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**Datasheet for the decision
of 1 February 2021**

Case Number: J 0012/19 - 3.1.01

Application Number: 10719228.8

Publication Number: 2393977

IPC: D06M16/00, D06M23/08,
D06M23/12, A01N63/00

Language of the proceedings: EN

Title of invention:

TEXTILE WITH BIOCONTROLLING PROPERTIES

Patent Proprietor:

Transito NV

Opponent:

Chrisal NV

Headword:

Relevant legal provisions:

EPC Art. 106(1), 111(1)

EPC R. 142

RPBA 2020 Art. 11

Keyword:

A "communication" constituting a "decision" under Article
106(1) EPC (yes)

Opponent party to resumption proceedings under Rule 142(2) EPC
(yes)

Decisions cited:

T 0552/02, T 1561/05, T 0683/14

Catchword:



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Case Number: J 0012/19 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 1 February 2021

Appellant: Chrisal NV
(Opponent) Priester Daensstraat 9
3920 Lommel (BE)

Representative: IPLodge bv
Technologielaan 9
3001 Heverlee (BE)

Respondent: Transito NV
(Patent Proprietor) Vestingstraat 38 bus 3
2018 Antwerpen (BE)

Decision under appeal: "Communication from the Legal Division" of the
European Patent Office posted on 15 March 2019
denying the opponent party status in
"proceedings pursuant to Rule 142 EPC"

Composition of the Board:

Chairman W. Sekretaruk
Members: B. Müller
A. Jimenez

Summary of Facts and Submissions

I. The opponent's appeal filed on 21 March 2019 is directed against the document entitled "Communication from the Legal Division" of 15 March 2019 "to deny the Opponent (present Appellant) party status in the proceedings pursuant to Rule 142 and its resulting refusal to consider the observations and requests submitted by the Opponent on 5 February 2019..." (see notice of appeal, page 1). This is the text of the document:

Reference is made to your letter of 05.02.2019 received on the same date at the EPO. The Legal Division informs you [i.e. the appellant] as follows:

Please note that **you are not party to the proceedings pursuant to Rule 142 EPC**. As a third party to these proceedings, you may file neither observations nor any procedural requests.

Opposition proceedings relating to the European patent No. 2 393 977 **will be resumed on 01.04.2019**. The opposition division as the competent organ will decide on the further conduct of said opposition proceedings.

(Emphasis added.)

The appellant requested that the Board "set aside the Legal Division's denial of the Opponent's party status, its refusal to consider the observations and requests submitted by the Opponent on 5 February 2019, and the resulting implicit confirmation of the announced resumption of the opposition proceedings with Transito NV as the proprietor of the patent under opposition".

II. The following indents summarise the sequence of events preceding the appeal filed on 21 March 2019.

- In a letter of 10 February 2017 the opponent wrote to the EPO that the proprietor of the opposed patent, Transito NV, had been declared bankrupt on 31 January 2017 by the "Court of Commerce [*"handelsrechtbank"*] of Antwerp, Belgium". A respective extract from the Belgian Official Gazette ("*Belgisch Staatsblad*") was attached wherein, under the heading "*Rechtbank van koophandel Antwerpen, afdeling Antwerpen*" (Commercial Court of Antwerp, Division Antwerp), *inter alia*, the appointment of an administrator ("*curator*") of the insolvent company was mentioned.

- In a "communication" of 21 February 2017 addressed to the administrator of Transito NV the Legal Division stated that the opposition proceedings before the EPO had been interrupted as from 31 January 2017 owing to bankruptcy proceedings against the proprietor Transito NV, on the basis of Rule 142(1)(b) EPC. A copy of the "communication" was sent to the opponent.

- With a letter of 16 October 2018 the opponent informed the EPO that the Commercial Court of Antwerp, Division Antwerp, had terminated the bankruptcy proceedings for Transito NV, the registered proprietor of the patent under opposition, thus bringing an end to the existence of the legal entity Transito NV. A corresponding page of the Belgian Official Gazette dated 15 October 2018 was attached where the notice of the closure of the bankruptcy proceedings was published.

- In a "communication" of 11 January 2019 to Transito NV the Legal Division stated:
According to the submitted evidence the European Patent Office has been informed that Transito NV... is the person authorised to continue proceedings before the EPO. Therefore, pursuant to Rule 142(2) EPC, the Legal Division of the EPO herewith communicates that

proceedings will be **resumed** with the registered applicant **on 1 April 2019**. (See point 2.)

Should you have any objections to these findings of the Legal Division, you are invited to file your comments within two months from the date of notification of this communication. (See point 4.)

(Emphasis added.)

A copy of the communication was sent to the opponent.

- In response to that communication the opponent, on 5 February 2019, formally objected to a resumption of the proceedings with Transito NV acting as the proprietor of the patent under opposition. The summary proceedings before the Commercial Court to end the bankruptcy proceedings for Transito NV had brought an end to the legal existence of the latter. As the opponent still had an interest in the revocation of the patent, the opponent requested, as a main request, that the opposition proceedings be resumed with the opponent as the sole party, and that the patent be revoked in its entirety on the grounds previously brought forward. The appellant requested a separately appealable decision (Article 106(2) EPC) and oral proceedings if the Legal Division refused the main request.

