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**Datasheet for the interlocutory decision
of 26 March 2015**

Case Number: T 0445/08 - 3.3.07

Application Number: 99955620.2

Publication Number: 1140330

IPC: B01D65/08, B01D61/22, C02F1/44

Language of the proceedings: EN

Title of invention:
WATER FILTRATION USING IMMERSED MEMBRANES

Patent Proprietor:
Zenon Technology Partnership

Opponent:
Evoqua Water Technologies LLC

Headword:
Water Filtration/Zenon/Identity of the Appellant

Relevant legal provisions:
EPC R. 139

Keyword:
Admissibility of appeal - notice of appeal - name and address
of appellant -
correction of error establishment of the true intention beyond
any reasonable doubt[yes]

Decisions cited:
G 0001/12, J 0008/80, J 0006/91, J 0019/03, T 0824/00

Catchword:

If the notice of appeal is to be considered in the context of the file history, the true intention needs to be confirmed by external facts and evidence at least to prevent that requirements such as those of Article 107 EPC be circumvented (point 9).

In applying Rule 139 EPC to a party's request to correct a mistake in the notice of appeal in respect of the identity of the appellant, the principle of legal certainty needs to be taken into consideration (point 10).



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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 Technical Board of Appeal 3.3.07
of 26 March 2015

Appellant:
(Patent Proprietor)

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

Representative:

Nash, David Allan
Haseltine Lake LLP
Redcliff Quay
120 Redcliff Street
Bristol BS1 6HU (GB)

Respondent:
(Opponent)

Evoqua Water Technologies LLC
4800 North Point Parkway, Suite 250
Alpharetta, GA 30022 (US)

Representative:

Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 28 December
2007 revoking European patent No. 1140330
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman J. Riolo
Members: G. Santavicca
M.-B. Tardo-Dino
A. Uselli
I. Beckedorf

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Opposition Division, posted on 28 December 2007, revoking European patent No 1140330.
- II. The (registered) patent owner was *Zenon Technology Partnership, The Corporation Trust Company Corporation Trust Centre 1209 Orange Street, Wilmington, DE 19801/US* (the patent had been acquired from *Zenon Environmental Inc, 845 Harrington Court Burlington Ontario L7N 3P3 Canada*, by an assignment registered by the EPO on 30 May 2006).
- III. A notice of appeal, dated 8 February 2008 but received on 15 February 2008, was filed, reading:

*"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 (emphasis 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."

The procedural steps after the filing of the notice of appeal

- IV. On a communication dated 7 March 2008 notifying the parties of the commencement of the appeal proceedings, the Registrar of the Board added the following handwritten statement: *"the appeal was filed in the name of ZENON ENVIRONMENTAL INC (underlined by the Registrar). The patentee is here registered as ZENON TECHNOLOGY PARTNERSHIP (underlined by the Registrar). Therefore the patentee is asked to clarify the situation."*
- V. The Appellant and the Respondent both reacted with letters dated 13 March 2008. The Appellant wrote *"... the appeal should of course have been filed in the name of the current proprietor, i.e. Zenon Technology Partnership (underlined by the Appellant). I apologise for the confusion and respectfully request the correction"*. The Respondent requested that the appeal be rejected as inadmissible, as it had been lodged by a legal entity other than the adversely affected (entitled) party.
- VI. With a communication dated 16 April 2008, the Board asked the Appellant's representative who had lodged the appeal to specify the legal basis for the requested correction. The Board also made clear that whether a correction of a procedural act, such as the filing of an appeal, was possible was an "interesting question", and that it was not appropriate for the Board in an

inter partes case to give advice on this, but only to decide on the submissions of the parties.

VII. With letter dated 23 June 2008, the Appellant's representative explained that he was acting on behalf of Zenon Technology Partnership, the Patent Proprietor, and requested that the notice of appeal dated 8 February 2008 be corrected to give the correct name (and address) of the Patent Proprietor, who was the only party who could possibly be entitled to appeal against the decision in question. The Appellant also added that the EPC was not clear about the procedure for correction of a procedural act. Consequently, the correction was requested on the basis of either Rule 139 EPC or Rule 101(2) EPC.

VIII. In its letters dated 8 August 2008, 18 May 2009 and 30 August 2011, the Respondent maintained that neither of the corrections requested under Rules 101(2) or 139 EPC was allowable in the case at issue.

IX. With letter dated 30 August 2011, the Appellant filed two documents, respectively labelled Annexes A and B:

- a copy of the payment of the appeal fees under the name of *Zenon Technology Partnership* (Annex A); and,

- a declaration of Mr Gibbs, the representative, stating: "(1) *I am and have been the European Patent Attorney principally responsible for the above patent, during examination and opposition. (2) It was always the intention to file the appeal in the name of the patentee Zenon Technology Partnership, and the mention of Zenon Environmental Inc, the proprietor until February 2007, in the notice of appeal (letter dated 8 February 2008) was a simple error*" (Annex B).

X. In its interlocutory decision of 30 January 2012, the Board referred the following questions to the Enlarged Board of the Appeal:

(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)?

XI. The Enlarged Board of Appeal, in its decision G 1/12 of 30 April 2014, answered the questions as follows:

Question (1):

The answer to reformulated question (1) - namely whether 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 it possible to correct this error under Rule 101(2) EPC by a request for substitution by the name of the true appellant - is yes, provided the requirements of Rule 101(1) EPC have been met.

Question (2): Proceedings before the EPO are conducted in accordance with the principle of free evaluation of evidence. This also applies to the problems under consideration in the present referral.

Question (3): In cases of an error in the appellant's name, the general procedure for correcting errors under Rule 139, first sentence, EPC is available under the conditions established by the case law of the boards of appeal.

Question (4): Given the answers to questions (1) and (3), there is no need to answer question (4).

Procedural steps after G 1/12

XII. In its letters of 12 May 2014 and 31 July 2014, the Appellant maintained that the genuine error in the notice of appeal did not reflect the actual intention of the Patent Proprietor, so that it was evidently correctable on the basis of either Rule 101(2) EPC or Rule 139 EPC, and therefore the appeal was admissible. Also, the Appellant requested that, since the patent in suit was in its 15th year, for the sake of procedural economy, the oral proceedings address procedural and substantive issues.

XIII. With letters of 30 May and 25 November 2014, the Respondent (i) requested the change of its name to *Evoqua Water Technologies LLC* (because the previous Opponent/ Respondent Siemens Industry, Inc. had sold and transferred

all assets of its specialised business unit Water Technologies to Siemens Water Technologies LLC, which had changed its name to *Evoqua Water Technologies LLC*, as apparent from the documents concerning the transfer); and (ii) submitted the relevant assignment thereof.

With letters of 2 July 2014 and 10 September 2014 the Respondent maintained its requests as to the inadmissibility of the appeal, which should be decided before the discussion on the substantive issues.

- XIV. In the summons to oral proceedings of 2 October 2014, the Board enclosed a communication to the parties, informing them of its provisional view that the appeal was inadmissible according to G 1/12, "*in the light especially of the statements of the Enlarged Board in points 20, 27 and 30 with respect to Rule 101(2) EPC and point 37 with respect to Rule 139 EPC*".
- XV. With letter dated 23 January 2015, the Appellant requested that the Board be enlarged to include two legal members, pursuant to Article 9 of the RPBA, and submitted further items of evidence, as follows:
- a) Annex 1: email of 29 January 2008, "*Subject: EP 11400330-Zenon appeal due 28 Feb*", from Mr Gibbs (representative) to Mr Scott Pundsack (external Canadian patent counsel of the Appellant), reminding him that notice of appeal was to be filed and appeal fees were to be paid by 28 April.
 - b) Annex 2: email of 5 February 2008, "*conversation: EP 11430- Zenon: appeal due 28 Feb*", from Mr Pundsack, instructing Mr Gibbs to file the notice and pay the fee.

- c) Annex 3: Mr Gibbs's letter of 4 April 2008 to Mr Pundsack, informing him that, for some "opaque" reason, Zenon Environmental, the old name, had been mentioned in the notice of appeal, that this had been queried by the EPO and that an objection of inadmissibility of the appeal had been raised by the Opponent.

- d) Annex 4 includes Exhibits:
 - (A) Sworn affidavit by Mr Gibbs dated 22 January 2015, reaffirming his declaration of 26 August 2011;
 - (B): email of Annex 2;
 - (C): email of Annex 1;
 - (D): Communication of the Registrar of the Board of 7 March 2008;
 - (E): Fax of 13 March 2008 by Mr Gibbs in reply to the communication of the Registrar;
 - (F): Mr Gibbs's letters of 4 April 2008 (Annex 3) and 8 February 2008.

- e) Annex 5: Sworn affidavit by Mr Pundsack dated 19 December 2014 (including the emails and the letter of Annexes 1 to 3 as Exhibits (A) to (C)).

- f) Annex 6: Letter of 5 June 2000 to the International Bureau of WIPO requesting a change of address of the former Applicant, *Zenon Environmental Inc.*

- g) Annex 7: Form PCT/IB/306 from the International Bureau, recording the requested change of address.

- h) Annex 8: "Extract from the Register of European Patents" regarding the change of the address.

- i) Annex 9: Extract from the assignment agreement between Zenon Environmental Inc and Zenon Technology Partnership

- XVI. The Board was enlarged to five members pursuant to Article 9 RPBA on 4 February 2015.
- XVII. With letters dated 26 February 2015 and 23 March 2015, the Appellant drew attention to decisions issued by the boards of appeal after G 1/12.
- XVIII. By fax dated 20 March 2015, the Respondent announced that neither the Respondent nor its representative would be attending the oral proceedings.
- XIX. Oral proceedings were held on 26 March 2015 in the announced absence of the duly summoned Respondent. The debate was restricted to the admissibility of the appeal.

Parties' requests

- XX. The Appellant requested correction of the relevant part of the notice of appeal dated 8 February 2008, namely of the name, address and nationality, and that the appeal be declared admissible. It also requested, as auxiliary requests, that the Board ask the President of the EPO for further observations pursuant to Article 18 RPBA and refer the following questions filed during the oral proceedings to the Enlarged Board of Appeal:
"(1) Does Rule 40(1)(b) EPC, which refers to "information identifying the applicant or allowing the applicant to be contacted" apply mutatis mutandis to the notice of appeal as suggested by Rule 99(3) EPC 2000?"

(2) *In particular, is the name and address of the Appellant's representative sufficient?"*

XXI. The Respondent, in its written submissions, had requested that the appeal be rejected as inadmissible.

The Appellant's arguments can be summarised as follows:

- a) The test "*no visible deficiency*", mentioned by the Board in its communication, was unsatisfactory, because a reference to the file was always appropriate, and could permit with sufficient certainty identification of the "*correct*" Appellant, complying with Article 107 EPC, despite a discrepancy in the notice of appeal (inverted commas from the Appellant).
- b) The notice of appeal should not be read in isolation from the file history. In the case at hand it was derivable from the file that the notice of appeal had been filed and the appeal fees paid, by the same representative as in the first instance proceedings, so that the Appellant was identifiable, namely the sole entitled Appellant, i.e. the Patent Proprietor, within the two-month period for filing the notice of appeal.
- c) This was demonstrated by the communication of the Registrar issued on 7 March 2008, before the expiry of the two-month time limit (8 March 2008).
- d) It was further evidenced by the submitted annexes, which proved that the wrong indication in the notice of appeal constituted a genuine error and did not reflect an intention on the part of the

representative to file the appeal in the name of *Zenon environmental Inc.*

- e) Still further evidence was that the address indicated in the notice of appeal was no longer the address of Zenon Environmental Inc. One could not understand why, if it had been the true intention to file on behalf of *Zenon Environmental Inc.*, the representative would have used an outdated address.
- f) Consequently the requested correction did not reflect a change of mind. The reason for the error was "opaque" to quote the representative in (A3) but could be explained by a lapse of concentration and the similarity in the names of the companies. In this respect, a plausible scenario was that the person in charge of preparing the notice of appeal simply copied the first page of the PCT application.
- g) A number of decisions cited by the Appellant had applied Rule 139 EPC (T 283/11; T 1706/02; T 2015/09; T 662/09) and accepted the correction of the error.
- h) The strict requirements applied in the case law with respect to mistakes in designation of states should not be applied to notices of appeal.

The arguments of the Respondent in its written submissions can be summarised as follows:

- i) The company mentioned in the notice of appeal was a real legal entity, different from the Patent Proprietor/Appellant.
- j) The fact that in the notice of appeal reference was made to the application and to the Examining

Division demonstrated that the representative was still at the stage of the examination proceedings. Thus, at the time of filing the notice of appeal, the true intention of the representative was to file the appeal on behalf of *Zenon Environmental Inc.*, the Proprietor of the application.

- k) It was only upon receipt of the communication sent by the Registrar that the Appellant became aware of the error in law made.
- l) Such an error in law could not be corrected, as decided in J 42/89 of 30 October 1991.
- m) The situation was comparable with that in G 2/04 (OJ 2005, 549) (point 3.1). The declarations in the opposition proceedings concerning the legal personality of the Appellant were quite clear and not open to interpretation. Another company, not the Opponent was indicated as the Appellant. In such a situation there was no deficiency which could be remedied in conformity with G 02/04.
- n) Having regard to G 1/12, such an error could not be corrected under Rule 101(2) EPC because the true intention when filing the notice of appeal was to file it in the name of the Applicant, *Zenon Environmental Inc.*
- o) As to Rule 139 EPC, the Enlarged Board referred to the principles established by the jurisprudence on Rule 88 EPC.
- p) It was clear from these principles that no correction under Rule 139 EPC was possible since it was originally intended to file an appeal in

the name of the Applicant, *Zenon Environmental Inc*, and the Appellant had not proven that the original intention was a different one.

- q) Proof of what was the original true intention was given in the letter of 2 December 2013 of the Appellant, during the referral proceedings. In that letter, the Appellant stated: "*Beyond the European representative, the partner ZEI is evidently also a contact point for the partnership ZTP. Further in view of the relationship between ZIP and ZTP, it could be supposed in the circumstances that the partner ZEI was acting on behalf of the partnership ZTP*". It resulted from this paragraph that *Zenon Environmental Inc* could act on behalf of *Zenon Technology Partnership*. The Appellant had argued that *Zenon Environmental Inc* was entitled to appeal. This statement supported the view that the true intention was to file an appeal in the name of *Zenon Environmental Inc*.

Reasons for the Decision

Admissibility of the appeal

1. The Patent Proprietor has requested the correction of the identity of the Appellant in the notice of appeal on the basis of either of Rules 101(2) and 139 EPC.
2. The context of the referral was summarised in point 7.1.1 and 7.2 of the referring decision. The present Board held that the current case belonged to the category of cases where the appeal was filed by the presumably entitled person who ultimately was however

not entitled. This situation, as submitted by the Opponent, could be the result of a mistake of law. But the recourse, in the case law of the Boards of appeal, to the subjective notion of the "true intention" had introduced uncertainty about whether, and to which extent, that notion could be taken into account to correct an identification in a notice of appeal.

3. The Enlarged Board's answer in G 1/12 (Point 40 of the Reasons) is clear: In cases of an error in the Appellant's name, the general procedure for correcting errors under Rule 139, first sentence, EPC is available under the conditions established by the case law of the Boards of appeal.
4. Therefore, the present Board has to determine whether the wrong statement concerning the Appellant's identity in the notice of appeal, or, as defined in point 34 of the Reasons of G 1/12, the "error of expression in the declaration", is the consequence of an error which can be rectified under Rule 139 EPC.
5. According to established case law on Rule 139 EPC, a "mistake" may be said to exist in a document filed with the EPO if the document does not express the true intention of the person on whose behalf it was filed. The mistake may take the form of an incorrect statement or an omission (J 06/91, OJ EPO 1994, 349, point 2.2 of the Reasons).
6. The Enlarged Board referring to the established case law specified (point 37 of the Reasons) that:
 - (a) The correction must introduce what was originally intended. The possibility for correction cannot be used to enable a person to give effect to a change

of mind or development of plans (J 08/80, OJ EPO 1980, 293).

(b) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one (J 08/80 already cited, point 6 of the Reasons).

(c) The error to be remedied may be an incorrect statement or an omission.

(d) The request for correction must be filed without delay.

7. In the present case, the Appellant had to establish that the statement regarding its identity in the notice of appeal was the result of an error in the expression of its true intention, so that the correction requested does not reflect a change of mind.

8. The Board concedes (to the Respondent) that it was not immediately clear that the appeal filed on behalf of *Zenon Environmental Inc*, a company fully identified with its address and nationality and different from the Patent Proprietor, was actually intended to be filed on behalf of *Zenon Technology Partnership*.

9. Regarding the requirements listed in G 1/12, the Board cannot accept that the mere fact that *Zenon Technology Partnership* was the party adversely affected during the opposition proceedings was sufficient to establish the true intention. As argued by the Respondent, other interpretations were possible. If it is indisputable that the notice of appeal is to be considered in the context of the file history, the true intention needs to be confirmed by external facts, at least to prevent

- requirements such as those of Article 107 EPC being circumvented.
10. It is established case law that procedural legal certainty is a higher value than true party intention and that legal certainty demands that the EPO be able to rely on statements made by the parties in proceedings (T 824/00 OJ EPO 2004, 005), point 8 of the Reasons). As a general rule, the parties are bound by their procedural acts notified to the EPO, provided that the procedural statement was unambiguous and unconditional.
 11. On the other hand, Rule 139 EPC acknowledges as a further legal value the desirability of having regard to the true as opposed to the ostensible party intentions in legal proceedings. As stated in decision J 19/03 of 11 March 2005 (not published in the EPO OJ):
" As a result of the conflict between these two legal principles, the case law reads Rule 88 [139] first sentence EPC so that it confers a discretion on the competent instance (here the board) to allow or not allow a correction of an error since it is only stated in this rule that a respective error "may be corrected".... In order to weigh the necessity for legal certainty and the interests of the public against the interest of an applicant, the jurisprudence developed criteria concerning when a correction of procedural acts may be allowable or not" (see points 5,6 and 7 of the Reasons of the decision).
 12. Coming to the evidence now on file, the Board cannot draw any conclusion from the communication from the registrar. This communication was intended to inform the parties of the commencement of the appeal proceedings. The registrar chose to point out a

discrepancy noted during the admissibility check by a hand written comment in the margin of this communication, and not to send a communication under Rule 101(1) or (2) EPC although authorised to do so ("Decision of the Presidium of the Boards of Appeal dated 12 November 2007 concerning the transfer of functions to the Registrars of the Boards of Appeal", supplementary publication, OJ EPO 1/2015, page 66).

13. Therefore, the Board has to consider the evidence on file as a whole in the light of the principles established in the case law.
- 13.1 The Appellant explained that by "opaque" reason in the letter of 4 April 2008 it meant a lapse of concentration due to the fact that the names of the two companies were similar. The most plausible scenario was that the person in charge of preparing the appeal simply copied the identity mentioned on the first page of the PCT application.
- 13.2 The additional evidence filed after the communication sent by the Board (*supra*) corroborates this explanation. In particular, from Annex 6 (a letter dated 5 June 2000 informing the International Bureau of WIPO of the change of address of *Zenon Environmental Inc*) it appears that the address on the notice of appeal was no longer the address of *Zenon Environmental Inc* at the time of filing the notice of appeal (March 2008).
- 13.3 This information sheds light on the insufficient evidence previously on file. In fact, the payment of the appeal fee by *Zenon Technology Partnership and the mention of its name* at the top of the notice of appeal was of much less significance in establishing the true

intention, than the complete identification of *Zenon Environmental Inc* given as the Appellant, and the only explanation that the reason for this statement was "opaque".

13.4 If, on the contrary, the Board considers the affidavit of Mr Pundsack, i.e the counsel, who instructed the representative to file the notice of appeal, and the fact that the address forming part of the identification block on the notice of appeal was no longer the valid one, then the mention of *Zenon Technology Partnership* at the top of the notice of appeal, the fact that the same representative has been in charge of the case during the opposition and the appeal proceedings, and the payment of the appeal fee by this company *Zenon Technology Partnership*, taken together become relevant, in the light of the plausible scenario that the person who prepared the appeal had in mind the right company, but instead just took a copy of the PCT application. These facts combine to establish beyond any reasonable doubt that the representative could not have had any doubts about the identity of the adversely affected company in the absence of any divergent instruction from the counsel, and there was no reason for the Appellant's representative to deviate from the intention to file an appeal on behalf of the only company adversely affected by the decision under appeal.

Therefore, the requested correction cannot result in enabling the Appellant to change its mind.

13.5 As to the statement made by the Appellant in the letter dated 3 December 2013, and cited out by the Respondent as further evidence that the appeal was intended to have been filed by the former Patent Proprietor on behalf of its subsidiary, this lost significance during

- the oral proceedings, in the light of the representative's explanation. The Board understands, from the explanation given during the oral proceedings, that this statement was purely hypothetical and a fallback argument designed to save the appeal by citing the case law on joined opposition.
- 13.6 Considering also the principle of legal certainty referred to above (point 10), according to which parties are bound by their procedural acts, the Board comes to the conclusion that the interests of Respondent are not sacrificed in the present case because, apart from the fact that the true intention was to file an appeal on behalf of the entitled person, the request for correction was filed five days after the expiry of the two-month time limit for filing the notice of appeal.
14. Accordingly, the Board concludes that the requirements for the correction requested are met, and thus that the correction is to be allowed. As a consequence, the appeal is retroactively admissible, the correction under Rule 139 EPC having effect *ex tunc*.
15. Since the Board comes to a positive conclusion under Rule 139 EPC, there is no need to decide on the request for correction under Rule 101(2) EPC.

Order

For these reasons it is decided that:

1. The request for correction of the name, the address and the mention of the nationality of the Appellant is allowed.
2. The appeal is admissible.

3. The proceedings on the substantive issues will be continued in writing.

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated