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**D E C I S I O N**  
**of 24 January 2002**

**Case Number:** J 0012/00 - 3.1.1

**Application Number:** 95923865.0

**Publication Number:** 0758906

**IPC:** A61K 47/48

**Language of the proceedings:** EN

**Title of invention:**

Pegylation reagents and compounds formed therewith

**Applicant:**

Kohno Tadahiko et al

**Opponent:**

-

**Headword:**

Transfer in ownership/KOHNO ET AL

**Relevant legal provisions:**

EPC Art. 71, 72  
EPC R. 20

**Keyword:**

"Transfer in ownership"  
"Lack of suitable assignment document"

**Decisions cited:**

-

**Catchword:**

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**Europäisches  
Patentamt**

**European  
Patent Office**

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des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

**Case Number:** J 0012/00 - 3.1.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 24 January 2002**

**Appellant:** Amgen Inc.  
One Amgen Centre Drive  
Thousand Oaks  
California 91320 (US)

**Representative:** Brown, John David  
FORRESTER & BOEHMERT  
Pettenkoferstrasse 20-22  
D-80336 München (DE)

**Decision under appeal:** Decision of the Legal Division of 27 September  
1999 refusing a request for recordal of a  
transfer in ownership.

**Composition of the Board:**  
**Chairman:** J.-C. Saisset  
**Members:** H. Preglau  
M. B. Günzel

## Summary of Facts and Submissions

- I. European Patent Application No.959 234 65.(originally PCT/US 95/07555,claiming the priority of US application serial No. 08/259,413) was filed in the name of the inventors T.Kohno, D.Kachensky and M.Harris. It entered the regional phase before the European Patent Office on 6 December 1996.
- II. By letter dated 26 January 1998 the registration of a transfer in ownership from the inventors to Shearwater Polymers Inc. (M.Harris) and Amgen Boulder Inc., now Amgen Inc. (T.Kohno, D.Kachensky) was requested.
- III. Whereas in the case of M.Harris and T.Kohno assignment documents relating expressly to the transfer were submitted, a similar document was not filed for D.Kachensky. It was explained that Mr.Kachensky had declined to sign such a transfer of rights.
- IV. Instead of an assignment document an "Employee Confidentiality and Inventions Agreement" was presented as proof that Mr.Kachensky's rights to the patent application were automatically transferred to the employer.
- V. The Legal Division rejected to register the transfer in ownership from D.Kachensky to Amgen Inc. It argued that the documents presented did not fulfil the requirements of Rule 20 EPC as they did not show clearly that an assignment of the co-applicant's right to the European Patent Application No 959 238 65.0 had really been carried out. The decision was dated 27 September 1999.

- VI. Against this decision the present appeal was lodged by Amgen Inc. on 3 December 1999, the appeal fee was paid the same day and the grounds of appeal were filed on 7 February 2000. Oral proceedings were requested.
- VII. The appellant argued that the documents presented showed clearly that Mr. Kachensky has recognised Amgen Inc. as owners of his patent application by virtue of an assignment signed together with his employment contract. He referred to records of the transfer in ownership in other countries where the documents submitted were found to be sufficient.
- VIII. In preparation of the oral proceedings the Board informed the appellant about its preliminary analysis of the case.
- IX. A request for postponement of the already scheduled oral proceedings was rejected by the Board because of a lack of convincing reasons.
- X. In a letter dated 18 January 2002 the appellant requested that the appeal be allowed. He further requested that independently of the outcome of the appeal the case should be sent to the Examining Division for substantive examination. At the same time he informed that due to the unavailability of the representative participation in the oral proceedings would be most unlikely.
- XI. Oral proceedings were held on 24 January 2002 in the absence of the appellant.

## Reasons for the Decision

1. The appeal is admissible.
  
2. The EPC deals with the transfer of rights under Articles 71 and 72 and Rule 20. Article 71 allows generally the transfer of a European Patent Application. According to Article 72 an assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract. The requirements for registering a transfer can be found in Rule 20 EPC.