III. The impugned "communication" of 15 March 2019 (see point I above) was issued in response to the opponent's letter of 5 February 2019.

IV. In a consultation by telephone of 5 April 2019 a formalities officer informed the appellant's representative that the notice of appeal filed during the interruption of the proceedings had no legal validity. The appellant was also informed that the patent had lapsed in all designated Contracting States

and that, consequently, a communication pursuant to Rule 84 EPC "had been" issued (see point VIII below).

With a letter of 9 April 2019 the appellant formally confirmed the notice of appeal filed on 21 March 2019, without however considering this to be necessary. In its view the responsibilities of the Legal Division in respect of the interruption and resumption of the opposition proceedings continued to exist without interruption. An appeal directed specifically at a decision falling under the responsibilities of the Legal Division could not be denied legal effect for the sole reason that it had been filed during the period of interruption of the opposition proceedings. The appellant had to file the notice of appeal during the period of interruption to ensure that the resumption of the opposition proceedings would be suspended as a consequence of the suspensive effect of the appeal (Article 106(1) EPC).

- V. In the statement of grounds of appeal of 3 May 2019 the appellant explained that the main purpose of the appeal was to keep the EPO from proceeding with the opposition proceedings against the patent in issue on the basis of an incorrect assessment of the legal status of its proprietor of record, Transito NV, after its bankruptcy (grounds, page 1).

As to the admissibility of the appeal, the appellant argued that the document of 15 March 2019 labelled "communication" summarily dismissed the requests made in the opponent's letter of 5 February 2019 on the grounds that the opponent was "not a party to the proceedings pursuant to Rule 142 EPC". The Legal Division had thus implicitly rendered a decision on the admissibility of the opponent's requests.

Although the opponent was not recognized as a party in the impugned decision, this should not affect the admissibility of the present appeal, since the denial of party status was the subject of the appeal. Otherwise, there would be no legal remedy against an incorrect denial of the party status by a first-instance department. The appellant was adversely affected by the Legal Division's refusal to hear its observations or decide on its requests, as this violated its right to be heard.

In respect of the substance of the appeal, the appellant discussed "Procedural Violations in the First-Instance" (title point IV), the "Incorrect Assessment of Proprietor's Situation" (title point V), "The proprietary situation of European patent no. 2393977" (title point VI) and the "Consequences for the Opposition Proceedings" (title point VII).

The appellant grouped the asserted procedural violations (point IV) as follows:

- A. Right to be heard
 - 1. *Incorrect assessment of party status*
 - 2. *Breach of legitimate expectations*
 - 3. *Breach of procedural safeguards*
- B. No reasoning given (violation of Rule 111(2) EPC)
- C. Breach of the principle of "Equality of Arms"

Below the Board sets out the main submissions made under these headings.

A.1. Incorrect assessment of party status

As to the asserted incorrect assessment of the appellant's party status, the appellant referred to

proceedings relating to requests for re-establishment of rights. An opponent was automatically party to those proceedings if the request was filed by the proprietor during opposition proceedings (citing Guidelines for Examination in the European Patent Office, E-VIII, 3.1.2, which was based on case law of the boards of appeal, i.e. T 1561/05 and T 552/02). The mere fact that, in cases pertaining to interruption and resumption of proceedings under Rule 142 EPC, a different department, i.e. the Legal Division, took the decisions did not justify departing from the principles of T 1561/05 and T 552/02 in the case of an intended resumption of proceedings after an interruption due to bankruptcy. As in the case of re-establishment proceedings, the outcome of interruption/resumption proceedings was of the utmost importance to the opponent, as the decision on the resumption of opposition proceedings had an impact on whether and when the opponent could obtain revocation of the opposed patent. An incorrect decision, as in the case under appeal, could lead to unnecessary and costly oral proceedings while depriving the opponent of the opportunity to request and enforce an apportionment of costs.

Furthermore, there was a distinction between registrations of transfers (a core competence of the Legal Division under Article 20 EPC) and matters of interruption and resumption of proceedings (an additional duty of the Legal Division). While it could be argued that an opponent had no business commenting on proceedings before the Legal Division concerning the registration of a transfer of the patent under opposition, because the opponent was not privy to the transaction between the proprietor and its successor-in-title, the same could not be said for a decision

concerning the existence or non-existence of the proprietor, because the existence of legal persons had an *erga omnes* effect.

Moreover, in this particular case, denying the opponent party status would have the absurd result that the Legal Division would actually be conducting proceedings without any party, as a non-existent proprietor of record clearly could not be or remain a party either. This would then mean that the Legal Division could take any decision it liked regarding the resumption of the proceedings without challenge, since no-one would have any legal remedy against such a decision, thus completely frustrating the provisions of Article 106(1) EPC.

2. Breach of legitimate expectations

The record showed that the opponent had made good-faith efforts to keep the EPO apprised of the fate of the proprietor of record, which the officers of Transito NV failed to do (the appellant referred to its letters dated 10 February 2017 and 16 October 2018). A member of the Legal Division even contacted the representative of his own volition in a telephone call dated 25 October 2018 to solicit views on the then legal status of the patent under opposition in view of the closure of the bankruptcy proceedings.

The telephone call from the Legal Division clearly gave the representative the impression that (i) their opinion was valued by the Legal Division and (ii) the opponent was being consulted as a party to the proceedings.

