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**D E C I S I O N**  
of 25 august 1994

**Case Number:** J 0001/91 - 3.1.1

**Application Number:** 90304744.7

**Publication Number:** -

**IPC:** A62B 35/04

**Language of the proceedings:** EN

**Title of invention:**  
Bypassing double action rope grip

**Applicant:**  
LATCHWAYS LIMITED

**Opponent:**  
-

**Headword:**  
Unlawful applicant/LATCHWAYS

**Relevant legal norms:**  
EPC Art. 60, 61, 164  
EPC R. 13, 14, 15, 16

**Keyword:**  
"Party other than applicant entitled to patent"  
"Filing of new application by lawful applicant"

**Decisions cited:**  
J 0001/91 (Interlocutory Decision); G 0003/92

**Catchword:**



Case Number: J 0001/91 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 25 August 1994

**Appellant:**

LATCHWAYS LIMITED  
3 St. Mary Street  
Chippenham  
Wiltshire, SN15 3JL (GB)

**Representative:**

Ben-Nathan, Laurence Albert  
Urquhart-Dykes & Lord  
91 Wimpole Street  
London W1M 8AH (GB)

**Decision under appeal:**

Decision of the Receiving Section of the European Patent Office dated 27 December 1990 refusing to consider European patent application No. 90 304 744.7 to be an application under Article 61(1)(b) EPC.

**Composition of the Board:**

**Chairman:** R. L. J. Schulte  
**Members:** G. Davies  
J. P. B. Seitz

## Summary of Facts and Submissions

- I. This Decision is issued pursuant to a Decision of the Enlarged Board of Appeal dated 13 June 1994 (G 3/92, to be published), in which the Enlarged Board replied to an important question of law referred to it by this Board in its Interlocutory Decision dated 31 March 1992 (J 1/91, OJ EPO 1993, 281), issued in the course of proceedings concerning this case under Article 112(1)(a) EPC.
- II. A complete summary of the facts before the Legal Board of Appeal in this case is set out in the said interlocutory decision. The salient facts of the case are also summarised in the Enlarged Board's Decision.
- III. For the purposes of this decision, the relevant facts may be briefly summarised as follows:

On 1 May 1990, the Appellant, Latchways Limited, filed European patent application No. 90 304 744.7 under Article 61(1)(b) EPC (the "1990 application"). The application was filed subsequent to a final decision of the Comptroller of the UK Patent Office dated 6 March 1990 concerning a reference under Section 12(1) of the UK Patents Act 1977 for a ruling on the question whether Latchways Limited was entitled to the grant of European patent application No. 85 400 859.6 filed on 2 May 1985 (the "1985 application") by a third party (the "unlawful applicant"), claiming priority from US application No. 606 351 filed on 2 May 1984.

The sequence of events leading to the dispute were the following: in 1982 the Appellant company was interested in exploiting a device which it had developed, and for this purpose details of the device were disclosed in

confidence to a third party (the "unlawful applicant"). Unknown to the Appellant, this third party in 1985 filed a European patent application (the 1985 application") in respect of such device, and this application was published later in 1985, but was deemed to be withdrawn in 1986 because no request for examination was filed in due time.

The Appellant was unaware at this time of the 1985 application, and filed a European patent application in respect of the same invention in 1987. A European search report was drawn up and transmitted to the Applicant in 1988. This cited the earlier 1985 application, thus making the Appellant aware of the 1985 application for the first time.

The Appellant accordingly referred a question to the Comptroller of the United Kingdom Patent Office under Section 12 of the United Kingdom Patent Act 1977, as to whether he was entitled to the grant of a European patent for the invention disclosed in the 1985 application. A Superintending Examiner acting for the Comptroller duly issued a Decision in favour of the Appellant, dated 6 March 1990. This decision was a final decision within the meaning of Article 61 EPC, as decided by the Legal Board of Appeal (cf. J 1/91, *supra*, Reasons for the Decision, paragraph 12 and recognised by the Enlarged Board (cf. G 3/92, Reasons for the Decision, paragraph 4).

Within three months, the Appellant filed a new European patent application (the 1990 application") in respect of subject-matter disclosed in the 1985 application, pursuant to Article 61(1)(b) EPC.

The Receiving Section of the European Patent Office issued a Decision dated 27 December 1990, however, in which it was held that the 1990 application could not be dealt with under Article 61(1)(b) EPC because the 1985 application was no longer pending at the date of filing of the 1990 application, this, according to the Receiving Section, being a pre-requisite for the application of Article 61 EPC.

The Receiving Section's Decision was based primarily upon a consideration of the wording of Article 61 EPC and its associated Rules 13 to 15 EPC.

- IV. The Appellant appealed against the decision of the Receiving Section, filing a notice of appeal, a statement of grounds of appeal and paying the prescribed fee on 19 February 1991, and requested cancellation in its entirety of the decision to refuse to consider the application as an application under Article 61(1)(b) EPC.
- V. The arguments of the Receiving Section and those of the Appellant in defence of their respective points of view are set out in the Interlocutory Decision of this Board, referred to above.
- VI. In that Decision, this Board referred the following question to the Enlarged Board of Appeal:

"Where it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Article 61(1) EPC, files a new European patent application in respect of the same invention under Article 61(1)(b) EPC, is it a pre-condition for the

application to be accepted that the original usurping application still be pending before the EPO at the time the new application is filed?"

VII. In its decision of 13 June 1994, G 3/92 , referred to above, the Enlarged Board answered this question as follows:

"When it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Article 61(1) EPC, files a new European patent application in respect of the same invention under Article 61(1)(b) EPC, it is **not** a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed."

#### **Reasons for the Decision**

1. According to Article 60(1) EPC, the right to a European patent shall belong to the inventor or his successor in title and Article 60(3) EPC lays down the principle that "For the purposes of proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right to the European patent". However, Article 61 EPC provides a mechanism to deal with the situation where a European patent application is made by a person not having the right thereto. Where, by a final decision of a competent national court, it is adjudged that a person other than the applicant is

entitled to the grant of a European patent, that person has the right under Article 61(1) EPC to either:

- (a) prosecute the application as his own application in place of the applicant (Article 61(1)(a) EPC);
- (b) file a new European patent application in respect of the same invention (Article 61(1)(b) EPC); or
- (c) request that the application be refused (Article 61(1)(c) EPC).

The claimant may take one of these steps within three months of the decision of the national court becoming final provided that the European patent has not yet been granted. In this case, the decision of the competent national court in the Appellant's favour having become final on 6 March 1990, and the European patent not having been granted, these two conditions have been fulfilled.

2. In the decision under appeal, the Receiving Section refused the Appellant's request that its application be considered an application under Article 61 (1) (b) EPC on the ground that an application may be made under Article 61 EPC (and the relevant Rules) only "in the frame of a pending initial procedure". However, the Enlarged Board of Appeal in its decision G 3/92, *supra*, has decided that, when it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Article 61(1) EPC, files a new European patent application in respect of the same invention

under Article 61(1)(b) EPC, it is **not** a pre-condition for the application to be accepted that the earlier original usurping application be still pending before the EPO at the time the new application is filed.

According to Article 112(3) EPC the decision of the Enlarged Board is binding on the Legal Board. Thus, the Board finds that the conditions of Article 61(1) EPC have been met in this case, that the Appellant is a person entitled, within the meaning of Article 61(1) EPC, to the grant of a European patent in respect of the invention disclosed in the 1985 application and, therefore, to file a new European patent application in respect of that invention, pursuant to Article 61(1)(b) EPC.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the Receiving Section for further prosecution of the new European patent application filed by the Appellant on 1 May 1990 (the 1990 application).

The Registrar:

The Chairman:

M. Beer

R. Schulte