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**Datasheet for the decision
of 15 June 2015**

Case Number: J 0002/14 - 3.1.01
Application Number: 08736405.5
Publication Number: 2148770
IPC: B29B11/14, B65D77/06,
B65D25/14, B29C49/06, B29C49/22
Language of the proceedings: EN

Title of invention:

INTEGRALLY BLOW-MOULDED BAG-IN-CONTAINER HAVING AN INNER LAYER
AND THE OUTER LAYER MADE OF THE SAME MATERIAL AND PREFORM FOR
MAKING IT

Applicant:

Anheuser-Busch InBev S.A.

Respondent:

Dispensing Technologies B.V (Third Party)

Headword:

Stay of proceedings

Relevant legal provisions:

EPC Art. 61
EPC R. 14(1), 14(3)

Keyword:

Resumption of the proceedings for grant

Decisions cited:

J 0033/95, J 0007/96, J 0033/03, J 0020/05, J 0009/06,
J 0015/06, J 0006/10, J 0015/13

Catchword:



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Case Number: J 0002/14 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 15 June 2015

Appellant: Anheuser-Busch InBev S.A.
(Applicant) Grand'Place 1
1000 Brussels (BE)

Representative: BiiP cvba
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1831 Diegem (Bruxelles) (BE)

Respondent: Dispensing Technologies B.V.
(Third Party) Grasbeemd 1
5705 DE Helmond (NL)

Representative: Arnold-Siedsma
Bezuidenhoutseweg 57
2594 AC Den Haag (NL)

Decision under appeal: **Decision of the Legal Division of the European
Patent Office dated 14 June 2013**

Composition of the Board:

Chairwoman C. Vallet
Members: B. Müller
T. Karamanli

Summary of Facts and Submissions

- I. The appeal lies from the decision by the Legal Division of 14 June 2013 refusing the applicant's main request that "the suspension of the grant proceedings be undone" and the auxiliary request that "a date for the resumption of the proceedings be set pursuant to Rule 14(3) EPC". The decision under appeal concerns both European patent applications Nos. 08 749 615.4 and 08 736 405.5. The present decision deals only with the second application.
- II. The appeal was filed by the applicant by letter dated 26 August 2013 and the prescribed fee was paid on the same day.
- III. The facts underlying the present case, as far as they are relevant to the present decision, are as follows.
- IV. European patent application No. 08 736 405.5 was filed as a PCT application on 18 April 2008 in the name of InBev S.A, now Anheuser-Bush InBev S.A (change recorded in the European Patent Register with effect from 17 November 2011). The decision to grant a patent was issued on 23 February 2012. The publication of the mention of the grant in the European Patent Bulletin was scheduled for 21 March 2012.
- V. By letter dated 20 March 2012, received at the European Patent Office (EPO) on the same day, Dispensing Technologies B.V. requested, as a third party within the meaning of Rule 14(1) EPC, a stay of the proceedings in respect of the application under consideration. It submitted that entitlement proceedings within the meaning of Article 61(1) EPC had

- been instituted against the applicant before the Brussels Commercial Court (hereinafter BCC). In support of that request, a copy of the writ of summons - together with a translation into English - was filed.
- VI. By a communication dated 28 March 2012, the Legal Division informed the applicant and the third party that the grant proceedings were stayed as from 20 March 2012. The Legal Division also indicated that the published mention of the grant concerning EP 08 736 405.5 would be corrected accordingly.
- VII. By letter dated 28 May 2012, the applicant requested an appealable decision. The applicant requested that the suspension of the grant proceedings be undone (main request) or that a date for resumption be set pursuant to Rule 14(3) EPC (auxiliary request).
- VIII. In its decision the Legal Division held that the third party was indeed seeking before the BCC a decision within the meaning of Article 61 EPC, i.e. that it was entitled to the grant of a patent in respect of the application in suit. It also found that this action had been instituted on 20 March 2012, at a point in time when the grant proceedings were still pending, so that the Legal Division was competent to order a correction of the mention of the grant. As regards the auxiliary request, the Legal Division held that it was premature to set a date for resumption of the grant proceedings, considering in essence that no delaying tactics had been demonstrated, and that the third party's request for withdrawal of its action before the BCC, not accepted by the applicant, could not be interpreted as consent to the continuation of the grant proceedings. It noted that a date for a hearing before the BCC had been scheduled for 18 September 2013.

