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I N T E R L O C U T O R Y D E C I S I O N of 7 December 2004

Case Number: T 0085/03 - 3.3.3

Application Number: 97109582.3

Publication Number: 0812863

IPC: C08F 20/12

Language of the proceedings: EN

Title of invention:
Acrylic emulsions prepared in the presence of fully hydrolyzed poly(vinyl alcohol)

Patentee:
AIR PRODUCTS AND CHEMICALS, INC.

Opponent:
Clariant GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 107, 108

Keyword:
"Party entitled to appeal (yes)"
"Form of appeal - statement of grounds filed by entitled party (yes)"

Decisions cited:
T 0870/92, T 0670/95, T 0298/97, T 1137/97, T 0715/01

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0085/03 - 3.3.3

I N T E R L O C U T O R Y D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 7 December 2004

Appellant: (Opponent)
Clariant GmbH
Patente, Marken, Lizenzen
Am Unisys-Park 1
D-65843 Sulzbach (DE)

Representative:
Ackermann, Joachim, Dr.
Postfach 11 13 26
D-60048 Frankfurt am Main (DE)

Respondent: (Proprietor of the patent)
AIR PRODUCTS AND CHEMICALS, INC.
7201 Hamilton Boulevard
Allentown, PA 18195-1501 (US)

Representative:
Kador & Partner
Corneliusstrasse 15
D-80469 München (DE)

Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office dated 17 September 2002 and posted 6 November 2002 concerning maintenance of European patent No. 0812863 in amended form.

Composition of the Board:

Chairman: R. Young
Members: W. Sieber
R. Moufang

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 812 863, based on European patent application No. 97 109 582.3, was published on 15 September 1999 (Bulletin 1999/37). A notice of opposition was filed on 15 June 2000 by Clariant GmbH, requesting revocation of the patent in its entirety on the grounds of Article 100(a) and (b) EPC.

II. By an interlocutory decision which was announced orally on 17 September 2002 and issued in writing on 6 November 2002, the opposition division decided that the patent could be maintained in amended form based on Claims 1 to 18 filed by the proprietor during the opposition procedure.

III. On 15 January 2003, the opponent, Clariant GmbH, filed a notice of appeal against the above decision with simultaneous payment of the prescribed fee.

IV. On 10 March 2003, the professional representative Dr Ackermann filed the statement of grounds of appeal. In the same letter, the transfer of the opposition to Celanese Emulsions GmbH was requested. However, no evidence for the transfer was submitted with the grounds of appeal.

V. As evidence for the transfer of opposition, the representative filed on 2 April 2003 copies of the title page and pages 5, 7, 8, 14, 62 and 63 of a "Master Purchase and Sale Agreement" between Clariant International AG and Madionova GmbH of 26 September 2002 as well as an extract of the Handelsregister

Königstein/Ts. showing that Madionova GmbH had changed its name into Celanese Emulsions GmbH in November 2002.

VI. In a communication issued on 11 July 2003, the board informed the opponent that the documents filed so far were not sufficient to prove the alleged transfer of opposition. As the "Master Purchase and Sale Agreement" of 26 September 2002 was concluded between Clariant International AG and Madionova GmbH, it appeared doubtful as to whether the relevant business of the seller's affiliate Clariant GmbH (the opponent) was transferred to the purchaser by this agreement. Furthermore, the agreement mentioned a closing date on page 8 (in the context of the definition of the business of Clariant GmbH) although the pages filed so far did not give any indication when this closing date was.

VII. With a letter dated 7 October 2003, the representative submitted an excerpt (title page, pages 2, 5, 9) of an "Asset Purchase Agreement" between Clariant GmbH and Madionova GmbH to prove the transfer of the relevant business of the original opponent, Clariant GmbH, to Madionova GmbH (now Celanese Emulsions GmbH).

VIII. On 4 August 2004, the parties were summoned to attend oral proceedings to deal with the admissibility of the appeal. The salient issues were identified by the board as being firstly, whether Clariant GmbH was entitled to file the notice of appeal since it had already transferred the relevant business before filing the notice of appeal, and secondly, whether Celanese Emulsions GmbH which appeared to have filed the statement of grounds of appeal was entitled to do so.

IX. In a letter filed on 5 November 2004, the respondent requested that the appeal be rejected as inadmissible. When filing the statement of grounds of appeal, the representative Dr Ackermann had acted for Celanese Emulsions GmbH. Since, however, Celanese Emulsions GmbH had not produced evidence for the transfer of opposition within the time limit of Article 108 EPC, 3rd sentence, the statement of grounds of appeal was not filed by an entitled party. Therefore, the appeal was not admissible.

With respect to transfer of opponent/appellant status, the respondent requested, as an auxiliary request, that the following five questions be referred to the Enlarged Board of Appeal:

(1) Which formal requirements are necessary for the transfer of the status of opponent/appellant?

(2) In particular, are Rule 20 EPC and Rule 61 EPC to be applied analogously for the transfer of the status of opponent/appellant?

(3) If question 2 is answered to the affirmative, is it a consequence for an admissible appeal that according to Rule 65(1) EPC in connection with Article 108 EPC that the transfer of rights shall have effect vis-à-vis the Board of Appeal only when documents have been produced satisfying the Board of Appeal?

(4) Shall a record in the European Patent Register be requested?

(5) Shall similar standards of evidence be applied for the proof of the transfer of opponent/appellant status as already established for the transfer of patent applications and patents (cf. Guidelines Part E, Chapter XIII, Point 1)?

X. In a letter filed on 8 November 2004, the appellant requested to confirm that the appeal was admissible, since both the notice of appeal and the statement of grounds of appeal were filed in the name of Clariant GmbH, ie the original opponent. To substantiate its argumentation, an authorisation from Clariant GmbH to Dr Ackermann dated 6 March 2003 was submitted.

XI. In a letter filed on 23 November 2004, the respondent requested that the authorisation submitted on 8 November 2004 not be considered by the board since it was late filed.

XII. On 7 December 2004, oral proceedings were held before the board.

The respondent basically relied on its written submissions filed on 5 November 2004 and 23 November 2004. In particular, it took the position that the only reasonable understanding of the statement of grounds of appeal could be that the representative Dr Ackermann had acted for Celanese Emulsions GmbH which, however, was not a party to the proceedings. Consequently, the appeal was not admissible. As regards the representative's authorisation, this document should not be considered because it was filed after the time

limit set by the board in the annex to the summons to oral proceedings and appeared to change the legal situation completely. In any case, according to the general principles of law, the statement of grounds of appeal had to be interpreted at the time of receipt at the EPO when no authorisation was on file. To support the latter argument, the respondent filed document D5, which was admitted into the proceedings:

D5: Excerpt from Palandt, Bürgerliches Gesetzbuch, 62nd edition, pages 114 and 115.

The representative of the appellant argued that the authorisation was filed within the time limit set by the board. Furthermore, it was clear from the statement of grounds of appeal itself that he had acted for Clariant GmbH when filing the statement of grounds of appeal. As an auxiliary motion, he requested that the five questions submitted by the respondent in the letter dated 5 November 2004 be referred to the Enlarged Board of Appeal.

XIII. The appellant requests that the appeal be held admissible (main request) or, in the alternative, that the five questions submitted by the respondent in the letter dated 5 November 2004 be referred to the Enlarged Board of Appeal (auxiliary request).

The respondent requests that the appeal be rejected as inadmissible (main request) or, in the alternative, that the five questions submitted in the letter dated 5 November 2004 be referred to the Enlarged Board of Appeal (auxiliary request).

Reasons for the Decision

1. According to Article 107 EPC, 1st sentence, any party to proceedings adversely affected by a decision may appeal. In the present case, Clariant GmbH, which was the opponent before the first instance and against which the decision to maintain the patent in suit in amended form was issued, filed the notice of appeal although it had, as demonstrated in the appeal proceedings later, already sold the relevant business to another company when filing the appeal. However, according to established case law, the "original" opponent retains its rights and obligations for the purpose of European Patent Office (EPO) proceedings as long as the transfer of the opposition has not been requested at the EPO and no adequate evidence has been provided (eg T 870/92 of 8 August 1997, point 3 of the reasons; T 670/95 of 9 June 1998, point 2 of the reasons; T 1137/97 of 14 October 2002, points 1 to 7 of the reasons; none of the decisions published in the OJ EPO). Since neither a request for transfer of the opposition nor evidence proving such transfer had been filed at the EPO, Clariant GmbH was still, for the purpose of EPO proceedings, the opponent entitled to file the appeal. Hence, the requirements of Article 107 EPC are met.

2. The last sentence of Article 108 EPC requires that a statement of grounds of appeal must be filed within four months after the date of notification of the decision appealed from. Although that sentence does not indicate by whom the statement of grounds of appeal has to be filed, the logical course of action would require that this be the same party filing the notice of appeal

(eg T 298/97, OJ EPO 2002, 83, point 1 of the reasons and T 715/01 of 24 September 2002, point 2 of the reasons; not published in the OJ EPO), or, if a transfer took place in the meantime, by the transferee of opposition.

2.1 In the present case, the letter containing the statement of grounds of appeal was not filed by Clariant GmbH, as the notice of appeal, but by the professional representative Dr Ackermann. Since the letter also contains a request for transfer of the opposition status from Clariant GmbH to Celanese Emulsions GmbH but no explicit statement for which company the representative is acting, it is not immediately evident from that letter whether the representative acts for the "original" opponent, ie Clariant GmbH, or already for the "new" opponent, ie Celanese Emulsions GmbH. However, when the time limit under Article 108 EPC, last sentence, expired no documents proving the transfer of the opposition to Celanese Emulsions GmbH had been submitted (section IV, above) so that the above-mentioned requirements for a transfer of opposition, namely request and adequate evidence, were not fulfilled when the statement of grounds of appeal was filed. Thus, if the statement of grounds of appeal were indeed filed on behalf of Celanese Emulsions GmbH, the question of admissibility of the appeal would arise since it may be questioned whether the statement of grounds of appeal was filed by a party to the proceedings.

2.2 Hence, the decisive question relating to the admissibility of the present appeal is in which name the statement of grounds of appeal has been submitted.

Since there is no explicit statement on this matter in the statement of grounds of appeal, the board has to interpret the content of this document.

2.2.1 The opening paragraphs of the statement of grounds of appeal filed on 10 March 2003 read as follows:

> *"Sehr geehrte Damen und Herren,*
> *hiermit wird die Vertretung für die Einsprechende und Beschwerdeführerin angezeigt.*
>
> *Ferner wird zu dieser Beschwerde mitgeteilt, dass die Einsprechende in der Zwischenzeit umfirmiert hat. Der den Gegenstand dieses Einspruchs betreffende Geschäftsbetrieb der Clariant GmbH ist verkauft worden und firmiert jetzt als Celanese Emulsions GmbH mit Sitz in Kronberg, Handelsregister Königstein/Ts., HRB 5322. Es wird daher beantragt, die Einsprechende und Beschwerdeführerin entsprechend umzuschreiben."*
> *…*
> *Nachfolgend wird nunmehr zu der am 14 Januar 2003 erhobenen Beschwerde, die sich gegen die Entscheidung der Einspruchsabteilung vom 06.11.2002 über den Einspruch gegen das oben genannte Patent (nachstehend kurz als "Streitpatent" bezeichnet) richtet, die Beschwerdebegründung im Sinne von Artikel 108 EPÜ überreicht.*

2.2.2 It is conspicuous to the board that the first sentence where the representative indicates that he is acting for the opponent and appellant contains neither an explicit reference to Celanese Emulsions GmbH nor any implicit connection to the next paragraph where Celanese Emulsions GmbH is mentioned for the first time. Thus, the board agrees with the appellant that this self-contained statement of the first sentence does not

add up to a statement to represent Celanese Emulsions GmbH. Moreover, the terms "opponent and appellant" have to be interpreted, in the absence of any other explicit or implicit context, as referring back to Clariant GmbH which filed the notice of appeal.

2.2.3 The second paragraph of the statement of grounds of appeal requesting the transfer of the opposition does not invalidate the interpretation of the first sentence since both passages relate to different procedural steps. On the one hand, the first sentence relates to the presentation of a new representative whereby his procedural action has relations to the past of the opposition appeal proceedings with Clariant GmbH as the appealing party. On the other hand, the second paragraph relates to the future of the opposition appeal proceedings with Celanese Emulsions GmbH as the "new" opponent/appellant.

2.2.4 This interpretation of the statement of grounds of appeal is also supported by the authorisation (EPO Form 1003), filed by the appellant in response to the communication of the board and admitted into the proceedings. This document, dated 6 March 2003, authorises Dr Ackermann to represent Clariant GmbH. Furthermore, this authorization predates the filing of the statement of grounds of appeal (10 March 2003) which makes it abundantly clear that the statement of grounds of appeal was indeed filed in the name of Clariant GmbH and that nothing else was ever intended.

As regards the authorisation, the respondent argued that it was filed late and should therefore not be considered by the board. However, the authorisation

filed by the appellant on 8 November 2004 was not late-filed as alleged by the respondent. It was filed in reply to a communication of the board where the final date for making any written submissions in preparation of the oral proceedings was fixed at one month before the oral proceedings. Since the final date, ie 7 November 2004, fell on a Sunday and the authorisation was filed on Monday 8 November 2003, ie the first day after the final date on which all filing offices were open for receipt of documents and on which ordinary mail was delivered, the board accepts that the authorisation was filed in time (in analogy to Rule 85(1) EPC). Consequently, the board cannot exclude the authorisation from consideration.

Furthermore, the respondent argued that the authorisation could not be used to interpret the ambiguous statement of grounds of appeal since, according to general principles of law (eg D5), the statement of grounds of appeal had to be interpreted at the time when it was received at the EPO, ie when no authorisation was on file. In this context, the board notes that an authorisation filed at a later stage of the proceedings can be considered by the EPO to clarify an ambiguous situation concerning a professional representative's entitlement to act. This is apparent from Article 1(3) of the Decision of the President of the European Patent Office dated 19 July 1991 of the filing of authorisations (OJ EPO 1991, 489) where it is stated that "[t]he European Patent Office may require that an authorisation be produced if the circumstances of a particular case necessitate this, particularly in case of doubt as to the professional representative's entitlement to act." It may therefore be argued that a

late filed authorisation may also be used for clarification purposes in a situation of doubt as to whether a previously filed document was submitted on behalf of a certain person. However, the board does not need to decide this question since the authorisation is not decisive for the interpretation of the statement of grounds of appeal in the present case. Even without taking the authorisation into account, the interpretation of the statement of grounds of appeal is that it has been filed in the name of Clariant GmbH (sections 2.2.1 to 2.2.3). The authorisation supports this interpretation but does not change the legal view on the statement of grounds of appeal as argued by the respondent.

2.2.5 Nevertheless, the respondent took the position that the only reasonable understanding of the statement of grounds of appeal must be that the representative Dr Ackermann acted in the name of Celanese Emulsions GmbH which, when filing the statement of grounds of appeal, was not a party to the proceedings. Since, furthermore, Celanese Emulsions GmbH failed to provide adequate evidence for the transfer of opposition within the time limit of Article 108 EPC, 3rd sentence, the appeal was not admissible.

However, the board cannot accept this line of argumentation because a careful and objective analysis of the statement of grounds of appeal leaves no doubt that the statement of grounds of appeal was filed in the name of Clariant GmbH, ie the entitled person (sections 2.2.1 to 2.2.4, above).

2.2.6 In summary, the statement of grounds of appeal has to be interpreted as being filed in the name of Clariant GmbH, ie the party entitled to appeal.

3. Thus, the opponent's appeal complies with Articles 106 to 108 EPC and Rule 64 EPC and is therefore admissible.

4. As the board decided that the statement of grounds of appeal was filed in the name of Clariant GmbH, ie the "original" opponent, the issue of transfer of opposition is irrelevant to the question as to whether or not the present appeal is admissible. Therefore, there is no basis for the board to refer the questions concerning such a transfer of opposition to the Enlarged board of Appeal.

Order

For these reasons it is decided that:

1. The appeal is admissible.

2. The procedure will be continued in writing.

The Registrar: The Chairman:

E. Görgmaier R. Young