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**Datasheet for the interlocutory decision
of 30 January 2012**

Case Number: T 0445/08 - 3.3.07
Application Number: 99955620.2
Publication Number: 1140330
IPC: B01D 65/08, B01D 61/22,
C02F 1/44
Language of the proceedings: EN
Title of invention:
Water filtration using immersed membranes
Patent Proprietor:
Zenon Technology Partnership
Opponent:
Siemens Industry, Inc.
Headword:
-

Relevant legal provisions:

EPC Art. 107; 112(1)(a)
EPC R. 101(1),(2); 99(1)(a); 41(2)(c)

Keyword:

"Notice of appeal filed in name of person not entitled to appeal - Error alleged in identity (yes): deficiency under Rule 101(2) and 99(1)(a) EPC or error under Rule 139 EPC? Point of law of fundamental importance - contradictory case law [yes] - legal uncertainty about admissibility requirements [yes] - necessity to refer questions to Enlarged Board [yes]"

Decisions cited:

G 0011/91; G 0002/04; T 0483/90; T 0013/91; T 0340/92;
T 0001/97; T 0097/98; T 0656/98; T 0814/98; T 0715/01;
T 1421/05; T 0128/10

Catchword:

Questions

(1) When a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is a request for substituting this other legal or natural person admissible as a remedy to "deficiencies" provided by Rule 101(2) EPC?

(2) If the answer is yes, what kind of evidence is to be considered to establish the true intention?

(3) If the answer to the first question is no, may the appellant's intention nevertheless play a role and justify the application of Rule 139 EPC?

(4) If the answer to questions (1) and (3) is no, are there any possibilities other than *restitutio in integrum* (when applicable)?



Case Number: T 0445/08 - 3.3.07

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 3.3.07
of 30 January 2012

Appellant: Zenon Technology Partnership
(Patent Proprietor) The Corporation Trust Company
Corporation Trust Centre
1209 Orange Street
Wilmington, DE 19801 (US)

Representative: Gibbs, Christopher Stephen
Haseltine Lake LLP
Lincoln House, 5th Floor
300 High Holborn
London WC1V 7JH (GB)

Respondent: Siemens Industry, Inc.
(Opponent) 3333 Old Milton Parkway
Alpharetta, GA 30005 (US)

Representative: Weigelt, Udo
Grünecker, Kinkeldey
Stockmair & Schwanhäusser
Anwaltssozietät
Leopoldstrasse 4
D-80802 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 December 2007
revoking European patent No. 1140330 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: J. Riolo
Members: M.-B. Tardo-Dino
G. Santavicca

Summary of Facts and Submissions

- I. The present decision is restricted to the admissibility of the appeal filed on behalf of ZENON ENVIRONMENTAL INC. with the letter dated 8 February 2008 and received on 15 February 2008.
- II. The relevant facts to be considered by the Board in this respect are the following.

European application No. 99955620 on which European patent No. 1140330 was granted originated from international application PCT/CA99/01113 (publication No. WO 00/30742), which was filed on 18 November 1999 in the name of ZENON ENVIRONMENTAL INC. The patent, once granted, was assigned to *Zenon Technology Partnership* on 30 May 2006. The transfer of ownership was registered by the EPO with effect from 10 February 2007.

The opposition division revoked the patent by a decision dated 28 December 2007. The name of the patent proprietor was correctly cited in the decision as *Zenon Technology Partnership*.

On 7 March 2008 the Registrar of the Board sent a communication notifying the parties of the commencement and the reference number of the appeal proceedings. This communication bore the following handwritten statement: "*the appeal was filed in the name of ZENON ENVIRONMENTAL INC. The patentee is here registered as Zenon Technology Partnership. Therefore the patentee is asked to clarify the situation*".

In response, Zenon Technology Partnership sent a letter dated 13 March 2008 and received on 17 March 2008 confirming that *"the appeal should of course have been filed in the name of the current proprietor, i.e. Zenon Technology Partnership"* and requesting correction of this error.

III. With a letter of 13 March 2008 the opponent (respondent) challenged the admissibility of the appeal on the ground that it had been filed by a company ZENON ENVIRONMENTAL INC. which was not the registered patent owner. The actual patent owner, namely *Zenon Technology Partnership*, and the company ZENON ENVIRONMENTAL INC., which had filed the appeal, were two different entities and therefore the second company was not entitled to file an appeal in the place of the registered patent owner. The headnote of decision T 656/98 (OJ EPO 2003, 385) was quoted, according to which *"[f]or a transferee of a patent to be entitled to appeal, the necessary documents establishing the transfer, the transfer application and the transfer fee pursuant to Rule 20 EPC must be filed before the expiry of the period for appeal under Article 108 EPC. Later recordal of the transfer does not retroactively validate the appeal"*. No transfer request had been filed with the EPO. The respondent also remarked that it was more than unlikely that ZENON ENVIRONMENTAL INC. was in fact the successor of Zenon Technology Partnership.

IV. The Board issued a first communication on 16 April 2008 inviting the appellant's representative to explain on whose behalf he was acting, under what provision of the EPC the correction was being requested, what precisely

the correction would be and what effect it would have on the proceedings.

The Board also drew the appellant's attention to the new Rule 103(1)(b) EPC, according to which the appeal fee is to be reimbursed if the appeal is withdrawn before the filing of the statement of the grounds of appeal.

- V. The appellant's representative answered on 23 June 2008, stating that he was acting on behalf of *Zenon Technology Partnership* and specifying that he requested the correction under Rule 139 EPC (Rule 88 EPC 1973) "*or in the alternative a decision under Rule 101(2) EPC (Rule 65(2) EPC 1973) that the appellant is not (correctly) identified*" and that the deficiency be corrected. He referred to decisions T 715/01, T 460/99 and T 97/98 (OJ EPO 2002, 183).
- VI. On 8 August 2008, the respondent replied to the Board's communication as well as to the appellant's response, and objected to the request for correction for reasons summarised below.
- VII. In a communication accompanying the summons to oral proceedings, the Board invited the parties to comment on the facts which might possibly be evidence of an error and would justify the application of Rule 101(2) EPC in accordance with case law, as illustrated especially by T 97/98 and mentioned in G 2/04 (OJ EPO 2005, 549).

VIII. The appellant responded on 30 August 2011. Its written argument as expounded during the oral proceedings can be summarised as follows:

- (a) There was evidence on file that the true intention was to file an appeal in the name of Zenon Technology Partnership: all the admissibility requirements had been complied with. The payment instruction for the appeal fee was in the name of the real patent proprietor (a copy of a debit order was attached to the submissions as evidence) and the representative was the same as in the first-instance proceedings. A declaration from the representative was also filed to prove that Mr Gibbs "*[was] and [had] been the Patent Attorney principally responsible for the above patent, during examination and opposition. It was always the intention to file the appeal in the name of the patentee, Zenon Technology Partnership, and the mention as appellant of "Zenon Environmental Inc", the proprietor until February 2007, in the Notice of Appeal (letter dated 8 February 2008) was a simple error*".

- (b) The discrepancy clearly related to information required by Rule 99(1)(a) EPC and was a deficiency within the meaning of Rule 101(2) EPC. The discrepancy was noted by the Board in the communication from the Registrar of the Board of Appeal, and the representative in reply cleared it up promptly.

- (c) No change of ownership of the patent took place or was requested in the period between the issue

of the first-instance decision and the filing of the notice of appeal.

- (d) There was no basis in the EPC for saying that the specific provision for remedying deficiencies (Rule 101(2) EPC) constituted a "*lex specialis*" which defeated the general applicability of Rule 139 EPC. In this respect reference was made to cases J 4/85 (OJ EPO 1986,205), T 219/86 (OJ EPO 1988, 254) and J 8/80 (OJ EPO 1980, 293). Furthermore T 656/98, quoted by the respondent, contemplated the possibility of correction under Rule 88 EPC 1973. According to the appellant, whereas Rule 101(2) EPC required that the identity of the person in whose name the appeal should have been filed be derivable from the information in the appeal, if necessary with the help of other information on file, Rule 139 EPC should not be read as being subject to this restriction.

IX. On 30 August 2011 the respondent referred to its previous submissions and provided additional arguments. These arguments, also expanded during oral proceedings, can be summarised as follows:

- (a) Although the circumstances of the present case differed from those of T 656/98, it could be deduced from the latter that the Board there was of the opinion that if the formal requirements of Rule 41(2)(c)[*sic*] (Rule 64(a) EPC 1973) were fulfilled, there was no basis for a correction under Rule 101(2) EPC (Rule 65(2) EPC 1973).

(b) On the other hand, the circumstances of the present case differed from those of T 97/98 because the notice of appeal of 8 February 2008 explicitly mentioned the name, the address and the nationality of the appellant. It was the true intention of the representative of the appellant to file an appeal in the name of this entity.

Thus the appeal filed in the name of a legal entity different from the patent proprietor and therefore not entitled to appeal was inadmissible pursuant to Article 107 EPC.

(c) There was no legal means to remedy this non-compliance.

- Rule 101(1) EPC provided that an appeal which did not comply with Articles 106 to 108, Rule 97 or Rule 99(1)(b) or (c) or (2) EPC was to be rejected as inadmissible unless any deficiency had been remedied before the relevant period under Article 108 EPC had expired.
- Rule 101(2) EPC provided that if the appeal did not comply with Rule 99(1)(a) EPC, the Board of Appeal was to communicate this to the appellant and invite it to remedy the deficiencies noted within a period to be specified.

(d) The respondent drew a distinction between the class of deficiencies within the ambit of Rule 101(1) EPC and the class of deficiencies within the ambit of Rule 101(2) EPC, submitting that they did not belong to the same legal level.

- Non-compliance with Article 107 EPC pertained to the first class of deficiencies under Rule 101(1) EPC and could be remedied only in accordance with the requirements of that rule.

- The second class of deficiencies was different inasmuch as the identification of the appellant required in Rule 99(1)(a) EPC, to which reference is made in Rule 101(2) EPC, corresponded to Rule 41(2)(c) EPC, which set out the formal requirements which had to be fulfilled for identification of a party. Rule 101(2) EPC applied only to deficiencies concerning those formal requirements.

- The respondent concluded that these two classes of requirements and their deficiencies were not to be treated in the same way. The Board had to check first of all whether the appellant as identified in the notice of appeal was entitled to appeal according to the requirements of Article 107 EPC.

- Provided that the appellant fulfilled the requirements of Article 107 EPC, it was then possible, if a deficiency such as a wrong spelling or a wrong address has occurred, to invite it to remedy this deficiency.

- But if the information in the notice of appeal identified an appellant which was a legal entity but which was not entitled to appeal according to Article 107 EPC, then the only possibility was to remedy this within the time period of two months. Otherwise Rule 101(2) EPC was not applicable and

correction on the basis of this rule was not possible.

- In the current case there was no deficiency to be remedied pursuant to Rule 101(2) EPC, since the Board never sent a communication as prescribed by that rule.

(e) Nor was it possible to make any correction on the basis of Rule 139 EPC, because that rule, which implemented the common provisions of Part VII of the EPC regarding proceedings under the EPC, was a general provision over which the specific rules governing the appeal proceedings took precedence according to the general principle of law that "*lex specialis generalibus derogat*".

(f) As an auxiliary request in the event that the Board did not reject the appeal as inadmissible, the respondent requested that the Board refer a question to the Enlarged Board as a point of law of fundamental importance (see next paragraph).

- X. The final requests presented by the parties at the oral proceedings before the Board were as follows:

The appellant requested correction of the relevant part of Mr Gibbs' letter dated 8 February 2008, namely correction of the name, address and nationality of the appellant, and that the appeal be declared admissible. The appellant further objected to the requested referral to the Enlarged Board.

The respondent requested that the appeal be dismissed as inadmissible. As an auxiliary request it filed a question to be referred to the Enlarged Board:

"Does Rule 101(1) EPC in connection with Article 107 EPC allow the correction under Rule 101(2) EPC or Rule 139 of the appellant to substitute a legal entity other than the one indicated in the notice of appeal?"

XI. At the end of the oral proceedings, after deliberation, the Board announced that it would issue its decision in writing.

Reasons for the Decision

Admissibility of the notice of appeal

1. It is undisputed that the notice of appeal as filed is not admissible pursuant to Article 107 EPC because the appellant company was not a party to the opposition proceedings and accordingly was not adversely affected by the appealed decision. It was no longer the patent proprietor.

The request for correction concerning the appellant with a view to complying with Article 107 EPC was filed only in reply to the Registrar's letter and after expiry of the relevant two-month period provided for by Rule 101(1) EPC.

Accordingly, the only remaining question is whether the correction as requested, which would result in the appeal being admissible, is possible pursuant to Rule 101(2) or 139 EPC.

The request for correction

2. The notice of appeal was drafted as follows:

*"European Patent No 1140330 (99955620.2-062)
Zenon Technology Partnership*

We hereby give Notice of Appeal (underlined by the appellant) against the decision of the Examination Division [sic] dated 28 December 2007 to refuse the above patent application [sic]. Cancellation of the decision in its entirety is requested so that the patent may be maintained....

The name, address and nationality of the Appellant is (emphasised by the Board):

ZENON ENVIRONMENTAL INC

845 Harrington Court

Burlington

Ontario L7N 3P3

Canada

ZENON ENVIRONMENTAL INC is a Canadian Corporation.

In the event that the Board of Appeal wishes to make a decision detrimental to the Applicant's [sic] rights at any time, it is hereby requested that Oral Proceedings be held to discuss the matter".

2.1 It appears from the notice, which complies with all the requirements of Rules 99(1)(a) and 41(2)(c) EPC, that the appellant is fully identified, the company in question being a real company corresponding to the former owner of the patent in suit incorporated under

Canadian law, while the current owner is incorporated under the law of Delaware, USA.

- 2.2 But the question of admissibility arises because it is contended that the appellant's identification in the notice of appeal stemmed from an unintentional inversion between the former and current patent owner.
3. The Board tends to concur with the respondent that in the circumstances of the case at hand there are no deficiencies with respect to the requirements of Rules 101(2) and 99(1)(a) EPC. This latter rule, by incorporation of Rule 41(2)(c) EPC, defines the standard formal administrative items of information required to fill out the notice of appeal, which will permit the identification of the appellant. Article 107 EPC on the other hand, once the appellant has been identified, defines an admissibility requirement to be fulfilled by the appellant in order to be entitled to appeal.

Therefore Rule 101(2) EPC, which authorises correction of deficiencies under Rule 99(1)(a) EPC, can only justify corrections of deficiencies that are directed to completing the appellant's identity, if this was not fully provided in the notice of appeal, in cases where the appellant is already identifiable from the notice of appeal.

4. The Board has now to look into the case law and consider whether this conclusion (points 1 and 3 *supra*) contradicts the established case law dealing with questions of correction of a notice of appeal.

5. The case law offers three categories of decisions to be considered:
- (a) decisions in which correction of the name of the appellant was allowed under Rule 65(2) EPC 1973 because it was held that there was a deficiency, so it was possible to infer from the file who the real appellant was. Sometimes the Boards indicated that Rule 65(2) EPC 1973 was preferred to Rule 88 EPC 1973 as it was more specific (T 715/01 of 24 September 2002, point 9 of the Reasons, not published in the OJ EPO);
 - (b) decisions in which Rule 88 EPC 1973 was used as a legal basis for the corrections (T 814/98 of 8 November 2000, not published in the OJ EPO);
 - (c) decisions in which correction was refused because the notice of appeal contained no remediable errors but rather a mistake of law.

Decisions allowing the request for correction on the basis of Rules 99(1)(a) and 101(2) EPC (Rules 64(a) and 65(2) EPC 1973)

5.1 T 340/92

- (a) In T 340/92 of 5 October 1994 (not published), correction of the name of the appellant was allowed and the appeal declared admissible because the erroneous mention of the appellant's name was held to be due to a confusion between the name of the appellant company (société Croizet-Pourty) and its parent company (SOGEA). In this case a request for re-establishment of rights had been filed but the Board decided that this request was superfluous.

(b) The Board then considered that where the appellant's name or the name of the person actually entitled to appeal was not mentioned in the notice of appeal, in non-compliance with Rule 64(a) EPC 1973, it was possible to remedy this deficiency under Rule 65(2) 1973 EPC within the time limit allocated by the Board.

The Board stated that the name of the parent company had been indicated by error, as was apparent from the statement of grounds of appeal and the explanations of the subsidiary company, which was the only one to be adversely affected by the decision under appeal and which was sufficiently identifiable through its representative's name (point 1 of the decision). It was inferred from the fact that the subsidiary was the only party adversely affected and that it was sufficiently identifiable through its representative that the error was a deficiency that could be remedied under Rule 65(2) EPC 1973.

(c) It is difficult to know to what extent the solution and reasons given by the Board in that case are relevant for, or transposable to, the current case. However, as far as this Board understands, it seems that the notice of appeal in T 340/92 did not contain an entire identity of the appellant. Only its name was erroneous, which is not the case here.

5.2 *T 483/90, T 613/91 and T 1/97*

- (a) In T 483/90 of 14 October 1992 (not published in the OJ EPO) the appeal was filed by the opponent without specifying its address; with respect to the name, even if it was not completely clear, it seems that there was no deficiency. In T 613/91 of 5 October 1993 (not published in the OJ EPO) the address was missing.
- (b) In T 1/97 of 30 March 1999 (not published in the OJ EPO), which cited the two preceding decisions, the notice of appeal was filed in the name of the opponent; there was an inconsistency between the name indicated in the notice of appeal ("Crown Cork & Seal Co") and the name taken from the appealed decision ("Crown Cork AG"). But there was no Swiss company "Crown Cork & Seal Co" registered at the address indicated in the notice of appeal, which was the correct address of the "Crown Cork AG" company. The Board did not accept that Rule 64(a) EPC 1973 applied only when the appellant's name or address was missing and stated that the general term "deficiencies" used in Rule 65(2) EPC 1973 was to be interpreted as also referring to an incorrect indication of an appellant's name and/or address (point 1.4 of the Reasons).

For the then competent Board *"there [was] a close relationship between Rule 64(a) and Article 107 first sentence"*, this latter presupposing the identification of the appellant (point 1.1 of the Reasons). The Board went on: *"However, this does not mean that if Rule 64(a) is not or not correctly met then Article 107 first sentence will necessarily not be complied with"* (*idem*). For the

Board it was clear that what was required was that the appellant had to be sufficiently identifiable within the two-month period, if necessary with the aid of the decision under appeal, in order to establish that it was entitled to appeal under Article 107, first sentence, EPC. On the other hand, deficiencies and omissions concerning the name and address of the appellant given in the notice of appeal as specified in Rule 64(a) EPC 1973 could be remedied later (*idem*).

- 5.2.1 This Board agrees in principle with the analysis made in case T 1/97 by the competent Board, which given the particular circumstances of that case admitted the correction.
- 5.2.2 In these three cases the circumstances seem to differ from those of the case at hand. There were deficiencies within the meaning of Rule 99(1)(c) EPC (correct name not specified but appellant identified as the opponent and/or missing address; discrepancy in the addresses) which did not enable the boards to establish the appellant's precise identity but justified an investigation.
- 5.3 T 97/98
- (a) In T 97/98 of 21 May 2001, which, *inter alia*, referred to T 340/92 and T 1/97, the appeal had been filed in the name of *Fresenius AG* instead of *Fresenius Medical Care Deutschland GmbH*. In this particular case also no name was explicitly indicated as the appellant's name, but "*Fresenius AG*" was mentioned as the opponent's name.

- (b) The Board first noted that it was not unusual in a notice of appeal to designate the appellant in such a way, namely by referring only to the "opponent" in cases where the opponent became the appellant. Such an indication was admitted as an indication of the appellant's name as required by Rule 64(a) EPC 1973 in situations where the same representative who had represented the opponent in the opposition proceedings had then filed the appeal. The same result followed in the case of a patent proprietor/appellant in T 867/91 of 12 October 1993 (point 1.1 of the Reasons).
- (c) This Board subscribes to the statements in point 1.3 of T 97/98, namely that the requirements of Rule 64(a) EPC 1973 are intended, along with their administrative purposes, to secure the appellant's identification and to allow the Boards of Appeal to check its entitlement to file an appeal as required by Article 107 EPC, and that Rules 64(a) and 65(2) EPC 1973 cannot be construed as forming an exception to the basic principle that the appellant must be identifiable on expiry of the time limit for filing an appeal.
- (d) But in the opinion of the competent Board in T 97/98 there was a deficiency in the indication of the name and address of the appellant within the meaning of Rule 65(2) EPC 1973 not only when no such express indications at all had been made in the notice of appeal but also when wrong indications had been made (repeated twice, point 1.3 of the Reasons). And some passages of the

reasons further expand this statement in a way which might be seen to be potentially conflicting with the conclusion that the Board in the present case could reach (see points 1 and 3 *supra*): For instance, the Board stated that correction of errors in the name or address of the appellant might be of varying nature. It might lead after correction to a different natural or legal person to the one indicated within the time limit for filing the appeal having to be regarded as the appellant. *"What is required under Rules 64(a) and 65(2) EPC [1973] is that there was indeed a deficiency, i.e. that the indication was wrong, so that its correction does not reflect a change of mind as to whom the appellant should be"* (the two last sub-paragraphs of point 1.3)", and (point 1.4): *"correction of the name of the appellant to substitute a natural or legal person other than the one indicated in the appeal is allowable under Rule 65(2) EPC [1973] in conjunction with Rule 64(a) EPC [1973] if it was the true intention to file the appeal in the name of said person and if it could be derived from the information in the appeal, if necessary with the help of other information on file, with a sufficient degree of probability that the appeal should have been filed in the name of that person"*. To this end the competent Board thoroughly examined the documents (extract from the commercial register, a copy of a letter to the representative and an authorisation) accompanying the request for correction.

- (e) This decision, putting considerable weight on the *"true intention"* of the appellant, was quoted

together with T 814/98 of 8 November 2000 in *The European Patent Convention*, Singer/Stauder (volume 2, third edition, Article 110, page 243) as allowing a correction of the appellant's name on a different legal basis to that in T 340/92 or T 1/97. T 814/98 was different because it explicitly accepted the correction under Rule 88 EPC 1973 (see paragraph 6.1 *infra*). As to T 97/98, despite the fact that the legal basis was Rule 65(2) EPC 1973 and not Rule 88 EPC 1973, it in fact used the same terminology as in G 11/91 of 19 November 1992 about the requirements of Rule 139 EPC (Rule 88 EPC 1973) when assessing whether the requirements of Rule 101(2) EPC (Rule 65(2) EPC 1973) in conjunction with Rule 99(1)(a) EPC (Rule 64(a) EPC 1973) were met.

Thus, the introduction of the notion of "true intention" to assess the requirements of Rules 99(1)(a) and 101(2) EPC could have an impact beyond the circumstances of the case upon which the Board then decided: in particular, the conclusion drawn in point 1.4 (see point (d), paragraph 5.3 *supra*) could *prima facie* embrace correction of any nature and apply to the case at hand (see 5.8 *infra*), all the more so since T 97/98 explicitly referred in its point 1.3 to point 1.1 of the reasons of T 1/97, where it is stated that the name **and** address of the appealing opponent can be identified from the decision under appeal (emphasis added by the Board).

- 5.4 In seeking to establish the true intention, all the quoted decisions also rely very much on the fact that

the appellant had the same representative and that, in conjunction with the appealed decision, it was apparent that the notice of appeal could have been validly filed only by the person adversely affected (point 1 of T 340/92; point 1.3 of T 1/97; point 1.5 of T 97/98).

5.5 In this Board's view, it is not pure speculation to read the common reasons of the decisions cited above in the sense that, under Rule 101(2) EPC (Rule 65(2) EPC 1973), the entire identification of the appellant could be replaced provided that the true intention to file an appeal in the name of the right person was established, one of the possible means of evidence for establishing the true intention being the fact that nobody else pursuant to Article 107 EPC would have been entitled to appeal. In fact, this interpretation crystallised in T 15/01 of 17 June 2004 and T 715/01 of 24 September 2002 (not published in the OJ EPO).

5.5.1 In the first case the appeal was filed in the name of a legal person which no longer existed due to a merger. The Board took a broad view of the possibilities offered to an appellant to correct the notice of appeal, since it referred to the case law justifying correction on the basis of Rule 88 EPC (T 814/98; T 460/99 of 30 August 2001) as well as to T 97/98 (commented upon *supra* point 5.3). The Board endorsed T 97/98, according to which *"nothing [in Rules 65(2) and 64(a) EPC 1973] allowed them to be applied only to certain kinds of deficiencies and as a matter of principle not when the correction of a wrong indication led to a different person to the one originally expressly named in the appeal having to be regarded as the appellant"*. The deficiency was that the indication was wrong, so that

the correction expressed what was intended when the appeal was filed (point 14 of the Reasons in T 15/01).

5.5.2 In the second case, the notice of appeal had been filed by the right person while the statement of grounds of appeal was filed by the new patent proprietor, who however had not yet been registered as such. But, and this is why this Board has to mention this case, the Board then did not make any distinction between the two appeal procedural steps, considering the same admissibility requirements to be met both by the statement of grounds and by the notice of appeal (point 4 of the Reasons): *"the only question remains whether a correction of the name of the applicants in the said statement of grounds is allowable under Rule 65(2) EPC [1973]"*. Then the Board, in point 5, referred to the passage from T 97/98 quoted in point 5.3(d) above and then concluded (point 10(f)): *"Thus, the Board considers that in the present case it is possible to remedy the deficiency under Rule 65(2) EPC [1973], even after expiry of the time limit for filing the appeal [...], since the true intention of the appellants was to comply with the formal requirements for making an appeal admissible. This corresponds to applying in the present situation the rationale of T 97/98"*.

5.5.3 Again, it is true that in T 715/01 the procedural step concerned was not the notice of appeal; but this Board understands, given the general statement in point 5 of T 715/01, that it was the Board's view in this latter case that the broad interpretation of T 97/98 regarding the statement of grounds could be applied to the notice of appeal. In this case such broadening would come into

open conflict with G 2/04, T 656/98 or T 128/10 (see *infra*).

5.6 In case T 1421/05 of 18 January 2011 the decisive issue was who the opponent was. The appeal had been filed in the name of an opponent who had transferred the assets to which the opposition related and who no longer existed but who had a universal successor. After having decided that the status of opponent remained with the transferor, the Board then stated: "*an appeal filed by mistake in the name of an opponent who no longer exists but who has a universal successor, and which was obviously intended to be filed on behalf of the person who is the actual opponent and who was prejudiced by the decision, namely the universal successor, is admissible; if necessary the notice of appeal and statement of grounds of appeal may be corrected to record the name of the true appellant/opponent*" (point 4 of the Headnote: points 6 and 7 of the Reasons). The correction of the notice of appeal was undoubtedly not the main issue in this case (the question arose in fact as a consequence of the main issue, namely who the opponent was), but the Board, in the event that the notice of appeal and statement of grounds were defective, gave its reasons why the correction, if necessary, should be allowed (point 7 of the Reasons). The Board indicated that it followed the approach of the Board in T 715/01, which had decided that the relevant rule was Rule 65 and not Rule 88 EPC 1973, which was in Chapter V of Part VII of the Implementing Regulations to the Convention, and that the principles for correction under Rule 65(2) EPC 1973 were set out in T 97/98. While in T 97/98 the Board was satisfied that, from reading the appeal with the help of the

indications in the impugned decision, a third party could have derived who really intended to appeal, without knowing the details later brought before the Board of Appeal, T 1421/05 went still further and stated that the Board in T 97/98 did not mean that it was a necessary requirement for correction that the information should be derivable from the appeal (point 7.5 of the Reasons).

5.7 In the light of this case law, having considered the general statements of the decisions mentioned above, particularly in T 97/98, against their specific factual background, this Board could come to the conclusion that some differences can be detected in the factual circumstances (see points 5.1(c) and 5.2.2 above), which in the present case could justify a refusal of the requested correction without apparently deviating from the established case law. But the Board is not convinced that these differences are more than formal differences: what was found decisive was the true intention which led the boards to decide that the indication was wrong and the true intention was established with the help of information taken from the file or the fact that the representative had been the same. Moreover, there are decisions, such as T 715/01 and T 1421/05, which developed the potentially broad interpretation of T 97/98 in a sense which in fact can be seen as broadening the scope of Rule 101(2) EPC.

5.8 This is why the question arises in the present case whether, in view of this possible broad interpretation, this Board should consider the alleged incorrect indication in the notice of appeal as a deficiency pursuant to Rules 99(1)(a) and 101(2) EPC. In fact the

parameters used to establish the true intention in the decisions analysed above point to an error qualifying as such a deficiency in the identity of the appellant: from the file and the appealed decision it is immediately clear that *Zenon Technology Partnership* is the only party adversely affected, the same representative has been acting for this company since the opposition procedure, no transfer of rights has occurred, the appeal fee had been paid in the name of Zenon Technology Partnership, in addition the anomaly was immediately seen by the Registrar - all of which could plead in favour of a genuine error.

5.8.1 As regards genuine errors, the Board refers here to *The Annotated European Convention* by Derk Visser, 19th edition, page 581, where the case law of the boards of appeal in this matter is summarised as follows:

- (a) the first requirement for a correction to be authorised under Rule 101(2) EPC is that the deficiency is a genuine error, adding however that the correction must reflect what was intended when filing the appeal, which is an intentional feature;
- (b) the second requirement reflects, in the Board's view, the ambiguity of the case law. It is stated:
 - (i) on the one hand that the indication in the notice of appeal must be such that the appellant is identifiable upon expiry of the period for filing the appeal, even though it is allowed to make the correction after that point in time, so that it is possible to determine whether or not the appeal was

filed by the entitled person in accordance with Article 107 EPC. This Board fully agrees with this statement, which was already in T 1/97 (see point 5.2(b) *supra*). But there is a second comment.

- (ii) on the other hand that it is sufficient for that purpose that it is possible to derive from the information in the appeal, if necessary with the help of other information on file, with a sufficient degree of probability by whom the appeal *should have been filed* (T 97/98, point 1.4) (italics added by the Board). This remark introduces an element of subjectivity into the assessment of the requirements of Rule 99(1)(a) and 101(2) EPC.

5.8.2 Having said that, the Board notes that there is another trend in the case law, which sticks to objective criteria.

Decisions rejecting the request for correction

5.9 G 2/04 (OJ 2005, 549), T 128/10 and T 656/98 (OJ 2003, 385)

G 2/04

5.9.1 The facts underlying this case were that the opponent (Akzo Nobel N.V.) and the company owning the activities to which the opposition pertained (bioMérieux B.V.) had

filed a notice of appeal because they were in doubt as to which of the two companies was entitled to appeal. One of the requests was that the name of the appellant bioMérieux B.V. in the notice of appeal be corrected to Akzo Nobel N.V. if this company was the one entitled to appeal. The Enlarged Board noted that the opponent Akzo Nobel N.V., clearly identified as the opponent in the declaration of opposition, was not indicated as the appellant but bioMérieux was (point 3.1 of the Reasons). This was in conformity with the true intention of the author of the declaration. The Enlarged Board went on to state that it was the established case law that in such circumstances there was no deficiency which might be remedied in accordance with Rule 64(a) in conjunction with Rule 65(2) EPC 1973, nor was there an error which might be corrected in accordance with Rule 88 EPC 1973 (point 3.1 of the Reasons).

5.9.2 Thus this Board cannot conclude from these statements that the Enlarged Board really endorsed T 97/98 in its general statements, or T 715/01, applying these statements: Indeed the Enlarged Board then concluded that "considering the overriding interest that a party must be identifiable, the [Enlarged] Board sees no reason for a broadening of the scope of application of Rule 65(2) or Rule 88, first sentence, EPC [1973]" (point 3.1 of the Reasons).

5.9.3 In the Board's interpretation this only means that where there is no deficiency in the sense of Rules 99(1)(a) and 101(2) EPC there is no reason to search for the true intention, the Enlarged Board leaving open

the question of the relation between Rules 101(2) EPC (Rule 65(2) EPC 1973) and 139 EPC (Rule 88 EPC 1973).

T 128/10 and T 656/98

- 5.9.4 In T 128/10 of 10 December 2010, the mistake as in T 656/98 was held to be a mistake of law as to who was entitled to appeal.
- 5.9.5 The circumstances these two cases have in common are that the notice of appeal was filed on behalf of an identified person and was intended to be filed on behalf of this person, but it transpired afterwards that this person was not entitled to appeal (after a transfer of rights it happened that the appellant had not yet become the registered patent owner at the time of filing the notice of appeal).
- 5.9.6 In these cases where it was submitted that the real intention was to file the notice of appeal on behalf of the patent proprietor, the Boards concluded that the intention as to the identity was clear and that there was neither a deficiency nor a mistake (Reasons, point 7.1 of T 656/98 and point 5.4 of T 128/10).
- 5.9.7 The only difference between the case at hand and T 128/10 or T 656/98 is that in the latter cases there was a clear mistake of law: the patent proprietors had overlooked the fact that registration was a necessary requirement for being recognised as patent proprietor in proceedings before the office and therefore for being entitled to appeal, while in the present case the mistake consists in having filed an appeal in the name of a person who was not entitled to appeal, when there

had been no change which could have introduced a possible hesitation about who was entitled to appeal. Accordingly, if there were not the reservations made in point 5.8 *supra*, and the question about the possible role of the intention, the present case could correspond to the situation as described in points 7.1 to 7.3 of the Reasons of T 656/98, where the Board then concluded that there was no deficiency, hence no room for any application of Rule 65(2) EPC 1973.

Decisions based on Rule 139 EPC

6. The Board is aware that the case law is not uniform as to whether the scope of application of Rule 139 EPC extends to an act of procedure such as the notice of appeal.
- 6.1 T 715/01 excluded it and preferred to apply Rule 65(2) EPC 1973. T 814/98 of 8 November 2011 allowed the correction of the appellant's name on the basis of Rule 88 EPC 1973 without any preliminary discussion about the applicability of the rule. Other decisions simply mentioned it was possible without any comments (see for instance T 15/01 already mentioned, point 14 of the Reasons). Consequently this rule cannot be seen as a satisfying solution.
- 6.2 The upshot of the above is that the decision of this Board on the admissibility of the notice of appeal depends on the role allocated, or not, to the appellant's intention, either under Rule 101(2) EPC in conjunction with Rule 99(1)(a) EPC or under Rule 139 EPC. Accordingly, given the fact that the case law offers no clear uniform answer, the Board will now

consider the respondent's auxiliary request for a referral to the Enlarged Board.

Auxiliary request: referral to the Enlarged Board of Appeal

7. In fact, it results from all the decisions examined above that the crucial line of partition within the case law is, or should be, the existence of a deficiency, always relied on by the decisions, rather than the intention.
 - 7.1.1 Either the notice of appeal was filed in the name of the presumed entitled person, who ultimately was not entitled. Whatever the intention was at the time of filing, it led to a mistake of law and to the inadmissibility of the appeal (T 128/10; T 656/98).
 - 7.1.2 Or something happened, perhaps not intentionally, which led to a deficient indication in the notice of appeal. But the difficulty with respect to this category of decisions is that some of them accepted a very broad definition of "deficiency", by having recourse to the notion of "true intention" to characterise such deficiencies, e.g including discrepancies, as an unintentionally wrong identification. And in these cases the true intention was thoroughly investigated to complete the identity of the identifiable person (see for instance T 1/97 above).
- 7.2 In that light, the current case could belong to the first category, as already asserted (point 5.9.7): the notice of appeal was filed on behalf of somebody not entitled to appeal, and it contains no deficiency

pursuant to Rule 99(1)(a) EPC, so that there is no reason to trigger the application of Rule 101(2) EPC.

7.3 But in the light of the comments in points 5.8 above, it remains an open question whether a wrong indication can be considered a deficiency open to correction under Rule 101(2) EPC because the appellant contends that the true intention was to file an appeal in the name of Zenon Technology Partnership, submitting arguments close to those admitted to establish the true intention.

7.4 As already indicated in points 5.8 above, the case law has introduced the subjective notion of "true intention" and the possibility to "derive from the information in the appeal, if necessary with the help of other information on file, with a certain degree of probability by whom the appeal should have been filed".

Thus uncertainty exists about whether and, if so, under which requirements it is possible to have recourse to the true intention to assess whether there is a remediable deficiency under Rule 101(2) in conjunction with Rule 99(1)(a) EPC. This uncertainty concerns an important point of law: the admissibility of an appeal.

Owing to this uncertainty the Board could turn to Rule 139 EPC, which could be a possible solution. But this rule offers no clear answer either (see points 6, *supra*).

7.5 Pursuant to Article 112(1)(a) EPC, in order to ensure uniform application of the law, or if a point of law of fundamental importance arises, the Board of Appeal shall, during proceedings on a case and either of its

own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes.

7.6 In the present case, the main reason to refer a question to the Enlarged Board is that a point of law of fundamental importance has arisen. Given the overriding interest that the party must be identifiable as underlined by the Enlarged Board (G 2/04, point 3.1 of the Reasons), it is a matter of legal certainty that the admissibility requirements for a notice of appeal should be immediately clear for the parties and should not need to be settled at the price of a preliminary admissibility discussion about the definition of a deficiency and the possible remedies.

7.7 At this point the Board refers and subscribes to point 1.1 of T 656/98, where it is stated that it must be possible to determine the person entitled to appeal precisely and easily if the appeal process is not to be tangled up already at the outset in complicated investigations as to the relations between the original parties and later would-be parties and would-be appellants. This declaration made in relation to the transfer of rights to patent ownership remains relevant for the current case because it addresses the status of the appellant.

7.8 Apart from the trouble caused by the investigations which might be necessitated by a search for the true intention, the Board is not convinced that allowing the correction only on the basis of the true intention would not result in broadening the scope of application

of Rule 101(2) EPC in a manner which was prohibited by G 2/04, also with the consequence *contra legem* of eluding Rule 101(1) and Article 107 EPC.

- 7.9 In fact the question is whether this broad interpretation would not lead in extreme cases to simply ignoring Article 107 EPC: in cases where the patent is revoked or the opposition is rejected, the sole possible appellant being the sole losing party or its legal successor, the requirements of Rule 99(1)(a) EPC could simply be ignored.
- 7.10 Furthermore, while the Enlarged Board in G 2/04 had no reason to discuss the relationship between Rules 65(2) and 139 EPC 1973, now Rules 99(1)(a) and 101(2) EPC, for the purpose of the referral at hand, it admitted implicitly that it was an issue. In the present case the appellant bases its request on both provisions, so that the question of their relationship is also decisive for the present decision on admissibility.
- 7.11 Finally, having regard to certain elements of case law, the Board cannot be sure that the true intention of the appellant has no role to play. Accordingly, taking the responsibility to pronounce judgment on this important point of law in a sense which would depart from these elements of case law would be fatal for the appellant's case. This would add unfairness in a context of legal uncertainty.
8. This is why the Board comes to the conclusion that the issue is to be referred to the Enlarged Board.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board:

(1) When a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is a request for substituting this other legal or natural person admissible as a remedy to "deficiencies" provided by Rule 101(2) EPC?

(2) If the answer is yes, what kind of evidence is to be considered to establish the true intention?

(3) If the answer to the first question is no, may the appellant's intention nevertheless play a role and justify the application of Rule 139 EPC?

(4) If the answer to questions (1) and (3) is no, are there any possibilities other than *restitutio in integrum* (when applicable)?

The Registrar:

The Chairman:

S. Fabiani

J. Riolo