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**Datasheet for the decision  
of 15 June 2015**

**Case Number:** J 0016/14 - 3.1.01

**Application Number:** 06013136.4

**Publication Number:** 1830287

**IPC:** G06F17/50

**Language of the proceedings:** EN

**Title of invention:**

Method for planning sheet pile wall section

**Applicant:**

PilePro LLC

**Headword:**

Transfer and reversal of transfer of entries in the European Patent Register, requirements in respect of evidence of succession in title, stay of grant and opposition proceedings, payment of appeal fee where several applications and patents are affected, referral to the Enlarged Board of Appeal (no)

**Relevant legal provisions:**

EPC Art. 60(1), 60(3), 61, 108  
EPC R. 22, 14, 78, 85, 99

**Keyword:**

Transfer and reversal of transfer of entries in the European Patent Register, stay of proceedings

**Decisions cited:**

G 0001/09, G 0003/92, J 0028/94, T 0553/90

**Headnote:**

When a title to a European patent or patent application has been transferred and the European Patent Register has been amended to reflect this, it is not justified, if doubt later arises as to sufficient proof of succession in title, to undo the registration of the transfer. Nevertheless a request, (by the party having been registered before), for staying the grant and/or the opposition proceedings could be taken into consideration.



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Case Number: J 0016/14 - 3.1.01

**D E C I S I O N  
of the Legal Board of Appeal 3.1.01  
of 15 June 2015**

**Appellant:** Contexo AG  
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Representative:  
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**Respondent  
(Applicant):** PilePro LLC  
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Representative:  
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**Decision under appeal:** **Decision of the Legal Division of the European  
Patent Office dated 28 April 2014**

**Composition of the Board:**

**Chairwoman** C. Vallet  
**Members:** D. Prietzel-Funk  
D. Rogers

## Summary of Facts and Submissions

- I. The present appeal concerns the Legal Division's decision of 28 April 2014 to refuse the appellant's request for reinstatement in the European Patent Register as applicant for and proprietor of the following patent applications and granted patents (hereinafter "the applications and patents in question"):

European patent applications with the application numbers

05 002 204.5 (appeal case J 22/14)  
06 013 136.4 (the present appeal case J 16/14)  
06 762 753.9 (appeal case J 21/14)  
06 762 754.7 (appeal case J 20/14)  
08 008 210.0 (appeal case J 17/14)

European patents

EP 1 907 634 (appeal case J 18/14)  
EP 1 698 733 (appeal case J 19/14)

- II. The relevant facts of the case are as follows:

The respondent (PilePro LLC) was originally entered in the European Patent Register as the applicant for the five European patent applications and as the proprietor of the two European patents mentioned above. In each case, the European patent attorney named in the Register was Mr Weigel. By letter of 23 June 2010 (22 June 2010 for EP 1 698 733), Mr Weigel, citing his authority to represent both the existing applicant/proprietor and the future applicant/proprietor of the applications and patents in question (the latter being Contexo AG, the appellant in the present case), requested the EPO to transfer the relevant Register

entries to the appellant and, as evidence of the transfer of rights, submitted extracts from an assignment agreement dated 25 March 2010 signed by Mr Richard Heindl for the assignor and by Mr Enrico Farroni as chairman of the assignee's board of directors. Proof of Mr Heindl's authorisation to represent the respondent was supplied in the form of a letter dated 27 October 2003 to Mr Heindl in which Mr Roberto Redondo Wendt as "President" of the respondent confirmed that Mr Heindl was "named and recognized as the CEO of PilePro LLC".

- III. The Register entries in question were transferred to the appellant as requested.
  
- IV. The respondent challenged this in a letter received by the EPO on 19 August 2011, in which he sought reversal of the transfer or, alternatively, the stay of proceedings until the definitive closure of the pending civil proceedings concerning the applications and patents in question before the Cantonal Court of Zug (Switzerland). The respondent maintained that Mr Weigel had not been authorised to represent him in connection with the transfers. The respondent also objected that only extracts of the assignment agreement had been submitted to the Transcription Service of the EPO (Umschreibstelle, now CDR), and therefore the transfer should not have been made. Furthermore, the assignment agreement was invalid because Mr Richard Heindl was not the authorised sole signatory thereof. Under general principles of law, the EPO was obliged to revoke unlawful administrative acts - the transfers in this case. At any rate all pending proceedings before the EPO should be stayed in the light of an interim injunction issued by the Swiss Cantonal Court of Zug on 1 September 2010 prohibiting the present appellant from

taking decisions concerning the applications and patents in question that were detrimental to the present respondent, together with a warning of enforcement. The corresponding main action had been brought before the Swiss Cantonal Court within the appropriate time limit.

- V. Without hearing the appellant, the Legal Division thereupon ordered the reversal of the transfers and the reinstatement of the respondent as the applicant/ proprietor in the Register in all seven cases.
- VI. This was challenged by the appellant, who requested an appealable decision on the matter. It objected to the infringement of its right to be heard and to the reverse transfer to the respondent on various grounds. In the proceedings, it requested its reinstatement in the European Patent Register and, alternatively, the stay of all pending proceedings in connection with the applications and patents in question, refusal to transfer those applications and patents to a third party and the right to participate in the ongoing opposition proceedings against the patents in question, along with an opinion from the President of the EPO. The respondent in turn upheld the reverse transfer and requested in the alternative the stay of the proceedings before the EPO until the definitive closure of the civil proceedings concerning the applications and patents in question before the Cantonal Court of Zug.
- VII. On 28 April 2014, the Legal Division in a single decision in respect of all seven applications and patents in question refused the appellant's request for reinstatement in the Register, together with all of his alternative requests. The main reason it gave was that

the recording of a transfer in the European Patent Register under Rule 22 EPC was a purely formal procedure. The material entitlement to the transferred rights was not a matter for the EPO to examine in the transfer procedure. Where the lawfulness of a transfer was subsequently called into question, the Office was obliged to correct the Register by restoring the original status until the matter was definitively resolved by the relevant national court. This was why the original applicant and proprietor had duly been reinstated. The reversal of a transfer was not an inter-partes procedure, which was why the successor in title did not have to be heard in advance. Since a national court decision ruling that material entitlement lay with the appellant had not been submitted, the appellant's alternative requests for stay of the pending examination and opposition proceedings before the EPO were also unfounded.

VIII. The appellant challenged this decision in the form of a single letter of appeal in respect of which he paid a single appeal fee. In the notice of appeal, the header refers, in addition to the seven applications and patents in question, to another European patent application - number 07023977.7. The appellant's main ground for appeal was the lack of opportunity to comment on the respondent's requests prior to the reverse transfer, seeing this as an infringement of his right to be heard. He also argued that a transfer to a successor in title should not simply be reversed in the Register because that impinged unlawfully on the legal status of the successor in title. He also maintained that all proceedings (criminal, private prosecution and civil) brought by the respondent against him to date in Switzerland relating to the allegedly invalid assignment agreement had been unsuccessful. Most

recently, the Cantonal Court of Zug had dismissed as without merit the respondent's (main) action against the appellant in case A3 2010 108, concerning transfer of the applications and patents in question, in a judgment of 28 May 2015 because it was deemed proven that "the defendant is the lawful proprietor of the patents at issue" (point 8 of the considerations).

- IX. At the oral proceedings before the board, the appellant withdrew all the original requests in connection with patent application EP 07 239 77.7 (EP 1 939 359) along with the request made shortly before the oral proceedings for postponement thereof.

Finally, it requested that the impugned decision be set aside and that Contexo AG be reinstated as proprietor for all patents and patent applications cited in the decision. Alternatively, it requested the stay of all proceedings, the stay of the opposition proceedings, refusal to make further transfers, the summoning of witnesses and the referral of a range of questions to the Enlarged Board of Appeal, mainly concerning the granting of the right to be heard in connection with the reverse transfers in the Register and the protection of justified reliance on existing entries therein.

- X. The respondent's final requests were as follows:

"1. That the appeal be dismissed.

Failing that:

2. That all proceedings be stayed pending a final decision from the relevant national court.



3. That the following legal questions be referred to the Enlarged Board of Appeal under Article 112 EPC, since a point of law of fundamental importance is at issue:

(a) Is the payment of only one appeal fee under Article 108 EPC sufficient for more than one appeal to be deemed filed if in the impugned decision several cases have been joined for simplicity's sake and the board of appeal has duly assigned each case a separate number?

(b) Where the status of an entry in the European Patent Register is in dispute between the parties to appeal proceedings, may the board of appeal change that status or cause it to be changed through its decision without waiting for a final decision to be taken by the competent national court before which proceedings between those same parties are pending?"

XI. The respondent's main arguments were as follows:

The appeal was inadmissible. Only one appeal fee had been paid although the impugned decision related to seven different applications and patents. Mr Weigel did not have power of attorney in respect of the notice of appeal signed by him because the appellant had already given Mr Jäger, a lawyer, that power for the proceedings relating to the applications and patents. Nor had any "clear statement of grounds" been submitted. The statement of grounds filed by fax on 8 September 2013, the last day of the period for filing it, was not the same as the original document filed after expiry of the period on 25 September 2013. This meant that Dr Farroni, who had signed the statement of grounds, had not been entitled to represent the appellant either. On the merits, the respondent defended the soundness of the impugned decision. The

appellant had not submitted the final decision of a competent national court ruling that he was materially entitled to the rights in question. The Register status was therefore correct, and the appellant's requests for stay of proceedings and further alternative requests were not to be granted either.

- XII. Regarding his own alternative request for stay of all the proceedings pending before the EPO, the respondent said that in the alternative this request should, in view of the interim injunction issued in his favour by the Swiss Cantonal Court of Zug, be allowed until that court had issued a final decision on the merits in the pending proceedings.

## **Reasons for the Decision**

### Appellant's main request

1. The appeal is admissible. Contrary to the respondent's view, the requirements in this regard under Rule 99 EPC are met.

- 1.1 As regards the payment of only one appeal fee, the following applies:

In the impugned decision, the Legal Division ruled on a single issue relating to all applications and patents in question, and concerning their reverse transfer from the appellant to the respondent in the European Patent Register. The original transfer from the respondent to the appellant was based on the assignment agreement dated 25 March 2010 between the parties on all the applications and patents in question. Throughout the proceedings before the Legal Division, both the parties

themselves and the Legal Division conducted a uniform procedure specifically relating to all the applications and patents in question, and the impugned decision logically relates to them all. That is why only one appeal fee is payable for the appeal against the impugned decision and not, as the respondent maintains, seven such fees. This is not altered by the fact that each application and patent covered by the appeal was assigned its own reference number. This was purely for data organisation purposes within the boards' electronic file system and not something ordered by the boards. According to information requested by the board from the IT department, the electronic file system automatically opens an individual electronic appeal file for each patent application and patent affected by an appeal, assigning an individual file number to each. This purely technical step has no bearing on the legal position. However, once taken, this step cannot be reversed, and to complete the process the board is obliged to draft a decision in respect of each file number. Moreover, in the interests of consistency and comprehensibility, the decision wording has to be adapted to each individual file.

- 1.2 The board regards as illogical the respondent's assumption that Mr Weigel did not have power of attorney for the notice of appeal he signed on 7 July 2014. The appellant's power of attorney dated 22 November 2013 in respect of Mr Jäger, having the same office address as Mr Weigel, was, as evidenced by its content, not an exclusive power of attorney; moreover, sub-authorisation was permitted. In this context, the assumption that Mr Weigel was not authorised to file the appeal at the time he did, despite his stating in the notice of appeal that he was acting on the appellant's behalf, is unconvincing.

- 1.3 Nor are reasonable doubts about the admissibility of the appeal justified by the respondent's submission that the faxed statement of grounds did not tally with the statement of grounds filed in writing after expiry of the time limit. Statements of grounds may be filed by fax with the EPO. A letter of confirmation is not usually required. Both parties accept that the EPO received the faxed statement of grounds in question before expiry of the time limit and thus in due time. Nor has the respondent raised any serious doubts worthy of investigation by the board about the authorship of the extra statement of grounds submitted in writing, referring solely to differences in appearance such as a stamp stating "Copy Made" on the fax only and a slight variation in Dr Farroni's signature. As such, this does not call into question the authenticity of the faxed statement of grounds. In particular, no changes to the actual wording were indicated or are otherwise apparent.
- 1.4 The respondent's complaint that the statement of grounds was signed by Dr Farroni in the capacity of mere board member and not as "chairman of the board of directors", which was why the power of signature was being called into question, is also unsuccessful. Under the Swiss federal law on the representation of Swiss public companies that supplements the Swiss Civil Code (Part five: Code of Obligations (BO)), a Swiss public company is represented by its board of directors (Article 718 BO). It is common ground that Dr Farroni was a member of the board.
2. The appeal proceedings relate to the question of whether the current Register status is correct.

2.1 The transfer procedure described in Rule 22 EPC is the basis for legally assessing whether the initial transfer to the appellant as the respondent's successor in title was wrong and the ordering of the respondent's reinstatement was right.

Under Rule 22(1) EPC, the transfer of a European patent application is recorded in the European Patent Register at a party's request if documents are produced as evidence of the transfer. Under Rule 85 EPC, Rule 22 EPC also applies to granted patents.

2.2 The parties disagree on whether the Legal Division set unduly low criteria for evidence of transfer of rights as well as on whether the transfer to the appellant as successor in title can be reversed merely at the request of the originally recorded respondent.

2.2.1 Regarding the first point, it is noted that the EPO's Transcription Service examined the appellant's request for transfer dated 23 June 2010 on the basis of the documents submitted by him and went on to make the transfers as requested.

2.2.2 The respondent's objections in this regard do not withstand scrutiny. Although the parties agree that the Transcription Service did not have all of the pages of the assignment agreement at its disposal, it was able on the basis of submitted pages 1, 4, 10 and 22 to regard the claimed succession in title as duly proven. These pages designated the parties to the agreement and clearly stated that the applications and patents in question were the subject of the agreement, and the subject of section 2 of the agreement (page 4) was, the parties agree, the unrestricted transfer of those rights. Contrary to the respondent's view, the

submission of extracts in the form of the pages concerning transfer of rights is not unusual and is commonly attributable to the fact that, in the interests of the parties, not all details of such an agreement, which may be broader in scope, should be disclosed. This in its own right is no basis for questioning the conclusive proof of succession of title under Rule 22 EPC.

Nor did the respondent cite any particular passage of the full wording of the assignment agreement which would have called into question, even objectively, the assumption of transfer of rights and consequently the succession in title at the time of transfer and, by extension, the lawfulness of the transfer made.

The assignment agreement also bore the formally required signatures of the parties to it, those being, for the assigning respondent, that of Mr Richard Heindl as its CEO and, for the appellant, that of Dr Farroni as the chairman of the appellant's board of directors.

Regarding sufficient proof of Mr Heindl's capacity as CEO, the Transcription Service was in possession of a letter of confirmation from PilePro issued in 2003.

The respondent argued, in particular before the Legal Division, that Mr Weigel, contrary to what he claimed, had no "power of attorney" to represent the respondent in transfer proceedings, but this argument does not hold water with regard to the transfer because Mr Weigel was the patent attorney named in the European Patent Register as the respondent's European representative at the time. This sufficed for the transfer. The question of whether and to what extent Mr Weigel actually had the right to represent the

respondent with regard to the transfer is a substantive issue that is not to be addressed in the formal procedure before the EPO.

The requirements for transferring the applications and patents in question to the appellant had therefore been met; in particular the transfer of rights had been adequately proven. The transfer to the appellant on 24 June 2010 was therefore correct and lawful.

2.3 Regarding the second point, the question of reversal of the transfer, the Legal Division held in the impugned decision that where the lawfulness of a transfer was subsequently challenged, the Office was obliged to correct the Register by restoring the original status until the matter was definitively resolved by the relevant national court. Further, in the light of the respondent's allegation of substantive flaws, i.e. that Mr Richard Heindl was not authorised to conclude the assignment agreement, the proof that the appellant was the successor in title was no longer deemed to have been submitted, and the transfer was therefore reversed.

2.3.1 This cannot be endorsed. If an application or patent in the European Patent Register is transferred to a successor in title, he acquires the legal status of his predecessor as applicant or proprietor. Under the legal fiction of Article 60(3) EPC, the applicant is the (formally entitled) proprietor of the right to the European patent; the EPO does not check this entitlement and it cannot be contested in grant or opposition proceedings (decision of Technical Board of Appeal 3.2.03 dated 15 June 1992 - T 553/90, point 2.3). Furthermore, the Enlarged Board of Appeal has decided that the subject of a patent application is an

object of property that confers on its proprietor both provisional protection under Article 64 EPC and procedural rights on the basis of Article 60(3) EPC (G 1/09 of 27 September 2010, point 3.2.1). This de jure and de facto favourable position could only be subsequently withdrawn from the applicant on the basis of a legal provision. However, no such basis is apparent here.

2.3.2 To the extent that "correction" of the Register entry is mentioned in the impugned decision, Rule 140 EPC, which concerns the correction of errors in decisions, clearly does not apply. Under said rule, only the correction of errors of transcription, linguistic errors and obvious mistakes is permitted, and these are not at issue in the present case. On this point the respondent has indeed asserted, in view of the obviousness required under Rule 140 EPC for the "error" that he alleges, that the absence of some pages from the assignment agreement was obvious and that, as a result, the Transcription Service should have been particularly careful given the number of applications and patents in question and carried out further investigations. The board does not agree with this, however, because it was not an "error" at all, as shown in point 2.2 above, and certainly not an obvious error in a decision within the meaning of Rule 140 EPC.

2.3.3 The respondent has also argued that, according to general principles of law equally applicable in all contracting states, an unlawful administrative act can be reversed. Bearing in mind the principle of the rule of law and the principle of legal certainty enshrined therein, it is doubtful whether the cited principle of law actually applies to this boundless extent and whether the substantive incorrectness of the first



transfer can constitute the sole ground for reversing the transfer. But, in the final analysis, this question can be left unanswered because even if the recording of a transfer in the Register constituted an administrative act - and this itself is an open question - it would not have been unlawful, as shown above.

2.4 Contrary to the opinion of the Legal Division, once executed, a transfer can no longer be reversed, even if doubt later arises as to sufficient proof of succession in title. Once the application has been transferred to him, the successor in title, as evidenced by the Register, is formally authorised and has all the rights that this confers. As previously stated, this favourable legal position cannot subsequently be simply withdrawn from the person recorded in the Register.

2.5 To the extent that the parties also argued extensively about the material entitlement to the applications and entries in question, the Legal Division rightly pointed out that, under the European patent system, assessment of this issue was exclusively a matter for the national courts (see also decision of the Enlarged Board of Appeal, G 3/92, OJ EPO 1994, 607, point 3).

2.6 It follows from all this that the appeal against reversal of the transfer is well-founded.

3. Respondent's auxiliary request for staying the proceedings pending before the EPO regarding the applications and patents

3.1 Under Rule 14 EPC, grant proceedings are stayed if a third party proves that he has instituted proceedings against the applicant seeking a decision within the

meaning of Article 61(1) EPC, i.e. a decision by which the entitlement to the grant of the European patent is conferred on a person other than the registered applicant. On this point, the respondent submitted that he had obtained an interim injunction against the appellant and had brought proceedings on the main issue before the Swiss Cantonal Court of Zug with the aim of getting the applications and patents in question transferred back under his name and having a warning of enforcement issued. There is agreement that a final decision has not yet been issued on this action.

- 3.2 The subject-matter of the action before the Swiss civil court is that the defendant (Contexo AG), according to the plaintiff (PilePro LLC), wrongly acquired the right to the patent applications and thereby - after recording in the Register - the respective (fictitious) right to the grant of the patent as purported successor in title because the underlying assignment agreement was invalid. In effect the claim being made is that the right to the European patent and to the property rights in the patent rest with the plaintiff, the respondent in the present case.

Since the EPC rules on stay of proceedings aim to protect the genuinely entitled party and to secure his legal position (decision of 4 October 1996 - J 28/94), the board considers it appropriate to apply Rule 14 EPC. Until such time as the Register is amended again on the basis of substantive law, the respondent is to be protected from adverse actions on the part of the formally authorised person recorded in the Register.

Under Rule 14 EPC (and Rule 78 EPC regarding the registered patent proprietor during opposition proceedings), and according to the general rules on

burden of proof, the burden of presentation and proof towards the EPO rests with the person claiming entitlement with reference to corresponding national proceedings, hence the respondent and not, as clearly assumed in the remarks made in the impugned decision, the appellant. The respondent has submitted sufficient documentation in that respect, and therefore the alternative request for stay of proceedings is well-founded.

4. Respondent's auxiliary request for referral of questions to the Enlarged Board of Appeal under Article 112 EPC

4.1 The respondent has requested referral under Article 112 EPC concerning the payment of only one appeal fee in cases in which "in the impugned decision several cases have been joined for simplicity's sake and the board of appeal has duly assigned each case a separate number", but this question is not of fundamental importance within the meaning of Article 112(1) EPC. It would appear that the issue here was an isolated one, attributable to the boards' electronic file system - a system still under development - and its particular technical parameters as mentioned above under point 1.1.

4.2 The other request for referral to the Enlarged Board of Appeal, on whether a board is entitled to change a disputed entry in the European Patent Register or to cause it to be changed through its decision without waiting for a final decision to be taken by the competent national court before which proceedings between the same parties are pending, is redundant. The present decision does not prejudice a decision by the Swiss Cantonal Court of Zug as the present case

concerns rectifying the incorrect reversal of a transfer, whereas the court will be deciding on the substantive legal position.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to enter the appellant in the European Patent Register as proprietor of European patent application No. 06 013 136.4.
3. The grant procedure for European patent application No. 06 013 136.4 is to be stayed until the decision of the 3rd Division of the Cantonal Court of Zug, in the case with the file number A3 2010 106, has become final.

The Registrar:

The Chairwoman:



C. Eickhoff

C. Vallet

Decision electronically authenticated