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**Datasheet for the decision
of 13 November 2012**

Case Number: J 0007/10 - 3.1.01

Application Number: 03816761.5

Publication Number: 1628582

IPC: A61B 17/11, A61B 17/064

Language of the proceedings: EN

Title of invention:
Screw-device for anastomosis

Applicant:
De Winter, Erwin

Third Party:
University Medical Centre (UMC) of the University of Utrecht

Headword:
Stay of proceedings/DE WINTER

Relevant legal provisions:
EPC Art. 108
EPC R. 14, 103

Keyword:
"Stay of proceedings for grant"
"Resumption of proceedings for grant"
"Reimbursement of the appeal fee (no)"

Decisions cited:
J 0028/94, J 0007/96, J 0036/97, J 0010/02, J 0033/03,
J 0009/10, T 0146/82, T 1561/05, T 0388/09

Catchword:
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Case Number: J 0007/10 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 13 November 2012

Appellant:
(Applicant)

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Representative:

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Respondent:
(Third Party)

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Representative:

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Decision under appeal:

**Decision of the Legal Division of the European
Patent Office of 17 August 2009.**

Composition of the Board:

Chairman: B. Günzel
Members: C.-P. Brandt
C. Vallet

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Legal Division of the European Patent Office (EPO) dated 17 August 2009 upholding the suspension of the grant proceedings before the EPO pursuant to Rule 14(1) EPC as from 22 October 2008 in respect of European patent applications EP 03 816 760 (the subject of appeal case J 6/10) and EP 03 816 761, both filed by the same applicant (Mr Erwin de Winter), and rejecting the request that the proceedings be resumed.
- II. European patent application 03 816 761 is based on international application PCT/BE03/00126 filed on 22 July 2003.
- III. In a letter dated 28 November 2005 the University Medical Centre of the University of Utrecht, the Netherlands (hereinafter "UMC" or "the third party") submitted that the invention claimed should be considered as belonging to UMC under Dutch law. Suspension of the proceedings under Rule 13 EPC 1973 was requested.
- IV. By a communication dated 29 December 2005 the Legal Division informed UMC that in the absence of evidence that it had instituted national court proceedings, the proceedings before the EPO could not be stayed.
- V. With letter dated 30 October 2006 UMC filed "a draft of the action of entitlement" against the applicant.
- VI. By a communication dated 10 November 2006 UMC was informed that proceedings could not be stayed until

- such time as the action on entitlement was filed before a competent court.
- VII. By letter dated 22 October 2008 UMC filed a further request that the proceedings for grant be stayed, based on proceedings initiated before the District Court of The Hague. As evidence it attached a copy of a writ of summons, in Dutch, dated 15 October 2008. In reply to a communication of the Legal Division, UMC submitted an English translation of the writ with letter dated 16 December 2008. The writ of summons indicated both European patent applications mentioned in point I above.
- VIII. By a communication dated 15 January 2009 the proceedings for grant concerning both European patent applications concerned were stayed under Rule 14(1) EPC as from 22 October 2008.
- IX. With letter dated 22 May 2009 the applicant objected to the stay of proceedings and requested their resumption.
- X. The Legal Division issued a decision on 17 August 2009 stating that the grant proceedings for European patent applications 03 816 760 and 03 816 761 would not be resumed. It pointed out that if the conditions for staying proceedings under Rule 14(1) EPC were fulfilled the EPO was obliged to stay them; it had no discretion in the matter. In view of the interests of both parties involved, the Legal Division did not consider it appropriate to resume the proceedings.
- XI. On 16 October 2009 the applicant/appellant filed notice of appeal against the Legal Division's decision. Only one appeal fee was paid, which was allocated by the EPO

- to European patent application 03 816 760 (the subject of appeal case J 6/10). The statement setting out the grounds of appeal was filed on 14 December 2009.
- XII. By communication dated 2 July 2010 the Legal Board of Appeal informed the appellant that although in a legal sense there were two separate appeal proceedings (J 6/10 and J 7/10) only a single appeal fee had been paid, which the EPO had allocated to appeal J 6/10. The appellant was given the opportunity either to pay the missing second appeal fee or to indicate clearly and unambiguously to which appeal it wanted the appeal fee paid by debit order dated 16 October 2009 to be allocated.
- XIII. With letter dated 9 September 2010 the appellant confirmed within the time limit set by the Board that the said fee should be allocated to appeal J 6/10. It also enclosed a voucher for payment of a second appeal fee, for the present appeal J 7/10.
- XIV. By communication dated 21 April 2011 the Board informed the appellant that the arguments so far submitted by the appellant failed to convince it that the decision under appeal was erroneous and had to be set aside.
- XV. With letter dated 2 December 2011 the third party informed the Board that the reason for which the District Court of The Hague had suspended the Dutch proceedings by decision of 29 April 2009, i.e. pending a decision by the Belgian courts on competence to hear the dispute between Dr De Winter and UMC, no longer applied, the Belgian Supreme Court having ruled that it had no competence to hear that case. However, the Dutch

proceedings were still suspended under Dutch law because Dr De Winter's attorney in those proceedings had retired.

