BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

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D E C I S I O N
of 23 June 1999

Case Number: T 0938/94 - 3.3.4

Application Number: 89100852.6

Publication Number: 0326014

IPC: A61K 37/02

Language of the proceedings: EN

Title of invention:
Composition of anticoagulants

Applicant:
HOECHST JAPAN LIMITED

Opponent:
-

Headword:
Composition/HOECHST JAPAN

Relevant legal provisions:
EPC R. 64(a), (b), 65(2), 78(3)

Keyword:
"Admissibility of appeal (no)"

Decisions cited:
T 0483/90

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0938/94 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 23 June 1999

Appellant: (Patentee)
HOECHST JAPAN LIMITED
Corporate Center,
Intellectual Property Office
New Hoechst Building
10-16, 8-chome, Akasaka
Minato-ku, Tokio (107) (JP)

Representative:
Lauppe, H.F. Dr.
Behringwerke AG
Patentabteilung
Postfach 1140
D-35001 Marburg (DE)

Respondent: (Opponent)
IMMUNO AG
Industriestrasse 67
A-1221 Wien (AT)

Representative:
Stein-Dräger, Christiane, Dr., Dipl.-Chem.,
Hoffmann Eitle,
Patent- und Rechtsanwälte,
Postfach 81 04 20
D-81904 München (DE)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 13 October 1994 revoking European patent No. 326 014 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairwoman: U. Kinkeldey
Members: R. E. Gramaglia
S. C. Perryman

Summary of Facts and Submissions

I. European patent No. 0 326 014 (application No. 89 100 852.6), relating to a composition of anticoagulants, was granted on the basis of 3 claims.

II. Notice of opposition was filed by the respondents (opponents). Revocation of the patent in its entirety was requested on the grounds of lack of novelty and of inventive step.

III. By a decision dated 20 September 1994 with written reasons posted 13 October 1994, the Opposition Division revoked the patent for lack of inventive step. The decision was based on claim 1 as amended during the opposition procedure.

IV. A Notice of Appeal against this decision was filed on 13 December 1994, signed by a representative, and an indication that correspondence should be sent to Behringwerke Aktiengesellschaft, Patentabteilung, Postfach 1140, 35001 Marburg. The Notice did not contain the name and address of the appellant.

V. The board sent a communication, dated 16 January 1995, stating that the Notice of Appeal failed to comply with Rule 64(a) EPC, and that pursuant to Rule 65(2) EPC, the appellant was requested to provide the necessary information within two months of the receipt of the communication.

VI. Grounds of Appeal were filed on 20 February 1995. These did not give the name and address of the appellant.

VII. By fax dated 25 April 1995 it was stated that the address of the appellant was ("die Anschrift der Beschwerdeführerin lautet"):

Hoechst Japan Limited
Corporate Center,
Intellectual Property Office
New Hoechst Building
10-16, 8-chome, Akasaka
Minato-ku, Tokio (107)
Japan

VIII. The respondents (opponents) filed counterarguments. They submitted that as the name and address of the appellant had only been supplied outside the time limit set by the Board in its invitation under Rule 65(2) EPC first sentence for providing the information required by Rule 64(a) EPC, then by Rule 65(2) EPC last sentence the Board of Appeal should reject the appeal as inadmissible.

IX. The board sent a communication accompanying the summons to oral proceedings, indicating its provisional view. On the question of admissibility it stated that on the issue of whether the requirements of Rule 64(a) EPC had been met, two views appeared possible. Firstly the strict view, namely that as the name and address of the Appellant were not explicitly stated in the Notice of Appeal and were not furnished within the set time limit pursuant to Rule 65(2) EPC first sentence, the appeal should be rejected as inadmissible. Secondly, the generous view, by analogy to the situation in T 483/90, wherein the Board concluded that the Appellants were sufficiently identified despite the name being wrong and the address being misleading. In the present case,

too, these deficiencies might be considered as remedied by the presence in the notice of appeal of the number of the contested patent and the name and address of one professional representative belonging to the patent department of Behringwerke AG which had acted for the patentee in the opposition proceedings.

The board also indicated doubts as to whether the claims on file satisfied the substantive requirements of the EPC.

X. With the submission of 25 May 1999, the appellant filed an Auxiliary Claim Request, and arguments on the substantive issues, but no comments on the issue of admissibility. It also indicated that it would not attend the oral proceedings and withdrew its request for these.

XI. Oral proceedings took place on 23 June 1999, at which no representative appeared for the appellant.

The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request (claims before the opposition division) or the auxiliary request.

The respondents (opponents) requested that the appeal be declared inadmissible or that the appeal be dismissed.

Reasons for the Decision

Admissibility of the Appeal

1. The appellant has not disputed that its name and address were not stated in the Notice of Appeal, nor that it failed to give this information within the time limit set by the invitation pursuant to Rule 65(2) EPC first sentence to provide this information. The notification of the Board of 16 January 1995 was sent by registered letter. Rule 78(3) EPC provides that where notification is effected by registered letter, this shall be deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be. Here there is no dispute, so the notification must be deemed to have been received by 23 January 1995, making the two month time limit set expire on 23 March 1995. Thus the provision of the name and address on 25 April 1995 was out of time.

2. In these circumstances the Board has no choice but to reject the appeal as inadmissible as laid down in Rule 65(2) EPC second sentence: to do anything else would not be applying the European Patent Convention.

3. The requirements of Rule 64(a) EPC merely reflect a standard requirement when initiating a legal procedure, such as an appeal, that the name and address of the party initiating the procedure be given, so that it can

be checked that the party is entitled to initiate the procedure, and that the party is clearly identified should, for example, the procedure result in an order for costs being made against it. Initiation of such procedure is also a suitable time for those acting on behalf of the party to check that it is identified by its correct current name and address. While usually the name and address of the party will not have changed, there can be no presumption or implication that this is so. Hence the requirements of Rule 64(a) EPC. The mere failure to give the correct, or any, name and address will not be automatically fatal, as Rule 65(2) EPC first sentence requires that an invitation be issued to remedy any deficiencies noted before the appeal can be rejected as inadmissible. Giving the name and address of a party is not an onerous burden. Even if an appellant fails to do so in the Notice of Appeal, he has the further period required to be set by Rule 65(2) EPC first sentence in which to do so. Someone incapable both of meeting the clearly laid down requirements of Rule 64(a) EPC and of remedying this defect within the set time limit when invited to do so, cannot expect to have a further doctrine invented to excuse his failures.

4. In its second communication (see section IX above) the board suggested that there might be an analogy to case T 483/90 of 14 October 1992. On close analysis of the facts and reasoning of that case, the board comes to the conclusion that the analogy fails, as in that case no invitation pursuant to Rule 65(2) EPC first sentence appears ever to have been issued. Rather the board in that case found that the appellant had been correctly named, and that the incorrect indication of the name of the patentee (not the appellant) and the absence of an

address for the appellant did not make the appeal inadmissible, because the appellant was clearly identified. It does not seem to have been considered whether, in any case for inadmissibility to be found on this ground, a specific invitation to provide the address should not first be sent. Thus the facts of that case differ in so many ways from those of the present case, that no principle can be extracted from it that assists the appellant.

5. Nor can the jurisprudence of the boards on the question of finding the requirement of Rule 64(b) EPC for a statement identifying the extent to which amendment or cancellation of the decision, implicitly satisfied by deducing this extent from the totality of the appellant's submissions, including those in the opposition proceedings, assist the appellant in respect of the requirements of Rule 64(a) EPC. The jurisprudence in respect of the requirements of Rule 64(b) EPC originates from a desire to mitigate the harshness of an absolute, irremediable, requirement as to the contents of the Notice of Appeal. Generous treatment of the failure to meet this requirement thus occurs in very special circumstances. The requirement of Rule 64(a) EPC to give the name and address of the appellant must be treated differently as Rule 65(2) EPC explicitly provides a remedy if this basic information is forgotten.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar: The Chairwoman:

A. Townend U. M. Kinkeldey