The preconditions for registering a transfer of a European patent application are therefore the following:

- a request of an interested party (Rule 20(1) EPC),
  
  - the production of documents satisfying the European Patent Office that the transfer has taken place (Rule 20(1) EPC),
  
  - the payment of an administrative fee (Rule 20(2) EPC).
3. As far as the written request and the payment of a fee is concerned the preconditions set out under point 2 are fulfilled. It remains to be examined whether the documents presented are such as to satisfy the European Patent Office, that is to say whether they prove sufficiently that a transfer of the European patent application No 95923865.0 took place.
  
  4. The followings documents were submitted to the Legal Division:

- A Employee Confidentiality and Inventions Agreement dated 6 November 1992 and signed by D.Kachensky
- B Amgen Inc. Proprietary Information and Inventions Agreement dated 29 December 1994 and signed by D.Kachensky (page 3 and exhibit A are missing)
- C Communication of the Australian Patent Office dated 30 October 1997
- D Decision of the Australian Patent Office dated 23 October 1997
- E Statutory Declaration of Tom D.Zindrick dated 1 May 1997
- F Letter of Gowling, Strathy & Henderson to Amgen Inc. dated 4 November 1997
- G Registration Certificate No 1 486 449 of the Canadian Patent Office dated 10 June 1997
- H Assignment between T.Kohno and Amgen Boulder Inc. dated 6 December 1996
- I Registration Certificate No 1 486 450 of the Canadian Patent Office dated 10 June 1997
- J Amgen Proprietary Information and Inventions Agreement (like Document B but completed with page 3 and exhibit A)
- K Employee Confidentiality and Inventions Agreement (identical with Document A)

- M Assignment between M.Harris and Shearwater Polymers Inc. signed by M.Harris and dated 4 December 1996
- N Letter of Gowling, Strathy & Henderson to Amgen Inc., referring to Canadian patent application 2,191,971
- O Filing Certificate No 2,191.971 of the Canadian Patent Office
- P Letter of Gowlings, Strathy & Henderson to the Canadian Patent Office concerning a request for transfer in ownership dated 28 February 1997
- Q Letter of S.B.G. & K.Patent and Law Offices to Amgen Inc. dated 27 April 1998
- R Document in Hungarian dated 1 April 1998 mentioning PCT/US 95/07555

Together with the statement of grounds of appeal additional documents were provided:

- S First and last page of Employee Confidentiality and Inventions Agreement (these pages being identical with the respective pages of Document A)
- T Notice of Recordal of Assignment Document concerning US Application Serial No 08/482,284, filing date 6 July 1995 from USPTO dated 26 July 1996 with three attached assignment documents signed by T.Kohno, D.Kachensky and M.Harris.

5. Document A, point 3(b) only states in a general way the

obligation to assign and agree to assign all rights to inventions to the Company. There is no specification of which application or applications are concerned.

6. Document B (in the complete version as Document J) contains a similar wording under point 4(a) and (c) which also does not specify any application. Under both agreements the employee is obliged to do or to permit something in connection with inventions made by him. However, they both only create the obligation to act in a specific way eg. to assign rights to the Company which rest originally with the inventor but they do not constitute the assignment itself.

Under point 4(a) of Document B/J reference is made to the California Labor Code where in section 2870 exceptions to the obligation to assign inventions to the employer are mentioned. The distinction between "free inventions" and those being paid for or at least carried out with the help of an employer's equipment shows clearly that an explicit assignment of an invention to the employer is necessary, as there is no general obligation to transfer all possible inventions of an employee to the enterprise.

7. Concerning these two above- mentioned documents the Board finds that they are both not equivalent to an assignment document.

With only these documents at hand it is impossible to know whether an invention disclosed in a patent application is a free one or one subject to the obligation to be assigned to the employer. These documents are only therefore a basis for further assignments. Any other interpretation would make the



obligation provided for under point 5 of Document B to make assignments on request of the Company superfluous. The same comment applies to the clause which can be found under point 3(c) of Document A.

8. Documents C to R concern registrations in different countries on the basis of documents other than assignment documents. As a matter of completeness the Board will comment upon the documents submitted by the appellant but wants to underline that the specific legal provisions of the EPC define what is required for the registration of a transfer of rights before the European Patent Office and therefore it cannot help to show what might or might not be sufficient for another patent office in case of transfer of rights. It is the European Patent Office which has to examine the documents produced by the party in the proceedings before the European Patent Office to prove the effective assignment of a right. And it is only this Office which has to be satisfied by what has been presented to it.
  
9. Documents C and D refer to a "request to record change of name" before the Australian Industrial Property Organization. Document E is a statutory declaration of a senior corporate counsel of Amgen Inc. who declares that based on the contract of employment, Amgen Boulder Inc (the predecessor company of Amgen Inc.) was at all times the rightful owner of the invention where the inventor Dave Kachensky was concerned and which is described in the priority document 08/259 413, the PCT application PCT/US 95/07555 and the Australian Patent No. 28286/95. It was at all times intended that the application should proceed into Australian national phase in the name of Shearwater Polymers Inc. and Amgen

Boulder Inc.

10. Documents F to P concern assignments of applications before the Canadian Patent Office. In Doc.P reference is made to Section 31 of the Canadian Patent Act. Section 31 deals with joint applications. The paragraphs related to the basic situation of the present case read as follows:

"31.(1) Effect of refusal of a joint inventor to proceed.- Where an invention is made by two or more inventors and one of them refuses to make application for a patent ....,the other inventors or their legal representatives may make application, and a patent may be granted in the name of the inventors who make the application, on satisfying the Commissioner that the joint inventor has refused to make application .....

(2) Powers of Commissioner.-In any case where

(a) an applicant has agreed in writing to assign a patent, when granted, to another person or to a joint applicant and refuses to proceed with the application, or

(b).....

the Commissioner, on proof of the agreement to his satisfaction, or if satisfied that one or more of the joint applicants ought to be allowed to proceed alone, may allow that other person or joint applicant to proceed with the application, and may grant a patent to him in such manner that all persons interested are

entitled to be heard before the Commissioner after such notice as he may deem requisite and sufficient.

(3).....

The Canadian Patent Act contains an explicit provision which allows to accept a change in ownership even in cases where no assignment document as such is provided. A comparable provision cannot be found in the EPC. The EPC requires in Rule 20(1) the proof that the transfer has taken place. It is clear from the comparison of these two provisions that the legal situation under the Canadian Patent Act is completely different from the one under EPC.

- 11. Documents Q and R refer to proceedings before the Hungarian Patent Office. They are also of no relevance for the present case ( see comments under point 8)
- 12. Documents S and T were provided with the statement of grounds. Document S is identical with Document A which was already on file before the Legal Division.

As can be seen from Document T the USPTO has accepted the registration of the transfer of US application serial No. 08/482,284 filed 7 June 1995 on the basis of an assignment duly signed by all three applicants. The document contains the autorisation and request of all three applicants and thus also for Mr.Kachensky to the Commissioner of Patents and Trademarks of the United States to grant the patent to Amgen Inc. As it is a duly signed assignment document it does not support the appellants argument that a transfer of the present application from Mr.Kachensky to the appellant should be recognised even in the absence of an assignment by

Mr Kachensky.

Because of the different serial no it is also not suitable as proof of transfer of the European patent application based upon the US application serial No. 08/259,413 filed 14 June 1994, even if there might be a certain relationship between the two as to the subject matter of both US applications.

13. Under the given circumstances it was not relevant that Documents A and B were only signed by Mr Kachensky and not also by his respective contracting partners.
14. None of the presented documents was of such a kind as to convince the Board that a transfer has taken place. Document A and B might contain an obligation to sign an assignment later on but cannot be interpreted as the assignment itself. The appellant has failed to produce documents satisfying the European Patent Office that the transfer has been effected.
15. As far as the request for continuation of the examination proceedings is concerned the Board is not competent to decide on the request, as it does not concern the subject matter of the present appeal.

## **Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset