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**Datasheet for the decision  
of 24 October 2007**

**Case Number:** J 0009/06 - 3.1.01

**Application Number:** 01271394.7

**Publication Number:** 1358215

**IPC:** C08B 37/00

**Language of the proceedings:** EN

**Title of invention:**

Glycosaminoglycans derived from K5 polysaccharide having high antithrombin activity and process for their preparation

**Applicants:**

Oreste, Pasqua, et al

**Third Party:**

Inalco S.p.A.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 21(2), 61(1)

EPC R. 13, 67, 68(2)

RPBA 10b(1)

**Keyword:**

"Change of the composition of the Board (no)"

"Late-filed document - admitted"

"Suspension of proceedings (no)"

"Continuation of proceedings (yes)"

"Reimbursement of appeal fee (yes)"

**Decisions cited:**

G 0003/92, J 0028/94, J 0006/03, T 0146/82, T 0740/93,

T 0921/94

**Catchword:**

-



Case Number: J 0009/06 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 24 October 2007

**Appellants:**

Oreste, Pasqua  
Via Mac Mahon, 43  
I-20155 Milan (IT)

Zoppetti, Giorgio  
Via Mac Mahon, 43  
I-20155 Milan (IT)

**Representative:**

Gislon, Gabriele  
Marietti, Gislon e Trupiano S.r.l.  
Via Larga, 16  
I-20122 Milano (IT)

**Third Party:**

Inalco S.p.A.  
Via Calabiana, 18  
I-20122 Milano (IT)

**Representative:**

Gerli, Paolo  
Notarbartolo & Gervasi  
Corso di Porta Vittoria 9  
I-20122 Milano (IT)

**Decision under appeal:**

**Decision of the Legal Division of the European  
Patent Office of 8 December 2005.**

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** T. Karamanli  
C. Heath

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the Legal Division dated 8 December 2005 upholding the suspension of the grant proceedings before the European Patent Office (EPO) pursuant to Rule 13(1) EPC in respect of European patent application No. 01 271 394.7 as from 15 July 2004 and rejecting the request not to suspend proceedings.
- II. The present European patent application is based on international application PCT/IB01/02492 (hereafter the "international application") filed on 17 December 2001 and published as WO 02/50125, claiming priority from patent applications US 09/738,879 (hereafter the "US priority application 1") and US 09/950,003 (hereafter the "US priority application 2"). Both US priority applications claim priority from the Italian patent application MI2000A000665 (hereafter the "Italian application").
- III. In a letter dated 8 July 2004, received at the EPO on 13 July 2004, a third party filed a request for suspension of the proceedings for grant pursuant to Rule 13(1) EPC on the grounds that proceedings concerning the entitlement to the European patent application in suit had been initiated against the joint applicants before the Italian Court of Milan, together with a copy of the "writ of summons" of 20 May 2003 and a translation thereof into English. The confirmation copy was filed on 15 July 2004.

Request 4 of this writ of summons reads:

*"To find and declare all the rights connected with the patent which is subject of application n° MI2000A000665 - including the right to extension abroad and in particular to the territory in the United States of America - belong to INALCO and, therefore, to authorise INALCO to hold in its name the US patent applications n° 09/738,879 and n° 09/950,003, with a transfer of the patent eventually granted in favour of INALCO."*

- IV. By a communication dated 3 November 2004 the Legal Division informed the applicants and the third party that the proceedings before the EPO had been suspended in respect of the present European patent application as from 15 July 2004 and that the third party had not consented to the continuation of the grant proceedings.
- V. In a letter received on 27 December 2004 at the EPO the applicants requested that the proceedings for grant not be suspended and, as an auxiliary request, that an appealable decision be issued and for the EPO "to set a date in which the proceedings will be continued". They submitted evidence that they had filed a law suit against the third party at the Court of Milan on 12 February 2001, i.e. well before the respondent filed its writ of summons, and that they had asked the Court of Milan to ascertain and declare that they had acquired the absolute freedom of disposing of the invention disclosed in the Italian application and of the rights deriving from it, including further technical developments. They also submitted that such developments, being distinct new subject-matter with respect to the Italian application, were added to the US priority applications 1 and 2. This subject-matter

was then claimed in the subsequent European patent application in suit.

VI. The Legal Division issued a decision on 8 December 2005 stating that, pursuant to Rule 13(1) EPC and in view of the case law of the Boards of Appeal (J 28/94, OJ EPO 1997, 405, point 3 of the Reasons and T 146/82, OJ EPO 1985, 267, point 2 of the Reasons), the EPO had to suspend grant proceedings in respect of the present European patent application *ex officio* "without having a discretionary power and without hearing the patent proprietor", since the third party had filed sufficient proof for the opening of entitlement proceedings against the applicants of the European patent application in suit before the Italian Court of Milan and it did not consent to the continuation of proceedings. The Legal Division thus rejected the request to continue proceedings and stated that the proceedings remained suspended as from 15 July 2004.

VII. By a letter received on 13 February 2006 at the EPO, the applicants requested the Legal Division to "restart" the grant proceedings and filed a copy of decision No. 4080/05 dated 20 April 2005 of the Court of Milan (hereafter the "Judge Bonaretti" decision) and a copy of the third party's appeal against said decision. In the applicant's view there were no entitlement proceedings pending with respect to the present European patent application because this application was not reassigned to the third party in the "Judge Bonaretti" decision and, in its appeal against this decision before the Italian court, the third party did not ask for the reassignment of the present application. Thus the European patent

application in suit remained in the name of the applicants.

As an auxiliary measure, the applicants requested an appealable decision.

- VIII. On 17 February 2006 the applicants (appellants) filed a notice of appeal against the Legal Division's decision and paid the appeal fee. The statement setting out the grounds of appeal was filed on 18 April 2006.
- IX. By letter of 18 May 2006, the Legal Division informed the appellants and the third party (respondent) that it had decided not to rectify the contested decision and the present appeal was remitted to the Legal Board of Appeal.
- X. The Board summoned the appellants and the respondent to oral proceedings. By a communication pursuant to Article 11(1) of the Rules of Procedure of the Board of Appeal (RPBA) dated 31 August 2007, the Board set out its preliminary and non-binding opinion on the merits of the appeal.

The Board first pointed out that the requirements of Rule 13(1) EPC for suspending the grant proceedings did not seem to have been met, since the documents submitted by the respondent did not provide sufficient evidence that the respondent had opened entitlement proceedings against the appellants. In the Board's preliminary view none of the requests in the respondent's writ of summons of 20 May 2003 appeared to be clearly and unambiguously directed to a finding of the national court that the third party rather than the

applicants was entitled to the grant of the European patent in suit. The requests in the writ of summons were directed to the adjudgement of the entitlement with regard to the US priority applications and the Italian application. The Board noted that it was not possible for the EPO, nor was it its function in the context of the examination of a request to suspend proceedings under Rule 13 EPC to examine to what extent, if any, the subject-matter contained in a European patent application in respect of which suspension was requested might correspond to the subject-matter of another application, ownership of which was disputed before a national court. The Board further set out that if there was any need or room for interpretation of the meaning of a claimant's request in a law suit before the national court, it was within the sole competence of that national court to interpret the extent of the claimant's claim and it was not for the EPO to perform any such interpretation in the context of a decision on suspension.

With regard to the continuation of the grant proceedings the Board set out that, even if the suspension of proceedings was justified under Rule 13(1) EPC, in accordance with Rule 13(3) EPC, it lay within the discretion of the EPO to decide *ex officio* or upon request on which date proceedings were to continue regardless of the state reached in the national entitlement proceedings.

XI. In response to this communication the respondent made further submissions and filed inter alia a table in which the claims of the international application and

of the US priority application 2 (US 09/950,003) were presented synoptically.

- XII. In a letter dated 17 October 2007, the appellants made further submissions and filed a full copy of the interim decision 10397/05 dated 27 September 2005 of the Court of Milan (hereafter the "Judge Rosa" decision) and the respondent's summary of conclusions filed on 20 October 2003 in said national court proceedings.
- XIII. Oral proceedings were held on 24 October 2007. During these proceedings the respondent presented a copy of the English translation of page 2 of the conclusions of the respondent which had been already filed in Italian by the appellant (see point XII above). The appellants requested that the decision under appeal be set aside, and that the proceedings for grant be resumed as soon as possible.
- XIV. The respondent requested that the appeal be dismissed, or in the auxiliary that examination proceedings for grant be resumed in September 2008. Further it requested that the present Legal Board of Appeal be enlarged by the addition of a technically qualified member.
- XV. The appellants' arguments presented in writing and during oral proceedings, insofar as relevant to the present decision, can be summarised as follows:

*Composition of the Legal Board of Appeal*

The respondent's request for enlarging the Board by the addition of a technically qualified member should be



refused since such a change of the Board's composition was not possible under the EPC and even if it were, it would cause unnecessary delay to the appeal proceedings.

*Late-filed document*

The copy of the English translation of page 2 of the respondent's conclusions was presented by the respondent at a very late stage of the proceedings before the Board, i.e. during the oral proceedings, and therefore was late-filed. There was not sufficient time for the appellants to check the correctness of this translation. Page 2 was also absolutely irrelevant because neither the international application nor the European patent application in suit were mentioned therein. Thus the translation should not be admitted into appeal proceedings.

*Suspension of proceedings*

The requirements for suspension under Rule 13(1) EPC were not fulfilled because entitlement proceedings had not been not opened before the Court of Milan with respect to the European patent application in suit.

The question in the present case was whether or not it was clear from the respondent's writ of summons and conclusions that entitlement proceedings with respect to the European patent application in suit had been opened. This question should be answered without interpreting the respondent's requests broadly. Also in decision J 6/03 of 29 September 2004 the requests made in proceedings before the Canadian court were not

interpreted in a broad manner. The facts in decision J 6/03 were different from those in the present case. As pointed out in the Board's preliminary opinion, the interpretation of unclear requests was within the competence of the national court. The legal questions concerning the ownership of a patent could not be discussed before the EPO. It was not the task of the Legal Board of Appeal to interpret the requests of the legal proceedings before a national court.

In the evidence on file it was nowhere explicitly mentioned that the present European patent application should be in the ownership of the respondent. There was also no reference to **all** applications filed by the appellants in these documents. Request 4 of the writ of summons did not relate to the present application since the international application published as WO 02/50125 was not mentioned therein, although the respondent was aware of its existence. The starting point in the respondent's writ of summons and conclusions was always the Italian application. In the second half sentence of page 2, point C) of the conclusions the ownership was claimed with regard to "said applications". But this referred to those which were mentioned in the first half sentence of point C), i.e. the Italian application and "all corresponding foreign extensions". An "extension" was an application which claimed priority directly from the Italian application. This was true for the US priority applications. However, the European patent application did not claim priority from the Italian application. Moreover the appellants' international application was neither an extension of the priority rights of the Italian application, nor a copy of the applications filed by the respondent, but

contained new subject-matter with respect to the Italian application.

In his interim decision Judge Rosa also stated that his court had no jurisdiction for deciding on the ownership of the US priority applications and that this matter should be decided by foreign authorities. Nothing was said however on the jurisdiction over deciding on the ownership of the international or European application. This meant that this was not the subject of a dispute. Thus entitlement proceedings had been opened before the Italian court only with respect to the US priority applications.

*Continuation of proceedings*

Since the suspension of proceedings for grant was not justified, proceedings should be continued as soon as possible, preferably on the date of the Board's decision.

Both parties appealed against the "Judge Bonaretti" decision and it would take about four years for a final decision in these proceedings to be reached - proceedings which neither related to the ownership of international application published as WO 02/50125 nor to the ownership of the present European patent application. In the interim decision proceedings before the Court of Milan were suspended as far as the original Italian application was concerned until a final decision in the "Judge Bonaretti" case was reached. Therefore, it would take even longer until a final decision was reached in this case.

XVI. The respondent's arguments presented in writing and during oral proceedings, insofar as relevant to the present decision can be summarised as follows:

*Composition of the Legal Board of Appeal*

The current state of proceedings showed the difficulty in completely separating the legal issues from certain technical considerations about the invention. For this reason it would be advisable to ensure that possible technical issues were discussed before a Legal Board of Appeal enlarged by the addition of a technically qualified member at oral proceedings.

*Late-filed document*

The copy of the English translation of page 2 of the respondent's conclusions should be admitted into the appeal proceedings since it was a translation of a page of a document which had already been filed in Italian by the appellants and which was highly relevant as evidence for the content of the respondent's writs of summons.

*Suspension of proceedings*

The decision of the Legal Division to suspend proceedings under Rule 13(1) EPC had been and was still fully justified.

There was no need to formulate a claimant's request in such a way that it literally repeated the wording of Rule 13(1) EPC, but it could also be formulated in other words. Such a request had to be interpreted

broadly by the EPO, taking into account all circumstances of the case.

Such a broad interpretation of a claimant's request was applied in decision J 6/03, where the claim read:  
*"...an order requiring the defendants to assign to the plaintiffs any and all right, title and interest they own in the patent applications and any other related or corresponding patents or applications, and in the alleged inventions disclosed therein."* (J 6/03, point II of the Facts and Submissions).

The facts of this decision were comparable to those of the present case. In Request 4 of the writ of summons neither the European patent application in suit nor the international application on which it was based were explicitly mentioned. However, in this Request, several patent applications which were connected with said European and international applications were referred to. Request 4 had to be read together with page 2, point C) of the conclusions where the transfer of the ownership of "all corresponding foreign extensions" was clearly requested. Thus a general reference to all applications, which were discussed in the writ of summons as a whole, was made. It was clear from the writ of summons that all applications cited therein should be in the respondent's name. The appellants' understanding that "all corresponding foreign extensions" were only applications which claimed priority from the Italian application was not correct. "Extension" meant any patent application or patent which claimed the same invention as the Italian application. In the present case there was a cascade of applications which were nearly identical. A technically

qualified member would know that adding subject-matter did not necessarily mean that a new invention was added. The fact that the US priority application 2 was a continuation-in-part application did not necessarily mean that a new invention had been added. Therefore, "said applications" in the second half sentence of point C) of the conclusions also comprised the present European patent application.

By interpreting a request broadly as was done in decision J 6/03, an unmistakable ownership claim was derivable from the wording of Request 4 of the respondent's writ of summons and conclusions. In its request to retain the US priority applications 1 and 2 in its name, the respondent claimed in fact that it was the person entitled to the grant of the European patent based on the present application. Since all independent claims were identical in the US priority application 2 and the present application as published, the application in suit definitely contained claimed subject-matter with respect to which the respondent had opened entitlement proceedings in Italy.

In addition, Request 6 of the writ of summons - which should be read in the sense of assuming the respondent's ownership of the applications mentioned therein - necessarily meant that the respondent did not recognise the appellants as the applicants entitled to the international application published as WO 02/50125. This claim had to be read in the light of the respondent's full description of the case which could be found in the writ of summons. On page 18, 2nd paragraph of the writ of summons it was clearly stated that the US priority applications and the international

application were a copy of the Italian application filed by the respondent.

*Continuation of proceedings*

Even if the requirements for the suspension of the proceedings for grant were not met in the present case, the EPO would not be prevented from applying Article 61 EPC when a final decision is reached by the Italian courts. Proceedings before the EPO should therefore remain suspended until September 2008 because of the current stage of the Italian court proceedings. The suit concerning the "Judge Bonaretti" case would be decided in four months at the latest. The same applied to the "Judge Rosa" case. The delay in the latter case before the Italian courts was caused by the appellants and not by the respondent so that no delaying tactic was being undertaken by the present third party.

**Reasons for the Decision**

1. The appeal is admissible.
2. *Composition of the Board*

In the present case the appeal lies from a decision of the Legal Division. The competence and composition of the Legal Board of Appeal for appeals from a decision of the Legal Division is laid down in Article 21(2) EPC. This provision stipulates that in such appeal proceedings the Board of Appeal shall consist of three legally qualified members (the "Legal Board of Appeal"). This provision is mandatory and the EPC does

not foresee that appeals from a decision of the Legal Division are dealt with by the Legal Board of Appeal in a different composition. Therefore, the composition of this Board cannot be changed as requested by the respondent. Thus the respondent's request to enlarge the Legal Board of Appeal by the addition of a technically qualified member has to be refused.

3. *Late-filed document*

The copy of the English translation of page 2 of the respondent's conclusions filed during the oral proceedings before the Board is a partial translation of a document which had already been filed in Italian by the appellants. In the Board's view, the content of that page does not raise complex legal issues which, if considered at this stage of proceedings, would cause a delay in proceedings. Therefore, in exercising its discretion under Article 10b(1) RPBA, the Board admits this translation into the appeal proceedings.

4. *Suspension of the proceedings for grant*

4.1 Rule 13(1) EPC stipulates that if a third party provides proof to the EPO that it has opened proceedings against the applicant for the purpose of seeking a judgment establishing that it is entitled to the grant of the European patent, the EPO shall stay the proceedings for grant unless the third party consents to the continuation of such proceedings.

4.2 The provisions of the Implementing Regulations on suspension have to be seen in their proper context, in particular that of Article 61(1) EPC, which governs the



procedural rights of a person who has been adjudged to be entitled to the grant of a European patent, as opposed to the actual applicant for a European patent (G 3/92, OJ EPO 1994, 607, point 1 of the Reasons).

In its decision G 3/92 (*supra*, point 3 of the Reasons) the Enlarged Board of Appeal held:

*"Under the European patent system, the EPO has no power to determine a dispute as to whether or not a particular applicant is legally entitled to apply for and be granted a European patent in respect of the subject-matter of a particular application.*

*Determination of questions of entitlement to the right to the grant of a European patent prior to grant is governed by the "Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the grant of a European Patent" (the "Protocol on Recognition"), which is an integral part of the EPC. This Protocol gives the courts of the Contracting States jurisdiction to decide claims to entitlement to the right to the grant of a European patent, provides a system for determining which national court shall decide such claims in individual cases, and requires the mutual recognition of decisions in respect of such claims, within the Contracting States to the EPC."*

- 4.3 In the light of this reasoning of the Enlarged Board of Appeal, the Board concludes that it is not possible for the EPO, nor is it its function in the context of the examination of a request to suspend proceedings under Rule 13 EPC, to examine whether and, if so, to what extent, the subject-matter disclosed in a European patent application in respect of which suspension is

requested corresponds to the disclosure of another application, ownership of which is disputed before a national court. Therefore, the Board does not concur with the respondent's argument that, when evaluating the evidence filed in support of the alleged opening of entitlement proceedings within the meaning of Rule 13(1) EPC, the Board has to compare the technical content of the European patent application in suit with the technical content of the Italian application and the US priority applications, ownership of which is disputed before the Italian courts. This is a task which cannot and should not be undertaken in the course of examining a request under Rule 13(1) EPC. Rather, if there is any need or room for interpretation of the meaning of a claimant's request in a law suit before the national court, it is within the sole competence of that national court to interpret the extent of the claimant's claim and it is not for the EPO to perform any such interpretation in the context of a decision on suspension.

The Board does not agree with the respondent's view that in decision J 6/03 a broad interpretation was applied. In point 6 of the Reasons it was held that "*claim No. 1(n) of the plaint before the Canadian Court of Ontario can be **considered** (emphasis added by the Board) to be a claim to the entitlement to the grant of a European patent according to the requirements under Rule 13(1) EPC*". Since the relevant claim was **considered** to be a claim to the entitlement to the grant of a European patent, in case J 6/03 no decision was taken on the question whether or not this claim actually was one within the meaning of Rule 13(1) EPC. However, what was actually decided, was that

entitlement proceedings initiated before a Canadian court were not proceedings within the meaning of Rule 13(1) EPC.

4.4 As the wording of Rule 13 EPC suggests, the EPO is only entitled to suspend the proceedings for grant if there is clear and unambiguous proof that the claimant's request in the proceedings before the national court is for judgement that he is entitled to the grant of the European patent application which is to be suspended. Even if it were accepted that the claimant's request does not have to be formulated in such a way that it repeats literally the wording of Rule 13(1) EPC, the documents filed as evidence must, however, allow an unambiguous identification by the number of the European patent or the European patent application in question.

4.5 None of the respondent's requests in the writ of summons is for judgement that he is entitled to the right to the grant of the European patent in respect of the European patent application in suit.

4.5.1 The only request in the writ of summons explicitly referring to the present European patent application is request 6). Therein however, the respondent does not request a transfer of the application in suit or a statement by the court that the respondent is the person entitled to the grant of said patent. What is requested is a finding by the court that the use by the appellants of the subject-matter covered by the application in suit would be an infringement of that application and that the appellants be restrained from

using the subject-matter of the application in suit until a final decision has been reached.

4.5.2 All the other requests refer to applications other than the present application: Requests 1) and 2) refer to national Italian applications and "related applications abroad". Their relation to the European patent application in suit, if any, is undefined. Requests 3) and 4) refer to the two US applications, priority from which is claimed in the application in suit, to the Italian patent application priority from which is claimed in the US patent applications and to the right to the extension of the Italian patent application abroad, rather than to the European patent application in suit.

4.5.3 In the Board's view, Request 4 also does not relate to the present European patent application if Page 2, point C) of the conclusions is taken into account. The application to which reference is made in the respondent's writ of summons and conclusions is always the Italian application. The Boards concurs with the appellants' argument that an "extension" is an application which claims priority directly from the Italian application. In the present case this is only true for the US priority applications, but not for the European patent application which claims priority only from the US priority applications 1 and 2. Therefore, the European patent application is not an extension of the priority rights of the Italian application.

4.5.4 The very fact that a priority is claimed allows no conclusion as regards the degree of correspondence, if any, between the priority application and the later

application. There is nothing on the present file showing that the application in suit would be identical word-for-word to the original Italian filing or one of the original US filings. The present application is connected to the Italian patent application only via a cascade of priorities. The US priority application 2 from which priority is claimed in the European patent application in suit is a continuation-in-part of the US priority application 1, thus pointing to added subject-matter. Therefore, in a case such as the present one, it would not be possible to determine the relationship between the Italian patent application or one of the US patent applications (ownership of which is disputed before the Italian courts) and the application in suit without a detailed examination and comparison of the technical contents, a task which cannot and should not be undertaken in the course of examining a request under Rule 13(1) EPC (see point 4.3 above).

- 4.6 In view of the above, as a third party within the meaning of Rule 13(1), the respondent has not proven that it has opened national entitlement proceedings with respect to the present European patent application against the appellants seeking a decision that the respondent rather than the appellants is entitled to the grant of the European patent. Therefore, taking into account the evidence on file, the requirements of Rule 13(1) EPC for suspending the grant proceedings have not been met in the present case. Thus the Board comes to the conclusion that the decision under appeal is to be set aside.

5. *Continuation of the proceedings for grant*

- 5.1 According to decision J 28/94 (*supra*, points 2.1 to 2.2.1 of the Reasons), suspension of grant proceedings pursuant to Rule 13(1) EPC is ordered by a communication without hearing the applicant for a European Patent or taking a formal decision. The immediate effect of such a communication is justified as a preventive measure to protect the third party's rights during entitlement proceedings.
- 5.2 In the present case, suspension as from 15 July 2004 was ordered by the Legal Division's communication dated 3 November 2004. Although the requirements for suspension of the proceedings were not met from the beginning in the present case, the Board has to order the continuation of the grant proceedings because the immediate effect of the suspension can neither be set aside with retroactive effect, nor be reversed by a decision in these appeal proceedings.
- 5.3 The Board agrees with the submissions of the appellants that the proceedings for grant should be continued as soon as possible, since the respondent did not provide sufficient evidence that it had commenced entitlement proceedings against the appellants from the outset.
- 5.4 However, the Board cannot concur with the respondent's argument that it would be justified in the present case to continue grant proceedings only as from September 2008 in view of the fact that the proceedings before the national courts are at a very advanced stage and therefore decisions are soon to be expected. Once it is established after proceedings have been suspended, that

at no time had the requirements of Rule 13(1) EPC been fulfilled, the proceedings for grant are to be continued as soon as possible taking into account the circumstances of the case.

6. In the present case the appellants declared that they had no objection against the continuation of the grant proceedings as from the date of the Board's decision. Therefore, the Board orders that the proceedings are to be continued from that date, and that the case is remitted to the first instance for further prosecution.

7. *Reimbursement of the appeal fee*

- 7.1 The reimbursement of the appeal fee is ordered where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantive procedural violation (Rule 67 EPC).

- 7.2 According to Rule 68(2) EPC, the decisions of the European Patent Office open to appeal shall be reasoned. Reasoning within the meaning of Rule 68(2) EPC does not mean that all the arguments submitted must be dealt with in detail, but it is a general principle of good faith and fair proceedings that reasoned decisions contain, in addition to the logical chain of facts and reasons on which every decision is based, at least some motivation on crucial points of dispute in this line of argumentation in so far as this is not immediately apparent from the reasons given, in order to give the party concerned a fair idea of why its submissions were not considered convincing (T 740/93 of 10 January 1996, point 5.4 of the Reasons and T 921/94 of 30 October 1998, point 6.2.3 of the Reasons).

7.3 In the reasoning of the decision under appeal the requirements for suspension of the proceedings for grant according to Rule 13(1) EPC and the relevant case law of the Boards of Appeal are mentioned. Thereafter, it is merely stated as a conclusion that these requirements are fulfilled. However, no reasons are given as to why that would be the case. In particular with regard to the requirement of providing proof for the opening of entitlement proceedings the Legal Division has not explained why and to which extent the evidence filed by the third party is sufficient. Having regard to the fact that the appellants contested in the first instance proceedings that the requirements for suspension were fulfilled in the present case the Legal Division should have dealt in detail with the evidence on file and the appellants' arguments in its decision. By failing to do so, the Legal Division did not give the appellants a fair idea of why their submissions were not considered convincing. Therefore, the requirements of Rule 68(2) EPC are not fulfilled in the present case and a substantial procedural violation occurred in the first instance proceedings.

7.4 Since the decision of the first instance contravenes Rule 68(2) EPC, it is equitable to reimburse the appeal fee pursuant to Rule 67 EPC.



**Order**

**For these reasons it is decided that:**

1. The request for enlarging the Legal Board of Appeal by the addition of a technically qualified member is refused.
2. The decision under appeal is set aside.
3. The proceedings for grant are continued.
4. Reimbursement of the appeal fee is ordered.
5. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel