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DECISIONS OF THE BOARDS OF APPEAL

Decision of the Legal Board of Appeal dated 20 January 1998

J 7/96 - 3.1.1

(Language of the proceedings)

Composition of the board:

Chairman: J.-C. Saisset

Members: G. Davies

J.-C. M. De Preter

Applicant/Respondent: Instance, David John

Third Party/Appellant: Denny Bros Printing Ltd.

Headword: Suspension of proceedings

Article: 60, 61(1), (3), 64(1), 67, 97(2), (4), 98, 99(1), 105, 106(1) EPC

Rule: 13(1), (3), 14, 89 EPC

Keyword: "Proceedings for grant pending - yes" - "Suspension of proceedings - yes" - "Referral to the Enlarged Board - no"

Headnote

A decision of the examining division to grant a European patent (Article 97(2) EPC) does not take effect on the date the decision-making process following written proceedings before that division is completed but on the date on which the European Patent Bulletin mentions the grant (Article 97(4) EPC). In the interim period,

proceedings for grant are still pending before the EPO and a request for suspension of proceedings under Rule 13 EPC is admissible.

Summary of facts and submissions

I. Euro-PCT patent application No. 91 915 912.9 was filed on 30 August 1991 by David John Instance. On 8 September 1995, the examining division handed over a decision to grant the European patent pursuant to Article 97(2) EPC to the postal service of the European Patent Office, which despatched it by registered post on 14 September 1995. The decision also indicated that mention of the grant would be published in European Patent Bulletin 95/43 of 25 October 1995.

II. In a letter dated 3 September 1995, and received by fax at the EPO on 3 October 1995, a third party, Denny Bros Printing Limited, requested suspension of the proceedings under Rule 13(1) EPC. Attached to this communication was a copy of the writ initiating proceedings before the Comptroller of the UK Patent Office to seek a declaration that the invention, subject of application No. 91 915 912.9, was the property of Denny Bros Printing Limited.

III. In a communication dated 13 October 1995, the Legal Division informed the representative of Denny Bros Printing Limited that the proceedings could not be suspended on the ground that the decision to grant the patent had already been reached and despatched on 14 September 1995, ie before the fax requesting suspension of the proceedings had been received by the EPO. In a fax dated 16 October 1995, Denny Bros Printing Limited requested an appealable decision to be issued before the date of publication of the mention of the grant on 25 October 1995, to enable an appeal to be lodged prior to the publication of the mention of the grant of the application.

IV. On 30 October 1995, the legal division issued a decision to refuse the request for suspension of the proceedings on the ground that, on the date of receipt of the request for suspension, the decision to grant application No. 91 915 912.9 had

already been taken by the examining division pursuant to Article 97(2) EPC. It was argued in the decision that only grant proceedings which were still pending could be suspended under Rule 13 EPC and that, in accordance with G 12/91 (OJ EPO, 1994, 285), any decision taken by the EPO concerning the grant of a patent binds the EPO from the date it is handed over to the internal postal service. In this case, the decision was passed to the postal service of the EPO on 8 September 1995. The request to suspend proceedings did not reach the EPO until 3 October 1995, when the grant procedure had already been closed and was no longer pending.

The decision also drew a distinction between the existence and binding effect of the decision to grant and its taking legal effect in the public domain. Once the latter has occurred, any competitors must respect the patentee's rights. However, the EPC provides in Article 64(1) EPC that the mention of the grant of the patent must first have been published. Hence the parallel provision in Article 97(4) EPC that the decision to grant does not take effect until the date on which the European Patent Bulletin mentions the grant. In the meantime, the applicant continues to enjoy provisional protection under Article 67 EPC. For this reason, it is still possible during this interim period to take action in respect of the application. It is established EPO practice that an application may, for example, be withdrawn or transferred; applicants may even withdraw individual designations if they wish. However, the examining division may not (except, of course, in the event of an admissible appeal (Article 106(1) EPC)) set aside or amend its own decision to grant. Thus, the grant of the patent exhausts any entitlement to grant which a third party, as opposed to the applicant, could allege vis-à-vis the EPO.

Furthermore, were a third party to be declared entitled to a European patent application by a national court and to submit the judgment to the EPO in the period between the decision to grant and the publication of the mention of the grant, the fact that the decision to grant had been taken would render void all the rights under Article 61(1) EPC of the party truly entitled. The decision to grant a patent to the existing applicant could not be set aside and, once a patent was granted, there was

no longer any application which could be prosecuted under Article 61(a), (b) or (c) EPC.

V. Notice of appeal was filed on 1 November 1995, together with the appeal fee, followed by a statement of grounds of appeal submitted on 29 February 1996. The appellant's main request was that the Board of Appeal should set aside the decision of the legal division dated 30 October 1995 and that suspension of application No. 91 915 912.9 under Rule 13 EPC should be deemed to have taken effect as of receipt of the original request for suspension on 3 October 1995. The appellant further requested that a notice be published to the effect that the mention of the decision to grant which had appeared on 25 October 1995 was withdrawn and had no legal effect. Oral proceedings were requested in the event that the Board of Appeal were to take the preliminary view that suspension should not be granted.

VI. In a communication sent to the applicant and the appellant and dated 23 December 1996, the examining division informed the parties that, following the lodging of the appeal by the appellant, which had suspensive effect, the publication procedure of the decision to grant had to be suspended and the publication date of 25 October 1995 had to be cancelled; the cancellation would be published in the European Patent Bulletin 97/06 of 5 February 1997 (cf. J 28/94, OJ EPO 1995, 742).

VII. In a communication pursuant to Article 110(2) EPC dated 16 May 1997, the Board informed the parties that, according to its provisional conclusions, the request for suspension of the proceedings for grant complied with the provisions of Rule 13(1) EPC and had been submitted in due time. The appellant had provided proof that it had commenced proceedings against the applicant before the UK Patent Office on 3 October 1995, seeking a declaration that the invention the subject of the application in suit was the appellant's property. The appeal and the request for suspension was likely therefore to be allowed. According to the Board's preliminary view, the grant of a European patent takes effect neither on the date the decision to grant is reached by the examining division, nor on the date on which the applicant is

informed of the EPO's intention to grant a patent, but on the date the mention of the grant is published in the European Patent Bulletin (Article 97(4) EPC).

The Board also indicated that, should it decide to suspend the proceedings, it was considering exercising its powers under Rule 13(3) EPC to set a date on which the EPO would continue the pending proceedings. To this end, the parties were requested to provide the Board with all available information concerning the progress of the proceedings in the United Kingdom.

VIII. In its statement of grounds of appeal and at the oral proceedings, the appellant argued essentially as follows:

The EPC and its implementing regulations had been misconstrued in arriving at the decision to refuse suspension. In the appellant's view, the EPO has no discretion as regards suspension of an application; Rule 13 EPC provides that "... the European Patent Office **shall** stay the proceedings for grant ..." where the necessary supporting documentation is provided. Moreover, as the term "proceedings for grant" is nowhere defined in the EPC, the normal definition should be employed, which includes the period between the date of issue of the decision to grant and the date of the decision taking legal effect, grant proceedings thus still being in progress and pending until the latter date. A contrary interpretation would result in internal inconsistencies in the EPC as Article 97(4) EPC expressly provides the decision to grant a European patent shall not take effect until mention of the grant appears in the European Patent Bulletin. Furthermore, such a contrary interpretation would lead to an inequitable balance between the rights of the applicant and those claiming to be true owners. Under Rule 14 EPC it is expressly provided that neither the application nor the designation of any Contracting State may be withdrawn while an application is suspended under Rule 13 EPC, and yet the EPO (and the applicant) acknowledge that, subsequent to the decision to grant but prior to the decision taking effect, the applicant may withdraw the application or designations of Contracting States. The purpose of Rules 13 and 14 EPC is to preserve the status

quo while the question of entitlement is being settled, as a matter of public policy to avoid legal uncertainty.

Moreover, as the term suspension is used in both Article 106(1) EPC, dealing with decisions subject to appeal, and Rule 13 EPC, the provisions should not be deemed to have differing effects (see also J 28/94, above).

The appellant also argued that decision G 12/91 (OJ EPO 1994, 285, see paragraph IV, above), as well as the other Enlarged Board decisions referred to by the applicant (G 1/90 (OJ EPO 1991, 275) and G 4/91 (OJ EPO 1993, 339) and G 3/92 (OJ EPO 1994, 607), see paragraph IX, below) related to determining the date after which submissions of parties to proceedings before the EPO will no longer be considered. Following opposition or appeal proceedings, there are no express provisions relating to the date when the decision takes legal effect other than Rule 78(3) EPC. In the case of decisions to grant, on the other hand, Article 97(4) EPC expressly provides for the date on which the decision to grant takes effect. In the appellant's view, it was therefore inappropriate to apply decision G 12/91, which concerned the decision-making process in opposition proceedings, to the unique circumstances of proceedings for grant where express provisions for the date of legal effect exist in the EPC. Moreover, it should be noted that nowhere in G 12/91 is reference made to the decision being final; this was significant because any decision of the opposition division may be appealed with suspensive effect. In any case, application of Rule 13 EPC only suspends the legal effect of the decision and neither requires it to be altered, nor reopens examination. The decision to grant is solely a decision to grant a patent on an application; it is not a decision to grant a patent to a particular individual, nor is it a decision to grant a patent having legal effect on a certain date. References in a decision to the name of the proprietor of the patent and to the date on which mention of the decision to grant is to be published are merely formal matters ancillary to the decision. If this were not the case, it would not be possible for the transfer of an application to another party to be recorded after the decision to grant had been issued, as is established practice.

Furthermore, G 12/91, above, identifies the cut-off date as the date when a decision is removed from the power of the department that issued it. In the case of a request for suspension, only the legal division has jurisdiction, not the examining division which issues the decision to grant. The request opens a new procedure and does not re-open the examination proceedings. On this basis alone the application of G 12/91 to the present circumstances was misguided.

G 4/91, above, related to an intervention under Article 105 EPC by an assumed infringer in opposition proceedings. The Enlarged Board found that such an intervention presupposes that opposition proceedings are pending at the time notice of intervention is given and that proceedings before the opposition division are terminated when its decision is issued, irrespective of when it becomes final, following expiry of the two-month time limit for filing an appeal. In the appellant's opinion, this decision is also not relevant. The question was not whether the assumed infringer had rights in the patent but whether he could appeal against a decision of the opposition division, in circumstances where neither the patentee, nor the opponent(s) had done so. Again, it was necessary to distinguish between opposition proceedings (where there was no provision equivalent to Article 97(4) EPC) and proceedings for grant.

Article 61(1) EPC does not, in the appellant's opinion, conflict with the binding nature of the decision to grant, as the latter is not specific to the applicant and for that reason changes of applicant are regularly recorded after the decision to grant has been issued. The EPO has a duty to ensure that valid patents are granted and suspension of the application even after the decision to grant has been issued under Article 97(2) EPC would enable a dispute on entitlement to be resolved and a valid patent granted in accordance with Article 61(1) EPC. Registration of a third party entitled to the application and eventual patent would not require the original decision to grant to be set aside. Moreover, as regards the possible application of Article 61 EPC, to the extent that an application remains pending until the publication of the mention of the grant, the third party is capable of prosecuting the application as its own application in place of the applicant (Article 61(1)(a) EPC); there is also no valid

reason why a new European patent application could not be filed (Article 61(1)(b) EPC); and a request to refuse the application may be deemed withdrawal of the application (withdrawal being acknowledged by the decision to refuse suspension as being possible after the decision to grant has been taken) (Article 61(1)(c) EPC).

Finally, in response to the Board's indication that it was considering exercising its powers under Rule 13(3) EPC to set a date on which the EPO would continue proceedings, the appellant would prefer that the Board did not fix a date at this stage because of the uncertainty as to how long the proceedings in the United Kingdom would last. A decision was unlikely before the end of 1998 and the proceedings should not be continued before the entitlement proceedings were concluded.

IX. The applicant (respondent) filed two separate responses to the communication of the Board on 22 September 1997. In the first, it requested the Board, in the case that it should decide to suspend the proceedings, to set a date on which the proceedings would be continued before the EPO, regardless of the stage reached in the proceedings in the United Kingdom. These proceedings, including any appeal, could continue for as long as two years. In the meantime uncertainty prevailed and the applicant's interests were being damaged because it had no remedies against infringement of the application.

In its second letter, the applicant requested dismissal of the appeal and that the application in suit be permitted to proceed to grant. Oral proceedings were also requested. In support of its request, a further submission was filed on 16 January 1998. In these communications, and at the subsequent oral proceedings, essentially the following arguments were put forward by the applicant:

It was a pre-requisite for an application for suspension of proceedings under Rule 13(1) EPC that there must be in fact proceedings for grant which the EPO is able to stay. There was no case law of the boards of appeal on this point. In T 146/82, where proceedings had been stayed, no decision to grant had been issued by the examining division and the grant proceedings had been clearly pending. In the

present case, the decision to grant had already been made before the application for suspension had been filed. According to the applicant, it is the date on which the decision to grant becomes final under the provisions of Article 97(2) EPC that determines the existence or not, as the case may be, of proceedings for grant which may be stayed under Rule 13(1) EPC. In its view, this interpretation gives effect to the purposive effect of Rule 13(1) EPC and Article 61(1) EPC. It also preserves the rights of the applicant once the decision of the examining division has been made. Finally, it is supported by the case law of the boards of appeal.

The purposive effect of Rule 13(1) EPC is to permit a person to suspend the proceedings for grant to prevent the application from proceeding to grant, being refused or withdrawn, so that, if a person is ultimately adjudged by a final decision to be entitled to grant of a European patent, that person may perform any of the three acts specified in Article 61(1)(a), (b) or (c) EPC. This can only be the case if the grant of the European patent has not yet been made final. There would be no point in obtaining suspension if there was no possibility of obtaining relief under Article 61(1) EPC. In the applicant's view, it followed that the date proceedings to grant are concluded is not the date of the mention of the grant under Article 97(4) EPC but the earlier date on which the decision to grant becomes final under Article 97(2) EPC. The earlier date irrevocably establishes the applicant's rights as between such applicant and the EPO. Those rights cannot be taken away or passed to another person by implementation of Article 61(1) EPC or Rule 13(1) EPC. In support of this proposition, it was argued that such an interpretation would establish a fair balance between the rights of an applicant and a third party. Once the examining division has taken its decision to grant, the applicant is entitled to have the patent granted in its name. It is also at liberty to withdraw or assign its rights to another party in the period between the decision to grant and the publication of the mention of the grant. In this connection, the applicant did not dispute the fact that during this period the application was still pending before the EPO, arguing, however, that this was irrelevant because Rule 13(1) EPC applied only to the stay of "proceedings for grant", which it asserted are concluded once the decision to grant has been taken. To decide that the time limit for suspending proceedings runs until

the date of mention of the grant would unnecessarily extend the period of time required to protect the as yet unproved rights of a third party to the detriment of the applicant.

The applicant argued also that its interpretation of the term "proceedings for grant" was borne out by a number of decisions of the Enlarged Board of Appeal and of the Legal Board of Appeal. G 1/90, above, and G 4/91, above, in conjunction with other decisions, particularly G 12/91, above, and G 3/92, above, make clear that the "proceedings for grant" referred to in Rule 13(1) EPC are terminated and thus cannot be stayed following the issue of the decision to grant under Article 97(2) EPC. G 1/90 makes clear (paragraph 5 of the reasons) that the decision to grant of Article 97(2) EPC terminates the grant procedure. Decision G 4/91 states (paragraph 7 of the reasons) that upon the issue of a decision by the opposition division, the opposition proceedings are terminated regardless of the date on which the decision of the opposition division takes legal effect and an assumed infringer could no longer intervene in the proceedings because the opposition proceedings were at an end. By analogy, the issuing of a decision to grant must terminate proceedings for grant. It is further suggested that, in G 3/92 (paragraph 5.3 of the reasons), the Enlarged Board stated that the procedural implementation of Article 61(1) EPC by virtue of Rules 13 to 15 EPC are only applicable in the period "before and including the making of a decision on the grant" of an application and that it is not applicable after the decision to grant has become final according to the case law established in G 12/91. In J 11/91 and J 16/91 (OJ EPO 1994, 28), the Legal Board of Appeal had discussed the significance and interrelationship between Article 97(2) and 97(4) and stated inter alia "the Board considers that the date of the decision to grant pursuant to Article 97(2) EPC is the decisive date as between the EPO and the applicant" (paragraphs 2.4 and 2.6 of the reasons).

The applicant also argued that the suspensive effect of an appeal under Article 106(1) EPC did not give authority to the examining and opposition divisions to retroactively cancel the decision to grant (cf. paragraph VI, above).

In conclusion, at the oral proceedings, the applicant requested that the appeal be dismissed; in the alternative, it was requested that the following question be referred to the Enlarged Board:

Are proceedings for grant before an examining division terminated upon issue of a decision to grant a European patent, regardless of when such decision takes effect?

Reasons for the decision

1. The appeal is admissible.

2. Suspension of proceedings

2.1 Rule 13(1) EPC states that, if a third party provides proof to the EPO that he has opened proceedings against the applicant for the purpose of seeking a judgment that he 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. In this case the third party, or appellant, having requested suspension of the proceedings for grant, did not consent to the continuation of the proceedings. According to the case law of the boards of appeal, if satisfactory proof of the opening of relevant proceedings before a national court is given to the EPO by the third party, then the suspension **must** be ordered (T 146/82 OJ EPO 1985, 267). In the Board's view, it is self-evident that an application for a stay of proceedings may only be considered if proceedings are in fact pending before the EPO.

2.2 Rule 13 EPC must be considered in the context of the European Patent Convention as a whole, including, in particular, Article 61 EPC and Rule 14 EPC. These provisions form part of a system of legal process which is provided under the EPC for determining the right to a European patent application when this is in dispute, and for implementing this determination. It is clear from the travaux préparatoires of the EPC that it was considered important to provide such a system in which disputes as to entitlement could be settled by a final decision of a national

court but then implemented centrally by the EPO with respect to all the designated States (see document IV/2498/1/61-D, page 17 et seq). The terms of these provisions must be interpreted in this context and in the light of the object and purpose of this system (cf. G 3/92, above, point 1 of the reasons).

2.3 Article 61(1) EPC governs the procedural rights of a person who has been adjudged by a final decision of a national court to be entitled to the grant of a European patent in place of the applicant and provides such a person with the opportunity to take certain prescribed actions in relation to the application "**provided that the European patent has not yet been granted**". Such a person may (a) prosecute the application as his own application in place of the applicant; (b) file a new European patent application in respect of the same invention; or (c) request that the application be refused. Rule 13 EPC, which provides for suspension of proceedings during the period when the third party is seeking a judgment that he is entitled to the grant of the European patent, has the objective of preserving the rights of the third party during the entitlement proceedings. Rule 14 EPC aims also to preserve those rights by providing that, as from the time when a third party proves to the European Patent Office that he has initiated proceedings concerning entitlement and up to the date on which the European Patent Office resumes the proceedings for grant, neither the European patent application nor the designation of any Contracting State may be withdrawn.

2.4 Rules 13 and 14 EPC are implementing regulations in respect of Article 61 EPC. They presuppose that the earlier application (by the unlawful applicant) is pending at the time when the person claiming to be the lawful applicant commences proceedings before a national court of a Contracting State, claiming his entitlement to grant, and they are intended to be applicable in that factual situation.

3. In the present case, the appellant, who is a third party within the meaning of Rule 13(1) EPC, provided proof that relevant proceedings had been commenced against the patent applicant before the United Kingdom Patent Office on 3 October 1995, seeking a declaration that the invention, subject of application

No. 91 915 912.9, was the appellant's property. This fact is not in dispute and the proceedings are taking their course at the national level. On the date on which the request for suspension of the proceedings for grant was received at the EPO, ie 3 October 1995, the examining division had decided to grant a European patent to the applicant under Article 97(2) EPC; however, the decision to grant the patent had not yet taken effect as the grant had not been mentioned in the European Patent Bulletin pursuant to Article 97(4) EPC. As a result, as even the applicant admits, the patent application was still pending before the EPO at the time the application for suspension was made.

4.1 The department of first instance argued in its decision that grant proceedings can only be suspended if they are still pending before the EPO. However, in its opinion, grant proceedings are concluded and the decision to grant becomes binding on the EPO when the decision to grant a European patent in accordance with Article 97(2) EPC becomes final. Thereafter, the decision can no longer be amended and thus applications from a third party can no longer be taken into consideration, nor can proceedings be suspended. Relying on the decision of the Enlarged Board of Appeal in G 12/91, above, the department of first instance argued that the decision-making process following written proceedings is completed on the date the decision to grant is handed over to the EPO postal service by the decision-taking department's formalities section for notification to the applicant. In the present case, this had occurred on 8 September 1995, before the filing of the request to suspend the proceedings.

4.2 The department of first instance also argued that, since the decision to grant under Article 97(2) EPC could not be set aside or amended, there was no longer any entitlement to grant which a third party could allege vis-à-vis the EPO and no longer any application which could be prosecuted under Article 61(a), (b) or (c) EPC, should a final decision of a national court adjudge the third party to be entitled to the grant of the European patent.

5.1 The applicant argued along similar lines but drew a distinction between when an application is still pending and when proceedings for grant are still in progress. The applicant does not dispute that the application is still pending before the EPO until the date of the mention of the grant pursuant to Article 97(4) EPC, but asserts that Rule 13(1) EPC requires that "proceedings for grant" be still in progress before the examining division at the time an application for suspension of proceedings is made thereunder. In its opinion, once the examining division has decided to grant the European patent and the decision has been handed over to the EPO postal services (cf. G 12/91, above) the proceedings for grant are concluded and there are no "proceedings for grant" to be stayed under Rule 13(1) EPC.

5.2 In support of its argument, the applicant has relied on a number of decisions of the Enlarged Board (cf. paragraph IX, above).

5.3 It was also submitted that the phrase "proceedings for grant" in Rule 13(1) EPC should be interpreted in the context of a third party found to be entitled to a European patent being able to proceed with any one of the three procedural options specified in Article 61(1) EPC. Once the decision to grant under Article 97(2) EPC has become final, such a person would not be entitled to any rights under Article 61 EPC.

6.1 The Board does not share the views of the department of first instance and the applicant that the proceedings for grant are concluded on the date the examining division reaches its decision to grant a European patent under Article 97(2) EPC. It is true that this date represents the date on which the process of reaching a decision on the application within the examining division is concluded; both the EPO and the applicant are bound by the decision as far as the text of the patent to be granted, the claims, description and drawings are concerned, and the subject-matter of the text of the patent becomes *res judicata* at that date. Thereafter, the EPO can no longer amend its decision and must disregard any fresh matter the parties may submit thereafter (cf. G 12/91 and J 11 and J 16/91, above, points 2.5 and 2.6 of the reasons). Only linguistic errors, errors of transcription and obvious mistakes may

be corrected later under Rule 89 EPC. The date on which the decision to grant the European patent is reached is thus clearly decisive as regards the EPO and the applicant. However, it is clear from the wording of Article 60(3) EPC that the decision to grant does not decide on who is the proprietor of the patent because it states: "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"; there is therefore no more than a presumption that the applicant is entitled, which may be rebutted in accordance with the provisions of Article 61 EPC and Rule 13 EPC. Likewise, Article 64(1) EPC makes it clear that the decision to grant under Article 97(2) EPC does not confer any rights on the proprietor in the designated Contracting States until the date of publication of the mention of the grant.

6.2 Under Article 97(4) EPC, the decision to grant a European patent referred to in Article 97(2) EPC does not take effect until the date on which the European Patent Bulletin mentions the grant. This mention shall be published at the earliest three months after the start of the time limit referred to in Article 97(2)(b) EPC for the payment of the fees for grant and printing. It is from this date of mention that, in accordance with Article 64(1) EPC, a European patent confers on its proprietor the same rights in respect of each Contracting State in respect of which it is granted as would be conferred by a national patent granted in that State (cf. *Singer*, *Europäisches Patentübereinkommen*, 1989, Article 97.14 EPC). The EPO publishes the mention of the grant of the European patent at the same time as it publishes a specification of the patent containing the description, claims and any drawings. Thus the date on which the mention of the grant of the patent is published is also the date on which the text of the patent is made available to the public (Article 98 EPC). The mention also marks the time when the responsibility of the EPO comes to an end and the national patent systems take over; the granted patent becoming a bundle of national patents. It also marks the start of the period during which a notice of opposition may be filed (Article 99(1) EPC). Thus, the date of publication of the mention of the grant of the patent is the date on which the grant of the patent takes legal effect with respect to third parties, and on which the extent of protection conferred on the applicant is determined once and for all by means of the

accompanying publication of the specification of the patent pursuant to Article 98 EPC.

6.3 During the period between the decision to grant the patent (Article 97(2) EPC) and the publication of the mention of the grant (Article 97(4) EPC), the application is deemed to be still pending before the EPO. As the department of first instance itself admits in its decision, and as is also not disputed by the applicant, according to established EPO practice it is still possible during this interim period to take some limited action in respect of the application, which may, for example, be withdrawn or transferred. Applicants may even withdraw individual designations if they so wish. For its part, the EPO continues to have certain rights or obligations concerning the patent during this period; for example, the annual fees fall due and transfers of rights in the patent must be registered by the EPO.

6.4 With regard to the assertion of the applicant that its interpretation of the term "proceedings for grant" is borne out by a number of decisions of the Enlarged Board, the Board finds that the applicant has misconstrued these decisions. None of the cases cited are concerned with the distinction between the legal effects of Article 97(2) EPC and 97(4) EPC in the circumstances of the present case. G 1/90 was concerned with the question whether the revocation of a patent under Article 102(4) and (5) EPC requires a decision. Mention is made therein of the termination of the grant procedure according to Article 97(2) EPC in the context that at that stage the examining division delivers a decision (point 5 of the reasons). Nothing relevant to the present case can be construed from that reference. G 4/91 and G 12/91 are concerned with the stage of proceedings at which the examining or opposition division no longer has the power to amend a decision or to consider fresh arguments concerning the text of the application or patent submitted by the parties. As already stated, it is settled law that, following the issue of a decision to grant by the examining division, both the EPO and the applicant are bound by the decision (cf. paragraph 6, above). G 4/91 found that, as far as the points of substance at issue are concerned, opposition proceedings are finally terminated when a decision is issued, if no appeal is filed in time. The case was concerned with an assumed

infringer wishing to intervene in the opposition proceedings after a decision had already been taken, but which had not become final because the time period for filing an appeal had not yet elapsed. The applicant seeks to conclude from this that the date at which a decision to grant is made must also terminate grant proceedings. However, the legal situation with respect to the taking effect of a decision in proceedings for grant is quite different to that applying in opposition proceedings. Article 97(4) EPC specifically provides that a decision to grant shall not take effect until the date on which the European Patent Bulletin mentions the grant. Moreover, the travaux préparatoires of the EPC make it absolutely clear that this was the intention behind Article 97(4) EPC: "Nach der Neufassung beschliesst die Prüfungsabteilung über die Erteilung des Patents; dieser Beschluß wird aber erst an dem Tage wirksam, an dem der Hinweis auf diese Erteilung im Europäischen Patentblatt bekanntgemacht wird" [translation: "According to the new text, the examining division decides on the grant of the patent; this decision, however, will only take effect on the date on which the mention of the grant is published in the European Patent Bulletin."] (document BR/177 d/72, page 13). There is no equivalent provision so far as opposition proceedings are concerned and G 4/91 does not support the applicant's case. Likewise the Board considers that the passage referred to by the applicant in G 3/92 (cf. point 5.3 of the reasons) does not support the interpretation put on it in the applicant's submissions; in that case, the Enlarged Board was concerned with an entirely different problem; similarly, there is nothing in the passages referred to in J 11/91 and J 16/91 (paragraphs 2.4 and 2.6 of the reasons) to support the applicant's case.

7. As regards the definition of "proceedings for grant" argued for by the applicant, there is no basis for such a definition in the European Patent Convention. On the contrary, the "procedure up to grant", the title of Part IV of the Convention, is defined and described in detail in Part IV, Articles 90 to 98 EPC, inclusive. These provisions of the EPC make it clear that proceedings up to grant include the procedure provided for under Article 98 EPC, which reads: "At the same time as it publishes the mention of the grant of the European patent, the European Patent

Office shall publish a specification of the European patent containing the description, the claims and any drawings".

8. Rule 14 EPC provides: "As from the time when a third party proves to the European Patent Office that he has initiated proceedings concerning entitlement and up to the date on which the European Patent Office resumes the proceedings for grant, **neither the European patent application nor the designation of any Contracting State may be withdrawn**". This provision aims to protect the third party requesting suspension under Rule 13(1) EPC by preventing the original applicant from prejudicing the third party's rights. The applicant in the present case does not dispute that, in the period between the decision to grant being taken and the mention of the grant being published, an applicant can withdraw the application and a third party to whom rights have been assigned by contract is entitled to have the transfer registered by the EPO. In the light of the aim of Rule 14 EPC, it would be totally inequitable if, during the same interim period, an applicant can withdraw the application and a third party under Rule 13(1) EPC were to be refused suspension and the opportunity to prove that he is the rightful owner of the application. Moreover, any other interpretation would be contrary to the object and purpose of Article 61 EPC and Rule 13 EPC, which is to provide a centralised procedure for settling disputes as to entitlement during the period the EPO is responsible for the application (cf. paragraph 2.2, above). The logic of this system would be destroyed if, in the interim period between the decision to grant being taken and the mention of the grant being published, a jurisdictional gap were to exist, neither the EPO nor the national patent systems being responsible for the application.

9. With regard to the relationship between Rule 13 EPC and Article 61 EPC, the Board disagrees with the argument that, since the decision to grant under Article 97(2) EPC could not be set aside or amended, there was no longer any entitlement to grant which a third party found to be entitled could allege vis-à-vis the EPO and no longer any application which could be prosecuted under Article 61 EPC. Following the decision to grant under Article 97(2) EPC, the application is still

pending before the EPO, proceedings up to grant not having been concluded (Article 97(4) EPC and Article 98 EPC). The third party would therefore be free to avail himself of at least one of the options provided for by Article 61(1)(a) EPC, "prosecution of the application as his own application in place of the applicant", (cf. G 3/92 (paragraph 5.8 of the reasons)). It is clear from the text of Article 61 EPC in all three languages that these options are alternatives, they being listed with the word "or", "ou" and "oder" preceding the last option. It is not necessary that the third party be in a position to exercise all of the options. There is no need therefore for the Board to consider whether such a third party would be able to exercise the other options of requesting that the application be refused (Article 61(1)(b) EPC) and filing a new European patent application in respect of the same invention under (Article 61(1)(c) EPC).

10. In conclusion, the Board holds that a decision of the Examining Division to grant a European patent (Article 97(2) EPC) does not take effect on the date the decision-making process following written proceedings before that division is completed but on the date on which the European Patent Bulletin mentions the grant (Article 97(4) EPC). This means that at the time the request for suspension of proceedings in the present case was filed at the EPO, the proceedings for grant were still pending before the EPO and the European patent had not yet been granted.

11. The request for suspension of the proceedings for grant thus complies with the provisions of Rule 13(1) EPC and was submitted in due time. The appellant party provided proof that it commenced proceedings against the applicant before the UK Patent Office on 3 October 1995, seeking a declaration that the invention the subject of application No. 91 915 912.9 is the appellant's property. The appeal should therefore be allowed.

12. The Board has decided not to exercise its powers under Rule 13(3) EPC to set a date on which the EPO intends to continue the proceedings pending before it, in the light of the present uncertainty concerning the likely date when the entitlement proceedings in the United Kingdom will be completed.

13. The Board also has the following remark to make on the suggestion that the examining division exceeded its authority when it retroactively cancelled the mention of the grant published on 25 October 1995 (cf. paragraphs VI and IX, above). This Board decided in J 28/94, above, that the suspensive effect of an appeal under Article 106(1) EPC deprives the contested decision of all legal effect until the appeal is decided. Otherwise the appeal would be deprived of any purpose. Thus, in the event of appeal against a decision refusing to suspend publication of the mention of grant of a patent, publication must be deferred pending the outcome of the appeal. If, as is the case in the present appeal, the publication occurred before an appeal was lodged, the EPO must take appropriate steps to inform the public that the mention of the grant was not valid. The examining division in retroactively cancelling the mention of the grant in the European Patent Bulletin in the present case was acting in full conformity with Article 106(1) of the EPC.

14. For the reasons given in paragraphs 2 and 6 to 11, above, the Board considers that the question which the applicant has requested should be referred to the Enlarged Board has been fully answered in the reasons for the present decision and that there is, therefore, no reason under Article 112 EPC for the Board to refer the question to the Enlarged Board.

Order

For these reasons it is decided that:

1. The request of the respondent to refer a question to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The proceedings before the EPO in respect of patent application No. 91 915 912.9 are suspended under Rule 13(1) EPC with retrospective effect from 3 October 1995.