- IX. In the statement of grounds of appeal filed on 24 October 2013, the appellant requested that:
- the first point of the contested decision be cancelled and that "suspension of the application Nos. EP 08 749 615.4 and EP 08 736 405.5 be deemed undone as from the date on which the original request for suspension was received" by the EPO, i.e. 20 March 2012 (main request);
 - the second point of the decision i.e. not to set a date for resumption of the proceedings, be cancelled and that such a date be set (auxiliary request);
 - the appeal fee be reimbursed "on the basis that the refusal of suspension was a substantial procedural violation".
- X. The Board issued a communication on 23 February 2015 and summoned the parties to oral proceedings, which were held on 6 May 2015.
- XI. On 3 April 2015 the appellant filed new submissions containing new requests. The respondent's last submissions made before the oral proceedings are dated 2 April 2015.
- XII. The arguments of the appellant, as far as they are relevant to the present decision, can be summarised as follows:
- Regarding the main request, the resumption of the proceedings was justified due to the length of the stay, over three years. This was the direct consequence of actions by the respondent (third party) that could be considered as an abuse of proceedings and delaying tactics in order to avoid hearings before the BCC on the merits, even though three dates had been reserved for that purpose on 18 September 2013, 18 June 2014 and

28 January 2015 respectively. The appellant presented in detail the sequence of events. The following are of particular relevance:

- on 5 July 2012, the respondent started an action against the appellant before the Court of St. Louis (Missouri) claiming that the appellant had misappropriated trade secrets which formed the basis of the patentable invention;
- on 13 July 2012, the respondent withdrew ("waived") "without prejudice" the Belgian action justifying the stay of the grant proceedings. The appellant refused the waiver so that the proceedings continued;
- on 15 April 2014, a second set of proceedings was started by the respondent before the BCC against the applicant with the same cause of action;
- on 10 October 2014, the respondent withdrew its case before the Court of St. Louis (Missouri);
- on 27 January 2015, the respondent filed a second request for a stay of the proceedings for grant in respect of the European patent application in suit, based on the second action started in Belgium;
- on 28 January 2015, the hearing scheduled in the first set of proceedings before the BCC was postponed *sine die*.

As regards the appellant's refusal to accept the third party's withdrawal of the first action in Belgium, the appellant argued that its intention was to plead and obtain a decision on the merits as soon as possible in order that the grant proceedings could continue, given that the waiver by the respondent was undisputedly triggered by a lack of (accessible) evidence. Even if the appellant had accepted the withdrawal, this would not have prevented the respondent from initiating the second action by serving a second writ of summons and obtaining the postponement of the planned hearings

based on the argument that a discovery procedure in the USA would yield decisive evidence as regards the entitlement case.

The appellant declared that it was ready to commit neither to withdrawing the application in suit nor to abandoning it as long as the first proceedings in Belgium were still pending. Regarding the first auxiliary request it argued that the conditions for a stay of the grant proceedings pursuant to Rule 14(1) EPC were not fulfilled at the date of filing of the pertinent request, i.e. 20 March 2012. As a consequence it requested that a date be set for resumption of the grant proceedings.

The appellant considered that the proceedings before the BCC were about entitlement in name but not in nature. Referring to decision J 15/13, it submitted that the proceedings before the BCC were not directed to a transfer of the application as a result of being the true inventor, in view of the fact that nine months before the meeting at which the respondent had informed the appellant about "*the coating, i.e. the release agent, used in the form of a silicone for the inner preform (of the bag-in-container) avoiding this inner preform to stick to the outer preform while being heated at the time of blowing*", the appellant had already filed a US patent application claiming: "*an integrally blow-moulded bag-in-container comprising the same polymer in contact on either side of the interface between the inner and the outer layers*". This was exactly what was claimed in the application in suit. It was not related to the release agent alleged to be *the know-how* of the respondent, for which it did not file a patent application. The sole relation between the invention claimed by the respondent and the invention

claimed in the application in suit was an **integrally blow-moulded bag-in-container**. This relationship would not be sufficient to satisfy the test for unity of invention and therefore it could not be regarded as the same invention within the meaning of Rule 14(1) EPC.

The respondent's argument that the use of a release agent was mandatory in order to use the same polymer on either side of the interface, such that the application lacked an essential feature, concerned the validity of the patent rather than its ownership. Thus the proceedings, by their nature, were not entitlement proceedings.

The appellant also disputed that the respondent had truly instituted proceedings in Belgium at the date of the request for a stay, i.e. on 20 March 2012, because at that point in time it had still not registered its writ of summons with the Court as required by the Belgian Judicial Code. It presented an interpretation of Article 717 of said Code, supplemented by an expert legal opinion.

The appellant finally explained how the second auxiliary request could preserve the interests of both parties and relied on decision J 33/03 in this respect.

XIII. The respondent argued in essence as follows:

As regards the request based on Rule 14(3) EPC, the basic principle was that the grant proceedings should be stayed until a final decision had been reached by the competent national court. This principle could only be ignored when the third party consented in writing to the continuation of the proceedings. This was not the case so that the contested decision was

correct in its assessment. Resumption of the proceedings at the present stage (application ready for grant) would jeopardise the fundamental right of the third party when becoming the new lawful applicant under Article 61(1) EPC, namely the right to prosecute a new application. This should be taken into consideration when balancing the interests of the parties. The appellant (applicant) would lose no substantive rights due to a prolongation of the suspension.

The risk was particularly serious for the third party in the present case where, after resumption, the patent would be published, with the consequence that it would then split up into several national patents. This could lead to the rejection of the claim for entitlement relating to a European patent which no longer existed, forcing the third party to institute several new sets of proceedings in different states. In addition, the third party ran the risk of withdrawal of the application. Rule 14(3) EPC provided the EPO with discretionary means only in the event that the third party agreed to the stay being lifted or no longer pursued the request for stay. The recent case law taking into account the long duration of the proceedings or delaying tactics or even a first-instance decision in favour of the applicant was unbalanced. The EPO was not in a position to assess the length of proceedings before national courts and the respondent was not in any way delaying the proceedings.

Regarding the request for withdrawal of the action before the BCC, the respondent argued that before the commencement of the action, it had believed it possible to make use of evidence obtained within the

framework of arbitration proceedings in the USA, although subject to a confidentiality agreement. Since the appellant had raised an objection "it realised that, without the evidence available from the arbitration proceedings, its position in the Belgian entitlement proceedings was jeopardised...". It had therefore decided to withdraw without prejudice the Belgian action and to introduce an action in the Circuit Court of St. Louis (Missouri) on the ground of theft of trade secrets, and had requested wide-ranging discovery. The appellant was using every means to prevent the respondent from having access to evidence. Its opposition to the withdrawal belonged to the same strategy. However, it could not be excluded that the BCC would reject the withdrawal so that the entitlement proceedings, which were still pending, could continue.

Concerning the requirements of Rule 14(1) EPC, the respondent affirmed that it had adduced evidence that entitlement proceedings had been opened before the BCC on 20 March 2012. The EPC did not require that all the procedural steps required by national procedural law had been completed, which the EPO was not in a position to assess. Yet, contrary to the allegation of the appellant, Article 717 of the Belgian Judicial Code was to be construed in such a way that the action was brought to the court at the date of the writ of summons, in so far as the case was registered in the court's docket before the hearing indicated in the writ of summons. This was the interpretation given by the Belgian Supreme Court.

The Belgian proceedings were entitlement proceedings within the meaning of Article 61(1) EPC in that the request was to declare the respondent solely entitled

to the patent application in suit. The EPO was not competent to compare the subject-matter in national entitlement proceedings and the subject-matter of the application for which stay had been ordered (cf. decision J 20/05). Nor could the EPO define the scope of the national proceedings. The lack of complete identity objected to by the appellant between the invention as claimed in the application and the explanations given by the respondent in the course of the Belgian proceedings only reflected the different views of both parties as to what constituted the gist of the invention. This was exactly what the national court had to decide upon (cf. decision J 9/06), as correctly assessed by the Legal Division.

The arguments put forward in respect of objections not maintained in the respondent's last submissions do not need to be mentioned.

XIV. The final requests of the appellant are as follows:

- **Main request:** *"Pursuant to Rule 14(3) EPC, the Board of Appeal is respectfully requested to set a date on which it intends to resume the proceedings for grant with immediate effect, regardless of the stage reached in the national proceedings instituted under Rule 14(1) EPC" or", alternatively, that the date should be as soon as possible."*;

- **Auxiliary request 1:** *"In case the MR cannot be granted, the Board of Appeal is respectfully requested to decide, contrary to the Legal Division's appealable decision dated 14/06/2013, that the conditions for suspension of the grant proceedings pursuant to Rule 14(1) EPC were not fulfilled when the Third Party filed*

its request dd. 20/03/2012 and to declare unfounded the decision to stay the grant proceedings of the EP-Application in suit. Consequentially, the Board of Appeal is respectfully requested to end the suspension of the grant proceedings pursuant to Rule 14(1) EPC with immediate effect and/or set a date pursuant to Rule 14(3) EPC on which to resume the proceedings for grant with immediate effect or as soon as possible.";

*- **Auxiliary request 2:** "In case the AR1 cannot be granted, the Board of Appeal is respectfully requested to set a date pursuant to Rule 14(3) EPC on which it intends to resume the proceedings for grant, regardless of the stage reached in the national proceedings instituted under Rule 14(1) EPC, **under condition** that the Applicant/Appellant files a divisional application before mention of grant of the parent Patent in the Bulletin, said divisional application calling for the subject-matter of the claims of the parent application with the additional feature that a release agent is applied between the layers."*

XV. The respondent requested that the appeal be dismissed.

XVI. The decision of the Board was announced at the oral proceedings held for that sole purpose on 15 June 2015.

Reasons for the Decision

1. The appeal fulfils the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is therefore admissible.

2. Main request

The stay of the proceedings

- 2.1 Under Rule 14(1) EPC the EPO must stay grant proceedings if a third party provides evidence that it has instituted proceedings against the applicant for the purpose of seeking a decision that the third party instead of the applicant is entitled to the grant of the European patent. This issue is not disputed within the scope of the new main request. Nevertheless, a request for resumption of the proceedings for grant only makes sense from a logical point of view if the stay of these proceedings is to be considered as legally justified. The Board shares in this respect the reasoning of the contested decision.
- 2.2 Upon reading the pertinent provisions of the Belgian Judicial Code and the decisions of the Belgian Supreme Court and the legal study submitted by the parties, the Board considers that the writ of summons served on the appellant on 20 March 2012 had the effect of initiating proceedings before the BCC, irrespective of the fact that it was registered on 29 March 2012, thus the day before the first hearing, which took place on 30 March 2012. The Board, in this respect, affirms its provisional findings in the communication annexed to the summons for oral proceedings (see point 5.1).
- 2.3 This writ of summons filed by the third party (respondent) requests the court: "*to declare that they are solely entitled to the European patent application with number EP 2 148 770 (application number 08 736 405.5) and to order the transfer of the*

application to them. - to declare that they are co-inventor of the inventions described in European patent application (08 736 405.5) and in European patent application (08 749 615.4) and are therefore co-owners of these inventions."

- 2.4 These requests obviously aim at recognition of the rights of the claimant to European patent applications which are clearly identified and correspond to those that the appellant filed with the EPO. Contrary to the argument put forward by the appellant, the EPO is not competent to determine whether the scope of the inventions claimed before the national court is identical to that conferred by the patent applications which are the subject of the request for a stay. This lies within the exclusive competence of the court before which the action was brought. Only where it is clear that no identity exists between the claimed subject-matters could the EPO reject the request for stay due to non-compliance with the requirements of Rule 14(1) EPC. However, this does not apply in the present case.
- 2.5 The competence of the Legal Division to order suspension after the publication of the mention of the grant of the patent and to order correction of said publication, provided that the requirements for a stay were met before the publication, has been recognised by the Legal Board of Appeal in decisions J 15/06 of 30 November 2007, point 14 of the Reasons, and J 33/95 of 18 December 1995. This was no longer disputed in the last submissions of the appellant.
- 2.6 The decision to stay the grant proceedings was thus justified.

The request to resume the proceedings for grant

3. Under Rule 14(3) EPC, upon staying the proceedings for grant, or thereafter, the EPO can order that the grant proceedings be resumed regardless of the state reached in the national entitlement proceedings. Contrary to the decision to stay, it is within the discretion of the EPO to decide whether the proceedings for grant are to be continued.
- 3.1 The Board does not share the respondent's view that, in principle, patent grant proceedings must be stayed until a final decision has been reached in the national entitlement proceedings. Rule 14(3) EPC cannot be construed as an exception to such a principle as this rule provides that a date for resumption may be set **upon staying** the proceedings for grant as well as thereafter. This view has already been expressed by the Legal Board of Appeal in decision J 33/03, point 2.1 of the Reasons, and in decision J 15/13 of 9 May 2014, point 2.1 of the Reasons. While it may be true that the practice has developed in such a way that a stay has rarely been set in advance for a fixed time period in order to allow the third party sufficient time to conduct the proceedings before a national court until they are concluded, it is nevertheless clear that Rule 14(3) EPC gives the EPO the power to set the time frame for resumption of the grant proceedings right at the beginning of the stay.
- 3.2 It follows that the mere fact that the proceedings before the BCC are still pending is not a sufficient

ground to refuse to set a date for the resumption of the grant proceedings.

- 3.3 In order to determine whether the grant proceedings are to be resumed, the Board has to take into account all aspects relevant in balancing the interests of the parties, however, without considering to which party the European patent might belong. This lies within the sole competence of the national courts (see J 33/03 of 16 November 2004, point 2.1 of the Reasons).
- 3.4 In so doing the Board has to bear in mind that the aim of Rule 14 EPC is to prevent a non-entitled applicant from impairing the position of a potential true proprietor by amending or even withdrawing the application without the latter's consent (cf. J 7/96, OJ EPO 1999, 443, point 8 of the Reasons).
- 3.5 In the present case, the stay of the grant proceedings was requested on the day before the publication of the mention of the grant of the patent, which means that the third party waited until the very last moment to introduce the case before the BCC and to request a stay of the proceedings. Taken alone, this is not a sufficient ground for resumption of the proceedings because it would run counter to the right of the third party to request a stay as long as the grant proceedings are still pending. However, such a circumstance might play a role if there are other facts or evidence showing that the third party is not actively seeking a decision by the national court. On the other hand, this also means that the applicant (appellant) can no longer influence the scope of the patent in so far as it has already approved the text in which it was intended to grant the patent (cf. J 6/10 of 13 November 2012, point 4.6 of the Reasons). This is

all the more true in the present case as the decision to grant the European patent was already issued.

3.6 According to a consistent body of case law, the length of the proceedings before the national court or national authority is also to be taken into consideration in a decision whether to resume the grant proceedings (see for instance J 6/10 of 13 November 2012, point 4.2 of the Reasons). This aspect is of particular relevance in the case at issue where so far no hearing as to the substance has taken place before the BCC, although the entitlement proceedings were started three and a half years ago.

4. In the present case, the sequence of events is the following:

- on 20 March 2012, the proceedings for entitlement were initiated by the third party before the BCC. It requested a stay of the grant proceedings before the EPO on the same day;

- on 13 July 2012, the third party attempted to withdraw the Belgian action "without prejudice", meaning that the waiver needed the agreement of the other party to the proceedings in order to be effective; the appellant did not give its agreement;

- on 15 May 2014, the third party brought a second set of entitlement proceedings against the appellant before the BCC with the same cause of action; this is not disputed by the parties;

- on 27 January 2015, the third party requested a stay of the proceedings on the basis of the second Belgian proceedings. This request was rejected by the Legal

Division on the ground that it was redundant due to the fact that the grant proceedings had already been stayed;

- at the date of the oral proceedings before the Board, no hearing had taken place before the BCC as to the merits of the case. The two sets of Belgian proceedings have not been consolidated so far.

- 4.1 This shows that the first entitlement action instituted before the BCC, which serves as the sole basis for the current stay, was withdrawn by the respondent about four months after being instituted and, moreover, that the grant proceedings have been stayed for more than three years although the respondent (third party) does not wish to pursue these proceedings. Such a factual situation appears to be entirely inconsistent with the aim of Rule 14(3) EPC.
- 4.2 It is true that the first entitlement proceedings are still pending due to the fact that the appellant did not accept the withdrawal. However, the reasons for this refusal are clear, nor are they disputed by the third party, which recognised in its written submissions and again at the oral proceedings before the Board that it was not in a position to pursue the first entitlement action due to a lack of evidence.
- 4.3 In such circumstances, the third party cannot be regarded as truly seeking a national court decision recognising its right to the patent. In drawing this conclusion the Board is not considering the merits of the entitlement proceedings, as it is not within its competence to do so, but accepts the conclusion drawn by the respondent itself that its case before the

Belgian Court was without prospect of success in the case at issue.

- 4.4 The respondent's argument that, by not accepting the withdrawal, the appellant bears the sole responsibility for the proceedings still being pending before the national court does not really reinforce the position of the appellant and is therefore not convincing. Construed a contrario, this also means that had the appellant accepted the waiver, no proceedings would have continued at national level and consequently the grant proceedings would not have been stayed further. Moreover, the Board considers that the appellant has a legitimate interest in trying to defend its case as it considers most appropriate, in particular by using the opportunity to have its right to the patent affirmed where the third party failed in its attempt to have ownership recognised. This is also true if this choice leads to a longer stay of the proceedings. This ground, however, cannot justify that the stay be maintained.
- 4.5 The Board is not in a position to assess whether the appellant used every means to block the third party from having access to evidence. This question lies within the exclusive competence of the national courts and is of no relevance in the present proceedings.
- 4.6 The second entitlement action instituted before the BCC does not serve as a basis for the stay in dispute. Even if it might constitute a ground for a second stay in the near future, these national proceedings are not under scrutiny in the present case.
5. Therefore, the decision under appeal must be set aside and a date for resumption of the proceedings for grant must be set.

6. The appellant's main request being granted, the appellant's auxiliary requests need not be considered.
7. The request for reimbursement of the appeal fee was not maintained at the oral proceedings. Affirming its preliminary opinion expressed in the communication annexed to the summons to oral proceedings, the Board does not see any reasons for ordering reimbursement of the appeal fee of its own motion.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to resume the proceedings for grant on 15 October 2015.

The Registrar:

The Chairwoman:



C. Eickhoff

C. Vallet

Decision electronically authenticated