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**Datasheet for the decision
of 15 March 2012**

Case Number: J 0004/10 - 3.1.01

Application Number: 02722968.1

Publication Number: 1496918

IPC: A61K 33/36

Language of the proceedings: EN

Title of invention:

Use of Sodium meta-arsenite for the treatment of tumours

Applicant:

Komipharm International Co. Ltd.

Co-Applicants:

Lee, Sang Bong

Yang, Yong Jin

Headword:

Registration as co-applicant/KOMIPHARM

Relevant legal provisions:

EPC Art. 61, 133(2), 153

EPC R. 14, 159(1)

PCT Art. 27(2)(ii), 39(1)(b)

PCT R. 51bis1(a)(ii), 92bis(1)(a)

Relevant legal provisions (EPC 1973):

EPC Art. 72

EPC R. 20

Keyword:

"Recording of co-applicants by the International Bureau and EPO"

"Proof of entitlement to be registered as co-applicant"

"Evidence of transfer of rights"

"Deletion of entries from the European Patent Register"

"Submissions not made by professional representative"

Decisions cited:

J 0038/92, T 0039/92, J 0012/00, T 0213/89, T 0003/90,

T 1027/03, T 0717/04

Catchword:

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Case Number: J 0004/10 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 15 March 2012

Applicant/Appellant: Komipharm International Co., Ltd.
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Kyonggi-do (KR)

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Respondent: Lee, Sang Bong
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Representative: Gillard, Richard
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Prospect House
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Co-Applicant: Yang, Yong Jin
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Decision under appeal: Decision of the Legal Division of the European
Patent Office of 11 August 2009.

Composition of the Board:

Chairman: B. Günzel
Members: C.-P. Brandt
G. Weiss

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Legal Division dated 11 August 2009 rejecting the request of the applicant Komipharm International Co., Ltd. (hereinafter "Komipharm"; originally named Korea Microbiological Laboratories, Ltd.) to reverse the entry into the European Patent Register concerning the applicant by which Mr Lee, Sang Bong (hereinafter "Mr Lee") and Mr Yang, Yong Jin (hereinafter "Mr Yang") had been added as co-applicants of the European patent application 02 722 968.1. Said European patent application was filed by Korea Microbiological Laboratories, Ltd. as international application PCT/NL/02/00231 on 10 April 2002 and published on 23 October 2003 as WO 03/086424. The international application mentioned the original applicant as sole applicant for all designated states except for the US and Mr Lee and Mr Yang as inventors and applicants for the US only.
- II. In the Power of Attorney dated 7 May 2002 for the representation before all competent authorities concerning the above-mentioned international application Korea Microbiological Laboratories, Ltd., Mr Lee and Mr Yang were indicated as applicants. The written authorisation for the common representative was signed by Mr Lee and Mr Yang, the latter also signed on behalf of Korea Microbiological Laboratories, Ltd. in his capacity as President.
- III. With letter dated 11 November 2004, the representative submitted to the EPO two Forms PCT/IB/306 from the International Bureau (hereinafter "IB") dated

9 November 2004, one of them giving notice of a change regarding the applicant by the IB pursuant to Rule 92bis.1 PCT, Section 422 Administrative Instructions. According to this notification the two inventors and applicants for the US, Mr Lee and Mr Yang, were now also recorded as applicants for all designated states.

- IV. With letter dated 27 November 2008 a representative, newly appointed by Mr Lee, requested the EPO to "update" the European Patent Register, which would indicate Komipharm as sole applicant, by adding Mr Lee and Mr Yang as co-applicants. A copy of the relevant bibliographic data on file at the IB indicating Komipharm, Mr Lee and Mr Yang as applicants, as well as a copy of the Form PCT/IB/306 already submitted to the EPO with letter dated 11 November 2004, indicating the recording of Mr Lee and Mr Yang as co-applicants in the IB Register were attached.
- V. With communication dated 28 November 2008 the EPO notified Komipharm, also having appointed a new representative, of the corrected entries concerning the applicant now including Mr Lee and Mr Yang as co-applicants.
- VI. With letter dated 3 December 2008 Komipharm asserted that a transfer of rights in this patent application had never taken place and requested to revert to entering Komipharm as sole applicant.
- VII. With letter dated 19 December 2008 the representative of Mr Lee contended that the international patent application was filed mistakenly in the name Komipharm

- as the sole applicant. He submitted a copy of a contract between the three co-applicants dated 16 May 2005 as well as a translation of the contract as proof of the co-ownership of the two newly added co-applicants. The translation of the contract was not signed by the parties nor was there a comment of the translator that the original copy was signed.
- VIII. In a communication dated 3 February 2009 the Legal Division stated that Rule 92bis.1 PCT did not prescribe the presentation of evidence of a transfer during the international phase of the PCT application. However, pursuant to Article 27(2)(ii) PCT the EPO as the elected office may request the furnishing of further documents as proof pursuant to Rule 22 EPC. The representative of Mr Lee was informed that the documents submitted as proof for the co-ownership of Mr Lee had not been duly signed by Komipharm.
- IX. With letter dated 17 March 2009 the representative of Mr Lee informed the EPO that the contract dated 16 May 2005 was stamped by the parties to the contract and that the seal rather than the signature was generally used for formal legal documents in Korea. Furthermore, a translation of the notarization of the stamps by a public notary law firm as part of the contract was submitted.
- X. By decision of the Legal Division dated 11 August 2009 the request of Komipharm to reverse the entry into the European Patent Register concerning the applicant by which Mr Lee and Mr Yang had been added as co-applicants of the European patent application 02 722 968.1 was rejected. The IB had registered a

change of applicants pursuant to Rule 92bis.1 PCT, which would be generally binding for the EPO. However the EPO may request the furnishing of further proof (Article 27(2)(ii), Rule 51bis(a) PCT), which had sufficiently been done by the submission of the contract of 16 May 2005.

- XI. With letter dated 12 October 2009, received by the EPO on 22 October 2009, Komipharm filed a notice of appeal. A statement setting out the grounds of appeal was sent to the EPO by a faxed letter dated 17 December 2009. Enclosed with the statement setting out the grounds of appeal were copies and certified translations of a complaint of Mr Lee against Komipharm of June 2008 and a cross-complaint of Komipharm against Mr Lee of July 2008 filed at the Seoul Central District Court challenging the legal effect of the contract of 16 May 2005. The agreement of 16 May 2005 could not be evidence in support for the request to register a transfer by the IB of 11 November 2004.

The appellant requests in essence

that the decision of 11 August 2009 of the Legal Division be set aside, and that the entry of Mr Lee and Mr Yang into the European Patent Register as co-applicants be reversed.

Should the Legal Board of Appeal not be prepared to refuse to register Mr Lee and Mr Yang as co-applicants, the appellant requests that these proceedings be stayed pending the resolution of the Korean court proceedings as to the legal effect of the agreement of 16 May 2005.

In the event that the Legal Board of Appeal is disinclined to grant either of these requests, oral proceedings are requested.

XII. In response to the statement setting out the grounds of appeal the respondent (Mr Lee) filed with letter dated 3 August 2010 copies and translations of judgements of the Seoul Central District Court of 20 May 2010 (2008GAHAP60921 and 2009GAHAP100178), which give rulings on the complaint of Mr Lee against Komipharm of June 2008 and the cross-complaint of Komipharm against Mr Lee of July 2008 as indicated in the statement setting out the grounds of appeal. Mr Lee confirmed that these judgements are mainly based on the three-parties agreement filed with the EPO on 19 December 2008. It was contended that the Court confirmed Mr Lee as co-owner of the patent according to the Co-Ownership Agreement as requested in the complaint but that the complaints of Komipharm were rejected.

XIII. With letter dated 18 August 2010 the representative of Mr Lee re-filed the submissions of Mr Lee made in his letter dated 3 August 2010 and requested,

that the appeal be dismissed.

As an auxiliary request oral proceedings were requested.

XIV. With communication dated 21 April 2011 the Legal Board of Appeal set out its preliminary opinion pursuant Article 17(2) RPBA. The Board was of the opinion that the EPO was correct in recording Mr Lee and Mr Yang as

co-applicants on 28 November 2008 in reliance on the documents issued and provided by the IB and available at that time. However, the documents filed subsequently during the regional phase before the EPO according to Article 27(2)(ii) PCT, Rule 20 EPC 1973 did not provide evidence that a transfer of rights in favour of Mr Lee and Mr Yang actually occurred. The Board pointed out that there are some inconsistencies and contradictions in the letter of Mr Lee of 3 August 2010 re-filed by his representative with letter dated 18 August 2010 compared with the annexed judgements of the Seoul Central District Court of 20 May 2010, particularly with regard to the Co-Ownership Agreement in each case. Consequently the request of Komipharm to reverse the entry in the European Patent Register of Mr Lee and Mr Yang as co-applicants appeared to be allowable.

- XV. With letter dated 13 June 2011, filed by Mr Lee himself rather than by his professional representative, Mr Lee commented on the objections raised by the Board in its communication of 21 April 2011. With regard to the agreement of 16 May 2005 he argued that this agreement was submitted "as an evidence of co-applicant" and not "as an evidence of transfer of patent rights" and that a transfer of rights had never happened.
- XVI. By communication dated 29 July 2011 the parties were summoned to oral proceedings before the Board of Appeal on 20 December 2011.
- XVII. With letter dated 1 August 2011 the appellant (Komipharm) responded to Mr Lee's letter of 13 June 2011 and included i.a. a certified translation of the judgement of the Seoul High Court Civil Court of

30 June 2011. This is a judgement on appeal from the judgement of the Seoul Central District Court of 20 May 2010 (XII. above). This appeal judgement had materially altered the first instance ruling, particularly in holding that the agreement of 16 May 2005 was null and void. Consequently, there was no evidence at all of a transfer of any rights in the patent application from the original applicant to Mr Lee.

Mr Lee's submissions of 13 June 2011 were inadmissible due to the fact that these submissions were not made via a professional representative, as required by Article 133(2) EPC.

XVIII. With letter dated 6 December 2011 the representative of the respondent (Mr Lee) informed the Board that he would not attend oral proceedings set for 20 December 2011. Consequently, the oral proceedings scheduled for 20 December 2011 were cancelled with communication of the Board dated 15 December 2011.

Reasons for the Decision

1. The appeal is admissible.
2. In the appeal proceedings the professional representative of Mr Lee (Mr Richard Gillard from elkington and fife LLP) has not been authorised by Mr Yang and hence is acting for Mr Lee only. Mr Yang is not represented in these appeal proceedings nor have any submissions been made on his behalf.

3. Oral proceedings scheduled for 20 December 2011 were cancelled after the representative of the respondent (Mr Lee) had informed the Board with letter dated 6 December 2011 that he would not attend oral proceedings.

According to the established jurisprudence of the Boards of Appeal this statement is to be treated as an equivalent to a withdrawal of the request for oral proceedings (see T 3/90, OJ EPO 1992, 737, point 1 of the reasons; T 1027/03 of 10 January 2005, point 2 of the reasons).

The auxiliary request for oral proceedings of the appellant was only to take effect if its requests as to the substance (see XI above) were not found allowable in the written proceedings. Therefore, the Board is not obliged to hold oral proceedings, since it allows the appellant's main request in the written proceedings.

Main Request

4. With its main request the appellant seeks in essence that the entry of Mr Lee and Mr Yang into the European Patent Register as co-applicants be reversed. This request is allowable if the registration of Mr Lee and Mr Yang as co-applicants in the European Patent Register as conveyed in the communication of the Legal Division dated 28 November 2008 was contrary to law (points 4.1-4.6 below), or, if after the entry in the European Patent Register and during the European/Regional phase of the patent application a

legal basis for the correction of that entry became apparent (point 5 below).

4.1 The registration in the European Patent Register of the change concerning the applicants was based on a copy of the Form PCT/IB/306 from the IB dated 9 November 2004, giving notice of the recording of a change concerning the applicant by the IB pursuant to Rule 92bis.1 PCT, whereby Mr Lee and Mr Yang were now recorded as inventors/applicants for all designated states. It was also backed up by a copy of the relevant bibliographic data on file at the IB of the international patent application at issue indicating Komipharm, Mr Lee and Mr Yang as applicants. Both copies were filed with the letter dated 27 November 2008 of the representative of Mr Lee requesting the respective "update" of the European Patent Register.

4.2 Pursuant to Article 39(1)(b) PCT, Article 153 EPC, Rule 159(1) EPC the present international patent application entered the European phase on 10 November 2004, i.e. 31 months from its international filing date of 10 April 2002. Rule 159 EPC applies instead of Rule 107 EPC 1973 according to Article 7 of the Revision Act of 29 November 2000 (OJ EPO 2001, Special Edition No. 4, 50), Article 1(6) of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Revision Act of 29 November 2000 (OJ EPO 2007, Special Edition No. 1, 197) and Article 2 of the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000 (OJ EPO 2007, Special Edition No. 1, 89).

4.3 The recording of Mr Lee and Mr Yang as co-applicants by the IB as notified and evidenced by the Form PCT/IB/306 dated 9 November 2004 as well as by the copy of the relevant bibliographic data on file at the IB had therefore still been performed during the international phase of the PCT application and hence before the international application entered the European phase on 10 November 2004.

4.4 No other information can be obtained when looking at the EPO-Form 1200 "Entry into the European phase (EPO as designated or elected Office)", signed by the then common representative of Komipharm, Mr Lee and Mr Yang and received by the EPO on 8 October 2004. This Form displays under "1. Applicant: *Indications concerning the applicant(s) are contained in the international publication or recorded by the International Bureau after the International publication.*" The International Publication took place on 23 October 2003. In the International Publication only Korea Microbiological Laboratories Ltd. (predecessor to Komipharm) was indicated as applicant. However, at the time of entry into the European phase on 10 November 2004 Mr Lee and Mr Yang were already recorded as co-applicants as shown by the above-mentioned IB-Form PCT/IB/306 dated 9 November 2004 and by the copy of the relevant bibliographic data on file at the IB. This situation did not change by the 28 November 2008, when the EPO performed and communicated the correction of the applicants as recording Mr Lee and Mr Yang as co-applicants in the European Patent Register.

4.5 The requirements set out in Rule 92bis.1(a) PCT, the provision governing the recording of a change of i.a.

the applicant, have obviously been met. The recording of the change of applicants on 9 November 2004 was requested also on behalf of the registered applicant Komipharm, i.e. of its predecessor Korea Microbiological Laboratories, Ltd., since the request was filed at the IB by the then common representative on record of Korea Microbiological Laboratories, Ltd., Mr Lee and Mr Yang. This prerequisite being met Rule 92bis.1 (a) PCT does not require proof of entitlement regarding the change of applicants in the form of submitting documents.

- 4.6 Considering these facts and evidence and in the absence of any clear indication giving rise to considerable doubts that Mr Lee and Mr Yang, from a legal point of view, should not be registered as co-applicants, it was reasonable for the Legal Division to rely on the correctness of the IB Register and the bibliographic data at the IB as submitted by Mr Lee's representative with the letter dated 27 November 2008. Therefore the correction of the European Patent Register on 28 November 2008 is not to be impugned on that account.
5. Pursuant to Article 27(2)(ii) PCT, Rule 51bis.1(a)(ii) PCT once the processing of the international application in the national/regional phase has started the designated office may require assignments and additional documents relating to the entitlement to apply for or be granted a patent, provided that the national law provides for a respective legal basis. With regard to the European phase of an international application and the EPO as designated office as in the case at issue Rule 20 EPC 1973, Rule 22 EPC respectively, constitute the pertinent legal provisions

thereby implementing Articles 71 and 72 EPC 1973, Articles 71 and 72 EPC respectively. In the present case Rule 20 EPC 1973 rather than Rule 22 EPC applies according to Article 7 of the Revision Act of 29 November 2000 (OJ EPO 2001, Special Edition No. 4, 50), Article 1(1) of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Revision Act of 29 November 2000 (OJ EPO 2007, Special Edition No. 1, 197) and Article 2 of the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000 (OJ EPO 2007, Special Edition No. 1, 89), albeit these Rules as well as Articles 71 and 72 EPC are almost identical as regards the substance.

Contract dated 16 May 2005

- 5.1 After Komipharm had objected to the entry of Mr Lee and Mr Yang as co-applicants in the European Patent Register arguing that there was no legal basis for the registering of either of the additional parties as co-applicants Mr Lee submitted with letter dated 19 December 2008 a copy and a translation of a contract dated 16 May 2005 between Komipharm, Mr Lee and Mr Yang as evidence of the co-ownership of the two newly added co-applicants.
- 5.2 There is still reasonable doubt whether the seal, which according to Mr Lee's submission is generally used rather than the signature for formal legal documents in Korea, and whether the filing of a translation of the notarization of the stamps by a public notary law firm as part of the contract are sufficient to the requirements of Article 72 EPC 1973 (assignments in

writing and signature of the parties) at all. However, this does not need to be decided by the Board in the present case, since the contract dated 16 May 2005 cannot be regarded as adequate proof of the entitlement of Mr Lee and Mr Yang to be registered as co-applicants of the patent application at issue by virtue of their original status nor by transfer of rights. On the contrary and thereby for the moment leaving out of consideration the fact that the Seoul High Court Civil Court held with judgement of 30 June 2011 that the agreement of 16 May 2005 was null and void (XVII above, point 5.8 below) this document apart from the reasons given in that judgement raises such serious doubts as to the entitlement of Mr Lee and Mr Yang to be recorded as co-applicants that the entry in the European Patent Register should have been reversed.

- 5.3 First of all the contract of 16 May 2005 cannot per se serve as evidence of the request for registration as co-applicants directed to the IB in November 2004, since it was apparently concluded only six month later without any discernible retroactive effect.
- 5.4 Neither can the contract substantially be regarded as a legally valid basis for a subsequent transfer of rights to Mr Lee and Mr Yang nor as an entitlement to be registered as co-applicants of the patent application at issue. Rule 20 EPC 1973 requires that the documents produced as evidence of a transfer of rights must directly verify the transfer which already took place (J 38/92 and J 39/92, both of 16 March 1995, in each case points 2.3 and 2.4 of the reasons). Documents only establishing the obligation to assign rights but not constituting the assignment itself do not comply with

Rule 20 EPC 1973 (J 12/00 of 24 January 2002, points 2 and 14 of the reasons).

Regarding the contract of 16 May 2005 as filed by Mr Lee's letter dated 19 December 2008 the respective chapter "C. (Co-ownership ...) 2." (No. 2 of annexes Catalog of applied patent indicating the PCT application at issue) at most constitutes a legal obligation to transfer rights concerning the PCT application where, as in the case under consideration, the application was filed only by one of the contracting parties. A direct transfer of rights from Komipharm to Mr Lee and Mr Yang as required by Rule 20 EPC 1973 cannot be inferred from this passage of the contract.

Korean Judgements

- 5.5 Considering the comments in Mr Lee's letter dated 13 June 2011 on the inconsistencies and contradictions between the submissions of the parties and the judgements of the Seoul Central District Court of 20 May 2010 with regard to the Co-Ownership Agreement as set out in the Board's communication dated 21 April 2011 the Board has no occasion to change its opinion. However, this issue finally is quite immaterial for the present decision of the Board for the reasons given below (points 5.6, 5.8).
- 5.6 The letter dated 13 June 2011 was filed by Mr Lee himself rather than by his professional representative. As correctly argued by the appellant in its letter dated 1 August 2011 according to Article 133(2) EPC a natural or legal person without a residence or

principal place of business within the territory of one of the contracting states must act through a professional representative in all proceedings established by this Convention with the exception of filing the European patent application. Mr Lee's address is in Korea, thus not within the territory of one of the contracting states. Therefore, the requests and arguments contained in Mr Lee's the letter of 13 June 2011 would have had to be submitted by the professional representative. As these submissions were made neither by Mr Lee's representative nor endorsed by him, the Board following the jurisprudence of the Boards of Appeal cannot take them into consideration (see T 213/89 of 10 April 1990, point 2 of the reasons; T 717/04 of 28 February 2007, point 1 of the reasons).

5.7 The same legal consequence applies with regard to the contention of Mr Lee in his letter of 13 June 2011 that the agreement of 16 May 2005 was submitted "as an evidence of co-applicant" and not "as an evidence of transfer of patent rights" and that a transfer of rights had never happened. For the sake of argument only the Board points out that if the agreement of 16 May 2005 was submitted "as an evidence of co-applicant" and a transfer of rights had never happened this allegation as far as proceedings before the EPO are concerned could only be relevant with respect to a procedure pursuant to Article 61 EPC, Rule 14 EPC. However, entitlement procedures according to Article 61 EPC, Rule 14 EPC have not yet been initiated with regard to the patent application at issue.

5.8 Finally the appellant has put forward another serious reason why the agreement of 16 May 2005 cannot be

regarded as appropriate and sufficient proof of a legally valid transfer of rights in terms of the patent application underlying the present appeal proceedings and thus of an entitlement of Mr Lee and Mr Yang to be registered as co-applicants. With letter dated 1 August 2011 the appellant filed a certified translation of the judgement of the Seoul High Court Civil Court of 30 June 2011 which is a judgement on the appeals from the judgements of the Seoul Central District Court of 20 May 2010 (see XVII above). This appeal judgement materially altered the first instance rulings, particularly in holding that the agreement of 16 May 2005 was null and void due to the fact that the Joint Ownership Agreement was not approved by the board of directors. The Seoul High Court Civil Court further stated that the claims which are based on the effectiveness of the Joint Ownership Agreement are groundless.

5.9 Consequently, this agreement which was the only document submitted that, by itself, met the requirements of Article 27(2)(ii) PCT and Rule 20 EPC 1973 and which also formed the main legal basis of the judgements of the Seoul Central District Court of 20 May 2010, can no longer be regarded as evidence in favour of Mr Lee and Mr Yang for any rights to the present patent application nor as entitlement to be recorded as co-applicant in the European Patent Register.

6. For the time being the EPO was correct in recording Mr Lee and Mr Yang as co-applicants on 28 November 2008 relying on the documents issued and provided by the IB and available at that time.

However, the documents, i.e. the agreement of 16 May 2005 and the judgements of the Seoul Central District Court and the Seoul High Court Civil Court filed subsequently during the regional phase before the EPO according to Article 27(2)(ii) PCT, Rule 20 EPC 1973 do not provide evidence that a transfer of rights in favour of Mr Lee and Mr Yang actually occurred nor that they were co-owners of the present patent application. This applies even more considering that the Seoul High Court Civil Court as the final instance held that the agreement of 16 May 2005 is null and void and of no effectiveness. Therefore the recording of Mr Lee and Mr Yang as co-applicants in the course of the proceedings before the EPO has proved to be unsustainable. Consequently the request of the appellant to reverse the entry in the European Patent Register of Mr Lee and Mr Yang as co-applicants and to revert to Komipharm as sole applicant is allowable.

7. Since the Main Request of the appellant is allowable, there is no need to decide upon its Auxiliary Request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance (Legal Division) with the order to delete the entry of Mr Lee, Sang Bong and Mr Yang, Yong Jin as co-applicants from the European Patent Register.

The Registrar:

The Chairman:

C. Eickhoff

B. Günzel