In view of the earlier correspondence and the telephone contact with the Legal Division, the opponent had every reason to expect that its views on the matter would be welcomed by the Legal Division. Hence denying the opponent the right to file observations and requests violated the opponent's legitimate expectations.

3. Breach of procedural safeguards

By denying the opponent party status, the Legal Division had also denied the opponent the procedural safeguards that came with party status, including the right to present comments on the grounds of an (intended) decision (Article 113(1) EPC) and the right to state one's case in oral proceedings (Article 116(1) EPC).

B. No reasoning given (violation of Rule 111(2) EPC)

The impugned decision refused to deal with the observations and requests of the opponent, on the grounds that it is "not a party to the proceedings before the Legal Division". No legal basis was given.

Moreover, the notice of resumption of proceedings dated 11 January 2019, which the impugned decision of 15 March 2019 implicitly rendered final, did not provide adequate reasoning as to why the proceedings should be continued with Transito NV. The notice merely stated: "According to the submitted evidence the European Patent Office has been informed that Transito NV... is the person authorised to continue proceedings before the EPO." The notice contained no indication whatsoever of what "submitted evidence" had been taken into consideration.

C. Breach of the principle of "Equality of Arms"

The notice of resumption of proceedings, dated 11 January 2019, was sent to the last address of the proprietor of record, with the explicit invitation to submit comments within two months of the date of notification. A copy of the same notice was sent to the opponent. Not allowing the opponent to comment on the very same notice on which the proprietor was explicitly invited to comment constituted a flagrant violation of the principle of equality of arms.

The appellant's requests made in the statement of grounds of appeal (in point VIII) were those made in the notice of appeal (point I above).

In addition, for reasons of procedural economy, the appellant did not insist on a remittal of the case to the Legal Division pursuant to Article 11 RPBA because of fundamental deficiencies of the first-instance proceedings (violation of the right to be heard and the duty to state reasons). Assuming that the Board did not remit the case the appellant also requested that the Board declare that Transito NV no longer meets the requirements for being a party to proceedings before the EPO and order that the opposition proceedings be resumed with the opponent as the sole party.

The appellant further requested that the Board order reimbursement of the appeal fee due to substantial procedural violations in the meaning of Rule 103(1) (a) EPC consisting in the violation of the opponent's right to be heard and the lack of substantive reasoning for the refusal to hear the opponent.

VI. On 4 June 2019 the Legal Division referring to "your submissions of 21.03.2019 and 03.05.2019", i.e. the appeal and its confirmation, issued a communication pursuant to Article 113 EPC. Therein it stated that it could not concur with the appellant's view that the "communication" of 15 March 2019 was a decision within the meaning of Article 106 EPC. It therefore interpreted the request of 21 March 2019 (entitled "Notice of Appeal") as a request for issuance of an appealable decision.

The Legal Division (in point 4.1) took the view that proceedings under Rule 142 EPC were *ex parte* proceedings, as opposed to proceedings under Rule 14 EPC, where a third party within the meaning of Rule 14 EPC acquired the status of party to the stay proceedings.

The third party referred to in Rule 142(2) EPC was a third party to the interruption proceedings. The EPO could not notify any third party to the patent granting proceedings, i.e. the public. Thus Rule 142(2) EPC did not allow for another interpretation. As far as the protection of the interests of the public was concerned, information was provided through entry in the European Patent Register of the dates of interruption and resumption (see Rule 143(1)(t) EPC) and in the European Patent Bulletin. Furthermore, the Legal Division stated in point 5:

It is to be noted that there are no provisions under the EPC that would allow resumption of proceedings without an applicant or proprietor. Under the current legislation, in cases **where the EPO has not been informed of the identity of the person authorised to continue the proceedings**, e.g. in the event of the death of the applicant for or proprietor of a European patent where no heir can be found, patent granting

proceeding have to remain **interrupted sine die**. As opposed to the death of a natural person, the EPO **cannot exclude that a legal entity** that had for all purposes **ceased to exist may not be revived** at some point **through the retroactive effect of a provision of national law restoring it** (comp. G 1/13).

(Emphasis added.)

VII. In a reply to the Legal Division of 20 June 2019 the appellant raised objections to the Division's interpretation of the request of 21 March 2019 (entitled "Notice of Appeal") as a request for issuance of an appealable decision. If the Legal Division was not minded to rectify its decision under Article 109(1) EPC, its only alternative was to remit the appeal to the board of appeal under Article 109(2) EPC without comment as to its merit. As the EPC did not provide any other options, the Legal Division had exceeded its powers in the present case by issuing a communication under Article 113 EPC containing comments on the admissibility and the merits of the appeal, instead of remitting the case to the Board of Appeal.

As a precaution, the appellant made the following comments on the communication:

It disagreed with the view (expressed in point 4.1) that Rule 142(2) EPC did not allow for any interpretation other than that the third party referred to in that rule was a third party to the interruption proceedings. The mere use of the term "third party" did not imply that such party (in particular, the opponent) did not have party status in the interruption proceedings. The opponent was appropriately referred to as a "third party" in Rule 142(2) EPC because it was a third party to the actions taken against the property of the proprietor which were the subject of Rule 142(1) (b) EPC (explicitly referred to in Rule 142(2) EPC).

