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D E C I S I O N
of 25 May 1999

Case Number: J 0036/97 - 3.1.1

Application Number: 92913812.1

Publication Number: 0588944

IPC: G01S 13/75

Language of the proceedings: EN

Title of invention:

An improved miniature transponder device

Applicant (Respondent):

Algernon Promotions Inc.

Third party (Appellant):

Sokymat SA

Headword:

Suspension of proceedings/ALGERNON

Relevant legal provisions:

EPC Art. 97(4)

EPC R. 13

Protocol of Recognition Art. 3, 5, 7, 9(2)

Keyword:

"Suspension of proceedings"

Decisions cited:

J 0028/94, J 0007/96, J 0008/96, T 0146/82

Headnote:

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Case Number: J 0036/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 25 May 1999

Appellant: Sokymat SA
Zone industrielle
1614 Granges (Veveyse) (CH)

Representative: Kather, Peter, Dr.
Seelig & Preu, Bohlig
Scheibenstrasse 43
40479 Düsseldorf (DE)

Respondent: Algernon Promotions Inc.
Apartadeo 4725
Panama 5 (PA)

Representative: Witte, Alexander, Dr.-Ing. et al.
Witte, Weller & Partner
Rotebühlstrasse 121
70178 Stuttgart (DE)

Decision under appeal: Decision of the Legal Division of the European Patent Office dated 8 October 1997 refusing a request pursuant to Rule 13(1) EPC for suspension of proceedings with respect to European patent application No. 92 913 812.1.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. Schachenmann
A. Lindqvist

Summary of Facts and Submissions

- I. On 21 August 1997 the EPO issued a decision to grant a patent on European patent application No. 92 913 812.1. The applicants (respondents) were informed that, according to Article 97(4) EPC, the decision would take effect on the date on which the European patent Bulletin mentioned the grant, i.e. on 1 October 1997.
- II. On 24 September 1997 a third party (appellants) filed a request to stay the proceedings for grant according to Rule 13 EPC and submitted proof that they had opened proceedings against the respondents before the Landgericht München I for the purpose of seeking a judgement that they were entitled to the grant of the European patent on the application referred to above.
- III. In a decision dated 8 October 1997 the Legal Division of the EPO refused the appellants' request on the grounds that the decision to grant a patent for the application referred to above had become final already on 15 August 1997. It did not matter, in its view, that the decision to grant had not yet taken effect pursuant to Article 97(4) EPC at the time the appellants' request was filed.
- IV. On 8 October 1997 the appellants filed a notice of appeal against the decision of the Legal Division including a written statement setting out the grounds of appeal. The appeal fee was duly paid.

The appellants requested that the decision of the Legal Division be set aside and the proceedings with respect to European patent application No. 92 913 812.1 be suspended pursuant to Rule 13 EPC.

Furthermore, they requested that the publication of the mention of the grant be prevented or that a correction be published in the European Patent Bulletin informing the public that 1 October 1997 was not to be considered the date of grant.

V. In support of these requests the appellants submitted that even if the decision to grant was already taken and notified when they filed their request under Rule 13 EPC, it had a binding effect only between the EPO and the applicants. As concerns third parties, it did not take legal effect, pursuant to Article 97(4) EPC, until publication of the mention of the grant in the European Patent Bulletin. Thus, neither the date on which the decision was handed over to the EPO postal service nor the date of its notification to the applicants could, for reasons of legal certainty, be of any importance for the application of Rule 13 EPC. The only date relevant in this connection was the date of publication of the mention of the grant in the European Patent Bulletin. However, such publication had not yet occurred at the time of filing the request and proof under Rule 13 EPC. In these circumstances the Legal Division was wrong in deciding that the proceedings in respect of European patent application No. 92 913 812.1 were not to be suspended.

VI. On 4 November 1997, the EPO issued a communication informing the parties that, as a consequence of the suspensive effect of the appeal filed on 8 October 1997, the publication procedure of the decision to grant had to be suspended until the end of the appeal proceedings and that, therefore, the publication date of 1 October 1997 of the mention of the grant was cancelled. The cancellation of the publication date of 1 October 1997 was published in the European Patent Bulletin 97/51 of 17 December 1997.

VII. In their response dated 18 December 1997 the respondents requested that (main request):

- the appeal be rejected as inadmissible,
- the cancellation of the publication date of 1 October 1997 of the mention of the grant be set aside, and
- the European Patent Office be ordered to publish a correction of the publication of the cancellation of the publication date of 1 October 1997 of the mention of the grant, informing the public that 1 October 1997 was to be considered as the date of grant within the meaning of Article 64(1) and 97(4) EPC, and to inform the National Offices accordingly.

As an auxiliary request the respondents requested that a date be set as soon as possible, on which the EPO intended to continue the grant proceedings regardless of the stage reached in the proceedings pending before the Landgericht München I.

VIII. In support of these requests the respondents argued as follows: It was true that, on September 23 1997, the appellants had brought an action against the respondents (proprietors) before the Landgericht München I for the purpose of seeking a judgement that they were entitled to the grant of the European patent. However, the action was based on allegations only without offering any evidence. More importantly, the Landgericht München I had no jurisdiction, pursuant to Article 3 of the Protocol on Recognition, to decide such claims against the proprietor, a company having its residence outside the Contracting States of the EPC. Thus, the law suit instigated by the appellants was not admissible. In addition, due to a non-

disclosure agreement between the appellants and the legal predecessor of the respondents, the appellants' action constituted an abuse of law. Moreover, the German subsidiary of the appellants had been aware of the patent application of the respondents for a long time and could therefore have filed a request under Rule 13 EPC much earlier. Finally, the request under Rule 13 EPC was filed too late since the application was already granted at that time.

IX. In a letter dated 31 March 1998 the appellants commented on these arguments. They admitted that the Landgericht München I lacked jurisdiction according to Article 3 of the Protocol on Recognition. However, in the mean time, they informed the Board that an agreement pursuant to Article 5 of the Protocol was concluded between the parties to the effect that the Landgericht München I should decide on their dispute concerning the right to the grant of the patent. Furthermore, the appellants denied that the non-disclosure agreement referred to by the respondents had any relevance for the present case. In particular, the agreement was concluded several years before the filing date of the present patent application which was based on an invention made by the founder of the appellants.

X. On 28 December 1998 the appellants informed the Board that the Landgericht München I had summoned the parties to oral proceedings taking place on 16 September 1999.

Reasons for the Decision

1. The present appeal lies from a decision of the Legal Division rejecting the appellants' request for suspension of the proceedings for grant of the published European patent application No. 92 913 812.1 under Rule 13 EPC.

According to the main request of the respondents the present appeal should be rejected "as inadmissible". The arguments submitted in support of this request do not, however, refer to the issue of admissibility of the appeal (Rule 65 EPC) but rather concern its allowability. Since the appeal complies with Articles 106 to 108 and with Rule 1(1) and Rule 64 EPC, it is admissible.

2. According to the jurisprudence of the Boards of Appeal suspension of the proceedings for grant **must** be ordered under Rule 13 EPC, if satisfactory proof of the opening of relevant national proceedings is given by a third party seeking a judgement that it is entitled to the grant of the European patent while the proceedings for grant are still pending (T 146/82, OJ EPO 1985, 267; J 28/94, OJ EPO 1997, 400, point 2.1 of the reasons).
3. The Legal Division rejected the appellants' request for suspension of the proceedings under Rule 13 EPC on the grounds that it was filed after the decision to grant the European patent had been issued. However, in two recent decisions J 7/96 and J 8/96 of 20 January 1998 the Legal Board of Appeal came to the conclusion that an admissible request for suspension of proceedings

under Rule 13 EPC can still be filed in the interim period between the decision to grant a patent and the date on which the European Patent Bulletin mentions the grant. The present Board sees no reason to depart from this finding.

Thus, in view of the fact that the request for suspension of the proceedings under Rule 13 EPC was filed on 24 September 1997, i.e. before the publication of the mention of the grant scheduled for 1 October 1997 took place, the request was submitted in due time.

4. The respondents raised the issue of jurisdiction of the Landgericht München I and argued that the appellants' action constituted an abuse of law (see point VIII., supra). However, pursuant to Article 7 of the Protocol on Recognition the courts in the Contracting States before which entitlement proceedings are brought shall of their own motion decide whether or not they have jurisdiction pursuant to Articles 2 to 6 of the Protocol. Moreover, according to Article 9(2) of the Protocol, neither the jurisdiction of the national court whose decision is to be recognised nor the validity of such decision may be reviewed. Thus, according to these provisions, the EPO can neither examine the national procedural law nor national substantive law to be applied in proceedings concerning the right to the grant of a European patent (see Stauder, Münchner Gemeinschaftskommentar, vol. 6, Protocol of Recognition, Article 9, No. 9). For this reason, the Board cannot consider the respondents allegations referred to above.

5. In connection with Rule 13 EPC, it is sufficient for the Board to ascertain that the party requesting suspension of the proceedings has opened proceedings against the applicants in a Contracting State for the purpose of seeking a judgement that it is entitled to the grant of the European patent.

In the present circumstances, the appellants, when requesting suspension of the proceedings on 24 September 1997, submitted a copy of their statement of claim filed with the Landgericht München I one day before. The copy bears a date stamp providing authentic proof that the original was indeed filed on 23 September 1997. The Board is therefore satisfied that entitlement proceedings before a court in a Contracting State were opened when suspension of proceedings under Rule 13 EPC was requested.

6. Thus, irrespective of the final outcome of the national court proceedings, the requirements of Rule 13(1) EPC for suspension of the present proceedings are met. The appellants' requests (see para IV., supra) can therefore be allowed. Since the publication on 1 October 1997 of the mention of the grant could not be prevented, the EPO was correct in cancelling that publication in the European Patent Bulletin 97/51 of 17 December 1997 (see decision J 7/96, point 13 of the reasons).

7. In view of this result, there is no room for allowing any of the respondents' main requests (see para VII., supra) which therefore have to be rejected.

According to the respondents' auxiliary request the Board should set a date on which the EPO intended to continue the grant proceedings regardless of the stage reached in the proceedings pending before the Landgericht München I. Rule 13(3) EPC indeed provides a

legal basis for such a request. However, the Board has decided not to exercise its powers under this Rule since, although the proceedings before the national court appear to make real progress, it is uncertain when they will be completed (see point X., supra). On the other hand, a continuation of the proceedings before the EPO at the present stage could result in procedural disadvantages for the appellant.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

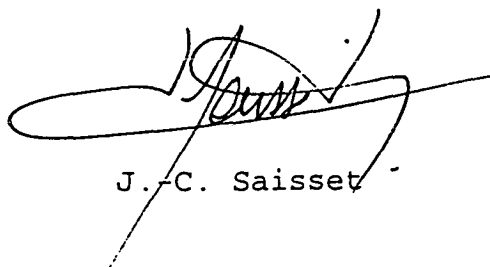
2. The proceedings before the EPO in respect of patent application No. 92 913 812.1 are suspended under Rule 13(1) EPC with retrospective effect from 24 September 1997.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

B. Sch.

A. L. 1111.D