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Datasheet for the decision of 14 April 2016

Case Number: T 0577/11 - 3.2.05

Application Number: 03793808.1

Publication Number: 1540227

IPC: F16L15/06

Language of the proceedings: EN

Title of invention:
Threaded tube joint

Patent Proprietor:
Tenaris Connections Ltd.

Opponent:
Vallourec Oil and Gas France

Headword:
Entitlement to priority

Relevant legal provisions:

EPC Art. 61, 88(1), 104(1), 108
EPC R. 52(2), 52(5), 88(1), 97(1), 106
EPC 1973 Art. 21(4), 54(1), 54(2), 56, 60, 72, 87(1), 112(1)(a), 113, 116, 118, 150
EPC 1973 R. 38, 67
Act revising the Convention on the Grant of European Patents Art. 7(1)
Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC Art. 1
RPBA Art. 9, 12, 13, 15(5), 21
Business distribution scheme of the Technical Boards of Appeal Art. 3(1)

Charter of Fundamental Rights of the European Union Art. 17
First Protocol to the Convention for the Protection of Human Rights and Fundamental Freedoms Art. 1
Paris Convention Art. 4A, 4B, 4C, 4D, 19
PCT Art. 2(x), 8, 11(3), 27(5), R. 4.5(d), 4.10(a)

Keyword:

Admission of late-filed documents - no
Re-opening of the debate
Rule 106 EPC objection - dismissed
Oral submissions by an accompanying person – yes
Referral to the Enlarged Board of Appeal – no
Validity of the priority – no
Admission of the second and third auxiliary requests – yes
Novelty – yes (second auxiliary request)
Inventive step - no (all requests)
Reimbursement of the appeal fee – no
Apportionment of costs – no

Decisions cited:

G 0012/91, G 0003/93, G 0004/95, G 0002/04, G 0001/12, G 0001/13, R 0010/08, R 0014/10, J 0019/87, T 0271/85, T 1002/92, T 1008/96, T 1059/98, T 1056/01, T 0005/05, T 0062/05, T 0788/05, T 0493/06, T 0382/07, T 0160/13, T 0205/14, T 0517/14

Further decisions cited:

European Court of Human Rights, *Anheuser-Busch v Portugal*, decision of 1 November 2007

German Federal Court of Justice, decision of 16 April 2013, X ZR 49/12, *Fahrzeugscheibe*
German Federal Patent Court, decision of 15 February 2012, 5 Ni 59/10 (EP), and decision of 28 October 2010, 11 W (pat) 14/09
Higher Regional Court Düsseldorf, decision of 6 December 2012, I-2 U 46/12
German Imperial Patent Office, BlPMZ 1906, 127

High Court of Justice of England and Wales:
Edwards Lifesciences AG v Cook Biotech Incorporated, [2009] EWHC 1304 (Pat);
KCI Licensing Inc. et al. v Smith & Nephew PLC et al., [2010] EWHC 1487 (Pat);
HTC Corporation v Gemalto S.A., [2013] EWHC 1876 (Pat);
Idenix Pharmaceuticals Inc. v Gilead Sciences Inc. et al., [2014] EWHC 3916 (Pat)

Hoge Raad der Nederlanden, decision of 3 November 2006, *Nebula*, NJ 2007, 155

Catchword:

1. Continuation of the appeal proceedings after first oral proceedings before the board with the scheduling of second oral proceedings is not, as such, a reason for admitting new submissions filed after the first oral proceedings (see Reasons, point 2.3).

2. If the debate on a particular topic had been closed without announcement of a decision on the matter, the board has discretion over whether or not it re-opens the debate and over the extent to which it does so (see Reasons, point 3.1).

3. For a claimed priority to be valid pursuant to Article 87(1) EPC 1973, the applicant of a subsequent application claiming priority from an earlier application (priority application) who is not the person who filed the priority application must, when the subsequent application is filed, be that person's successor in title in respect of the priority application or of the right to claim priority. A succession in title that occurs after the filing date of the subsequent application is not sufficient to comply with the requirements of Article 87(1) EPC 1973 (see Reasons, point 6.5).

4. Where the applicant of the priority application and the applicant of the subsequent application contractually agree that (only) economic ownership ("economische eigendom" under Dutch law) of the priority application and the right to claim its priority is to be transferred to the subsequent applicant, this is not sufficient to consider the latter a successor in title within the meaning of Article 87(1) EPC 1973 (see Reasons, point 6.6.2).

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Case Number: T 0577/11 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 14 April 2016

Appellant: (Patent Proprietor)	Tenaris Connections Ltd. 112 Bonadie Street Kingstown (VC)
Representative:	Bruno Cinquantini Notarbartolo & Gervasi S.p.A. Corso di Porta Vittoria, 9 20122 Milano (IT)
Respondent: (Opponent)	Vallourec Oil and Gas France 54, rue Anatole France 59620 Aulnoye-Aymeries (FR)
Representative:	Gabriel de Kernier Cabinet Netter Conseils en Propriété Industrielle 36, avenue Hoche 75008 Paris (FR)
Decision under appeal:	**Decision of the opposition division of the European Patent Office posted on 21 January 2011 revoking European patent No. 1540227 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	M. Poock
Members:	H. Schram
	M. Blasi
	P. Lanz
	T. Karamanli

Summary of Facts and Submissions

I. On 4 March 2011 the appellant (patent proprietor) lodged an appeal against the decision of the opposition division, posted on 21 January 2011, by which European patent No. 1 540 227 was revoked. The statement setting out the grounds of appeal was filed on 26 May 2011.

II. The documents referred to in the present decision include the following:

D1 WO 03/048623;

D2 US 3,870,351;

D6 WO 00/66928;

D7 US 5,007,665;

D8 VAM® Catalog No. 940, March 1997, 12 pages;

D9 API Specification Standard 5B, 14th edition, August 1996, front page, page 9, and 2 pages Errata, date of issue 9 April 1998;

D15 EP-A 0 708 224;

D16 EP-A 0 916 883;

D19 Patent assignment agreement between Tenaris Connections·BV and Tenaris·Connections AG, entered into as of 9 September 2003;

D20 First legal opinion of Mr Th. C. J. A. van Engelen dated 3 July 2015;

D21 First legal opinion of Messrs F. Boscariol and D. Martucci dated 30 June 2015;

D22 First observations under Article 115 EPC with 24 annexed documents comprising copies of decisions and of legal literature, filed by Mr M. Haedicke with letter of 29 June 2015 and re-filed by the appellant with letter of 3 July 2015;

D23a Observations under Article 115 EPC filed by Mr B. Oosting with letter of 6 July 2015;

D23 Email exchange between Ms E. Rossetti of Notarbartolo & Gervasi S.p.A. and Mr D. Milesi between 15 and 23 May 2003;

D24 Email exchange between Ms A. Gerli of Notarbartolo & Gervasi S.p.A., Mr D. Milesi and Mr J. Ojam between 24 June and 14 July 2003;

D25 Letter of Ms A. Gerli dated 28 July 2003 to Mr D. Milesi concerning "foreign filings in the name of Tenaris Connections AG of Italian patent application No. RM2002A000445";

D26 Invoice of Notarbartolo & Gervasi S.p.A. dated 29 August 2003 to Tenaris Connections AG;

D27 Second legal opinion of Messrs F. Boscariol and D. Martucci dated 11 March 2016 including Exhibits 1 to 5;

D28 Second legal opinion of Mr Th. C. J. A. van Engelen dated 14 March 2016 with a copy of decision J 19/87 and of the opinion dated 25 June 1984 referred to in that decision;

D29 Second observations under Article 115 EPC filed by Mr M. Haedicke with letter of 17 March 2016 with copies of legal literature and of parts of the *travaux préparatoires* to the Paris Convention and to the EPC 1973.

III. European patent application No. 03 793 808.1, which matured into the European patent mentioned above, was based on international application PCT/EP2003/009870 (published as WO 2004/023020). This international application filed under the PCT [hereinafter referred to as "international application" or "subsequent application"], for which the EPO acted as designated Office, had been filed in the name of Tenaris Connections AG as applicant for all designated states except the United States of America and of five natural persons as applicants for the United States of America on 6 September 2003. Priority was claimed from Italian application No. RM2002A000445 of 6 September 2002 [hereinafter referred to as "priority application"], filed in the name of Tenaris Connections BV.
The declaration of priority was submitted upon filing of the subsequent application by indication of the priority data in the dedicated section of PCT request form PCT/RO/101. No declaration as to the applicants' entitlement, at the international filing date, to claim the priority of the earlier application (see Box VIII(iii) of Form PCT/RO/101) was submitted upon or after the filing of the subsequent application.

Patent assignment agreement D19 [hereinafter referred to as "Agreement"] between Tenaris Connections·BV, a corporation organised and existing under the laws of the Netherlands (assignor), and Tenaris·Connections AG, a corporation organised and existing under the laws of the Principality of Liechtenstein (assignee),

concerning *inter alia* the assignment of the rights of said Italian patent application, the rights to the invention and the priority right (section 1 of the Agreement), was entered into as of 19 September 2003. Section 4 of said Agreement reads:
"This Agreement has a retroactive effect to commence as from January 1, 2003. As from the effective date the ASSIGNEE is considered the sole and exclusive owner of the Patents."

IV. The opposition division held that the invention claimed in claim 1 of the main request then on file was disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC in combination with Article 83 EPC), but that the subject-matter of said claim did not meet the requirements of Article 100(c) EPC in combination with Article 123(2) EPC.

The opposition division was of the opinion that priority had been validly claimed, since Agreement D19 proved that the transfer of rights, including priority rights, took place with effect from 1 January 2003, which was before the filing date of the later European application. Document D1 was therefore comprised in the state of the art according to Article 54(3) EPC.

The opposition division further held that claim 1 of the first and second auxiliary requests filed during the oral proceedings before the opposition division on 7 December 2010 did not contain subject-matter which extended beyond the content of the application as filed (Article 100(c) EPC in combination with Article 123(2) EPC), but that the subject-matter of said claims did not involve an inventive step with

respect to document D2 (Article 56 EPC).

V. In its statement of grounds of appeal, the appellant did not address the validity of the claimed priority.

In its reply, the respondent contested the validity of the claimed priority.

VI. At the appeal stage, the appellant requested that its name and address be changed in the European Patent Register. It was submitted that the company, incorporated under Liechtenstein law, was permitted to use any of the names "Aktiengesellschaft" (or "AG") and "Limited" (or "Ltd"), that it had been migrated to Saint Vincent and the Grenadines and registered there under the name "Tenaris Connections Limited", and that the registration neither created a new legal entity nor affected the identity or continuity of the company as previously constituted. The entries in the European Patent Register were accordingly changed to "Tenaris Connections Ltd.", with an address in Kingstown, VC.

VII. In a (first) communication accompanying the summons to attend (first) oral proceedings dated 12 May 2015, the board expressed its provisional opinion that, although Agreement D19 including its retroactive effect might be a valid agreement under national law, this could not overcome the fact that it had been concluded after the filing date of the European patent application, and so the priority was not validly claimed (see, in particular, point 5.6 of said communication). The board also indicated that no substantial procedural violations had occurred, that the calling into question of the validity of the priority by the respondent (opponent) could not be considered an abuse of proceedings, that it saw no reason to order a different

apportionment of costs (see points 6 and 7 of said communication), that it appeared that claim 1 of the main request met the requirements of Article 123(2) EPC and Articles 83 and 84 EPC 1973 (see points 8 and 9 of said communication) and that the subject-matter of claim 1 of the main request seemed to be new vis-à-vis document D1 (see point 10 of said communication).

VIII. On 29 June 2015 Mr Haedicke filed (first) observations under Article 115 EPC regarding the retroactive transferability of a priority right (D22).

IX. In a letter of 3 July 2015, the appellant addressed *inter alia* the validity of the claimed priority, relying on legal opinions of Mr Van Engelen (D20) and of Messrs Boscariol and Martucci (D21), as well as on the observations of Mr Haedicke (D22). It was submitted that the assignment as of 9 September 2003 due to Agreement D19, although it had occurred after the filing of the subsequent application, was sufficient for the priority to be considered validly claimed. Secondly, Agreement D19 provided for a retroactive effect. According to another line of argument the priority right had been transferred, in accordance with Italian law, by "carrying out convincing behaviour" between companies of the same group, namely the filing of the subsequent application in the name of Tenaris Connections AG.

X. On 6 July 2015 Mr Oosting filed observations under Article 115 EPC regarding the validity of Agreement D19 under Dutch law (D23a).

XI. On 28 July 2015 the board in the composition provided for by Article 21(4)(a) EPC 1973 and Article 3(1) of the Business distribution scheme of the Technical

Boards of Appeals (cf. OJ EPO 2015, Supplementary publication No. 1, II.3) decided to enlarge its composition to three technically qualified members and two legally qualified members in accordance with Article 9 of the Rules of Procedure of the Boards of Appeal (RPBA) and Article 21(4)(b) EPC 1973.

XII. First oral proceedings were held before the board on 3 August 2015.

During those oral proceedings the board came *inter alia* to the conclusions that the subject-matter of claim 1 of the main request and of the first auxiliary request did not involve an inventive step with respect to document D2 and that the subject-matter of claim 1 of the second auxiliary request involved an inventive step with respect to document D2 and, if the claimed priority were not valid, would not involve an inventive step with respect to document D1. The third auxiliary request was not discussed.

The issues discussed in the oral proceedings further included:
- the validity of the claimed priority,
- the appellant's request for a different apportionment of costs, and
- the substantial procedural violations alleged by the appellant, see minutes, page 5 to page 7, fourth paragraph.

During the oral proceedings the appellant's representative filed the following declaration in support of its allegation that prior to the filing of the subsequent application a transfer of the priority right had been orally agreed upon between Tenaris Connections BV and Tenaris Connections AG:

"I undersigned ... hereby declare that prior to the date of 06.09.2003 I received instructions from the responsible person for IP and my usual contact in the Company Tenaris Connections BV to file a PCT patent application claiming priority of the Italian patent application RM2002A445 in the name of Tenaris Connections AG, with the information that the latter Company was the new owner. I add that the responsible person for IP matters of Tenaris Connections BV was the same as the responsible person for IP of Tenaris Connections AG. I then instructed our paralegal staff to prepare accordingly the PCT patent application which was timely filed on 06.09.2003. Truthfully declared in Munich on 03.08.2015 [SIGNATURE]"

Said declaration was not admitted into the proceedings. The parties confirmed that, if the board were to decide to refer questions to the Enlarged Board of Appeal, they wished to comment on the questions beforehand. The chairman declared the debate closed with regard to the issues discussed in the oral proceedings and informed the parties that the proceedings would be continued in writing, see minutes, page 7, second and third last paragraphs.

XIII. In a letter dated 1 December 2015, the respondent referred to the fact that the debate as to the issue of priority was closed and requested that evidence which might be presented by the appellant not be admitted into the proceedings.

XIV. In a (second) communication accompanying the summons to attend (second) oral proceedings dated 2 February 2016 the board *inter alia* expressed its provisional opinion that the claimed priority was not valid and that the

main reason for arriving at this opinion was that at the actual time of filing of the subsequent application Tenaris Connections AG had not been the owner of the priority application and/or the right to claim priority from it. In this context, the board stated in point 3.2.2, second paragraph: *"With respect to the appellant's submissions regarding Italian law, the board does not consider it as proven that the legal ownership of either the priority application or the priority right was transferred with retrospective effect to Tenaris Connections AG"*. The board further indicated that it did not intend to refer questions of law to the Enlarged Board of Appeal and gave a preliminary opinion on the allowability of the third auxiliary request.

XV. By letter dated 14 March 2016, the appellant submitted that the priority right had been transferred prior to the filing of the subsequent application under Italian law on the basis of the enclosed evidence (D23 to D26), presented further additional arguments and filed a second legal opinion of Messrs Boscariol and Martucci (D27) and a second legal opinion of Mr Van Engelen (D28). The appellant requested that the following questions be referred to the Enlarged Board of Appeal:

> *"1. Must the transfer of right of priority be proven in a formal way and by applying the high standard of proof as required by Article 72 EPC or is it sufficient to apply the means within the meaning of art.117EPC?*
>
> *2. In view of the decisions T517/14 and T205/14, where the Board decided that the applicable law in transferring a right of priority to a successor in title is <u>exclusively</u> the national law and where the*

national law allows retrospective transfer of rights, can such transfer be recognized under the EPC? If the answer is no, is it allowable to limit the effect of the applicability of the national law in case of retroactive effect of a contract, by means of a literal interpretation of the EPC and of the Paris Treaty and is retroactivity of a contract transferring the priority right against the principles of the EPC?

3. Is it necessary for the enjoyment of a priority right under article 87(1) EPC that the "succession in title" qualifies as a transfer of legal ownership of either the priority application or the priority right or may (i) a transfer or grant of an equitable interest, like economic ownership, or (ii) any other form of contractual consent from the applicant of the priority application be sufficient to meet the requirements of article 87(1) EPC?

4. Is it necessary for the enjoyment of a priority right as provided for in article 87(1) EPC that the "succession in title" must have taken place before or when the European application is filed, or is it sufficient that this succession takes place before or when the declaration of priority of article 88(1) EPC is filed in accordance with the Implementing Regulations (i.e., sixteen months from the earliest priority date claimed as provided for in Rule 52(2) EPC)? If the answer to this question is that it is not necessary that the succession has taken place before or when the European application is filed, is it then necessary that the succession has retroactive effect or not?

5. Are the concepts of "enjoyment" of a priority right and "successor in title" within the meaning of article 87(1) EPC autonomous concepts of European Patent Convention law or are these concepts to be interpreted by applying national law?

6. If the answer to the last question is that national law must or can be applied, which national law must or can in that case then be applied: (i) the law of the state of the priority application, (ii) the national law that applies to the legal relationship between the transferor and the transferee of the right of priority, (iii) the national law of the domicile of the transferor, (iv) the national law of the domicile of the transferee, (v) any other national law that may apply in conformity with general accepted principles of private international law, or (vi) any other national law?"

XVI. On 17 March 2016 Mr Haedicke filed second observations under Article 115 EPC regarding the retroactive transferability of a priority right (D29).

XVII. Second oral proceedings were held before the board on 14 April 2016.

During those oral proceedings the appellant's representative filed the following objection under Rule 106 EPC:

"Munich *14.4.2016 11h30*
Appeal case T0577/11
The Patentee objects under Rule 106 EPC*, because of the procedural defect made by the Board, as a*

fundamental violation of Art. 113 EPC occurred. In the 1st oral proceedings the debate on validity of the priority rights under Italian law were not the object of a decision. By not reopening this part of the debate the Patentee has been deprived of its right to present all comments important for the decision to be taken by the Board.

For the Patentee

[Signature]"

At the end of the oral proceedings, the parties confirmed their requests as follows:

The appellant requested that

- the decision under appeal be set aside and that the patent be maintained in amended form on the basis of any of the sets of claims filed as the main request and the first to third auxiliary requests with the statement of grounds of appeal dated 25 May 2011,
- questions of law be referred to the Enlarged Board of Appeal,
- the appeal fee be refunded for substantial procedural violations committed by the opposition division,
- a different composition of the opposition division be ordered in case of remittal, and
- an apportionment of costs in favour of the appellant be ordered.

The respondent requested that the appeal be dismissed.

After deliberation, the chairman announced the board's decision.

XVIII. Claim 1 of the main request reads as follows:

"A threaded tube joint, comprising a male threaded tube member (1) and a female threaded tube member (2) with substantially cylindrical walls,

the male member (1) having a toroidal sealing surface (11) placed at its end portion near the threaded portion thereof engaging for sealing purpose, when the male and female members (1, 2) are in the assembled position,

a corresponding frusto-conical sealing surface (12) of the female threaded tube member (2) placed near a threaded portion

wherein the radius Rs of the toroidal sealing surface has a value comprised in the range 30 and 100 mm when OD is greater than 140 mm and is comprised in the range of 30 and 75 when OD is less than 140 mm

characterised in that

there is provided a thread with trapezoidal profile and with a clearance equal to or less than 0,15 mm between the stab flank (6) of the male member (1) and the corresponding stab flank (5) of the female member (2) in the assembled position and in that

a diametric interference (δ) between the toroidal sealing surface (11) and the frusto-conical sealing surface (12) is in the range from 0,2 mm to 1,0 mm."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the expression "and in that a contact length "b" between the toroidal sealing surface (11) and the frusto-conical sealing surface (12) is longer than 0,5 mm" has been added at the end of the claim.

Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the expression "and

in that the male member (1) has a front end frusto-conical abutment surface (9) forming an angle (γ) comprised in a range between -15° and -5° with a plane orthogonal to a longitudinal axis (X) defined by the joint" has been added at the end of the claim.

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the expression "in that a contact length "b" between the toroidal sealing surface (11) and the frusto-conical sealing surface (12) is longer than 0,5 mm" has been added before the expression "and in that the male member ...".

XIX. The arguments of the appellant, in writing and during the oral proceedings, may be summarised as follows:

Inventive step starting from document D2 - main request and first auxiliary request

Document D2 did not disclose the characterising features of claim 1 of the main request, namely that (a) the clearance between the stab flank of the male member and the corresponding stab flank of the female member had to be equal to or less than 0.15 mm in the assembled position, and (b) the diametric interference δ between the toroidal sealing surface and the frusto-conical sealing surface had to be in the range from 0.2 mm to 1.0 mm. The claimed range for the threading clearance ensured that under high compressive loads the threading contributed to absorbing part of the compression load. The gap between the thread stab flanks defined the moment in time when during loading of the joint the structural compressive load was shared by the threaded area, thus increasing compression resistance as from the point in time when the stab

flanks started being in contact. Consequently, it was clear that the pin seal member and the box seal member would suffer a relative axial movement as the load was changing from tension to compression or *vice versa*. By means of the claimed range for δ, the radial interference in the seal region was always ensured, independently of the traction forces acting on the joints. As the metal seal contact was made on a frusto-conical surface, it was clear that there was a dependency between the relative axial position and the actual diametric interference deriving from the taper effect. These features were linked together in a synergic manner. They provided improved sealing for a wide range of operational loads, such as axial, compression and bending loads. However, the synergic effect had not been recognised by the opposition division, see Reasons, point 17.2.3, last paragraph.

Document D2 taught an arcuate profile at the end of the male member with a view to increasing the contact pressure, cf. column 2, lines 37 to 57, and column 1, lines 63, to column 2, line 7, and Figures 7 and 8. The skilled person would not turn to document D16, since that document taught a straight profile at the end of the male member (cf. Figures 4 and 5) and explicitly referred to the disadvantages of an arcuate profile, cf. paragraphs [0016] to [0018] and Figure 3. The skilled person would also not turn to document D9, since the male member shown in Figure 5 had no toroidal sealing surface placed at its end portion near the threaded portion for engaging a corresponding frusto-conical sealing surface of the female member. The skilled person, starting from the threaded joint according to document D2, would not consider any of documents D6 or D7 and documents D15 or D16 to look for a solution to a coherent problem such as the

optimisation of the sealing capacity of a premium threaded joint, as they referred to other types of joint. The subject-matter of claim 1 of the main request was hence not obvious to the skilled person.

The further limiting feature of claim 1 of the first auxiliary request, namely (c) "a contact length "b" between the toroidal sealing surface (11) and the frusto-conical sealing surface (12) is longer than 0,5 mm", maximised the seal response. It was not independent of features (a) and (b) discussed above; all three characterising features of said claim formed a functional combination. The subject-matter of claim 1 of the first auxiliary request was hence not obvious to the skilled person.

Validity of the priority

As to the applicable law, (1) the laws of the Netherlands were involved because Agreement D19 indicated in section 5 that the contract should be governed by the laws of the Netherlands, (2) the laws of Italy were involved because the priority right originated from an application filed with the Italian Patent and Trademark Office and (3) the EPC was involved because the patent in suit was a European patent claiming priority from the earlier Italian patent application. The laws of Liechtenstein were not relevant.

The following five lines of argument established that Tenaris Connections AG was to be considered a "successor in title" of Tenaris Connections BV for the Italian priority application or the right to claim priority from it:

Transfer of ownership as of 9 September 2003 based on section 1 of Agreement D19, line (i)

The transfer of the priority application and the priority right which occurred on 9 September 2003, i.e. three days after filing of the subsequent application, was sufficient for the priority right to be validly claimed. This date was prior to the 16-month period available under the revised EPC for filing the declaration of priority. There was no requirement derivable from Article 87(1) EPC 1973 that the subsequent applicant had to be the successor in title when the subsequent application was filed. The 12-month period was relevant only for the filing of a subsequent application. There was no requirement that the subsequent applicant had to prove his entitlement to claim priority. A broad approach followed from the legal changes under EPC 2000 and was beneficial for the applicants of the priority and subsequent applications. Third parties were not adversely affected.

Transfer of ownership with retroactive effect as from 1 January 2003 based on section 4 of Agreement D19, line (ii)

As section 4 of Agreement D19 provided for a retroactive effect, the priority application and the right to claim its priority had been transferred from Tenaris Connections BV to Tenaris Connections AG as from 1 January 2003.

With respect to Italian law, all the rights mentioned in Agreement D19 were validly transferred with effect as from 1 January 2003 because on the basis of the principle of freedom of contract enshrined in Article 1322 of the Italian Civil Code it was

permissible to provide for a retroactivity clause. In support, reference was made to legal opinion D21.

With respect to Dutch law, section 4 was to be interpreted in the sense that the parties agreed to transfer with retroactive effect the "economische eigendom" (economic ownership), but not the legal ownership. This was sufficient, however, as shown by decision J 19/87, the *travaux préparatoires* of the Washington Conference of 1911 for revising the Paris Convention and decisions T 205/14 and T 517/14.

Transfer agreement "by carrying out convincing behaviour" within a corporate group, namely the filing of the subsequent application, line (iii)

Under Italian law, no particular form was required for a contractual assignment of a patent application or a priority right and such a contract could be entered into "by carrying out convincing behaviours", i.e. via a mutual agreement "manifested by conclusive action". The ownership of the priority application and the priority right was legally acquired by Tenaris Connections AG under Italian law when it carried out a "convincing behaviour" showing that the application and the priority right belonged to it. In view of the fact that Tenaris Connections BV and Tenaris Connections AG were companies of the same corporate group Tenaris SA, the filing of the subsequent application in the name of Tenaris Connections AG constituted convincing behaviour showing that Tenaris Connections AG was the rightful owner of the priority application and the priority right derived from it. Thus, Tenaris Connections AG acquired ownership of the priority application and the priority right arising from it upon filing the subsequent application (appellant's letter of

3 July 2015, page 7, third paragraph, and legal opinion D21, page 6, third paragraph). Reference was made in this context to Italian case law on trade marks, in particular the theory of the group trade mark and free circulation inside a corporate group. Agreement D19 was concluded after the filing of the subsequent application only in order to produce written evidence of the previous assignment ("*ad probationem*").

Transfer of ownership by way of an oral agreement prior to the filing of the subsequent application, line (iv), and admission of the written declaration of the appellant's representative

Prior to the filing of the subsequent application, a transfer of the priority right had been orally agreed upon between Tenaris Connections BV and Tenaris Connections AG. The appellant's representative had received instructions from Tenaris Connections BV for the filing of the subsequent application in the name of Tenaris Connections AG (see his declaration filed during the first oral proceedings as proof of the existence of an oral agreement on the transfer of the priority application prior to the filing of the subsequent application). The priority right did not need to be mentioned as it was an accessory right to the application, which was automatically transferred with the application under Italian law (see page 5, fourth paragraph, and the paragraph bridging pages 6 and 7 of the minutes of the first oral proceedings). These submissions and said declaration should be admitted into the proceedings.

Transfer by an agreement "manifested by conclusive action" prior to the filing of the subsequent application, line (v), and admission of documents D23 to D29 into the proceedings

The written submissions of 14 March 2016 together with the appended documents D23 to D28, as well as document D29, which was filed by a third party but was declared to represent the appellant's own submissions, should be admitted into the proceedings.

Documents D23 to D27 had been filed in reaction to the non-admission of the declaration of the appellant's representative at the first oral proceedings. Any doubts of the board would now be overcome. Documents D23 to D26 had been retrieved from the internal files in the representative's Milan office a few days after the first oral proceedings before the board. The documents showed that there had been "conduct" between Tenaris Connections BV and Tenaris Connections AG which demonstrated that the priority right had been transferred according to Italian law before the filing of the subsequent application.

As the issue of transfer of ownership had existed since the beginning of the appeal proceedings, the respondent could be expected to deal with it and could not have been taken by surprise. These documents had also been filed in reaction to the board's statement in point 3.2.2, second paragraph, of its communication of 2 February 2016 (cf. point XIV above).

Document D27 supported the existence of an agreement between Tenaris Connections BV and Tenaris Connections AG "manifested by conclusive action" according to Italian law prior to the filing of the subsequent

application. Mr Milesi, responsible for IP matters in both companies, sent instructions to the representative's firm that the subsequent application should be filed in the name of Tenaris Connections AG. In August 2003, Tenaris Connections AG was informed by the representative's firm of the filing of the subsequent application claiming priority from the earlier Italian application.

Documents D23 to D27 were therefore highly relevant, as they could be expected to change the outcome of the case, and should be admitted in line with decision T 1002/92. The new submissions did not represent a change to the appellant's case that the priority right had been transferred under Italian law before the filing of the subsequent application. Non-admission by the board would violate Article 1 of the First Protocol to the Convention for the Protection of Human Rights and Fundamental Freedoms (European Convention on Human Rights, "ECHR").

Legal opinion D28 was relevant in the event that the transfer of the priority right before the filing of the subsequent application was not accepted by the board, and like document D29 it contained arguments for matter which was in the proceedings.

Re-opening of the debate on the validity of the priority

In view of the above, the debate, although it had been closed with respect to the issue of validity of priority, had to be re-opened. The debate had only been closed due to the lateness of the day, the sole open question being whether a referral to the Enlarged Board of Appeal would be made. The facts had now changed,

because the board itself had addressed this issue in point 3.2.2 of its second communication and because *prima facie* highly relevant evidence had been filed by the appellant which provided proof that the priority right had indeed been transferred in time. This required the debate on this point to be re-opened.

Not re-opening the debate constituted a fundamental violation of Article 113 EPC 1973, and an objection under Rule 106 EPC was raised accordingly (see point XVII above). In the first oral proceedings, the validity of the priority under Italian law had not been the subject of a decision. Not re-opening this part of the debate deprived the appellant of its right to present all comments important for the decision to be taken by the board.

Referral to the Enlarged Board of Appeal

Questions of law should be referred to the Enlarged Board of Appeal to ensure uniform application of the law. With respect to Agreement D19, the board's approach was inconsistent with decisions T 62/05 and T 1008/96. Further, the board's view of the interpretation of the term "successor in title" within the meaning of Article 87(1) EPC 1973 diverged from decisions J 19/87, T 205/14 and T 517/14. Moreover, the concepts needed to be primarily, if not exclusively, governed by convention law instead of national law. Furthermore, important points of law arose, also in view of Article 1 of the First Protocol to the ECHR and Article 17 of the Charter of Fundamental Rights of the European Union (2000/C 346/01).

Admission of the second and third auxiliary requests

The second and third auxiliary requests had been filed with the statement setting out the grounds of appeal in an attempt to overcome the objection of lack of inventive step raised in the opposition proceedings and should therefore be admitted into the appeal proceedings.

Novelty and inventive step – second and third auxiliary requests

Document D1 did not disclose a length for the clearance d1 between the stab flanks of the male and female members shown in Figure 14. The subject-matter of claim 1 of the second auxiliary request was therefore new for this reason alone. Figure 1 of document D1 described a threaded joint of the prior art, see page 10, line 5, to page 13, line 15. In this section (see in particular page 11, lines 8 and 9), reference was made to trapezoidal threads of the type known as "buttress" threads as defined in American Petroleum Institute (API) specification 5B, cf. document D9, page 9. The clearance mentioned therein did not pertain to embodiments of the invention according to document D1, since these were described on page 13, lines 17 et seqq., and shown for example in Figures 2 and 5. The respondent's argument that the clearance of API specification 5B was part of the disclosure of document D1 thus failed. Document D1 was silent about the diametric interference. Because the form of the lip sealing surface 5 was not a toroidal sealing surface as in the invention, the diametric interference could not be inferred from R1. This was a second difference with respect to document D1.

The subject-matter of claim 1 of the second auxiliary request also involved an inventive step with respect to document D1 for the same reasons as given above for the subject-matter of claim 1 of the first auxiliary request with respect to document D2.

Refund of the appeal fee

A refund of the appeal fee was requested in view of several substantial procedural violations committed by the opposition division. A refund was therefore to be considered equitable.

Apportionment of costs

An apportionment of costs incurred during the opposition proceedings in favour of the appellant was requested on account of an abuse of procedure by the respondent, because the validity of the priority had been contested at a very late stage of the opposition proceedings. This request had not been submitted at an earlier stage because the appellant had not been asked at the end of the oral proceedings before the opposition division whether it had any further requests and because the request had not been considered until after the oral proceedings.

XX. The arguments of the respondent, in writing and during the oral proceedings, may be summarised as follows:

Inventive step starting from document D2 - main request and first auxiliary request

Document D2 disclosed a threaded tube joint with all the features of the preamble of claim 1 of the main request. The male and female threads of said threaded

tube joint had a trapezoidal profile. This document did not disclose a value or a range for the clearance between the stab flanks of the male and female members in the assembled position, nor a value or a range for the diametric interference. However, the skilled person knew that said clearance should be minimised with a view to minimising the axial relative movements of the male and female members (see also paragraphs [0028] to [0030] of the patent). The range for the clearance claimed in claim 1 of the main request, namely ≤ 0.15 mm, was well-known from the prior art (see e.g. document D6, page 8, lines 23 to 30, document D7, column 2, lines 35 to 40, and document D9, page 9). The skilled person further knew that the diametric interference depended on the diameter of the joint and that the mean contact pressure between the male and the female members increased with the diametric interference (see also paragraph [0017] of the patent). The diametric interference should be sufficient to provide an excellent seal (see column 1, line 61, of document D2). The range for the diametric interference δ claimed in claim 1 of the main request, namely 0.2 mm ≤ δ ≤ 1.0 mm, was also well-known from the prior art (see e.g. document D15, page 2, lines 35 to 36, and Table 2 as well as document D16, Tables 1 and 3). It followed that the subject-matter of claim 1 of the main request did not involve an inventive step.

According to claim 1 of the first auxiliary request the contact length between the surfaces of the male and female members had to be longer than 0.5 mm. The skilled person knew that the contact length was directly related to the design of the sealing surfaces and to the level of diametric interference (see also paragraph [0018] of the patent). Figure 3 of document D2 showed a large contact length ("seal 21") between

the surfaces of the male and female members. Since the length of the radius R1 was between 50 and 300 mm (see column 4, line 30, and Figure 4), and taking the diametric interference known from Table 1 or 3 of document D16, the resulting contact length was inevitably longer than 0.5 mm. The subject-matter of claim 1 of the first auxiliary request therefore did not involve an inventive step.

Validity of the priority

The appellant did not take a clear position as to which law it considered to be applicable. "Law shopping" should not be admitted.

Transfer of ownership as of 9 September 2003 based on section 1 of Agreement D19, line (i)

When the subsequent application was filed, Tenaris Connections AG was not yet the successor in title of Tenaris Connections BV. As the priority right had not been transferred before expiry of the 12-month priority period, it no longer existed and therefore a subsequent transfer was not possible. The 16-month period for filing the declaration of priority or later points in time were not relevant. What was relevant was the filing of the subsequent application, even in situations where it was filed prior to expiry of the 12-month period.

Transfer of ownership with retroactive effect as from 1 January 2003 based on section 4 of Agreement D19, line (ii)

The acquisition of the "economische eigendom" on the basis of Agreement D19 was not sufficient to meet the

requirement of "successor in title" within the meaning of Article 87(1) EPC 1973. Acquisition of the legal title was necessary. Decision J 19/87 could not be relied upon because property law in the UK was different and not applicable to the present case.

Transfer agreement "by carrying out convincing behaviour" within a corporate group, namely the filing of the subsequent application, line (iii)

Such a transfer upon filing was not proven. Agreement D19 did not refer to a transfer which had already taken place. The language rather suggested that a transfer of rights was agreed upon for the first time at the date of conclusion of Agreement D19, thus on 9 September 2003.

Transfer of ownership by way of an oral agreement prior to the filing of the subsequent application, line (iv), and admission of the written declaration of the appellant's representative

The appellant's submissions relating to a prior oral transfer made during the first oral proceedings should not be admitted because they were late. The filed evidence was not complete since the person giving the instructions was not identified. Moreover, the declaration of the appellant's representative constituted no proof that there had been a transfer by oral agreement or even a transfer of the priority right at all. The priority right was an independent right and thus to be distinguished from the priority application. It was not clear in relation to what subject-matter Tenaris Connections AG was "the new owner". Agreement D19 too provided no proof, as it did not make any reference to a transfer which had occurred earlier.

Transfer by an agreement "manifested by conclusive action" prior to the filing of the subsequent application, line (v), and admission of documents D23 to D29 into the proceedings

Documents D23 to D29 should not be admitted into the proceedings. They should have been filed together with the grounds of appeal. Their filing could also not be considered as a legitimate reaction to the first oral proceedings. Furthermore, they had been filed at a very late stage, only about one month before the second oral proceedings. In view of the newly filed evidence a number of uncertainties and further questions arose. In particular, it was not clear for which companies Mr Milesi worked and what powers he had. In documents D23 and D24 there was no reference to an oral contract or to a transfer that had already taken place. Due to the addition of "if possible" after Mr Milesi's statement in his email dated 23 May 2003 to Ms Rosetti "that all patents shall be filed directly in the name of Tenaris Connections [AG]" (cf. document D23), said statement could not be considered as an instruction. The submitted email exchange ended on 14 July 2003. The evidence D23 to D25 suggested that it was intended that transfers of rights should be made by means of a signed written contract, as also shown by the existence of Agreement D19. The content of the latter would be contradictory if the rights had already been transferred.

Re-opening of the debate on the validity of the priority

The appellant had not requested a re-opening of the debate in advance of the second oral proceedings. The debate on the validity of the priority had been closed,

and it was a surprise that it was now to be re-opened. There was also no change in the case, and the appellant should have filed the documents prior to the first oral proceedings. Furthermore, it was consistent case law that two sets of oral proceedings were not held when the facts remained unchanged.

Referral to the Enlarged Board of Appeal

A referral should not be made. There was no need to refer questions to the Enlarged Board of Appeal.

Admission of the second and third auxiliary requests

The appellant's requests were not convergent in the sense that the second auxiliary request no longer contained the additional feature of claim 1 of the first auxiliary request. The second and third auxiliary requests contained the feature that the front end frusto-conical abutment surface of the male member formed an angle γ comprised in a range between -15° and -5° with the longitudinal axis, cf. claim 3 as granted. This feature had not previously been claimed in any independent claim, was late-filed and was *prima facie* well-known in the art (see e.g. documents D6 to D8, D15 and D16). For these reasons the second and third auxiliary requests should not be admitted into the proceedings.

Novelty and inventive step – second and third auxiliary requests

Document D1 referred (see page 11, lines 8 to 13) to trapezoidal threads of the type known as "buttress" threads as defined in API specification 5B. This specification corresponded to document D9, which

disclosed on page 9 a clearance of 0.025 to 0.18 mm. Document D1 also referred (see page 16, lines 24 to 27) to the threaded tube joint VAM TOP® according to catalogue VAM® No. 940 edited by Vallourec Oil & Gas in July 1994. This catalogue corresponded to document D8, which disclosed thread forms having a clearance in the claimed range. Document D1 disclosed a clearance d1 in Figure 14. Although document D1 did not explicitly disclose the value of d1 (cf. page 20, lines 22 to 24), it was clear from documents D9 and D8 that this document implicitly disclosed the first characterising feature of claim 1 of the second auxiliary request. The diametric interference could be inferred from the contact width mentioned in the passage on page 17, lines 14 to 20, of document D1 and from Figure 5 and claim 9 of document D1. Document D1 also disclosed the last characterising feature of claim 1 of the second auxiliary request, cf. Figure 5 showing that the appendix had a front end frusto-conical abutment surface having an angle of 15° with a plane orthogonal to the longitudinal axis. It followed that the subject-matter of claim 1 of the second auxiliary request was not new.

If the board were to consider the first and second characterising features of claim 1 of the second auxiliary request as distinguishing features vis-à-vis document D1 (as was the case for the same features of claim 1 of the main request vis-à-vis document D2), the arguments given above for the main request applied. The subject-matter of claim 1 of the second auxiliary request therefore did not involve an inventive step.

Claim 1 of the third auxiliary request differed from claim 1 of the second auxiliary request in that the contact length b had to be longer than 0.5 mm. Since

this feature was known from document D1 (see page 17, lines 14 to 16), the subject-matter of claim 1 of the third auxiliary request also did not involve an inventive step.

Apportionment of costs

There had been no abuse of the procedure by the respondent. The issue of the validity of the priority was raised in view of claim requests containing technical features for which document D1 became relevant.

Reasons for the Decision

1. The appeal is admissible.

PROCEDURAL ISSUES

2. *Admission of facts, evidence and arguments in relation to the validity of the claimed priority*

2.1 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion must be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

After filing its statement of grounds of appeal, the appellant presented various lines of argument in order to establish that Tenaris Connections AG was entitled to claim priority from the Italian priority application as the "successor in title" of Tenaris Connections BV

(see point XIX above, Validity of the priority, lines of argument (i) to (v)).

Of these various lines of argument, line (ii) was the one presented before the opposition division and considered in the decision under appeal. Line (ii) was reiterated and new lines (i) and (iii) with documents D20 to D23a were presented in the appellant's response of 3 July 2015 to the communication of the board dated 12 May 2015. There was no reason for the board not to admit lines (i), (ii) and (iii) into the appeal proceedings. Nor was their admission a contentious issue between the parties.

Line (iv) was submitted for the first time during the first oral proceedings before the board, and line (v) was presented thereafter with letter dated 14 March 2016. Lines (iv) and (v) and the respective declaration and documents were an amendment to the appellant's case under Article 13 RPBA which was not admitted into the appeal proceeding for the reasons set out in the following sections.

2.2 Transfer of ownership by way of an oral agreement prior to the filing of the subsequent application, line (iv), and admission of the written declaration of the appellant's representative

During the first oral proceedings before the board the appellant alleged for the first time that the priority right had been transferred, together with the priority application, from Tenaris Connections BV to Tenaris Connections AG by way of an oral agreement prior to the filing of the subsequent application. In this context, the appellant's representative filed a written

declaration as proof of this allegation (cf. point XII above).

This line of argument (iv) had not been presented at an earlier stage of the appeal proceedings. In the appellant's submissions of 3 July 2015 it was argued among other things that no formal requirements applied under Italian law for a transfer of the priority right and that a transfer was valid even if made orally. However, these were general legal explanations concerning formal requirements for a transfer of rights under Italian law. It is clear from the content of said letter (see page 7, third paragraph) that a transfer based on an "agreement by convincing behaviour by the filing of the subsequent application in the name of Tenaris Connections AG", i.e. an agreement implied by conduct, namely by the act of filing, was being alleged, and not a transfer based on an oral agreement which had occurred prior to the filing of the subsequent application. Hence, the appellant's submissions during the first oral proceedings amounted, after presentation of two additional lines of argument at the appeal stage (lines (i) and (iii)), to yet another amendment to its case within the meaning of Article 13(1) RPBA.

The appellant justified the lateness of its submissions regarding a prior oral agreement on the ground that, in proceedings before the opposition division, the respondent had also presented submissions very late by contesting the validity of the claimed priority only shortly before the oral proceedings, and this had been accepted by the opposition division. Moreover, the appellant had not expected that the claimed priority might be considered invalid by the board in spite of Agreement D19.

The board does not consider these arguments to be a convincing explanation of why these submissions could not have been presented at an earlier stage of the appeal proceedings.

The validity of the claimed priority was already an issue during the proceedings before the opposition division, and it was held in the decision under appeal that the priority was valid. Therefore it is understandable that the appellant did not address the validity of the claimed priority in its statement of grounds of appeal. However, the respondent, in its reply to the appeal, again disputed that Tenaris Connections AG was entitled to claim priority. The appellant therefore had sufficient reason to present all its arguments and evidence concerning the validity of the priority in its reaction to the respondent's reply or, at the latest, in its reaction to the first communication of the board. Thus the board agrees with the respondent that the appellant presented its new submissions at a very late stage of the appeal proceedings.

When exercising its discretion under Article 13 RPBA with regard to the new submissions, the board considered the stage of the proceedings, and also whether the appellant's new line of argument, based on new facts and evidence, and contested by the respondent, could be regarded as sufficiently straightforward to be dealt with by the board or the respondent without an adjournment of the oral proceedings.

According to the allegations (see minutes of the first oral proceedings, page 5, fourth paragraph, and page 7, first paragraph), the transfer by oral agreement

concerned the priority application, and the priority right was automatically transferred with the application as an accessory right to the application. However, the substance of the written declaration of the appellant's representative filed as proof does not clearly indicate any agreement by oral consent. Also, it refers to Tenaris Connections AG as "the new owner" without further specification. The evidence filed in support of this allegation is not clear and does not allow the alleged facts to be established in a straightforward manner.

With respect to the identity of the "responsible person for IP matters" at Tenaris Connections BV and Tenaris Connections AG, which was questioned by the respondent, the appellant's representative declared at the first oral proceedings that he did not remember the person's name and that he would have to check the files in his firm in order to retrieve the relevant information. Therefore, as argued by the respondent, the declaration of the appellant's representative does not constitute proof that there has been a transfer by oral agreement or even a transfer of the priority right at all. Thus the new allegations concerning a transfer by oral agreement gave rise to additional questions which could not be clarified during the first oral proceedings, and would have required an adjournment of them. However, pursuant to Article 13(3) RPBA, the need to adjourn oral proceedings because of submissions made after the summons to oral proceedings is a strong reason for not admitting those submissions into the proceedings. In assessing the admission of new submissions, it is of relevance whether the new submissions would require an adjournment. That second oral proceedings may take place for other reasons is not a reason for admitting such late submissions.

In view of the above, the board, exercising its discretion, decided not to admit the representative's declaration, or the new allegations and the new line of argument concerning a transfer by oral agreement which were based on this declaration, into the appeal proceedings in accordance with Article 13(1), (3) RPBA.

2.3 Transfer by an agreement "manifested by conclusive action" prior to the filing of the subsequent application, line (v), and admission of documents D23 to D27 into the proceedings

After the first oral proceedings before the board, the appellant filed documents D23 to D27 and argued for the first time that the priority application and the priority right were transferred from Tenaris Connections BV to Tenaris Connections AG by an agreement "manifested by conclusive action" prior to the filing of the subsequent application.

In the appellant's view these further submissions did not amount to an amendment to its case since it had been arguing as of an earlier stage of the appeal proceedings that there had been a transfer of the priority right under Italian law prior to the filing of the subsequent application.

The board, however, does not share this view. The statement of grounds of appeal did not contain any facts, evidence or arguments with respect to the validity of the claimed priority.

With the new submissions the appellant argued that the priority application and the priority right derived from it had been transferred by an agreement "manifested by conclusive action" prior to

6 September 2003, i.e. prior to the filing date of the subsequent application (see page 4, third paragraph, of the letter dated 14 March 2016 and legal opinion D27, pages 2 to 4). Hence, these submissions are an amendment within the meaning of Article 13(1) RPBA. Moreover, compared to lines of argument (i) to (iv) hitherto presented by the appellant, these new submissions were a further amendment to its case.

The board also does not share the appellant's view that documents D23 to D27 should be accepted as an appropriate reaction to the non-admission of its representative's written declaration at the first oral proceedings.

Continuation of the appeal proceedings after the end of oral proceedings is not, as such, a reason for admitting new submissions or additional evidence relating to issues which were not admitted at the first oral proceedings or in respect of which the debate had indeed been closed. In the board's view, presenting a party's case little by little, depending on the further evolution of the case, is not in line with the principle of procedural economy. Moreover, the fact that documents D23 to D26 were retrieved from the internal files in the representative's Milan office a few days after the first oral proceedings before the board suggests that this evidence could also have been filed much earlier in the appeal proceedings.

As the appellant itself had correctly pointed out, the validity of the priority had been an issue as from the beginning of the appeal proceedings. This however cannot provide a valid basis for the appellant's argument that the respondent could not be surprised by new submissions on this issue at any point in time.

Nor can the content of point 3.2.2 of the board's communication of 2 February 2016, to which reference was made by the appellant, be accepted as a valid reason for these late submissions (see further details in point 3.2 below).

As to the issue of whether the content of documents D23 to D27 was highly relevant and was likely to change the outcome of the case, the board found that the submitted evidence did not allow clear conclusions to be drawn as to the transfer of the priority application or the priority right from Tenaris Connections BV to Tenaris Connections AG prior to the filing of the subsequent application. Instead, several uncertainties and further questions arose.

As pointed out by the respondent, it is not clear from the evidence which companies Mr Milesi worked for and what powers he had. The submitted correspondence between the appellant and its representative contains no indication that the priority application or the right to claim its priority had already been transferred. The respondent referred to the wording of Mr Milesi's email sent on 23 May 2003 to the firm of the appellant's representative: *"all the patents shall be filed directly in the name of Tenaris Connections [AG], if possible"*. The board shares the respondent's view that, due to the addition "if possible", the statement is conditional and open to interpretation. It was Mr Milesi's answer to an email sent by the representative's firm about subsequent filings for *inter alia* the priority application, where it was also indicated that *"once we receive your confirmation, we will provide you ... with documents and assignment of priority rights to be signed by the parties"*. Documents D24 (email of 24 June 2003) and D25 likewise refer to

signed assignments. It is not possible to dismiss the respondent's view that it was intended that transfers of rights should be made by written contract, as also shown by the existence of Agreement D19, and that the assignment was simply not made in due time.

In view of the above, the board does not consider documents D23 to D27 to be highly relevant. Thus, also in the light of decision T 1002/92 cited by the appellant, these documents cannot be admitted at this late stage of the appeal proceedings.

Finally, without further addressing the question of the applicability of the provisions of the First Protocol to the ECHR, the board did not come to the conclusion that its Article 1, relating to the protection of property, was violated by the non-admission of the new submission. The board's decision is based on procedural rules, notably Article 13 RPBA, in particular taking into account the principle of fair proceedings for all parties, the interest of legal certainty and procedural efficiency.

In view of the above considerations, the board, exercising its discretion, therefore did not admit documents D23 to D27 and the new line of argument based on these documents into the appeal proceedings in accordance with Article 13(1), (3) RPBA.

3. *Re-opening the debate on the validity of the priority*

3.1 Re-opening the debate - general issues

As to the significance of the closing of the debate, the Enlarged Board of Appeal confirmed in its decision G 12/91 (OJ EPO 1994, 285) that, as far as oral

proceedings are concerned, it marks the moment up to which parties may submit observations. It is fixed by the decision-making department - having first heard the parties' submissions - to allow itself time to consider its decision. Once the debate has been closed, further submissions by the parties must be disregarded unless the department allows the parties to present comments within a fixed time limit or decides to re-open oral proceedings for further substantive debate of the issues (cf. G 12/91, *supra*, Reasons, point 3).
These considerations of principle equally apply to proceedings before the boards of appeal (cf. R 10/08, Reasons, point 8, and R 14/10, Reasons, point 6.1).
In the aftermath of decision G 12/91 (*supra*), the principle that no submissions may be made by the parties after closure of the debate unless the board decides to re-open it is explicitly included in current Article 15(5) RPBA. Hence, the closing and also, as a rule, the re-opening of the debate are at the board's discretion.

However, a decision given orally by a board becomes effective and binding by virtue of being pronounced (see also G 12/91, *supra*, Reasons, point 2).
It excludes any re-opening of the debate. Therefore, the boards are generally very careful about what they announce in the course of oral proceedings and whether they render an interlocutory decision on a particular point which would prevent them from reconsidering that point at a later stage, should the need arise.
In addition to announcing a decision or re-opening the debate, for instance for follow-up questions on the issue previously discussed, the board may also announce conclusions of its deliberations or invite the parties to discuss the next topic.

As the closing of the debate as a rule takes place after the parties have been given the opportunity to present any facts, evidence or arguments they consider relevant, and as it initiates the deliberation phase for the deciding body concerning the topic in relation to which the debate has been closed, it also becomes clear that a re-opening of the debate constitutes an exception (cf. R 10/08, Reasons, point 8). Any re-entering into a substantive discussion at this stage, where after deliberation a conclusion or even a decision could be given by the board, would undoubtedly lead to delays.

In the board's view, this also means that there is no right of a party to have the debate re-opened. Hence a party's request for the debate to be re-opened is to be considered merely as a suggestion to the board to do so. Otherwise, due to a party's absolute right to oral proceedings, if a board, having closed the debate at the end of oral proceedings with the announcement that the decision would be issued in writing, then received a request for re-opening of the debate combined with a request for oral proceedings, the board might have to hold oral proceedings only on the issue of re-opening.

As to the circumstances in which a re-opening of the debate may occur, there may be situations which make it necessary, for example if the board establishes that a fundamental procedural deficiency constituting a ground for petition for review has occurred. Other reasons which may lead to a re-opening of the debate are situations where the board itself considers it expedient to obtain further comments from the parties in order to be able to reach its decision.

In the board's view, only in exceptional cases should the debate be re-opened due to late submissions by a party. Otherwise, the provisions governing the late filing of a party's submissions, in particular Article 13(1), (3) RPBA, risk being undermined or losing importance. These considerations also apply if second oral proceedings take place in order to hear the parties on issues in relation to which the debate has not been closed.

As to the extent to which the debate can or must be re-opened if the board decides to re-open it, the board takes the view that it does not have to re-open it for all issues, but can also do so only for specific points, depending on the circumstances (see point 3.3 below). This matches the exceptional character of the re-opening of the debate, as it allows further discussion to be limited to the extent necessary. Moreover, the board should not be deterred from re-opening the debate by the consideration that, if it did so, it might be faced with a repetition of the entire earlier debate.

3.2 In the present case, the chairman had closed the debate at the end of the first oral proceedings with regard to the issues discussed in those oral proceedings (cf. page 7 of the minutes, sixth paragraph), which included the validity of the claimed priority.

During the second oral proceedings the appellant requested re-opening of the debate on the validity of the priority, in particular concerning its lines of argument (iv) and (v), whereas the respondent categorically objected to any re-opening.

The board does not share the appellant's opinion that, in view of the content of point 3.2.2 of its communication dated 2 February 2016, the board had itself already re-opened the debate on the issue of the validity of the priority under Italian law.

In this communication the board conveyed *inter alia* its conclusions on the issue of priority (cf. points 3.1 and 3.2) and informed the parties of its intention not to make a referral to the Enlarged Board in that respect (cf. point 3.3).

Point 3.2.2 of said communication cannot be understood as indicating that the board had re-opened the debate on the issue of priority. It also did not raise new aspects which had not been discussed in the appeal proceedings. As the context and the heading of point 3.2 of the communication clearly show, said point concerns the alleged retrospective transfer based on Agreement D19. With respect to the appellant's submissions regarding Italian law it contains *inter alia* the board's opinion that it did not consider it proven that the legal ownership of either the priority application or the priority right had been transferred with retrospective effect to Tenaris Connections AG. The appellant might have taken this as an opportunity to file further submissions. The fact that the board, after the debate on the validity of claimed priority had been closed, informed the parties of its opinion on this issue cannot however be considered a re-opening of the debate on this issue.

Also, the board does not share the appellant's view that the debate on the priority issue had been closed only due to the lateness of the day. The parties were able to present all the comments that they then had on

the issue of priority before further topics were addressed following the issue of priority (see minutes of the first oral proceedings, pages 5 to 7).

The appellant based its request to re-open the debate on the further argument that it had filed *prima facie* highly relevant evidence which provided proof that the priority right had been transferred in due time. Apart from not sharing this view (cf. point 2.3 above), the predominant issue for the board in its consideration not to re-open the debate on the issue of priority as a whole was that no violation of a party's right to be heard was apparent to it.

3.3 Re-opening the debate only for a specific point, and admission of documents D28 and D29 into the proceedings

During the second oral proceedings, however, the board decided to re-open the debate with regard to a specific point, namely the statement in point 3.2.2, third paragraph, of its communication of 2 February 2016, reading: *"A transfer of economic ownership with retrospective effect according to Dutch law, which does not entail a transfer of the legal title, is not sufficient to meet the requirements of Article 87(1) EPC 1973".*

The first oral proceedings had ended following a discussion *inter alia* of the validity of the claimed priority, during which the board had also addressed the question of a referral to the Enlarged Board of Appeal. In its communication of 2 February 2016 the board indicated its intention not to refer questions of law to the Enlarged Board. One of the issues involved in the context of a potential referral was the aspect of

the retroactive effect addressed in section 4 of Agreement D19 under Dutch law.

The board therefore considered it appropriate to hear the parties specifically on the above-mentioned statement. It admitted documents D28 and D29 into the proceedings since it considered them relevant to this point. Legal opinion D28 contained additional legal explanations on the subject of "economic ownership" under Dutch law, in particular in the context of decision J 19/87, and included arguments favouring a referral to the Enlarged Board. D29 contained further legal explanations of the retroactive transferability of the priority right. In re-opening the debate on the above point and admitting these two related documents, the board did not consider this to be unfair to the respondent. Parties must take into account that a board can decide to re-open a closed debate as long as no decision has been taken. The respondent, objecting to a re-opening of the debate and the admission of the documents in general, did not argue that it was unable to address the point. As to the respondent's point that two sets of oral proceedings are not held in case of unchanged facts, the board notes that this concerns the limits of the right of a party to oral proceedings pursuant to Article 116 EPC 1973. It does not prevent the board from addressing issues at oral proceedings after a re-opening of the debate.

4. *Objection under Rule 106 EPC*

4.1 During the second oral proceedings the appellant filed a written objection under Rule 106 EPC in which it made explicit reference to a fundamental violation of Article 113 EPC 1973.

4.2 The board does not share the appellant's view that not re-opening the debate on the validity of the priority in full had deprived it of its right to present all comments important for the decision to be taken by the board.

The validity of the claimed priority had been an issue from the beginning of these appeal proceedings in view of the respondent's reply to the appeal. The first communication of the board dated 12 May 2015 indicated the board's preliminary opinion that the claimed priority was not valid. The appellant thus had ample opportunity to present all facts, evidence and arguments which it considered relevant for the prosecution of its case.

It is true that during the first oral proceedings the board did not take an interlocutory decision concerning the validity of the claimed priority. However, it did take a procedural decision to declare the debate closed on this issue in accordance with Article 15(5), first sentence, RPBA. It is clear from the wording of Article 15(5), second sentence, RPBA that the closure of the debate is not binding on the board, but that the board can decide to re-open the debate. The board, however, is of the view that a party has no right to a re-opening of the debate, but that it lies within the discretion of the board to re-open the debate or not and, if it does so, on which specific issue(s) the debate is re-opened (see point 3.1 above).

The issues of whether the appellant's written submissions of 16 March 2016 and documents D23 to D29 should be admitted into the proceedings and whether the debate on the validity of the claimed priority should be re-opened were extensively discussed at the second

oral proceedings, and the parties had the opportunity to present their arguments in that respect.

4.3 Therefore, the objection under Rule 106 EPC was dismissed.

5. *Oral submissions by Mr Van Engelen at the second oral proceedings*

5.1 At the second oral proceedings, the appellant requested that its expert on legal matters, Mr Van Engelen, a Dutch professor of law, be allowed to make oral submissions. The respondent objected to this request as Mr Van Engelen was not a professional representative, and the appellant's intention that he should speak had not been announced in advance of the oral proceedings. Hence the request was to be refused, cf. decision G 4/95 (OJ EPO 1996, 412).

5.2 The criteria set out in G 4/95 relate to the content and timing of the request of a party that its accompanying person be permitted to make oral submissions. These criteria governing the board's discretion are, in particular, aimed at ensuring that no oral submissions are presented by or on behalf of a party which take the opposing party by surprise and for which that party is not prepared. Accordingly, especially where such requests are made shortly before or at the oral proceedings, they should be refused unless there are exceptional circumstances or the opposing party agrees (see G 4/95, *supra*, Headnote II and Reasons, point 10).

5.3 Mr Van Engelen had already made oral submissions on behalf of the appellant at the first oral proceedings, which was not a contentious issue at the time.

Because of his earlier presence and oral submissions, it was foreseeable for the respondent and the board that, when the board summoned to second oral proceedings, Mr Van Engelen would also attend those proceedings and would make further oral submissions on behalf of the appellant. This was all the more so because the appellant, together with its submissions, had filed a second legal opinion by Mr Van Engelen (D28) in advance of the second oral proceedings. Accordingly, the respondent was able to properly prepare itself in relation to further oral submissions by Mr Van Engelen.

5.4 In view of the particular circumstances of the present case, the board allowed Mr Van Engelen to make oral submissions on the legal issues as an "accompanying person" of the appellant's representative.

PRIORITY

6. *Validity of the claimed priority*

6.1 The issue of entitlement to the priority right

The sole issue contested with respect to the validity of the claimed priority was whether, as argued by the appellant, Tenaris Connections AG was entitled to claim priority from the earlier Italian application filed on behalf of Tenaris Connections BV. Tenaris Connections AG was one of the several applicants for the international application and was indicated *inter alia* for the designation of EP (cf. Rule 4.5(d) PCT), the latter making it unnecessary to assess the relevance of designations in this context.

In its communication of 12 May 2015, the board, applying the general principle that a party claiming a right must be able to show that it is entitled to that right and referring to decisions T 1008/96, Reasons, point 3.3, T 1056/01, Reasons, point 2.10, and J 19/87, expressed its view that, in the present circumstances where the validity of the claimed priority was at stake, it was the appellant-patentee who had to demonstrate that the priority was validly claimed. This was not contested by the appellant, and in the meantime further case law has been issued in which this approach is also applied (cf. decisions T 205/14 of 18 June 2015, Reasons, point 3.5, and T 517/14 of 19 June 2015, Reasons, point 2.6).

6.2 Applicable provisions of the PCT and EPC

Both the appellant and the respondent referred to the provisions of the EPC as the basis for assessing whether the subsequent application validly claimed priority from the earlier application filed by Tenaris Connections BV, and in particular for the question whether Tenaris Connections AG, one of the applicants for the subsequent application and the only applicant for all designated EPC contracting states, could be considered the successor in title as regards the priority application or the right to claim priority from it. The board agrees that the EPC provisions are applicable for the assessment of this question.

The subsequent application is an international application filed under the PCT on 6 September 2003 for which the EPO acted as designated Office. Such an international application is deemed to be a European patent application ("Euro-PCT application") as of its international filing date (cf. Article 150(3) EPC 1973

and Article 11(3) PCT). That Articles 150-158 EPC 1973 are applicable in the present case follows from the facts that the decision to grant the patent in suit took effect before the entry into force of EPC 2000 and that the transitional provisions do not provide for applicability of these provisions in their revised form to patents already granted (see Article 7 of the Act revising the EPC of 29 November 2000 and Article 1 No. 6 of the Decision of the Administrative Council of 28 June 2001, OJ EPO 2003, Special Edition No. 1, 201 et seq.). As Articles 150-158 EPC 1973, which constitute the part of the EPC which, pursuant to Article 150(1) EPC 1973, governs international applications, do not comprise provisions relevant for determining the validity of a claimed priority, the general provisions of the EPC apply with the proviso that, in case of conflict, the PCT provisions will prevail (cf. Article 150(2) EPC 1973).

In various respects, the PCT explicitly accords primacy to "national law", which for the present purposes is the EPC for European regional applications or patents (cf. Article 2(x) PCT). Article 27(5) PCT provides that any contracting state to the PCT is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.

The validity of a claimed priority is relevant for defining the effective date of a claimed invention and for determining the relevant state of the art. As the validity of the claimed priority thus has a direct effect on the patentability of the claimed invention,

the provisions of the EPC, in particular Article 87(1) EPC 1973 (and not Article 8 PCT or Article 4 Paris Convention), may be applied pursuant to Article 27(5) PCT for the question at issue in the present case, namely whether the applicant was entitled to claim priority from the earlier application.

According to the transitional provisions (Article 7 of the Act revising the EPC and Article 1 No. 1 of the Decision of the Administrative Council, *supra*), Article 87(1) EPC 1973 applies to the present patent.

In this context the board notes that the English version of this provision refers to "successors in title" in the plural form. The parties and the board have read the provision in the singular. The fact that the German and French versions of the EPC provision and Article 4A(1) Paris Convention, on which the provision was modelled, all use the singular form, and also the fact that the inconsistency between the languages was removed in the revised EPC without any indication that this constituted a change in substance (see OJ EPO 2007, Special Edition No. 4, Article 87), leave the board in no doubt that the English version of Article 87(1) EPC 1973 should also be read as "successor in title".

6.3 Applicable law for assessing succession in title within the meaning of Article 87(1) EPC 1973

In the present case, the board did not need to decide which law is applicable for assessing the validity of the transfer of the priority application or the priority right or whether, or under what conditions, the priority application and the priority right are transferable under the relevant law. None of the

appellant's lines of argument, which were based on the applicability of Italian and Dutch law, have led to a finding that the requirements of Article 87(1) EPC 1973 were fulfilled. No other national laws were invoked by the parties. Therefore to reach a decision in the present case it was not essential to determine the applicable law.

6.4 The appellant's lines of argument

In view of the board's decisions not to admit lines of argument (iv) and (v) and the respective declaration and documents (see points 2.2 and 2.3 above), the lines of argument to be considered as to their merits were a transfer based on Agreement D19 (lines (i) and (ii)) and a transfer by an agreement "by carrying out convincing behaviour within a corporate group", namely by filing the subsequent application on 6 September 2003 (line (iii)).

Even though it appears that, logically, lines (i),(ii) and (iii) are mutually exclusive, the board has assessed each line independently and, in doing so, has accepted a change in the appellant's argument as regards the nature of Agreement D19, i.e. whether it was constitutive of the transfer or of a declaratory nature only.

6.5 Transfer of ownership on 9 September 2003 based on section 1 of Agreement D19 (line (i))

6.5.1 It was not contested between the parties that, on the basis of Agreement D19, Tenaris Connections AG was the "successor in title" of Tenaris Connections BV for the Italian priority application and the right to claim priority from it as of 9 September 2003. This date,

however, is three days after the filing date of the subsequent application.

The appellant argued that, for a priority claim to be valid, Article 87(1) EPC 1973 required only that there was a valid first application, and that the subsequent application was filed within 12 months after the first filing in respect of the same invention, which subsequent application could be filed by the applicant's successor in title. No time restriction could be derived from the provision concerning the time by when the succession in title had to have taken place.

The board, however, notes that a time constraint as to the question of succession in title is imposed by Article 87(1) EPC 1973.

6.5.2 Wording of Article 87(1) EPC 1973

Article 87(1) EPC 1973 reads: *"Any person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent ..., or his successors in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application."*

The provision uses the wording *"has ... filed"* and *"shall enjoy, for the purpose of filing a European patent application"* (see also the German version *"eingereicht hat"/"genießt für die Anmeldung ... zum europäischen Patent"* and the French version *"a ... déposé"/"jouit, pour effectuer le depôt d'une demande*

de brevet européen"). The provision therefore relates to a period of time lying between the acts of filing the priority application and filing the subsequent application. The term "successor in title" refers in the context of the provision to the person who has duly filed the priority application but not yet the subsequent application ("[a]ny person who has duly filed ..., or his successor[...] in title"). Hence, for a right of priority to be enjoyed from a first application, the subsequent application must be filed by the applicant of the priority application or his successor in title. The latter alternative presupposes that the succession in title has already taken place when the subsequent application is filed. Thus, whilst the circumstances of a succession in title, whether originating from a contract or occurring by operation of law, remain undefined, the requirement that the succession in title must have occurred when the subsequent application is filed is clearly derivable from the wording of Article 87(1) EPC 1973.

The appellant's interpretation that Article 87(1) EPC 1973 does not impose such a requirement and thus is not concerned with the point in time of a succession in title can, in the board's view, not be reconciled with the wording of the provision.

6.5.3 Interpretation of Article 87(1) EPC 1973 in line with the provisions of the Paris Convention in view of the legislative history

As stated by the Enlarged Board of Appeal, *"Articles 87 to 89 EPC provide a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application. The Paris Convention also contains rules of law*

concerning priority. The Paris Convention is not formally binding upon the EPO. However, since the EPC - according to its Preamble - constitutes a special agreement within the meaning of Article 19 of the Paris Convention, the EPC is clearly intended not to contravene the basic principles concerning priority laid down in the Paris Convention" (cf. G 3/93, OJ EPO 1995, 18, Opinion, point 4).

The board considers that its interpretation of Article 87(1) EPC 1973 is in line with Article 4 Paris Convention and the legislative history of these provisions.

Article 87(1) EPC 1973 was modelled on Article 4A(1) and Article 4C Paris Convention (see also Document IV/6514/61, report on the meeting of 6 October 1961 of the Patents Working Party; Report on the First Preliminary Draft Convention, 1970, Part IV, point 7; Document MR/27 of 18 April 1973, Comments by WIPO, point II.1). Hence, it is no surprise that Article 4A(1) Paris Convention uses similar wording ("who has duly filed"/"for the purpose of filing") and thus also refers to the scenario in which a first application has been filed but not yet the subsequent application.

From the legislative history of the Paris Convention it can be derived that the right of priority was already incorporated in the original text of the Paris Convention of 1883 (see Bodenhausen, Guide to the Paris Convention, BIRPI 1969, page 35).

The creation of the right of priority was aimed at protecting the rights of the applicant of a first application for an invention in all countries of the

Paris Union by securing the filing date as the effective date for the definition of the state of the art. This was to enable the applicant to decide, within a certain period, in which other countries protection should be sought in respect of the same invention and to prepare for such subsequent filings which, in the absence of a centralised filing system, were still required at that time. In the event of such subsequent filings, other applications or disclosures occurring in the priority period were to have no negative effect as regards the patentability of the invention (see Article 4B Paris Convention).

At the Washington Revision Conference in 1911, the wording "successor in title" was added to Article 4A(1) Paris Convention (Actes de la Conférence de Washington de 1911, UIPPI, Berne 1911, "Actes de Washington", pages 44, 247, 275 and 307), but the historical documentation does not indicate a specific point in time as to when the succession in title must have taken place, nor does it give much information about the purpose of the amendment (see, however, the points addressed by the appellant mentioned in point 6.5.2(b) below).

It is, however, reported that, while the "successor in title" was not mentioned in Article 4A Paris Convention, courts in some countries allowed successors in title to claim priority, whereas others did not. The addition of the term "successor in title" to the Paris Convention clarified the situation in order to meet an urgent need in practice (see Wieczorek, Die Unionspriorität im Patentrecht, 1975, page 129).

It must be borne in mind that applications in foreign countries involve additional costs which the applicant

cannot always afford and which might prevent him from further exploiting his invention abroad. The amendment of 1911 confirmed that the applicant's successor in title could also enjoy the priority right, and that therefore it was not necessary for the applicant of the priority application to make the subsequent filings himself in order for them to benefit from the priority of the earlier application.

The board sees no indication in the *travaux préparatoires* that this amendment was intended to change or substantially broaden the concept of priority as designed by the Paris Convention and having existed at that time for almost thirty years.

The legislative development of the provision suggests that the underlying intention was to extend the options of the applicant of the first filing by allowing him, in addition to the existing alternative of filing the subsequent application himself, to transfer his rights to another person who would then enjoy the priority right as the applicant's successor in title. However, because the applicant wishing to make his own subsequent filing must do so within the priority period, a transfer of ownership is also subject to the same time constraints, such that the successor in title may file the subsequent application within the same period.

There is no indication that, during the Washington Revision Conference, the intention in adding the term "successor in title" was to give an applicant claiming priority from an earlier application who is not entitled to the right of priority when he is filing his application an opportunity to acquire at a subsequent stage the priority right existing from an earlier

application in respect of the same invention filed by another person and attribute it to his own application.

The appellant, in support of its position that there was no indication that the succession in title had to have already been completed at the time of filing the subsequent application, referred to the fact that, at the Washington Conference, there was even a proposal by the French delegation to introduce an amendment to the effect that the entitlement of the successor in title would have had to be proven only at the time of grant of a patent (cf. Actes de Washington, *supra*, pages 95 and 191).

However, this proposal concerning proof of entitlement to the right of priority was not taken up into the Paris Convention. The board also notes that the relevant passage relates to the time for furnishing proof of a succession in title that has taken place. No conclusions can be drawn from this statement as to when such succession must occur. In particular, it cannot be concluded that it should be permissible to transfer the priority application or the priority right arising from it until the time at which proof of a succession in title must be furnished.

In view of the above, the board considers that its interpretation of Article 87(1) EPC 1973 is in line with the basic principles governing the right of priority laid down in the Paris Convention.

6.5.4 Relevant case law

Likewise, in the case law of the boards of appeal and the jurisprudence of national courts of the EPC contracting states hitherto, the point in time at which

the subsequent application was filed has been considered relevant in assessing whether the applicant of the subsequent application is entitled to the claimed priority pursuant to Article 87(1) EPC 1973 as a successor in title (see decisions T 62/05, Reasons, point 3.4; T 788/05, Reasons, point 2; T 493/06, Reasons, point 11; T 382/07, Reasons, point 9.1; German Imperial Patent Office, BlPMZ 1906, 127; German Federal Court of Justice, decision of 16 April 2013, X ZR 49/12 – *Fahrzeugscheibe*, Reasons, point II.2.a); High Court of Justice of England and Wales, *Edwards Lifesciences AG v Cook Biotech Incorporated*, [2009] EWHC 1304 (Pat), para 95 with reference to decisions J 19/87 and T 62/05; *KCI Licensing Inc. et al. v Smith & Nephew PLC et al.*, [2010] EWHC 1487 (Pat), para 58; *HTC Corporation v Gemalto S.A.*, [2013] EWHC 1876 (Pat), para 132; *Idenix Pharmaceuticals Inc. v Gilead Sciences Inc. et al.*, [2014] EWHC 3916 (Pat), para 409; Higher Regional Court Düsseldorf, decision of 6 December 2012, I-2 U 46/12, Reasons, point II.B.3(b)(aa) 1.2.1).

It is less clear from the above-mentioned case law whether, considering that the smallest time unit under the EPC is a day, the latest day on which succession in title has to have occurred is the day before the filing of the subsequent application or whether that date is still included. This specific question, however, was not relevant in the present case.

As to other approaches, the board is aware of decisions in which the German Federal Patent Court considered that it was the moment of filing the declaration of priority with the particulars relating to the priority application which was relevant for the assessment of entitlement to priority rights (German Federal Patent Court, decision of 15 February 2012, 5 Ni 59/10 (EP),

Reasons, point I.2, and decision of 28 October 2010, 11 W (pat) 14/09, Reasons, point II.B.2(a)(cc)).

In the present case, the subsequent application was filed on 6 September 2003 and, at the same time, the declaration of priority was submitted in accordance with Article 8(1) PCT and Rule 4.10(a) PCT (as in force until 31 March 2007). According to appellant's line of argument (i), Tenaris Connections AG was the successor in title as of 9 September 2003, i.e. three days later. Hence, Tenaris Connections AG was not entitled to the claimed priority pursuant to Article 87(1) EPC 1973 according to any of the established approaches in the case law.

6.5.5 Decisions cited by the appellant

The appellant, however, referred to Agreement D19 and argued that in decisions T 62/05 and T 1008/96 the deciding boards had also taken into consideration declarations which were signed after the filing of the respective subsequent application. In both cases, the boards did not refuse the declarations because of the date of the signature, but for other reasons (contradictory evidence on file or vague content of the declaration). *A contrario*, Agreement D19, to which such other reasons did not apply, provided a valid basis for a succession in title under Article 87(1) EPC 1973.

The board does not share the appellant's approach that, because a board decided that one of two conditions was not met, it could be concluded that the board considered the other condition to be fulfilled. The present case is also not comparable because Agreement D19 differs from the declarations on file in the two cited cases referred to by the appellant: in

case T 62/05, it was a declaration of the "Representative Director & President" of the applicant of the priority application, who was reporting on events that had occurred prior to the subsequent filing; in case T 1008/96 it was a declaration of the applicant of the priority application in which she confirmed before a notary public that she had assigned the priority applications in a specific year which preceded the filing of the subsequent application.

Hence, these two decisions do not support the appellant's case. Nor can they held to contradict the board's finding that, if the applicant of the subsequent application is not the applicant of the priority application, he must be the successor in title when the subsequent application is filed.

6.5.6 Proof of entitlement to the priority right

The appellant, in support of its view that Article 87(1) EPC 1973 did not set a time constraint in respect of the succession in title, referred to the circumstance that an applicant who claims the priority of an earlier application is not always obliged to provide proof of his entitlement to the priority right if he did not file the priority application. The absence of the need to file such proof as a matter of course corresponded to the absence of the need to be a successor in title upon filing the subsequent application.

On this point the board notes that the absence of a need to file proof of entitlement cannot automatically lead to the conclusion that, as suggested by the appellant, the applicant need not be entitled to the right at a particular point in time. Rather, the

absence of a requirement in the EPC for the applicant to submit proof of his entitlement to the claimed priority as a matter of course corresponds to the absence of an obligation for the EPO to assess the validity of the claimed priority in every case in which priority is claimed.

In the preparatory work for the EPC, there was in fact a discussion in the Patents Working Group in 1963, in the context of how and when the priority right was to be claimed (Article 74 of the preliminary draft 1962, later Article 88 EPC 1973), about whether also to include a provision in the implementing regulations on proof of transfer of the priority right from the applicant of the first application to the subsequent applicant.

On the one hand, it was argued that it would be useful if the EPO would establish in a case of succession in title that an agreement did indeed exist between the two parties, because it too often happened that the applicant of the subsequent application claimed priority from an earlier application without being entitled to do so. Moreover, the claiming of a priority right was published in the European Patent Register.

On the other hand, it was argued that, in view of the many cases in which a claimed priority would not become relevant for the grant of a patent, the EPO should not be obliged to assess the validity of a transfer of priority in each and every case. It was sufficient that the EPO could ask for proof of succession in title if and when the question became relevant in a particular case. Publication in the Register would signify only that a priority right was claimed, but without providing any guarantee given by the Office as to the

validity of the priority (cf. document 7669/IV/63 of 6 November 1963, meeting of the Patents Working Group from 1 to 12 July 1963, Article 74).

Whereas the Patents Working Group seems to have been in favour of including a provision concerning entitlement to the priority right (cf. document 7669/IV/63, Article 74 continued), this approach was abandoned at a later stage in the preparatory discussions, partly due to considerations relating to the PCT (see document BR/ 51/70 of 7 October 1970, point 36). The proposal to require the applicant, at least, to make a statement as to entitlement to the priority right, which was considered in conformity with the PCT, did not receive sufficient support at that time.

As a result, applicants who are not applicants of the priority application and claim priority from it have to submit proof of entitlement only if the EPO invites them to do so. The requirement that the applicant of the subsequent application must be entitled to claim priority when filing his application is a separate issue.

6.5.7 Considerations as to the inventor's position

As further support for the argument that no time restriction for the succession in title concerning the priority application or the priority right arising from it is imposed by the EPC, the appellant referred to the discussions in the *travaux préparatoires* of the Diplomatic Conference in 1973 concerning the inventor's position (see document M/PR/G, report of the Main Committee I, point C.3.; document M/48/I, Memorandum B). The appellant argued that, as regards the transfer of the inventor's rights, it was not intended for legal

certainty for third parties to be established during the examination procedure, and that the legislator's decision not to require proof of transfer of the inventor's rights emphasised that those rights, including the priority right, should be transferred in as free and unimpeded a manner as possible.

The board considers that the absence of a requirement for the applicant to file proof of his entitlement to the invention again corresponds to the absence of a requirement that this fact is to be verified by the EPO as a matter of course. No further-reaching conclusions may be drawn. Moreover, the board recalls that the issue at stake in the present case is not the inventor's right to the European patent, governed by Article 60 EPC 1973 and Article 61 EPC, but the right of the applicant of a European (or Euro-PCT) application to claim priority from an earlier application pursuant to Article 87(1) EPC 1973. The right of priority arises for the person who filed the first application ("any person who has duly filed..."), irrespective of his entitlement to the invention. For this reason, too, it is hardly convincing to make the leap from the absence of a requirement for the applicant to file proof of his entitlement to the invention to a free and unimpeded transferability of the right of priority.

6.5.8 Filing of the declaration of priority, Article 88 and Rule 52(2) EPC

The appellant further argued that, because Article 88 and Rule 52(2) EPC allowed the declaration of priority to be filed after the filing of the subsequent application, until expiry of 16 months from the earliest priority claimed, the priority right must have

been available, and therefore also transferable, at least until expiry of this time limit. Since the applicant of a priority application who filed a subsequent application within the priority period did not have to decide whether to claim priority when filing the subsequent application, there was no reason why he should be required to own the priority right at that date. Therefore, the transfer of ownership from Tenaris Connections BV to Tenaris Connections AG on 9 September 2003 occurred in due time.

The board notes that the provisions of Article 88 and Rule 52 EPC are not applicable in the present case. The application that led to the patent in suit was an international application. Pursuant to Rule 4.10(a) PCT (as in force until 31 March 2007) the declaration of priority was, as a rule, to be made on filing the subsequent application (similarly under Article 88(1) and Rule 38(1), (2) EPC 1973).

Moreover, the filing of the declaration of priority, i.e. the indication of the date on which and the state in or for which the previous application was made and the file number, is a purely formal requirement that the applicant of the subsequent application has to fulfil if he wants to invoke the priority right for prosecution of the subsequent application. It ensures that the patent office which receives the subsequent application is duly informed of the fact that priority is claimed because of its importance for the prosecution of the application, in particular for search and examination. The particulars in the declaration of priority are published with the application (see Article 4D(2) Paris Convention, Rule 38(6) EPC 1973, Rule 52(5) EPC), for the purpose of informing the public of the claimed priority,

without however providing any guarantee as to the validity of the claimed priority (see also point 6.4.6).

The Paris Convention of 1883 did not contain any rules on when and how the right of priority may be claimed (see Bodenhausen, *supra*, page 47), and the rule introduced at the Washington Revision Conference in 1911 leaves it to the choice of the national legislators to determine the latest date on which such a declaration must be made, without providing for harmonisation (cf. Article 4D(1) Paris Convention); and this demonstrates the formal nature of the declaration of priority, in addition to the fact that Article 4D(4) Paris Convention itself names it a "formality". The EPC legislator likewise considered the filing of the declaration of priority to be of procedural relevance only (see e.g. document BR/135/71 of 17 November 1971, point 112).

The question of the point in time by which the declaration of priority can or must be filed is, therefore, to be distinguished from the question of the point in time at which the subsequent applicant who is not the applicant of the priority application must be entitled to claim priority, the latter a question that also involves issues of substantive law. Answering the first question does not permit conclusions to be drawn therefrom as regards entitlement to the right.

6.5.9 Need for a broad interpretation and no adverse effect for third parties

The appellant further argued that the applicant of the priority application should be allowed more flexibility to make use of his priority right to the greatest

extent possible. This means that he should thus be able to assign his right to an applicant of a subsequent application that has already been filed. At the same time, an applicant of a subsequent application who was not the applicant of the priority application should be given the possibility to become entitled to the priority right after filing his application.

In the appellant's view, a more liberal approach was also needed because transactions between companies could be complex and might take time, in particular because of difficulties of communication between the companies. Documentation of events with a legal impact was, in many cases, not precise or was even contradictory.

Nor would a broad approach have a detrimental effect on the legitimate expectations of third parties. Before the application was published, third parties had no knowledge of its existence. Provided that the priority claim appeared in the published application, allowing a succession in title after filing of the subsequent application could not adversely affect third parties' expectations. Since there was no requirement for proof of transfer of the right of priority to be filed as a matter of course, third parties had to take into consideration that, where a claimed priority appeared in the published application, this priority, if assessed, would indeed turn out to be valid.

The board, however, does not consider it possible to change the conclusions it has reached on the basis of the clear wording of and the *travaux préparatoires* for the relevant legal provisions.

There might well be circumstances in which both parties concerned, i.e. the applicant of the priority application as the owner of the priority right and the applicant of a subsequent application as a potential successor in title, would welcome greater flexibility in making use of the right of priority.

However, an interpretation as proposed by the appellant would mean that it should be permissible for the applicant of a subsequent application who had not filed the priority application to make use of a right of priority owned by another person, and arrange for acquisition of that right only at a point in time when this becomes necessary, possibly up to the time when the patent is granted.

There can be no doubt that more flexibility is desirable from the point of view of the subsequent applicant, as it would increase his chances of validly claiming priority. However, it appears questionable whether this extension of the concept of the right of priority is indeed always desirable from the point of view of the applicant of the first application. If the "successor in title" requirement could be fulfilled after the filing of the subsequent application, this would mean that, by the time the applicant of the first application would himself have to file a subsequent application (12-month priority period), he would not know for sure whether an assignment would eventually take place. Postponing the final date to an even later stage would further mean that acquisition of the priority right could be influenced by the expected outcome of the grant proceedings, i.e. by whether the priority becomes relevant or whether a patent is granted at all.

The board accepts that transaction scenarios may, in practice, not always be simple. However, it also notes that, in situations in which the applicant of the priority application and the successor in title-to-be do not manage to arrange for a valid transfer of the priority application or of the right to claim its priority before the filing of the subsequent application, the subsequent application could be filed by the entitled person and be assigned, together with the other right(s), afterwards. Alternatively, both the applicant of the priority application and the successor in title-to-be could file the subsequent application jointly. The subsequent application would have been filed by the applicant of the priority application as co-applicant, and due to the unity of the application, the claimed invention would benefit from the right of priority. As the Enlarged Board in decision G 2/04 (OJ EPO 2005, 549, Reasons, point 2.2.1) put it, albeit in a different context: *"This shows that available possibilities for organising industrial property matters ... entail different legal consequences and different possibilities as to how to safeguard a party's interests. Such differences alone, however, are no reason deliberately to ignore the legal consequences of the specific course of action chosen. Rather, there should be convincing reasons why such consequences might be not acceptable in a specific situation."*

As to the aspect that third parties' legitimate expectations would not be adversely affected by permitting a succession in title to be effected after the filing of the subsequent application, the board considers this argument to be of little weight. On this basis it could also be argued that there should be no restriction on making changes to the disclosure of the application or remedying deficiencies as long as this

is done prior to publication. What is important, in the board's view, is that the requirements of the EPC are fulfilled at the relevant point in time.

6.5.10 In view of the above considerations, the transfer of ownership of the Italian priority application and the right to claim priority from it from Tenaris Connections BV to Tenaris Connections AG as of 9 September 2003 (line of argument (i)), which occurred after the filing date of the subsequent application, was too late. On the basis of this transfer Tenaris Connections AG could not enjoy, for the purpose of filing the subsequent application, the right of priority in accordance with Article 87(1) EPC 1973.

6.6 Transfer of ownership with retroactive effect as of 1 January 2003 based on section 4 of Agreement D19 (line (ii))

6.6.1 Approach based on Italian law

The appellant submitted that the rights mentioned in Agreement D19 were validly transferred with effect from 1 January 2003 because on the basis of the principle of freedom of contract enshrined in Article 1322 of the Italian Civil Code it was permissible to provide for a retroactivity clause. In support, reference was made to legal opinion D21. The validity of the retroactive transfer was contested by the respondent.

Legal opinion D21, signed by two attorneys at law, deals on pages 2 to 5 with the "transfer of an IP right according to Italian law". The focus of this section lies on the argument that Tenaris Connections AG acquired legal ownership when it "carried out convincing behaviour", namely by filing the subsequent

application (see point XIX above, Validity of the priority, line (iii)). In relation to a retroactive transfer it is merely stated that the *"parties may also determine that property over the goods sold will be transferred only at a specified later date or at a prior date, i.e. retroactively, like it was the case of the contract for the transfer of the patent application and the priority right from Tenaris Connections BV and Tenaris Connections AG"*. As the basis for this statement, reference was made to Article 1322 of the Italian Civil Code, which reads (translation by the appellant): *"The parties may freely determine the content of the contract within the limits imposed by the law and by the corporate rules. The parties may as well conclude contracts which do not appertain to those types which have a particular discipline, provided that they are directed to realise interests which merit protection following the legal order."* Except for this, the legal opinion does not contain any further reasoning in support of a transfer with retroactive effect. The national court decisions cited in legal opinion D21 relate to different issues (see also point 6.6).

In these circumstances, the legal consequences of section 4 of Agreement D19 under Italian law, in particular the extent to which a retroactive effect would be recognised, have not been established by the appellant to the satisfaction of the board. Accordingly, the board was unable to conclude that, when the subsequent application was filed, Tenaris Connections AG was the successor in title on the basis of section 4 of Agreement D19 when applying Italian law.

6.6.2 Approach based on Dutch law

With regard to Dutch law, it is uncontested that what was transferred with retroactive effect was not the legal title but the economic ownership ("economische eigendom"). The appellant also confirmed at the second oral proceedings (cf. minutes, page 7, last paragraph, to page 9, first paragraph) that, when the parties to the contract entered into it, they agreed that solely the economic ownership was to be transferred to Tenaris Connections AG with retroactive effect, but not also the legal title. Whereas Tenaris Connections AG was entitled, retroactively as from 1 January 2003, to all benefits and revenues from the transferred rights and bore the costs and risks in relation to the transferred subject-matter, Tenaris Connections BV remained the legal owner and retained the legal title until 9 September 2003, the date on which Agreement D19 was concluded (see also legal opinion D20, points 2.2 to 2.5). Therefore, on the basis of the retroactive effect, when the subsequent application was filed Tenaris Connections BV was the sole owner of the legal title and Tenaris Connections AG had economic ownership. According to the appellant, the economic ownership that Tenaris Connections AG had acquired could be qualified as a licence (cf. minutes of the second oral proceedings, page 7, third paragraph).

For the present purposes there was no further need for the board to clarify whether section 4 of Agreement D19, due to its reference to "Patents" and the definition in section 1, related only to the priority application or whether it also comprised the right to claim priority from that application. The board accepted that the retroactive effect should indeed apply to both.

In order to show that the transfer of "economische eigendom" on the basis of section 4 of Agreement D19 was to be considered a "succession in title" under Dutch law the appellant referred to the *Nebula* decision of the Dutch Hoge Raad (decision of 3 November 2006, NJ 2007, 155; cf. legal opinion D20, point 2).

The board accepts that "economische eigendom" exists as a legal concept under Dutch law. However, it is not derivable from the decision relied upon, nor has it been shown by the appellant to the satisfaction of the board, that the transfer of "economische eigendom" on the basis of a contractual agreement is to be considered, under Dutch law, as a "succession in title" for the purpose of claiming priority from an earlier patent application, i.e. as having the consequence that the successor in title would be considered, under Dutch law, to be entitled to claim priority from an earlier application. For the relevant point in time, namely the filing of the subsequent application, the arrangement amounted in the board's view to a limited transfer of rights, as opposed to a transfer of overall rights of ownership. This was not sufficient for Tenaris Connections AG to become a successor in title within the meaning of Article 87(1) EPC 1973. The appellant's further arguments in this context did not lead to a different finding by the board.

(a) Decision J 19/87

The appellant relied in its submissions on decision J 19/87, in which a transfer of the "equitable interest" under English law was found to be sufficient.

However, the situation underlying J 19/87 is to be distinguished from the present one. Therefore, a

different finding would not contradict this previous decision.

In J 19/87, the inventor Mr B had assigned to a company his rights in the invention and in the UK patent application that he had filed, together with the right to file further applications and the right to claim priority from the UK application. Agreeing that the first assignment was void, the company assigned the rights back to the inventor by an agreement under seal. The inventor then filed a European patent application claiming priority from the earlier UK application. However, the second agreement had not been signed by the inventor, with the effect that, under the relevant provisions of the UK Patents Act then in force, which required the signature of both parties for the assignment of a patent application, he became the owner of the invention, but not the owner of the UK patent application. As regards the application, he became "entitled in equity" and was entered as such on the Register of Patents in the UK.

In these circumstances, the deciding board held that when the European application was filed, the inventor *"was entitled to the right to apply for and be granted a European patent in respect of the invention the subject of the UK application, having regard to Article 60 EPC, first sentence. Furthermore, ... under Article 87(1) EPC on [the date on which the European application was filed] Mr B[...] enjoyed, for the purpose of filing the European patent application ..., a right of priority"* (cf. J 19/87, Reasons, point 2).

The board notes that this conclusion was drawn from a situation in which the relevant assignment agreement, by which ownership was to be transferred, was concluded

prior to the filing of the subsequent application and was defective solely for formal reasons. The formal defects in the assignment could have been remedied by the contracting parties at any moment after its conclusion, and this remedy was legally possible under English law. In the present case, the parties contractually agreed that the assignment agreement, which was concluded after the filing date of the subsequent application, should have retroactive effect in relation to the transfer of economic ownership only. It was not intended that the legal title too should be transferred as from the earlier date, nor could it have been acquired.

Moreover, as follows from J 19/87, Reasons, point 2, and page 5 of the legal opinion given in that case (cf. enclosure of legal opinion D28), the "equitable assignment" was registrable on the UK patent register and registration had indeed taken place. As to the present case, according to the appellant's explanation, registration of economic ownership in the patent register was not provided for under Dutch patent law. Economic ownership could be defined as a licence, and licences were clearly registrable. However, no registration in the Dutch patent register had been effected for Agreement D19.

With regard to the appellant's argument that "economische eigendom" was the same as ownership "in equity" as in decision J 19/87 and that, for this reason, a similar approach should be taken, the board agrees with the respondent that these concepts are to be distinguished from one another. The "title in equity" under English law, with which J 19/87 was concerned, arose in a particular situation and can, in

the board's view, not be taken out of its context but should be confined to the facts of that case.

(b) *Travaux préparatoires* to the Paris Convention

The appellant further referred to the legislative history of Article 4A(1) Paris Convention as amended by the Washington Conference in 1911, and argued that the *travaux préparatoires* would not support the conclusion that an actual transfer of ownership of either the priority application or the priority right originating from it was required. In the appellant's view, the concept of "ayant cause" was not seen as limited to a transfer or cessation, as was clear from the unchallenged position of the UK delegate that this expression was equivalent to "*heirs, executors, administrators and assigns*" (see Actes de Washington, *supra*, page 247). The appellant further submitted that "administrators" and "executors" were generally not legal owners but only *"people acting with some form of authorisation from the legal owner and are thus entitled to represent that legal owner or can be assumed to act with the legal owner's contractual consent"* (cf. legal opinion D28, point 3.9).

Without further considering the legal impact which the declaration of one member of the Paris Union has on the interpretation given to the Paris Convention by other Union members or on the EPO, the board notes that there is no clear information on file on the concept of "administrators" and "executors" as referred to by the UK delegate. In the light of the respondent's submissions that the laws in the UK were different, the appellant's alleged definition of the terms "administrators" and "executors" is too vague for the board to establish to its satisfaction that both

concepts as referred to by the UK delegate are similar to the owner of the "economische eigendom" under Dutch law as transferred by Agreement D19. The concept of "ayant cause" as understood by the UK delegation does not become clearer on the basis of the report of the Conference concerning the addition of this term, which indicates that the UK delegation accepted it "*sous la réserve que la signification des mots « ayant cause » est limitée aux « cessionnaires » et représentants légaux*" (see Actes de Washington, *supra*, page 275).

Hence, in view of the lack of clarity as to the meaning of the terms cited by the appellant, the board considers that the reference to the *travaux préparatoires* to the Paris Convention does not support the appellant's case.

(c) Decisions T 205/14 and T 517/14

In support of its argument that obtaining "economic ownership" under Dutch law on the basis of section 4 of Agreement D19 should be accepted as "succession in title", the appellant also relied on the statement in decisions T 205/14 and T 517/14 that assessing whether the applicant is a "successor in title" within the meaning of Article 87(1) EPC 1973 "*is the exclusive concern of national law*" (cf. T 205/14, Reasons, point 3.6.3, and T 517/14, Reasons, point 2.7.3).

The board notes that this statement was made to refute the argument that the EPC legislator did not intend to burden the EPO with questions of national law and that therefore the issue should be solved on the basis of Article 60(1) and (3) EPC 1973. This board agrees with the statement in these two decisions but fails to see a conflict with the above-mentioned passages relating to

the "*exclusive concern of national law*" cited by the appellant, given that, in the present case, the board could not establish on the basis of the appellant's submissions that Tenaris Connections AG was, when the subsequent application was filed, the "successor in title" under any of the national laws relied on by the appellant. The board notes, however, that the reference to "national law" might, depending on how the relevant law that governs the requirements for a "succession in title" under Article 87(1) EPC 1973 is to be determined, need further interpretation. This question did not arise in the present case since it concerned an Italian priority application that was transferred by a Dutch company on the basis of a contract that, according to the agreement itself, should be governed by the laws of the Netherlands, and, as set out above, the appellant based its arguments only on Italian and Dutch law.

(d) Should economic ownership of Tenaris Connections AG acquired under section 4 of Agreement D19 suffice?

The appellant argued that, for tax purposes, economic ownership generally sufficed to have the economic owner treated as the proprietor (cf. legal opinion D21, page 3). However, in the board's view, this is not sufficient for it to be accepted as succession in title in the present context. The board acknowledges that, in the area of tax law, economic considerations may prevail for the allocation of subject-matter to natural or legal persons and that patents, including applications and priority rights, are important economic assets.

On the other hand, the board notes that the provisions of the EPC governing the filing and examination of

patent applications and the validity of granted patents are more specifically characterised by a formal allocation of the application or patent to a person (or jointly to a group of persons), on the basis of the act of filing. A multiplicity of rights and roles is generally avoided (cf. Article 60(3) EPC 1973, Article 61 EPC, Article 118, first sentence, EPC 1973). Moreover, the priority right under Article 4A Paris Convention and Article 87(1) EPC 1973 originates in the person of the applicant, irrespective of entitlement to the invention.

In the present situation, legal ownership and economic ownership became separated due to the retroactive effect contractually agreed upon between Tenaris Connections BV and Tenaris Connections AG after the filing date of the subsequent application. Tenaris Connections AG was to be the owner of (only) the "economische eigendom" of the priority application or the priority right derived from it as of a date preceding the filing of the subsequent application. This is a limited transfer of ownership, and for that reason Tenaris Connections AG is, in the board's view, not to be considered a "successor in title" within the meaning of Article 87(1) EPC 1973. As of the original date, legal ownership remained vested in Tenaris Connections BV, the applicant of the priority application. The board also sees no reason why the economic ownership obtained by Tenaris Connections AG, which according to the appellant's submissions could be defined as a contractual licence, should be a basis for claiming priority or prevail over legal ownership retained by Tenaris Connections BV. In this context, the board also notes that no evidence was filed by the appellant demonstrating that acquisition of "economische eigendom" under Dutch law (or economic

ownership in general) has been accepted by a national court as "succession in title" in the context of claiming priority or in the area of patent law in general.

6.6.3 Because Tenaris Connections AG did not, together with the economic ownership, acquire the legal title with retroactive effect, it is not necessary to decide on the further question of whether the retroactive effect of the contractual agreement valid under national law would have to be acknowledged under Article 87(1) EPC 1973 or on the relevance of the findings of the Enlarged Board of Appeal in decision G 1/13 (OJ EPO 2015, A42) in this respect.

6.6.4 Hence, in light of the above, the board concludes that Tenaris Connections AG was not the successor in title within the meaning of Article 87(1) EPC 1973 on the basis of section 4 of Agreement D19 (line of argument (ii)) when the subsequent application was filed.

6.7 Transfer agreement "by carrying out convincing behaviour within a corporate group", namely by filing the subsequent application (line iii)

The respondent questioned the applicability of Italian law, on which the appellant had based this line of argument. However, this question does not need to be answered in the present circumstances. The board accepts that, as argued by the appellant, patent applications and priority rights may be transferred under Italian law "by carrying out convincing behaviour" or "by conclusive action", which was understood by the board to mean in the present case that a transfer allegedly occurred on 6 September 2003 by means of an agreement implied by conduct, namely by

the filing of the subsequent application on behalf of Tenaris Connections AG, claiming priority from the earlier application filed by Tenaris Connections BV, a company within the same corporate group.

However, in the board's view, such a transfer has not been proven. In this context, the board has taken the approach that Article 72 EPC 1973 provides no basis for imposing formal requirements for a transfer of the Italian priority application or the priority right derived from it and has assessed the evidence provided on the basis of the principle of free evaluation of evidence (see also decisions T 205/14, Reasons, point 3.6.1, and T 517/14, Reasons, point 2.7.1).

Tenaris Connections BV and Tenaris Connections AG are separate legal persons belonging to the same corporate group. Legal acts such as the filing of patent applications or oppositions are to be attributed to the legal person that performed them, and not to the corporate group (see also T 5/05, Reasons, point 4.3; G 2/04, *supra*, Reasons, point 2.2.1). The priority application and the right to claim priority from it were therefore to be attributed to Tenaris Connections BV, subject to a later transfer.

The appellant argued that the fact that the subsequent application was filed in the name of Tenaris Connections AG, claiming priority from the earlier application filed in the name of Tenaris Connections BV, implied that an agreement as to the transfer of ownership of the priority application or the priority right arising from it was manifested between the two companies by virtue of the filing of the subsequent application.

In the board's view, however, the sole act of filing a subsequent application of one company of a corporate group which claims priority from an earlier application of another company of the same corporate group does not clearly imply that there was a mutual agreement between the companies concerning a transfer of ownership of the priority application or the priority right arising from it.

The appellant pointed out that, in claiming priority, the content and data relating to the unpublished priority application must have been known to Tenaris Connections AG. However, whether or not data relating to a filed patent application, or its content, is available not only to the company that is the applicant of the application but also to other companies of the corporate group is one issue. A further, different issue is whether a company within the same group has acquired ownership of another company's patent application or the right to claim priority from it and, if so, under what circumstances this occurred.

In support of its argument for a "transfer by convincing behaviour", the appellant referred to decisions of Italian courts relating to trade marks. The board notes that no Italian case law concerning a transfer of a patent application or the right to claim priority from it was cited. Moreover, in the extract from the decision presented by the appellant concerning the "theory of the group trade mark" and the "free circulation inside the group" it is stated that "*there is no need to use the scheme of the contract of licence ... in the presence of productive or commercial contracts, which comprise ... enterprises which operate ... according to unitary decisions of industrial policy*" (see appellant's letter of 3 July 2015, page 6,

third paragraph). The board notes that in the present case no "productive or commercial contract" or comparable evidence is on file.

The further court decisions cited by the appellant (see legal opinion D21, page 5, second and third paragraphs) mention the existence of declarations as to which party is the owner. The appellant referred in this context to Agreement D19, arguing that it was produced by the parties as written evidence of the previously concluded assignment ("*ad probationem*"). The respondent pointed out that Agreement D19 did not mention any contract as having already been concluded and that it contradicted the allegation that a transfer had already occurred upon filing of the subsequent application.

In the board's view, in the light of the text of Agreement D19 ("*hereby assigns and transfers*") and in the absence of any reference or hint in respect of an earlier transfer, an ordinary reader of Agreement D19 would not assume that a transfer of the rights mentioned in Agreement D19 had already occurred prior to its conclusion. There is no indication of the purpose of the clause in Agreement D19 providing for retroactive effect, and hence it is not clear whether it aims at formalising an earlier agreement made in non-written form or at actually producing earlier effects. A contract concluded with a retroactive clause is no proof that rights have already been transferred before the date of its conclusion.

The appellant submits that it was not unusual for "*ad probationem*" agreements to be drafted in such a way and that this was done in the present case in order to have a valid agreement in case the previous transfer was not accepted; but this is an unproven allegation, not

supported by any evidence. Similarly, the filing of the subsequent application in the name of Tenaris Connections AG, which occurred before the conclusion of Agreement D19 but later than the date envisaged for the retroactive effect, cannot serve as proof in this context in itself.

Finally, the reference to the "*Fahrzeugscheibe*" decision of the German Federal Court of Justice (BGH, X ZR 49/12 of 16 April 2013) does not support the appellant's argument either. In that case, the Federal Court of Justice accepted that there had been a transfer of the priority right between companies of the same group implied by conduct under German law prior to the filing of the subsequent application. However, the situation as regards the evidence on file was quite different: in particular, there was proof that there was a contract on co-operation in research and development which had been concluded between the companies of the corporate group prior to the filing of the applications and which addressed the issue of industrial property rights. Furthermore, there was evidence of a communication from the company which had filed the priority application to the holding company, addressing the question of an extension of patent protection to other countries, which in the light of the existing contract was interpreted by the court as an offer of a transfer, as well as evidence of a copy of the internal files of the holding company predating the filing of the subsequent application, which was interpreted as the acceptance of the offer that did not have to be expressly declared in view of a waiver contained in the existing contract. No comparable evidence which could have been evaluated by the board was submitted by the appellant in the context of the line of argument relating to a transfer upon filing of

the subsequent application (line (iii)), and the evidence submitted by the appellant in the context of the line concerning a transfer by an agreement "manifested by conclusive action" *prior* to the subsequent filing (line (v)) was not admitted into the appeal proceedings *inter alia* because it was considered not to be highly relevant (see point 2.3 above).

Thus, in view of the above the board comes to the conclusion that an agreement for a transfer of the priority application or the priority right arising from it from Tenaris Connections BV to Tenaris Connections AG implied by conduct, as manifested by the act of filing the subsequent application, has not been sufficiently proven.

6.8 For these reasons, the board cannot concur with any of the appellant's lines of argument (i) to (iii) submitted in support of the validity of its priority claim and to be assessed as to their merits. Therefore, the priority claimed in the patent in suit is not valid.

7. *Referral to the Enlarged Board of Appeal*

7.1 According to Article 112(1)(a) EPC 1973, a board may, either of its own motion or following a request from a party, refer any question of law to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law, or if an important point of law arises.

The appellant has based its request for a referral on both alternatives, uniform application of the law and the arising of an important point of law (see point XV above for the wording of the proposed questions).

7.2 Uniform application of the law

With regard to the first alternative, the appellant referred to Article 21 RPBA, but that relates to a situation where a board considers it necessary to deviate from an earlier opinion or decision of the Enlarged Board. That is not the case here. As set out above (see point 6.5.3), the question of a general acceptance of a retroactive effect, for which decision G 1/13 (*supra*) might have been of relevance, and the resultant question whether the present situation is comparable to the one in case G 1/13 did not in fact arise.

The appellant argued that the board deviated from decisions T 62/05 and T 1008/96 in the context of the assessment of Agreement D19 and from decisions J 19/87, T 205/14 and T 517/14 in the context of the qualification of "economische eigendom". As set out above (see points 6.4.5, 6.5.2(a) and (c)), the board does not consider that there are any contradictions with these decisions, particularly in view of the differing situations underlying the respective cases.

In as far as the appellant relied on a deviation from the decision of the German Federal Patent Court of 28 October 2010 (11 W (pat) 14/09), the board notes that this approach does not seem to be followed by the German Federal Court of Justice (*Fahrzeugscheibe* decision of 16 April 2013, X ZR 49/12, Reasons, point II.2.a)). Moreover, Article 112 EPC 1973 is concerned with a uniform application of the law within the boards, and thus a referral cannot be based on divergence from national court decisions. However, this does not, of course, mean that the boards pay no

attention to developments in jurisprudence before national courts.

The appellant also argued that a uniform application of the law was not ensured if the question of whether a person is a "successor in title" was to be answered on the basis of national law, because the result could vary, depending upon the applicable law. Instead, uniform application of the law required the concepts of both succession in title and enjoyment of priority right to be primarily, if not exclusively, governed by convention law rather than national law.

The board notes that the appellant had never contested in the proceedings before the board that national law should apply, even though the opposition division and the board had from the outset followed this approach. The appellant also acknowledged that there were differences depending on the national law which was applied (cf. legal opinion D20, points 2.5 and 4). The argument that the issue should be dealt with primarily by the law of the EPC was raised only in the context of whether or not to refer questions to the Enlarged Board.

In this respect, the board reiterates what was already held in decisions T 205/14 (Reasons, point 3.6.2) and T 517/14 (Reasons, point 2.7.2), namely that the EPC does not establish a fully harmonised patent system and that the question of who can be a "successor in title" within the meaning of Article 87(1) EPC 1973 must, in the absence of EPC provisions governing this question, be answered on the basis of national law. Also, otherwise situations such as a transfer by operation of law would not be covered. Moreover, in other decisions of the boards too, the assessment of "successor in

title" was made on the basis of national law (see J 19/87, Reasons, point 2; T 1008/96, Reasons, point 3.3; T 160/13, Reasons, point 1.1). Decision T 62/05, which applied the requirements of Article 72 EPC 1973 in assessing the validity of a contractual transfer of the priority right, appears to be an isolated one and not further followed (see in this respect T 205/14, Reasons, point 3.6.1, and T 517/14, Reasons, point 2.7.1).

That national law applies in this context is therefore based on a uniform approach of the boards of appeal. It has also not been argued that relevant national law is, in the present case, applied by this board in a different way than in an earlier decision by any board.

7.3 Important point of law

7.3.1 An "important point of law" within the meaning of Article 112(1)(a) EPC 1973 arises if that point is of fundamental importance in that it is relevant to a substantial number of similar cases and is therefore of great interest not only to the parties to the present appeal but also to the public at large (see e.g. T 271/85, OJ EPO 1988, 341; G 1/12, OJ EPO 2014, A114, Reasons, point 11). However, even in such a situation, the board should make a referral only if it considers that a decision by the Enlarged Board is required.

7.3.2 In the present case, the board had to rule whether a transfer of ownership of the priority application or the priority right derived from it which occurred at a point in time which was (1) after the filing of the subsequent application, (2) after expiry of the 12-month priority period, and (3) after the filing of the declaration of priority was sufficient for a succession

in title within the meaning of Article 87(1) EPC 1973. The board acknowledges that this may affect a number of cases.

However, the board reached its conclusion on the basis of the wording of the provisions of the EPC and the Paris Convention and considered the result confirmed by their purpose and the *travaux préparatoires*. The approach taken is consistent with the existing case law of the boards of appeal and of national courts, and the board was therefore able to decide on the issue free from any doubts.

7.3.3 Concerning the question whether "economische eigendom" under Dutch law acquired by section 4 of Agreement D19 qualifies as a "succession in title" within the meaning of Article 87(1) EPC 1973, it appears doubtful that it would be relevant to a substantial number of similar cases. Even if this was the case, the board considered itself in a position to resolve the issue on its own.

The board acknowledges, as pointed out by the appellant, that, in view of the board's finding that the priority was invalid, the appeal had to be dismissed and the revocation of the patent in suit became final with this decision, and that this is irremediable due to the board's capacity as being the first and final judicial instance and the fact that no further proceedings as to the merits of the case are available for the appellant.

The final-instance aspect is inherent in all proceedings before the boards of appeal and therefore not in itself a determining factor in the assessment of a referral. Also, there is an omnipresent risk that, once a board has taken a decision, its approach may be

seen differently by another board or even be superseded by a later opinion or decision of the Enlarged Board. Deciding cases and thereby actively taking part in the further development of the jurisprudence relating to the European patent system is one of the natural duties of the boards of appeal.

In support of its argument for a referral concerning the interpretation of the concepts "succession in title" and "enjoyment of a priority right", the appellant has also referred to Article 1 of the First Protocol to the ECHR and Article 17 of the Charter of Fundamental Rights of the European Union, which provide guarantees for the protection of "property" or "possession", concepts covering proprietary interests and rights of commercial value. The appellant emphasised in this context that, according to the *Anheuser-Busch v Portugal* judgment of 1 November 2007, the role of the European Court of Human Rights was to ensure that decisions of courts *"are not flawed by arbitrariness or otherwise manifestly unreasonable"*. A referral to the Enlarged Board was warranted, *"to make sure that Tenaris Connection A.G. will not suffer from arbitrary interpretations of article 87(1) EPC"*.

Leaving aside considerations of whether and under what circumstances the board is bound by the cited legal provisions, the board appreciates the importance of the issues in question for the appellant. However, it does not share the appellant's concern that its interpretation of Article 87(1) EPC 1973 is arbitrary.

7.4 For the above reasons, the appellant's request for a referral to the Enlarged Board of Appeal must be refused.

MAIN REQUEST AND FIRST AUXILIARY REQUEST

8. *Inventive step starting from document D2, Article 56 EPC 1973*

8.1 During the first oral proceedings held before the board, the issue of inventive step was initially discussed starting from document D2.

8.2 Document D2 discloses (see column 3, line 58, to column 4, line 30, and Figures 1 and 2) a threaded joint structure comprising a male thread 2 and a female thread 3 with substantially cylindrical walls, the male thread 2 having a toroidal sealing surface near its end portion having a radius R1 between 50 and 300 mm. It also discloses that the male and female threads 2, 3 have a trapezoidal profile. It is silent about the clearance between the stab flanks of the male and female members in the assembled position and about the diametric interference δ between the toroidal and frusto-conical sealing surfaces.

The subject-matter of claim 1 of the main request differs from the threaded joint structure known from document D2 in that the clearance between the stab flanks of the male and female members in the assembled position is equal to or less than 0.15 mm and in that the diametric interference δ between the toroidal and frusto-conical sealing surfaces is in the range from 0.2 mm to 1.0 mm.

8.3 It is common general knowledge in the art of threaded joints for oil well pipes that the clearance or gap between the stab flanks of the male and female members in the assembled position must be designed to close such that the stab flanks forming the gap engage at a

value of compressive stress that is less than the compressive stress causing deformation of the torque shoulder, with a view to distributing the compression load to the threads without yielding the torque shoulder, cf. for example document D6, page 8, lines 23 to 30. This document mentions (see page 9, lines 3 and 4) that in a typical application of the threaded connection according to the invention, the clearance between the stab flanks will preferably be 0.002-0.004 inch (0.05 to 0.1 mm), which is within the range of equal to or less than 0.15 mm claimed in claim 1 of the main request. Also, document D7 shows embodiments of couplings for well casings having a clearance between the stab flanks of the male and female members in the assembled position within the claimed range (see column 2, lines 35 to 40). Reference is also made to API Specification Standard 5B (see document D9, last page, replacement Figure 6).

It is also common general knowledge in the art of threaded joints for oil well pipes that the diametric interference, i.e. the difference between initial nominal diameters of the male and female members in unloaded condition, must be designed such that a sufficiently large surface pressure at the sealing surfaces is generated, see e.g. document D15, page 2, lines 35 and 36. This document shows embodiments of tubes having various radii of curvature, seal taper and seal length (see Tables 2, 3 and 4) and a diametric interference of max. 0.95 and 0.75 mm for tubes with an outer diameter of 273.05 and 177.80 mm, respectively (see Table 2, penultimate row). Also, document D16 shows embodiments of tubes having a diametric interference within the range from 0.2 mm to 1.0 mm claimed in claim 1 of the main request (see Tables 1 and 3, third row from the bottom).

8.4 In the judgment of the board, the person skilled in the art of threaded joints for oil well pipes, starting from document D2 and seeking to provide a threaded joint structure having good sealing properties, would select a clearance between the stab flanks of the male and female members in the assembled position on the basis of the common general technical knowledge recited in point 8.2 above, and would select a diametric interference on the basis of the common general technical knowledge recited in point 8.3 above, and would thus arrive at the invention.

In this state of affairs, there is no need to examine whether or not there was a synergistic effect between the claimed range for the clearance between the stab flanks of the male and female members in the assembled position and the claimed range for the diametric interference δ between the toroidal and frusto-conical sealing surfaces.

8.5 Hence the subject-matter of claim 1 of the main request is obvious to the person skilled in the art and therefore does not involve an inventive step within the meaning of Article 56 EPC 1973.

8.6 The additional feature of claim 1 of the first auxiliary request requires that the contact length b between the toroidal sealing surface of the male member and the frusto-conical sealing surface of the female member is longer than 0.5 mm.

The contact length b is the length axially measured on the male and female seal surfaces in which the contact pressure is developed. As shown in Figure 3, the diameters of the male and female members, which differ by the diametric interference δ in unloaded condition,

are equal in the assembled position where these members are in contact.

It is clear to the person skilled in the art that the value of b is related to the radius Rs of the toroidal seal surface, cf. paragraph [0023] of the patent. It follows from the formula at column 6, line 27, that the contact length b is in fact proportional to the square root of Rs. The value of b is also related to the level of interference δ, see paragraph [0018] of the patent.

Thus specifying a minimum value for the contact length b adds hardly any substantial information over and above the indication of the range for the radius Rs of the toroidal seal surface and the range for the diametric interference δ. The person skilled in the art, starting from document D2 as the closest prior art, having selected a clearance between the stab flanks of the male and female members in the assembled position on the basis of the common general technical knowledge recited in point 8.2 above and having selected a diametric interference on the basis of the common general technical knowledge recited in point 8.3 above, would obtain a threaded joint structure having an active length of contact pressure of at least 0.5 mm.

8.7 Hence the subject-matter of claim 1 of the first auxiliary request is obvious to the person skilled in the art and therefore does not involve an inventive step within the meaning of Article 56 EPC 1973.

SECOND AND THIRD AUXILIARY REQUESTS

9. *Admission of the second and third auxiliary requests*

9.1 Article 12(1)(a) RPBA stipulates that appeal proceedings are to be based on the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC.

While it lies within the power of the board "to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings" (Article 12(4), first half-sentence, RPBA), the general rule is that everything presented by the parties under Article 12(1) RPBA "shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in" Article 12(2) RPBA (Article 12(4), second half-sentence, RPBA).

9.2 Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the feature of claim 3 as granted "[and in that] the male member (1) has a front end frusto-conical abutment surface (9) forming an angle (γ) comprised in a range between -15° and -5° with a plane orthogonal to a longitudinal axis (X) defined by the joint", hereinafter "male member feature", has been added at the end of the claim.

Likewise, claim 1 of the third auxiliary request differs from claim 1 of the first auxiliary request in that the male member feature has been added at the end of the claim.

The male member feature distinguishes the subject-matter of claims 1 of the second and third auxiliary

requests significantly from the threaded joint structure known from document D2, see point 10.1 below.

9.3 The board has taken into consideration that the respondent questioned the validity of the priority, and first cited more documents (e.g. D15 and D16) to demonstrate the common general knowledge of the skilled person, only with its letter of 2 December 2010. Since the oral proceedings before the opposition division already took place on 7 December 2010, the appellant had very limited time to formulate a response. Hence, in the board's view, the appellant could not have been expected to file the second and third auxiliary requests in the oral proceedings before the opposition division.

In these circumstances, the second and third auxiliary requests filed by the appellant for the first time with its statement of grounds of appeal are considered by the board to be an appropriate attempt to overcome the objection of lack of inventive step raised in the proceedings before the opposition division.

9.4 In view of the above, the second and third auxiliary requests are therefore taken into account in these appeal proceedings pursuant to Article 12(4) RPBA.

10. *Novelty and inventive step, Articles 54(1), (2) and 56 EPC 1973*

10.1 Document D2 teaches that "*a first metal-to-metal contact seal is formed upon make-up of the joint between an outer surface of a thread-free end portion or lip of the male threaded member*" and that "[A]*t the same time, a second metal-to-metal contact seal is formed between the end face of the lip of the male*

member and a corresponding face of the female member, the end face of the lip substantially having a profile of a convex or concave surface of revolution and the corresponding face of the female member having a profile substantially complementary to that of the mating end face of the male member so that an extremely high contact pressure is developed at the end of the make-up by virtue of the principles of the contact between convex and concave surfaces", cf. column 2, lines 37 to 57. The area of high contact pressure of the second metal-to-metal contact at the end face of the male member ("seal 22") is shown in Figure 3. The mating faces are convex and concave surfaces of revolution, cf. column 3, lines 7 to 10, and lines 19 to 21.

For the person skilled in the art, starting from document D2, it was not obvious to replace the male member having a convex or concave mating surface with a male member having "a front end frusto-conical abutment surface (9) forming an angle (γ) comprised in a range between -15° and -5° with a plane orthogonal to a longitudinal axis (X) defined by the joint" as required by claim 1 of the second auxiliary request, since that would go against the teaching of document D2.

Hence it is necessary to investigate whether the subject-matter of claim 1 of the second auxiliary request is new and, if so, whether said subject-matter involves an inventive step with respect to document D1.

10.2 Since the priority claimed for the patent is not valid (see point 6.7 above), document D1, which was published on 12 June 2003, i.e. before the date of filing of the European patent application which matured into the

patent in suit, forms part of the state of the art pursuant to Article 54(2) EPC 1973.

10.3 Document D1 discloses all the features of the preamble of claim 1 of the second auxiliary request, see Figures 2 and 5. With respect to the last feature of the preamble it is noted that this document discloses (see page 15, lines 17 to 20) that the toroidal portion has a radius of curvature R1 ("radius Rs" in the patent in suit) on the threading side which is preferably between 30 and 120 mm, in the present case 60 mm, and that the threaded tubular connection of the invention has been modified with respect to a prior-art pipe with an external diameter of 244.48 mm and a thickness of 13.84 mm (page 16, lines 20 to 30) by simply adding an appendix with an axial length of 3 mm (page 13, lines 17 to 22). Document D1 also discloses the last characterising feature of claim 1 of the second auxiliary request, see page 13, line 31, to page 14, line 2, and Figure 5.

10.4 The male threaded portion comprises a male threading with trapezoidal threads (page 11, lines 8 and 9, and Figure 14). The clearance between the stab flank of the male member and the corresponding stab flank of the female member is indicated by d1 (page 20, lines 22 to 24). Since document D1 does not disclose the length of the clearance d1, it does not disclose the first characterising feature of claim 1 of the second auxiliary request.

The respondent argued that document D1 (see page 11, lines 7 to 13) referred to trapezoidal threads of the type known as "buttress" threads as defined in API specification 5B. This specification corresponded to document D9, which disclosed on page 9 a clearance of

0.025 to 0.18 mm. Said clearance was thus "incorporated by reference" in document D1. Document D1 (see page 16, lines 24 to 27) also referred to catalogue VAM® No. 940 edited by Vallourec Oil & Gas in July 1994, which disclosed thread forms having a clearance in the claimed range and which corresponded to document D8.

The board cannot accept the respondent's view. The disclosure of documents referred to in a ("referring") document is part of the disclosure of the referring document only to the extent that it is made explicitly clear in the referring document what information is referred to. The reference in document D1 to "of the type known as "buttress" threads as defined in API specification 5B" and the reference to "[The] prior art threaded connection studied corresponds to a VAM TOP® premium threaded tubular connection as shown in VAM® catalogue n° 940 edited by Vallourec Oil & Gas in July 1994 for pipes with an external diameter of 244.48 mm and thickness 13.84 mm ..." fail to meet this requirement.

10.5 Document D1 is silent about the diametric interference between the toroidal sealing surface and the frusto-conical sealing surface. Hence this document does not disclose the second characterising feature of claim 1 of the second auxiliary request.

The respondent also argued that the diametric interference could be inferred from the passage on page 17, lines 14 to 16, of document D1, which reads: "*Curve C relating to the change in the contact width between the sealing surfaces indicates an effective contact width reducing from 1.5 to 1.1 mm when the axial tensile load changes from 0 to 100%*" (translation by the board). Reference was also made to Figure 5 and

claim 9 of document D1, reading: "*Threaded tubular connection according to any of the claims 6 to 8, wherein each lip sealing surface has an axial width (l_s) of less than 10 mm and preferably 5 mm or less*" (translation by the board).

This argument cannot be accepted. In accordance with the invention of document D1 (see page 5, lines 13 to 15, and Figure 5), the lip of the male member comprises a portion termed the "appendix" with an axial length l_a between the lip sealing surface and the distal axial abutment surface at the free end of the lip, whereby the lip sealing surface (see page 14, line 24, to page 15, line 6) is constituted by (a) on the free end side, a conical portion 33 with a width l_c and (b) on the threading side, a toroidal portion 31 with a width l_r, whereas in the patent in suit and in document D2 the sealing surface consists of a toroidal portion only. The relation between the contact length and the diametric interference for a sealing surface consisting of a toroidal portion is not necessarily applicable to the sealing surface of document D1.

10.6 The subject-matter of claim 1 of the second auxiliary request is therefore new vis-à-vis document D1.

10.7 The subject-matter of claim 1 of the second auxiliary request differs from the threaded joint structure known from document D1 in that the clearance between the stab flanks of the male and female members in the assembled position is equal to or less than 0.15 mm and in that the diametric interference δ between the toroidal and frusto-conical sealing surfaces is in the range from 0.2 mm to 1.0 mm.

In the board's judgment, the person skilled in the art of threaded joints for oil well pipes, starting from document D1 and seeking to provide a threaded joint structure having good sealing properties, would select a clearance between the stab flanks of the male and female members in the assembled position on the basis of the common general technical knowledge recited in point 8.2 above within the range claimed for said clearance, and would select a diametric interference on the basis of the teaching of the common general technical knowledge recited in point 8.3 above within the range claimed for the diametric interference, and would thus arrive at the invention.

10.8 It follows that the subject-matter of claim 1 of the second auxiliary request does not involve an inventive step within the meaning of Article 56 EPC 1973.

10.9 Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the expression "in that the contact length "b" between the toroidal sealing surface (11) and the frusto-conical sealing surface (12) is longer than 0,5 mm" has been added before the expression "and in that the male member ...".

The additional feature is known from document D1, see the passage on page 17, lines 14 to 16.

10.10 It follows that the subject-matter of claim 1 of the third auxiliary request does not involve an inventive step within the meaning of Article 56 EPC 1973 for the same reasons as those set out for the second auxiliary request.

11. In view of the above, none of the appellant's main request and first to third auxiliary requests is allowable. Therefore, the appeal must be dismissed.

12. *The appellant's request for reimbursement of the appeal fee*

Pursuant to Rule 67 EPC 1973, a prerequisite for reimbursement of the appeal fee is that the appeal is deemed to be allowable. Since the appeal must be dismissed (see point 11 above), the appellant's request for reimbursement of the appeal fee is to be refused.

13. *Apportionment of costs*

13.1 The appellant's request for a different apportionment of costs relates to costs incurred during the proceedings before the opposition division.

The appellant did not request a different apportionment of costs during the proceedings before the opposition division, and the opposition division did not consider this of its own motion. Accordingly, no decision on this issue was taken by the opposition division.

Concerning the reasons for requesting a different apportionment of costs at the appeal stage only, the appellant admitted that it had not been considered such a request until after the oral proceedings before the opposition division (cf. minutes of the first oral proceedings, page 7, third paragraph). In view of this, the appellant's further argument that it had not been asked by the opposition division at the end of the oral proceedings about any further requests loses relevance.

Under Article 104(1) EPC, each party to the opposition proceedings bears the costs it has incurred, unless the opposition division, for reasons of equity, orders a different apportionment of costs. Pursuant to Rule 88(1) EPC, if an apportionment of costs is ordered it must be dealt with in the decision on the opposition. Rule 97(1) EPC further provides that an apportionment of costs of opposition proceedings cannot be the sole subject of an appeal.

The board infers from these provisions that the apportionment of costs incurred in the proceedings before the opposition division is a separate decision to be taken by the opposition division and that, if such a decision was taken by the opposition division, it can in specific circumstances be reviewed within the framework of an appeal. However, if no decision has been taken by the opposition division on an apportionment of costs, the board cannot consider and decide upon an appellant's request, presented for the first time in appeal, relating to an apportionment of costs incurred in the proceedings before the opposition division (similar in T 1059/98, Reasons, point 2.2).

13.2 Therefore the request for a different apportionment of costs must be refused.

Order

For these reasons it is decided that:

1. The appellant's objection under Rule 106 EPC submitted in writing during the oral proceedings on 14 April 2016 is dismissed.

2. The appellant's request for a referral to the Enlarged Board of Appeal is refused.

3. The appeal is dismissed.

4. The appellant's request for a reimbursement of the appeal fee is refused.

5. The appellant's request for a different apportionment of costs is refused.

The Registrar: The Chairman:

D. Meyfarth M. Poock

Decision electronically authenticated