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**Datasheet for the decision
of 10 December 2010**

Case Number: T 0128/10 - 3.4.01

Application Number: 96114753.5

Publication Number: 0766190

IPC: G06K 7/06

Language of the proceedings: EN

Title of invention:

IC card reader with audio output

Patentee:

Gemalto SA

Opponent:

Molnia, David

Headword:

-

Relevant legal provisions:

EPC Art. 112(1)(a)

EPC R. 22, 99(1)(a), 101(2), 139

Relevant legal provisions (EPC 1973):

-

Keyword:

-

Decisions cited:

T 0656/98, T 0015/01, T 0097/98, G 0002/04

Headnote:

I. According to Rule 22 EPC in conjunction with Rule 85 EPC, the procedural requirements to be fulfilled for recording the transfer of a European patent in the European Patent Register consist in the filing of a request of the interested party, the production of documents providing evidence of the transfer, and the payment of an administrative fee. These requirements do not need to be fulfilled at the same time. If they are met on different dates, the transfer shall only have effect vis-à-vis the EPO at the date on which all the requirements mentioned above are fulfilled (Reasons, 3.5).

II. If an appellant declares that it was its true intention to file an appeal on behalf of its name, there is no deficiency in the notice of appeal concerning the name of the appellant which may be remedied in accordance with Rule 99(1)(a) EPC in conjunction with Rule 101(2) EPC (in agreement with T 97/98) nor an error which may be corrected pursuant to Rule 139, first sentence, EPC (Reasons, 5.4).



Case Number: T 0128/10 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 10 December 2010

Appellant:
(Patent Proprietor)

Gemalto SA
6, rue de la Verrerie
F-92190 Meudon (FR)

Representative:

Debay, Yves
Cabinet Debay
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F-78170 La Celle Saint Cloud (FR)

Respondent:
(Opponent)

Molnia, David
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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 27 November 2009
revoking European patent No. 0766190 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: B. Schachenmann
Members: G. Assi
F. Neumann

Summary of Facts and Submissions

I. European patent No. 0 766 190 (application number 96114753.5) was granted with a decision of the examining division dated 30 June 2005. The mention of the grant was published in the European Patent Bulletin 2005/32 of 10 August 2005. The patent proprietor was XIRING.

II. On 10 May 2006 an opposition was filed by David Molnia against the patent as a whole. The opposition was based on the grounds pursuant to Article 100(a) EPC 1973 in connection with Articles 52(1), 54 and 56 EPC 1973, Article 100(b) EPC 1973 in connection with Article 83 EPC 1973, and Article 100(c) EPC 1973 in connection with Article 123(2) EPC 1973.

In its decision, dispatched on 27 November 2009, the opposition division held that the ground for opposition mentioned in Article 100(a) EPC 1973 in connection with Articles 52(1) and 56 EPC 1973 prejudiced the maintenance of the patent. Hence, the opposition division revoked the patent.

III. On 24 January 2010 a notice of appeal, dated 23 January 2010, was filed on behalf of Gemalto SA (hereinafter "*alleged appellant*") against the decision of the opposition division. The appeal fee was paid on 22 January 2010. An assignment document signed by Gemalto SA as transferee and XIRING as assignee was produced with the notice of appeal.

IV. With a communication of 16 February 2010, in which XIRING was still indicated as the patent proprietor,

the Client Data Registration of the EPO drew attention to deficiencies in the "*request dated 23 January 2010*" for entry of a change in the European Patent Register concerning the name of the patent proprietor. In particular, the administrative fee pursuant to Rule 22(2) EPC had not yet been paid. It was requested to remedy the deficiency within a period of two months from notification of the communication.

- V. The administrative fee was paid on 25 February 2010.
- VI. A statement setting out the grounds of appeal was filed on 10 March 2010.
- VII. With a communication of 1 April 2010 the Client Data Registration stated that the entries pertaining to the patent proprietor had been amended to Gemalto SA. The registration of the transfer had effect from 25 February 2010.
- VIII. With a letter of 19 July 2010 the opponent (respondent) submitted that the appeal should be held inadmissible as Gemalto SA was not entitled to file the appeal.
- IX. On 26 August 2010 the parties were summoned to oral proceedings scheduled to take place on 10 December 2010. On 2 September 2010 the Board sent a communication dealing with the issue of the admissibility of the appeal.
- X. In response to the Board's communication, the parties made further submissions with letters of 7 September 2010 and 21 September 2010.

