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

Case Number: T 0924/15 - 3.3.02

Application Number: 09164815.4

Publication Number: 2103606

IPC: C07D307/46

Language of the proceedings: EN

Title of invention:

Method for the synthesis of 5-alkoxymethylfurfural ethers

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 requests - 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, 3).



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0924/15 - 3.3.02

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

Appellant: Furanix Technologies B.V.
(Patent Proprietor) Zekeringstraat 29
1014 BV Amsterdam (NL)

Representative: EP&C
P.O. Box 3241
2280 GE Rijswijk (NL)

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

Representative: J A Kemp
14 South Square
Gray's Inn
London WC1R 5JJ (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 3 March 2015
revoking European patent No. 2103606 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeal by the patent proprietor (hereinafter "appellant") lies from the decision of the opposition division to revoke European patent No. 2 103 606.
- II. The contested patent was granted for European application 09 164 815.4, which had been filed as a divisional application of earlier European application 07 723 190.0, filed on 12 March 2007 under the PCT as PCT/EP2007/002145 (hereinafter "the parent application") and claiming priority from European application 06 075 564.2 (hereinafter "the priority application").
- III. The patent as granted contains a set of eleven claims, independent claim 1 of which reads as follows:
- "1. Method for the manufacture of ethers of 5-hydroxymethylfurfural by reacting a glucose-containing starting material with an alcohol in the presence of a catalytic or sub-stoichiometric amount of a heterogeneous or homogeneous acid catalyst, wherein water is present as solvent in addition to the alcohol, and wherein the method is performed in a continuous flow process."*
- IV. The following were among the items of evidence cited during opposition proceedings:
- D11: Declaration of assignment between Avantium International B.V. and Furanix Technologies B.V. dated 1 March 2007
- D12: EP 1 834 950 A, publication of the priority application.

The opposition division came to, *inter alia*, the following conclusions:

- The transfer D11 of the priority application dated 1 March 2007 complied with the requirements of Article 72 EPC.
- The priority claim of the contested patent was therefore not valid.
- D12 was prior art according to Article 54(3) EPC.
- The subject-matter of claims 1 to 11 as granted (main request) was not novel over D12.
- Auxiliary request 1 was not admitted into the proceedings.

V. In its statement setting out the grounds of appeal, the appellant maintained that the contested patent was entitled to priority. In order to support its case, it filed the following new items of evidence:

D20: Declaration of assignment of a patent application by NeoDec B.V. to SPGPrints B.V.

D21: Legal opinion of Mr G Kuipers of law firm De Brauw Blackstone Westbroek of Amsterdam, the Netherlands, dated 3 July 2015, accompanied by three annexes including

Annex 2: Statement of Mr T B van Aken dated 2 July 2015, regarding the right to claim priority from patent application EP 06 755 654.2.

The appellant further contested the non-admittance of auxiliary request 1 into the proceedings by the opposition division.

VI. In its reply to the statement of grounds, the opponent (hereinafter "respondent") maintained that the priority claim was invalid. In order to corroborate its argumentation, it further relied on the following new items of evidence:

D22: 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 11 November 2015.

D23: Annex A containing documents relating to the filing and transfer of European patent application 01201096.3 and subsequent filing of PCT/EP02/03343.

D24: 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.

VII. 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 the appellant Furanix Technologies B.V. (hereinafter also referred to as "Furanix") by means of the assignment D11.

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

D25: Legal opinion of Mr G Kuipers of law firm De Brauw Blackstone Westbroek of Amsterdam, the Netherlands dated 20 December 2018.

D26: Legal opinion of Prof. Dr. C J J C van Nispen dated 19 December 2018.

D27: The Paris Convention Centenary, wipo-pub-875, ISBN 92-805-0099-6, WIPO 1983, pages 5, 15, 16, 27 to 31.

D28: 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).

IX. Under cover of a further letter dated 3 January 2019, the appellant filed a set of seven claims to be considered as auxiliary claim request 4.

X. By letter of 14 January 2019, the respondent objected to the admittance into the proceedings of D25, D26 and auxiliary claim request 4 of the appellant. It also raised objections under Article 123(2) EPC against this claim request.

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

D29: Copy of Mr van Aken's publicly available entry in the "Linkedin" database.

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

D30: Response by Mr M van Gardingen dated 17 January 2019 to the legal opinions of Mr G Kuipers and Prof. Dr. C J J C van Nispen filed with the

respondent's submissions of 21 December 2018
(VIII, *supra*).

XII. Oral proceedings before the board were held on 21
January 2019.

XIII. Final requests

The **appellant** requests as its main request that the
impugned decision be set aside and that the patent be
maintained as granted or, alternatively, that the case
be remitted to the opposition division for further
prosecution.

Alternatively, it 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 appellant requests
that should the board conclude that assignment D11 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 accordingly under Rule 139 EPC to Furanix.

As its third auxiliary request, the appellant requests that auxiliary claim request 1 that was not admitted by the opposition division be admitted into the proceedings and the case be remitted to the opposition division on the basis of this request for further prosecution.

As its fourth auxiliary request, the appellant requests that auxiliary claim request 4 as filed with letter dated 3 January 2019 be admitted into the proceedings and that the case be remitted to the opposition division on the basis of this request for further prosecution.

In addition, the board understands that the appellant requests documents D25 to D28 be admitted into the proceedings.

The **respondent** requests that the appeal be dismissed.

It also requests that D25, D26, auxiliary claim request 1 and auxiliary claim request 4 not be admitted into the proceedings.

If D25 and D26 are admitted into the proceedings, the respondent requests that D30 be admitted.

If D25 and D26 and auxiliary claim request 4 are admitted and oral proceedings are adjourned, the respondent requests that costs be apportioned against the appellant.

The respondent requests that its submissions as annexed to its letter dated 14 January 2019 be admitted into

the appeal proceedings in case the claims of auxiliary claim request 4 were discussed during the oral proceedings.

Lastly, the respondent requests that, should the board overturn the findings of the opposition division regarding priority entitlement and novelty over D12, the case be remitted to the opposition division for further prosecution.

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

Admittance of D25, D26 and D30 - apportionment of costs:

- Documents D25 and D26 were highly relevant for assessing the priority entitlement and thus 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 D25 and D26, 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 D11 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 van Aken (annex 2 of document D21) 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 D11 that the priority right was in fact assigned. As was stated in document D21, 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 D11 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 D11 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 D28.
- 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, D12 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.

Admittance of auxiliary claim request 1:

- The opposition division exercised its discretion in an unreasonable way and not in accordance with the right principles as required by G 7/93. The parties should be treated equally. Since several late-filed documents of the respondent were admitted by the opposition division, the appellant's late-filed claim request should also have been admitted. In addition the opposition division should have followed the Guidelines E-V 2.2(a). The request should thus be admitted into the appeal proceedings.

Admittance of auxiliary claim request 4:

- This request was clearly allowable under Articles 84 and 123(2) EPC, was not complex and should thus be admitted into the proceedings. It was filed late because it was in response to the communication of the board.

XV. The respondent essentially counter-argued as follows:

Admittance of D25, D26 and D30 - apportionment of costs:

- Documents D25 and D26 were submitted on 21 December 2018. The documents were late-filed and the respondent 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 appellant'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 respondent's late-filed document D30 would also have to be admitted into the appeal proceedings.

- A cost order made against the appellant was requested in view of the additional work occasioned by the appellant'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 (D11), dated 1 March 2007, all rights pertaining to the priority application were transferred from Avantium to the appellant, 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 D22

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 D11 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 produced 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 D11 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, D12, the publication of the priority application, pertained to the prior art to be considered for the assessment of novelty under Article 54(3) EPC.
- D12 disclosed all the features of claim 1 at issue, and therefore the main request lacked novelty and was not allowable.

Admittance of auxiliary claim request 1:

- The opposition division was right in non admitting this request into the proceedings.

Admittance of auxiliary claim request 4:

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

Reasons for the Decision

Admittance of D25, D26, D27, D28 and D30 - apportionment of costs

1. Documents D25, D26 and D30 were filed after submission of the statement of the grounds of appeal and the respondent's reply. Admittance of the 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).

- 1.1 Documents D25 and D26, which were filed by the appellant, 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 respondent had had the opportunity to properly consider its view on this issue and to present and corroborate its counter arguments in document D30. In addition the board itself had sufficient time to consider the issue. The board thus decided to exercise its discretion to admit documents D25 and D26 into the proceedings. Document D30, the reply of the respondent, was as a consequence also admitted into the proceedings.
- 1.2 As neither the respondent nor the board had objections to admitting the appellant's late-filed documents D27 and D28, these documents were admitted into the proceedings as well.
2. Since the respondent had not explained why the late filing of documents D25 and D26 had led to additional work which could have been avoided in case of timely filing and since the oral proceedings were not adjourned, 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

3. As mentioned in point II above, the contested patent results from a divisional application divided from the parent application PCT/EP2007/002145. This parent application was filed on 12 March 2007 in the name of

Avantium. It claims priority from the application published as D12, 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 D11 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.

- 3.1 The appellant 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. 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.
- 3.2 The respondent 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 respondent.

- 3.3 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 D11, the "*declaration of assignment*" was signed in Amsterdam. The alleged assignment will therefore be assessed by applying the law of the Netherlands.

- 3.4 In an earlier stage of the appeal proceedings the appellant 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 appellant 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 (XIV, *supra*).

3.5 Document D21 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.

3.6 Document D11 is signed on behalf of both Avantium and Furanix by Mr van Aken, the Chief Executive Officer of both companies. It can be assumed, and it has not been disputed, that Mr van Aken had the power to dispose of the priority right.

Document D11 states that Avantium "*declares to have assigned all rights pertaining to European Patent application Nos. 06075564.2 and 06075565.9*" to Furanix, the former application being the priority application in the present case. Document D11 further states that Furanix "*declares to accept all these rights*".

Document D11 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 appellant'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 van Aken (acting for Avantium as well as Furanix) to sign a document to effectuate the assignment on the 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 an assignment had already taken place. In any case, the wording of document D11 clearly points to the assignment of the priority right to Furanix on 1 March 2007 or an earlier date.

- 3.7 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 appellant did not prove such contradictory intentions for the following reasons.

The alleged intention to retain the priority right is not expressed in document D11. It is highly unlikely that if the intention had 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 appellant, 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 D21), Mr van Aken confirmed that "*In 2007 business considerations compelled me to assign European application EP 06075564.2 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 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.

- 3.8 As document D11 is intended to provide proof of the assignment of rights, its persuasive weight is considerable. The counter evidence put forward by the appellant is not convincing. It must therefore be held that the respondent has complied with the burden of proof of the alleged assignment of the priority right.
- 3.9 The priority claim of the opposed patent is thus invalid.

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

4. 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).
- 4.1 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".

- 4.2 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"*.
- 4.3 Documents D27 and D28, which were submitted in support of the appellant'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.
- 4.4 On the basis of Article 87 EPC, the board is thus in a position to answer both questions posed by the appellant (XIII, *supra*) affirmatively. The appellant's request to refer those questions to the Enlarged Board of Appeal is therefore refused.
- 4.5 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

5. In its last submission dated 21 December 2018, the appellant argued for the first time that should the board conclude that all rights, including the right to priority, were assigned by means of D11 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 appellant argued that the criteria for an allowable correction as set out in G 1/12 had been met in the present case.

6. 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 appellant has consistently argued that the true intention underlying assignment D11 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 it was 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 appellant for a correction under Rule 139 EPC is refused.

Main request - claim 1 - novelty under Article 54 EPC

7. Since the priority claim of the contested patent is invalid, D12, the publication of the priority application, represents prior art to be considered for novelty under Article 54(3) EPC. This was common ground.
 - 7.1 The appellant did not dispute that D12 discloses (paragraphs [0009], [0014], [0018], [0020] to [0022], [0024] and [0025], claims 1, 15 and 17) a method for the manufacture of ethers of 5-hydroxymethylfurfural by reacting a glucose-containing starting material with an alcohol in the presence of a heterogeneous or homogeneous acid catalyst, wherein water is present as solvent in addition to the alcohol, and wherein the method is performed in a continuous flow process.
 - 7.2 It follows that D12 anticipates the subject-matter of claim 1 as granted.
 - 7.3 The appellant's main request, first auxiliary request (request for referral to the Enlarged Board of Appeal) and second auxiliary request (request for correction) are therefore not allowable.

Third auxiliary request ("Auxiliary request 1") - admittance into the proceedings

8. This auxiliary claim request corresponds to the "auxiliary request 1" filed before and not admitted by the opposition division (impugned decision, page 13 and

annex). Claim 1 according to this request reads as follows (amendments in comparison with claim 1 as granted (III, *supra*) put in bold by the board):

*"1. Method for the manufacture of ethers of 5-hydroxymethylfurfural by reacting a glucose-containing starting material with an alcohol in the presence of a catalytic or sub-stoichiometric amount of a heterogeneous or homogeneous acid catalyst, wherein water is present as solvent in addition to the alcohol, and wherein the method is performed in a continuous flow process, **and wherein the residence time in the flow process is between 10 seconds and 600 seconds.**"*

8.1 The appellant argued that it was made aware of the objection to non-entitlement to priority only in the respondent's letter of 11 September 2014. This was two months prior to the oral proceedings before the opposition division and corresponded to the very last day for making submissions and/or amendments as fixed by the opposition division under Rule 116 EPC. A written response against this extremely late-filed objection was therefore not possible.

The opposition division had not considered the fact that said auxiliary request had actually been occasioned by the extremely late submission of the respondent, with consequences that were entirely unpredictable. In admitting this late objection of the respondent on the one hand, and refusing the auxiliary request on the other hand, the opposition division had exercised its discretion in an unreasonable way. Reference was made to G 7/93. The principle of equality of arms was clearly breached.

Moreover, the opposition division took its decision after only 10 minutes deliberation. The only

consideration was to bring the procedure to a close. It was not understood, why the opposition division did not consider an alternative approach in the form of a second hearing or continuation in writing, which would have allowed the parties to review the auxiliary request. The opposition division had therefore not exercised its discretion in accordance with the right principles as required by G 7/93.

Additionally, in the very similar case underlying European patent No. 2 105 439, the opposition division had decided in favour of the appellant and acknowledged the priority claim. The appellant had thus assumed that the same would have been decided in the present case. The decision of the opposition division on the validity of the priority claim took the appellant by surprise, thus justifying the filing of present auxiliary claim request 1 in accordance with the Guidelines.

- 8.2 The board is not convinced. Under Article 12(4) RPBA, the board has the power not to admit *inter alia* requests into the proceedings that were not admitted at the first-instance stage. An overruling of the decision of the opposition division on the non admittance of said auxiliary claim request would presuppose that the opposition division either failed to exercise its discretion in accordance with the right principles or exercised its discretion in an unreasonable way (G7/93, JO 1994, 775; reasons: 2.6).

The board notes that, contrary to what was argued above, the appellant did take position on the objection as to non-entitlement to priority raised by the respondent on 11 September 2014, in its letter dated 13 October 2014, i.e. about one month before the oral proceedings before the opposition division. With the

same letter, the appellant also filed an auxiliary claim request, which was admitted into the proceedings together with the appellant's and opponent's observations on the validity of the priority (see the minutes of the oral proceedings before the opposition division, page 1, third paragraph). There is therefore no reason to conclude that the parties were not treated equally.

It was only after having heard the decision of the opposition division denying priority and novelty over D12 that the appellant replaced said auxiliary claim request filed by letter of 13 October 2014 with present auxiliary claim request 1 which was not admitted (see the minutes of the oral proceedings before the opposition division, page 3). Present auxiliary claim request 1 was therefore filed at the latest possible stage, clearly putting the adverse party in the extremely disadvantageous position of having to deal with new issues at very short notice. In fact, claim 1 was amended (point 10, *supra*) by inserting a feature concerning the residence time range, which was extracted from the examples (application as filed, tables on pages 11 and 12). On the one hand, this amendment went in a different direction as the previous auxiliary request filed by letter of 13 October 2014 and subsequently withdrawn: here claim 1 had been amended by including the range of the reaction temperature. On the other hand, the insertion of a feature taken from the examples could not be predicted in advance and raised issues concerning clarity and compliance with Article 123(2) EPC, to be dealt with at an extremely late stage of the proceedings.

The admittance of such a request into the proceedings could have only been justified if the request was to be

seen as a response to new objections raised at the oral proceedings, which was, however, clearly not the case, as set out above. Also the fact that in a similar case an opposition division, moreover in a different composition, took a decision in the appellant's favour cannot justify the filing of auxiliary claim request 1 by the appellant at such a late stage. It pertains to the very nature of *inter partes* opposition proceedings that parties have diverging opinions regarding at least some of the raised issues (here the priority claim). Each party must thus envisage the possibility that the opposition division may adopt the view of the adverse party and if so wishes, prepare fallback positions (claim requests) accordingly, without first awaiting for the opposition division's decision. This decision was also not reversing a preliminary opinion of the opposition division on the validity of the priority as any expressed preliminary views did not regard this issue.

- 8.3 In non admitting said auxiliary claim request 1, the opposition division therefore exercised its discretion in a reasonable way and in accordance with the right principles as required by G 7/93. The board sees no reasons to overrule this decision. Auxiliary claim request 1 is therefore not admitted into the appeal proceedings.

Fourth auxiliary claim request - admittance into the proceedings

9. Claim 1 of the fourth auxiliary claim request as filed by the appellant by letter of 3 January 2019 reads as follows (amendments in comparison with claim 1 as granted (III, *supra*) put in bold by the board):

"1. Method for the manufacture of ethers of 5-hydroxymethylfurfural by reacting a glucose-containing starting material with an alcohol in the presence of a catalytic or sub-stoichiometric amount of a heterogeneous or homogeneous acid catalyst, wherein water is present as solvent in addition to the alcohol, and wherein the method is performed in a continuous flow process, **wherein the residence time in the flow process is between 60 seconds and 600 seconds, wherein the continuous flow process is a fixed bed continuous flow process, wherein the fixed bed comprises a heterogeneous acid catalyst, and wherein the heterogeneous acid catalyst is zeolite beta.**"

9.1 The appellant argued that this request though being late-filed should be admitted into the proceedings since it was clearly allowable under Articles 84 and 123(2) EPC. The claimed subject-matter focused on the examples of the application as filed. It was not complex and was convergent with previous auxiliary claim request 1. Moreover, the request had to be seen as an answer to point 7.3 of the communication issued by the board in preparation for the oral proceedings.

9.2 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 only 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.

9.3 In the present case, the board observes that, as correctly submitted by the respondent, the objection as regards the validity of the priority was extensively dealt with in the impugned decision (point 20) and raised by the respondent from the onset of the appeal proceedings. The appellant 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 only about two weeks before the oral proceedings, clearly puts the adverse party in the extremely disadvantageous position of having to deal with new issues at very short notice.

9.4 Under point 7.3 of its communication issued on 8 November 2018 in preparation for the oral proceedings, the board, besides announcing questions concerning admittance of auxiliary claim request 1 into the proceedings and its compliance with Articles 84 and 123(2) EPC, observed that claim 1 of this request appeared to lack novelty over D12. Such preliminary view offered to the parties was not an invitation to file additional claim requests and certainly not only two weeks before the oral proceedings.

9.5 The board further notes that the features inserted into claim 1 were extracted from the examples contained in the application as filed (tables on pages 11 and 12). The compliance of claim 1 with Article 123(2) EPC is highly questionable, since several features pertaining to these examples were not included into claim 1, e.g. the glucose concentration, the presence and

concentration of ethanol and the specific catalyst used. The claimed subject-matter is, therefore, an intermediate generalisation of the examples.

9.6 Moreover, the board concurs with the respondent that the feature "zeolite beta" raises a clarity issue under Article 84 EPC since it cannot be *prima facie* decided whether or not this feature has a clear and generally accepted technical meaning in the art.

9.7 Additionally, the restriction of the claimed subject-matter to a method as defined in the fourth auxiliary claim request was not predictable since it was not manifested by the appellant during the appeal proceedings until shortly before the oral proceedings.

9.8 The board concludes that the fourth auxiliary claim request 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 fourth auxiliary claim request into the proceedings.

Conclusions

10. None of the requests of the appellant 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 appeal is dismissed.
3. The request for apportionment of costs is rejected.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated