

DECISION OF THE BOARDS OF APPEAL

Decision of Technical Board of Appeal 3.2.1 dated 20 June 1996

T 798/93 - 3.2.1*

(Translation)

Composition of the board:

Chairman: F. Gumbel

Members: M. Ceyte

J.-C. Saisset

Patent proprietor/Appellant: LOHR INDUSTRIE

Opponent/Respondent: Monti, Umberto, Ing.

Headword: Identification of real opponent/ROAD TRAIN

Article: 54(1), 56, 99(1), 110(1), 112(1), 114(1), 117(1)(g), 117(3), 123, 133 EPC

Rule: 55(a), (d) EPC

Keyword: "Opposition filed by a professional representative acting on his own behalf and with the avowed purpose of supplementing his professional training" - "Admissibility of opposition (yes)" - "Presumption established by Article 99(1) EPC that the real opponent is the person who has lodged the opposition" - "Proof that a third party is acting as the real opponent (no)" - "Sworn statement (no; confirmation of decision T 635/88)" - "Referral to the Enlarged Board of Appeal (no)"

Headnote

I. Article 99(1) EPC, which enables "any person" to institute opposition proceedings, establishes the presumption that the real opponent is the person who has lodged the opposition. The EPC and its attendant provisions make no stipulation as to the opponent's personal circumstances or motives for acting.

Requests that the opposition be declared inadmissible must therefore be refused if, as in the present case, they are based on objections regarding the opponent's personal circumstances, for example his profession (a professional representative before the EPO) or his field of technical expertise (different from that of the patent forming the subject of the opposition), or on objections concerning the opponent's motives for acting (statement by the opponent explaining that his only reason for acting was to supplement his professional training).

II. The presumption established by Article 99(1) EPC can only be set aside if proof is furnished, during the proceedings, that a third party has claimed to be the real opponent. In this event, to uphold the principle established by board of appeal jurisprudence that "oppositions must be filed and pursued ... so as to avoid ... uncertainty", the "person" in whose name the opposition was filed may be asked to assist in dispelling the doubt (see T 635/88).

Summary of facts and submissions

I. The appellant is the proprietor of European patent No. 0 214 919 (application No. 86 440 073.4).

II. As a natural person resident in one of the EPC contracting states (Italy), the opponent (respondent) filed an opposition requesting that the patent be revoked in its entirety.

The patentability of the subject-matter was contested, in particular, on the basis of the

following documents:

D1: IT-C-904 996

D8: IT-U-205-465 (cited in the original European patent application).

III. In a decision posted on 23 July 1993, the opposition division revoked the European patent.

In the division's view, the subject-matter of claim 1 as granted was clearly derived from the teaching of D1.

IV. In a letter received on 10 September 1993 the appellant (patent proprietor) lodged an appeal against this decision, paying the requisite fee.

The reasoned statement of grounds for appeal was filed on 20 November 1993.

In a fax dated 25 November 1993 the appellant contested the admissibility of the opposition, alleging that the opponent was acting on behalf of another company, instead of on his own account. It produced documents to show that the opponent was a professional representative before the EPO, and that, acting in this capacity, he had in the past filed European patent applications on behalf of clients.

V. In reply to the board's communication the opponent explained that he was indeed a professional representative but was acting on his own behalf. Since he had no experience of opposition and lacked any knowledge in the field of heavy goods vehicles, he had decided to lodge an opposition to the patent in question with the aim of supplementing his professional training. This was a cheaper option than attending a training seminar on the subject of opposition proceedings.

Moreover, once this specific aim had been achieved, he had no interest whatever in the eventual fate of the patent.

In a fax dated 7 February 1996 the opponent announced that he would not be attending the oral proceedings scheduled to take place on 20 June 1996.

VI. At the oral proceedings the appellant (patent proprietor) requested that the contested decision be set aside; that (main request) the opposition be declared inadmissible, if necessary after the taking of evidence to determine the identity of the real opponent; that the Enlarged Board of Appeal be asked to define appropriate restrictions on the filing of oppositions by professional representatives; and that the opponent be required to remain a party to the proceedings.

The appellant also requested (auxiliary request) that the patent be maintained on the basis of the amended claims and the relevant description, as filed during the oral proceedings, and the drawings in the original version as granted.

VII. Regarding the opponent's entitlement to lodge an opposition, the appellant made the following main points:

- as an Italian patent attorney and a professional representative before the EPO, the opponent was not a third party in the ordinary sense; enrolment in the list of professional representatives before the EPO was granted in recognition of professional ability, notably with regard to opposition proceedings;

- a professional representative before the EPO was expected to realise that he would automatically come under suspicion of acting on behalf of a client if he lodged an opposition in his own name, ie without instructions from a client;

- an interest in acting was not in itself a condition of admissibility, but in this case the issue of interest must be taken into account; filing an opposition for purely wilful reasons was contrary to the very principle of opposition and undermined the dignity of the proceedings;

- given that the opponent's own technical training was in the field of electronics, there was no cogent reason for him to lodge an opposition against this particular European patent;

- during the opposition proceedings, the opponent had shown a knowledge of the relevant art which he could not normally have possessed;

- the search report contained no reference to D1, and only an expert in the field of heavy goods vehicles could have drawn the opponent's attention to the prior art in this document;

- the motive belatedly cited by the opponent - ie the wish to improve his professional skills in the area of opposition proceedings - was not convincing; professional training was normally conducted at specialist training centres, and opposition proceedings required essentially the same professional skills as those involved in the assessment of patentability, with which the opponent, as a representative, was fully conversant;

- the opponent's efforts were directed towards a single end: the invalidation of a patent, which had not merely been picked out at random, on behalf of a company whose identity was deliberately being concealed by the opponent;

- the opponent's behaviour could only be understood in the light of a simple motive: that he was in fact working for a competitor of the appellant;

- the documents submitted during the discussion before the department of first instance indicated that company R., based in Italy, was infringing the European patent in question; this company therefore had a vested interest in invalidating the patent, using the opposition procedure as an expedient and borrowing the opponent's name;

- clearly, therefore, a legitimate doubt existed as to the real opponent's identity, according to the principle laid down in T 635/88 (OJ EPO 1993, 608, point 9.1 of the reasons for the decision).

In support of its auxiliary request, the appellant submits that neither of the documents D1 and D8 cited in the opposition suggests the use of a trailer, said to be stable, with central axles, and a towing hook disposed in a low position under the chassis of the lorry body.

The skilled person would therefore be unable to arrive at the claimed invention on the basis of these two documents and of his general knowledge of the field.

VIII. The opponent requested by letter that the appeal be dismissed.

Regarding the admissibility of the opposition, he pointed out that Article 99(1) EPC allowed any person to lodge an opposition, and that opponents were not required to justify themselves by explaining their interest in opposing the patent (see T 635/88 OJ EPO 1993, 608, point 6 of the reasons for the decision).

Having declared in his fax of 7 February 1996 that he had no further interest in the present case and would therefore not be taking part in the oral proceedings on 20 June 1996, the opponent was not in a position to comment on the narrower version of claim 1 filed by the appellant.

The opponent has stated in writing that the subject-matter of the patent in question was clearly derived from the combined teachings of D1 and D8. ...

IX. The amended claim 1 reads as follows:

...

Reasons for the decision

1. The appeal complies with Articles 106 and 108 and Rules 1(1) and 64 EPC, and is therefore admissible.

2. The opponent's statement explaining his lack of interest in the fate of the European patent to which his opposition relates cannot be construed as a withdrawal of the opposition. Withdrawal requires an unambiguous statement; in the present case, no such statement has been forthcoming.

