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Bezeichnung der Erfindung: Articulated boom-dipper-bucket assembly for a tunnel  
Title of invention: boring machine  
Titre de l'invention :

Klassifikation / Classification / Classement : E 21 D 9/10

### ENTSCHEIDUNG / DECISION

vom / of / du 3 July 1987

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

ZOKOR INTERNATIONAL LTD.

Einsprechender / Opponent / Opposant :

DAVY THORNABY LIMITED trading as  
GROSVENOR TUNNELLING INTERNATIONAL

Stichwort / Headword / Référence : naming of opponent/ZOKOR

EPO/EPC/CBE Article 99(1), Rules 55, 56(1), (2), 88

Kennwort / Keyword / Mot clé : boom-dipper-bucket/ZOKOR

#### Leitsatz / Headnote / Sommaire

- I. Deliberate concealment of an opponent's identity must be regarded as intentional non-compliance with Rule 55(a) EPC and cannot be corrected as a "mistake" under Rule 88 EPC at any time. (Case T 25/85, OJ EPO 1986, 81 explained).
- II. However, if an opponent is not correctly identified in the notice of opposition, owing to a genuine mistake, in principle the mistake can be corrected even after expiry of the opposition period, under Rule 88 EPC.

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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 219 /86



**DECISION**  
of the Technical Board of Appeal 3.2.2  
of 3 July 1987

**Appellant :**  
(Opponent)

DAVY THORNABY LIMITED  
trading as GROSVENOR TUNNELLING INTERNATIONAL  
PO Box 10  
Stockton-on-Tees  
Cleveland TS17 6AZ  
Great Britain

**Representative :**

Kirk, Geoffrey Thomas  
Batchellor, Kirk & Eyles  
2 Pear Tree Court  
Farringdon Road  
London EC1R 0DS  
Great Britain

**Respondent :**  
(Proprietor of the patent)

ZOKOR INTERNATIONAL LTD.  
1470 Farnsworth Avenue  
Aurora  
Illinois  
United States of America

**Representative :**

Lewald, Dietrich  
Patentanwälte Müller-Boré, Deufel, Schön, Hertel  
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Isartorplatz 6  
D-8000 München 26

**Decision under appeal :**

Decision of the Formalities Officer acting for the  
Opposition Division of the European Patent Office  
dated 11 March 1986 rejecting an opposition as  
inadmissible under Rule 56(1) EPC.

**Composition of the Board :**

**Chairman :** C. Maus

**Member :** P. Ford

**Member :** R. Gryc

## Summary of Facts and Submissions

- I. European patent No. 0 014 733 was granted to the Respondents in 1983, the mention of the grant being published in European Patent Bulletin No. 83/41 dated 12 October 1983. Accordingly, pursuant to the provisions of Article 99(1) EPC and Rule 83(4) EPC, the period for giving notice of opposition expired on 12 July 1984.
  
- II. On 5 July 1984, a notice of opposition was filed on behalf of the Appellants by a professional representative. The Appellants, a British company, were carrying on business *inter alia* from an address in Essex, England, under a trading name ("Grosvenor Tunnelling International", hereinafter "GTI") which was different from their corporate registered name. Their registered office was, and still is, situated in Cleveland, England. The Board of Appeal takes note of the fact that in the file of the present case there are items of printed notepaper and printed publicity material relating to the goods and services of the Appellants which show that the corporate registered name, registration number and registered office address were printed on such GTI documents, together with the GTI name and the Essex address. The Board also accepts the Appellants' submission that the practice of carrying on business in the United Kingdom under a trade name which is not the real name of the individual, or the registered name of the company, concerned, is lawful and common. In this connection, the appellants have supplied copies of relevant national laws with their Statement of Grounds of the appeal.
  
- III. Unfortunately, owing to a misunderstanding on his part, the professional representative believed that GTI was the corporate name of his clients and he therefore filed the notice of opposition on behalf of "Grosvenor Tunnel

International Ltd., a British company" and he gave the Essex address. (The word "Tunnel" was a typing error for "Tunnelling"). The representative did not file an authorisation from his clients at the time.

- IV. On 10 July 1984, the Companies Registry in England and Wales issued an official certificate of change of registered name of the Appellants to "Davy Thornaby Limited". The registered name had previously been "Head Wrightson Teesdale Limited". The change of name did not take effect until that date (cf. section 27(4), Companies Act, 1981) and it did not affect any rights or obligations of the company or render defective any legal proceedings brought by it or that might be continued in its former name.
- V. On 13 July 1984, a Formalities Officer acting for Directorate General 2 of the European Patent Office sent a communication to the professional representative, drawing attention to the failure to file an authorisation of the representative as required under Rule 101(1) to (3) EPC and warning him that if the authorisation was not filed in due time, the notice of opposition would be deemed not to have been filed, pursuant to Rule 101(4) EPC.
- VI. The representative replied by letter dated 30 July 1984 enclosing an authorisation in his favour given by Davy Thornaby Limited. He explained that, although he was not aware of the fact at the time when the opposition was filed by him, GTI was a division of Davy Thornaby Limited and did not have an independent corporate existence. In the circumstances, he submitted, it would seem proper for the opposition to proceed in the name of the company, Davy Thornaby Limited.

VII. On 13 August 1984, the Formalities Officer communicated the notice of opposition as an admissible notice of opposition to the Respondents, also sending copies of the representative's letter and of an official communication, also of the 13 August 1984, addressed to the representative, which observed: "it is not quite clear if you want the opponent's name in this proceedings to be changed into the corporation's name : Davy Thornaby Ltd. If it is correct that under the concerned national law a corporation could handle legally under its division's name no change of our records are necessary. Then Davy Thornaby Ltd. is the legal authority but acting under the division's name".

VIII. By letter dated 5 September 1984, the representative replied that he did request a change of the EPO's records. The reason given was that "Grosvenor Tunnelling International Limited "(sic)" became a division of Davy Thornaby Limited on 2nd July 1984". In reply, by a communication dated 17 September 1984, the Formalities Officer asked for the filing of evidence. In the course of a telephone conversation on 24 September 1984, the Formalities Officer pointed out that substitution of opponents was not permitted. In response, by letter dated 17 October 1984, the representative stated that "Grosvenor Tunnelling International and Davy Thornaby Limited are the same entity and were so when the opposition was filed, one being merely a part of the other". In an accompanying affidavit, the company secretary of Davy Thornaby Limited confirmed that "Grosvenor Tunnelling International was ..... a division or part of Davy Thornaby Limited" and "had no legal status independently of Davy Thornaby Limited". He (confusingly) added that GTI was entitled to trade in the name of Davy Thornaby Limited - the converse being clearly

correct - and (even more confusingly) that the opposition has been filed "nominally" by Grosvenor Tunnelling International but "on behalf of" and "with the knowledge and the wish of" Davy Thornaby Limited.

- IX. By a communication dated 24 October 1984, the Formalities Officer informed the parties that the change of name had been recorded.
- X. In a letter dated 26 February 1985, the Respondents made observations concerning the validity of the opposition and requested that if the European Patent Office considered the opposition to be valid then at least documents should be filed showing that it is possible in Great Britain for a body not having independent corporate existence to file a valid opposition and that the documents should be brought to the attention of the patentee. In a reply filed on 17 May 1985 the Appellants' representative objected that there was no reason for the opposition to be considered inadmissible.
- XI. In a communication dated 4 September 1985, the Formalities Officer said that it was still not clear what the relationship between Davy Thornaby Limited and GTI was and the communication set a time limit for the filing of further documents.
- XII. By letter dated 12 December 1985, the Respondents asked auxiliarily for oral proceedings and the opportunity to file a counterstatement.
- XIII. By letter dated 7 January 1986, in reply to the communication dated 4 September 1985, the Appellants' present representative attempted to explain the position. He stated that GTI was a division of the company earlier known as Head Wrightson Teesdale Limited. As previously

explained by the company secretary in his affidavit, Head Wrightson Teesdale Limited had changed its name to Davy Thornaby Limited so it was therefore also correct to say that GTI was a division of Davy Thornaby Limited. Thus there has never been any change of opponent. Correction of the notice of opposition was requested under either Rule 88 EPC or Rule 56(2) EPC.

- XIV. After further exchanges of correspondence on matters which do not affect the present decision, on 11 March 1986, the Formalities Officer issued the Decision under appeal in which he held that the Appellants' request that the name of the opponent be changed to that of Davy Thornaby Limited was rejected and that the notice of opposition was rejected as inadmissible under Rule 56(1) EPC on the ground of lack of identification of the opponent within the period for filing a notice of opposition.

In the Reasons for the Decision, the Formalities Officer observed that the change of name of Head Wrightson Teesdale Limited to Davy Thornaby Limited was an added complication but was not actually relevant to the question of admissibility of the opposition. At the date of expiry of the period for filing a notice of opposition, the only name and address before the European Patent Office was an inaccurate designation of "a trading style ....which never became a legal entity". It was therefore impossible to see that GTI could constitute "any person" within the meaning of Article 99(1) EPC.

The Office had to deem a body to be equivalent to a legal person when the evidence presented indicated otherwise. If GTI did not possess legal personality and the capacity to enter into transactions, then there was no valid notice of opposition at the date of expiry of the period for filing a notice of opposition. It was accordingly not possible to

make good this essential defect by subsequently showing that the name in which the opposition was filed was a trading style or division which belonged to "another party" which could have filed a valid opposition. Reliance was placed on the Decision of Technical Board of Appeal 3.3.1 of 18 December 1985 in Case T 25/85, a copy of which was annexed to the Formalities Officer's decision, in support of the proposition that the identity of an opponent must be known before the opposition period expires. Furthermore, in accordance with a published decision of an Opposition Division (OJ EPO 1986, 56) a switch from an inadmissible to an admissible opponent would be in conflict with Rule 56(1) EPC. Accordingly, neither Rule 56(2) EPC nor Rule 88 EPC could be relied upon by the opponent and the notice of opposition had to be rejected as inadmissible under Rule 56(1) EPC.

- XV. On 9 May 1986, the Appellants filed notice of appeal against the Decision. The appeal fee was duly paid. In the Grounds of Appeal filed on 8 July 1986, it was contended that the error in naming the opponent which existed on the record at the expiry of the opposition period could be corrected under Rule 56(2) EPC. The decision under appeal proceeded on the incorrect basis that the opponent had not been named whereas the name had been given but not in the form required by Rule 26(2)(c) EPC. The practice of using trade names which were not the correct legal title of a company was well established in the United Kingdom and recognised in legislation (copies of which were supplied, as noted in para. II above). The entity carrying on the business under such names was the company and acts done under such names were in law, those of the company.



There was no analogy between the present case and other cases in which no opponent had been named at all. The difficulty in the present case arose only from the fact that "Grosvenor Tunnelling International" could not be said to be the "official designation" of Davy Thornaby Limited within the meaning of Rule 26(2)(c) EPC as was required for compliance with Rule 55(a) EPC. Furthermore, since the Formalities Officer had already decided to permit the change of name (cf. para. IX above) he could not subsequently refuse to do so. The Appellants put forward detailed criticisms of the Decision under appeal and requested the setting aside of the Decision and remittal of the case to the Opposition Division for further consideration.

XVI. On 2 December 1986, the Respondents filed observations in reply, contending that the decision in Case T 25/85 was relevant; that the evidence filed was unclear and that the legal rights of both parties should be properly considered.

#### Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. Both the Formalities Officer and the Respondents have had difficulties in understanding the facts and the legal situation in this case, due to the undoubtedly confusing statements which have been made on behalf of the Appellants from time to time (cf. in particular para. VIII above). Nevertheless, when all the evidence is considered, the Board finds that the following facts and matters are clearly established:

- (1) The notice of opposition was filed on behalf of the Appellants, a British company, and not on behalf of any other legal or natural person, let alone any body alleged to be equivalent to a legal person.
  - (2) At the time it was filed, the Appellants were openly and lawfully trading as GTI from the address given in the notice of opposition. Consequently, the Appellants were at least identifiable on the basis of the information given in the notice of opposition.
  - (3) The failure to name the Appellants by their correct "official designation" in the notice of opposition was due entirely to the unintentional mistake of the professional representative concerned.
  - (4) He acted promptly to correct the mistake as soon as he became aware of it, even though some of the statements he subsequently made or relied upon were in themselves confusing.
3. Having regard to these facts and matters, it was not justified for the Formalities Officer to find:
- (1) that it was "impossible" to see that GTI could constitute a "person" within the meaning of Article 99(1) EPC;
  - (2) that the Office had to deem a body to be equivalent to a legal person when the evidence presented indicated otherwise;
  - (3) that if GTI did not possess legal personality and the capacity to enter into transactions there was no valid notice of opposition at the expiry of the opposition period;

(4) that there was thus an essential defect which could not be made good by subsequently showing that the name in which the opposition was filed was a trading style or division which belonged to another party which could have filed a valid opposition.

4. For his understanding of the relevant law, the Formalities Officer relied upon a decision of a Technical Board of Appeal in Case T 25/85 (OJ EPO 1986, 81) and upon an earlier decision of an Opposition Division (OJ EPO 1986, 56), in support of his rejection of the present opposition as inadmissible. Both decisions were expressed in rather broad terms and, in consequence, the Formalities Officer failed to appreciate that the present case was clearly distinguishable from them. They were both cases in which the identity of an opponent was deliberately concealed from the European Patent Office until after the period for opposition had expired. Deliberate concealment of an opponent's identity, as a result of which it is impossible for the Office to check the admissibility of an opposition, must be regarded as an intentional non-compliance with Rule 55(a) EPC. Such deliberate concealment cannot be corrected as a "mistake" under Rule 88 EPC at any time. A mistake may be said to exist in a document filed with the European Patent Office if it does not express the true intention of the person on whose behalf it was filed. (Case J 08/80, OJ EPO 1980, 293 at 296: para. 4 of the Reasons for the Decision). The true intention of a person who files or authorises a representative to file an anonymous opposition is to be anonymous. If he acts in such a way, he must take the consequences.

5. However, the situation is quite different if the opponent is not correctly identified in the notice of opposition, owing to a genuine mistake. In the present case, it can be deduced from all the circumstances that the true intention of the Appellants was that an opposition should be filed openly in their name. Their representative made a mistake when he attempted to carry their intention into effect. In principle, such a mistake can be corrected under Rule 88 EPC even after expiry of the opposition period, because the correction of a mistake in a document always has retrospective effect (cf. Case J 04/85, OJ EPO 1986, 205: para. 13 of the Reasons for the Decision). Once corrected, the notice of opposition is deemed to have been in its corrected form before the opposition period expired. It follows that, in such circumstances, it is possible for the Office to check the admissibility of the opposition on the basis of the corrected notice. Thus there is no reason why the opposition in question should be rejected. On the contrary, the Enlarged Board of Appeal (Case Gr 01/84, "Opposition by proprietor/MOBIL OIL", OJ EPO 1985, 299 at 303) has drawn attention to the "fundamental principle" to be deduced from the EPC provisions relating to opposition, namely that only valid patents should be maintained in force so far as it lies within the power of the European Patent Office to achieve this and that "it can be deduced that, except in cases of manifest abuse of procedure, the overwhelming public interest lies in each opposition being examined on its merits".
6. The Board has also taken account of a decision of Technical Board of Appeal 3.3.2 dated 21 January 1987 in Case T 222/85 "Inadmissible/PPG" (at present published only in (1987) 2EPOR 99) in which an opposition was held to be inadmissible as the notice of opposition failed to set forth any sufficient indication of the relevant facts, evidence and argument relied upon by the opponent. That

decision distinguished the substantive requirements of Rule 55(c) from the formal requirements of Rule 55(a) EPC (para. 4 of the Reasons for the Decision). It pointed out that oppositions must be filed and pursued in good faith so as to avoid procrastination and uncertainty. In the present case, there can be no doubt as to the good faith of the Appellants.

7. In its decision in Case T 25/85 (OJ EPO 1986, 81 at 87: cf. para. 12 of the Reasons for the Decision) the Technical Board of Appeal 3.3.1 expressed the opinion that Rule 56(2) EPC is "*lex specialis*" in respect of Rule 88 EPC. The Board considered that Rules 55(a) and 56(2) EPC allowed correction of the notice of opposition after expiry of the opposition period only to the extent of correcting information concerning the opponent but did not allow his subsequent naming.
8. The present case is one which could have been dealt with under Rule 56(2) EPC if the Formalities Officer had issued an invitation to remedy deficiencies within a period specified by him but he did not, obviously because the Appellant's representative took the initiative, requested correction and provided evidence in support of his request. The Board considers that, in the circumstances, no objection to correction based on Rule 88 EPC can be grounded upon any observations made in Case T 25/85. The substance of the correction is clearly within the scope of what Technical Board of Appeal 3.3.1 considered to be allowable. It is not necessary for the purposes of the present case to decide what would be the position if by mistake no opponent was named at all. As pointed out earlier, this was not the position either in Case T 25/85, where there was a deliberate omission. Thus the observations of Technical Board of Appeal 3.3.1 regarding Rule 88 EPC, which are summarised in the preceding

paragraph, were strictly obiter dicta. It cannot be considered as finally decided that Rule 56(2) EPC is a "lex specialis" in respect of Rule 88 EPC. The better view may be that of the Legal Board of Appeal in Case J 04/85 (loc.cit.), which is that the provisions of Rule 88 EPC are of general application and that other Rules relating to the remedying of deficiencies are simply complementary to that Rule. It has to be remembered that an invitation to remedy deficiencies merely has to be responded to, whereas correction of a mistake may involve proving that a mistake was made, what it was and what the correction should be (cf. Case J 08/80, cited in para. 4 above).

9. For the foregoing reasons, the appeal must be allowed.
  
10. Although the appeal is allowed, the Board does not consider that there has been any substantial procedural violation such that reimbursement of the appeal fee might be ordered in accordance with Rule 67 EPC.

#### Order

For these reasons, it is decided that:

1. The Decision of the Formalities Officer acting for Directorate General 2 dated 11 March 1986 is set aside.
  
2. The Notice of Opposition filed in these proceedings is to be corrected under Rule 88 EPC so that the name of the opponent is "Davy Thornaby Limited" and the correct full postal address of the registered office of that company is given as the address of the opponent.
  
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar

The Chairman

02068 B. A. Norman

C Maus