However, there was no explicit exclusion of such third parties from involvement in interruption proceedings. If the Contracting States had wanted the opponent to remain outside of the interruption proceedings, they would have explicitly said so, as they did in the case of third parties presenting observations concerning the patentability of an invention (Article 115 EPC, last sentence: "That person shall not be a party to the proceedings."). Hence, the fact that they omitted a similar statement from Rule 142(2) EPC was relevant and supported the contention that, since third parties were not explicitly excluded from involvement, the opponent should be a party to the interruption proceedings.

VIII. With a letter of 20 June 2019 to the opposition division, the appellant replied to the communication of the Division under Rule 84(1) EPC dated 10 April 2019. By that communication the parties had been informed that

the ... European patent has been surrendered or has lapsed with effect for all the designated Contracting States.

The opposition proceedings may be continued at the request of the opponent, provided that within two months from notification of this communication a request is so filed.

In reply, the appellant put forward that, as a result of the suspensive effect of the appeal (Article 106(1) EPC), the decision to resume the opposition proceedings on 1 April 2019 had to be considered to be suspended and the opposition proceedings still to be interrupted under Rule 142 EPC. In that light, the communication under Rule 84(1) EPC was sent prematurely.

As a precaution, in case the opposition division were to establish that it could proceed notwithstanding the

appeal filed on 21 March 2019 and that the issuance of the communication under Rule 84(1) EPC was justified at this stage, the opponent requested that the proceedings be continued under Rule 84(1) EPC with a view to obtaining a retroactive revocation of the patent under opposition.

The opponent also requested an apportionment of costs in view of the manifestly inappropriate procedural conduct of Transito NV prior to its dissolution.

- IX. On 14 October 2019, the appeal, which had not been rectified, was referred to the boards of appeal.

- X. Together with a summons to oral proceedings, the Board, on 17 December 2019, issued a communication pursuant to Article 15(1) RPBA to both the opponent (appellant) and the registered proprietor Transito NV. The registered letter to Transito NV was returned.

According to the Board's preliminary view set forth in the communication the appeal was admissible, but not allowable. The Board provisionally affirmed the Legal Division's denial of the opponent's party status in the proceedings under Rule 142(1)(b) and (2) EPC. According to the case law, the former provision protected the interests of the patent proprietor and its creditors. There was no need for the opponent to participate in those proceedings. An opponent considering that the patent proprietor no longer existed might avail itself of any rights following from that alleged fact in the course of the opposition proceedings that were resumed against its will.

- XI. In letter of reply of 23 February 2020 to the Board's communication the appellant put forward that the present case might be resolved without the Board taking

a position on the party status of opponents in interruption/resumption proceedings in general if the Board recognised that, under the circumstances of the case, the appellant had a legitimate expectation to be treated as a party (or at least to be heard) in the proceedings before the Legal Division, and that denying it the opportunity to be heard violated the principle of good faith.

The appellant fully agreed with the basic principle that "an interruption under Rule 142(1)(b) EPC served the protection not only of the interests of the patent proprietor but also those of its creditors" (T 1389/18). However, the parties whose interests a particular procedure was designed to protect were not necessarily the only parties who should be heard in the procedure. The appellant did not share the Board's preliminary opinion that "there is no reason to make it possible for the opponent to act in the proceedings under Rule 142(1)(b) and (2) EPC".

When in the course of opposition proceedings it was necessary to interrupt the proceedings to protect the interests of the patent proprietor and of its creditors, this naturally had an impact on the time at which the opposition proceedings could be concluded, so it directly affected the interests of all the parties to the opposition proceedings. Given the urgency of conserving the status quo in such circumstances, it was justifiable that the EPO did not hear the parties prior to declaring an interruption under Rule 142(1) EPC. However, once the interruption had come into effect, there was no justification for refusing to hear legal challenges to the decisions under Rule 142 EPC brought forward by an opponent, as it had a legitimate interest

in a speedy and legally correct conclusion of the main proceedings to which it was a party.

The present case was no longer about an interruption, but about an intended resumption of the main proceedings. The proprietor no longer existed. There was only one interest left to protect: the interest of the opponent to see a speedy and legally correct end to the opposition proceedings.

Requiring an opponent to challenge an incorrect assessment of the status of the proprietor at the end of the (resumed) opposition proceedings would not be correct. It would go against the desire for efficiency underlying the allocation of responsibilities for interruptions and resumptions of proceedings to the Legal Division by the Decision of the President of 21 November 2013 if those proceedings were to be treated as separate proceedings to which the opponent would not be a party, thus forcing the opponent to voice its concerns about the same legal issues in the resumed opposition proceedings.

In addition to the procedural violations raised in the statement of grounds of appeal, the appellant raised another procedural violation that had taken place after the lodging of the appeal: contrary to Article 109(2) EPC, the Legal Division did not remit the statement of grounds to the Board of Appeal "without delay and without comments as to its merits". After the submission of the statement of grounds on 3 May 2019, the Legal Division explicitly commented on its merits in a communication dated 4 June 2019 and only remitted the statement of grounds to the Board of Appeal after a complaint by the appellant. The Board only received the case in October 2019, i.e. five months after the filing of the statement of grounds.

XII. With a letter of 10 April 2020 the appellant requested an interlocutory decision on the party status of Transito NV in the present appeal proceedings; more precisely that the Board of Appeal declare, in an interlocutory decision, that Transito NV no longer existed as a legal entity and that it therefore could not be a party to the present appeal proceedings.

In a communication of 22 April 2020 the Board declined to issue the requested declaration in an interlocutory decision. The question of the existence of the patent proprietor as a legal entity would arise only in the event that the Board, further to the oral proceedings, reversed its preliminary view and intended to find in the opponent's favour. In this case, the Board would determine how to proceed further and likely adjourn the oral proceedings.

It followed from Article 60(3) EPC that Transito NV, being the registered patent proprietor, for the time being, was deemed to be entitled to exercise the rights conferred by the patent. This was independent of the question of whether or not Transito NV existed as a legal entity.

XIII. On 28 September 2020, third-party observations were received.

In a communication of 9 October 2020 in reply to an email by the representative relating to the conduct of the upcoming oral proceedings via video conference, the Board affirmed its view expressed in the communication of 22 April 2020.

XIV. In the oral proceedings held on 19 October 2020 the appellant requested an interlocutory decision on the party status of Transito NV in the present appeal proceedings. It further requested to set aside the Legal Division's denial of the opponent's party status in the proceedings under Rule 142 EPC as notified in the communication from the Legal Division dated 15 March 2019.

The opponent, which was the sole party represented, argued that under the presumption of Article 60(3) EPC, Transito NV, being the registered proprietor, was entitled to exercise the rights conferred by the patent and was party of right under Article 107 EPC. The summons not having been published in the European Patent Bulletin, the registered proprietor was not duly summoned under Rule 115(1) EPC.

The Chairman announced that the Board would summon the parties to fresh oral proceedings on 1 February 2021. As to the substance, he stated that there was no legal basis for the requested interlocutory decision and that more thought would be given to the question of whether in opposition proceedings it was correct that the opponent was denied party status.

XV. A summons to fresh oral proceedings to be held on 1 February 2021 was issued. The public notification thereof under Rule 129 EPC was made in the European Patent Bulletin 48/2020 of 25 November 2020, page 4610, section III.2 (21), under (application) number 10719228.8.

In the oral proceedings of 1 February 2021 the appellant initially requested

- that an interlocutory decision on the party status of Transito NV be taken in the present appeal proceedings,
- that the Legal Division's denial of the opponent's party status in the proceedings under Rule 142 EPC as notified in the communication from the Legal Division dated 15 March 2019 be set aside, and
- that the appeal fee be reimbursed.

As to the question of whether the opponent was a party to the resumption proceedings, the appellant argued as follows:

Interruption and resumption proceedings were incidental to the main opposition proceedings. Being accessory, according to general legal principles, they followed the main proceedings.

The interests served by interruption and resumption were the following:

- One set of interests were those of the proprietor's creditors.
- The opponent also had important interests:
 - on the one hand, if the Legal Division did not resume the proceedings, the opponent would be deprived of opportunities to have the case dealt with swiftly.
 - On the other hand, as in this case: if the opposition proceedings were resumed with the (no longer existing) patent proprietor, then the proprietor could no longer serve for costs and be a partner in the dialogue.

After the debate, the Chairman, in particular, reiterated the Board's opinion that there was no legal

basis for an interlocutory decision on the party status of Transito NV.

The appellant then stated its final requests that

- the decision under appeal be set aside,
- the appeal fee be reimbursed.

XVI. At the end of the oral proceedings of 1 February 2021 the chairman announced the Board's decision.

Reasons for the Decision

1. Whether the appeal is admissible

1.1 Whether the "communication" of 15 March 2019 constitutes a "decision" within the meaning of Article 106 EPC

According to Article 106(1), first sentence, EPC, an appeal lies from "decisions" of, *inter alia*, the Legal Division of the EPO. Under established case law of the boards of appeal, whether a document constitutes a decision or not depends on the substance of its content and not on its form; see Case Law of the Boards of Appeal of the EPO (hereinafter referred to as "Case Law"), 9th edition 2019, sections V.A.2.2.2 and III.K.3.1, and the cases cited there. According to T 165/07 (Reasons, point 3), the decisive question was whether the document at issue, when objectively interpreted in its context, could have been understood by its addressees as a final, i.e. not merely preliminary, and binding determination of substantive or procedural issues by the department ("organ") of the EPO which has jurisdiction ("is competent"). The Board shares this view, with the proviso that even a document issued by a

department of the EPO that does not have jurisdiction may constitute a decision.

The Board notes that, in the impugned "communication" of 15 March 2019, "Reference is made to your letter of 05.02.2019...". In that letter the appellant *inter alia* requested resumption of the appeal proceedings with the appellant as sole party and revocation of the patent. It also requested that the Legal Division allow a separate appeal under Article 106(2) EPC "on the decision to be rendered".

In the "communication" under appeal, the Legal Division replied *inter alia* (emphasis added):

Please note that you are **not party** to the proceedings pursuant to Rule 142 EPC. As a third party to these proceedings, you may **file** neither observations **nor any procedural requests**.

Opposition proceedings relating to the European patent No. 2 393 977 will be **resumed on 1 April 2019...**

This latter paragraph of the "communication" made the "Resumption of proceedings after interruption Rule 142(2) EPC" that the Legal Division announced in a letter of 11 January 2019 final. This letter itself cannot be considered final, and thus not a decision, but a communication, because its addressee, Transito NV, was allowed a two-month time limit for comments on the resumption (see above, point II, fourth indent).

Apart from causing the announced resumption of the proceedings to become final, in the impugned "communication" of 15 March 2019, the opponent was also denied party status and, by the passage "...you may [not] file... any procedural requests", its requests were rejected as inadmissible.

The impugned "communication" of 15 March 2019 thus constitutes a final, binding determination of procedural issues by a department of the EPO, i.e. the appellant's party status and the resumption of proceedings. The "communication" therefore is a decision in the meaning of Article 106(1), first sentence, EPC.

- 1.2 Whether the appellant is a "party to the proceedings adversely affected by a decision" under Article 107, first sentence, EPC

The proceedings before the Legal Division relating to interruption and resumption of the opposition proceedings before the opposition division are intermediate proceedings in relation to the opposition proceedings. Whether or not the opponent (appellant) is party to the resumption proceedings is the main subject of the present appeal. As to its admissibility, the Board shares the appellant's view that although it

was not recognized as a party by the department of first instance that rendered the impugned decision, this should not affect the admissibility of the present appeal, since the denial of party status is subject of the appeal. Otherwise, there would be no legal remedy against an incorrect denial of party status by a first-instance department.

(See above, point IV.)

The Board also agrees that the impugned "communication", which constitutes a decision, adversely affects the appellant. This is due to the mere fact that the Legal Division, rightly or wrongly, denied the appellant party status and thus did not consider its observations and requests made in the letter of 5 February 2019 mentioned above.

1.3 Time limits pursuant to Article 108 EPC

The time limits for filing the appeal and the statement of grounds of appeal mentioned in Article 108, first and third sentence, EPC have also been complied with: as the impugned "communication" was issued on 15 March 2019, the notice of appeal filed on 21 March 2019 and the statement of grounds of appeal filed on 3 May 2019 were received within the applicable two-month and four-month time limit, respectively (cf. Article 108 and Rules 126, 131 and 134 EPC).

Further to the "communication" of 21 February 2017, on 21 March 2019, when the appeal against the "communication" (decision) of 15 March 2019, was filed, the opposition proceedings were in the state of interruption (see point II above). This legal consequence, which the appellant agrees to, has no impact on the validity of the filing of the notice of appeal. Reason for this is that, as stated, the proceedings before the Legal Division relating to interruption and resumption of the opposition proceedings before the opposition division are intermediate proceedings in relation to the opposition proceedings. Procedural acts filed during the period of interruption of the opposition proceedings may have no legal validity. But the same cannot be said in relation to the proceedings before the Legal Division, simply because they are not interrupted but, rather, meant to determine the end of the interruption of the opposition proceedings. As a consequence, the appellant's confirmation of the filing of the notice of appeal on 9 April 2019 (see point IV above) has no object.

1.4 Suspensive effect (Article 106(1), second sentence, EPC)

Pursuant to this provision, an appeal filed against a decision of the Legal Division has suspensive effect. Accordingly, given that the admissibility requirements have been complied with, the appeal suspended the resumption of the opposition proceedings ordered for 1 April 2019 in the impugned "communication" (decision). Consequently, the "communication" of 21 February 2017 stating that the opposition proceedings had been interrupted as from 31 January 2017 (see above, point second indent) continues to be valid.

It follows in particular that the opposition division's communication under Article 84(1) EPC of 10 April 2019 (see point VII above) has no legal effect (was "sent prematurely", in the words of the appellant). The appellant's request that the opposition proceedings be continued, filed as a precaution, therefore was not necessary.

2. Whether the appeal is allowable

2.1 The legal framework

The Board considers that the appeal would be allowable if the Legal Division, in the impugned "communication" (decision), had improperly denied the appellant party status in the resumption proceedings under Rule 142(2) EPC and concluded that, as a third party to these proceedings, the appellant might file neither observations nor any procedural request. As a consequence, the Legal Division did not consider the

observations and requests submitted by the opponent on 5 February 2019, reason why the resumption of the opposition proceedings on 1 April 2019 with Transito NV as the proprietor of the patent under opposition announced on 11 January 2019 became final (but was suspended by the appeal).

Rule 142 EPC, in pertinent part, reads as follows (emphasis added):

(1) Proceedings before the European Patent Office shall be interrupted:

...

(b) in the event of the applicant for or proprietor of a patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings

(2) When, in the cases referred to in paragraph 1(a) or (b), the European Patent Office has been informed of the identity of the person authorised to continue the proceedings, it shall **notify such person** and, where applicable, **any third party**, that the proceedings will be **resumed** as from a specified date.

According to the "Decision of the President of the European Patent Office dated 21 November 2013 concerning the responsibilities of the Legal Division" (OJ EPO 2013, 600), point 1.2(b) [s]ole responsibility for the following duties shall be vested in the **Legal Division**:
... Interruption and resumption of proceedings (Rule 142 EPC).

2.2 Analysis

2.2.1 Case law regarding Rule 142 EPC

Rule 142 EPC provides no indication as to whether the third party mentioned in its paragraph 2 is party to the resumption proceedings.

According to J 16/05 the rationale of Rule 90(1)(b) EPC 1973 (corresponding to Rule 142(1)(b) EPC) was to protect parties not able to act in the proceedings for the defined legal reasons against a loss of rights which would otherwise occur, until such time as the EPO could resume the proceedings under Rule 90(2) EPC 1973 (Rule 142(2) EPC).

In T 1389/18 the Board held that an interruption under Rule 142(1)(b) EPC served the protection not only of the interests of the patent proprietor but also those of its creditors.

(For more case law relating to Rule 142(1)(b), see "Case Law", section III.D.3.6.)

2.2.2 The appellant's reasoning

The appellant argued that, in resumption proceedings under Rule 142(2) EPC, arguably different from interruption proceedings under Rule 142(1) EPC, not only the interests of the patent proprietor and its creditors were covered by the rationale of Rule 142 EPC. Rather, where opposition proceedings were pending, the opponent's interests were *also* protected, or, in this case, where the proprietor no longer existed, *only* those interests enjoyed protection (see above, point XII).

From the reasons given by the appellant for its assertion, which have been reproduced in the summary of facts and submissions above, the following are highlighted:

As in the case of re-establishment proceedings, to which an opponent was party if the request for re-

establishment was filed by the patent proprietor during opposition proceedings, the outcome of interruption/resumption proceedings was of the utmost importance to the opponent. This was because the decision on the resumption of opposition proceedings had an impact on whether and when the opponent could obtain revocation of the opposed patent. An incorrect decision, as in the case under appeal, could lead to unnecessary and costly oral proceedings while depriving the opponent of the opportunity to request and enforce an apportionment of costs.

(See, in particular, above, point V, A.1.)

The opponent was appropriately referred to as a "third party" in Rule 142(2) EPC because it was a third party to the actions taken against the property of the proprietor which were the subject of Rule 142(1)(b) EPC (explicitly referred to in Rule 142(2) EPC). (See above, point VII.)

Requiring an opponent to challenge an incorrect assessment of the status of the proprietor at the end of the (resumed) opposition proceedings would go against the desire for efficiency underlying the allocation of responsibilities for interruptions and resumptions of proceedings to the Legal Division by the Decision of the President of 21 November 2013 if those proceedings were to be treated as separate proceedings to which the opponent would not be a party, thus forcing the opponent to voice its concerns about the same legal issues in the resumed opposition proceedings. (See above, point XI.)

2.2.3 The Board's view

The Board is of the view that, where opposition proceedings were interrupted and the Legal Division intends to resume proceedings, as in this case, or, conversely, where it refuses to resume the proceedings, the outcome of the resumption proceedings has an immediate impact on the opponent's legal position.

Insofar, the Board agrees that there is a parallel to proceedings relating to re-establishment of rights. In T 552/02 it was held (in point 1.6) that there was a general principle of law that all the parties whose interests were affected by a decision were parties to the proceedings ("...principe général de droit que toutes les parties dont les intérêts sont affectés par une décision sont parties à la procédure..."; see also T 1561/05, point 1.2).

In resumption proceedings, the opponent is party to the main opposition proceedings. Any decision taken in the intermediate resumption proceedings may (adversely) affect the opponent's legal position. The opponent cannot be required to defend its rights only subsequently in the main (opposition) proceedings, after they have been resumed. Such a requirement, as the appellant rightly stated, would delay proceedings and might cause additional costs.

2.3 Conclusion on the opponent's party status

The opponent (appellant) is party to the resumption proceedings. As a consequence, the Legal Division's denial of the appellant's party status to the resumption proceedings in the impugned decision, entitled communication, of 15 March 2019, was unlawful.

It follows that the division's failure to consider the observations and requests submitted by the opponent on 5 February 2019 was equally unlawful.

2.4 Legitimate expectations

The appellant stated that the Legal Division, with a telephone call, actively reached out to the appellant's representative for comment, prior to the communication of 15 March 2019, in which it was held that the opponent "may file neither observations nor any procedural requests". The appellant contended that, in view of this call and earlier correspondence, the Legal Division raised the legitimate expectation of being treated as a party in the interruption proceedings as a matter of good faith.

(See points V.A.2 and XI above.)

Given that the Board has acknowledged the opponent's (appellant's) party status in the resumption proceedings, there is no need to decide on whether such status would also derive from the principle of legitimate expectations as developed by the boards of appeal (see Case Law, III.A). The Board merely remarks *obiter* that it would be difficult to see how comments solicited by a member of the EPO in a telephone conversation could, in essence, establish a reasonable expectation that it conveyed party status. Members of the EPO may reach out to parties to proceedings before it to elucidate an issue, in conformity with their duty to examine a case *ex officio*. Disappointment about not being afforded party status after such a consultation made in the context of correspondence with the EPO would not appear to give rise to a legal remedy. Information **solicited** by the EPO does, in particular, not fall under the category "Information

provided by EPO" (Case Law, title of section III.A.2, emphasis added).

2.5 Remittal to the Legal Division

The foregoing examination of the appeal has revealed that it is allowable within the meaning of Article 111(1) EPC. This is because the Legal Division, in the impugned "communication" (decision) of 15 March 2019, erred in denying the appellant's party status to the resumption proceedings and consequently failed to consider the observations and requests submitted by the opponent on 5 February 2019 (see point 2.3 above).

Pursuant to Article 111(1) EPC:

Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

According to Article 11 RPBA 2020,

The Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

In the statement of grounds of appeal, the appellant asserted that fundamental deficiencies of the first-instance proceedings had taken place in the proceedings before the Legal Division:

- not considering the observations and requests submitted by the opponent on 5 February 2019 amounted to a violation of its right to be heard (*idem*, IV.A);
- the brief impugned "communication" did not comply with the division's duty to state reasons (Rule 111(2) EPC; *idem*, IV.B).

For reasons of procedural economy, the appellant did however not insist on a remittal of the case to the Legal Division pursuant to Article 11 RPBA.

In its reply to the Board's communication under Article 15(1) RPBA (above, point XI *in fine*), the appellant, in addition to the procedural violations raised in the statement of grounds of appeal, raised another procedural violation that had taken place after the lodging of the appeal: contrary to Article 109(2) EPC, the Legal Division did not remit the statement of grounds to the Board of Appeal "without delay and without comments as to its merits".

(The appellant further asserted that the violation of the opponent's right to be heard and the lack of substantive reasoning for the refusal to hear the opponent constituted substantial procedural violations in the meaning of Rule 103(1)(a) EPC justifying reimbursement of the appeal fee and requested such reimbursement. See below, point 3.)

As set out at the beginning of this section, the Legal Division, in the impugned "communication" (decision) of 15 March 2019, erred in denying the appellant's status of party to the resumption proceedings and consequently failed to consider the observations and requests submitted by the opponent on 5 February 2019.

In analogy to the situation in case T 683/14 (see point II.D *in fine*), the error to deny the opponent party status in the resumption proceedings was of a substantive nature. The procedural consequences thereof, i.e. in particular

(i) the failure to consider the observations and requests submitted by the opponent on 5 February 2019 and
(ii) the lack of reasoning of the brief document, entitled and meant to be a mere communication, and
(iii) the failure to forward the appeal "without delay and without comments as to its merits" to the Board were all caused exclusively by the implementation of the erroneous substantive position.

It follows from the foregoing that the Legal Division did commit errors, but substantive and not (independent) procedural ones. The appellant itself, in its written submissions, confirmed this as to the above errors (i) and (ii). Notably, the appeal was directed against the "communication" (decision) of 15 March 2019 "to deny... party status in the proceedings... and its **resulting refusal** to consider the observations and requests submitted by the Opponent on 5 February 2019..." (emphasis added; see point I above). In the oral proceedings of 1 February 2021 the appellant agreed to this conclusion in respect of all three errors (i), (ii) and (iii). It argued, however, that these substantive errors led to procedural deficiencies (Article 11 RPBA) and violations (Article 103(1)(a) EPC).

The Board disagrees. It cannot consider the consequences of the substantive errors to also constitute deficiencies in the proceedings, let alone fundamental ones, within the meaning of Article 11 RPBA. The mere implementation of an erroneous substantive legal position is of no independent erroneous nature and thus cannot constitute an independent deficiency in the proceedings.

The Board has not been able to detect any other fundamental deficiency. As to the asserted additional procedural violation relating to the manner of the forwarding of the appeal to the Board (item (iii) above), any corresponding deficiency in the proceedings under Article 11 RPBA would be immaterial, in addition to the reasons given above, because a belated forwarding of the appeal filed could logically not have caused the appellant to file the appeal, i.e. the required causal link between the asserted procedural violation and corresponding deficiency and the filing of the appeal does not exist.

Even though the example of an exception to non-remittal under Article 111(1) EPC provided in Article 11 RPBA does not apply, the Board, making use of its discretion, still decides to remit the case to the Legal Division. Having denied the appellant's status of party to the resumption proceedings, the Legal Division has so far not considered the observations and requests submitted by the opponent on 5 February 2019 by which, in particular, it objected to the resumption of the opposition proceedings with Transito NV acting as patent proprietor and requested that the opposition proceedings be resumed with the opponent as the sole party.

As a rule, proceedings before the EPO are designed such that issues may normally be decided by two instances, i.e. an administrative first-instance department and, upon judicial review, by the boards of appeal. Remittal to the Legal Division, which has not examined the appellant's case as to substance at all, will be in compliance with this rule. These circumstances constitute "special reasons" to remit within the meaning of Article 11, first sentence, RPBA 2020.

3. Whether the appeal fee is to be reimbursed

In the statement of grounds of appeal (above, point V *in fine*) the appellant requested that the Board order reimbursement of the appeal fee due to substantial procedural violations in the meaning of Rule 103(1) (a) EPC consisting in the violation of the opponent's right to be heard and the lack of substantive reasoning for the refusal to hear the opponent. In its reply to the Board's communication under Article 15(1) RPBA, the appellant, raised the further procedural violation that the Legal Division did not remit the statement of grounds to the Board of Appeal "without delay and without comments as to its merits". (See above, point 2.5.)

The Board considers this request to be unfounded for reasons, which, in the present case, are analogous to those expressed above, in point 2.5. Those reasons, in the Board's view, lay out that substantial procedural violations are not apparent in the proceedings before the Legal Division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside and the case is remitted to the Legal Division for further prosecution.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated