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D E C I S I O N
of 18 May 2001

Case Number: T 0656/98 - 3.3.4

Application Number: 87307918.0

Publication Number: 0260105

IPC: C12N9/14

Language of the proceedings: EN

Title of invention:
Preparation of enzymes having altered activity

Patentee:
Genencor International, Inc.

Opponent:
Henkel KGaA
Novozymes A/S
Unilever N.V.

Headword:
Non-party appellant/GENENCOR

Relevant legal provisions:
EPC Art. 106, 107, 108, 110, 112(1), 114(1)
EPC Rules 20(3), 61, 64, 65, 66, 88

Keyword:
"Transferee entitled to appeal before registration -(no)"
"Appeal validated by recordal outside appeal period-(no)"
"Correction under Rule 88 EPC -(no)"
"Rule 65(2) applicable -(no)"
"Appeal admissible-(no)"

Decisions cited:

G 0004/88, J 0007/80, J 0016/96, T 0675/93, T 0001/97

Headnote:
For a transferee of a patent to be entitled to appeal, the necessary documents establishing the transfer, the transfer application and the transfer fee pursuant to Rule 20 EPC must be filed before the expiry of the period for appeal under Article 108 EPC. Later recordal of the transfer does not retroactively validate the appeal.

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Case Number: T 0656/98 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 18 May 2001

Appellant: (Patentee)
Genencor International, Inc.
925 Page Mill Road
Palo Alto, California 94304-1013 (US)

Representative:
Armitage, Ian Michael
Mewburn Ellis
York House
23 Kingsway
London WC2B 6HP (GB)

Respondent I: (Opponent 02)
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Henkelstrasse 67
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Respondent II: (Opponent 03)
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Representative:
Bassett, Richard Simon
Eric Potter Clarkson,
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58 The Ropewalk
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Respondent III: (Opponent 04)
Unilever N.V.
Weena 455
NL-3013 AL Rotterdam (NL)

Representative:
Kan, Jacob Hendrik, Dr.
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Patent Division
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 20 April 1998 revoking European patent No. 0 260 105 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairwoman: U. M. Kinkeldey
Members: S. C. Perryman
L. Galligani

Summary of Facts and Submissions

I. European Patent 260 105 was revoked by a decision of the Opposition Division announced at oral proceedings on 2 July 1997 with the written reasons posted on 20 April 1998, on the grounds that none of the requests put forward were found to meet the requirements of the European Patent Convention.

II. The parties notified of the decision were:

(1) the then patent proprietor on record at the EPO, Genencor, Inc.;

(2) opponent 02 now respondent I;

(3) then opponent 03 Novo Nordisk A/S;

(4) opponent 04 now respondent III.

Former opponent 01 had withdrawn its opposition prior to the decision under appeal, and thereby ceased to be a party to the opposition proceedings.

III. The representatives on record for the then patent proprietor Genencor, Inc filed on 30 June 1998 a notice of appeal on behalf of:

"The proprietor: Genencor International Inc, of
925 Page Mill Road,
Palo Alto,
CA 94304-1013, USA "

Grounds of appeal were filed on 18 August 1998.

IV. The board issued a communication dated 9 September 1998 querying the fact that the name and address of the proprietor on record at the EPO were not those stated for the appellant, and commenting that if the latter was a different legal entity, then a question arose whether the appeal was filed by a party to the proceedings for the purpose of Article 107 EPC. The appellant's comments were invited.

V. On 16 October 1998 a letter from the representatives of the appellant was filed stating inter alia:

> "...
> You have noted that EP 0260105, the subject of appeal T 656/98 stands in the name of Genencor, Inc, but the appeal was filed in the name of Genencor International, Inc.
>
> This was because EP 0260105 was transferred from Genencor, Inc. to its associated company, Genencor International, Inc., before the appeal was filed.
>
> We assume that we simply need to file an application to register the transfer to Genencor International, Inc. in order to put the record straight..."

VI. A further letter dated 4 November 1998 from the representatives of the appellant (fax copy received 5 November 1998, originals received 6 November 1998) enclosed a certified copy of an assignment of European Patent 0260105 from Genencor, Inc. to Genencor International, Inc. for all designated countries, headed "Effective date 2 January 1997" and signed on behalf of both companies. The letter stated inter alia:

"...
European Patent 0260105 was transferred from Genencor, Inc. to Genencor International, Inc. after the patent was granted and before the Notice of Appeal was filed on 30 June 1998. Since Genencor International, Inc. was proprietor of the European patent as at 30 June 1998, the appeal had to be filed by Genencor International, Inc..
..."

The transfer fee was also paid.

VII. The transfer was recorded by the legal section of the EPO, and notification dated 17 December 1998 sent that the European patent had been transferred to the appellant with effect from 6 November 1998.

VIII. Respondent III filed a submission on 16 January 1999 asking that the appeal be declared inadmissible inter alia on the ground that at the time of filing the appeal the appellant was not a party to the proceedings.

IX. The board issued a communication dated 10 February 1998 referring to Rules 20(3), 61 and 66 EPC, and giving its provisional opinion that the appeal appeared inadmissible as not having been filed by a party to the proceedings as required by Article 107 EPC.

X. Respondent II, Novozymes A/S, was recognized as successor to original Opponent 03, Novo Nordisk A/S, on the basis of evidence provided showing that Novozymes A/S was formed by a demerger from Novo Nordisk A/S approved on 13 November 2000, with all the enzyme business, including the opposition passing to

Novozymes A/S.

XI. Further submissions were made by the parties and oral proceedings took place on 18 May 2001 on the question solely of the admissibility of the appeal, at which oral proceedings all parties were represented.

XII. The arguments in writing, insofar as maintained, and at the oral proceedings on behalf of the appellant can be summarized as follows:

- Since the end of 1990 Genencor, Inc. until it was finally wound up on 9 July 1997 had been a wholly owned subsidiary of Genencor International, Inc., both of them being Delaware corporations. Well before 1997 Genencor, Inc. was no longer trading or active. The two companies would be treated in EU law as a single economic unit.

- In answer to a question from the board, it was also stated that under EU law, it would be possible to enforce an order for costs given in EPO proceedings not only against the proprietor of record, but also against another company considered together with proprietor as a single economic unit.

- Though in name the patentee was Genencor, Inc., representation was by Genencor International, Inc.. For the purpose of Article 107 EPC the party adversely affected was a combination of Genencor, Inc. and Genencor International, Inc.. Already in correspondence long before the appeal, the representative had referred to Genencor International, Inc. as being the proprietor: no

distinction could be made between Genencor, Inc. and Genencor International, Inc., otherwise there would be a mismatch between the real world and how the EPO looked at the position.

- The situation was a classic one for the application of Rule 65(2) EPC. If the name was wrong this provided a safety net as shown by the case T 1/97 Naming of appellant/CROWN CORK of 30 March 1999.

- As a matter of law on the dissolution of Genencor, Inc., Genencor International, Inc. acquired all its assets with immediate effect.

- To interpret Rule 20 EPC relating to registering a transfer of a European patent application and in particular Rule 20(3) EPC stating that "A transfer shall have effect vis-à-vis the European Patent Office only when and to the extent that documents referred to in paragraph 1 have been produced" as requiring that the transfer be produced to the EPO before any action by the transferee could be recognized as validly taken in the proceedings, would be to discriminate unjustifiably between a patentee-appellant on the one hand and an opponent-appellant on the other hand, as Rule 20(3) EPC would not apply to transfers of oppositions.

- Rule 88 EPC would only apply if Rule 65(2) EPC did not apply. The mistake was that the representative believed that the transfer of the patent to Genencor International, Inc. had been properly recorded: this was a mistake of fact, not of law.

- The following questions (as stated in the submission received 18 April 2001 as rearranged and amplified at the oral proceedings) were suggested for referral to the Enlarged Board of Appeal before any question of admissibility was decided adversely to the appellant:

1. - What is the meaning of "party" in Article 107.

   - Does it cover a situation where the appellant is the successor in title to the registered proprietor who was the party to the proceedings but at the time of lodging the Notice of Appeal has not been recorded as such in accordance with Rule 20.

2. - What is the effect(if any) of Rule 20(3) on the provisions of Articles 106 to 108.

   - in particular where the patentee of record transfers his interest in the patent prior to the Notice of Appeal being lodged but the transfer is not recorded until after the due date for lodging the Notice of Appeal

   - does Rule 20(3) prevent the Office from considering facts prior to recording the transfer, in particular the date of transfer and any acts taken by the transferee in the interim to protect the rights of the transferee.

3. - Under what circumstances would the erroneous naming of the proprietor in the Notice of

Appeal constitute a mistake correctable under Rule 88.

- Does Rule 88 apply where there is a discrepancy between the name and address of the registered proprietor and the name and address of the appellant from which it is apparent to the Appeal Board that Article 107 may not have been complied with and where such discrepancy was due to a mistaken belief as to the proper party.

- Does Rule 88 apply where the appellant, as owner, has mistakenly been named in the Notice of Appeal instead of the registered proprietor when the registered proprietor no longer exists.

4. - What is the effect of Rule 65(2).

- Does it apply where (as here) the Technical Board of Appeal has drawn attention (noted and communicated) to the patentee that the appeal does not comply with Rule 64 sub-paragraph (a) in that the name and address of the appellant are not the same as the name and address of the registered proprietor.

- If so does Rule 65(2) override Rule 65(1) regarding compliance with Article 107 and as to whether the incorrectly naming of the appellant can be remedied under the provisions of Rule 65(2).

XIII. The arguments of the respondents were inter alia that:

- Article 107 EPC required an appellant to fulfill two separate requirements:

  (1) to show his status as a party in the proceedings which led to the decision under appeal; and

  (2) to show adverse effect.

- No-one could act in proceedings unless he was of record as a party, or had been recorded, on adequate evidence, as the successor to a previous party on record.

- Being adversely affected in some general economic sense did not confer the status of a party.

- Decision G 4/88 (OJ EPO 1989, 480) showed that the status of opponent could only be transferred subject to stringent conditions: there was no discrimination in requiring that Rule 20(3) EPC be complied with before someone could be recognized as the successor to the original patent proprietor; any difficulties could be avoided by registering the assignment at the EPO.

- The existence of an unregistered assignment was not to be taken into account for the purpose of determining who was a party entitled to appeal, see T 675/93 of 16 September 1997.

- The purported appeal did comply with the requirement of Rule 64(a)EPC of containing the

name and address of the appellant: there was thus no scope for the application of Rule 65(2) EPC.

- No correctable mistake had been shown - the firm intention was to file an appeal in the name of Genencor International, Inc..

XIV. The appellant (patentee) requested that the decision under appeal be set aside and as main request that the appeal be declared admissible and that the proceedings be continued in writing and as auxiliary request that the questions suggested in the annexe to the submissions of 11 April 2001 as amplified by the sheet submitted at the oral proceedings on 18 May 2001 be referred to the Enlarged Board of Appeal.

The respondents (opponents) requested that the appeal be rejected as inadmissible.

Reasons for the Decision

1. *Article 107 EPC*

1.1 Article 107 EPC is concerned with those entitled to appeal and to be parties to appeal proceedings. It must be possible to determine these precisely and easily if the appeal process is not to be tangled up already at the outset in complicated investigations as to the relations between the original parties and later would-be parties and would-be appellants. This makes the only sensible interpretation of "party" in Article 107 EPC one limited to the parties of record in the first instance proceedings which led to the decision under

appeal and their duly recorded successors.

1.2 This meaning of "party" in Article 107 EPC appears more clearly from the French and German texts, than the English text, as the former explicitly refer to a party to the proceedings which led to the decision under appeal. In accordance with general procedural principles "party" will also cover someone who has completed all the formalities necessary to be recognized as the legal successor of a party in the first instance proceedings or to be recognized by the tribunal concerned as a new party to the proceedings. In the case of a patent proprietor the rules for recognizing a successor are laid down by Rule 20 EPC. The only provision in the EPC for joining as a new party is Article 105 EPC, but this is not relevant here.

1.3 The need for interpreting "party" in Article 107 EPC as being confined to the parties of record and their duly recorded successors, also emerges from the fact that the EPO has no jurisdiction to decide disputes as to the right to a patent but must by Article 60(3) EPC recognize the applicant as entitled to exercise the right to the European patent, unless there is a decision by a competent national court in accordance with the Protocol on Jurisdiction and the Recognition of Decisions in Respect of the Right to the Grant of a European patent.

1.4 Consideration of what might be recognized under EU law as "economic units" associated with a party of record, seems wholly outside any remit given to the European Patent Office. Nor can any genuine need for such a wide interpretation of "party" be seen. If someone entitled

under some agreement to become the registered proprietor, is incapable of fulfilling the simple requirements of Rule 20 EPC in time to preserve all his rights, then he must bear the consequences. No good reason can be seen for involving the EPO or the other parties is a roving enquiry as to what "economic units" might justify party status. A departure from strict compliance with the formal requirements of Rule 20 EPC would leave no clearly defined limit on who might not also be considered a party.

2. *Question 1 to the Enlarged Board of Appeal*

2.1 To the board the answer to suggested Question 1 for the Enlarged Board of Appeal is thus clear on the wording of the EPC: "party" in Article 107 EPC does not include someone who is neither the proprietor of record, nor has filed the necessary documents (and paid the fee) to be recorded as successor under the provisions of Rule 20 EPC. There are no cases contradicting this view, and as the meaning is clear the point cannot be considered an important point of law needing a reference.

3. *Articles 107 and 108 EPC, Rules 20, 61 and 66 EPC*

3.1 Rule 20(3) EPC provides that

"A transfer shall have effect vis-à-vis the European Patent Office only when and to the extent that the documents referred to in paragraph 1 have been produced."

3.2 Rule 61 EPC headed 'Transfer of the European patent' reads:

"Rule 20 shall apply mutatis mutandis to any transfer of the European patent made during the opposition period or during opposition proceedings."

3.3 Rule 66(1) EPC headed 'Examination of Appeals' reads:

"Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings mutatis mutandis."

3.4 The purpose of Rule 20 EPC is to ensure that transfers have to be produced to the EPO (and the relevant administrative fee paid) before the EPO is obliged or entitled to take note of such transfer. The procedure is particularly simple and easy to comply with, rather more so than most procedures for recording assignments in national patent offices. The wording is clear and by virtue of Rules 61 and 66 also mandatory in appeal proceedings. Merely because the requirement is so simple to comply with, is no reason to ignore it.

3.5 That the text of an assignment refers to an effective date, can only be a reference to that date being effective as between the parties to the assignment. It cannot be the date at which the transfer is effective vis-à-vis the European Patent Office, as this would be in direct contradiction of the express wording of Rule 20(3) EPC. Taking as effective date vis-à-vis the European Patent Office an earlier "effective date" recited in the assignment document might retrospectively throw in doubt whether procedural steps taken after the "effective date" stated in the assignment document but before its submission to the European Patent Office were validly taken. The

possibility of as yet unsubmitted assignments being retrospectively effective, would mean that there would be no certainty that the EPO was dealing with the correct "proprietor". Further problems might arise for the EPO if an assignment containing an earlier "effective date" were not submitted until after recordal of an assignment document stating a later "effective date". All these problems are avoided by taking Rule 20(3) EPC at face value, which is the interpretation adopted by the board.

3.6 The effective date of transfer to Genencor International, Inc. being thus the date of recordal of the assignment, which falls outside the period for filing the notice of appeal as laid down in Article 108 EPC, prima facie no appeal has been filed by a party to the proceedings which led to the decision under appeal, within the period for filing an appeal laid down by Article 108 EPC. Thus under Rule 65(1) EPC the appeal must be rejected as inadmissible.

4. *Question 2 to the Enlarged Board of Appeal*

4.1 For the reasons given above, the answer to proposed Question 2 for referral to the Enlarged Board of Appeal is clear and no reference is necessary. The combined effect of Articles 107 and 108 EPC requires the notice of appeal to be filed within two months of the date of notification of the decision appealed from by a party to the proceedings. Someone not a party to the proceedings cannot file a valid appeal, and Rule 20(3) EPC prevents retroactive validation of the appeal if the necessary documents have not been produced to the EPO until after the expiry of the appeal period. That the transfer document may state an earlier date as

being the effective date of the transfer as between the transferor and the transferee is irrelevant: the important date is the date of production to the European Patent Office of documents satisfying it that the transfer has taken place.

4.2 The arguments of the appellant that "party" in Article 107 EPC should be given some extended meaning, whether under EU law or otherwise, would be to bypass the requirements of Rule 20(3) EPC. To argue for including as "parties" persons not already on record at the EPO, including in particular unrecorded assignees, ignores that this would convert a part of simple check on admissibility, required under Article 110 EPC as a preliminary step in every appeal, into possibly complicated investigation as to what economic relations or unrecorded assignments the proprietor of the patent, as on record at the EPO, had entered into. The board can see no reason why the drafters of the EPC should have contemplated such investigations, rather than the simple check needed if Rule 20(3) EPC is taken at face value.

4.3 By decision G 4/88 (supra) assignments of oppositions are only possible in restricted circumstances: that different conditions are imposed on opponents and patentees when assigning their status as parties does not seem to amount to any sort of unjustifiable discrimination. Patents can be assigned much more freely than oppositions, subject only to the formalities of Rule 20 EPC being complied with.

5. *Rule 88 EPC*

5.1 The letters received 16 October and 5 November 1998

from the appellant's representatives, written after receipt of the board's communication that the name of the appellant is different from that of the proprietor on record, can only be taken as confirming that it was the intention to state the name and address of Genencor International Inc as appellant in the notice of appeal. The board is unable to see here a mistake of fact, which might make the naming of someone not on record correctable under Rule 88 EPC.

5.2 The difference to the situation in J 7/80 (OJ EPO 1981, 137) is not one of law but one of fact. The board deciding that case was able on the evidence before it to find that there had been an error in identifying the correct applicant and its nationality, so that correction under Rule 88 EPC was allowed.

6. *Question 3 to the Enlarged Board of Appeal*

6.1 On the facts, the notice of appeal reflects what the representatives intended to say, as confirmed by communications from the representatives received 16 October and 5 November 1998. The board thus sees no factual basis for referring the first part of the suggested question on Rule 88 EPC.

6.2 On the second part of the suggested question on Rule 88 EPC again no need for a reference is seen. What might or might not be apparent to the Appeal Board seems irrelevant when considering a notice of appeal: only for a correction concerning a description, claims or drawings would it be relevant whether the correction was obvious or not. On the facts the board can only see a mistake of law as to who was entitled to appeal, which is not correctable under Rule 88 EPC.

6.3 On the third part of the suggested question on Rule 88 EPC, there is no evidence that the registered proprietor did not exist at the time of appeal (see below points 9.1 to 9.3), so the suggested question is irrelevant. The appellant did not ask for time to file some evidence to try and substantiate this submission.

6.4 Thus no question of law concerning Rule 88 EPC arises that can be regarded as needing an answer from the Enlarged Board of Appeal pursuant to Article 112(1) EPC.

7. *Rules 64 and 65 EPC*

7.1 The notice of appeal did comply with the requirements of Rule 64(a) EPC that the name and address of the appellant be stated. Accordingly, there was no basis for an invitation by the board to remedy any deficiency as referred to in Rule 65 EPC: there was no deficiency.

7.2 The communication of 9 September 1998 was sent to query the discrepancy between the name and address of the proprietor on record, and the stated name of the proprietor and appellant in the Notice of Appeal. What might have happened if the response had been that a mistake had been made, and the appeal was meant to be filed in the name of the then registered proprietor can remain a conjecture: no such response was made. Instead by two letters dated 16 October and 4 November 1998 it was confirmed that the appeal was deliberately in the name of Genencor International, Inc., and an assignment from Genencor, Inc. to Genencor International, Inc. was filed.

7.3 No room is seen here for any application of Rule 65(2)

EPC to make the appeal admissible.

8. *Question 4 to the Enlarged Board of Appeal*

8.1 On the facts here as there was no case for applying Rule 65(2) EPC, the questions concerning this rule are irrelevant and no reference is required.

9. *Succession other than by way of transfer*

9.1 The board understood that it was also being submitted that at the time of the appeal Genencor, Inc. did not exist anymore, and that as a matter of law on the dissolution of Genencor, Inc., Genencor International, Inc. acquired all its assets with immediate effect. No documentary evidence relating to the dissolution of Genencor, Inc. was submitted, nor was any evidence relating to Delaware corporation law produced. Laws of states other than those of the member states of the European Patent Convention are to be treated as matters of facts on which evidence should be provided. If by its submissions, the appellant intended to show that the patent became vested in it other than by transfer, so that Rule 20 EPC would not apply, then not only is any evidence for this lacking, but the submission is also in contradiction to the appellant's reliance on an assignment as evidence of its entitlement.

9.2 Pursuant to Article 114(1) EPC, the European Patent Office has the power to examine the facts of its own motion and shall not be restricted to the facts produced by the parties. Accordingly for lack of any evidence, the board checked on the information available on the Internet on the Delaware Code, the relevant portion appearing to be Title 8 Corporations.

If as submitted by the appellant, Genencor, Inc. was dissolved, then § 278 and 281 of this title do not appear to provide any support for Genencor, Inc. not existing for any purpose at the time of appeal, or for its property vesting as a matter of law in Genencor International, Inc. even if the latter is the sole shareholder. The apparently relevant parts of the Delaware Code, Title 8 Corporations found by the board and put to the parties at oral proceedings read:

> "§ 278. Continuation of corporation after dissolution for purposes of suit and winding up affairs
>
> All corporations, whether they expire by their own limitation or are otherwise dissolved, shall nevertheless be continued, for the term of 3 years from such expiration or dissolution or for such longer period as the Court of Chancery shall in its discretion direct, bodies corporate for the purpose of prosecuting and defending suits, whether civil criminal or administrative, by or against them, and of enabling them gradually to settle and close their business, to dispose and convey their property, to discharge liabilities and to distribute to their stockholders any remaining assets, but not for the purpose of continuing the business for which the corporation was organized. With respect to any action, suit or proceeding begun by or against the corporation either prior to or within 3 years after the date of its expiration or dissolution, the action shall not abate by reason of the dissolution of the corporation; the corporation shall, solely for the purpose of such action suit or proceeding, be

continued as a body corporate beyond the 3-year period and until any judgements, orders or decrees therein shall be fully executed, without the necessity for any special direction by the Court of Chancery.

§ 281. Payment and distribution to claimants and stockholders.

(a) A dissolved corporation or successor entity which had followed the procedures described in § 280 of this title:

(1) Shall pay the claims made and not rejected in accordance with § 280(a) of this title,

(2) Shall post the security offered and not rejected pursuant to § 280(b) of this title,

(3) Shall post any security ordered the Court of Chancery in any proceeding under § 280(b) of this title, and

(4) Shall pay or make provision for all other claims that are mature, known and uncontested or that have been finally determined to be owing by the corporation or such successor entity.

Such claims or obligations shall be paid in full and any such provision for payment shall be made in full if there are sufficient assets. If there are insufficient assets, such claims and obligations shall be paid or provided for according to their priority, and among claims of equal priority, ratably to the extent of the assets legally available therefor. Any remaining assets shall be distributed to the

> stockholders of the dissolved corporation, provided, however, that such distribution shall not be made before the expiration of 150 days from the date of the last notice of rejections given pursuant to § 280(a)(3) of this title. In the absence of actual fraud, the judgment of the directors of the dissolved corporation or the governing persons of such successor entity as to the provision made for the payment of all obligations under paragraph (4) of this subsection shall be conclusive.
> (b) ....."

9.3 From this it does not appear that Genencor, Inc. ceased to exist for all purposes on dissolution, nor that Genencor International, Inc. would immediately be entitled to Genencor, Inc.'s assets as a matter of law.

9.4 The appellant has not submitted that it became successor as a matter of law by merging into itself its wholly owned subsidiary Genencor, Inc. pursuant to § 253 of the Delaware Code Title 8, so this cannot be presumed to apply.

9.5 The only comment made by counsel for the appellant was that the board's investigations had not produced the correct part of the Delaware Code. Whether this is so or not, the board is left with no facts on which to base a finding in favour of the admissibility of the appeal on this line of argument.

10. *Principle of protection of legitimate expectations*

10.1 The EPO has recognized, pursuant to a principle well established in European Community law, that measures

taken by the EPO should not violate the legitimate expectations of its users. The appellant has referred to the fact that the representatives acting for the proprietor already before 1997 referred to Genencor International, Inc. as the proprietor of the patent in suit. Indeed, in the opposition file there appears in December 1996, a change of heading in the representatives' letters from Genencor, Inc. to Genencor International, Inc.. The EPO however in all its correspondence continued to refer to the proprietor as Genencor, Inc..

10.2 If the attention of the EPO had been drawn to the fact that the proprietor had changed, or that the representative was now acting for someone else, the board might have felt it necessary to consider whether under the above doctrine, because the EPO had not drawn attention to the requirements of Rule 20 EPC, a case could be made out for a legal fiction under which the transfer could be deemed filed in time.

10.3 However, the EPO cannot be deemed to take on the burden of spotting every possible action that a proprietor or unrecorded transferee should take in his own interest. A different name does not necessarily involve a change of proprietor. The proprietor or transferee is in a position to know what has happened, and it is well known in the patents field that not recording transfers may have consequences.

10.4 The submission was made that not considering Genencor, Inc. and Genencor International, Inc. as one entity, either of whom could in its own name take any necessary procedural steps irrespective of the provisions of the EPC, would lead to a mismatch between the "real world"

and how the EPO looked at the position. However, formalities for registering the changes in the ownership of what may be valuable property, a patent, are part of the "real world". The patent here remained in the name of the original patentee for years when the latter was a mere husk operated by the appellant, for whatever reasons they chose to proceed in this manner. A mismatch with reality lay also in this conduct, which had some inherent risks. The board cannot here see any case that the EPO by its conduct raised any legitimate expectation that the appeal could be filed in the name of an unrecorded transferee.

11. *No general power to accept change of party*

11.1 In decision J 16/96 (OJ EPO 1998, 347) concerning an application to register an association of representatives, the legal board of appeal allowed a request for a change of party in ex parte appeal proceedings as there such change was procedurally convenient. In that case, however, there were no provisions of the EPC, such as Rule 20 EPC, preventing retroactive recognition of a change of party, and procedurally the change of party was more convenient for the parties and the EPO than requiring a further application to be filed by the correct parties. No general power of the boards of appeal to consider, and where appropriate allow, requests for a retrospective change of a party can be deduced from this in a situation, such as here with Rule 20 EPC, where a specific provision of the EPC forbids retrospective recognition.

12. *Referral in general*

12.1 For a reference to be made to the Enlarged Board of Appeal, Article 112(1) EPC requires that it be referred to ensure uniform application of the law or because an important point of law arises.

12.2 The board considers that insofar as questions of law arise on facts established in this case, the view taken by the board is in accordance with the clear and explicit wording of the Articles and Rules concerned. There is no conflicting case law. Thus no questions of law require to be referred to the Enlarged Board of Appeal.

12.3 This case shows the importance of proprietors and their representatives taking steps to record transfers as soon as possible after these have occurred, to prevent situations such as in the present case becoming frequent. The number of changes of proprietor occurring as a result of sales of part of businesses, mergers and demergers has increased to such an extent that problems are now frequently encountered, and proceedings delayed, and without reasonably prompt recordal of transfers other cases where the right to file an appeal is lost may well occur.

Order

For these reasons it is decided that:

1. The request for referral of questions to the Enlarged Board of Appeal is refused.

2. The appeal is rejected as inadmissible.

The Registrar: The Chairwoman:

P. Cremona U. Kinkeldey