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**Datasheet for the decision  
of 9 February 2017**

**Case Number:** T 1201/14 - 3.5.05

**Application Number:** 07014824.2

**Publication Number:** 1883190

**IPC:** H04L12/56, H04W36/06

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for setting field data of scheduling information in a wireless communications system

**Patent Proprietor:**

Innovative Sonic Limited

**Opponent:**

Telefonaktiebolaget L-M Ericsson (publ)

**Headword:**

Transfer of right of priority

**Relevant legal provisions:**

EPC 1973 Art. 54, 87(1), 112(1)(a)

EPC R. 106

RPBA Art. 13(1)

Paris Convention Art. 4A(1)

**Keyword:**

Proprietor's entitlement to claim priority - (no)  
Standard of proof - affidavits: "beyond reasonable doubt"  
Admission of late-filed line of argument - (no)  
Novelty - (no)  
Request for referral to the Enlarged Board - (refused)  
Objection under Rule 106 EPC - (dismissed)

**Decisions cited:**

G 0002/98, G 0001/12, G 0001/13, J 0019/87, T 0472/92,  
T 1008/96, T 1056/01, T 0062/05, T 0493/06, T 0382/07,  
T 1069/08, T 1621/09, T 2330/10, T 0786/11, T 1852/11,  
T 1458/12, T 2357/12, T 0160/13, T 0205/14, T 0517/14

**National decisions cited:**

- High Court of Justice of England and Wales (Chancery Division, Patents Court), decision of 12 June 2009 - *Edwards Lifesciences AG v. Cook Biotech Incorporated* [2009] EWHC 1304 (Pat)
- German Federal Patent Court, decision of 28 October 2010, 11 W (pat) 14/09
- German Federal Court of Justice, decision of 16 April 2013, X ZR 49/12, *Fahrzeugscheibe*

**Catchword:**

See point 3.2.2.2 of the Reasons.



**Beschwerdekammern**  
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Case Number: T 1201/14 - 3.5.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.05**  
**of 9 February 2017**

**Appellant:** Innovative Sonic Limited  
(Patent Proprietor) 2nd Floor, The AXIS, 26 Cybercity,  
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**Representative:** Grünecker Patent- und Rechtsanwälte  
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**Respondent:** Telefonaktiebolaget L-M Ericsson (publ)  
(Opponent) 164 83 Stockholm (SE)

**Representative:** Hoffmann Eitle  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 14 March 2014  
revoking European patent No. 1883190 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chair** A. Ritzka  
**Members:** K. Bengi-Akyuerek  
D. Prietzel-Funk  
P. Cretaine  
G. Weiss

## Summary of Facts and Submissions

I. The appeal was lodged against the opposition division's decision to revoke the present European patent as granted, which is based on the following European patent application:

**D2:** EP 07014824.2 (filed on 27 July 2007).

The opposition division found that the claims as granted fulfilled the requirements of Articles 123(2) EPC and 83 EPC 1973 but lacked novelty (Article 54 EPC 1973), having regard to the disclosure of

**A4:** "HLBS values in Scheduling Information message", Change Request, ASUSTeK, 3GPP TSG-RAN2 Meeting #54, draft Tdoc R2-062399, pp. 1-5, 28 August 2006 to 1 September 2006.

Document A4 was taken to be state of the art under Article 54(2) EPC 1973 because the opposition division held that the patent proprietor was not entitled to enjoy the right to claim the priority date derived from US provisional application

**P:** US 60/833,822 (filed on 28 July 2006),

on the grounds that it could not prove that it was "successor in title" to the right to claim priority from application P within the meaning of Article 87(1) EPC 1973.

II. During the opposition proceedings the patent proprietor argued that priority application P, filed by the inventor *Sam Shiaw-Shiang JIANG*, had been transferred, by a first transfer, to the Taiwanese company *ASUSTeK*

*Computer Inc.* (henceforth "ASUSTeK") and then, by a second transfer, to the patent proprietor. The opposition division held that the first transfer was sufficiently proven. However, it did not accept the validity of the second transfer, which the patent proprietor had attempted to substantiate by means of three separate legal lines of argument, each based on a different type of transfer, namely (1) a transfer by way of a "nunc pro tunc assignment" under US law, (2) an "implicit transfer" under German law and (3) a "direct transfer" under US law.

The first line of argument was rejected by the opposition division on the grounds that a retroactive assignment of the right of priority was contrary to the provisions of Article 87(1) EPC 1973 and that thus its allowance would override fundamental principles of the EPC, i.e. the *lex fori* in this case (cf. appealed decision, Reasons 5.14). The second line of argument was not accepted either on the grounds that German law, which the patent proprietor believed to be applicable based on the principles of *favor negotii* and the *lex loci protectionis*, was in fact not applicable to the present case (cf. appealed decision, Reasons 5.16 and 5.17). Lastly, the proprietor's third line of argument did not succeed on the grounds that the direct transfer of another US non-provisional application (henceforth "D1") from ASUSTeK to the patent proprietor did not necessarily include the transfer of application P and the associated right of priority (cf. appealed decision, Reasons 5.18 and 5.19).

III. In particular, the following evidence relating to the alleged second transfer of the right of priority was filed during the opposition and appeal proceedings:

- D1:** US 11/878,892 (filed on 27 July 2007) claiming priority from P;
- E1 to E4:** exhibits relating to the first transfer;
- E5:** copy of a *nunc pro tunc* assignment relating to the second transfer, recorded by the USPTO on 4 February 2013;
- E6:** legal opinion from legal expert A. Justin Poplin relating to the *nunc pro tunc* assignment;
- E7,E8:** exhibits relating to the assignment of D1, recorded by the USPTO on 27 July 2007;
- E10:** affidavit from *Tsung-Tang Shih*, chairman of ASUSTeK, regarding a general policy, signed on 31 August 2012;
- E11:** affidavit from *Su-Huei Liu*, chairman of the appellant, regarding the general policy, signed on 14 August 2012;
- E12:** affidavit from *Vincent Hong*, general counsel of ASUSTeK, regarding the general policy, signed on 8 September 2012;
- E13:** affidavit from *Frank Lin*, patent engineer of ASUSTeK, regarding the general policy, signed on 13 August 2012;
- E14,E14a:** email from ASUSTeK's Taiwanese representative regarding a report on the filing of P, sent on 18 October 2006;
- E14b,E14c:** communications from ASUSTeK's US representative regarding a report on the filing of P, dated 28 July and 23 August 2006;
- E15,E15a:** email from ASUSTeK's and the appellant's Taiwanese representative regarding a report on the filing of D2, sent on 20 August 2007;
- E15b:** communication from the appellant's German representative regarding a report on the

- filing of D2, dated 9 August 2007;
- E16:** copy of the decision of the German Federal Court of Justice, X ZR 49/12 dated 16 April 2013 - Fahrzeugscheibe;
- TW1, TW2:** legal opinion and CV of Professor *Tsung-Fu Chen* regarding the requirements for an assignment of the right of priority under Taiwanese law;
- TW3:** excerpts from the Taiwanese Patent Act in the version of 22 January 2014;
- A7, A8:** affidavits from *Vincent Hong* and *Su-Huei Liu* regarding a "trust relationship", signed in January 2013;
- A13:** EP-A-2 134 000 (filed by ASUSTeK on 4 June 2009);
- A15:** EP-A-2 151 966 (filed by ASUSTeK on 6 May 2009);
- A16:** patent proprietor's letter dated 21 January 2013 filed in the opposition proceedings regarding its European patent EP-B-2 077 691 (underlying pending appeal case T 1763/13).

The patent proprietor filed exhibits E1 to E8 for the first time with its letter dated 30 September 2013 in response to the summons to oral proceedings before the opposition division and exhibits E10 to E16 with its letter dated 22 October 2013 shortly before the date scheduled for those oral proceedings, which the opposition division decided to postpone as a result. The opposition division admitted evidence E1 to E8 and E10 to E16 into the proceedings due to their *prima facie* relevance to the question of succession in title under Article 87(1) EPC 1973. Furthermore, it refused the proprietor's request for the exclusion from file inspection of two certificates (which were marked as confidential), filed as evidence of a change of its

address.

IV. With its statement setting out the grounds of appeal, the appellant re-submitted those certificates (i.e. E18 and E19) as evidence of change of address together with an excerpt (i.e. E20) from the *travaux préparatoires* to Article 88 EPC. It requested that the decision under appeal be set aside and that the patent be maintained as granted. In particular, it advanced additional arguments in support of the validity of the succession in title with regard to the patent's priority claim relating to two lines of argument invoked so far, namely the *nunc pro tunc assignment* under US law and the implicit transfer under German law. However, concerning the direct transfer under US law, it merely indicated that it maintained the arguments that it had presented during the opposition proceedings.

V. In addition, by letter dated 24 July 2014, the appellant requested that its previously registered address, i.e. "Offshore incorporations centre P.O. Box 957, Road Town Tortola/VG" be changed to

"2nd Floor, The AXIS, 26 Cybercity,  
Ebene 72201  
Mauritius".

However, it did not dispute the opposition division's decision to refuse the request to exclude the corresponding certificates from file inspection.

VI. In its letter of reply dated 8 December 2014, the respondent requested that the appeal be dismissed. Further, it requested that the opposition division's decision to admit exhibits E1 to E8 and E10 to E16 into the proceedings be overruled on the grounds that the



opposition division had not exercised its discretionary power in accordance with the right principles. In particular, it provided arguments, supported by references to evidence including exhibits A7, A8, A13 and A15 and to the relevant jurisprudence of the Boards of Appeal, to demonstrate that the appellant was not the valid successor in title with respect to the priority claim.

- VII. By letter dated 29 July 2015, the appellant elaborated on its previous arguments as to the first and second lines of argument, and also introduced a fourth line of argument based on a new type of transfer, namely (4) an "implicit transfer" under *Taiwanese* law.
- VIII. In a communication annexed to the summons to oral proceedings pursuant to Article 15(1) RPBA, the board gave its preliminary opinion on the appeal. In particular, it considered that - **irrespective of the issue of the applicable national law** - the appellant had not sufficiently and cogently established the validity of the transfer of the right of priority from ASUSTeK to the appellant (cf. board's communication, point 6.3; emphasis added).
- IX. By its letter of reply to the summons, the appellant submitted counter-arguments to the observations made in that communication.
- X. The respondent, in its letter of reply to the summons, reiterated its request that the decision of the opposition division to admit exhibits E1 to E8 and E10 to E16 be overturned. It further requested that the appellant's newly submitted fourth line of argument, including exhibits TW1 to TW3, should not be admitted

into the appeal proceedings under Article 13(1) RPBA.

XI. Oral proceedings were held on 9 February 2017, during which the admissibility of exhibits E1 to E8 and E10 to E16, the validity of the priority claim and the novelty of the claims as granted were discussed. As to the third line of argument regarding the "direct transfer" of the right of priority, the appellant merely referred to its written submissions. As regards the first line of argument concerning the *nunc pro tunc* assignment, it submitted - besides further arguments - the following questions for referral under Article 112(1)(a) EPC 1973, in order "to ensure uniform application of law for a point of law of fundamental importance":

- "1. *Does the code of rules of the EPC on priority prohibit a retroactive transfer of a right of priority as such, even if applicable national law allows such retroactive transfer?*
2. *If the answer is yes, are there specific circumstances where a retroactive transfer can nonetheless lead or contribute to a valid succession in title, including*
  - a. *where a retroactive transfer of the right of priority that is concluded after, but taking effect before the filing date of the subsequent European patent application, confirms an implicit, tacit or oral agreement that a transfer of the right of priority should be effected, wherein this agreement is concluded between the parties before the date of filing of the European patent application, yet is regarded to fall short of constituting a valid transfer agreement under applicable*

- law, e.g. because it is regarded not to meet certain formal requirements, and/or*
- b. *where, in addition to the retroactive transfer, a variety of facts establish that at the date of filing of the subsequent European patent application the applicant of the first application and the non-identical applicant of the subsequent European patent application were apparently in agreement that the latter should enjoy the right of priority of the first application for the subsequent European patent application, even where such facts would not amount to constitute an agreement in the legal sense?*
3. *Same as question 2, circumstances as set forth under a.), where the retroactive transfer is replaced by an agreement which is concluded later between the parties that confirms the earlier agreement and wherein said later agreement meets said certain formal requirements.*
4. *Are there other relevant facts and circumstances that influence the answers to the above questions, in particular, regarding the nature of the relationship between the parties to the transfer or the behavior of the parties after the filing of the European patent application?*
5. *Is the relevant point in time at which a succession in title for the right of priority has to have taken place, so that the subsequent European patent application can validly enjoy the claimed right of priority of the first application, the date of the filing of the European patent application, the date of the*

*priority declaration or other?"*

Before the closure of the oral proceedings, the appellant further raised the following objection under Rule 106 EPC:

*"We object to a fundamental violation of Art. 113 based on that the Board did not identify the applicable national law for determining validity of the transfer of the right of priority, thereby violating appellant's right to be heard."*

- The appellant's final requests were that
  - 1) the decision under appeal be set aside and that the patent be maintained on the basis of "the request subject to the decision under appeal";
  - 2) the questions posed be referred to the Enlarged Board of Appeal;
  - 3) its address be changed according to its letter dated 24 July 2014.
  
- The respondent's final request was that the appeal be dismissed.

At the end of the oral proceedings, the board's decision was announced.

XII. Claim 1 of the **patent as granted** ("request subject to the decision under appeal") reads as follows:

"A method for setting field data of a scheduling information in a wireless communications system according to the Medium Access Control protocol specification of the 3<sup>rd</sup> Generation Partnership

Project, the scheduling information comprising at least a Highest priority Logical channel Buffer Status field, called HLBS field hereinafter, for storing a Higher priority Logical channel Buffer Status index, called HLBS index hereinafter, the method comprising:

setting a value of the HLBS index to 15 when a Higher priority Logical channel Buffer Status value, called HLBS value hereinafter, is greater than 82 (302) and smaller or equal 100; and storing the value of the HLBS index into the HLBS field (304), characterized in that the value of the HLBS index is set to 15 when the HLBS value is greater than 100."

XIII. The appellant's arguments on the alleged second transfer of the right of priority, in so far as relevant to this decision, can be summarised as follows:

Generally, the formal requirements for a valid transfer of the right of priority were to be derived from the applicable national law. The successor in title according to Article 87(1) EPC 1973 had to be capable of benefiting from the EPC within the meaning of Articles 2 and 3 EPC 1973 and thus should not be confronted with undue hurdles where the former owner of the priority application and his successor in title were in agreement on the succession, as evidenced by the following four lines of argument (i.e. types of transfers).

(1) *Nunc pro tunc assignment under US law*

Assuming that the law of the country where the first

application P was filed, namely US law, was considered to be the law to be applied to the second transfer, the *nunc pro tunc assignment* of the right of priority (dated 14 December 2012), as evidenced by **E5** and **E6**, was allowable under the EPC. Articles 87 to 89 EPC by no means excluded a retroactive transfer of the right of priority from having an *effective* date (i.e. 24 July 2007 here) lying before the filing date of the later European patent application D2 (i.e. 27 July 2007), so that the required succession in title had effectively taken place at said effective date and thus before the filing date of application D2. It was not disputed that Article 87(1) EPC 1973 required a succession *before* the filing of the later European application. However, whether the succession in title under Article 87(1) EPC 1973 could have a retroactive effect was not a question of provisions contained in the EPC but a question of the applicable national law.

In this regard, the appellant stressed that US law acknowledged a *nunc pro tunc agreement* as valid. If the exclusion of such succession in title from being effective before the filing date of the later European application had been intended, then Article 87 or 88 EPC would have included clear requirements in this regard and would not have left the public in doubt as to such an important restriction that would overrule the relevant national law. The application of national law did not leave room for a mixture where the relevant national provisions were applicable for *some* aspects of scrutinising the formal validity of the succession in title but not for *others*. The case law of the Boards of Appeal did not support a construction of a mixture of formal requirements for determining the validity of a succession in title, where some ingredients were taken from an applicable national law and some from allegedly

inherent principles which at best were suggested by statements in commentaries, as had been set out in the decision under appeal. As to the concept of "legal certainty", to which the impugned decision referred, primarily the parties to the assignment of a right of priority were interested in having legal certainty in case of dispute. For those parties considerations on legal certainty meant that, absent statutory regulations providing for a specific form or contents, they were free to agree on the transfer as they deemed fit. In the present case, neither the parties involved nor any third party had ever argued that there were conflicting successions in title, so that legal certainty was clearly respected.

(2) *Implicit transfer by virtue of a general policy under German law*

Assuming that, based on the principle of *favor negotii* or the *lex loci protectionis*, the law of one of the designated EPC Contracting States (such as Germany) was considered to be the law to be applied here, an implicit transfer according to a general policy set up between ASUSTeK and the appellant at the end of 2006 for filing patent applications worldwide was evidenced by exhibits **E10 to E15**.

(2a) *Formal requirements under German law*

German law had no particular statutory formal requirements for a transfer of the right to claim priority to be made in writing, and this allowed for an oral, tacit or implicit transfer. This was most prominently demonstrated by the decision of the German Federal Court of Justice (Bundesgerichtshof) - *Fahrzeugscheibe* in **E16** concerning the evidence of such

an implicit transfer between closely connected entities.

(2b) *Implicit transfer*

Regarding the second transfer, ASUSTeK and the appellant had acted on the basis of a so-called general policy according to which, beginning from the end of the year 2006, ASUSTeK's intellectual property rights in the field of telecommunications standards - with the exception of six specifically mentioned cases - had to be assigned to the appellant, the latter being the newly founded "trust holder" for ASUSTeK. The transfer to the appellant of the right to claim the priority of application P from ASUSTeK was performed by implication under this general policy. Hence, the appellant was in charge of the filing of European patent applications claiming priority from US patent applications previously filed by ASUSTeK.

The correspondence submitted as exhibits E14 and E15 showed that the same representative (from the Taiwanese law firm NAIPO) was acting for both ASUSTeK and the appellant, as one consequence of the very close connection between those two companies. It also demonstrated that the corresponding instructions derivable from that policy were indeed put into practice. Since the parties acted in accordance with this general policy it could be concluded that it was the common will of the parties to transfer the particular rights of priority to the appellant without explicitly transferring it in written form in each and every case - including the case of application P, which was likewise covered by the general policy.

Furthermore, the fundamental importance of priority for



the validity of any resulting patent in the technical field of telecommunications standards had to be taken into account. Applicants in this area were well aware that oftentimes, shortly after the filing of the first application, relevant information regarding the invention was published, not rarely by themselves, for instance in the form of a "change request". Hence, where several parties agreed on a collaborative file prosecution strategy, the party filing the first application or having been assigned the right of priority of the first application was, in general, obliged to transfer this right to the connected company in charge of filing the subsequent application. Given that the appellant in the case at hand filed the "request for grant" form for European patent application D2, which also included the declaration of the priority claim arising from application P, it was clear that the right of priority had been transferred from ASUSTeK to the appellant for the purpose of filing application D2 with a valid priority claim from application P, thereby following the logic and the purpose of the general policy. This finding of an implicit transfer was also corroborated by the subsequent behaviour of both parties, which repeatedly prepared and submitted respective documents within various co-pending opposition proceedings before the EPO in support of a valid transfer of the right of priority, the *nunc pro tunc assignment* being only one example. Thus, there was also no likelihood or even a possibility of any abuse.

Accordingly, the general policy referred to in E10 to E13 together with the correspondence according to E14 and E15 established, in full agreement with the nature of the relationship between the two companies, that an implicit transfer of the right of priority arising from

application P for the filing of application D2 indeed took place between ASUSTeK and the appellant before the filing of D2. This implicit transfer should be accepted as valid for the purposes of Article 87(1) EPC 1973, since the formal requirements for a valid transfer of a right of priority, such as the need to perform the transfer in writing, were to be derived from the applicable national law, here German law.

(3) *"Direct transfer" under US law*

Assuming again that US law was considered to be the law to be applied to the second transfer, the appellant became the successor in title by virtue of the direct assignment of 24 July 2007 of US non-provisional application D1 (regarding the same invention) from the first applicant and inventor *S.S. Jiang* to the appellant, likewise claiming the priority of application P and thus incorporating it by reference, as evidenced by **E7** and **E8**. The transfer of D1 therefore also constituted sufficient proof of the transfer of application P and its associated right of priority to the appellant.

(4) *Implicit transfer by virtue of a general policy under Taiwanese law*

Assuming that the law (i.e. Taiwanese law) of the country where one of the parties (i.e. ASUSTeK located in Taiwan) to the assignment had its residence was considered to be the law to be applied to the second transfer, an implicit transfer in accordance with the general policy set up between ASUSTeK and the appellant was again evidenced by exhibits **E10 to E15**.

(4a) *Reasons for late filing*

Only detailed and ongoing analysis of the decision under appeal and other related decisions in the opposition proceedings between the present parties, together with the respondent's submissions, revealed that Taiwanese law was also a national law applicable to the determination of whether the requirements for a valid transfer of the right of priority prior to the filing of application D2 had been met. To this end, the appellant had acquired supporting evidence **TW1 to TW3** and had immediately submitted it with its letter dated 29 July 2015.

(4b) *Formal requirements under Taiwanese law*

Taiwanese law foresaw a transfer of the right of priority without requiring a specific form, in particular a written form, for such a transfer. In this respect, Taiwanese law complied with most legal systems across the world, including in particular those of the jurisdictions of most European countries, which were based on the principle of "freedom of contract", according to which a concluded contract was the meeting of minds of both parties. Pursuant to legal opinion TW1, the Taiwanese Civil Code adhered to the principle of *freedom of contract* so that a contract could be concluded by both parties through an express, tacit, implied or oral agreement, without any necessity for a written form. Hence, in this regard, the Taiwanese civil code seemed to correspond to German civil law.

In particular, the Taiwan Patent Act did not include regulations, such as for a written form, governing the assignment of a right of priority derived from a Taiwanese patent application since, according to TW1,

the right of priority and the right to apply for a patent, i.e. the right to file a later patent application, were in fact *inseparable* rights. Accordingly, under Taiwanese law, the right of priority could be transferred by assigning a right to file a later patent application with priority, which meant that the right to claim priority from the earlier application rested with the assignee of said right to apply for the later patent.

(4c) *Implicit transfer*

As to establishing how this legally possible implicit transfer before the filing of European patent application D2 took place, the appellant referred to its arguments made concerning the requirements of German law (see item (2b) above). In addition, there could be no question that the right to apply for the patent and thus, under Taiwanese law the right of priority, had been transferred from one party to the other for the purpose of filing application D2 with a valid priority claim.

XIV. The respondent's arguments as regards the second transfer of the right of priority can be briefly summarised as follows:

(1) *Nunc pro tunc assignment under US law*

Retroactive assignments of the right of priority could be accepted neither under Article 87(1) EPC 1973 nor under the basic principles of the Paris Convention.

(2) *Implicit transfer by virtue of a general policy under German law*

German law was not applicable in the present case under Articles 1 and 66 EPC 1973. The alleged general policy was based on a trust relationship established under Californian state law, according to **A7** and **A8**, and had not been validly established. The general policy itself was conditional, non-binding, vague and had not been complied with, as evidenced e.g. by European patent applications **A13** and **A15**, which were related to the field of telecommunications standards and were filed by ASUSTeK, and not the appellant.

(3) *Direct transfer under US law*

The assignment of D1 from the inventor to the appellant related only to the transfer of an *internal* right of priority, i.e. to a transfer of a right of priority derived from US provisional application P to the new applicant of a later US non-provisional application D1, without any consequences for an alleged transfer of the right of priority of application P to the applicant of the later *European* application D2.

(4) *Implicit transfer by virtue of a general policy under Taiwanese law*

The submissions relating to this fourth line of argument based on TW1 to TW3 should have been made earlier and should therefore not be admitted into the appeal proceedings under Article 13(1) RPBA. In any event, Taiwanese law was not applicable to the present case since affidavits A7 and A8 clearly demonstrated that the legal relationship between ASUSTeK and the appellant was governed by the laws of the State of California. Therefore, this fourth line of argument had no merit.

## Reasons for the Decision

1. *Request for a change of appellant's address*

The board accedes to the requested change of address, having due regard to the fact that this change does not denote a change in the appellant's legal identity (see cases T 786/11, Reasons 2, and T 1458/12, Reasons 1, decided by the same board, as well as T 2330/10, Reasons 1).

2. *Admissibility of exhibits **E1 to E8** and **E10 to E16***

The board sees no reason to overturn the opposition division's decision to admit exhibits E1 to E8 and E10 to E16 into the proceedings (cf. point III above), at least, due to their *prima facie* relevance to the validity of the opposed patent's priority claim (cf. appealed decision, Reasons 4.1).

The EPC does not provide a legal basis for excluding, in appeal proceedings, documents which were correctly admitted into the first-instance proceedings, in particular when the impugned decision is based on them (see e.g. T 1852/11, Reasons 1.3).

3. *Validity of priority claim (Article 87(1) EPC 1973) - appellant's entitlement as successor in title to claim priority*

The outcome of this appeal depends in the first place on the question whether A4, considered by the opposition division to be novelty-destroying, belongs to the prior art within the meaning of Article 54(2) EPC 1973. Application P, from which priority was

claimed, was filed on 28 July 2006 and thus before the publication date of A4 (i.e. August 2006). The opposition division correctly assumed that application P was filed by the inventor *S.S. Jiang* and that the non-identical appellant was only in a position to enjoy the right of priority from application P if it was the successor in title of ASUSTeK in respect of P at the filing date of European patent application D2. The board concurs with the opposition division and the appellant that the first transfer of the right of priority from inventor *S.S. Jiang* to ASUSTeK was validly performed (see appealed decision, Reasons 5.10 to 5.13). This conclusion is undisputed between the parties.

Hence, in the present case, the formal validity of the opposed patent's priority claim hinges on the question whether the second transfer of the right of priority derived from application P from the then applicant ASUSTeK to the appellant was validly performed. That is, whether the appellant validly enjoys the right of priority arising from application P under Article 87(1) EPC 1973.

### 3.1 *General considerations*

The EPC contains provisions (i.e. Articles 87 to 89 in conjunction with Rules 52 to 54) which form a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application (see e.g. G 2/98, OJ EPO 2001, 413, Reasons 3). In particular, Article 87(1) EPC 1973 relating to the right of priority reads as follows (emphasis added by the board):

"Any **person** who has duly filed, in or for

(a) any State party to the Paris Convention for the Protection of Industrial Property or

(b) any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his **successor 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 right of priority is defined in almost identical terms in Article 4A(1) of the Paris Convention.

3.1.1 *Substantive requirements derived from the EPC for a transfer of the right of priority*

3.1.1.1 From the wording of Article 87(1) EPC 1973 alone ("... for the purpose of filing a European patent application ..."; in the German version: "... für die Anmeldung ..."; in the French version: "... pour effectuer le dépôt d'une demande de brevet européen ...") it is clear to the board that, for a transfer of the right of priority from "any person" to a "successor in title" within the meaning of this provision to be considered valid, the transfer has to have been concluded *before* the filing date of the later European application claiming that priority. This is because the term "successor in title" in that provision refers to the person who has already filed ("has duly filed") the first application but not yet the later European patent application ("for the purpose of filing"). The board holds that this in turn directly implies that the succession in title must have already taken place when the later European patent application



is filed.

3.1.1.2 It can further be deduced from the wording of Article 87(1) EPC 1973 ("*Any person who has duly filed ... **an application** for a patent ... shall enjoy ... a right of priority ...*"), taken in conjunction with Article 87(3) EPC 1973 ("*... whatever the outcome of **the application** may be*"; in the German version: "*... wobei das spätere Schicksal der Anmeldung ohne Bedeutung ist ...*"; in the French version: "*... quel que soit le sort ultérieur de cette demande ...*"), that the "right of priority" derived from a given first application is in itself a substantive property right, which is to be distinguished from the property right to the first application. As such the right of claiming priority from a first application may be transferred *independently* of the right to the first application up until the filing of the later European application claiming priority from it (at which time it becomes an accessory right to the underlying first application). This interpretation is also in line with the jurisprudence of the Boards of Appeal (see e.g. T 62/05, Reasons 3.6; T 205/14, Reasons 3.3, third paragraph; T 517/14, Reasons 2.4, third paragraph).

Such independent transferability (i.e. legal separability) of the right of priority under the EPC is also corroborated by various commentaries, some of which are quoted below:

- K. Grabinski in Benkard, EPÜ, 2nd edition, 2012, section Art. 87, point 3: "*... Es[das Prioritätsrecht] ist als selbständiges vermögenswertes Recht auch ohne Änderung der Inhaberschaft der ersten Anmeldung übertragbar ...*";

- D. Visser in *The Annotated European Patent Convention*, 24th revised edition, 2016, section Art. 87, point 4, second paragraph: *"The applicant may transfer the right of priority to a successor in title, independently of the right to the grant of the patent ..."*;
- T. Bremi in *Singer/Stauder, Europäisches Patentübereinkommen*, 7th edition, 2016, Article 87 EPC, section 2.7, point 59: *"Das Prioritätsrecht ist unabhängig von der prioritätsbegründenden Anmeldung bis zum Zeitpunkt der Nachanmeldung frei übertragbar und ist auch für nur einzelne Nachanmeldestaaten übertragbar ..."*.

3.1.1.3 Hence, the substantive requirements derivable from the EPC for a valid transfer of the right of priority may be summarised as follows:

The successor in title with respect to the right to claim priority from a first application according to Article 87(1) EPC 1973 must prove that it indeed owned,

- (i) before the filing of the later European application,
- (ii) the right of priority relating to the first application for the purpose of filing the later European application claiming that priority.

3.1.2 *Formal requirements for a transfer of the right of priority*

In general, an agreement on the transfer of the right of priority is concluded by means of a contract between the transferor (the original owner of the right of priority) and the transferee (the owner's successor in

title). This requires two corresponding declarations of the contracting parties, whether express or implied, regarding the subject-matter of the transfer. The appellant is right in stating that the EPC lays down no formal requirements for the conclusion of such a transfer. Nor is this issue regulated in the Paris Convention. The board agrees with the appellant and the opposition division that a valid transfer of the right of priority does not require a separate formal assignment ("in writing" and containing a "signature of the parties") as is required for the transfer of European patent applications under Article 72 EPC 1973. Thus, an implicit transfer of a particular right may be accepted when it is sufficiently clear *that* the parties formed an agreement and *what* they agreed.

This finding does not contradict Article 125 EPC 1973, as invoked by the respondent and as concluded in the decision under appeal (cf. Reasons 5.5). According to this provision, the EPO must, in the absence of procedural provisions in the EPC, take into account the principles of procedural law generally recognised in its Contracting States. However, the board agrees with the appellant that requirements for the validity of a transfer of the right of priority, and in particular the question of which is the law that governs such requirements, are a matter of *substantive* rather than *procedural* law.

In any event, as the EPC contains neither guidance as to the *formal* requirements for a valid transfer of the ownership of the right of priority nor conflict-of-laws provisions for that purpose, national law is commonly relied upon by the departments of the EPO entrusted with the procedure (see e.g. J 19/87, Reasons 2, applying English law; T 160/13, Reasons 1.1, applying

German law; T 205/14, Reasons 3.6.2, applying Israeli law; T 1008/96, Reasons 3.3, referring to - but not applying - Italian law; Guidelines for Examination in the EPO, A-III, 6.1, fourth paragraph). In principle, the following national laws come into question in this context (see e.g. T. Breimi in Singer/Stauder, *Europäisches Patentübereinkommen*, 7th edition, 2016, Article 87 EPC, section 2.7, point 61):

- (a) the law of the country where the first application was filed ("*lex originis*");
- (b) the law of the country where the later application was filed ("*lex loci protectionis*");
- (c) the law of the country which is agreed upon in the relevant contract ("*lex loci contractus*");
- (d) the law of the country where at least one of the parties to the transfer has its residence ("*lex domicilii*").

The board is aware that so far there is no established jurisprudence of the Boards of Appeal as regards the national law generally applicable to the question of the transfer of the right of priority. In T 62/05 (Reasons 3.9), it was the *lex loci protectionis* that was chosen, namely by the analogous application of Article 72 EPC 1973, which governs the transfer of a European patent application, to the transfer of the right of priority (see also T 382/07, Reasons 8.3, which applied the *lex loci protectionis*). On the other hand, T 160/13 (Reasons 1.1) and T 1008/96 (Reasons 3.3) appear to have relied on the *lex originis* (i.e. German and Italian law respectively), and T 205/14 (Reasons 3.6.4) on the law applicable to the legal relationship between the parties to the transfer (i.e. the *lex domicilii* rather than the *lex originis*), which was Israeli law. The formal requirements of

different national laws for the transfer of intellectual property rights range from none at all (as e.g. under German law; see German Civil Code BGB, §398 and §413) to strict formal rules (as e.g. under US law; see 35 U.S.C. §261).

3.1.3 In conclusion, where the applicants of the first application and the later European application are not identical, it has to be proven that the *right of priority* derived from the first application and claimed for the later European application was indeed transferred, *before* the filing date of the later European application, by the applicant of the first application to its successor in title, in accordance with specific *formal requirements*.

3.2 *Assessment of the appellant's lines of argument regarding the alleged second transfer*

In the following, the board will assess the four lines of argument relied upon by the appellant. For each it will proceed on the assumption that the applicable law (i.e. US, German and Taiwanese law) is that stated by the appellant. In that regard, the board considers it appropriate to take this approach because its decision on the validity of the transfer of the right of priority arising from application P to the appellant did not depend on a determination of the national law applicable to the formal requirements for a transfer of the right of priority. In any event, the appellant's case failed for lack of sufficient evidence. The evidence adduced could not prove that the appellant was the owner of the right of priority arising from application P, irrespective of the formal requirements of any relevant national law (see points 3.2.1 to 3.2.4

below).

3.2.1 *Nunc pro tunc assignment under US law (based on **E5** and **E6**)*

As to this first line of argument, the appellant relies on the *lex originis*, i.e. US law. Even assuming that the *lex originis* is the applicable national law as regards the formal requirements for a transfer of the right of priority, the board holds that the appellant has not sufficiently proven that it was the valid successor in title for the purposes of Article 87(1) EPC 1973.

3.2.1.1 The appellant submitted exhibit E5 as evidence that the transfer of the right of priority derived from US provisional application P had been concluded after the filing on 27 July 2007 of European patent application D2 but that the parties had defined the effective date of the transfer as 24 July 2007 by way of a so-called *nunc pro tunc assignment* (i.e. a contract concerning the transfer of a right, which contract is concluded later in time than the contractually stipulated effective date of the transfer). The contract filed as E5 contains the following passage (emphasis added in that exhibit):

*"... **ASUSTeK Computer Inc.** ... hereby assigns to **Innovative Sonic Limited** ... the entire right, title and interest throughout the world in and to the invention and improvements which are the subject of **United States Patent Application Serial No. 60/833,822** ..., **nunc pro tunc, effective as of July 24, 2007** (the "Effective Date"), including ... the right to claim priority based on the filing date of the Application ...".*

In the board's judgment, however, it follows immediately from substantive requirement (i) above, which itself is based on the wording of Article 87(1) EPC 1973 (see point 3.1.1.1 above), that even if a retroactive transfer such as the *nunc pro tunc assignment* under US law invoked by the appellant was allowable under US law, it would not be acceptable under Article 87(1) EPC 1973. Any natural or legal person can only then be considered a "successor in title" for the right of priority within the meaning of Article 87(1) EPC 1973 if it obtained that right from its previous owner by a transfer agreement concluded before the filing of the later European patent application.

3.2.1.2 This literal interpretation of Article 87(1) EPC 1973 is perfectly in line with the established jurisprudence of the Boards of Appeal (see e.g. T 62/05, Reasons 3.5; T 493/06, Reasons 11; T 382/07, Reasons 9.1; T 205/14, Reasons 3.5). It also fully accords with several decisions of national courts (see e.g. German Federal Court of Justice (BGH), X ZR 49/12, GRUR 2016, 1038 - *Fahrzeugscheibe*, point 11; High Court of Justice of England and Wales (Chancery Division, Patents Court) - *Edwards Lifesciences AG v. Cook Biotech Incorporated* [2009] EWHC 1304 (Pat), point 95). The appellant is right in saying that in T 205/14 (see Reasons 3.4) the deciding board indicated that it was aware of diverging opinions in that respect (referring to a commentary by R. Moufang in Schulte, *Patentgesetz mit EPÜ*, 9th edition, 2014, §41, No. 28, and to a decision of the German Federal Patent Court, 11 W (pat) 14/09, according to which a priority could be validly claimed until the time at which the applicant files the declaration of priority). Nonetheless, the board in that case obviously considered the question whether the

transfer of the right of priority occurred before the filing of the later European application to be one of the basic requirements to be assessed in connection with the validity of the priority claim (see T 205/14, item a in Reasons 3.5 and 3.7). In the present case, however, the appellant filed its declaration of priority under Rule 52 EPC together with European patent application D2 (see EPO Form 1001, box 25, signed on 27 July 2007), so that the latter observations are of no relevance to this appeal.

- 3.2.1.3 A teleological interpretation leads to the same result. Given that the right of priority confers on its owner a benefit of an exceptional kind, it is of the utmost importance for third parties to have certainty as early as possible so as to be able to determine the patent application's effective filing date and the relevant prior art, with its crucial effect on patentability. To allow a retroactive assignment of the right of priority under Article 87 EPC 1973 would put individual parties in a position to change, at will and for the past, the effective date at which a substantive right arises. This, however, would not be in the public's interest.
- 3.2.1.4 Nor can the board share the appellant's view that - in the absence of any express exclusion in Article 87(1) EPC 1973 - such a retroactive transfer should be permissible. In fact, the contrary applies. Since Article 87 EPC 1973 presupposes that the applicant is the owner of the right of priority at the date of filing, as discussed above, such an exception would normally also have to be expressly codified in the relevant provisions of the EPC. Even if US law somehow allows for a retroactive transfer, the board emphasises that this does not necessarily mean that the same is true for Article 87(1) EPC 1973. As set out in decision



G 1/13 (OJ EPO 2015, 549, Reasons 8), a provision of national law which is contrary to the EPC cannot be acknowledged by the EPO (see also T 2357/12, Catchword 1).

3.2.1.5 Lastly, with regard to the invoked notion of "legal certainty", which arguably means that certain legal issues are expected to be treated and decided on in a uniform and predictable way, the board also notes that not accepting a retroactive transfer of the right of priority under the EPC has consistently been endorsed by various commentaries and national courts. Some of these are quoted below:

- R. Wieczorek, *Die Unionspriorität im Patentrecht*, 1975, section 3.2.4: *"... Rückwirkende Kraft kann einer verspätet vereinbarten Rechtsnachfolge nicht verliehen werden, da ein tatsächliches Erfordernis der Patentverleihung durch eine privatrechtliche Abmachung nicht nachgeholt werden kann ..."*;
- R. Teschemacher in *GRUR Int* 1983, section 5.5, second paragraph: *"... Die Übertragung muss allerdings vor Einreichung der europäischen Nachanmeldung stattgefunden haben. Die nachträgliche Konstruktion einer Priorität ist damit ausgeschlossen ..."*;
- Justice D. Kitchen in *Edwards Lifesciences AG v. Cook Biotech Incorporated* [2009] EWHC 1304 (Pat), point 95: *"... his position is not improved if he subsequently acquires title to the invention. It remains the case that he was not entitled to the privilege when he filed the later application and made his claim ..."*;
- K. Grabinski in *Benkard, EPÜ*, 2nd edition, 2012, section Art. 87, point 4: *"... Eine bei*

*Inanspruchnahme der Priorität fehlende Berechtigung kann nicht nachgeholt werden";*

- R. Moufang in Schulte, Patentgesetz mit EPÜ, 9th edition, 2014, section §41, point 28: "... Die Rechtsnachfolge muss vor Einreichung der Nachanmeldung eingetreten sein, ein nachträglicher Erwerb wirkt nicht zurück ...";
- T. Breimi in Singer/Stauder, Europäisches Patentübereinkommen, 7th edition, 2016, Article 87 EPC, section 2.7, point 59: "... Es ist also nicht möglich, nachträglich durch eine Übertragung des Rechts an einer Voranmeldung die Priorität zu manipulieren ...".

3.2.1.6 In summary, the appellant failed to convince the board that the *nunc pro tunc* assignment put forward in its first line of argument indeed fulfilled substantive requirement (i) of Article 87(1) EPC 1973.

3.2.2 *Implicit transfer by virtue of a general policy under German law (based on **E10 to E16**)*

Regarding this line of argument, the appellant submitted that a general policy had been established between ASUSTeK and itself and had been followed by both parties. By executing this policy the right of priority for the patent in suit was transferred to the appellant. As means of evidence the appellant filed affidavits E10 to E16. The respondent contested the content of those affidavits.

3.2.2.1 Exhibits E10 to E13 relate to four affidavits signed by the then respective chairmen of ASUSTeK and the appellant (E10 and E11), a general counsel (E12) and a patent engineer (E13) of ASUSTeK in 2012 (i.e. almost five years after the filing date of the present

European patent application D2), which indicate that a general policy in the field of telecommunications standards had been set up between that company and the appellant. For example, affidavit E10 includes the following statement (emphasis added by the board):

*"Beginning from the end of 2006 intellectual property in the field of **telecommunications standards** should be transferred from ASUSTeK to Innovative Sonic Limited ("Innovative"), since Innovative was founded as a trust holder for ASUSTeK. All **pending applications** and granted patents in this field with the exception of six particular cases that ASUSTeK wants to keep should be transferred to Innovative. ASUSTeK keeps US6687248, US6788944, US6728529, US7539220, US7068636 and US7203196 and their foreign counterparts and Innovative received the exclusive right to sublicense these patents. **New cases** should also be transferred to Innovative and ASUSTeK would support Innovative in prosecuting the cases. General Counsel of ASUSTeK, Vincent Hong, was involved in making this policy.*

*Based on the advice of Vincent, for the **new cases**, ASUSTeK should file the first filings as US provisional applications and then transfer the rights **including the right to claim priority** to Innovative for Innovative to file the follow up applications. I was also advised that since Innovative was a company with place of business in the British Virgin Islands, it may not be possible for Innovative to claim the right of priority in certain countries.*

*Therefore, based on this policy, ASUSTeK made the*

*first filings as US provisional applications and transferred the right to claim priority to Innovative in countries where it was legally possible. ASUSTeK filed the follow up applications and then transferred these applications to Innovative in countries where it was legally not possible for Innovative to claim the right of priority."*

The fundamental submissions regarding the above policy were repeated - using the same or similar wording - in affidavits E11 to E13.

3.2.2.2 As regards the applicable rules for assessing the evidence adduced, the board concluded the following: the burden of proving a valid transfer of the right of priority lies with the patent proprietor (appellant) since it is the one claiming that right (see e.g. T 1008/96, Reasons 3.3; T 1056/01, Reasons 2.10; T 493/06, Reasons 8; T 205/14, Reasons 3.5). This rule is all the more applicable taking into account that the patent proprietor (appellant) alone has access to the relevant evidence when it asserts a concluded transfer of rights. Given that the appellant submitted no other - in particular no contemporaneous documentary - evidence, the board accepts the later-executed affidavits filed as admissible means of evidence under Article 117(1) EPC. The probative value of those affidavits is to be decided by the board in accordance with the established principle of free evaluation of evidence. As to the standard of proof to be applied, this board concurs with the respondent that the circumstances of the present case require a proof "beyond reasonable doubt" (rather than a proof based on "balance of probabilities" as relied upon in T 205/14, Reasons 3.6.1 and the almost identical case T 517/14,

Reasons 2.7.1). This is because practically all the evidence regarding the general policy lies within the knowledge and power of only one party to these inter-partes proceedings within the meaning of T 472/92 (OJ EPO 1998, 161), Reasons 3.1 (concerning public prior use), i.e. the patent proprietor (appellant) here, whereas the other party (respondent) is not in a position to present any counter-evidence.

3.2.2.3 As regards this second line of argument, the appellant relies on the *lex loci protectionis*, here the law of Germany as one of the Contracting States to the EPC. The board first accepts that German law allows for an implicit transfer of the right of priority, as confirmed by the decision of the German Federal Court of Justice - *Fahrzeugscheibe* (E16), and that thus no transfer in writing is necessary. The board also accepts that application P (filed on 28 July 2006) qualifies as a "pending application" within the meaning of those affidavits at the time when the general policy was said to be established ("end of 2006"). Yet, even assuming that German law was the applicable national law as regards the formal requirements for the transfer of the right of priority, and that thus no transfer in writing was necessary, the board nonetheless holds that the appellant has not proven beyond reasonable doubt that it was the valid successor in title under Article 87(1) EPC 1973. The reasons are set out below.

3.2.2.4 Firstly, the board is not convinced that the general policy covers the transfer of the right of priority for application P. The board understands that the general policy according to which ASUSTeK "*should file the first filings as US provisional applications and then transfer the rights including the right to claim priority to Innovative for Innovative to file the*

*follow up applications*" constituted a common filing policy to be pursued from that time onwards, i.e. for applications to be newly filed. It was thus directed to the future and in the board's view amounts to a declaration by the two respective companies of the intention that, in this respect, the transfer of the right of priority was only applicable to "new cases" (in the terminology of E10 to E12; "future applications" in E13) rather than to "pending applications" and "granted patents". Since, at the time the general policy was set up, application P had already been filed, the above common filing policy, including the transfer of the right of priority, could not apply to it.

3.2.2.5 Secondly, even in respect of "new cases", the board is not convinced that the above filing policy had always been complied with. At the oral proceedings before the board, the appellant argued that the common declaration of intention according to the general policy was to be understood as binding instructions, and in support of its argument relied in particular on affidavit E13 (first page, last paragraph, last sentence to second page, first paragraph):

*"Therefore, on instructions from ASUSTeK's General Counsel, Vincent Hong, I instructed North America Intellectual Property Corporation to file applications in US, Europe and Korea under the name of Innovative and claim the right of priority of the US provisional patent applications under the name of ASUSTeK".*

Even assuming that such instructions did exist, it is apparent to the board that they were not necessarily followed by the employees of both companies in every

case. This is notably evidenced by European patent applications A13 and A15, both filed by ASUSTeK and claiming the priority of a first filing made by ASUSTeK in *Taiwan* (rather than in the US according to the alleged policy) in 2008, i.e. well after the general policy was set up.

Those applications concern subject-matter in the field of telecommunications standards and clearly qualify as "new cases" within the meaning of affidavits E10 to E13. Concerning the criterion "*in the field of telecommunications standards*" used in E10 to E13, the board is not persuaded by the appellant's argument that the field of telecommunications standards is supposed to be limited to patent applications concerned only with inventions relating to developments, e.g. by standardisation working groups, of *new* standards or to improvements of *existing* standards. Rather, the board agrees with the respondent that the above expression is to be construed much broader, so that it may well include inventions which are simply making use of or are based on existing telecommunications standards. Accordingly, applications A13 and A15 are also manifestly concerned with "telecommunications standards" within the broad meaning of the phrase "*in the field of telecommunications standards*" of the present affidavits (see e.g. A13, column 2, lines 5-9: "... *In accordance with the trend of designing mobile phones, a second generation (2G) mobile communication system and a third (3G) mobile communication standard communication system are integrated into a single mobile phone ...*"; A15, paragraph [0016]: "*According to an embodiment of the present invention, the wireless network includes a worldwide interoperability for microwave access (WiMAX) wireless network, a 3G wireless network, a 3.5G wireless network, or a long*

*term evolution (LTE) wireless network."*).

From these passages of A13 and A15 alone the board concludes that it was, at best, not unlikely that other exceptions to those allegedly binding instructions existed. The appellant conceded at the oral proceedings before the board that there were apparently more exceptions than initially alleged. This, however, raises serious doubts about the actual execution of instructions which allegedly were to be inferred from the above general policy, in particular about the applicability of the general policy to the present case.

3.2.2.6 Thirdly, even if the above common filing policy, including the transfer of the right of priority, was indeed applicable to "pending applications" (such as application P), it is not clear whether the transfer from ASUSTeK to the appellant of the right to apply for a patent based on those applications did in fact *include* the transfer of the right to claim priority from them (see again affidavit E10: "... *All pending applications ... in this field with the exception of six particular cases that ASUSTeK wants to keep should be transferred to Innovative ...*"). Given that the right to apply for a patent based on an application and the right to claim priority from that application are independent and thus separable rights (see point 3.1.1.2 above), the mere transfer of a pending application from one party to another does not necessarily mean that the associated right of priority is transferred between those parties too.

3.2.2.7 Furthermore, exhibits E14, E14a, E14b and E14c relate to emails and communications sent by the then Taiwanese and US representatives (M. Hsiao; J. McKinney Muncy) of



ASUSTeK to employees of ASUSTeK reporting the filing of application P, while exhibits E15, E15a and E15b relate to emails and communications sent by the then Taiwanese representative (N. Lee) of ASUSTeK and the European representative (T.J. Hager) of the appellant to employees of ASUSTeK and the appellant indicating the filing of European application D2 in the name of the appellant.

However, the board finds that the mere fact that patent attorneys receive instructions from companies to file patent applications does not automatically demonstrate that the right to claim priority from a first application was already validly transferred between the parties to the transfer before the filing date of the later application. This finding in no way contradicts the conclusions drawn in the decision of the German Federal Court of Justice - *Fahrzeugscheibe* (E16) since the underlying situation there was not comparable with the present case. In the former case, there was an express Research & Development cooperation agreement between the applicant of the first application and the applicant of the later application, together with an express indication that a certain national application had been filed with the German Patent and Trademark Office in order to enable the applicant of the later application to take decisions on further actions as regards subsequent filings (see E16, Reasons 15 to 17). Moreover, the evidence adduced in cited case T 160/13 to prove the validity of an implicit transfer of the right of priority under German law was also rather different. In that case, the relationship between the respective first application and the later application was absolutely clear from the corresponding email exchanges (see e.g. exhibit A1: "case GM03200DE"; "PCT

for 2003200").

3.2.2.8 Lastly, the appellant also contended that it was sufficiently clear from the combination of the general policy, the filing of application D2 in the name of the appellant and the declaration of priority according to Article 88(1) EPC in conjunction with Rule 52 EPC that only the appellant itself could have owned the right to claim priority from application P before the filing of D2, because it acted exactly in the manner generally foreseen in the general policy, as evidenced by E10 to E16.

The board, however, has already pointed out above that the general policy was not applicable to application P and that it apparently was not always complied with (see points 3.2.2.4 and 3.2.2.5). Furthermore, the mere ticking of box 25 in EPO Form 1001 for the purpose of a declaration of priority with respect to application P at the same time as (rather than before) the filing of application D2 does not in itself constitute proof of a valid transfer of the right of priority. Rather, the filing of the declaration of priority in respect of a European patent application under Rule 52 EPC is an entirely formal requirement with the aim to duly inform the EPO and the public that priority had been claimed for the purpose of prosecuting the application in terms of search and examination. This, however, may not provide any guarantee regarding the validity of the claimed priority. The board also notes in this context that in none of the appeal cases cited above with respect to a transfer of a right of priority was it decisive for the assessment of whether the priority was validly claimed that the declaration of priority relating to an application was indeed made by a different applicant, i.e. by the alleged successor in

title. This was so irrespective of whether the succession was found to be *invalid* (see e.g. "EPO request for grant" form for the application underlying T 1008/96; "PCT request" form, Box No. VI, for the application underlying T 62/05) or *valid* (see e.g. "PCT request" forms, Box No. VI, for the applications underlying T 160/13 and T 205/14). In conclusion, the board holds that the above argument does not add any concrete and distinct facts to the case from which it may be convincingly concluded when exactly, if at all, ASUSTeK transferred the right of priority of application P to the appellant. Therefore, this argument must also fail.

3.2.2.9 In summary, affidavits E10 to E13 and correspondence E14 and E15 fail to prove, on the basis of the standard of *beyond reasonable doubt*, that a valid assignment of the right of priority derived from application P was made before 27 July 2007, in view of each of the following considerations alone:

- the alleged general policy contains only very general statements on the *intention* of assigning the right to claim priority from *new* patent applications filed in the name of ASUSTeK, i.e. applications which were to be filed from the end of 2006 onwards (see point 3.2.2.4 above);
- the alleged general policy was not consistently respected by the employees of both companies (see point 3.2.2.5 above);
- even if the alleged general policy was applicable to pending applications already filed by ASUSTeK at the time the policy was set up, and thus also to application P, there is no indication that the right to claim priority from P was transferred

- together with the right to apply for a patent based on application P (see point 3.2.2.6 above);
- the mere fact that present European application D2 was indeed filed with the EPO on 27 July 2007 does not necessarily imply that the right to claim priority from application P had already been validly transferred (see points 3.2.2.7 and 3.2.2.8 above).

In sum, even assuming that the applicable national law did not prescribe that a transfer of the right of priority must be in writing and thus allowed for an *implicit* transfer, the appellant failed to sufficiently prove that the right of priority was validly transferred to it in an implicit way by virtue and in execution of a general policy between ASUSTeK and it.

### 3.2.3 *"Direct transfer" under US law (based on **D1**, **E7** and **E8**)*

As regards the alleged "direct transfer" of the rights associated with US non-provisional application D1 from the inventor to the appellant on 27 July 2007, as evidenced by the inventor's transfer declarations E7 and E8, the board concurs with the finding of the decision under appeal that the mere fact that those rights ("entire right, title, and interest") relating to a subsequently and independently filed application such as D1, which claimed priority from application P, were "directly" transferred to the appellant cannot establish that this necessarily included, for the present European application D2, the transfer of the right to claim priority from application P. In that regard, the appellant did not add any further comments to the arguments set forth in the opposition proceedings (cf. points IV and XI above).

3.2.4 *Implicit transfer by virtue of a general policy under Taiwanese law (based on E10 to E15 and TW1 to TW3)*

3.2.4.1 The appellant submitted this fourth line of argument, together with exhibits TW1 to TW3, for the very first time in its response to the respondent's letter of reply, i.e. long after filing its statement setting out the grounds of appeal (cf. point VII above).

3.2.4.2 In appeal proceedings, the admissibility of submissions filed after the appellant has filed its statement setting out the grounds of appeal, is subject to Article 13(1) RPBA. This also applies to late-filed arguments (see e.g. T 1069/08, Reasons 28; T 1621/09, Reasons 37). By virtue of Article 13(1) RPBA, a board's discretion in admitting any amendment to a party's case "*shall 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*". The list of criteria set out in Article 13(1) RPBA is not exhaustive ("*in view of inter alia*"). Thus, other well-established criteria relevant to the admissibility issue, such as whether the amendment relates to the case under appeal (Article 12(2) RPBA) or whether it is *prima facie* relevant to its outcome, may also be taken into account. Although the criterion referred to in Article 12(4) RPBA applies to lines of argument put forward in the statement setting out the grounds of appeal, it is by analogy and indeed a *fortiori* also valid for lines of argument submitted later in the appeal procedure.

Article 12(4) RPBA requires that everything presented by the parties under Article 12(1) RPBA is 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(2) RPBA, in turn, lays down that "[t]he statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on". Taken as a whole, the Rules of Procedure of the Boards of Appeal, and in particular Article 12(2) RPBA, make it clear that the parties' complete case must be submitted at the outset. The purpose of Article 12(2) RPBA is to ensure fair proceedings for all concerned and to enable the board to start working on the case on the basis of both parties' complete submissions.

In view of the above, as to the procedural aspects of this late-filing, the board agrees with the respondent that this new line of argument *could* and *should* have been presented with the statement setting out the grounds of appeal, given that the applicability of Taiwanese law, to which TW1 to TW3 refer, was already discussed in the opposition proceedings concerning the related European patent EP-B-2 077 691 (see e.g. A16 filed by the respondent).

3.2.4.3 As to the substance and *prima facie* relevance of this fourth line of argument, the appellant relies on the *lex domicilii*, i.e. Taiwanese law in this case. Concerning Taiwanese law, the appellant submitted that, similar to German law, Taiwanese law allowed for an implicit transfer of the right of priority, as indicated in the legal opinion of TW1. However, unlike German law, the right of priority and the right to file a later patent application claiming that priority were *inseparable* rights under Taiwanese law, rather than

*independent* rights.

However, the board holds that, even if Taiwanese law were to be accepted as the law governing the assessment of the general policy and the formal requirements for a valid transfer of the right of priority, the outcome of such an assessment would not be different from that of the appellant's second line of argument (see point 3.2.2 above), as a result of a lack of substantiation regarding the content of the underlying evidence. This is because (a) the general policy fails to cover the transfer of the right of priority for application P (see point 3.2.2.4 above) or (b) the general policy was not always complied with (see point 3.2.2.5 above). Moreover, (c) the general policy does not indicate the transfer of the right of priority for "pending applications" such as application P (see point 3.2.2.6 above). As to observation (c), the board holds that even assuming that the right of priority and the right to file a later patent application claiming that priority were indeed inseparable rights under Taiwanese law, as argued by the appellant, this could not override the substantive requirement as set out in point 3.1.1.2 above, according to which the right of priority relating to a first application can be transferred independently of the right to that first application. Hence, contrary to the appellant's view, the board finds that the fact that a certain patent application (such as application P) has been transferred on the basis of the alleged general policy does not necessarily mean - in the absence of any express or implied indication - that this transfer includes the right of priority derived from that application. Also, the observations made under points 3.2.2.7 and 3.2.2.8 above equally apply to this

fourth line of argument.

3.2.4.4 Consequently, the board decided not to admit the fourth line of argument (i.e. implicit transfer under Taiwanese law) and TW1 to TW3 into the appeal proceedings under Article 13(1) RPBA.

3.3 In view of the foregoing, the board judges that - irrespective of the issue of the applicable national law with regard to the present transfer of the right of priority - the appellant was not able to sufficiently establish that the right of priority arising from application P was validly transferred to the appellant before the filing of application D2. Thus, the priority claim for European patent application D2 is invalid, and A4 belongs to the prior art within the meaning of Article 54(2) EPC 1973.

4. *Novelty (Article 54 EPC 1973)*

It was undisputed during the appeal proceedings that document A4 discloses all the features of claim 1 as granted (cf. point XII above) and thus takes away its novelty (see in particular the statement setting out the grounds of appeal, page 15, section IV.1).

5. *Request for referral of questions to Enlarged Board*

5.1 According to Article 112(1) (a) EPC 1973, a board of appeal, *"in order to ensure uniform application of the law, or if a point of law of fundamental importance arises: ... shall ... refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes"*. It is clear from the wording of this provision that "points of law" may be referred to the Enlarged Board only if



they require clarification to ensure uniform application of the law or are of fundamental importance and the referring board takes the view that, for those reasons, it needs a ruling on them by the Enlarged Board in order to settle the case (see e.g. G 1/12, OJ EPO 2014, 114, Reasons 6).

5.2 As to the question of "uniform application of the law", the board is not aware of diverging case law in that respect. To the contrary, the relevant jurisprudence of the Boards of Appeal is consistent in holding that the successor in title of the applicant of the application from which priority is claimed must be the owner of the right of priority *before* the filing date of the later European patent application (see point 3.1.1.1 above).

5.3 As to the issue of "point of law of fundamental importance", the board holds that the questions posed concerning the allowability of a retroactive assignment of the right of priority are primarily relevant to the present (and possibly also to co-pending case T 1763/13) and thus of special interest only to the parties in those cases, but not for a large or substantial number of other similar cases. Indeed, the appellant conceded at the oral proceedings before the board that it had little idea of the number of cases for which the answer to the questions posed could be of relevance. Furthermore, the board is without a doubt in a position to answer those questions which are relevant to the present case (see in particular points 3.1.1.1 and 3.2.1 above).

5.4 Accordingly, the board decided to refuse the appellant's request that the above questions be referred to the Enlarged Board of Appeal.

6. *Objection under Rule 106 EPC*

6.1 The appellant, at the end of the oral proceedings before the board, made an objection under Rule 106 EPC on the grounds that its right to be heard under Article 113(1) EPC 1973 had been violated because the board did not identify the applicable national law for the matter of determining the validity of the transfer of the right of priority (cf. point XI above).

6.2 The board dismissed that objection on the grounds that no violation of the appellant's right to be heard occurred, having regard to the following observations:

- the board repeatedly and consistently indicated in writing (see point VIII above) and orally (see the minutes of the oral proceedings, page 5, last paragraph to page 6, first paragraph) that, in the present case, the determination of the applicable national law was not necessary for the board to decide on the validity of succession in title under Article 87(1) EPC 1973;
- the board discussed in turn each of the first to fourth lines of argument invoked by the appellant, based each time on the assumption that the particular national law relied upon by the appellant (US, German and Taiwanese law) was the applicable law;
- the appellant had several opportunities in writing and ample time at the oral proceedings to make its case on the basis of all four lines of argument invoked.

7. In view of the above, the appeal has to be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chair:



P. Cremona

A. Ritzka

Decision electronically authenticated