the validity and the dimension of the sale are difficult to assess. In the case giving rise to the referral, the opponent submitted that the relevant business had been sold together with the subsidiary. Nevertheless, it had to admit that its patent activities in the relevant field had not completely stopped after the sale. This shows

that a liberal admission of transfers may often result in the need to examine contested questions of fact or difficult questions of company law. This would broaden the possible procedural battle-fields for the parties and give rise to complications and delays in opposition proceedings. These difficulties are illustrated in the referring decision (point 2.5.2).

(b) The interest of the opponent

One can agree with the assumption in the referring decision that an opponent would not normally seek a transfer of its status without having some valid reason for doing so. The question is, however, not whether a more liberal approach to the transferability of oppositions would entail a serious risk of fanciful or frivolous procedural behaviour of opponents (*loc. cit.*, Reasons, point 2.5.3). Rather, the question has to be asked whether there are convincing reasons why a further exception should be made to the principle that it is not within the discretion of a party to the proceedings to transfer its status. Considering that an opposition filed by the parent and subsidiary company in common avoids any practical problems which may arise (*supra*, point 2.2.1), it is the opponent's responsibility if he does not act accordingly, and he cannot complain that procedural law does not meet his needs.

(c) The interest of the proprietor

Article 99(1) EPC allows "any person" to file an opposition within nine months from the publication of the grant of the European patent. It is in the

legitimate interest of the proprietor not to be forced to defend its patent against a new opponent after the expiry of that time-limit. It is true that the new opponent does not have a better procedural position than the old one (T 1091/02, Reasons, point 2.5.4). However, it may be expected that a new party reviews the course of action taken by its predecessor and tries to introduce new lines of attack. An economically stronger assignee may considerably intensify the attack on the patent. Even if Article 114(2) EPC provides means for avoiding an unjustified delay, the proceedings may be lengthened and become more difficult for the proprietor.

(d) The interest of the public

The referring decision sees the danger that the public interest in each opposition being examined on its merits may be jeopardised if opposition status could only be transferred under exceptional circumstances (Reasons, point 2.5.5). There was a certain likelihood that an opponent who was not allowed to transfer his status to another person might then simply withdraw his opposition or refrain from taking active part in the opposition proceedings. It is true that this cannot be excluded. However, such conduct should normally not be expected in the case of a sale of a subsidiary company. In the case giving rise to the referral, the opponent had not stopped its patent activities in the relevant field with the sale of the subsidiary. Also in other situations, it does not seem unreasonable that an opponent might bring pending opposition proceedings to an end in order to comply with contractual obligations

vis-à-vis a purchaser of a company in whose interest an opposition had been filed.

In addition, it has to be emphasised that in principle it is the notice of opposition which defines the legal and factual framework, within which the substantive examination of the opposition shall be conducted (G 9/91 and G 10/91, OJ EPO 1993, 408 and 420 - Power to examine/ROHM UND HAAS and Examination of opposition/appeals, Reasons, point 6). It is not only in the public interest that invalid patents be revoked but also that opposition proceedings be conducted speedily (see also *supra*, point 2.1.4). Therefore, the opponent's case should be made at the beginning of the proceedings and a final decision on the attack should be given as quickly as possible. If an opponent withdraws from the proceedings, the public interest in the examination of valid objections is preserved, to the extent to which the legislator considered this necessary, by Rule 60(2) EPC which allows the continuation of the proceedings *ex officio*.

2.2.3 In summary, there is no convincing reason, in particular not any overriding interest of the parties or the public, to extend the application of the rationale of G 4/88 to the case where a subsidiary company was sold in whose interest the opposition had been filed by the parent company.

3. Since questions 1(a) and (b) are answered in the negative, questions 2(a) and (b) need not be answered, leaving question 3 to be answered.

3.1 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 N.V. is not indicated as the appellant but bioMérieux B.V. 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). Considering the overriding interest that a party must be identifiable, the 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 N.V. 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.

3.2 Thus, the question remains whether an appellant can be validly indicated in an auxiliary request.

3.2.1 In general, procedural declarations must not be subject to any conditions (J 27/94, OJ EPO 1995, 831 - Divisional application/UNIVERSITÉ LAVAL). In the interest of legal certainty and efficiency of proceedings it should be clear from the outset whether a declaration is valid. This applies in particular to declarations initiating a procedure. Thus, an appeal

filed on a condition was held inadmissible (J 16/94, OJ EPO, 1997, 331 - Notice of appeal/XXX).

However, the requirement that procedural declarations be unconditional does not apply without exception.

As the referring decision correctly states, it is an accepted principle in proceedings before the EPO that a party may file auxiliary requests. When used appropriately, such requests do not impede the course of proceedings. Rather, they make clear at an early stage what the fallback positions of a party are and give the adversary and the deciding body the opportunity to be prepared as soon as the respective request becomes relevant. This is the case when the preceding preferred request turns out not to be allowed by the deciding body.

3.2.2 The notice of appeal in the case underlying the referral may be interpreted in different ways.

- (a) On the one hand, one can speak of two different appeals, the first in the name of bioMérieux B.V., the second in the name of Akzo Nobel N.V. In this case it would be consistent to require that both appeals, independently of each other, have to fulfil the formal requirements.
- (b) On the other hand, one can speak of one single appeal of which it is uncertain in whose name it should proceed. In that case there is certainly an appeal in the name of bioMérieux B.V. and, if bioMérieux B.V. is not entitled to appeal, the

question arises whether the auxiliary request is admissible.

- (c) Looking at the wording of the notice of appeal, the appellant apparently did not want to file two separate appeals. There is only one notice of appeal, the word appeal is used in the singular and the filing in the name of Akzo Nobel N.V. was said to be "subsidiarily and as a precautionary measure only".
- (d) What is more important than the mere wording is the purpose of the declaration. The intention was to file one single appeal. The author of the declaration wanted to file it in the name of the correct person, but was, however, not sure who the correct party to the proceedings was, the original opponent or the subsidiary in whose interest the opposition had been filed. The answer to this question did not depend on circumstances outside the proceedings. Rather, it was to be given by the referring Board when examining the admissibility of the appeal.

3.2.3 Question 3 has been posed by the referring Board in the context of legal certainty as far as the identity of the parties to the proceedings is concerned and this Board sees no reason to answer it in a broader context. There are certainly situations in which it is unclear for legal reasons who the correct party to the proceedings is.

- (a) An example was discussed in the oral proceedings before the Board: When preparing for his client

outside Europe, company A, a notice of appeal on the last day of the time limit, a European professional representative receives an e-mail from his client that company A had been merged with its competitor company B into company C and that the signed contracts had been submitted to the antitrust authorities for approval. It was unclear whether company A was still in existence. In this situation, there is not only the question of fact of whether or not the merger will be approved, but also questions of law, in particular the influence of an approval or an interdiction of the merger by the antitrust authorities on the effects of the contracts between the parties in company law.

- (b) The question of party status may quite often involve difficult questions of national law. Even a normally simple question as to which entities enjoy party status as a *body equivalent to a legal person by virtue of the law governing it* within the meaning of Article 58 EPC may turn out to be difficult in a specific case. This is evidenced by the "Gesellschaft bürgerlichen Rechts" according to German law which for some 100 years since the entry into force of the German Civil Code was not considered to be a legal person and a party to court proceedings until the civil courts started to modify the relevant case law (see Federal Court of Justice, decision of 29 January 2001, Neue Juristische Wochenschrift 2001, 1056) with the final result that this entity is now acknowledged as a party in the proceedings before the German Patent and Trademark Office (Mitteilung des

Präsidenten des Deutschen Patent- und Markenamts
Nr. 4/05, B1PMZ 2005, 2).

- (c) Another example of legal uncertainty about party status may be in a situation as envisaged in G 4/88 (*loc. cit.*), if a request for transfer of the opposition was submitted and the transfer has not yet been registered. It may be doubtful in the individual case whether or not the evidence submitted by the requester for establishing the transfer actually satisfies the EPO that a transfer of the relevant assets has duly taken place. Until the transfer is registered, party status is not definitely clear. Nevertheless there may be open time limits for performing procedural acts. In such a situation it appears legitimate that action is taken for the assignee whom the requester considers as entitled to act and, auxiliarily, for the assignor in case the requirements for a transfer have not yet been established.

3.2.4 The cases arising from legal problems as addressed above are to be distinguished from a conditional appeal which was the subject of decision J 16/94 (*loc. cit.*).

- (a) A conditional appeal intends to leave open whether appeal proceedings will become pending until the condition is fulfilled. In the case decided by the Legal Board of Appeal the condition was that a request for re-establishment of rights was refused. However, for reasons of legal certainty a notice of appeal must not leave doubts as to whether or not a decision is contested (J 16/94, *loc. cit.*,

Reasons, point 4; T 854/02 of 14 October 2002 - Use of Taxol/BRISTOL-MYERS SQUIBB, not published in OJ EPO, concerning a cross-appeal).

- (b) Such doubts do not exist if an appeal contains an auxiliary request concerning the person of the appellant. There are no doubts whether a review of the contested decision shall take place, but doubts only concerning in whose name the proceedings eventually will proceed. The notice of appeal is to be interpreted as one single appeal which, as a main request, is declared in the name of the person indicated first, and, as an auxiliary request, in the name of the person indicated alternatively. In the case underlying the referral, the professional representative was entitled to act in the name of both persons (*supra*, point 1.1.2).
- (c) The cited cases also have in common that the question of party status has to be decided by the competent body of the EPO on the basis of the file as it stands. This means that the "condition" for the relevance of the auxiliary request depends only on the judgment of this body. Thus, party status is not dependent on an uncertain event outside the proceedings. The uncertainty is not caused by the procedural conduct of the party but by a legal situation which, from an objective point of view, may be considered to be unclear. In this way the uncertainty concerning who will be considered to be the proper party is limited and the relevant question of law has to be answered anyway in the course of the pending proceedings,

whether or not an auxiliary request is submitted. Such a limited uncertainty may be accepted in the interest of the party which is forced to perform a procedural act within a prescribed time limit facing a legal situation which allows different interpretations.

3.2.5 As an alternative, in order to clarify party status, it would be possible to file two separate declarations, in the case underlying the referral one appeal in the name of bioMérieux B.V. and another appeal in the name of Akzo Nobel N.V.

- (a) Even if this course of action is taken, the Board of Appeal has to examine the question of the party status *ex officio* before dealing with the substance of the case(s). For initiating appeal proceedings, the only difference worth mentioning between the two possible approaches is that in the case of two appeals two appeal fees become due, whereas in the case of an auxiliary request only one appeal fee is to be paid. However, neither legal certainty nor efficiency of procedure are actually affected by the appellant's choice. For considering the two appeals, it would appear obligatory to hear them in the same proceedings pursuant to Article 9 of the Rules of Procedure of the Boards of Appeals since the appeals are filed from a single decision. The decisive preliminary procedural question to be considered in consolidated proceedings for both appeals would be identical, namely who is the correct party to the proceedings if a parent company sells its

subsidiary in whose interest it had filed the opposition.

- (b) In this situation, it appears overly formalistic and contrary to common sense to ask for the payment of two appeal fees for having one and the same legal question concerning who is the correct party to the proceedings answered in one single procedure. Any abuse of procedural options seems to be excluded if a request indicating an appellant in the alternative to the main request is restricted to a situation in which the party in question cannot be held responsible for the legal uncertainty as to which one of the entities may seriously be considered to be the correct party.
- (c) The respondent argued that allowing the indication of a further appellant by way of an auxiliary request would entail the possibility of filing even further auxiliary requests of a similar nature later on, e.g. as actually submitted by the appellant in the oral proceedings before Board 3.3.4, to the detriment of legal certainty. This argument is based on the respondent's approach that an auxiliary request can only be filed within an admissible appeal, and fails to appreciate the difference between a conditional appeal which is inadmissible and an auxiliary request leaving no doubt that the decision of the first instance is contested (*supra*, point 3.2.4). In any case, the respondent's view point does not seem to take due account of the case law requiring that an identifiable appellant must be indicated within

the time limit for filing the appeal (see the references *supra*, point 3.1).

3.2.6 In conclusion, it appears legitimate to the Enlarged Board of Appeal that a procedural declaration is made in the name of the person whom the person acting considers, according to his interpretation, to be the correct party, and at the same time, as an auxiliary request, in the name of a different person who might, according to another possible interpretation, also be considered the correct party to the proceedings, if there is a justifiable legal uncertainty as to how the law is to be interpreted in respect of the question of who the correct party to the proceedings is.

3.3 Whether such a justifiable legal uncertainty exists is a question to be answered on the basis of the facts of the individual case. For the facts underlying the referral, this has to be answered by the referring Board.

Order

For these reasons it is decided that:

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

- I. (a) The status as an opponent cannot be freely transferred.

- (b) A legal person who was a subsidiary of the opponent when the opposition was filed and who

carries on the business to which the opposed patent relates cannot acquire the status as opponent if all its shares are assigned to another company.

- II. If, when filing an appeal, there is a justifiable legal uncertainty as to how the law is to be interpreted in respect of the question of who the correct party to the proceedings is, it is legitimate that the appeal is filed in the name of the person whom the person acting considers, according to his interpretation, to be the correct party, and at the same time, as an auxiliary request, in the name of a different person who might, according to another possible interpretation, also be considered the correct party to the proceedings.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli