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**Datasheet for the decision
of 1 September 2022**

Case Number: J 0007/21 - 3.1.01

Application Number: XXXXX

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

CAPSID-FREE AAV VECTORS, COMPOSITIONS, AND METHODS FOR VECTOR
PRODUCTION AND GENE DELIVERY

Applicants:

N.N.

Headword:

Relevant legal provisions:

EPC R. 36(1), 22(3)

Keyword:

Divisional application - application to be treated as
divisional application (yes)
Co-applicants status as universal successor of original co-
applicant (yes)
Rule 22(3)EPC not applicable in case of universal succession

Decisions cited:

T 0015/01, T 0006/05, T 2357/12

Catchword:



Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique

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Case Number: J 0007/21 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 1 September 2022

Appellant: N.N.
(Applicant 1)

Appellant: N.N.
(Applicant 2)

Appellant: N.N.
(Applicant 3)

Appellant: N.N.
(Applicant 4)

Appellant: N.N.
(Applicant 5)

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office posted on 16 March 2021 refusing to process European patent application No. XXXXXXXX.X as a European divisional application pursuant to Rule 36(1) EPC.

Composition of the Board:

Chairman W. Sekretaruk
Members: L. Basterreix
 A. Jimenez

Summary of Facts and Submissions

- I. The appeal is against the Receiving Section's decision dated 16 March 2021 holding that the European patent application No. XXXXXXXXX.X was not to be treated as a European divisional application since it had not been filed by the joint applicants of the earlier European patent application No. XXXXXXXXX.X (Rule 36(1) EPC).
- II. The relevant facts leading to the decision under appeal are as follows:
- (a) The European patent application No. XXXXXXXXX.X was filed by joint applicants N.N. on 17 September 2019 as a divisional application of the earlier European patent application No. XXXXXXXXX.X (the parent application).
 - (b) By letter of 18 September 2019, received at the EPO on the same date, the parent application No. XXXXXXXXX.X was withdrawn.
 - (c) By communication of 14 October 2019, the Receiving Section informed the joint applicants that the second applicant of the divisional application, i.e. N.N., differed from the second applicant of the parent application, i.e. N.N., and therefore the European patent application could not be treated as a divisional application since there was a discrepancy in the identity of the applicants on the date the application was received. The applicants' attention was drawn to the possibility of filing a request for correction under Rule 139 EPC.

- (d) On 29 October 2019 the professional representative replied that the discrepancy in the identity of the applicants was not due to a mistake at the time the divisional application was filed. N.N. was an applicant of the divisional application as N.N. had merged into N.N. as of 1 January 2018. Copies of the documents demonstrating the merger were submitted in the form of a confirmatory deed of merger dated 20 March 2018. It was requested that the application at issue be treated as a divisional application.
- (e) By communication of 25 November 2019 the Receiving Section stated that pursuant to Rule 36(1) EPC only the applicant/s registered as such in the European Patent Register could file a divisional application. The change of applicants had, however, not been requested in respect of the parent application, which had been validly withdrawn with effect of 18 September 2019. As a consequence, a transfer of rights to N.N. could no longer be registered in respect of the parent application (Guidelines, A-IV, 1.1.1 and E-XIV, 3). The Receiving Section concluded that there was no identity of applicants, so the application at issue could not be treated as a divisional application.
- (f) By letter of 28 November 2019 the professional representative referred to decision T 15/01, in which the board of appeal concluded that a universal succession was not a transfer, meaning that the provision of then Rule 20(3) EPC 1973 (now Rule 22(3) EPC) was not applicable. The professional representative repeated the request for the application at issue to be treated as a divisional application.

- (g) Noting the loss of rights pursuant to Rule 112(1) EPC dated 21 December 2020, the Receiving Section stated that the application was not being processed as a European divisional application because when it had been filed the applicants were not identical to those on record in the parent application.
- (h) On 22 February 2021 the professional representative filed a request for an appealable decision under Rule 112(1) EPC and referred to his previous submissions dated 29 October 2019.

III. The reasons for the decision under appeal may be summarised as follows:

- (a) Pursuant to Rule 36(1) EPC only the applicant of the parent application or its successor in title as registered in the European Patent Register may file a divisional European patent application within the meaning of Article 76 EPC. Where there are joint applicants, the divisional application must be filed by the same joint applicants.
- (b) To satisfy this prerequisite of identity of all co-applicants registered in the European Patent Register for filing a valid European patent divisional application, the registration of the second co-applicant of the parent application would have had to be amended retroactively, which was no longer possible.
- (c) If the letters dated 29 October 2019 and 28 November 2019 submitted in respect of the application at issue were to be interpreted as a request for that kind of registration in respect of

the parent application, any such request could only have been filed during pending patent grant proceedings, pursuant to Rule 85 EPC, or filed together with an admissible means of redress. Yet at the above-mentioned dates no administration fee pursuant to Rule 22(2) EPC had been paid, so the request was deemed not to have been filed (Rule 22(2) EPC).

(d) The interpretation of Rule 22(3) EPC as regards the effective date of the registration by the board of appeal in decision T 15/01 did not make the registration itself redundant. A transfer becomes effective only once all the formalities of registering the transfer have been fulfilled, i.e. once the valid request has been filed, an administrative fee paid and the necessary documentary evidence provided. This applied regardless of whether the issue concerned a contractual transfer or a universal succession.

(e) In the case in hand, however, the transfer could no longer be registered and the identity of the co-applicants of the parent application could no longer be modified. Under those circumstances, there was no identity of applicants, and therefore the application at issue could not be treated as a divisional application.

IV. On 16 May 2021, the appellants filed notice of appeal. They requested that the Receiving Section's decision be set aside and that the application No. XXXXXXXXX.X be processed as a European divisional patent application.

V. In the statement setting out the grounds of appeal dated 16 July 2021, the applicants (appellants)

submitted that, as a result of the merger of two legal persons including N.N., N.N. was entitled to the divisional filing as the universal successor in law of said entity, joint applicant of the earlier European patent application. They added that under the case law of the boards of appeal a universal succession, e.g. a merger, is not a transfer of assets and should not be treated as such, and that the provisions of Rule 22(3) EPC did not apply in this case. Therefore, it should be held that as of 1 January 2018 N.N. was the sole successor in respect of all rights and obligations of N.N., which ceased to exist, and that N.N. automatically acquired party status in examination and filing proceedings before the EPO and was thus entitled, along with its joint owners, to file a divisional application from application No. XXXXXXXX.X.

Reasons for the Decision

1. The appeal fulfils the requirements of Articles 106-108 EPC and Rule 99 EPC and is therefore admissible.
2. Under Article 76 EPC and Rule 36(1) EPC, the applicant may file a divisional application relating to any pending earlier European patent application. The name of the second applicant of the divisional application, i.e. N.N., does indeed differ from the name of second applicant of the parent application, i.e. N.N.. This change of name is the consequence of a decision by the French government.
3. *N.N. as universal successor of N.N.*
 - 3.1 The appellants provided a confirmatory deed of merger dated 28 March 2018 (D2), which states that N.N. is a public institution serving scientific, cultural and

professional purposes created pursuant to Decree No. 2017-596, issued by the French Ministry of Education on 21 April 2017, by merging N.N. and N.N..

According to Article 3 of the confirmatory deed of merger, full ownership or, where appropriate, shared ownership of all patents and patent applications fully or jointly owned has been transferred to N.N.. The transfer of ownership to N.N. as a result of the merger of the two universities includes all associated rights, privileges and obligations, with N.N. thus being subrogated to all rights on both universities' patents or patent applications.

Article 4 states that the effective date of merger, transfer of ownership and the related name change is 1 January 2018.

3.2 The transfer to N.N. of all rights on the patents or patent applications owned by N.N. is in accordance with Article L.236-3, I of the French Commercial Code, under which the merger leads to the dissolution without liquidation of the companies that are disappearing and the universal transfer of their assets to the receiving companies, in their current state on the date the operation is finally carried out.

In view of the above, it is therefore established that from 1 January 2018 N.N. became the universal successor in law of N.N..

4. *Application of Rule 22(3) EPC in the context of universal succession in law*

Rule 22 EPC deals with the registration of transfers of European patent applications in the European Patent Register. Under Rule 22(3) EPC, a transfer does not take effect vis-à-vis the EPO until the date when and

to the extent that the documents providing evidence of that transfer have been produced.

4.1 The appellant states that neither Rule 36(1) EPC, nor Article 76 EPC, nor Rule 22(3) EPC requires a merger to be registered in the European Patent Register. The appellant referred to the case law of the boards of appeal under which the provisions of Rule 22(3) EPC do not apply in the context of universal successions in law, with the successor automatically acquiring party status from the date on which the merger becomes effective and not only once sufficient evidence to this effect has been submitted to the EPO.

4.2 Regarding the case law of the boards of appeal cited by the appellant, in T 15/01 the board made a distinction between the situation in which the transferee has acquired the patent through an assignment by the patentee on record and the situation in which the transferee is the universal successor in law of the original patentee as a result of a merger. The board concluded that Rule 20 EPC 1973 did not apply in the context of universal succession in law and that the universal successor of a patent applicant or patentee automatically acquires party status in proceedings pending before the EPO.

In T 06/05, the board confirmed this principle, stating that in the case of universal succession of the patent proprietor there is only one (legal) person remaining, namely the universal successor, who enjoys all the rights and is subject to all the obligations of its predecessor, whose legal status it assumes.

In T 2357/12, the board stated that "universal succession" as applied in the case law of the boards of

appeal was considered an exception to Rule 22(3) EPC. This autonomous concept developed in the case law of the boards of appeal applied to different types of cases, including succession by law where all assets remain united (death, conversion/transformation, amalgamation/merger).

The board comes to the same conclusion that Rule 22(3) EPC does not apply in the context of universal succession, but not for the same reasons as those submitted by the applicant.

4.3 The rules of interpretation of the Vienna Convention on the Law of Treaties of 1969, namely Articles 31 and 32, apply when interpreting the EPC (see G 5/83, reasons 5). Under Article 31(1), a treaty is to be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of the object and purpose of the treaty. While they are directly applicable only to the treaty itself, the same principles of interpretation may also be applied when interpreting the Implementing Regulations, i.e. the EPC rules.

4.4 In the context of a systematic interpretation, the meaning of "transfer" in the provisions of Rule 22 EPC must be established, taking into account its position within a coherent group of related legal norms. Rule 22 EPC implements Articles 71 and 72 EPC, relating to patent applications as objects of property. Under Article 71 a patent application is an object whose property can be transferred, or over which rights can be constituted and transferred, i.e. licence rights (Article 73 EPC) or rights *in rem* (Rule 23(1) EPC), for one or more of the designated contracting states. Therefore, the transfer of a European patent

application has the effect of making a patent application the property of another person.

The only provision relating to the conditions under which the transfer of a patent application may take place is Article 72 EPC, which states that "*[a]n assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract*". Although Article 72 EPC governs formal requirements, the only reference made in the EPC to the transfer of a patent application is in the form of an assignment contract.

Formal requirements laid down in Article 72 EPC, such as the establishment of the transfer in written form, the presence of the parties' names and signatures and the implied requirement to provide proof of the signatory's entitlement to sign on behalf of a legal person, all refer to the transfer of a patent application by contract. No other possibility is dealt with in the EPC, and some of those requirements would not be able to be met in the case of universal succession following the death of a natural person.

Moreover, Rule 143(1)(w) EPC states that the European Patent Register must contain entries concerning the rights and transfer of such rights relating to an application or a European patent where the Implementing Regulations provide that they are to be recorded. Hence, it can be inferred from that provision that not all kind of transfers of rights need to be registered, but only those explicitly mentioned in the Implementing Regulations. In so far as Rules 22 to 24 EPC provide that transfers, licences and other rights in a patent application must be registered, the provisions of Rule 143(1) EPC can only be understood if the term

"transfer" in Rule 22 EPC does not include all means of acquiring ownership of a patent application.

- 4.5 A teleological interpretation, i.e. an interpretation of the meaning in the light of the purpose of Rule 22 EPC, leads to the same conclusion. The intention of Rule 22 EPC is to ensure the informational role of the European Patent Register and to avoid any ambiguity as to who owns a patent application during proceedings before the EPO. Rule 22(3) EPC is more specifically intended to determine the effective date vis-à-vis the EPO of the transfer of ownership of a patent application. It is in the public interest that the Register reflects the true status of the patent application, including the applicant's particulars as stipulated in Rule 41(2)(c) EPC, i.e. the applicant's name, address and nationality and the state in which its residence or principal place of business is located.

The requirements mentioned above are justified when transferring a patent application by assignment, since only a specifically designated right is transferred to a third party and the former patent proprietor, i.e. the assignor, continues to exist. There are therefore two legal entities that still exist and it is important to be able to determine, by consulting the Register, the extent of the rights whose ownership has been transferred and the identity of the owner.

However, in the case of universal succession, the entirety of the assets are transferred automatically as a result of the disappearance of the legal personality of the patent application's owner. Consequently, there is no risk of confusion between two legal entities that could be considered owners of the patent application,

nor regarding the extent of the rights transferred since all assets remain united. Therefore, there is no justification for delaying the effect of the transfer of assets vis-à-vis the EPO until the date and time at which the evidence is provided proving the disappearance of the legal personality of the patent application's previous owner and the identity of its universal successor.

The board concludes that the notion of "transfer" in Rule 22 EPC should be interpreted as not covering universal successions, meaning that none of the requirements laid down in Rule 22 EPC for the registration of transfers is applicable. In the latter case, the effect of the change in ownership of the patent application is immediate and there is no need to postpone it to a later date on which the documents establishing that change have been provided to the EPO.

5. In view of the above, the board considers that as of 1 January 2018 N.N. automatically became the universal successor and owner of the patents and patent applications owned by N.N., including the jointly owned European patent application No. XXXXXXXX.X (the parent application), there being no need to request registration of the transfer, file documentary evidence and pay the fee. Therefore, the European patent application No. XXXXXXXX.X, filed by the joint applicants N.N., on 17 September 2019 was filed by the same co-applicants as the parent application and meets the requirements of Article 36(1) EPC.

Consequently, the decision under appeal must be set aside and the application at issue must be treated as a divisional application of the earlier European patent

application No. XXXXXXXX.X, which was still pending on the filing date.

Order

For these reasons it is decided that:

- The Receiving Section's decision is set aside.
- The case is remitted to the Receiving Section for further prosecution.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated