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**Datasheet for the decision
of 21 January 2019**

Case Number: T 0725/14 - 3.3.02

Application Number: 09165171.1

Publication Number: 2105439

IPC: C07D307/46, C07D307/50

Language of the proceedings: EN

Title of invention:

Method for the synthesis of organic acid esters of 5-hydroxymethylfurfural

Patent Proprietor:

Furanix Technologies B.V.

Opponent:

Archer-Daniels-Midland Company

Headword:

Relevant legal provisions:

EPC Art. 54(3), 87, 112

EPC R. 139

RPBA Art. 13(1), 13(3)

Keyword:

Priority - valid transfer of priority right (yes) - validity
of priority date (no)
Referral to the Enlarged Board of Appeal - (no)
Correction of error - (no)
Novelty - main request (no)
Late-filed auxiliary request - admitted (no)

Decisions cited:

G 0001/12, J 0019/87, T 0205/14, T 1201/14

Catchword:

Priority claim held invalid in view of the transfer of the
priority right within the priority year (reasons, 4).



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Case Number: T 0725/14 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 21 January 2019

Appellant: Archer-Daniels-Midland Company
(Opponent) 4666 Faries Parkway
Decatur
Illinois 62526 (US)

Representative: J A Kemp
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Respondent: Furanix Technologies B.V.
(Patent Proprietor) Zekeringstraat 29
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Representative: EP&C
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 February 2014 concerning maintenance of the
European Patent No. 2105439 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: M. Maremonti
P. de Heij
P. O'Sullivan
L. Bühler

Summary of Facts and Submissions

- I. The appeal by the opponent (hereinafter "appellant") lies from the interlocutory decision of the opposition division, finding that the European patent No. 2 105 439, in its form modified on the basis of the then pending main request and the invention to which it relates, meets the requirements of the EPC.
- II. The contested patent was granted for European application 09 165 171.1, which had been filed as a divisional application of earlier European application 07 723 191.8 filed on 12 March 2007 under the PCT as PCT/EP2007/002146 (hereinafter "the parent application") and claiming priority from European application 06 075 565.9 (hereinafter "the priority application").
- III. Independent claim 1 of the main request found allowable by the opposition division reads as follows:
- "1. Method for the manufacture of organic acid esters of 5-hydroxymethylfurfural by reacting a fructose and/or glucose-containing starting material with an organic acid or its anhydride in the presence of a catalytic or sub-stoichiometric amount of heterogenous acid catalyst, selected from the group consisting of zeolites."*
- IV. The publication of priority application EP 1 834 951 A (D1) was among the documents cited during opposition proceedings.

The opposition division came to *inter alia* the following conclusions on the then pending main request:

- The claimed subject-matter partially enjoyed the priority date of 10 March 2006 from D1.

- D1 was thus not a conflicting application and could not be used against the novelty of the claimed subject-matter.
- The claimed subject-matter was novel and involved an inventive step.

V. In its statement setting out the grounds of appeal, the appellant maintained, *inter alia*, that the priority claim was not valid. To support its case, it filed the following new item of evidence:

D17: Declaration of assignment between Avantium International B.V. and Furanix Technologies B.V. dated 1 March 2007.

In further letters, the appellant responded to the comments made by the patent proprietor (hereinafter "respondent" or "Furanix") concerning the validity of the priority by further relying on the following new items of evidence:

D20: A written legal opinion from Mr M van Gardingen, lawyer with the firm Brinkhof N.V. of De Lairesestraat 111-115, 1075 HH Amsterdam, the Netherlands dated 13 February 2015.

D21: The decision of the opposition division dated 3 March 2015 revoking European patent No. 2 103 606 in its entirety.

D28: Response by Mr M van Gardingen dated 6 January 2016 to the legal opinion of Mr G Kuipers dated 24 August 2015 and filed with the respondent's submissions of 8 October 2015 (D27, see below).

D29: Annex A containing documents relating to the filing and transfer of European patent

application 01201096.3 and the subsequent filing of PCT/EP02/03343.

D30: Annex B containing documents relating to the transfer of two European patent applications with applicants based in the Netherlands which subsequently served as bases for claiming priority.

VI. In its reply to the statement of grounds, the respondent rebutted, *inter alia*, the arguments of the appellant and submitted that the priority was validly claimed. It relied on the following new item of evidence:

D18: Letter dated 24 October 2007 requesting the registration of an assignment.

In a further letter, the respondent also relied on the following new items of evidence:

D25: Declaration of assignment.

D26: Form PCT/IB/306 dated 16 September 2008.

D27: Legal opinion of Mr G Kuipers of law firm De Brauw Blackstone Westbroek of Amsterdam, the Netherlands, dated 24 August 2015, with its:

Annex 2: Statement of Mr T B van Aken dated 24 August 2015 regarding the right to claim priority from patent application EP 06 755 655.9.

VII. By the communication dated 21 September 2018, the parties were informed that the board had been enlarged to five members.

VIII. In a communication issued in preparation for the oral proceedings, the board expressed the preliminary opinion that the priority right appeared to have been

transferred from Avantium International B.V. (hereinafter "Avantium") to Furanix by means of the assignment D17.

IX. In its reply dated 21 December 2018, the respondent corroborated its argumentation supporting priority entitlement by relying on the following new items of evidence:

D31: Legal opinion of Mr G Kuipers of law firm De Brauw Blackstone Westbroek of Amsterdam, the Netherlands, dated 20 December 2018.

D32: Legal opinion of Prof. Dr. C J J C van Nispen, dated 19 December 2018.

D33: The Paris Convention Centenary, wipo-pub-875, ISBN 92-805-0099-6, WIPO 1983, pages 5, 15, 16, 27 to 31.

D34: Bodenhausen, *Guide to the application of the Paris Convention for the protection of industrial property*, BIRPI 1968, pages 35 to 38.

It further requested that two questions be referred to the Enlarged Board of Appeal (see below) or, alternatively, that a correction be allowed under Rule 139 EPC (see below). It also filed two sets of claims and description pages as main and auxiliary requests.

X. By letter of 14 January 2019, the appellant objected to, *inter alia*, the admittance into the proceedings of D31, D32 and the auxiliary request of the respondent. It also raised objections under Article 123(2) EPC and for lack of novelty against the auxiliary request.

It attached to its letter the following new item of evidence:

D35: Copy of the Mr T B van Aken's publicly available entry in the "Linkedin" database.

XI. By letter of 17 January 2019, the appellant filed the following new item of evidence:

D36: Response by Mr M van Gardingen dated 17 January 2019 to the legal opinions of Mr G Kuipers and Prof. Dr. van Nispen filed with the respondent's submissions of 21 December 2018 (IX, *supra*).

XII. Oral proceedings before the board were held on 21 January 2019. During oral proceedings, the respondent withdrew the auxiliary request filed by letter of 21 December 2018 (IX, *supra*) and filed a new set of claims and description pages, constituting its "third auxiliary request".

XIII. Final requests

The **appellant** requests that the decision under appeal be set aside and that the patent be revoked.

It also requests that D31 and D32 not be admitted into the proceedings.

If D31 and D32 are admitted into the proceedings, the appellant requests that D36 be admitted.

If D31 and D32 are admitted, the appellant requests that costs be apportioned against the respondent.

Lastly, the appellant requests that the third auxiliary request filed by the respondent during oral proceedings not be admitted into the proceedings.

The **respondent** requests as its main request that the appeal be dismissed and that the patent be maintained on the basis of claims 1 to 12 and amended description

pages 1, 2, 2a, 3, 3a and 4 to 6 as filed by letter dated 21 December 2018.

Alternatively, the respondent requests as its first auxiliary request that the case be stayed and that the following questions of law be referred to the Enlarged Board of Appeal:

"1. Can the original inventor/applicant - under the Paris Convention for the protection of industrial property and corresponding articles in the European Patent Convention - lose the right to priority whereby the publication of his invention despite having validly filed a subsequent application within the priority year result [sic] in the invalidation of this subsequent application?"

2. If the answer to question 1 is yes, must the Paris Convention and corresponding articles in the EPC be interpreted such that the right to create priority is taken away from the original inventor/applicant in case of a successor in title?"

As its second auxiliary request, the respondent requests that should the board conclude that assignment D17 had the effect that all rights, including the priority right, were assigned from the initial applicant (Avantium) to the patent proprietor (Furanix), the name of the applicant of the parent application (II, *supra*) be corrected to Furanix under Rule 139 EPC.

As its third auxiliary request, the respondent requests that the patent be maintained on the basis of claims 1 to 11 and description pages 1, 2, 2a, 3, 3a and 4 to 6 of the third auxiliary request as filed during oral proceedings.

In addition, the respondent requests that documents D31 to D34 be admitted into the proceedings.

XIV. The arguments of the appellant, where relevant for the present decision, can be summarised as follows:

Admittance of D31, D32 and D36 - apportionment of costs:

- Documents D31 and D32 were submitted on 21 December 2018. The documents were late-filed and the appellant had difficulty reviewing the new material over the Christmas period. The newly raised issue of the "Haviltex" principle under the law of the Netherlands (see below) clearly constituted evidence which provided a significant change in the respondent's case. The issue could have been raised earlier. The documents therefore had to be excluded from the appeal proceedings. If the board admitted the documents, then the appellant's late-filed document D36 would also have to be admitted into the appeal proceedings.
- A cost order made against the respondent was requested in view of the additional work occasioned by the respondent's late amendment to its case with the submissions of 21 December 2018.

Assignment of the priority right under Article 87 EPC:

- By the declaration of assignment (D17), dated 1 March 2007, all rights pertaining to the priority application were transferred from Avantium to the respondent, Furanix. The parent application, a divisional application of which led to the opposed patent, was filed on 12 March 2007 in the name of Avantium and claimed priority based on this

priority application. However, on that date Avantium was no longer entitled to claim priority as the right had already been assigned to Furanix. The priority claim in the parent application was therefore invalid. Since a valid right to claim priority must exist when an application is filed, the subsequent assignment of the parent application to Furanix did not remedy the deficient priority claim. As a result, the opposed patent was not entitled to priority either, and the relevant date for assessing novelty and inventive step was therefore its filing date of 12 March 2007.

- Moreover, the validity of the assignment of the priority right had to be established under national law, in this case, Dutch law. Document D20 confirmed that the priority right was transferred away from Avantium on 1 March 2007, i.e. before the filing date of the European patent application that gave rise to the divisional application for the present patent. Such a transfer was possible under Dutch law, and document D17 was effective in executing the transfer.

- The "Haviltex" principle under the law of the Netherlands did not imply that the wording of an agreement could be ignored. Rather, depending on the circumstances, the wording of a contract carried more or less weight. In the present case, the clear wording of the declaration of assignment was decisive and not to be altered by after-the-facts "evidence" of the alleged intentions of the parties. Accepting the contrary would be detrimental to the legal certainty of third parties.

Article 4 Paris Convention - Referral to the Enlarged Board of Appeal:

- The interpretation of the respondent of Article 4 of the Paris Convention (Paris Convention for the Protection of Industrial Property) was in clear contradiction to the wording and was not supported by any evidence.

Request for correction under Rule 139 EPC:

- There was no evidence that the true intention was to file the parent application in the name of Furanix. It was entirely possible that the application was intentionally filed in the name of Avantium because the legal effect of the assignment D17 was not understood. In addition, the request for correction was made too late and, in any case, correction was not possible after grant of the patent.

Novelty:

- Since the contested patent was not entitled to the claimed priority, D1, the publication of the priority application, pertained to the prior art to be considered for the assessment of novelty under Article 54(3) EPC.
- D1 disclosed all the features of claim 1 at issue, and therefore the main request lacked novelty and was not allowable.

Third auxiliary request - admittance into the proceedings:

- This claim request was filed extremely late and raised new issues under Articles 84 and 123(2) EPC. Therefore, it should not be admitted.

XV. The respondent essentially counter-argued as follows:

Admittance of D31, D32 and D36 - apportionment of costs:

- Documents D31 and D32 were highly relevant for assessing the priority entitlement and therefore should be admitted into the proceedings.

Assignment of the priority right under Article 87 EPC:

- Since Avantium was the applicant of the first application and of the subsequent European application, priority could be claimed under Article 87(1) EPC. In this context reference was made to the Guidelines, which stated that a priority claimed in the parent application also applied to the divisional application.
- The transfer of the priority application was agreed on 1 March 2007, but only on 24 October 2007 was the EPO requested to register the transfer. According to Rule 22 EPC, the transfer was not effective before this date. Avantium therefore had a valid claim to priority when it filed the parent application.
- As confirmed by declarations D31 and D32, under Dutch law, the intention of the parties was decisive for the interpretation of a contract and more important than the actual wording of the contract. This was in accordance with the "Haviltex" decision of the Dutch supreme court. Furthermore the supreme court had ruled that the conduct of the parties after the conclusion of the contract could be of importance for its interpretation. This principle applied to both the

deed of assignment and the contract that formed the legal basis for the assignment.

- Since document D17 did not explicitly mention the priority right but just the right to the patent application, this document only effectuated assignment of the latter. Avantium retained the priority right.
- This was in accordance with the intention of the parties, as substantiated by the statement by Mr T B van Aken (annex 2 of document D27) and in accordance with the subsequent conduct of the parties shortly after the assignment. The fact that only two weeks after the assignment Avantium filed the parent application, invoking the right to priority, proved the intention of Avantium to retain the right to priority.
- Assuming that Dutch law was applicable, it could not be deduced from document D17 that the priority right was in fact assigned. As was stated in document D27, the legal opinion of Mr G Kuipers: 1) priority rights were separate rights that did not automatically pass with the assignment of a patent application but must be assigned separately; 2) document D17 did not constitute an assignment, requiring an act of delivery, but was intended to merely evidence an assignment that occurred in the past; 3) document D17 did not comprise a valid legal basis underlying the formal delivery, required for assignment. In the context of the latter two points, the respondent referred to decisions T 1751/07 and T 976/97.

Article 4 Paris Convention - Referral to the Enlarged Board of Appeal:

- Article 4 of the Paris Convention in its original version of 1883 created a right to priority for the applicant of a patent application. In addition, the 1911 version introduced the right to assign the right to invoke priority to the successor in title, without, however, taking away the right to create priority from the original applicant. The right to create priority was not the same as the right to invoke priority. The original applicant could therefore assign the right to priority to a successor and at the same time retain the right to claim priority itself. The wording of the present Article 4 "*or his successor in title*" and the similar wording of Article 87(1) EPC had to be interpreted as an "inclusive or", meaning that priority can be claimed by the original applicant or its successor in title or by both the original applicant and the successor in title. This view was supported by document D34.
- The relevance of the appropriate interpretation of the Paris Convention could not be overemphasised. In fact, the invalidation of a subsequent filing in a country of the Union by reason of the publication of the invention was at the very heart of the Paris Convention. This was the principle goal to be avoided.
- The Paris Convention was the foundation on which many patent treaties, including the European Patent Convention, have been built. Questions concerning the interpretation of the priority articles in the Paris Convention were therefore of fundamental

importance, justifying a referral of the questions put forward (XIII, *supra*) to the Enlarged Board of Appeal.

- In fact, a discussion at the highest level of the case law was an opportunity to create clarity for all and had the advantage that all interested parties might comment. Comments from other jurisdictions could be taken into account, thereby providing an additional opportunity for a harmonised view on this treaty.

Request for correction under Rule 139 EPC:

- If the board concluded that the assignment of the priority right to Furanix was intentional, then it was requested that the name of the applicant of the parent application be corrected. If it was established that it was the intention of the parties to file the application in the name of Furanix, then the request for correction met all the requirements for correction. Such a correction would not be detrimental to the public.

Novelty:

- Since the contested patent was entitled to the claimed priority, D1 did not represent prior art in the sense of Article 54 EPC and could not be used to prove lack of novelty of the claimed subject-matter.

Third auxiliary request - admittance into the proceedings:

- This request, though being late-filed, had to be admitted into the proceedings since it was clearly allowable under Articles 84 and 123(2) EPC. The

recited "fructose starting material" clearly covered fructose alone as the starting material. This embodiment had an unambiguous basis in the examples of the application as filed, particularly in the first table on page 8. The respondent had to be given a fair chance for the contested patent to be maintained on the basis of this claim request.

Reasons for the Decision

Enlargement of the board

1. Pursuant to Article 21(4)(b), second alternative, EPC and Article 9 RPBA, the board was enlarged by a technically qualified and a legally qualified member.

Admittance of D31, D32, D33, D34 and D36 - apportionment of costs

2. Documents D31, D32 and D36 were filed after submission of the statement of the grounds of appeal and the respondent's reply. Admittance of these documents is therefore subject to the board's discretion, having regard, *inter alia*, to the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy (Article 13(1) RPBA).
 - 2.1 Documents D31 and D32, which were filed by the respondent, did not raise new issues other than the "Haviltex" principle under the law of the Netherlands regarding the interpretation of contracts. The board was convinced that the appellant had had the opportunity to properly consider its view on this issue and to present and corroborate its counter-arguments in document D36. In addition, the board itself had

sufficient time to consider the issue. The board thus decided to exercise its discretion to admit documents D31 and D32 into the proceedings. Document D36, the reply of the appellant, was as a consequence also admitted into the proceedings.

- 2.2 As neither the appellant nor the board had objections to admitting the respondent's late-filed documents D33 and D34, these documents were admitted into the proceedings as well.
3. Since the appellant had not explained why the late filing of documents D31 and D32 had led to additional work which could have been avoided in case of timely filing, the board was unable to establish reasons of equity for ordering apportionment of costs (Article 104(1) EPC).

Assignment of the priority right under Article 87 EPC

4. As mentioned in II above, the contested patent results from a divisional application divided from the parent application PCT/EP2007/002146. This parent application was filed on 12 March 2007 in the name of Avantium. It claims priority from the application published as D1, also filed in the name of Avantium.

In the present case, the claimed priority right is thus valid only if Avantium had the right to invoke the right to priority based on the priority application when the parent application was filed. This is common ground between the parties.

However, it is disputed whether the priority right had been transferred to Furanix by way of document D17 before the parent application was filed, and if so whether this transfer invalidates the priority of the

parent application and consequently of the opposed patent.

- 4.1 The respondent argues that the priority application had been transferred to Furanix only after the filing of the parent application, specifically on 24 October 2007, the date in which a request was sent to the European Patent Office to register the transfer of the priority application, see D18. Therefore, in accordance with Rule 22 EPC, the alleged assignment of the priority right was effective only on 24 October 2007. The board, however, does not agree. Rule 22 EPC and the cited decisions T 1751/07 and T 976/97 that deal with Rule 22 EPC (Rule 20 EPC 1973) have no relevance to the present case. This rule concerns procedural aspects of the registration of a transfer of a European patent application and the effect of a transfer vis-à-vis the European Patent Office only. It has no bearing on the establishment of the right to priority. The alleged assignment of the priority application from Avantium to Furanix has thus to be fully examined.
- 4.2 The appellant contests the validity of the claimed priority right, relying on the alleged assignment of the right by Avantium, the applicant of the priority application and the parent application, to Furanix on 1 March 2007. The burden of proof of the alleged assignment is therefore on the appellant.
- 4.3 According to established case law, the transfer of a priority right has to be assessed by applying national law (see for example T 0205/14 reasons, point 3.6.3 and T 1201/14 reasons, point 3.1.2). The national law that applies to the assignment of the priority right is in general determined by the conflict of law rules of the court seised, here the board. However, such rules are

absent in the EPC and the law derived from the EPC and thus no guidance is given in establishing the applicable national law.

Neither the appellant nor the respondent have put forward any views in this respect, but they agree that the law of the Netherlands is applicable. The board sees no reason to deviate from that position. The priority application is a European application. It is not regulated by any national law and thus does not require the application of any particular national law. All other conceivable relevant circumstances point to the application of the law of the Netherlands. Avantium and Furanix are both companies established under the law of the Netherlands with registered offices in Amsterdam, the Netherlands. In addition, document D17, the "*declaration of assignment*" was signed in Amsterdam. The alleged assignment will therefore be assessed by applying the law of the Netherlands.

- 4.4 In an earlier stage of the appeal proceedings, the respondent questioned whether under the law of the Netherlands a priority right was transferable, separately from the priority application. The board understands that this issue is no longer relevant as the respondent now accepts and even underlines that the priority right is a separate right that can be transferred separately or with the entitlement to the priority application (see point XV, *supra*).
- 4.5 Document D27 explains that under the rules of the Dutch Civil Code, assignment of the priority right requires a formal delivery, which is in this case a written instrument, signed by the assignor and the assignee, intended to serve as evidence. The delivery should have a valid legal basis, i.e. a legal relationship that

underlies and justifies the assignment or - expressed in a different way - a fact by which a party is obliged to the assignment. The assignment should furthermore be made by a person with the power to dispose of the right.

- 4.6 Document D17 is signed on behalf of both Avantium and Furanix by Mr T B van Aken, the Chief Executive Officer of both companies. It can be assumed, and it has not been disputed, that Mr T B van Aken had the power to dispose of the priority right.

Document D17 states that Avantium "*declares to have assigned all rights pertaining to European Patent application Nos. 06075564.2 and 06075565.9*" to Furanix, the latter application being the priority application in the present case. Document D17 further states that Furanix "*declares to accept all these rights*".

Document D17 is clearly drawn up to bring about an assignment of rights as well as to serve the purpose to provide proof of what has been agreed between the contracting parties, Avantium and Furanix, i.e. of the legal basis for the assignment. In the board's view, the aforementioned requirements of a formal delivery grounded on a valid legal basis have thus been met, and the document is sufficient to execute the assignment under the law of the Netherlands of the priority right, which is one of the rights pertaining to the patent application. The board sees no basis to assume that under the law of the Netherlands the wording "*all rights*" would not be sufficient for this purpose and that the assignment would require explicitly mentioning the right to priority.

The board does not accept the respondent's view that the wording "*declares to have assigned*" (allegedly

intended to merely evidence an assignment that occurred in the past) instead of "assigns" would disqualify the document as the instrument for the assignment of the priority right. It has clearly been the intention of Mr T B van Aken (acting for Avantium as well as Furanix) to sign a document to effectuate the assignment on a particular date, which is also clear from the statement that Furanix "*declares to accept all these rights*". Such a statement does not make sense if the assignment had already taken place. In any case, the wording of document D17 clearly points to the assignment of the priority right to Furanix on 1 March 2007 or an earlier date.

- 4.7 The board accepts that under the law of the Netherlands, in particular according to the "Haviltex" principle, the intentions of the parties, which possibly contradict the wording of a contract, are relevant or even decisive for the interpretation of an agreement. However, this principle does not need to be considered further as the respondent did not prove such contradictory intentions for the following reasons.

The alleged intention to retain the priority right is not expressed in document D17. It is highly unlikely that if the intention would have been to retain the priority right, this would not have been explicitly mentioned and that the wording "*all rights*" would have been used instead. Even more so because the respondent, as it explained, had obtained advice from its patent attorney regarding the assignment and the wording of the document, and would therefore have considered the objective meaning of the document.

In his statement (annex 2 to D27), Mr T B van Aken confirmed that "*In 2007 business considerations*

compelled me to assign European application EP 06075565.9 to Furanix and to retain the Priority Right for Avantium" and that "Avantium International did not assign the Priority Right from Avantium International to Furanix on 1 March 2007, nor was it the intention of either Avantium International or Furanix or the aim of the Declaration to assign it". However, these alleged intentions are not corroborated by any contemporary document. It is not credible that the alleged decision to assign the entitlement to the priority application but to retain the priority right had not been communicated internally or with the company's patent attorney in writing. For these reasons alone, Mr T B van Aken's statement is not convincing.

The fact that only two weeks after the assignment Avantium filed the parent application, invoking the right to priority, is not convincing proof of the alleged intention either. Possibly and more likely, it had been overlooked that the application would now have to be filed in the name of Furanix to invoke the priority right.

- 4.8 As document D17 is intended to provide proof of the assignment of rights, its persuasive weight is considerable. The counter-evidence put forward by the respondent is not convincing. It must therefore be held that the appellant has complied with the burden of proof of the alleged assignment of the priority right.
- 4.9 The priority claim of the opposed patent is thus invalid.

Article 4 Paris Convention - Referral to the Enlarged Board of Appeal

5. Article 112 EPC stipulates that "*In order to ensure uniform application of the law, or if a point of law of fundamental importance arises*" the board shall refer questions to the Enlarged Board of Appeal, in particular upon request from a party, "**if it considers that a decision is required** for the above purposes" (emphasis added by the board).
- 5.1 The board is convinced that no decision of the Enlarged Board is required in the present case. In the board's view, the formulation in accordance with Article 4 of the Paris Convention of Article 87 EPC, in particular the wording "*Any person who has duly filed...an application for a patent... **or his successor in title,** shall enjoy...a right of priority*" (emphasis added by the board) renders perfectly clear that the mentioned right of priority pertains **either** to the first applicant **or** to its successor in title. In other words, contrary to what was submitted by the respondent, the "or" in Article 87 EPC and Article 4 of the Paris Convention must unambiguously be read as an "exclusive or".
- 5.2 The board is not aware of any board of appeal decisions giving a different interpretation to the mentioned wording of Article 87 EPC. The use of the word "*successor*" alone implies that a right has been transferred, i.e. that it does not pertain to the first applicant anymore. This reading of Article 87 EPC is in line with, for instance, decision J 19/87, according to which the right to priority pertains either to the first applicant or, in case of a valid transfer, to its successor in title. The entrusted legal board decided

(reasons, 2) that the first applicant for an invention was entitled to apply for a subsequent application for the same invention since its successor in title (National Research and Development Corporation (NRDC)) had validly transferred the rights of the invention back to it. The first applicant was therefore in turn the successor in title of NRDC to the invention and a "*declaration of priority was therefore properly made on the Request for grant form, in accordance with Article 88(1) EPC*".

- 5.3 Documents D33 and D34, which were submitted in support of the respondent's view about an "inclusive or", do not discuss the alleged retainment of the right to claim priority in spite of an assignment of that right to a successor in title either.
- 5.4 On the basis of Article 87 EPC, the board is thus in a position to answer both questions posed by the respondent (XIII, *supra*) affirmatively. The respondent's request to refer those questions to the Enlarged Board of Appeal is therefore refused.
- 5.5 As a consequence, the board cannot accept the view that that priority can be claimed by the original applicant or its successor in title or by both the original applicant and the successor in title.

Request for correction under Rule 139 EPC

6. In its last submission dated 21 December 2018, the respondent argued for the first time that should the board conclude that all rights, including the right to priority, were assigned by means of D17 from Avantium to Furanix, then a correction under Rule 139 EPC of the name of the applicant of the parent application (II, *supra*) should be allowed. The name "Avantium

International B.V." should be changed to "Furanix Technologies B.V.".

It argued that the applicant's interest in gaining optimum protection and a third party's interest in maintaining legal certainty had to be balanced and that in the present case, the public would not be affected by the correction requested.

Moreover, the respondent argued that the criteria for an allowable correction as set out in G 1/12 had been met in the present case.

7. The board disagrees. In G 1/12 (OJ, 2014, A114), the Enlarged Board stated that *"The boards of appeal, in particular the Legal Board of Appeal, have developed a large body of case law on corrections under the first sentence of Rule 88 EPC 1973 (first sentence of Rule 139 EPC) and established the following principles:*
 - (a) *The correction must introduce **what was originally intended**. For example, an applicant wishing to add a **designation not originally intended** on filing cannot rely on the first sentence of Rule 88 EPC 1973 (J 8/80, OJ EPO 1980, 293, in particular Reasons No. 7). The possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans (J 8/80, loc. cit., Reasons No. 6; J 6/91, OJ EPO 1994, 349). It is the party's actual rather than ostensible intention which must be considered.*
 - (b) *Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one (J 8/80, loc.cit., Reasons No. 6).*

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

(d) *The request for correction must be filed **without delay*** (emphasis added by the present board).

From the onset of these appeal proceedings, the respondent has consistently argued that the true intention underlying assignment D17 was for Avantium to retain the priority right for the invention disclosed in the priority application. Therefore, the true intention was not to file the parent application (II, *supra*) in the name of Furanix. In any case, no proof of such an intention has been provided. The above mentioned criterion (a) is thus clearly not met.

Additionally, under criterion (d), a correction should have been requested without delay, i.e. as soon as it was realised that the parent application was filed in the wrong name. The parent application was filed in the name of Avantium on 12 March 2007, while the request for correction was filed on 21 December 2018 and conditional on a negative opinion of the board as regards the transfer of the priority right from Avantium to Furanix. The above criterion (d) is therefore also clearly not met.

For these reasons, the request of the respondent for a correction under Rule 139 EPC is refused.

Main request - claim 1 - novelty under Article 54 EPC

8. Since the priority claim of the contested patent is invalid, D1, the publication of the priority application, represents prior art to be considered for novelty under Article 54(3) EPC. This was common ground.

- 8.1 The respondent did not dispute that D1 discloses (claims 1, 5 and 9) a method for the manufacture of organic acid esters of 5-hydroxymethylfurfural by reacting a glucose-containing starting material with an organic acid or its anhydride in the presence of a catalytic or sub-stoichiometric amount of zeolites.
- 8.2 It follows that D1 anticipates at least the embodiment of claim 1 at issue (III, *supra*) directed to the reaction of a glucose-containing starting material for the manufacture of organic acid esters of 5-hydroxymethylfurfural. The subject-matter of claim 1 is thus not novel over D1.
- 8.3 The respondent's main request, first auxiliary request (request to refer questions to the Enlarged Board of Appeal) and second auxiliary request (request for correction) are therefore not allowable.

Third auxiliary request - admittance into the proceedings

9. Claim 1 of the third auxiliary request as filed by the respondent during oral proceedings reads as follows (amendments in comparison with claim 1 of the main request (III, *supra*) put in bold by the board):

"1. Method for the manufacture of organic acid esters of 5-hydroxymethylfurfural by reacting a fructose ~~and/or glucose-containing~~ starting material with an organic acid or its anhydride in the presence of a catalytic or sub-stoichiometric amount of heterogenous acid catalyst, selected from the group consisting of zeolites."

The embodiment of claim 1 of the main request directed to the reaction of a glucose-containing starting material that was found to be anticipated by D1 has

thus been deleted from claim 1 of the third auxiliary request. Furthermore, the "fructose-containing starting material" has been amended to "fructose starting material".

- 9.1 The board notes that according to Article 13(1) RPBA, any amendments to a party's case after it has filed its grounds of appeal or reply to the grounds of appeal may be admitted and considered at the board's discretion. This discretion is to 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.

Article 13(3) RPBA additionally requires that amendments sought to be made after oral proceedings have been arranged be not admitted if they raise issues that the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

- 9.2 In the present case, as correctly submitted by the appellant, the objection as regards the validity of the priority was raised from the onset of the appeal proceedings. The issue was also dealt with in the impugned decision (points 6.1 to 6.6). The respondent had therefore ample opportunity to file an auxiliary claim request well in advance of the oral proceedings in the attempt to overcome this objection. The filing of amended claims at the oral proceedings, i.e. at the latest possible stage, clearly puts the adverse party in the extremely disadvantageous position of having to deal with new issues at very short notice.

- 9.3 The board further concurs with the appellant that the contested patent (paragraphs [0004] and [0007]) presented the alternative of a fructose starting

material as "*undesirable*" compared to glucose. The restriction of the claimed subject-matter to a fructose starting material only was not predictable from the teaching of the contested patent or manifested by the respondent during the appeal proceedings until the oral proceedings.

9.4 The board further considers that, contrary to what was submitted by the respondent, the feature of claim 1 "fructose starting material" raises a clarity issue under Article 84 EPC since it is *prima facie* unclear whether this feature should limit the starting material to fructose only or to materials comprising fructose. The term "fructose starting material" was not present in the granted claims and is thus open to a clarity objection in opposition appeal proceedings.

9.5 Additionally, the compliance of claim 1 with Article 123(2) EPC is highly questionable. If, as argued by the respondent, the claimed subject-matter should find its basis in the example reported in the first table on page 8 of the application as filed, then several features pertaining to this example were not included into claim 1, e.g. the fructose concentration, the presence and concentration of acetic acid, and the specific catalyst. The claimed subject-matter is therefore an intermediate generalisation of the example.

9.6 The third auxiliary request of the respondent, rather than simplifying the proceedings, raises new issues under Articles 84 and 123(2) EPC at an extremely late stage of the proceedings.

In exercising its discretion under Article 13(1) RPBA and with due consideration of the provisions of

Article 13(3) RPBA, the board therefore decided not to admit the third auxiliary request into the proceedings.

Conclusions

10. None of the requests of the respondent is allowable and admissible.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is rejected.
2. The decision under appeal is set aside.
3. The patent is revoked.
4. The request for apportionment of costs is rejected.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated