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**Datasheet for the decision
of 29 January 2025**

Case Number: J 0004/24 - 3.1.01

Application Number: 17867378.6

Publication Number: 3535086

IPC: B23K26/00, C22C38/34,
B33Y80/00, C22C38/54

Language of the proceedings: EN

Title of invention:

3D PRINTABLE HARD FERROUS METALLIC ALLOYS FOR POWDER BED
FUSION

Applicant:

MacLean-Fogg Company

Headword:

Relevant legal provisions:

EPC Art. 60(3)
EPC R. 70(2), 70a(2), 115(2), 142(1)(b)
RPBA 2020 Art. 15(1), 15(3)

Keyword:

Interruption of proceedings - (no) - interruption due to
procedure analogous to insolvency

Decisions cited:

J 0009/90, J 0011/95, J 0026/95, J 0011/98, J 0016/05

Catchword:



Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique

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Case Number: J 0004/24 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 29 January 2025

Appellant: MacLean-Fogg Company
(Applicant) 1000 Allanson Road
Mundelein, IL 60060 (US)

Representative: Richly & Ritschel Patentanwälte PartG mbB
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Decision under appeal: **Decision of the Legal Division of the European Patent Office posted on 15 December 2023 to not interrupt the patent grant proceedings with regard to European patent application EP 17 867 378.6 under Rule 142(1)(b) EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: B. Burm-Herregodts
M. Blasi

Summary of Facts and Submissions

- I. The appeal by the applicant (appellant) lies from the decision of the Legal Division of the European Patent Office of 15 December 2023 to not interrupt the patent grant proceedings of European patent application No. 17 867 378.6 under Rule 142(1) (b) EPC.
- II. The Nanosteel Company Inc. (Nanosteel) filed the aforementioned patent application as international patent application PCT/US 2017/059449 on 1 November 2017. The regional phase before the EPO was entered on 15 May 2019. Nanosteel remained the registered applicant until 12 September 2022.
- III. By communication of the Receiving Section of the EPO of 8 June 2020 pursuant to Rules 70(2) and 70a(2) EPC, the applicant was invited to indicate within six months whether it wished to proceed with the European patent application and to comment on the objections raised in the opinion accompanying the European search report and/or to file any amendments to the description, claims and drawings, correcting any deficiencies noted in the opinion.
- IV. The applicant replied to this communication by letter dated 8 December 2020. The representative of Nanosteel wrote that the applicant desired to proceed with the European patent application. No comment on the objections raised in the opinion accompanying the European search report was submitted.
- V. Having received no comments on the objections raised in the opinion accompanying the European search report within the given deadline and no request for an

extension of the time limit, a communication was issued by the Examining Division on 28 January 2021. With this communication, the loss of rights pursuant to Rule 112(1) EPC was notified to the applicant.

- VI. The procedure before the EPO was closed, and the fees were refunded.

- VII. By letter of 4 June 2021, together with attached annexes, Nanosteel requested an interruption of proceedings under Rule 142(1)(b) EPC starting from 5 December 2020 until at least 6 April 2021. The applicant indicated having lost legal capacity in that period due to a defaulted loan agreement. As an auxiliary measure, the applicant requested re-establishment of the rights lost by not observing the time limit set out in the communication of 28 January 2021. Furthermore, the applicant requested further processing in accordance with Rule [sic] 121 EPC, submitted a response to the communication of 8 June 2020 and filed a set of amended claims.

- VIII. The Legal Division issued a communication on 11 June 2021 expressing its view on the request for an interruption of proceedings and setting a time limit to reply.

- IX. The applicant responded with the letter of 16 August 2021 requesting an extension of the time limit which was accorded by the Legal Division. In this letter, the applicant's representative mentioned that both the applicant Nanosteel, and its exclusive licensee, Formetrix, had gone bankrupt and no longer existed.

- X. Further submissions were filed by the applicant Nanosteel on 21 October 2021 and 28 January 2022.
- XI. A general authorisation from the new owner of the patent application, MacLean-Fogg Company, to the professional representative of the original applicant, dated 28 May 2021, was filed on 10 February 2022. A transfer of rights with effect of 12 September 2022 was registered in the European Patent Register on 10 October 2022.
- XII. The appellant filed further submissions on 10 February 2022, 14 July 2022 and 28 September 2022. In its submission of 2 March 2023, an appealable decision was requested.
- XIII. Further communications on an interruption of proceedings under Rule 142(1)(b) EPC were issued by the Legal Division on 2 December 2021, 18 May 2022, 1 August 2022 and 23 December 2022.
- XIV. In the decision under appeal, the Legal Division decided that Nanosteel had maintained its legal capacity to manage and operate its business and that the requirements of Rule 142(1)(b) EPC were not fulfilled. The proceedings were therefore not interrupted.
- XV. A notice of appeal and a statement setting out the grounds of appeal with nine annexes were filed by the applicant MacLean-Fogg Company respectively on 30 January 2024 and 15 April 2024. The appellant requested that:
- the decision of the Legal Division of the European Patent Office dated 15 December 2023 be set aside

- the proceedings of European patent application No. 17 867 378.6 be interrupted in accordance with Rule 142(1) EPC starting from 5 December 2020 until at least 6 April 2021, in particular, in accordance with Rule 142(1)(b) EPC

The appellant contested the Legal Division's reasoning and argued as follows.

Nanosteel's request to interrupt the proceedings of European patent application No. 17 867 378.6 had been motivated on the grounds that Nanosteel, although still the legal owner of the application, had lost the legal capacity to act on or before 5 December 2020 due to a defaulted loan agreement with Horizon Technology Finance Corporation (Horizon), which as a consequence controlled Nanosteel's assets. At the beginning of December 2020, Horizon started to liquidate Nanosteel's assets under Article 9 of the US Uniform Commercial Code (US UCC). The procedure under Article 9 US UCC is similar to and an alternative to bankruptcy and thus constituted a legal reason preventing Nanosteel from continuing the proceedings before the EPO.

Nanosteel had an exclusive licensee, Formetrix Inc (Formetrix), which could have continued the prosecution under the exclusive licence agreement. Formetrix, however, filed for bankruptcy on 12 January 2021, thus being unable to pursue the prosecution. Formetrix, while in bankruptcy, was nevertheless able to purchase the European patent application on 31 March 2021, only for it to be sold, together with Formetrix, to MacLean-Fogg Company, the current applicant and appellant, on 6 April 2021.

- XVI. The Legal Board of Appeal (the Board) issued a communication pursuant to Article 15(1) RPBA in which it preliminarily concurred with the decision under appeal, meaning that the appeal would likely be dismissed.
- XVII. By letter of 28 January 2025, the appellant's representative announced that it would not attend oral proceedings on 29 January 2025. No arguments on the substance of the case were filed by the appellant in response to the Board's communication.
- XVIII. The order of this decision was announced at the end of the oral proceedings, which had been conducted without the duly summoned appellant in accordance with Rule 115(2) EPC.

Reasons for the Decision

1. The case is ready for decision on the basis of the appellant's written submissions and the decision under appeal. The appellant neither attended the oral proceedings nor filed any observation in response to the Board's communication pursuant to Article 15(1) RPBA. In accordance with Article 15(3) RPBA, the appellant's written submissions have been taken into account by the Board and are discussed in the following. After having assessed the case once again, the Board confirms its preliminary opinion as final.
2. The appeal is admissible but not allowable.
3. In its communication pursuant to Article 15(1) RPBA, the Board concurred with the decision under appeal in

which it was decided that the applicant Nanosteel had maintained its legal capacity to manage and operate its business and that the requirements of Rule 142(1)(b) EPC were not fulfilled. The proceedings were therefore not interrupted.

4. In accordance with Rule 142(1)(b) EPC, proceedings before the European Patent Office must be interrupted if the applicant for or proprietor of a patent, as a result of some action taken against its property, is prevented by legal reasons from continuing the proceedings before the EPO (see Case Law of the Boards of Appeal of the EPO, 10th edn. 2022, III.D.4)
5. The interruption of proceedings thus requires (i) an applicant/proprietor (ii) which is, as a result of some action taken against its property, prevented by legal reasons (iii) from continuing proceedings before the EPO.

(i) The applicant

6. The registered applicant was Nanosteel until the transfer of rights to MacLean-Fogg Company as of 12 September 2022. Nanosteel therefore has to be considered the only relevant applicant during the period between 5 December 2020 and 6 April 2021 - the period for which the interruption of proceedings is requested - entitled to exercise the right to a European patent in proceedings before the European Patent Office under Article 60(3) EPC.
7. The arguments of the appellant that either Formetrix, as an exclusive licensee, or even MacLean-Fogg Company, the registered applicant as of 12 September 2022, had the capacity of applicant or the capacity to act before

the European Patent Office during that period are therefore not convincing.

(iii) From continuing proceedings before the EPO

8. Contrary to the appellant's arguments, the facts of this case show that the applicant Nanosteel did continue proceedings before the EPO.
9. Nanosteel answered the communication of the Examining Division pursuant to Rules 70(2) and 70a(2) EPC of 8 June 2020 in letters sent on its behalf during and after the period of its alleged legal incapacity. In its letter filed on 9 December 2020, Nanosteel partially reacted to the communication when informing the EPO that the applicant wished to proceed with the European patent application.

On 4 June 2021, Nanosteel requested further processing and submitted a response to the communication of 8 June 2020 together with a set of amended claims (letter of 4 June 2021, page 2, 1.3).

In a separate letter of 4 June 2021, Nanosteel requested the interruption of proceedings and the re-establishment of rights.

10. The Board therefore holds from these facts, and since no evidence to the contrary was filed, that the applicant Nanosteel was not prevented by legal reasons from continuing the proceedings before the European Patent Office (see J 11/95, Reasons 5.3).

(ii) Which is, as a result of some action taken against its property, prevented by legal reasons

11. The appellant brought forward that Nanosteel, as the registered applicant, was, as a result of some action taken against its property, prevented by legal reasons from continuing the pending proceedings before the EPO.
12. Nanosteel, as was set out under points 8 and 9, continued proceedings before the European Patent Office during and after the period of its alleged legal incapacity.
13. The appellant has brought forward that the proceedings should be interrupted in line with Rule 142(1)(b) EPC and that this rule does not require formal bankruptcy proceedings. It argued that Nanosteel was subject to proceedings under Article 9 US UCC, which it alleges is an alternative to bankruptcy. Reference to the text of Article 9 US UCC was made.
14. The appellant's argument that Article 9 US UCC is analogous to Chapter 7 of the US Bankruptcy Code was not accepted by the Legal Division. In the decision under appeal, it was held that in an Article 9 US UCC procedure, *"the debtor's powers are not affected, as their legal entity continues to operate under its proper structure and administration"* and that *"the creditor does not take control of the administration of the applicant's company"*.

This was not convincingly refuted by the appellant.

15. Even if the Board agreed with the appellant that the Article 9 US UCC procedure constituted a procedure equivalent to bankruptcy proceedings, this would still

not lead as such to the interruption of proceedings under Rule 142(1)(b) EPC. In accordance with the case law of the Boards, bankruptcy proceedings can only lead to an interruption of proceedings when, if no specific circumstances are present, the action taken against the property of the applicant indeed makes it impossible for the applicant to continue the proceedings (see J 11/95, J 26/95 and J 11/98).

16. The appellant did not put forward any other special circumstances that could be regarded as analogous to the requirement that actions taken against its property made it legally impossible for it to continue proceedings.
17. The appellant further argued that Nanosteel was unable to continue the proceedings before the European Patent Office since Formetrix, the creditor responsible for the foreclosure, lacked the legal capacity to continue the proceedings before the EPO as a consequence of its bankruptcy. This argument is not convincing. As Nanosteel was the only applicant during the period between 5 December 2020 and 6 April 2021, it is irrelevant whether Formetrix, which was never the registered applicant, saw action taken against its property (see J 9/90, J 16/05).
18. None of the appellant's arguments is convincing. Therefore, the appeal against the decision of the Legal Division issued on 15 December 2023 must be dismissed, meaning that the proceedings are not interrupted under Rule 142(1)(b) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

I. Beckedorf

Decision electronically authenticated