- XVI. With letter dated 31 July 2012 UMC informed the Board that there was still no decision by the Dutch court on the ownership of the patent applications concerned, and no date had been set for a hearing in the proceedings before the District Court of The Hague.
- XVII. With letter dated 13 August 2012 the parties were summoned to oral proceedings, requested by both parties and scheduled for 13 November 2012.
- XVIII. With letter dated 15 October 2012 UMC made further submissions in support of dismissing the appeal and prolonging the stay of the proceedings. None of the grounds set out in the Guidelines for Examination (A-IV, 2.3) for lifting the stay of the proceedings was fulfilled.

The long duration of the Dutch entitlement proceedings resulted from various actions taken by the appellant in Belgium. During proceedings in Belgium the Dutch court had stayed the entitlement case, resuming it only early in 2012. UMC informed the Board that it was preparing a reply in order to speed up the proceedings before the District Court of The Hague.

- XIX. Oral proceedings before the Legal Board of Appeal were held on 13 November 2012. Neither UMC (the respondent), as announced with letter dated 15 October 2012, nor the representative of the appellant, as announced with

letter dated 9 November 2012, nor the appellant itself attended the oral proceedings.

XX. During the written proceedings the appellant requested that the contested decision of the Legal Division be set aside, and the suspension of the grant proceedings lifted. As an auxiliary request it asked the Board to exercise its discretion under Rule 14(3) EPC and order an immediate resumption of the proceedings on European patent application 03 816 761.

He further requested the Board to issue a decision on whether the request for payment of the second appeal fee was justified and, if it decided that it was not, to order the fee's reimbursement.

During the written proceedings the respondent requested that the appeal be dismissed and the proceedings stayed until the competent Dutch courts had taken a final decision on the ownership of the relevant applications, or, as an auxiliary request, that the Board set a date for resuming the proceedings, which should be no earlier than the beginning of 2014, by which time a first-instance decision from the Dutch court on the merits of the entitlement claim could be expected.

Reasons for the Decision

1. *Applicable provisions*

Rule 14 EPC rather than Rule 13 EPC 1973 applies. Rule 14 EPC implements Article 61 EPC. In this respect the Board refers to Article 7(1), second sentence, of the Revision Act of 29 November 2000 (OJ EPO 2001, Special Edition No. 4, 50), Article 1.1, first sentence, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the said Revision Act (OJ EPO 2007, Special Edition No. 1 of OJ EPO 2007, 197) and Article 2 of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000 (OJ EPO 2007, Special Edition No. 1, 89).

2. *Admissibility of the appeal*

The appellant having confirmed within the time limit set by the Board that the appeal fee paid on 16 October 2009 was rightly allocated to J 6/10, and having also enclosed a voucher for payment of a second appeal fee, for the present appeal J 7/10, the appeal is admissible.

The Legal Division's decision

3. The arguments submitted by the appellant fail to convince the Board that, by the time it was given the contested decision of 17 August 2009 not to resume the proceedings stayed with effect as from 22 October 2008

was erroneous and would have had to be set aside for that reason.

Under Rule 14(1) EPC the EPO must stay the proceedings *ex officio* if a third party shows that it has opened proceedings against the applicant in a contracting state for the purpose of seeking a judgement that it is entitled to the grant of the European patent (J 28/94, OJ EPO 1997, 400, point 3.1 of the Reasons; T 146/82, OJ EPO 1985, 267, point 2 of the Reasons.; J 10/02 of 22 February 2005, point 3.1 of the Reasons; J 7/96, OJ EPO 1999, 443, point 2 of the Reasons; J 36/97 of 25 May 1999, point 2 of the Reasons; J 33/03 of 16 November 2004, point 2.1 of the Reasons). These requirements were met once the third party had filed, with letter dated 16 December 2008, an English translation of the writ of summons dated 15 October 2008 which indicated that it had applied to the District Court of The Hague for a judgement that it was entitled to the grant of European patent application 03 816 761. The appellant's contention that UMC's unsuccessful attempts to obtain a stay of grant proceedings constituted illegitimate and abusive conduct cannot be taken into account for Rule 14(1) EPC purposes, but will be considered within the context of the Board's decision on Rule 14(3) EPC as regards the auxiliary request (see 4.3 below).

4. *Resumption of proceedings by the Board*

- 4.1 According to Rule 14(3) EPC, the EPO may, after staying the proceedings for grant, set a date on which it intends to resume them, regardless of the stage reached in the national proceedings instituted under Rule 14(1)

EPC. In the present case this pertains to the entitlement proceedings instituted by the third party against the appellant before the District Court of The Hague in October 2008. Under Rule 14(3) EPC the EPO has discretion to decide whether and as from which date the proceedings for grant are to be continued. In accordance with Article 111(1), second sentence, EPC the Board has decided that it will exercise the power within the competence of the department which was responsible for the decision under appeal.

4.2 Some aspects of the exercise of discretion under Rule 14(3) EPC have been considered in the case law of the Boards of Appeal of the EPO. These aspects are in particular (i) how long the proceedings before the national courts/authorities have been pending, (ii) the duration of the suspension of grant proceedings, and (iii) requests for suspension of grant proceedings filed at a late stage.

4.2.1 Regarding aspects (i) and (ii), the period for which the proceedings before the national courts/authorities have been pending and the duration of the suspension of grant proceedings are nearly equal in length. The third party had shown that it had initiated entitlement proceedings before the District Court of The Hague concerning European patent application 03 816 761. The grant proceedings were consequently stayed under Rule 14(1) EPC as from 22 October 2008. From this it follows that at the time of the present decision of the Legal Board of Appeal, the proceedings before the District Court of The Hague and the suspension of grant proceedings concerning European patent application 03 816 761 have both lasted more than four years.

4.2.2 According to the case law of the Boards of Appeal on Rule 14(3) EPC, a period of more than four years is considerable, both for grant proceedings to be stayed and for entitlement proceedings to be pending in first instance.

In decision T 146/82 (OJ EPO 1985, 267 No. 3 of the Reasons), "having regard to the considerable length of time for which the proceedings before the UK Patent Office have been pending" (about three years) the Board set a date for resumption of grant proceedings. In decision J 33/03 of 16 November 2004 the Board ordered immediate resumption of grant proceedings when they had been suspended for about three years and two months, even though the main reason for immediate resumption was that the request for suspension had been filed at a very late stage in those proceedings (see 4.6 below).

4.3 However, the four-year duration both of the suspension of grant proceedings and of the entitlement proceedings pending at the District Court of The Hague is not in itself the sole decisive factor for the Board's conclusion that prompt resumption of the grant proceedings should be ordered. Rather, it has to be seen in connection with the third party's procedural conduct in filing its requests under Rule 14(1) EPC before the Legal Division.

4.3.1 The third party's first attempt to achieve stay under Rule 14(1) EPC, by letter dated 28 November 2005, was unsuccessful due to the lack of any evidence that it had instituted national court proceedings. It was then and thereafter informed by the Legal Division that

proceedings could not be stayed until such time as the action on entitlement had been filed before a competent court. Almost one year later the third party filed a "draft of the action of entitlement". By letter dated 22 October 2008 and, hence, another two more years later, the third party again filed a request for the stay of the proceedings for grant relating to European patent application 03 816 761, based on proceedings initiated before the District Court of The Hague. However, it filed as evidence only a copy of a writ of summons, in Dutch, dated 15 October 2008. Only in response to a further communication from the Legal Division did it finally file an English translation of the writ, by letter dated 16 December 2008. Only then was the Legal Division in a position to stay the proceedings for grant under Rule 14(1) EPC, which it then did, with effect from 22 October 2008, by a communication dated 15 January 2009.

4.3.2 In other words, it took about three years for the third party to file an admissible request complying with Rule 14(1) EPC, even though it had been informed several times by the Legal Division of the requirements which had to be met. Obviously it did not try hard to file a valid request within a reasonable time. Such conduct runs counter to the public interest in clarification of the status and the ownership of the patent application.

4.4 A related further aspect for the Legal Board is that from an objective point of view the entitlement proceedings initiated in October 2008 before the District Court of The Hague were not actively pursued for a relatively long period, i.e. more than four years.

As to the reasons for the discontinuation of the entitlement proceedings, the parties have made differing and partly contradictory submissions.

- 4.4.1 With letter of 31 July 2012 the third party informed the Board that the District Court of The Hague had not yet taken any decision on the ownership of the patent application, or set a date for a hearing. Rather, as can be inferred from the third party's letter dated 15 October 2012, only then was it preparing a reply in order to speed up these proceedings, and it did not expect a first-instance decision from that court until 2014.
- 4.4.2 Under Rule 14(3), first sentence, EPC the EPO has discretion to set a date for resumption of the grant proceedings, **regardless of the stage reached in the national proceedings** (emphasis by the Board) instituted under Rule 14(1) EPC. The order to resume grant proceedings seems all the more equitable and reasonable considering that the grant proceedings have now been stayed for more than four years due to entitlement proceedings before the District Court of The Hague which appear still not very far advanced.
- 4.5 The third party refers in its letter of 15 October 2012 to the Guidelines for Examination (A-IV, 2.3), which are not binding on the Boards of Appeal (T 1561/05 of 17 October 2006, point 1.5 of the Reasons), but the passage cited does also mention "the probable duration of the court proceedings" as an essential factor. Nor is it inconsistent with the present findings of the Board that the Guidelines say that the grant proceedings must be further stayed "if the judgement

[of the national court] is expected in the near future"; as shown above, that is clearly not the case here. Lastly, the "delaying tactics" and "judgement in favour of the applicant" mentioned in the cited passage of the Guidelines are just examples of situations in which the grant proceedings should probably be resumed, and do not exclude other situations justifying resumption of proceedings.

4.6 Finally, the very late filing of the request for suspension of the grant proceedings is also regarded as a factor which suggests that the grant proceedings should be resumed under Rule 14(3) EPC (see 4.3, aspect (iii) above; J 33/03 of 16 November 2004, points 4.1 and 4.2 of the Reasons). When the grant proceedings of European patent application 03 816 761 were suspended with effect from 22 October 2008 by communication of the Legal Division dated 15 January 2009, they were already at a relatively advanced stage, the applicant/appellant had filed - by letter dated 5 November 2008 - amended claims in response to a communication pursuant to Article 94(3) EPC. This is a less advanced stage than proceedings had reached in the parallel appeal case J 6/10. However, the other factors mentioned above demand that proceedings are resumed in the present case, as well.

4.7 For these reasons resumption of the proceedings for grant is ordered as of 1 March 2013.

5. *Reimbursement of the appeal fee*

5.1 In its communication dated 2 July 2010 the Legal Board of Appeal had explained that there had been two

separate requests to stay the grant proceedings, relating to two different European patent applications. Therefore, even though the Legal Division had decided both requests together in one decision, from a legal point of view there were two separate cases giving rise to two decisions of the Legal Division in the legal sense. As a consequence, in order to prevent those decisions from becoming final, an appeal had to be filed for each of the applications concerned and, in order to avoid the legal consequence under Article 108, second sentence, EPC two appeal fees had to be paid. The notice of appeal referred to both applications, so there were also two appeals in the legal sense. However, only the amount due for one (single) appeal was paid. Since, however the Board considered that the Legal Division had committed a procedural violation by dealing with the two requests for stay of the proceedings together in one decision and had thereby led the appellant into the error of thinking that one appeal fee would do, the Board considers the principle of good faith demanded to give the appellant the opportunity to pay the further appeal fee within a time limit set by the Board, thereby making good the potentially fatal consequences of the Legal Division's error for the appellant's right to judicial review of the Legal Division's decision.

- 5.2 With letter dated 9 September 2010 the appellant submitted a voucher for payment of the second appeal fee, for the present appeal J 7/10. Hence, this fee, which was payable as a consequence of filing the notice of appeal, has been duly paid and is therefore not refundable for this reason.

- 5.3 Rule 103(1) (a) EPC provides that the appeal fee is reimbursed if the Board of Appeal deems the appeal to be allowable and if such reimbursement is equitable by reason of a substantial procedural violation. Whether the procedural violation was substantial can remain moot because, for reimbursement of the appeal fee to be equitable, a causal link must exist between the alleged procedural defect and the decision of the department of the first instance that necessitated the filing of an appeal (J 9/10 of 18 April 2012, point 3 of the Reasons; T 388/09 of 24 June 2009, point 6 of the Reasons).
- 5.4 However, there is no such causal link in the present case. Even if the Legal Division had processed the two sets of proceedings separately and thus legally correctly, it would still have been necessary to file two appeals and pay two appeal fees in order to avoid the legal consequence under Article 108, second sentence, EPC and prevent the decisions from becoming final.
- 5.5 From this it follows that there is no legal basis for reimbursing the appeal fee paid in respect of the present appeal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The resumption of the proceedings for grant is ordered as of 1 March 2013.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairwoman:

C. Eickhoff

B. Günzel