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Division juridique

EPA/EPO/OEB - 80298 München - Deutschland

**Einschreiben / Registered letter / Lettre recommandée**

Iviewit Holdings Inc.  
Mr Bernstein  
10158 Stonehenge Circle Suite 801  
US - Boynton Beach, FL 33437-3546

✉ EPA/EPO/OEB  
80298 München  
☎ +49-89/2399-0  
☎ +49-89/2399-5148

Durchwahl/Direct dial/  
Ligne directe:

5110

Zeichen/Reference/Référence

hb/LD

Datum/Date/Date

25. 11. 04

**Our Ref:** Legal R 13-268/2004  
**Application No:** 00 944 619.6      00 938 126.0      00 955 352.0  
**Applicant:** Iviewit Holdings, Inc.  
**Your Ref.::** Your email 28 October 2004

**COMMUNICATION CONCERNING SUSPENSION OF PROCEEDINGS UNDER RULE 13 EPC AND INTERRUPTION OF THE PROCEEDINGS UNDER RULE 90 EPC.**

Your email of **28 October 2004** was forwarded to the Legal Division for the purpose of examining whether a suspension of proceedings pursuant to Rule 13 EPC or an interruption of proceedings in accordance with Rule 90 EPC may apply.

**1. Responsibility**

The Legal Division has sole responsibility for the interruption and resumption of proceedings (OJ EPO 1989, 177 point 1. 2.b). **Please therefore address all relevant correspondence solely to the Legal Division in Munich, quoting the reference Legal R 13-268/2004.** The Legal Division automatically adds information about the suspension, interruption and resumption of proceedings to the file(s) in question.

**2. Suspension of proceedings under Rule 13 EPC**

The suspension of proceedings, pursuant to Rule 13 EPC, secures the rights of a third party and allows him time to prove his entitlement to the patent before a national court. According to Rule 13 EPC, if a **third party** provides proof to the EPO that he has opened proceedings against the applicant for the purpose of seeking judgment that the third party is entitled to the grant of a European patent, the EPO shall stay the proceedings for grant.

## 2.1 Jurisdiction

Rule 13 EPC applies only if the proceedings are opened before a Court which has jurisdiction to decide claims, against the applicant, to the right to the grant of a European patent. The determination of such question prior to grant is governed by the Protocol on Recognition which is an integral part of the European Patent Convention (see decision of the Enlarged Board of Appeal G 3/92, OJ EPO 1994, 607).

When both parties have neither a domicile nor a place of business in a Contracting State, Article 6 of the Protocol on Recognition provides exclusive jurisdiction of the German courts to the extent that no other rules on jurisdiction apply. Although it would be possible for a court of a non-contracting state to hear the matter, the decision hold by this court would not automatically be recognised by all contracting states which are designated in the application.

## 2.2 Action initiated

Furthermore, entitlement proceedings have to be initiated under Rule 13 EPC. Proof must be provided that the necessary steps in commencing legal proceedings before a national court of a contracting state were taken in order to establish that the third party is entitled to the grant of the European patent and not the registered applicant.

## 2.3 Present case

In the present case, there is a dispute between the applicant and his former American patent attorneys. Claims of fraud, malpractice, conspiracy, breach of contract were filed before the USPTO and disciplinary actions against alleged offending attorneys seem to be pending. It seems that the litigation does not concern the property of the patent applications **Nos. 00 944 619.6, 00 938 126.0 and 00 955 352.0** moreover no third party has requested the suspension of proceedings.

Therefore proceedings before the EPO cannot be stayed on the basis of the initiated actions for the applications concerned as Rule 13 EPC foresees only entitlement actions initiated by a third party against the applicant.

## **3. Interruption of proceedings under Rule 90(1) EPC**

In order to save applications from suffering loss of rights the European Patent Convention allows interruption of proceedings under certain specific conditions due to medical and / or financial hardship of the applicant or proprietor (Rule 90(1)(a) and (b)) and / or the professional representative (Rule 90(1)(c)).

### 3.1 Legal Incapacity (Rule 90(1)(a) EPC)

Proceedings before the EPO shall be interrupted in the event of the death or legal incapacity of the applicant for a European Patent or the person authorised by national law to act on his behalf (Rule 90(1)(a) EPC).

Legal incapacity means, that the applicant for a European patent or his representative, is not in the position to take action before the EPO for health reasons, such as for instance mental illness, mental deficiency, heavy physical illness or disability. This incapacity has to be established by means of production of an extensive and reliable medical opinion. Copies of national regulations concerning the interpretation of "incapacity" in the individual state concerned have to be filed too.

In the present case no request for interruption of the proceedings under Rule 90(1)(a) was filed, nor any evidence provided. It seems that the initiated actions taken before the USPTO and the circuit court of Florida do not concern incapacity of the applicant as defined in Rule 90(1)(a) EPC.

### 3.2 Action taken against the property (Rule 90(1)(b)(c) EPC).

Furthermore, proceedings before the EPO shall be interrupted in the event of the applicant for or proprietor of a European patent or his representative, as a result of some action taken against his property, being prevented from continuing the proceedings before the EPO (Rule 90(1)(b)(c) EPC). However it has to be established that the applicant for or proprietor of a European patent or his representative was prevented by **legal reasons** from continuing the proceedings before the EPO. The legal proceedings initiated against the applicant for or proprietor of a European patent or his representative must be in relation to bankruptcy proceedings or similar, the decisive criterion for interruption is whether the action against the property is such as to make it legally impossible to continue the proceedings (J 26/95, OJ 1999, 668). Financial difficulties are not a ground for interruption of proceedings under Rule 90(1)(b) or (c) EPC.

In the present case, it seems that no action has been taken against the applicant's property in the sense of Rule 90(1)(b) or (c) EPC.

## **4. Status of the applications**

As a service from the EPO, please be informed that for each application concerned the registered address is to be checked. Should the address be amended a request should be filed accordingly by a duly appointed professional representative.

### 3.1 Patent application 00 944 619.6

Registered address: One Boca Place, 2255 Glades Road, Suite 337, US - West, Boca Raton, FL 33431.

A professional representative has to be appointed pursuant to Article 133(2) EPC.

Payment of the 4<sup>th</sup> year renewal fee was due on 30 June 2004. This payment can still validly be made within six months from the said date provided an additional fee is paid at the same time (Article 86(2) EPC). The six-month period ends on 31 December 2004 and will be extended until **3 January 2005** according to Rule 85(1) EPC.

3.2 Patent application 00 955 352.0

Registered address: 10158 Stonehenge Circle Suite 801, US - Boynton Beach, FL 33437-3546

A professional representative has to be appointed pursuant to Article 133(2) EPC.

Payment of the 5<sup>th</sup> year renewal fee was due on 31 August 2004. This payment can still validly be made within six months from the said date provided an additional fee is paid at the same time (Article 86(2) EPC). The six-month period ends on **28 February 2005**.

3.3 Patent application 00 938 126.0

Registered address: 505 North Brand Boulevard, Suite 1420, US - Glendale, CA 91203

A professional representative has to be appointed pursuant to Article 133(2) EPC.

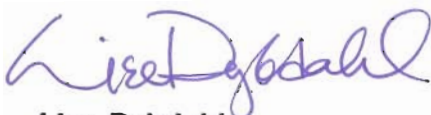
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**4. Representation**

Article 133(2) EPC stipulates that natural or legal persons not having either a contracting state residence or their principal place of business within the territory of one of the contracting states must be represented by a professional representative and act through him in all proceedings established by the European Patent Convention (EPC), other than in filling the European patent application. Any submissions by a non-European applicant, apart from when filling the European application, directly to the EPO cannot be taken into account.

The authorisation of the previous representative has been terminated as a result of relinquishment of representation by the professional representative.

**You are hereby invited to appoint a professional representative within three months of notification of this communication. If this invitation is not replied to in due time, the European patent applications may be deemed to be withdrawn.**



Lise Dybdahl  
Director  
Legal Division



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