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**Datasheet for the decision
of 27 March 2024**

Case Number: J 0001/23 - 3.1.01

Application Number: 16708122.3

Publication Number: 3265852

IPC: G01T1/29

Language of the proceedings: EN

Title of invention:
IONIZING RADIATION DETECTING DEVICE

Applicant:
Beamocular AB

Headword:
Entitlement to the grant of the patent by a person other than
the applicant

Relevant legal provisions:
EPC Art. 60(1), 61(1), 81, 106, 107, 108
EPC R. 14, 19, 99, 103(1)(a)
Protocol on Jurisdiction and the Recognition of Decisions in
respect of the Right to the Grant of a European Patent
Swedish Patents Act Art. 1, 17, 18
RPBA 2020 Art. 11

Keyword:

Admissibility of appeal - (yes)

Final decision within the meaning of Article 61(1) EPC - (yes)

Remittal to the department of first instance - special reasons
for not remitting the case (no)

Reimbursement of appeal fee - (no)

Decisions cited:

G 0003/92, J 0008/20

Catchword:

The provision of Article 81, 2nd sentence, EPC does not apply to cases where a final sovereign decision of a national court has determined that a person other than the applicant is entitled to the grant of the European patent under Article 61(1) EPC (see reasons point 2.5.2).



Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique

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Case Number: J 0001/23 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 27 March 2024

Appellant: Beamocular AB
(Applicant) Knivstagatan 6
753 23 Uppsala (SE)

Representative: Bjerken Hynell KB
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101 39 Stockholm (SE)

**Third Party within the
meaning of Rule 14 EPC:** C-Rad Imaging AB, 556643-6043
Bredgränd 18
753 20 Uppsala (SE)

Representative: Barker Brettell Sweden AB
Kungsbroplan 3
112 27 Stockholm (SE)

Decision under appeal: **Decision of the Legal Division of the European
Patent Office posted on 13 October 2022 resuming
the patent grant procedure with regard to
European patent application No. 16708122.3 with
the registered applicant and the third party
within the meaning of Rule 14 EPC.**

Composition of the Board:

Chair I. Beckedorf
Members: A. Jimenez
C. Almberg

Summary of Facts and Submissions

- I. The appeal of the registered applicant Beamocular AB (Beamocular) lies against the decision of the Legal Division, dated 13 October 2022, providing that the previously stayed patent grant proceedings for European patent application No. 16 708 122.3 (the application) be resumed, with Beamocular and the third party within the meaning of Rule 14 EPC, C-Rad Imaging AB (C-Rad), as co-applicants. The background of the appealed decision can be summarised as follows.
- II. On 2 March 2016, Beamocular filed the application as an international patent application under the Patent Cooperation Treaty (No. PCT/EP2016/054429, European publication No. 3 265852) claiming priority from US patent application No. 14, 635, 325.
- III. By letter dated 23 November 2017, C-Rad informed the EPO that it had instituted proceedings before the Stockholm District Court (in case No. PMT 6829-17) against Beamocular to seek a decision within the meaning of Article 61(1) EPC, and it requested that the patent grant proceedings based on the application be stayed under Rule 14(1) EPC. Following C-Rad's provision of evidence with the letter dated 5 December 2017, the Legal Division stayed the proceedings.
- IV. The decision of the Stockholm District Court of 26 July 2019 in the above-mentioned case was appealed before the Svea Court of Appeal (the Swedish Court), the decision of which of 23 April 2021 (in case No. PMT 9182-19, the Swedish decision) includes the following order:

"[...] declares that C-RAD Imaging AB has a better title than Beamocular AB (in bankruptcy) to half of the or those inventions specified in the patent claims [...] in the European patent application with publication number EP 3265852 as worded after the amendment made when the application was pursued at the European Patent office [...]"

- V. By letters dated 8 and 28 July 2021, C-Rad requested to be included as co-applicant of the above-mentioned European patent application. By letters dated 22 July and 15 November 2021, Beamocular objected to this request, essentially and effectively on the grounds that the Swedish decision did not qualify as a decision within the meaning of Article 61(1) EPC, and that there was no basis for any succession of the title to the invention.
- VI. By the communication of 23 June 2022, the Legal Division ordered a resumption of proceedings from 1 August 2022 with both parties as co-applicants. On 21 July 2022, the Legal Division declared the resumption of the proceedings null and void in view of the request of Beamocular for an appealable decision.
- VII. In the decision under appeal of 13 October 2022, the Legal Division held that the Swedish decision is a final decision within the meaning of Article 61(1) EPC granting half of the right to the grant of the European patent to C-Rad, and the proceedings were resumed with Beamocular and C-Rad as co-applicants.
- VIII. On 12 December 2022, Beamocular filed a notice of appeal. In its statement of grounds of appeal filed on 23 February 2023, it requested

that the appealed decision be set aside and that the patent grant proceedings be resumed with it as the sole applicant.

In addition to developing its earlier objections to the alleged qualification of the Swedish decision and succession of the title, it argued that the appealed decision failed to address the latter objection.

- IX. In reply, C-Rad requested that the appeal be dismissed, i.e. that the patent grant proceedings be resumed with Beamocular and it as co-applicants.
- X. Oral proceedings were held on 27 March 2024, with both parties maintaining, as their final requests, the requests from their statement of grounds and reply (see points VIII and IX above).
- XI. Both parties submitted translations of the Swedish decision. Although there are slight differences in the wording, both translations are equivalent. For the purposes of this decision, the Board refers to the certified version provided by Beamocular with the letter dated 15 November 2021.

Reasons for the Decision

1. Admissibility of the appeal

The appeal complies with the requirements of Articles 106 to 108 and Rule 99 EPC and is admissible.

2. Interpretation of the Swedish decision

Under Rule 14(2) EPC, where evidence is provided that a final decision within the meaning of Article 61(1) EPC has been taken, the EPO shall inform the applicant and any other party that the proceedings for grant shall be resumed as from the date stated in the communication. The EPO, in deciding on the stay or resumption of the grant proceedings under Rule 14(1) and (2) EPC, must only ascertain that the national proceedings invoked by the third party are indeed entitlement proceedings within the meaning of Article 61 EPC.

2.1 It is undisputed that the Swedish decision is a final decision. However, Beamocular contends that it does not qualify as a decision adjudging that C-Rad is entitled to half of the grant of the European patent within the meaning of Article 61(1) EPC.

2.2 In its first argument, Beamocular asserts that the Swedish decision merely states that C-Rad has a better right to half of the invention, without granting it entitlement to half of the application itself. Therefore, it argues that the subject of the decision is entitlement to the invention and not to the application. The mention of the application in the

order is solely to delineate the invention under consideration.

In its view, the Swedish Court could not decide on entitlement to the application because "patent applications" had been removed from C-Rad's request. The Legal Division was wrong in acknowledging that this change was merely an alignment with the wording of Articles 17 and 18 of the Swedish Patents Act. These provisions were also not applicable to the case since they apply to the Swedish patent authority and not the Swedish Court, and since they concern entitlement disputes on Swedish patents and not European patents.

The EPO is bound by the order of the Swedish decision and cannot interpret it beyond its explicit scope, which does not encompass entitlement to half of the application.

2.3 The Board remains unconvinced by this line of argument.

2.3.1 The relevant order of the Swedish decision is:

"[...] that C-RAD Imaging AB has a better title than Beamocular AB (in bankruptcy) to half of the or those inventions specified in the patent claims [...] in the European patent application with publication number EP 3265852 as worded after the amendment made when the application was pursued at the European Patent Office [...]"

As asserted by Beamocular and acknowledged by C-Rad, the requests from the latter were amended during the Swedish proceedings. Before the Swedish first-instance proceedings, C-Rad requested:

"that the Patent and Market Court decides that C-Rad has a better title to [or to a share to] the invention or inventions which are specified in the patent claims in the American patent application with the publication number US 2016/0259065 A1 and also in the European patent application with the publication number EP 3265852 **and all patent applications and patents which these may result in.**"

whereas in appeal, it withdrew the passage in bold at the end.

2.3.2 The Board, in line with the decision under appeal, holds that despite this amendment, there was no change in substance. Whether the requests made by C-Rad before the Swedish Court, or the Swedish decision itself, explicitly mention "all patent applications and patents which these [inventions] may result in", the Swedish decision can only be construed as affirming C-Rad's entitlement to half of the right to the grant of the European patent for the invention as claimed in the application.

2.3.3 Although Beamocular asserts that the application remains unaffected by the decision, it has failed to provide a credible explanation of the interpretation of the phrase "better title [. . .] to half of the [. . .] invention [...], specified in the patent claims [...] in the [current] European patent application [...]". Specifically, in the context of the Swedish decision, the Board finds it difficult to comprehend the distinction drawn by Beamocular between "entitlement to half of an invention specified in the patent claims in a European patent application" and "entitlement to half of said application". As noted by Beamocular (see letter of 25 January 2024, page 2,

third paragraph), it could be argued that ownership of an invention without entitlement to the corresponding patent or patent application would have no value and lack significance. Moreover, Beamocular was unable to explain what legal mechanism would allow ownership of an invention to be transferred to its rightful owner other than by transferring the corresponding, already published patent application.

- 2.3.4 The Board further disagrees with Beamocular's assertion that a decision within the meaning of Article 61(1) EPC must explicitly refer to the "right to the patent application and patents that may be issued [thereof]", citing the proceedings for European patent No. 2 715 077 (European patent application No. 12 792 628.5) as an example. In those proceedings, the decision issued by the Stockholm District Court on 29 June 2017 did indeed include such a reference. However, the absence of this specific language does not preclude a decision from qualifying as an entitlement decision under Article 61(1) EPC. As noted by Beamocular itself, courts are bound by the requests of the parties, and the wording of decisions in similar cases may vary accordingly.

From the perspective of the EPC and the EPO, such variations are to be expected whether the decisions are issued in the same or different jurisdictions subject to the convention. Entitlement decisions under Article 61(1) EPC are thus expected to look differently from one case to another. The key question is whether, in the particular case, the EPO interprets the decision presented as a final entitlement decision within the meaning of Article 61(1) EPC.

In the case at hand, even in the absence of an explicit reference to "all patent applications and patents that may be issued thereof", the entitlement to the invention as specified in the application inherently implies entitlement to the grant of a European patent based on the application.

2.3.5 Therefore, from the Board's perspective, the meaning of the order of the Swedish decision in the current case corresponds to having a better right to half of the patent application filed for that invention. This interpretation of the order is not contradicted but supported by the rationale in the Swedish decision. It references Article 1 of the Swedish Patents Act on entitlement to the "right of an invention for which a patent is sought" alongside Article 60(1) EPC on the right to a European Patent, and Article 18 of the Swedish Patents Act on title to an invention and transfer of an application (see page 5, third full paragraph, "Legal points of departure").

2.3.6 Moreover, the Board is content with C-Rad's explanation that the amendment of its requests before the Swedish Court was merely a revision to align the wording of the requests with Articles 17 and 18 of the Swedish Patents Act.

Beamocular's argument that these provisions were not applicable to the case is irrelevant. Under the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent (Protocol on Recognition), the Swedish courts have exclusive jurisdiction to decide claims, against the applicant, for entitlement, and to apply the relevant national law, within the framework of their own legal system. It is established case law that

the EPO is not competent to examine the substance and merits of a national entitlement decision (Case Law of the Boards of Appeal, 10th edition, July 2022, III.M. 3.1.2, fifth and sixth paragraphs; G 3/92, Reasons 3.3 and 3.4). The Swedish Court explicitly based its decision on, *inter alia*, Article 18(1) of the Swedish Patents Act, (page 5, fourth full paragraph, "Legal points of departure"), and the Board has no competence to review the correctness of this legal basis.

- 2.4 In a second line of argument, Beamocular puts forward that the Swedish decision does not mention any ground, by agreement or law, for a transfer of rights from the inventors to C-Rad, *i.e.* that there is no reference to a legal situation or transaction which would have made C-Rad successor in title in compliance with Article 81, second sentence EPC in conjunction with Article 60(1) EPC.

Citing J 8/20 (Reasons 4.2.3), it contends that the EPO must examine, even if only formally, whether the statement of a designation of inventor identifies an origin for the right to the patent within the scope of Article 60(1) EPC. It asserts that this requirement is not met in the Swedish decision as it does not clarify how the right to part of the invention was transferred from the inventor to C-Rad.

- 2.5 The Board disagrees.

- 2.5.1 As mentioned above, the current entitlement case falls within the exclusive jurisdiction of the competent Swedish court, which applies the relevant national law within its legal framework. Once the EPO has ascertained that the national proceedings initiated by the third-party constitute entitlement proceedings

within the meaning of Article 61 EPC and the decision is final, it is not competent to scrutinise the substance of the decision. This includes the adequacy of the details provided in the decision on how the person recognised by the court as entitled to the grant of the European patent obtained that right.

- 2.5.2 The conclusion reached by the Board in case J 8/20, stipulating that the EPO must examine whether a statement filed under Article 81, second sentence EPC falls within the scope of the EPC, does not apply to the circumstances of this case. The statement under Article 81, second sentence EPC indicating the origin of the right to the patent must be submitted by the applicant along with the request for grant (Rule 19 EPC). However, this requirement does not pertain to cases where a final sovereign decision of a national court has determined that a person other than the applicant is entitled to the grant of the European patent under Article 61(1) EPC. In such instances, the matter of by whom and how the right to the patent was acquired is deliberated and settled by the competent national court, and the EPO is bound by the court's conclusion without further requirement.

3. *Alleged substantial procedural violation*

- 3.1 In its statement of grounds of appeal (page 2, last paragraph), Beamocular argues that the appealed decision failed to address the argument raised in the letter dated 15 November 2021 (page 2) on the absence, in the Swedish decision, of any legal or contractual basis for the transfer of rights from the inventors to C-Rad.

3.2 The Board shares this view. However, whether this omission should be regarded as a substantial procedural violation may remain undecided given that the appeal is anyhow not allowable, and that the Board fails to see special reasons not to decide on it itself. In other words, neither reimbursement of the appeal fee nor remittal to the Legal Division appears to be an option (Rule 103(1)(a) EPC and Article 11 RPBA 2020 *e contrario*).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



C. Eickhoff

I. Beckedorf

Decision electronically authenticated