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D E C I S I O N
of 23 July 2004

Case Number: T 1091/02 - 3.3.4

Application Number: 92305862.2

Publication Number: 0520794

IPC: C12Q 1/68

Language of the proceedings: EN

Title of invention:
Methods for detection of carcinoma metastases by nucleic acid amplification

Patentee:
F. HOFFMANN-LA ROCHE AG, et al

Opponents:
(1) Akzo Novel N.V.
(2) Vysis Inc.

Headword:
Methods for detection/HOFFMANN-LA ROCHE

Relevant legal provisions:
EPC Art. 99(1), 104(1), 105, 107, 108, 112(1)(a), 117(1), 122, 133(3)
EPC R. 20(1),(2), (3), 21, 60(2), 61, 64(a), 65(1),(2), 88, 92(1),(2)

Keyword:
"Transfer of opponent status - substantive requirements - formal requirements - appeal filed by alleged transferee of opponent status - auxiliary request to consider appeal filed by original opponent - referral to Enlarged Board of Appeal"

Decisions cited:
G 0001/86, G 0004/88, G 0009/93, G 0001/94, G 0009/91, G 0003/97, J 0010/87, J 0016/94, T 0234/86, T 0349/86, T 0475/88, T 0005/89, T 0482/89, T 0563/89, T 0789/89, T 0553/90, T 0340/92, T 0649/92, T 0659/92, T 0870/92, T 0590/93, T 0670/95, T 0001/97, T 0298/97, T 0799/97, T 1137/97, T 1204/97, T 0097/98, T 0656/98, T 0814/98, T 0460/99, T 0602/99, T 0711/99, T 0854/99, T 0009/00, T 0824/00, T 0715/01, T 0788/01, T 0854/02

Headnote:
The following questions are referred to the Enlarged Board of Appeal:

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

   (b) If question 1(a) is answered in the negative: Can a legal person who was a 100%-owned subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates acquire opponent status if all its shares are assigned by the opponent to another company and if the persons involved in the transaction agree to the transfer of the opposition?

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

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

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

3. If question 1(a) and (b) is answered in the negative: Is an appeal admissible if, although filed on behalf of a person not entitled to appeal, the notice of appeal contains an auxiliary request that the appeal be considered filed on behalf of a person entitled to appeal?

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Case Number: T 1091/02 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 23 July 2004

Appellant: (Opponent 01)
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Other Party: (Opponent 02)
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Representative:
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London WC1X 8AL (GB)

Respondents: (Proprietors of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 16 August 2002 rejecting the opposition filed against European patent No. 0520794 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairwoman: U. Kinkeldey
Members: R. Moufang
R. Gramaglia

Summary of Facts and Submissions

I. The grant of European patent No. 0 520 794 was published on 26 November 1997. Oppositions were filed against this patent by Akzo Nobel N.V. (Opponent 1) and Vysis Inc. (Opponent 2). By decision of 11 July 2002, issued in writing on 16 August 2002, the opposition division rejected the oppositions.

II. On 25 October 2002 a notice of appeal against the above decision was filed. It stated that the appeal was filed in the name of bioMérieux B.V. since this company now owned the diagnostic activities of Akzo Nobel N.V. to which the opposition pertained. The notice further stated that, subsidiarily and as a precautionary measure only, in the event that the appeal in the name of bioMérieux B.V. were to be considered inadmissible, the appeal was filed in the name of Akzo Nobel N.V. A single appeal fee was paid.

A declaration signed by representatives of Akzo Nobel N.V., bioMérieux B.V. and bioMérieux S.A. in August 2002 was submitted with the notice of appeal. Its content may be summarised as follows: Akzo Nobel N.V. had diagnostics as part of its business, which had been concentrated in its business unit Organon Teknika B.V. The opposition was filed by Akzo Nobel N.V. in the interest of its European diagnostics business, as conducted on its behalf by Organon Teknika B.V. An agreement was reached effective from 30 June 2001 between Akzo Nobel N.V. and bioMérieux S.A. to transfer the diagnostic activities of Organon Teknika B.V. from Akzo Nobel N.V. to bioMérieux S.A. Since then Organon Teknika B.V. has continued its diagnostic business as a

100%-affiliate of bioMérieux S.A., first under its old name and since February 2002 under the name of bioMérieux B.V. The declaration makes specific reference to the opposition appeal proceedings concerning European patent No. 0 285 057 (T 746/00) for which the declaration had already been submitted to the Technical Board of Appeal 3.3.8. The declaration does not specifically refer to the present opposition.

III. On 27 December 2002 the appellant filed the grounds of appeal.

IV. On 14 May 2003 the board issued a communication drawing attention to the issue of admissibility of the appeal and summoned the parties to oral proceedings restricted to this issue.

V. By letter dated 27 June 2003, the appellant filed a further declaration signed by representatives of Akzo Nobel N.V., bioMérieux B.V. and bioMérieux S.A. in June 2003 and framed in similar terms to the previous declaration, but referring explicitly to the present opposition. Moreover, the appellant filed an authorisation for its professional representative.

VI. The further submissions and evidence provided by the appellant can be summarised as follows:

(a) While Akzo Nobel N.V.'s policy was to file oppositions relating to the business of its affiliated companies in its own name, the policy of bioMérieux S.A. was to have such oppositions filed in the name of the respective affiliated company. When bioMérieux S.A. acquired Organon

Teknika B.V. from Akzo Nobel N.V., it was therefore decided that the opposition should be transferred to Organon Teknika B.V.

(b) The declarations submitted showed the clear *bona fide* intention of all persons involved in the transaction. There was no abuse of procedural rights involved.

(c) The fact that Akzo Nobel N.V. filed relevant patent applications after the effective date of the sale of Organon Teknika B.V. could be explained by their relationship to the veterinarian business or by the concern not to jeopardise priority rights.

(d) In the appeal proceedings T 746/00, where Akzo Nobel N.V. was originally one of the opponents, the change of opponent status to Organon Teknika B.V. and the name change to bioMérieux B.V. were duly registered. Therefore, in the present case, bioMérieux B.V. had legitimate expectations that the transfer of opposition was also proven to the satisfaction of the board.

VII. The submissions and evidence provided by the respondents can be summarised as follows:

(a) Opponent status may only be transferred in the limited circumstances of a universal succession in law or of a transfer of business to which the opposition relates. This followed from board of appeal case law (eg T 659/92, OJ EPO 1995, 519)

and from the Guidelines for Examination in the EPO (D-I.4).

(b) The present opposition was not an inseparable part of the business assets of Organon Teknika B.V., but belonged to Akzo Nobel N.V. The mere assertion that the opposition was always attached to the business of the subsidiary was not a valid basis for "correcting" at a later date the identity of the original opponent.

(c) Although Akzo Nobel N.V. owned the subsidiary company, it did not directly own the relevant business which was owned by the subsidiary.

(d) No ownership of business assets was transferred from Akzo Nobel N.V. to its subsidiary.

(e) Transfer of ownership of shares by Akzo Nobel N.V. to bioMérieux S.A. was not equivalent to a transfer of relevant business assets which remained in the possession of Organon Teknika B.V.

(f) Akzo Nobel N.V. had filed patent applications relating to diagnostics even after 30 June 2001, thereby showing a continuing commercial interest in this business field. This cast doubt on the substance of the declaration signed in June 2003. It was highly questionable whether all of the business assets of Akzo Nobel N.V. relevant to the opposition lay with Organon Teknika B.V. at the time of the alleged transfer of opposition.

(g) When filing the notice of appeal, the appellant could not have legitimate expectations of being recognised as opponent. In parallel case T 746/00 the registration of Organon Teknika B.V. as new opponent 03 was published only in January 2003.

(h) According to decision T 670/95 of 9 June 1998, transfer of opponent status had to be factually substantiated and proven. This had not happened in the present case. The declarations submitted were vague and mixed facts and law.

(i) The "precautionary" naming of Akzo Nobel N.V. as appellant did not lead to an admissible appeal since there was no basis in the EPC for such a conclusion. Rules 65(2) and 88 EPC were not applicable here. The naming of bioMérieux B.V. as appellant was clearly intentional, not a mistake.

(j) Moreover, the notice of appeal was not filed by a properly authorised representative.

VIII. On 29 July 2003 oral proceedings took place. Opponent 2, who has not made any submissions on the issue of admissibility of the appeal, did not attend.

IX. The appellant requested that the appeal be found admissible and to proceed in the name of bioMérieux B.V. (main request) or in the name of bioMérieux S.A. (first auxiliary request) or in the name of both bioMérieux B.V. and Akzo Nobel N.V. (second auxiliary request) or in the name of Akzo Nobel N.V. (third auxiliary request). The appellant also requested an apportionment of costs.

Furthermore, the appellant proposed that the following questions be referred to the Enlarged Board of Appeal:

1. Is the adversely affected party pursuant to Article 107 EPC the party that owns the opposition (ie the factually adversely affected party) or the party that is mentioned in the register to be party to the opposition proceedings?

2. If it is the factual party, then should Rules 20, 21 and 61 EPC apply?

3. Are there subsequent requirement(s) for the transfer of an opposition/appeal/status of a party on top of G 4/88, such as

   – evidence (submitting)

   – filing in register

   – transfer of opposition to another than the acquiring party

   – owner of assets/party filing the opposition?

4. Should the evidence be contested by a party or the board, is submitting auxiliary evidence possible?

X. The respondents requested that the appeal be rejected as inadmissible. They also requested an apportionment of costs.

Furthermore, the respondents proposed that the following questions be referred to the Enlarged Board of Appeal:

1. Does Rule 20 EPC apply to the recordal of changes in the identity of an opponent or opponent/appellant?

2. Under what circumstances can a declaration signed on behalf of transferor and transferee of business assets to which an opposition relates be taken to be sufficient evidence to prove the transaction?

3. What legal standard should the board apply when considering sufficiency of the evidence of transfer of business assets to which an opposition relates? Is it "balance of probabilities" or "beyond reasonable doubt"?

4. If documentary evidence filed to prove transfer of business assets to which an opposition relates is found to be insufficient, is this a deficiency that can be remedied by filing further evidence?

5. Is there a legal presumption in favour of a transferee of a business to which an opposition relates or is the legal *onus* on the transferee to prove its status?

6. In order to avoid a rejection of an appeal by an opponent under Rule 65(1) EPC, is it a requirement that any change in identity of the opponent/appellant be recorded prior to the expiry of the period under Article 108 EPC?

7. Can the adversely affected party status of an opponent under Article 107 EPC be transferred freely or can it only be transferred in accordance with the principles of G 4/88 (OJ EPO 1989, 480)?

XI. At the end of the oral proceedings, the board announced that the debate was closed and that the decision would be issued in writing.

Reasons for the Decision

1. According to Article 107 EPC, the right to appeal a decision is restricted to the adversely affected party to the proceedings. If an appeal does not comply with Article 107 EPC, the board of appeal will reject it as inadmissible (Rule 65(1) EPC) unless the deficiency has been remedied before the relevant time limit laid down in Article 108 EPC.

1.1 In the present case, the notice of appeal explicitly stated that the appeal was filed by bioMérieux B.V. Thus, it has to be ascertained whether bioMérieux B.V. was a party to the opposition proceedings when the appeal was filed or at least when the time limit for filing the appeal expired.

1.2 The appellant claims opponent status based on the opposition filed by Akzo Nobel N.V. According to the appellant, the filing of this opposition was done in the interest of Akzo Nobel N.V.'s former wholly-owned subsidiary, Organon Teknika B.V., since the patent in suit related to the technical field of diagnostics and

since Akzo Nobel N.V had concentrated its diagnostic business in this subsidiary. Nevertheless, when the opposition was filed, only Akzo Nobel N.V. and not Organon Teknika B.V. acquired opponent status. This follows from decision G 3/97 of the Enlarged Board of Appeal (OJ EPO 1999, 245, points 2.1 and 2.2), according to which the opponent is the person who fulfils the requirements of the EPC for filing an opposition and there cannot be another "true" opponent apart from the formally authorised opponent. It is thus not possible to consider Organon Teknika B.V. as the original opponent (see also T 788/01 of 13 June 2003, point 2.3.1).

1.3 However, bioMérieux B.V. might have acquired opponent status due to a transfer of opposition from Akzo Nobel N.V. The appellant maintains that such a transfer occurred when Akzo Nobel N.V. sold and assigned its former wholly-owned subsidiary Organon Teknika B.V. to bioMérieux S.A. The argument is that due to this transaction the opposition against the patent in suit was transferred from Akzo Nobel N.V. to Organon Teknika B.V. which later changed its name into bioMérieux B.V. Thus, the alleged opponent status of bioMérieux B.V. depends on whether the substantive and formal requirements for a transfer of opponent status are fulfilled.

Substantive requirements for transfer of opponent status

2. The EPC does not contain any explicit provision relating to the substantive requirements for the transfer of opponent status. However, Rule 60(2) EPC stipulates that the opposition proceedings may be

continued even without the participation of the deceased opponent's heirs. Thus the EPC implicitly acknowledges that in case of death of an opponent, his opponent status is transmitted to the heirs (see G 4/88, point 4). This principle is also applied to other forms of universal succession, eg where a legal person merges into another one. Then the universal successor in law acquires the opponent status (see G 4/88, point 4; T 349/86, OJ EPO 1988, 345, point 4; T 475/88 of 23 November 1989, point 1; T 1204/97 of 11 April 2003, point 1.1).

2.1 It has been acknowledged that a transfer of opponent status may also occur in further circumstances. In decision G 4/88, the Enlarged Board of Appeal held that an opposition pending before the EPO could be transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition was filed. The Enlarged Board of Appeal explicitly reserved its position with respect to the more general question of whether an opposition could be transmitted or assigned independently of the existence of a legitimate interest.

2.2 In several subsequent decisions (see eg T 659/92, point 2; T 670/95, point 2; T 298/97, OJ EPO 2002, 83, points 7.1, 7.2 and 12.2; T 711/99, to be published in OJ EPO, point 2.1.5), the conditions under which the decision G 4/88 accepted a transfer of opponent status were regarded as indispensable. According to this case law, transfer of opponent status (outside universal succession cases) requires a transfer of the relevant business or part of it. Decision G 3/97 (point 2.2) lends some support to this case law since it considered

- as a supporting argument for its decision - that an opponent does not have a right of disposition over his status as a party.

2.3 It has to be examined whether the requirements as developed by the above case law are fulfilled in the present case, ie whether the business relating to the opposition was transferred from Akzo Nobel N.V. to Organon Teknika B.V.

2.3.1 According to the declarations signed by the representatives of Akzo Nobel N.V., bioMérieux B.V. and bioMérieux S.A., the agreement which became effective on 30 June 2001 was reached between Akzo Nobel N.V. and bioMérieux S.A. As a result of this agreement, all the shares of Organon Teknika B.V., formerly owned by Akzo Nobel N.V., were assigned to bioMérieux S.A.

2.3.2 It already appears doubtful whether the sale and the assignment of shares of a legally independent entity by a holding company to a third person can be regarded as the transfer of the **business** exercised by this entity. Even if the question were to be answered in the affirmative, the transferee of this business would *prima facie* have been bioMérieux S.A. and not Organon Teknika B.V. since the latter is not alleged to have been a party to the above agreement. Furthermore, it is difficult to see how Organon Teknika B.V. which already carried on the business diagnostics could have "newly" acquired this business by the transfer of its shares from its holding company to bioMérieux S.A. Thus, the board considers that the conditions required by the above case law are not met in the present case.

2.4 Nevertheless, the board takes the view that, from an overall perspective, the factual situation as alleged by the appellant is rather similar to the situation in which decision G 4/88 accepted a transfer of opponent status. If Organon Teknika B.V. had not been a separate legal entity, but a mere commercial division of Akzo Nobel N.V., the sale of this division would have been regarded as a transfer of the relevant business. The application of the above case law appears to make the transferability of opponent status depend on the corporate structure of the opponent: if a holding company files an opposition relating to the business of its legally separate affiliate, sale of this affiliate will not lead to a transfer of opponent status. If, however, a company files an opposition relating to the business of one of its commercial divisions, the sale of this division can give rise to a transfer of opponent status.

2.4.1 Such a different legal treatment of rather similar situations raises doubts as to the validity of the legal assumptions underlying the above case law. Thus, the board considers it appropriate to examine more closely these assumptions, ie the propositions

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

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

In doing so, the board starts from the premise that, in the absence of explicit provisions in the EPC, issues of procedural law should be resolved by taking into account general principles such as equal treatment, legal certainty and procedural efficiency and by considering the interests of the parties involved and of the general public.

2.5 Free transferability of opponent status?

2.5.1 *The principle of equal treatment:* It is a generally recognised principle that the parties to court proceedings have to be treated equally. This principle has to be strictly observed in opposition appeal proceedings before the EPO boards of appeal (see eg G 1/86, OJ EPO 1987, 447, points 13 to 15; G 9/91, OJ EPO 1993, 408, point 2). In particular, decision G 1/86 held that it would result in unjustifiable discrimination against the opponent if, in contrast to the patentee, his rights could not be re-established under Article 122 EPC in respect of failure to observe the time limit under Article 108, third sentence, EPC.

The board notes that the party status of the **proprietor** can be freely transferred, subject only to the formalities of Rule 20 EPC being complied with: if a European patent is transferred during opposition proceedings, the new patent proprietor entered in the register of patents takes the place of the previous patent proprietor both in the opposition and in the appeal proceedings (see T 656/98, OJ EPO 2003, 385, point 4.3). According to decision T 553/90 (OJ EPO 1993, 666, point 2.4) his entitlement may not even be questioned in these proceedings.

The board acknowledges that the situation of the proprietor is not completely congruous with that of the opponent. The transfer of party status from the old proprietor to the new proprietor presupposes the transfer of an industrial property right whereas no such property right is involved when opponent status is claimed to be transferred. However, it appears doubtful whether this distinction alone can justify substantially different procedural rules regarding the transferability of the respective party status. Limiting the transferability of opponent status may therefore amount to unequal treatment of parties.

2.5.2 *Legal certainty and efficiency of procedure:* Legal procedural certainty is generally regarded as a fundamental value of the procedure before the EPO (T 824/00, OJ EPO 2004, 5, point 6). Legal certainty *inter alia* demands that the EPO can rely on statements of the parties in proceedings (J 10/87, OJ EPO 1989, 323, point 12). In order to be able to do so, the EPO has to know reliably who the parties to the proceedings are. Furthermore, in order to ensure that opposition proceedings can be conducted expeditiously (see G 3/97, point 3.2.3), difficult and time-consuming investigations as to who the correct parties to the proceedings are should be avoided as far as possible.

Contrary to the view taken by the Technical Board of Appeal 3.3.7 in its decision T 711/99 (point 2.1.5(f)), this board considers that legal certainty and efficiency of procedure could be enhanced if opposition status were freely transferable. Opposition divisions and boards of appeal could then simply rely on

corresponding procedural statements of the old and of the new opponent without any need for further factual investigation or complex legal evaluation. This contrasts with the situation where the transfer of opponent status is made dependent on the fulfilment of certain substantive criteria, eg on the transfer of relevant business within the meaning of decision G 4/88. The case law illustrates that the task of ascertaining whether these criteria are met is not always easy (see eg T 659/92, points 3 to 3.3; T 298/97, point 7 to 7.8; T 9/00, OJ EPO 2002, 275, point 2(c)(dd)) and can prolong the proceedings considerably. Facts may have to be investigated and complex issues of contract law, company law or antitrust law may need to be decided. Since the EPO has to determine the identity of parties to the proceedings *ex officio*, complicated investigations might even be necessary where the patent proprietor does not object to the transfer of the opposition status.

2.5.3 *The interest of the opponent:* The circumstances which may cause an opponent to consider a transfer of his status to another person are various. They may, as in the present case, reflect business transactions affecting the economic interests of the opponent. It can be assumed that opponents do not normally seek a transfer of their status without having some valid reason for doing so. Thus, the board does not believe that free transferability of opponent status would entail a serious risk of fanciful or frivolous procedural behaviour of opponents.

It has been argued by the respondents that free transferability of opposition status could lead to a harmful trafficking in oppositions, ie that somebody might oppose European patents for the sole reason that he could later "sell" his opponent status to someone else. However, this scenario appears rather theoretical. Even if it cannot be excluded altogether, a similar result, though in a more concealed manner, might be achieved without transferability of opponent status: the "trafficker" may remain opponent, now under the sponsorship of a third person (see T 649/92, OJ EPO 1998, 97, point 2.6, discussing the possibility of hidden "real" opponents).

2.5.4 *The interest of the proprietor:* The board takes the view that in all cases where a transfer of opposition status is accepted the new opponent will not have a better procedural position than the old opponent. If eg the opposition proceedings are at a stage where a new ground for opposition raised by the old opponent could not be admitted, the new opponent will also be precluded from raising this ground. This contrasts with the position of a third party who files an intervention pursuant to Article 105 EPC (see G 1/94, OJ EPO 1994, 787, point 13).

It is therefore difficult to see how the transfer of opposition status can have a negative effect on the procedural position of the proprietor. Even in the exceptional situation that the old opponent has to expect a negative cost decision pursuant to Article 104(1) EPC, the transfer does not jeopardise the rights of the proprietor: an apportionment of costs may still be ordered, if necessary, also against the

original opponent (see decision T 789/89, OJ EPO 1994, 482, point 2.6, according to which an opponent who withdraws his opposition leaves his party status unaffected in so far as the question of apportionment of costs is at issue).

It may be argued that the transfer of opponent status enhances the risk of a patent proprietor being suddenly confronted with an opponent having more financial and legal resources than the original opponent. However, the proceedings before the EPO are not conceived to provide a guarantee against such a risk in general. This is shown eg by the recognition of transfer of opponent status in case of a merger (see point 2 above). Besides, a risk of this kind is incurred by the **opponent** due to the free transferability of the party status of the **proprietor** (see point 2.5.1 above).

2.5.5 *The interest of the public:* The opposition procedure under the EPC is designed as a legal remedy in the public interest which gives any third party an opportunity to challenge the validity of a granted patent (G 9/93, OJ EPO 1994, 891, point 3; G 3/97, point 3.2.1 and 3.2.3). The Enlarged Board of Appeal has acknowledged the existence of a "public interest in each opposition being examined on its merits" (G 3/97, point 3.2.3). This interest may be jeopardised if opposition status could only be transferred under exceptional circumstances. There is a certain likelihood that an opponent who is not allowed to transfer his opponent status to another person in a situation where he wishes to do so may then simply withdraw his opposition or refrain from taking active part in the opposition proceedings. Both possible

consequences would weaken the public control function of the opposition procedure concerning the patent in suit.

2.5.6 *General principles of law:* Reference is sometimes made to a "general principle of law" (T 711/99, point 2.1.5) or to the "nature of a mere procedural status" (cf. German Bundesgerichtshof, GRUR 1968, 613, point II 2(c)) in order to justify restrictions on the transferability of opponent status. Indeed, it appears that for most court procedures it is not within the discretion of a party to transfer its status to another person and that a transfer will be accepted only under certain conditions (eg in German civil procedural law if the transfer is deemed appropriate by the court or consented to by the other party, cf. Baumbach et al., Zivilprozeßordnung, 60th ed., Munich 2002, § 263 point 5 ff.).

However, opposition proceedings before the EPO exhibit certain peculiarities which may support the argument that the party status of an opponent should be transferable more flexibly than party status in most other court proceedings. As stated above (point 2.5.1), the party status of the **proprietor** is freely transferable. Thus, restricting the transferability of opponent status may result in an imbalance of procedural rights of the respective parties. Furthermore, according to Article 99(1) EPC an opposition can be filed by **any** person. There is no requirement that an opponent has to show an interest, of whatever kind, in invalidating the opposed patent (G 3/97, point 3.2.1; T 590/93, OJ EPO 1995, 337, point 2). The EPC legislator appears to have chosen

this unlimited approach with respect to the **original acquisition** of opponent status in order to safeguard the public interest in the possible control of a granted patent. It may therefore be asked whether a similar approach is not also appropriate in the context of the issue of **"derivative" acquisition**, ie transfer of opponent status.

2.6 Broadening the finding in decision G 4/88?

If, contrary to the arguments put forward under point 2.5 above, opponent status were not to be considered as freely transferable, the further question arises whether the conclusions reached by the Enlarged Board of Appeal in decision G 4/88 have to be considered as a narrow exception valid only for the situation where the original opponent transfers the relevant business or whether they should be applied *mutatis mutandis* to a situation where the original opponent has transferred a 100% subsidiary to whose business the opposition relates.

2.6.1 The board is of the opinion that both situations are very similar in respect of the interests involved (see point 2.4 above). In both cases, due to a major business transaction, the original opponent has a legitimate interest in transferring the opposition. It is true that in the second situation, in contrast to the first situation, the opposition could have been directly filed on behalf of the subsidiary to whose business the opposition relates (see decision T 711/99, point 2.1.3, which regarded this difference as essential). However, it does not seem appropriate to consider the decision to file the opposition on behalf

of the holding company as *prima facie* unreasonable, let alone as vexatious. Such a decision may be taken for good reasons, eg to simplify the matter for the central patent unit within the holding company or to make it possible for employees of the holding company to conduct the opposition proceedings before the EPC, since the EPC Implementing Regulations do not provide for the possibility foreseen in Article 133(3), second sentence, EPC (see T 298/97, point 4.2). If later the close legal and economic connection which existed between the holding company and its subsidiary when the opposition was filed ceases to exist, the holding company normally loses its interest in the opposition. The breaking up of the ties between an opponent and its relevant subsidiary appears to be comparable to the transfer of relevant business assets. Accepting the transfer of opponent status avoids in both situations a splitting-off of opponent status, on the one hand, and relevant business assets, on the other, between legally and economically unrelated companies.

2.6.2 There is support for the proposition that the legal and economic ties between a holding company and its subsidiary are of importance for the issue of transfer of opponent status. According to the Guidelines for Examination in the EPO (D-I.4), "acquiring companies may also take over oppositions filed by acquired companies" (German version: "Zulässig ist auch der Eintritt der Hauptgesellschaft in die Einsprechendenstellung der eingegliederten Gesellschaften." French version: "Est également possible la subrogation de la société mère aux sociétés affiliées dans la qualité d'opposant."). If, thus, the establishment of corporate ties between two companies

may give rise to a transfer of opponent status (see also decision of the German Bundesgerichtshof, GRUR 1968, 613, point II.2(f)), it appears plausible that the dissolution of these ties may also lead to a transfer of opponent status (see German Bundespatentgericht, Bl.f.PMZ 1991, 245).

2.7 Given the foregoing considerations (points 2.5 and 2.6), the board is inclined to accept a transfer of opponent status when the original opponent sells and assigns a subsidiary to whose business the opposition pertains. However, in view of the divergent case law of the boards of appeal, in particular in view of decision T 711/99, it is necessary to refer this question to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC (see No. 1 of the Order below).

3. *Formal requirements for transfer of opponent status*

3.1 *General:* The EPC does not contain any explicit provisions regarding the formal requirements for the transfer of opponent status. Notwithstanding its broad title ("Registering a transfer"), Rule 20 EPC only deals with the transfer of European patent applications and, *mutatis mutandis*, of European patents during the opposition period or during opposition proceedings (Rule 61 EPC). Nevertheless, it may be argued that the formal scheme provided for in Rule 20 EPC reflects a principle capable of being generalised and should, as far as possible, also be applied to requests for the transfer of oppositions.

As is clear from its paragraphs (1) and (2), Rule 20 EPC is primarily concerned with registering a transfer in the European Patent Register. However, its paragraph 3 has further important implications: a transfer of the patent application or of a patent shall have effect vis-à-vis the EPO only when and to the extent that documents satisfying the EPO that the transfer has taken place have been produced. This provision appears to make the acquisition of party status as applicant or proprietor in ongoing patent grant or opposition proceedings dependent on the formal requirement of documentary proof.

3.2 *Competence:* Irrespective of a possible application of Rule 20(3) EPC by analogy to the transfer of oppositions, the decision as to whether an alleged opponent has party status or not falls within the exclusive competence of the organ, ie opposition division or board of appeal, before which the opposition proceedings are pending. The decision neither presupposes that the name of the alleged new opponent has already been entered in the European Patent Register, nor is it precluded by a diverging previous entry made in the Register on an administrative basis. This view is in line with previous case law (see T 799/97 of 4 July 2001, point 3.2(a); T 602/99 of 21 November 2003, section VIII; T 854/99 of 24 January 2002, point 1.5; T 9/00, point 1(e)(bb)). It is also noted that the name of the opponent is not mentioned in the list of necessary entries under Rule 92(1) EPC or in any of the notices of the President of the EPO under Rule 92(2) EPC.

3.3 *Request and evidence:* In the present case, the notice of appeal contained information relating to the alleged transfer of opposition as well as an attached declaration signed by representatives of Akzo Nobel N.V., bioMérieux B.V. and bioMérieux S.A. However, the declaration did not explicitly refer to the present opposition. Further documentary evidence, including a declaration referring to the present opposition, was only submitted after the expiry of the appeal time limit.

Formal requirements for an alleged transfer of opponent status depend, at least to some extent, on its substantive requirements. If oppositions were freely transferable (point 2.5 above), the formal requirements could already be regarded as fulfilled by corresponding procedural statements of the original and the new opponent filed or made before the competent organ of the EPO. Further documentary proof would then be unnecessary.

If, however, the transfer of opponent status is accepted only under specific circumstances (including the sale and assignment of shares of a wholly-owned subsidiary to whose business the opposition relates; see above, point 2.6), the formal and evidentiary requirements may be more difficult to comply with. In this context, the question arises whether, by analogy with Rule 20(3) EPC, the alleged new opponent has to provide full documentary evidence for the facts justifying the transfer and whether a failure to do so within the appeal time limit makes an appeal by the new opponent inadmissible.

Several decisions of the boards of appeal have embraced the view that, for the purposes of EPO proceedings, the effective date of the transfer of opposition status had to be taken as the date the transfer was requested at the EPO and adequate evidence provided. Until that date the original opponent remained a party to the proceedings so that an appeal filed before in his name was considered admissible and an appeal filed before in the name of the alleged new opponent inadmissible (T 1137/97 of 14 October 2002, points 1 and 4; T 870/92 of 8 August 1997, points 2 and 3.1; T 670/95, point 2). These formal requirements for accepting a change of opponent status were considered to be conducive to procedural certainty as to who the appropriate parties were (T 1137/97, point 4).

However, other decisions accepted, or were at least prepared to accept, later-filed evidence for the transfer of an opposition. For example, in decision T 563/89 (section IV and point 1.1.) an appeal which was filed by the alleged new opponent was held admissible although a copy of the relevant contract of sale was submitted only after expiry of the appeal time limit. In decision T 298/97 (see section VIII and points 7.3 and 7.7) the appellant was given ample opportunity long after expiry of the time limits under Article 108, third sentence, EPC to submit evidence for a transfer of the opposition. Only since the requested evidence was not regarded as sufficient, the appeal was held inadmissible.

The above survey of board of appeal case law and of the different solutions adopted shows the need to refer the question set out under No. 2 in the Order below to the

Enlarged Board of Appeal. In the board's view, for a proper consideration the following points may be taken into consideration:

– The formal requirement set out in Rule 20(1) and (3) EPC appears to be well-suited to *ex parte* proceedings aimed at registering a transfer. It appears less suited to *inter partes* proceedings where facts may be either contested or consented to by the other party.

– Article 117(1) EPC contains a non-exhaustive list of means of giving or obtaining evidence. No means is considered to be *a priori* more conclusive than any other. The principle of free evaluation of evidence applies (see eg T 482/89, OJ EPO 1992, 646, points 2.1 and 2.2). If Rule 20(1) and (3) EPC were applied by analogy to the transfer of opponent status, a conflict with Article 117(1) EPC may arise.

4. *Admissibility of appeal in view of subsidiary request in notice of appeal*

4.1 If bioMérieux B.V. were not to be considered as a person entitled to appeal for the purposes of Article 107 EPC, a further issue would arise in view of the auxiliary request contained in the notice of appeal. Although the notice was explicitly filed on behalf of bioMérieux B.V., it also stated that, subsidiarily and as a precautionary measure only, in the event that the appeal in the name of bioMérieux B.V. were to be considered inadmissible, the appeal was filed in the name of Akzo Nobel N.V.

4.2 It is thus apparent from the notice of appeal that the representative of the original opponent and of the alleged new opponent was uncertain about the person entitled to appeal. This uncertainty even seems to have increased later since, in the oral proceedings, the representative requested that the appeal should proceed in the name of bioMérieux B.V. (main request) or in the name of bioMérieux S.A. (first auxiliary request) or in the name of both bioMérieux B.V. and Akzo Nobel N.V. (second auxiliary request) or in the name of Akzo Nobel N.V. (third auxiliary request).

4.3 It is a generally accepted principle of proceedings before the EPO that the parties may file auxiliary ("subsidiary") requests (see eg T 234/86, OJ EPO 1989, 79, point 5.5.1; T 5/89, OJ EPO 1992, 348, point 2.2). This principle also applies to appeal proceedings. However, an exception prevails where the appeal itself is filed as a subsidiary request. Decision J 16/94 (OJ EPO 1997, 331) dealt with a case where the applicant had filed a main request for re-establishment of rights to be considered by the first-instance department and, as a (second) auxiliary request, a notice of appeal. The Legal Board of Appeal considered this appeal inadmissible since it did not express the definite (but only a conditional) intention of a party to appeal. In decision T 854/02 of 14 October 2002 the opponent had filed an appeal which was made conditional on an appeal by the proprietor and on the positive assessment of an admissibility requirement by the board of appeal. The appeal was held inadmissible.

4.4 The factual circumstances dealt with in decisions J 16/94 and T 854/02 are not identical with the present situation where it may be argued that the appeal as such was unconditional and that the subsidiary request (for which no separate appeal fee was paid) only concerned the person to be treated as appellant. It may therefore be questioned whether the rationale underlying decisions J 16/94 and T 854/02 should also be applied in the present circumstances.

4.5 Moreover, the subsidiary request in the notice of appeal may also be interpreted as a conditional request for correction of the name of the appellant. Rule 64(a) EPC prescribes that the notice of appeal must contain the name and the address of the appellant. If the appeal does not comply with Rule 64(a) EPC, such a deficiency can be remedied at the invitation of the board of appeal, even after expiry of the time limit for filing the appeal (see Rule 65(2) EPC).

Board of appeal decisions have taken the position that there is a deficiency within the meaning of Rule 65(2) EPC not only when **no** such express indications at all are made in the notice of appeal but also when **incorrect** indications are made (T 340/92 of 5 October 1994, point 1; T 1/97 of 30 March 1999, point 1.4; T 97/98, OJ EPO 2002, 183, point 1.3; the same view was held in decision T 715/01 of 24 September 2002, point 10, with respect to the statement of grounds of appeal). It was also accepted that correction of the deficiency may then lead to a different natural or legal person to the one indicated in the notice of appeal (T 97/98, point 1.3). Decision T 97/98 considered it inappropriate, if not contradictory, not

to allow the name of the appellant to be substituted in such cases if, under Rules 64(a) and 65(2) EPC, the complete lack of indications can be remedied even after expiry of the time for filing the appeal.

4.6 The conclusions reached in the above cited decisions have been restricted to those situations where the incorrect naming of the appellant was due to a mistake. It is considered necessary for the existence of a deficiency that the indication is wrong, so that its correction does not reflect a later change of mind as to whom the appellant should be, but on the contrary only expresses what was intended when filing the appeal (T 97/98, point 1.3). In decision T 656/98 (point 7) no scope was seen for the application of Rule 65(2) EPC when the appeal is deliberately filed in the name of the non-registered assignee of the patent in suit. The conditions for a correction under Rule 65(2) EPC are thus regarded to be similar to the conditions for a correction under Rule 88 EPC. In fact, the latter provision has also been applied in some board of appeal decisions where the appellant was wrongly named (see T 814/98 of 8 November 2000, point 1; T 460/99 of 30 August 2001, point 1).

4.7 The above-cited case law, as a whole, does not lend much support for the proposition that the deliberate naming of one appellant combined with the subsidiary naming of another appellant may be regarded as a correctable deficiency under Rule 65(2) EPC. It appears that what was involved in the present case was not a factual mistake, but only uncertainty about the correct legal evaluation. Nevertheless, since this uncertainty was laid open in the notice of appeal by formulating

the subsidiary request, the board and the other parties were clearly aware of the intention to file an appeal on behalf of that legal entity which had the status of opponent 1 in the present opposition proceedings. It can therefore be argued that not to admit a correction of the name of the appellant under these circumstances would be overly formalistic and amount to undue hardship for an appellant who acted *bona fide*.

4.8 The issue presented above raises an important point of law since it touches on the interpretation of Article 107, first sentence, EPC, which is one of the basic requirements for the admissibility of an appeal. Pursuant to Article 112(1)(a) EPC, the board therefore decides to refer the question set out under No. 3 in the Order below to the Enlarged Board of Appeal.

5. *Relevance of referred questions for the outcome of the appeal proceedings*

5.1 The respondent has denied the admissibility of the present appeal with the further argument that the notice of appeal was not filed by a properly authorised representative. However, in view of the authorisation of the current representative filed by letter dated 27 June 2003, the board does not consider this challenge to be persuasive.

5.2 The appellant maintains that the registration of bioMérieux B.V. as new opponent in the appeal proceedings T 746/00 led to the legitimate expectation that the transfer of opposition was proven. However, it follows from the appeal file T 746/00 and the corresponding entries in the European Patent Register

that the transfer of opponent status in those proceedings had not yet been registered when the notice of appeal was filed in the present case. Furthermore, the decision as to whether an alleged opponent has party status in appeal proceedings must be taken by the competent board of appeal independently of any entries in the Register (see point 3.2 above). Thus, the principle of protection of legitimate expectations cannot apply in the present case.

5.3 In view of the above, the board considers that the present case requires a decision of the Enlarged Board of Appeal on the questions set out in the Order below. Their wording was arrived at in the light of the proposals made by the appellant and the respondents (see sections IX and X above). The requests of the appellant and of the respondents for apportionment of costs will be dealt with in the final decision of this board.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal:

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

2. (b) If question 1(a) is answered in the negative: Can a legal person who was a 100%-owned subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed

patent relates acquire opponent status if all its shares are assigned by the opponent to another company and if the persons involved in the transaction agree to the transfer of the opposition?

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

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

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

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

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

The Registrar: The Chairwoman:

A. Townend U. Kinkeldey