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**Datasheet for the decision
of 10 October 2008**

Case Number: T 1081/06 - 3.3.03

Application Number: 97941901.7

Publication Number: 0942936

IPC: C08F 2/00

Language of the proceedings: EN

Title of invention:

Build-up suppressor agents, compositions containing them and method of use in polymerization processes

Patentee:

3V SIGMA S.p.A.

Opponent:

Akzo Nobel N.V.

Headword:

-

Relevant legal provisions:

EPC Art. 107

Relevant legal provisions (1973):

EPC R. 101

Decision of the President of the EPO dated 19 July 1991 on the filing of authorisations

Keyword:

"Purported new opponent a party to the proceedings - yes"

"Admissibility of purported new opponent's appeal - yes"

"Validity of transfer of opponent status - no"

"Sub-authorisations of professional representative - yes"

Decisions cited:

G 0004/88; G 0002/04; T 0382/03; T 1178/04

Catchword:

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Case Number: T 1081/06 - 3.3.03

DECISION
of the Technical Board of Appeal 3.3.03
of 10 October 2008

(Opponent) Akzo Nobel N.V.
Velperweg 76
NL-6824 BM Arnhem (NL)

Representative: -

Respondent: 3V SIGMA S.p.A.
(Patent Proprietor) Piazza Principessa Clotilde, 6
I-20121 Milano (IT)

Representative: Minoja, Fabrizio
Bianchetti Bracco Minoja S.r.l.
Via Plinio, 63
I-20129 Milano (IT)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 26 May 2006
rejecting the opposition filed against European
patent No. 0942936 pursuant to Article 102(2)
EPC 1973.

Composition of the Board:

Chairman: R. Young
Members: M. C. Gordon
E. Dufrasne

Summary of Facts and Submissions

- I. Mention of the grant of European Patent No. 0 942 936 with the title "Build-up suppressor agents, compositions containing them and method of use in polymerization processes" in the name of 3V Sigma S.p.A. in respect of European patent application No. 97941901.7, filed on 29 July 1997 as international application No. PCT/EP97/04098, published as WO-A-98/24820 on 11 June 1998, and claiming a priority date of 4 December 1996 from Italian patent application IT MI96A002548, was announced on 18 October 2000 (Bulletin 2000/42) on the basis of 15 claims.
- II. A notice of opposition to the patent was filed on 10 July 2001 by CIRS S.p.A.
- III. By a letter dated 11 November 2003 the EPO was informed that the opponent was now Akzo Nobel N.V. Two documents were submitted in support of this transfer:
- A first document entitled (in the English language translation provided) "SHARE PURCHASE AND SALE AGREEMENT made in Padova, Italy, dated as of March 13, 2003" according to which all shares in CIRS S.p.A. had been purchased by Akzo Nobel Chemicals International B.V.;
 - A second document, dated 30 October 2003 certifying that Akzo Nobel Chemicals International B.V. was a wholly-owned subsidiary of Akzo Nobel N.V.

- The EPO issued a "Communication of Amended Entries" (EPO Form 2757 11.98) on 2 December 2003, recording Akzo Nobel N.V. as the opponent.
- IV. By a decision, taken without oral proceedings and dated 26 May 2006, the opposition division rejected the opposition.
- V. A notice of appeal against this decision was filed by Akzo Nobel N.V. on 13 July 2006, the requisite fee being paid on the same day.
- VI. The statement of grounds of appeal was filed by Akzo Nobel N.V. on 25 September 2006.
- VII. The patent proprietor - now the respondent - replied with a letter dated 9 March 2007.
- VIII. On 25 July 2008 the Board issued a summons to attend oral proceedings, scheduled for 10 October 2008 which summons was accompanied by a communication expressing the preliminary, provisional view of the Board on the case.
- IX. By letter dated 9 September 2008 from the professional representative of the respondent/patent proprietor (representative Mr. B of company BBM) a sub-authorisation was given to professional representative Mrs. K of the company B&B. In the letter it was requested:
- "Please enter this sub-authorisation into the files of the above case, so that [Mrs. K] may act for this case as well as I do."

X. In a second letter of equal date of the respondent/patent proprietor, signed by the aforementioned Mrs. K, it was requested *inter alia* that the appeal be dismissed as inadmissible on the basis that:

- (a) The opposition had been filed in the name of CIRS S.p.A.
- (b) The letter of 11 November 2003 contained no further information about the fate of CIRS S.p.A. beyond that contained in the two documents filed with that letter (see section III above).
- (c) Based on the information and support filed the agreement constituted only a share deal, i.e. a change of ownership.
- (d) With reference to the conditions for transfer of an opposition set out in decision G 4/88 (OJ EPO 1989, 480) it was submitted that it had not been shown, or even argued, that by the share deal all assets of CIRS S.p.A. had also been transferred to Akzo Nobel Chemicals International B.V. Accordingly it was already not in line with the case law that the opposition division had accepted the transfer of the opposition to Akzo Nobel Chemicals International B.V.
- (e) Further, with regard to the transfer from Akzo Nobel Chemicals International B.V. to Akzo Nobel N.V. it had only been certified that Akzo Nobel Chemicals International B.V. was a wholly-owned subsidiary of Akzo Nobel N.V.
- (f) These were two different legal entities. Nothing had been filed in support of any transfer of any business assets of Akzo Nobel Chemicals International B.V. to Akzo Nobel N.V.

- (g) With reference to G 2/04 (OJ EPO 2005, 549) it was submitted that, even though the present situation was slightly different, it was clear that since there had been no transfer of assets whatsoever from Akzo Nobel Chemicals International B.V. to Akzo Nobel N.V., the opposition division should not have accepted the transfer of the status of opponent to Akzo Nobel N.V.
- (h) Since the appeal had been filed in the name of Akzo Nobel N.V., which entity had never validly obtained the status of opponent in the proceedings before the opposition division, the appeal had not been filed by a party to the proceedings, contrary to Art. 107 EPC.
- (i) Therefore the appeal should be dismissed as inadmissible.

XI. Oral proceedings were held before the Board on 10 October 2008.

- (a) The representative of Akzo Nobel N.V. submitted that Mrs. K had not been properly authorised and requested that Mrs. K's submissions be deemed not to have been made (compare sections IX and X above).
 - (i) In support of this request reference was made to "Enclosure 6" of a letter of 16 May 2005 (before the opposition division) in which professional representative Mr. M of the company BBM and named on the front of the patent gave a sub-authorisation to the aforementioned representative Mr. B of BBM, which representative was the signatory of the letter of 9 September 2008 giving sub-authorisation to Mrs. K.

- (ii) Further it was not normal or implicit that a representative having been sub-authorised could him/herself grant a further sub-authorisation. On the contrary general legal principles required that there be an explicitly stated right to issue a sub-authorisation. This would usually require marking an appropriate box on the form relating to the authorisation. No such indication existed in this case however as there was no box on the form entering the application into the regional phase before the EPO relating to the power to grant sub-authorisations. Thus there was no indication in the file that Mr. B was empowered to give sub-authorisations.
 - (iii) Reference was also made to the findings of T 382/03 of 20 July 2004 (not published in the OJ EPO) on the basis of which it was disputed that Mr. B had the right to sub-authorise Mrs. K.
- (b) The representative Mrs. K submitted that Mr. M of the firm BBM had been the named representative at the commencement of proceedings before the EPO. Mr. M and Mr. B were from the same firm of professional representatives, namely BBM, which firm had represented the patentee throughout the examination and opposition proceedings. Thus the letter relating to Mr. B acting as the professional representative (see section XI.(a).(i) above) was to be seen as information as to which member of the same firm was prosecuting the case but not as a sub-authorisation. Further there was

nothing on the file that indicated that the firm BBM to which Messrs. M and B belonged could not give sub-authorisations.

- (c) Following deliberation the Board announced its decision that representative Mrs. K had been correctly authorised to act for the respondent/patent proprietor.
- (d) With respect to the admissibility of the transfer of the opponent status and the admissibility of the appeal the respondent/patent proprietor essentially referred to the written submissions of 9 September 2008 (see section X above).
- (e) The representative of Akzo Nobel N.V. submitted that the appeal was admissible. It was conceded that the circumstances as presented by the patent proprietor in its written submission of 9 September 2008 with respect to the non-validity of the transfer of opponent status were correct. However the conclusions as to the consequences for the admissibility of the appeal were incorrect. Reference was made to T 1178/04 (OJ EPO 2008, 80), in which it had been held that even though a transfer of the opponent status had been incorrectly registered the transferee was nevertheless a party to the proceedings and hence the appeal was admissible. The correct means of redress, as set out in paragraphs 44ff of the reasons of said decision, was to set the decision under appeal aside and remit the case to continue with the original opponent or its legal successor. This was the only means available to the Board to correct the error. The representative further stated that all submissions made by Akzo Nobel N.V. had been inadmissible.

(f) Following an interruption of the oral proceedings to allow the respondent/patent proprietor to study T 1178/04 the respondent/patent proprietor submitted that it agreed with the reasoning thereof as far as point 43 of the reasons. However it could not concur with the conclusions from point 44 onward. In G 2/04 (*supra*) there had been an auxiliary request for the proceedings to be continued with the original opponent. No such auxiliary request had been made either in the case underlying T 1178/04 or in the present case. Once the appeal period had expired - as it had in the present case - there was no further right to appeal.

It was submitted that the situation in the case in suit differed from that in T 1178/04 in an important respect: In the case underlying decision T 1178/04 the original opponent still existed. In contrast, in the case in suit the fate of CIRS S.p.A. was not known and thus it was not known who was the legal successor. The request of Akzo Nobel N.V. was unclear in this respect and as a consequence had to be refused.

Further there were serious doubts in view of G 2/04 (*supra*) concerning the legality of the transfer from Akzo Nobel Chemicals International B.V. to Akzo Nobel N.V. The opponent could and should have made an auxiliary request concerning the identity of the opponent, as had been done in the case underlying decision G 2/04 (see part II of the facts and submissions thereof).

XII. The appellant (opponent) requested that the submissions by the firm B&B (Mrs. K) be deemed not to have been

made or, in the alternative, that the case be remitted to the opposition division and that the opposition be continued with the original opponent or its legal successor.

The respondent (patent proprietor) requested that the appeal be dismissed as inadmissible, or, in the alternative, that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or on the basis of one of the auxiliary requests 1 to 3, in that order, all filed with letter dated 9 September 2008.

Reasons for the Decision

1. As is apparent from the foregoing, the admissibility of the appeal has been challenged on behalf of the respondent/patent proprietor by a professional representative whose authorisation to act has in turn also been challenged. Accordingly the first matter to be considered is the entitlement of Mrs. K to act for the respondent/patent proprietor.
2. *Authorisation of Mrs. K to act for the respondent/patent proprietor*
 - 2.1 The applicant and later the patent proprietor has been represented since the filing of the underlying PCT application by the same firm of professional representatives, namely BBM. This is apparent from the data on the front page of the PCT publication, the information on the EPO Form "1200 12.96" on file, dated 20 May 1999 concerning entry into the regional phase

before the EPO and the remaining correspondence during the examination and opposition procedures. The aforementioned form "1200 12.96" named Mr. M of BBM as the professional representative, who also signed the first submission of the patent proprietor, dated 20 December 2001 during the opposition proceedings. The last written submission of the patent proprietor during the opposition proceedings, dated 16 May 2005, was signed by representative Mr. B, also of the firm BBM. This letter was accompanied by an "Enclosure 6" (see section XI.(a).(i) above), a letter signed by aforementioned representative Mr. M, sub-authorising Mr. B, and containing the text:

"Please enter this sub-authorisation into the files of the above case, so that [Mr. B] may act for this case as well as I do."

The first substantive submission of the respondent/patent proprietor in the appeal procedure, dated 9 March 2007, was signed by the same representative, Mr. B.

The aforementioned letter of 9 September 2008 (see section IX above), from the same firm and also signed by Mr. B requested that a sub-authorisation in favour of Mrs. K be entered on the file. As noted in section IX above, this letter contained the text:

"Please enter this sub-authorisation into the files of the above case, so that [Mrs. K] may act for this case as well as I do."

- 2.2 It is conspicuous to the Board in this connection that:
- (i) There is no signed authorisation of the firm BBM on the file beyond the statement on EPO Form 1200 12.96 concerning "Entry into the regional phase before the EPO as designated

or elected Office", signed by Mr. M and dated 19 May 1999 that BBM in the person of Mr. M is the representative and the subsequent submissions informing the EPO of "sub-authorisations" of further professional representatives;

- (ii) All the persons mentioned in these subsequent submissions, namely Mr. B and Mrs. K are European professional representatives.

2.3 The requirements of the EPO in relation to the filing of authorisations are contained in the "Decision of the President of the European Patent Office dated 19 July 1991 on the filing of authorisations" (OJ EPO 1991, 489), to which, incidentally reference is made in part 4.4 of the reasons of the aforementioned decision T 382/03, cited by the representative of Akzo Nobel N.V. (see section XI.(a).(iii) above). This decision of the President sets out the applicable legal provisions relating to authorisations to act before organs of the EPO under R. 101 EPC 1973.

According to Article 1(1) of the cited decision of the President of the EPO, a professional representative is required to file a signed authorisation **only** in the circumstances set out in Art. 1(2) and 1(3) of said decision, i.e. specifically in the cases that:

- Art 1(2): If the European Patent Office is informed of a **change** of representative involving professional representatives **who are not members of the same association, without being notified that the previous representative's authorisation has terminated**, the new representative must file [...] an individual authorisation [...] or a

reference to a general authorisation already on file. [...]

- Art 1(3): The 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.** (emphasis in each case of the Board).

2.4 Thus it must be concluded, to the extent that the circumstances set out in Art. 1(2) or Art. 1(3) of the aforementioned Decision do not arise, that there was no requirement for a specific authorisation (let alone a sub-authorisation) in favour of a member of the firm BBM to be filed at all.

2.4.1 As regards the "sub-authorisation" by Mr. M of Mr. B of BBM, it is clear to the Board that "Enclosure 6" is in the nature of an information to the EPO concerning which professional representative in the firm of BBM would be dealing with the case. In particular it is clear:

- (a) that the change does not involve a professional representative who is not a member of the same association and
- (b) that the effect of the phrase "Please enter this sub-authorisation into the files of the above case, so that [Mr. B] may act for this case **as well as I do.**" (emphasis of the Board) is that no change of representative, i.e. no termination of representation by Mr. M has occurred. Nor does any doubt arise as to the sub-authorised professional representative's entitlement to act.

2.4.2 Consequently the circumstances set out in Art. 1(2) and Art. 1(3) of the above Decision do not arise in relation to the entitlement of Mr. B of BBM to act for the respondent.

2.5 As regards the sub-authorisation of Mrs. K of the firm B&B it is true that this involved a professional representative who was not a member of the same association as Messrs. B and M.

2.5.1 It is however clear to the Board that the letter of 9 September 2008 from the professional representative Mr. B who was, for the reasons given above, entitled to act for the respondent, informed the EPO that a further authorisation ("sub-authorisation") in favour of Mrs. K of the firm B&B was in effect.

2.5.2 Whilst it is conceivable that some doubt could, perhaps, have arisen as to the entitlement of one or other of the named professional representatives to act for the respondent, such doubt is precluded by the existence in the letter of 9 September 2008 of the sentence "Please enter this sub-authorisation into the files of the above case, so that [Mrs. K] may act for this case **as well as I do.**" (emphasis again by the Board). It is clear from the phrase "may act...as well as I do." that there has been no change of representative in the sense of Art. 1(2) of the above Decision of the President because there has been no termination of the previous entitlement. Consequently the effect of the letter of 9 September 2008 is that Mrs. K acquires entitlement to act for the respondent in the prosecution of this case. There is thus no doubt as to the entitlement of the

professional representative Mrs. K to act on behalf of the respondent.

2.5.3 Consequently it is conspicuous to the Board that the circumstances set out in Art. 1(2) and 1(3) of the above Decision of the President do not arise in relation to the sub-authorized professional representative Mrs. K either.

2.6 The arguments of the representative of Akzo Nobel N.V. regarding the admissibility of these sub-authorisations were two-fold:

- firstly that they were not supported by general legal principles and that explicit statements to such effect were required, e.g. by crossing boxes on forms (see section XI.(a).(ii) above) and
- secondly that the findings of decision T 382/03 rendered such granting of sub-authorisations invalid (see section XI.(a).(iii) above).

2.6.1 Regarding the first argument, it is conspicuous to the Board that the representative of Akzo Nobel N.V. did not further specify any such legal principle in support of his allegation. Nor, in the Board's view was it necessary or appropriate to seek recourse to unspecified "general legal principles" since the applicable law is explicitly set out in the above mentioned Decision.

As explained in sections 2.3 - 2.5 above, neither of the sets of the circumstances under which according to said Decision it is required that a signed authorisation be filed arise in relation to the sub-authorisations of either Mr. B or of Mrs. K.

Therefore according to the applicable legal provisions it was not necessary in the present case for either Mr. B or Mrs. K to submit a signed authorisation. Thus the argument of the representative of Akzo Nobel N.V. that an explicit statement relating to the power to grant sub-authorisations was required is irrelevant.

- 2.6.2 Regarding the further aspect of this argument of the representative of Akzo Nobel N.V. namely that it is required to indicate the right to give sub-authorisations by crossing a box on a - non-identified - form (see section XI.(a).(ii) above) it is observed that the EPO form "1200 12.96" entitled "Entry into the regional phase before the EPO as designated or elected Office" present on the file (see section 2.2.(i) above) contains no such box. The representative of Akzo Nobel N.V. neither argued that an incorrect form had been employed, nor for example that some other form should instead or additionally have been submitted. Accordingly this argument of the representative of Akzo Nobel N.V. is likewise not supported by the facts.

Moreover it is recalled that the use of that kind of form is optional. Further, the failure to cross such a box would not preclude the possibility of the party fulfilling the same requirement, i.e. conveying the same information, by some other means.

- 2.6.3 Regarding the second argument (see section XI.(a).(iii) above), it is noted that the decision cited, T 382/03, related to one of the sets of circumstances covered by the aforementioned Decision of the President of the EPO, namely the situation where there was a doubt regarding the status of the representative of an **opposing** party.

The present case however concerns the representative of the **patent proprietor** (emphasis of this Board). Specifically, T 382/03 concerned the situation where there had been an announcement of a change of representative without it having been established whether the first named, i.e. original representative had withdrawn (T 382/03 reasons 5.4).

This case law is not relevant here because, as explained in sections 2.4.1 and 2.5.2 above, there was no such "change of representative" in the sense of Art. 1(2) of said Decision of the President and there are consequently no such doubts.

Accordingly the situation in the case in suit is different from that underlying decision T 382/03 and accordingly the findings of T 382/03 are not relevant to the present case.

- 2.7 Professional representative Mrs. K was therefore entitled by the chain of sub-authorisations to make submissions on behalf of the respondent/patent proprietor and the submissions made by Mrs. K are admissible.

3. *Admissibility of the appeal*

- 3.1 It is not disputed between the parties that the transfer of the status of opponent from CIRS S.p.A. to Akzo Nobel N.V. was invalid (see section XI.(e) above). The Board concurs with this view. The letter of 11 November 2003 related to a sale of shares, i.e. a transfer of ownership only. There is no evidence that all assets or at least the assets in the interests of which the opposition was filed were transferred from CIRS S.p.A. to Akzo Nobel Chemicals International B.V.

Hence this latter entity never acquired opponent status (following G 4/88, Order, cited *supra*). The second transfer of opponent status from Akzo Nobel Chemicals International B.V. to Akzo Nobel N.V. was invalid for the same reason and further by analogy with G 2/04 cited *supra*, since no transfer at all occurred between Akzo Nobel Chemicals International B.V. and Akzo Nobel N.V.

Accordingly Akzo Nobel N.V. never validly acquired the status of opponent.

3.2 Instead a dispute arose between the parties regarding the consequences of this invalid transfer of the status of opponent for the admissibility of the appeal and the appropriate further procedure (see sections XI.(e) and (f) above).

3.3 Decision T 1178/04, cited by the representative of Akzo Nobel N.V. at the oral proceedings (see section XI.(e) above) related to a case in which, during the opposition proceedings, a transfer of opponent status took place which, although initially admitted by the opposition division, was later found by the Board to be invalid (see sections III-VII of the facts and submissions and sections 6 to 43 of the reasons of T 1178/04 respectively, in particular the conclusions in section 43).

Regarding the question of admissibility of the appeal - dealt with in sections 1 to 5 of the Reasons of T 1178/04 - it was held in section 3 of the Reasons that the term "party" simply meant someone who takes part in proceedings before the EPO. It was also held that a person was a party for this purpose even if the entitlement to take part in such proceedings was

brought into question and such entitlement was the subject matter of a pending decision. Although this person may cease to be a party if it were decided that he was not entitled to take part in the proceedings, this did not mean that he **never had been a party**, only that he was **no longer** entitled to take part in the proceedings (emphasis of this Board). In particular T 1178/04 in section 3 of the reasons clarifies that the status cannot change retrospectively from that of being a party to that of never having been a party.

3.4 Following this view, the Board considers that Akzo Nobel N.V. was and is a party to these proceedings. The finding that the ruling of the Opposition Division on the issue of opponent status was incorrect (see section 3.1 above) does not prevent Akzo Nobel N.V. from having been a party at the date it filed its notice of appeal (cf T 1178/04, reasons, 4).

3.5 As it has not been disputed that the other requirements of Art. 107 and 108 EPC have been satisfied in this case, it follows that the appeal of Akzo Nobel N.V. is admissible (see also T 1178/04, reasons, 5).

4. The next steps

4.1 Following the findings of T 1178/04 (Reasons 44ff) the correct procedural consequence is to set aside the decision as a whole, and to remit the case to the first instance with the order to continue the opposition proceedings with the correct opponent (following T 1178/04 in particular Order, 3).

- 4.1.1 The respondent/patent proprietor has indicated that it disagrees with this course of action since the fate of the original opponent CIRS S.p.A. was not known, i.e. whether this entity still exists or, if it no longer exists, who was the legal successor (see section XI.(f) above).
- 4.1.2 It is correct that no information has been submitted by either party concerning this matter.
- 4.1.3 However the fact that the question of the identity of the legal successor to CIRS S.p.A. has not been finally established does not justify to distinguish in the present case from the conclusions reached in T 1178/04, namely that the correct course of action in this situation is to refer the case back to the first instance for continuation of the opposition proceedings. Nor can the uncertainty concerning the identity of the legal successor of the original opponent have an influence on the conclusions reached, with reference to T 1178/04, in respect of the status of Akzo Nobel N.V.
- 4.1.4 Therefore the Board considers that the case is to be remitted to the opposition division with the order to continue the opposition proceedings with the original opponent or its legal successor.

Order

For these reasons it is decided that:

1. The appeal is held admissible.
2. The decision under appeal is set aside.

3. The case is remitted to the Opposition Division with the order to continue the opposition proceedings with the original opponent or its legal successor.

The Registrar:

The Chairman:

E. Görgmaier

R. Young