- XI. On 21 September 2010 correction of the name of the appellant was requested. Moreover, an accordingly amended notice of appeal was filed on behalf of XIRING against the decision of the opposition division referred to above (point II).
- XII. Further submissions by the parties dealing with the admissibility of the appeal followed with letters dated 29 October 2010, 7 December 2010 and 8 December 2010. Oral proceedings before the Board were then held at the scheduled date.
- XIII. The arguments put forward by the parties are summarized in the reasons for the decision.
- XIV. The alleged appellant requested that the appeal be found to be admissible and the appeal proceedings be continued as to the substance of the appeal or, as an auxiliary request, that the following point of law submitted by the letter dated 7 December 2010 be referred to the Enlarged Board of Appeal:
- "Is it sufficient to provide documentary evidence in relation to the transfer of a patent under appeal which was in fact submitted before the expiry of the period for filing the notice of appeal, according to Rule 20(3) [EPC 1973] or 22(3) [EPC], so that a transfer shall have effect vis-à-vis the European Patent Office? If yes, is the appeal receivable? If No, should the Board of Appeal have drawn attention of the appellant on incorrect designation of the Appellant and have invited the representative to modify the incorrect designation of the Appellant?"*

Is there in EPC 1973 or 2000, a Rule stating that to be an entitled-Appellant you should be recorded on the Register of European Patent, and in such case what is the utility of Rule 22(3) [EPC]?"

- XV. The respondent requested that the appeal be rejected as inadmissible or, as an auxiliary request, that the following point of law submitted by the letter of 29 October 2010 be referred to the Enlarged Board of Appeal:

"Can the unambiguous identification of a non-party as the appellant in a notice of appeal be considered an error for which correction under Rule 101(2) EPC or Rule 139 EPC is available, if said non-party is a purported transferee of the European patent for which, at the expiry of the period for filing the notice of appeal, documentary evidence had been submitted but the requirements of Rule 22(2) EPC had not been fulfilled?"

- XVI. In the present decision, reference will be made to "EPC 1973" or "EPC" for EPC 2000 (EPC, 13th edition, July 2007, Citation practice, pages 4-6) depending on the version to be applied according to Article 7(1) of the Revision Act dated 29 November 2000 (Special Edition No. 1 OJ EPO 2007, 196) and the decisions of the Administrative Council dated 28 June 2001 (Special Edition No. 1 OJ EPO 2007, 197) and 7 December 2006 (Special Edition No. 1 OJ EPO 2007, 89).

Reasons for the Decision

1. Preliminary remarks

According to the European Patent Bulletin 2005/32 of 10 August 2005 and the decision of the opposition division of 27 November 2009, XIRING was the patent proprietor. The notice of appeal of 23 January 2010, however, was filed on behalf of Gemalto SA.

2. Submissions of the parties

2.1 With the letter of 19 July 2010 the respondent submitted that the notice of appeal dated 23 January 2010 was deficient in that it did not contain the address of Gemalto SA.

Moreover, the appeal lodged by Gemalto SA should be held inadmissible on the ground that there was no evidence on file that a transfer of the patent from XIRING to Gemalto SA had been recorded before the expiry of the appeal period. In particular, the reference to a "*new owner, Gemalto SA*" in the notice of appeal and the production of an assignment document were not sufficient to effect the registration of the transfer.

The respondent thus concluded that during the entire period in which a notice of appeal could validly be filed against the decision of the opposition division, XIRING was to be regarded as the sole patent proprietor. In the absence of a registration of the transfer in due time Gemalto SA was not entitled to file an appeal. The

registration of the transfer outside the appeal period did not validate the appeal (T 656/98, OJ 2003, 385).

- 2.2 With the letter of 21 September 2010 the alleged appellant submitted that the assignment document produced with the notice of appeal dated 23 January 2010 indicated the addresses of both Gemalto SA and XIRING. Therefore, the respondent's allegation that the notice of appeal did not contain the address of Gemalto SA was unjustified.

Moreover, the respondent's submission that the appeal was inadmissible because Gemalto SA was not entitled to file an appeal was based on an incorrect interpretation of the provisions of Rule 22 EPC. In the alleged appellant's view, paragraphs 1 and 2 of Rule 22 EPC should be considered to apply vis-à-vis third parties, whereas paragraph 3 found application vis-à-vis the EPO. Any other interpretation of paragraph 3 would not be justified. Indeed, Rule 22(3) EPC did not state that a *"transfer shall have effect vis-à-vis the European Patent Office only at the date when and to the extent that the fee has been paid and the documents have been produced"*.

In the present case, the assignment document was produced with the notice of appeal of 23 January 2010 before the expiry of the appeal period and the transfer of the patent thus had effect vis-à-vis the EPO on that date according to Rule 22(3) EPC. The appeal was therefore admissible. Decision T 656/98 cited by the respondent was not relevant for the present case because it dealt with a different factual situation.

If the EPO held that the communication of the assignment was not sufficient for this to take effect vis-à-vis the EPO at the date when and to the extent that the document providing evidence had been produced, the EPO should then consider XIRING, the previous patent proprietor, to be the legitimate appellant. In such a case, the appeal of 23 January 2010 did not correctly designate the name and address of the appellant and the EPO should allow a correction pursuant to Rule 101(2) EPC in connection with Rule 99(1)(a) EPC. However, the Board did not send a communication inviting the party to remedy the deficiency.

According to the jurisprudence of the boards of appeal (T 97/98, OJ 2002,183), correction of the name of the appellant to substitute a natural or legal person other than the one indicated in the appeal was allowable under Rule 101(2) EPC, if it was the true intention to file the appeal in the name of said person and if it could be derived from the information in the appeal, if necessary with the help of other information on file, with a sufficient degree of probability that the appeal should have been filed in the name of that person.

In the present case, it was indeed the true intention to file the appeal in the name of the patent proprietor, but it was neglected to indicate XIRING as the appellant until the registration of the transfer of the patent took effect vis-à-vis the EPO.

- 2.3 With the letter of 29 October 2010 the respondent disagreed with the allegation that the mere submission of an assignment document made the transfer of the

patent effective vis-à-vis the EPO, regardless of when the request for the transfer was made and the administrative fee was paid. In the respondent's view, the transfer had effect vis-à-vis the EPO on the date on which the request, the evidence and the fee had all been received by the EPO, whichever was the latest. The interpretation of Rule 22 EPC made by the alleged appellant relied on an artificial distinction between the effect vis-à-vis third parties and the effect vis-à-vis the EPO. The EPC, however, was only concerned with the effect of a transfer vis-à-vis the EPO. This was essential for determining the party status in proceedings before the EPO. The conditions for having effect vis-à-vis third parties were governed by national law (Article 2(2) EPC). Anyhow, even if the EPO could be considered as a "*third party*" in transactions between an assignee and a transferee, the provisions for having effect vis-à-vis third parties, thus paragraphs 1 and 2 of Rule 22 EPC in the alleged appellant's view, would have to be applied together with the provisions of paragraph 3 concerning the effect vis-à-vis the EPO.

The respondent also drew attention to the fact that the alleged appellant was made aware of the official interpretation of Rule 22 EPC by the communication of 16 February 2010 (page 1, last two sentences; page 2, last sentence of point 1). Consistent with this interpretation, after the payment of the administrative fee on 25 February 2010, the communication of 1 April 2010 stated that the registration of the changes took effect on 25 February 2010. The alleged appellant did not contest this finding.

With regard to the alleged obligation of the Board of Appeal to send an invitation to correct deficiencies in the notice of appeal of 23 January 2010 pursuant to Rule 101(2) EPC, the respondent submitted that such an invitation was not at all necessary because the notice of appeal did not contain an incorrect designation of the appellant, which would have required a correction under Rule 101(2) EPC, but rather a correct designation of a non-entitled appellant, which called for rejection of the appeal as inadmissible under Rule 101(1) EPC. Moreover, a correction according Rule 139, first sentence, EPC was excluded because there was no evidence on record that an error had occurred. Indeed, when lodging the notice of appeal of 23 January 2010 the representative's true intention clearly was to designate Gemalto SA as the appellant.

- 2.4 With the letter of 7 December 2010 the alleged appellant reiterated the interpretation of Rule 22 EPC already made with the letter of 21 September 2010. Paragraphs 1 and 2 of Rule 22 EPC concerned the registration of a transfer in the European Patent Register, thus information for third parties. Conversely, paragraph 3 related to the effect of a transfer vis-à-vis the EPO. Rule 22 EPC thus dealt with the conditions for recording a transfer in the European Patent Register so that the transfer became available to the public and, moreover, the condition for a transfer having effect vis-à-vis the EPO. These two situations were different and should not be mixed up.

It should also be noted that Article 107 EPC did not require that an adversely affected party had to be recorded in the European Patent Register. The mere

production of documentary evidence of the transfer according to Rule 22(3) EPC had effect vis-à-vis the EPO to meet the requirement of being adversely affected.

2.5 During the oral proceedings on 10 December 2010 the alleged appellant relied on the introductory paragraph of chapter VII.D.5.2 of the 5th edition (2006) of the Case Law of the Boards of Appeal of the EPO. In the alleged appellant's opinion, this paragraph made clear that for a transfer to become effective vis-à-vis the EPO, it was only necessary to file documentary evidence of the transfer. The request and the fee were not required.

3. Rule 22 EPC

3.1 The procedure for recording the transfer of a European patent in opposition appeal proceedings is defined by Rule 22 EPC in connection with Rules 85 and 100(1) EPC.

3.2 According to Rule 22(1) EPC in conjunction with Rule 85 EPC the transfer of a European patent shall be recorded in the European Patent Register "*at the request of an interested party, upon production of documents providing evidence of such transfer.*"

It should be noted that the request of the party and the production of documents are conditions sine qua non for recording the transfer. However, paragraph 1 does not require that the request be filed and the documents be produced at the same date.

In the present case, on 24 January 2010 the alleged appellant filed the notice of appeal dated 23 January

2010, produced an assignment document at the same time, but failed to file a request for transfer of the patent as required by Rule 22(1) EPC. The official communication of 16 February 2010, however, includes the mention of a "*request dated 23 January 2010*". In view of the fact that the only document on file bearing the date of 23 January 2010 is the notice of appeal, the Board assumes that the Client Data Registration considered the production of the assignment document with the notice of appeal as an implicit request for recording a transfer of the patent in the European Patent Register. Since Article 22(1) EPC does not require a particular form of the request, the Board has no reason to disagree with the view of the Client Data Registration.

- 3.3 According to Rule 22(2) EPC "*The request shall not be deemed to have been filed until an administrative fee has been paid.*"

It is not required that the request for transfer be filed and the administrative fee be paid on the same date. In the case that these actions are performed on different dates, the date of payment of the fee prevails over the date of filing the request.

In the present case, the administrative fee was paid on 25 February 2010. It follows that the request implicitly filed on 24 January 2010 with the notice of appeal was not deemed to have been filed until 25 February 2010.

- 3.4 Pursuant to Rule 22(3) EPC "*A transfer shall have effect vis-à-vis the European Patent Office only at the*

date when and to the extent that the documents referred to in paragraph 1 have been produced."

Paragraph 3 regulates the date on which the transfer becomes effective vis-à-vis the EPO. The wording "*only at the date when and to the extent that the documents referred to in paragraph 1 have been produced*" makes any earlier date mentioned in the assignment document obsolete from the viewpoint of the EPO. The earliest date on which the transfer may take effect vis-à-vis the EPO is the date on which the documentary evidence has been produced. Of course, a prerequisite for the transfer to become effective is that a request for recording the transfer has been made. This request is only deemed to have been filed when the requirement of paragraph 2 has been fulfilled.

- 3.5 In summary, according to Rule 22 EPC in conjunction with Rule 85 EPC, the procedural requirements to be fulfilled for recording the transfer of a patent consist in the filing of a request of the interested party, the production of documents providing evidence of the transfer, and the payment of an administrative fee. These requirements do not need to be fulfilled at the same time. If they are met on different dates, the transfer shall only have effect vis-à-vis the EPO at the date on which all the requirements mentioned above are fulfilled. Indeed, only at this date it is ensured that all the requirements of Rule 22 EPC are met.

This interpretation of Rule 22 EPC is commonly accepted in the legal literature (Singer/Stauder, *Europäisches Patentübereinkommen*, Fifth Edition, 2010, Art 71, margin No. 12; Visser, *The annotated European Patent*

Convention, updated till 15 November 2009, Rule 22, page 404).

It is also consistent with the official line adopted by the EPO (Guidelines for Examination in the EPO, December 2007 and April 2010, E-XIII, 1) and the jurisprudence of the boards of appeal (Case Law of the Boards of Appeal of the EPO, December 2006, VII.D.5.2.2 and July 2010, VII.C.5.2).

- 3.6 In the present case, this means that the provision of Rule 22(3) EPC cannot lead to the conclusion that the transfer would have effect at the date, 24 January 2010, on which the notice of appeal with the enclosed copy of the assignment document was received. Rather, according to Rule 22(2) EPC, until the administrative fee has been paid, no request may be deemed to have been filed. Hence, despite the fact that the representative of the appellant Gemalto SA did not explicitly request the registration of the transfer of the patent in the notice of appeal, the Client Data Registration correctly concluded in the communication of 1 April 2010 that the registration had taken effect vis-à-vis the EPO on 25 February 2010, the date on which the administrative fee had been paid.

- 3.7 The alleged appellant's interpretation of Rule 22 EPC is in evident disagreement with the commonly accepted construction of the legal norm from which there is no reason to depart.

Moreover, it is not convincing. Indeed, it is based on the artificial assumption that paragraphs 1 and 2 of Rule 22 EPC should concern the effect vis-à-vis third

parties, whereas paragraph 3 should be considered in isolation and have application vis-à-vis the EPO.

As the Enlarged Board of Appeal stated in G 2/04 (OJ 2005, 549), "*Legal certainty requires that it is clear at any given time who the parties to the proceedings are*" (Reasons, 2.2.2(a)). Moreover, "*In the case of the proprietor, the industrial property right may be transferred and such transfer may have effect vis-à-vis the EPO if it is registered in accordance with Rule 61 in conjunction with Rule 20 EPC [1973]. This allows the new proprietor to defend his patent in opposition proceedings before the EPO. Hence, the procedural status of the proprietor cannot be transferred without the substantive title*" (Reasons, 2.1.2).

Therefore, the EPO registers the transfer of a patent to a new proprietor during the opposition period or during opposition procedure (Rule 85 EPC) or a possible subsequent appeal procedure (Rule 100(1) EPC). The EPO will regard the new proprietor as a party to the proceedings only if it is duly recorded as such, that is if the formalities as laid down in Rule 22 EPC have been completed. If the new proprietor wishes to participate in proceedings before the EPO, the registration under Rule 22 EPC is mandatory and allows a precise and simple determination of the parties, thus avoiding that the EPO is involved in complicated investigations as to the relations between a recorded party and an alleged successor.

The alleged appellant's argumentation fails to appreciate this aim of Rule 22 EPC. Even if its view would be accepted, which it is not, and assuming for

the sake of argument that the EPO could be considered as a "*third party*" in transactions between an assignee and a transferee, the provisions for having effect vis-à-vis third parties, thus paragraphs 1 and 2 of Rule 22 EPC in the alleged appellant's view, would have to be applied together with those of paragraph 3 with respect to the effect vis-à-vis the EPO, as the respondent submitted. This would lead to the conclusions drawn above by the Board.

3.8 In conclusion, the Board is of the view that the effective date of transfer of the patent to Gemalto SA is the date of payment of the administrative fee pursuant to Rule 22(2) EPC, which falls outside the period for filing a notice of appeal as laid down in Article 108 EPC. Thus, the appeal was not filed by a party to the proceedings which led to the decision under appeal. It follows that the respondent's conclusion that the appeal filed on 24 January 2010 in the name of Gemalto SA should be rejected as inadmissible (Rule 101(1) EPC) is correct.

3.9 With regard to the amended notice appeal lodged on 21 September 2010 on behalf of XIRING, it must also be rejected as inadmissible (Rule 101(1) EPC) because it was not filed within two months of notification of the decision of the opposition division (Article 108 EPC). Moreover, on 21 September 2010 XIRING was no longer adversely affected by the decision under appeal (Article 107 EPC) because the transfer of the patent to Gemalto SA became effective vis-à-vis the EPO on 25 February 2010.

4. The cited jurisprudence

4.1 T 656/98 (OJ 2003, 385)

4.1.1 In T 656/98 the board was confronted with the fact that the representatives on record for the patent proprietor Genencor Inc filed on 30 June 1998 a notice of appeal on behalf of "*The proprietor: Genencor International Inc*". The appellant stated the patent had been transferred from Genencor Inc to its associated company, Genencor International Inc, before the appeal was filed. With a letter of 4 November 1998, received on 6 November 1998, a certified copy of the assignment of the patent from Genencor Inc to Genencor International Inc was filed. The transfer fee was also paid. The EPO recorded the transfer of the patent with effect from 6 November 1998. An opponent (respondent) objected that the appeal was inadmissible on the ground that at the time of filing the appeal the appellant was not a party to the proceedings. The board rejected the appeal as inadmissible.

4.1.2 The alleged appellant held that the facts underlying T 656/98 and the present case were different.

First, in T 656/98 the document providing evidence of the transfer was not produced with the notice of appeal.

Second, Genencor Inc did not exist anymore at the date of the appeal in T 656/98, whereas XIRING still existed in the present case on 24 January 2010.

Moreover, in T 656/98 the representative of Genencor Inc received a communication from the board of appeal,

dated 9 September 1998, querying the fact that the name and address on record at the EPO were not those stated for the appellant. The representative thus had an opportunity to clarify the situation and to confirm the intention to designate Genencor International Inc as the appellant. In the present case, however, the representative of the alleged appellant did not receive the Board's communication dated 2 September 2010 until 8 September 2010 indicating a deficiency concerning the name of the appellant. A correction was then requested (Rule 101(2) EPC).

4.1.3 The mentioned differences are not sufficient for regarding T 656/98 as irrelevant. Quite on the contrary, in both the present case and T 656/98 a notice of appeal was filed designating as the appellant a patent proprietor who differs from the proprietor recorded in the European Patent Register. Moreover, for a decision to be considered relevant, it is not mandatory that all the facts are identical.

4.1.4 In T 656/98 (Headnote) the board held that "*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 [1973] must be filed before the expiry of the period for appeal under Article 108 EPC [1973]. Later recordal of the transfer does not retroactively validate the appeal*".

In the present case, the Board has no reason to depart from these conclusions which, as already stated above, are consistent with the official line adopted by the EPO and the jurisprudence of the boards of appeal.

4.1.5 As already mentioned above, the alleged appellant also submitted that, unlike in case T 656/98, the deficiency concerning the name of the appellant in the notice of appeal of 23 January 2010 had not been notified until the Board sent the communication of 2 September 2010.

This submission is not correct, as the respondent noted. Indeed, the Client Data Registration sent the communication of 16 February 2010 in which the alleged appellant was informed of a deficiency in the request under Rule 22 EPC and was invited to correct it. The deficiency was identified as non-payment of the administrative fee under Rule 22(2) EPC. The alleged appellant reacted by paying the due fee on 25 February 2010.

Moreover, attention is drawn to the fact that the Client Data Registration sent the further communication of 1 April 2010 informing that the registration of the transfer had taken effect on 25 February 2010, i.e. after the expiry of the period for filing a notice of appeal under Article 108 EPC. The alleged appellant did not reply to this communication, although it had been informed of the EPO's interpretation of the requirements according to Rule 22 EPC in the communication of 16 February 2010 and thus had been made aware of the legal consequences.

4.2 T 15/01 (OJ 2006, 153)

4.2.1 In T 15/01 the board distinguished between the situation where a party acquired a patent through a transfer and through a merger. It held that "*Rule 20(3)*

EPC [1973] does not apply in the context of universal successions in law. The universal successor of a patent applicant or patentee automatically acquires party status in proceedings pending before the European Patent Office" (Headnote, II).

4.2.2 T 15/01, cited by the alleged appellant, does not apply to the present case because the document, produced with the notice of appeal of 23 January 2010, provides evidence of the transfer of the patent and its American and Canadian members of the same patent family from XIRING to Gemalto SA. There is no evidence of a merger behind this transfer.

4.2.3 Therefore, the Board concludes that Rule 22(3) EPC applies in the context of the present case.

5. Correction of the appellant's name in the notice of appeal

5.1 The alleged appellant submitted that it was its true intention to file the appeal of 23 January 2010 in the name of the patent proprietor, but it was neglected to indicate XIRING as the appellant until the registration of the transfer of the patent took effect vis-à-vis the EPO. In such a case, a correction of the appellant's name in the notice of appeal should be possible.

5.2 In T 97/98 (OJ 2002, 183) an appeal in the name of Fresenius AG was lodged against a decision of the opposition division to maintain the patent in an amended form. Later on the appellant submitted that Fresenius AG was erroneously indicated in the notice of appeal as being the name of the opponent. The true

intention was to file the appeal in the name of Fresenius Medical Care Deutschland GmbH. Correction of the appellant's name was requested.

Thus, the situation was that on expiry of the time limit under Article 108 EPC 1973 the appeal did not expressly indicate the true name of the person in whose name the appeal was intended to be filed. In the board's view *"What is required under Rules 64(a) and 65(2) EPC [1973] is that there was indeed a deficiency, i.e. that the indication was wrong, so that its correction does not reflect a later change of mind as to whom the appellant should be, but on the contrary only expresses what was intended when filing the appeal. It must be shown that it was the true intention to file the appeal in the name of the person, who is, according to the request, to be substituted"* (Reasons, 1.3).

The board then concluded that *"correction of the name of the appellant to substitute a natural or legal person other than the one indicated in the appeal is allowable under Rule 65(2) EPC [1973] in conjunction with Rule 64(a) EPC [1973], if it was the true intention to file the appeal in the name of said person and if it could be derived from the information in the appeal, if necessary with the help of other information on file, with a sufficient degree of probability that the appeal should have been filed in the name of that person"* (Reasons, 1.4; Headnote).

- 5.3 It should be noted that the conclusions drawn in T 97/98 are endorsed by the Enlarged Board of Appeal in G 2/04 (OJ 2005, 549). In particular, *"Considering the overriding interest that a party must be identifiable"*,

the Enlarged Board saw "*no reason for a broadening of the scope of application of Rule 65(2) or Rule 88, first sentence, EPC [1973]*" (Reasons, 3.1).

5.4 In the present case, the alleged appellant itself declared that it was its true intention to file the appeal of 23 January 2010 on behalf of Gemalto SA which in its view was the patent proprietor at the filing date of the appeal. According to T 97/98, in such a situation, there is no deficiency in the notice of appeal concerning the name of the appellant which may be remedied in accordance with Rule 99(1)(a) EPC in conjunction with Rule 101(2) EPC nor an error which may be corrected pursuant to Rule 139, first sentence, EPC. Thus, the Board agrees with the respondent's submissions.

6. Auxiliary requests for referring points of law to the Enlarged Board of Appeal

6.1 Pursuant to Article 112(1)(a) EPC, "*in order to ensure uniform application of the law*", or "*if a point of law of fundamental importance arises*", the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. If the Board of Appeal rejects the request, it shall give the reasons in its final decision.

6.2 In the present case, the alleged appellant's auxiliary request essentially concerns the interpretation of the requirements of Rule 22 EPC and the correction of the

designation of the appellant in the notice of appeal. Since the jurisprudence of the boards of appeal with regard to both issues is consistent, there is no need to refer a question to the Enlarged Board of Appeal to ensure uniform application of the law. In view of this, the Board does not see that a point of law of fundamental importance arises, that would need a clarification by the Enlarged Board.

Therefore, the alleged appellant's auxiliary request is not allowable.

6.3 As the respondent's main request is allowable, the respondent's auxiliary request need not be considered.

Order

For these reasons, it is decided that:

The appeal is rejected as inadmissible

The Registrar:

The Chairman:

R. Schumacher

B. Schachenmann