Moreover, since the European patent in question has been revoked, withdrawal of the

opposition would have no impact on the appeal proceedings, which would be continued by the Office of its own motion in accordance with Articles 110(1) and 114(1) EPC.

3. Admissibility of the opposition

3.1 It is accepted that the opponent is a professional representative before the EPO, and that he has followed this profession in the recent past, notably by filing several European patent applications.

3.1.1 In the present case, the appellant accuses the opponent of having filed an opposition without mentioning his occupation as referred to above and without appointing a professional representative to act on his behalf.

3.1.2 The board is bound to point out that Article 99(1) EPC allows "any person" to institute opposition proceedings, and that the EPC and its attendant provisions make **no stipulation as to the circumstances of a person acting** in opposition proceedings before the EPO. Consequently, a professional representative before the EPO acting on his own behalf in opposition proceedings is under no obligation to state his occupation. Under Article 133 EPC, moreover, if such an opponent is a natural person resident in one of the contracting states and claiming to act on his own behalf, then he is not compelled to be represented in proceedings before the EPO.

3.1.3 The board also finds that the notice of opposition complies with the provisions of Rule 55 (a) and (d) EPC. The notice includes the opponent's name and address and the country in which his residence is located. It makes no reference to the appointment of a representative (paragraph (d)), but in this case, for the reasons explained above, representation is unnecessary.

3.1.4 In T 10/82 (OJ EPO 1983, 407) it was decided that an opposition filed by a European professional representative was inadmissible. However, the inadmissibility rested entirely on the representative's subsequent admission, during the proceedings, that he was in fact acting in a professional capacity, not on his own account but on behalf of a

client who was the real opponent.

3.1.5 In the present case, the opponent lodged the opposition not in his professional capacity but on a personal basis, making no reference to his profession. He has claimed all along to be acting on his own behalf, instead of representing a client. On this count there is no reason to declare the opposition inadmissible.

3.1.6 By the same token, in the absence of any stipulation regarding an opponent's occupation, an opposition cannot be declared inadmissible purely because the opponent's technical training was in an area different from, or entirely removed from, the field to which the contested patent relates.

3.2 As explained in point 3.1 above, Article 99(1) EPC allows "any person" to institute opposition proceedings, and contains no stipulation as to an opponent's personal circumstances.

3.2.1 In addition to the fact that the EPC and its attendant provisions contain no stipulation as to the opponent's personal circumstances, the above-mentioned decision in T 635/88 also makes it clear that **the opponent's interest in acting is not subject to any restriction.** The opposition procedure was deliberately designed to be open and readily accessible, so that third parties - acting on their own behalf, and, above all, in the public interest - would be able to get a patent limited or revoked by a department of the EPO, via a procedure which offers the advantage of being centralised. The openness of the procedure also speeds up the handling of the case by relieving the Office of the complicated task of verifying the opponent's circumstances and motives for acting.

3.2.2 Contrary to the appellant's view, there is nothing to prevent a person from lodging an opposition with the sole purpose of supplementing his training in the relevant field, as would seem to have happened in the present case.

3.3 In its written submissions and during the oral proceedings, the appellant has cited a number of further circumstances, in addition to those already mentioned, which

supposedly prove that the opponent, who is resident in Italy, was not acting on his own account but on behalf of the Italian company R. These further circumstances are as follows:

- in the field of trailers and semi-trailers, the appellant has only two serious European competitors, a German firm and the above-mentioned Italian company R.;
- referring to the documents submitted during the discussion before the department of first instance - specifically, to a number of photographs taken at the automobile exhibition held in Turin between 17 and 25 April 1993, and to an article published in a specialist magazine - the appellant takes the view that company R. is possibly infringing the European patent in question;
- the appellant finds it surprising that an individual with no document-searching facilities at his disposal was able to discover a document as relevant as D1 - on which the contested decision was based - although it did not figure in the European search report;
- it should also be pointed out that the opponent only declared his lack of any further interest in the proceedings after the appellant had requested that he be ordered to confirm under oath that he was acting on his own behalf. Two days before the oral proceedings, moreover, he sent a fax calling the board's attention to decision T 590/93 (OJ EPO 1995, 337). This conflicts with his statement that he had lost all interest in the case.

3.3.1 Having regard to all these circumstances, the appellant has reached the conclusion that company R. could well be the real opponent and that a "legitimate doubt" therefore exists in the sense of the above-cited decision T 635/88.

3.3.2 For the following reasons, the board finds this line of argument unacceptable:

3.3.3 As explained in point 1.2.4 of decision T 548/91 (not published in the OJ), Article 99(1) EPC establishes the presumption that "any person who submits an opposition also acts on his own behalf." This accords with the general practice of the

Office, which does not require an opponent to provide evidence of his circumstances and makes no attempt to verify them.

3.3.4 However, situations can indeed occur in which the identity of the real opponent is open to doubt. Obviously, for the reasons indicated above, such doubt cannot be based on deficiencies with regard to the opponents' circumstances or their interest in opposing the patent. Instead, legitimate doubt arises if, during the proceedings, it becomes apparent that a third party has claimed to be the real opponent. It is vital to ensure that the real opponent, ie the person on whose behalf the proceedings have been instituted, is known to the EPO, the proprietor of the contested patent and the general public. The reasons for this, set out in point 8.4 of the above-quoted decision T 635/88, are largely based on the principle, firmly established in board of appeal jurisprudence (see, for example, T 222/85 OJ EPO 1988, 128, point 6 in fine, confirmed in T 219/86, OJ EPO 1988, 254), that "oppositions must be filed and pursued ... so as to avoid ... uncertainty." As the Enlarged Board of Appeal noted in G 1/84 (OJ EPO 1985, 299), this would not be the case if the identity of the real opponent were unknown to the proprietor of the contested patent as well as to the general public.

3.3.5 The presumption referred to in T 548/91 is not beyond question; under specific circumstances, already defined by board of appeal jurisprudence, it may be set aside.

3.3.6 Thus, in the above-quoted decision T 10/82, the presumption that the "person who submits an opposition also acts on his own behalf" was invalidated by the opponents' admission, in the course of the proceedings, that they were not acting in their own name but on behalf of someone else. It was therefore quite clear that the stated opponents, ie the persons who had filed the notice of opposition under their name, were not the real opponents. Since there was no doubt about the facts of the situation, the board decided that the opposition was inadmissible.

3.3.7 In the above-mentioned case T 635/88, the circumstances were different. A consultancy firm in the field of intellectual property had opposed a European patent by filing a notice of opposition in its own name, thereby benefiting from the presumption that

it was the real opponent. However, a third party, summoned by the proprietor of the patent in question to appear before a national court for infringement, had claimed, in a document submitted as part of its defence, the status of an opponent. On the basis of this evidence adduced during the proceedings, and in view of the fact that the party which had filed the opposition was a consultancy firm retained by the defendant in the infringement proceedings, the board concluded that a doubt existed as to the real opponent's identity, and that this doubt was "legitimate". To end the uncertainty, the board asked the opponent which had filed the notice of opposition at the EPO to dispel the doubt by providing a sworn statement that it was acting in its own name and not on behalf of a client. In this case there was clear proof that a third party, other than the party which had filed the opposition, had claimed to be the real opponent.

3.3.8 However, proof that a third party has claimed to be the real opponent, and that this party is a client of the representative who has filed the opposition with the EPO, does not rule out the possibility that the latter, exercising the right to act on his own behalf (see Article 99 EPC - "any person"), may institute a purely personal action at law, regardless of all other considerations. In the above case, the board decided that there was, quite simply, a situation of legitimate doubt. The legitimacy of the doubt arose from the documentary evidence, contained in the file, that a third party had acted during proceedings before a national court as though it were the real opponent, and had thereby created a degree of legal uncertainty which was incompatible with the principle referred to in point 3.3.4 above.

3.3.9 In the present case, no such circumstances are apparent. It has not been shown that company R. had claimed to be the real opponent, so there is no "legitimate doubt", as previously defined and applied in T 635/88, to constitute a legal basis for requesting a sworn statement from the person in whose name the opposition was filed. It is up to the board to assess the probative value of the circumstantial evidence cited by the appellant; in this case, the board considers that the appellant's allegation of infringement by company R. does not suffice to prove that the latter company has claimed to be the real opponent. On the contrary, the board finds that there is only a single, named opponent, who is not subject to any restrictions regarding his personal circumstances or his interest

in acting, and who has asserted all along that he is acting on his own behalf; on these counts, therefore, his opposition is entirely admissible. His ambiguous attitude during the proceedings (see the final paragraph of point 3.3 above) may be open to consideration from an ethical point of view, but it has no bearing on the validity of the opposition proceedings.

3.4 Decision T 590/93, cited by the opponent, applies the principles explained in the foregoing (see, in particular, point 3 of the reasons).

3.5 It should also be pointed out that the obligation to provide a sworn statement in writing, as one of the means of giving evidence listed in Article 117(1) EPC, does not ensue automatically from a simple request by one of the parties. All the means of giving or obtaining evidence covered by Article 117 EPC are subject to the discretion of the EPO department concerned, which will only order their use if it considers this necessary. In the present case, as explained above, the sworn statement requested by the appellant would seem neither necessary nor useful, since it has not been shown that company R. was claiming to be the real opponent (see T 289/91, OJ EPO 1994, 649, point 2.2).

3.6 In consideration of the foregoing, the opposition is held to be admissible.

Consequently, the appellant's main request must be refused.

4. Appellant's request for the taking of evidence in order to establish that company R. was the real opponent

A request of this kind, couched in general terms, is inadmissible per se, since it does not refer to a specific means of obtaining evidence: for example, hearing witnesses, opinions by experts, or the production of documents. The only specific means requested by the appellant is the statement in writing (Article 117(1)(g) EPC), which was considered neither useful nor necessary; the request was therefore refused (see point 3.5 above).

The board has already explained why the presumption under Article 99(1) applies in the present case. It therefore sees no reason to take evidence of its own motion.

Finally, it should be emphasised that the opposition procedure was designed to enable third parties to get a patent limited or revoked by a department of the EPO, via a centralised procedure. It would therefore be inappropriate to devote a significant part of the proceedings to verifying that the person lodging the opposition is indeed acting on his own behalf. This is the basis of the presumption under Article 99(1) EPC.

5. Referral to the Enlarged Board of Appeal

The appellant has requested that the case be referred to the Enlarged Board of Appeal to obtain a definition of appropriate restrictions on the filing of oppositions by professional representatives.

Under the terms of Article 112(1) EPC, referral to the Enlarged Board is at the discretion of the boards of appeal "in order to ensure uniform application of the law or if an important point of law arises."

In the present case, neither of these two conditions is fulfilled. The present decision is in line with the established jurisprudence of the boards of appeal (see, especially, the above-mentioned decisions T 635/88, T 289/91 and T 590/93), which has already resolved the points of law to which the above ruling relates; consequently, these issues were no longer open to debate at the time when the present proceedings were instituted.

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

6. Auxiliary request (patent to be maintained in amended form)

6.1 Article 123 EPC

...

6.2 Novelty

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6.3 Problem - solution

...

6.4 Inventive step

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7. The board therefore finds that the reason given for opposition does not preclude maintaining the European patent in the amended version.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the instruction to maintain the patent on the basis of the amended claims and the relevant description, as filed during the oral proceedings, and the drawings in the original version as granted.

* This is an abridged version of the decision. A copy of the full text in the language of proceedings may be obtained from the EPO Information Office in Munich on payment of a photocopying fee of DEM 1.30 per page.