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Official Ref: G 1/22 and G 2/22

**Third party observations (amicus curiae brief) in accordance with
Article 10 of the Rules of Procedure of the Enlarged Board of Appeal**

We filed oppositions against EP 1 899 364 and against EP 3 263 581 on behalf of Cytune Pharma. Prof. Dr. Ansgar Ohly, LL.M. (Cambridge) prepared a legal declaration for these cases concerned with the question referred to the Enlarged Board of Appeal in G 1/22 and G 2/22.

In his declaration, Prof. Ohly concludes:

- *“The EPO has jurisdiction to determine who is entitled to claim priority. The Office has the right, and indeed the duty, to determine whether the EPA applicant is “any person” or a “successor in title” within the meaning of Article 87(1) EPC.*
- *A PCT application is a bundle of national or regional applications which are combined for administrative purposes, but which are separate in terms of substantive law. They are parallel applications, not joint applications.*

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HRB Nr. 111307
Amtsgericht München

DJB:JUM

- *Both Article 153(2) EPC and Article 118 EPC do not apply to the “bundle” of the entire PCT application, but only to the application to the extent that the EPO is named as the designated Office.*
- *Applicants who make one single PCT application for several designated states are not “joint applicants” in the sense that they would form a legal unity. Applications made by A and B for country X and by C for country Y are legally independent, even if they are combined for the sake of administrative convenience.*
- *A joint applicants approach for Euro-PCT applications would by-pass the established conflict of law rules according to which the validity of a transfer of the priority right must be determined by the national law which is applicable to the relations between the first and the second applicant. The initial applicant should be given the protection afforded to him by the applicable national law.*
- *There is no sufficient factual basis for a presumption of transfer based on the fact that the first and second applicants filed one single PCT application. Such a presumption would equally by-pass the determination of the applicable law and the determination of validity by the applicable national law.*
- *The “PCT joint applicants approach” may be convenient for the second applicant, as it saves him the trouble of proving transfer. But at the same time it affects the rights of the first applicant. Convenience is not a legal principle, and there is no convincing legal reason for departing from the basic principle that a successor in title who claims priority must give evidence of the transfer in the case of both applicants filing one single PCT application.”*

We herewith submit Prof. Ohly's declaration as amicus curiae brief in G 1/22 and G 2/22.

Maiwald Patentanwalts- und Rechtsanwaltsgesellschaft mbH
- Association No. 174 -



Dr. Julia Mössinger
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Enclosures:

Declaration by Prof. Dr. Ansgar Ohly (including CV and list of publications)

Opinion
on the entitlement to the right of priority among several applicants
in the case of Euro-PCT applications

submitted by

Prof. Dr. Ansgar Ohly, LL.M. (Cambridge)

Chair of Private Law, Intellectual Property and Competition Law

Ludwig-Maximilians-Universität München

29 March 2022

I. Terms of reference

- 1 I am a university professor at the Law Faculty of Ludwig-Maximilians-Universität München, where I hold the Chair of Private Law, Intellectual Property and Competition Law. I teach German, European and international patent law at my university. I have also done so at the University of Oxford, where I am a permanent Visiting Professor. My cv and a list of selected publications are attached.
- 2 I have been asked by Maiwald Patentanwalts- und Rechtsanwalts-GmbH to provide a legal opinion in the context of opposition proceedings against EP 1 899 364 at the European Patent Office regarding the following situation and questions:
 - (i) *The PCT application PCT/US2006/019403 claims priority from US 60/681,633. US 60/681,633 was filed by the applicants Leo Lefrancois and Thomas Stoklasek. PCT/US2006/019403 was filed by the University of Connecticut as applicant for all designated states except US and Leo Lefrancois and Thomas Stoklasek as applicants for US.*
 - (ii) *EP 1 899 364, a granted national phase patent of PCT/US2006/019403, accordingly only lists the University of Connecticut as applicant. At present, there is no evidence of a transfer of the right to claim priority from the applicants of the priority application US 60/681,633, i.e. Leo Lefrancois and Thomas Stoklasek, to the applicant of EP 1 899 364, i.e. the University of Connecticut.*
 - (iii) *Is the University of Connecticut entitled to validly claim priority from US 60/681,633 for EP 1 899 364? In particular, does the EPO have jurisdiction to analyze whether the University of Connecticut is the successor in title and does naming Leo Lefrancois and Thomas Stoklasek as applicants of PCT/US2006/019403 for US render a transfer of the right to claim priority from Leo Lefrancois and Thomas Stoklasek to the University of Connecticut redundant (“PCT joint applicants approach”)?*
- 3 After a first draft of this opinion had been completed, the present issue was referred to the Enlarged Board of Appeal.¹ The following opinion will be given in view of the pending referrals G 1/22 and G2/22.
- 4 The referral firstly asks the Enlarged Board of Appeal to clarify whether the EPC confers jurisdiction to the EPO to determine whether an applicant of an EP application has the right to claim priority. Only if this question is answered to the affirmative, the Enlarged Board of Appeal is asked to clarify the applicability of a so-called PCT joint applicants approach. In the following opinion, both issues will be discussed in turn.

II. The jurisdiction of the EPO

1. The case-law of the Boards of Appeal

- 5 Before the merits of and objections to the “PCT joint applicants approach” can be discussed, the preliminary issue of jurisdiction arises: Does the EPO have jurisdiction to decide on the entitlement to the priority right? Only if this is the case, the EPO is in a position to decide under which conditions joint applicants of an international application enjoy a right of priority.

¹ T 1513/17 and T 2719/19.

- 6 So far, the Boards of Appeal have answered this question in the affirmative.² The most extensive discussion of this issue can be found in decision T 844/18, the “CRISPR-Cas case”. The Board argued that Article 87(1) EPC set out four requirements which could usefully be referred to as questions: (1) who?, (2) where?, (3) what?, (4) when?.³ It was undisputed that the EPO, when deciding on issues of priority, could determine *where* the earlier application was made, *what* it concerned (i.e. whether it related to the same invention) and *when* it was made.⁴ There was nothing in Article 87(1) EPC which suggested that the EPO did not have the power and, indeed, the duty to concern itself with the “who”. In particular, Article 88 EPC and Rules 52, 53 did not dispense the EPO from examining the “any person” requirement in Article 87(1) EPC.⁵ The determination of the first applicant was a merely formal act. While the Board admitted that deciding whether the second applicant was a “successor in title” did involve a legal assessment, it did not discuss this issue in greater detail because it was not relevant for the case at hand.⁶ But the Board did not seem willing to distinguish between the determination of the first applicant (for which the EPO clearly had jurisdiction) and of a successor in title.
- 7 In a non-binding preliminary communication to the parties in case T 239/16, the Technical Board of Appeal addressed the issue and raised some points which might militate against the jurisdiction of the EPO. These arguments will be discussed below.⁷ In the eventual decision, however, issues of priority were not relevant; hence the point of jurisdiction was not discussed.
- 8 In case J 11/95, the appellants had unsuccessfully tried to invoke a priority right. This attempt failed for several reasons. Inter alia, the Legal Board of Appeal noted that the appellants’ right to claim priority had always been contested by the applicants of the previous Swiss application. The Board added: “However, such a dispute cannot be solved within the framework of the EPC since the European Patent Office has no jurisdiction to decide claims to the right to national patent applications or priority rights derived therefrom.”⁸ While, at first sight, this sentence seems to suggest that the Board doubted the EPO’s jurisdiction to decide on the entitlement of the right to priority, the context shows that the dispute concerned the question of who was the “true owner” of the first Swiss application, i.e. an issue which fell under Article 60(3) EPC.
- 9 Thus, the Boards of Appeal have so far consistently held that Article 87(1) EPC confers the jurisdiction on the EPO to decide about who is entitled to claim priority. Following the case law of the Boards of Appeal, the Examination Guidelines also state that a successor in title under Article 87(1) EPC is only entitled to a priority right if there has been a valid transfer under the relevant national provisions.⁹
- 10 In its referral, the Board of Appeal expresses agreement with this view.¹⁰ While the Board acknowledges that the EPO’s jurisdiction has been questioned in several decisions and in commentaries, it stresses that the EPO has routinely carried out such determinations until now, and the Board of Appeal expresses agreement with T 844/18 in that the bar for overturning long established case law should be very high.

² See, for example, T 493/06 para. 8, T 577/11 paras. 2 et seq., T 517/14 para. 2.6; this approach is also supported by *Haedicke* in Haedicke/Timmann, *Handbuch des Patentrechts*, 2th ed. 2020, § 11 para. 298; *Grabinski* in Benkard, *Europäisches Patentübereinkommen*, 3rd ed. 2019, Art. 87 para. 25.

³ T 0844/18 para. 12.

⁴ T 0844/18 para. 15.

⁵ T 0844/18 para. 18.

⁶ T 0844/18 para. 21.

⁷ *Infra* paras. 11-15.

⁸ J 0011/95 No. 4.

⁹ Guidelines for Examination (2022), A-III, para. 6.1.

¹⁰ T 1513/17 and T 2719/19 paras 24-27.

2. The challenge: inconsistency with Article 60(3) EPC

- 11 This view, however, has not remained uncontroversial. The most detailed challenge was made by *Bremi*;¹¹ his arguments are also mirrored in the non-binding communication of the Technical Board of Appeal in case T 239/16,¹² mentioned above. *Bremi* argued that disputes about the entitlement to the priority right should be treated like disputes about the entitlement to the patent, which are determined in proceedings before national courts or offices in accordance with national law (Article 60(1) EPO), whereas in proceedings before the EPO the applicant is deemed to be entitled to exercise the right to the patent (Article 60(3) EPO). *Bremi* supported his view with four arguments.¹³
- 12 First, Article 60(3) EPC was the expression of the more general consideration that the EPO should be kept out of property and entitlement disputes.¹⁴ Under this “separation of powers”, which had been discussed at length in the course of the preparatory works, the EPO should not be burdened with the application of the domestic law of the contracting states. Suitable conflict of law rules were also missing. If the EPO had to determine who the initial applicant’s successor in title was, it would not only potentially have to apply the law of the 38 EPO Contracting States, but also “basically any possible law on earth”.¹⁵
- 13 Second, Article 60(3) EPC was an application of a principle accepted in the property laws of many jurisdictions according to which the possessor was presumed to be the proprietor.¹⁶ Since the right to priority was also a property right, the same presumption should apply.
- 14 Third, Article 88 EPC did not require the applicant claiming priority to submit proof of his entitlement, and, hence, the EPO did not have the power to require such proof.¹⁷ This was borne out by the travaux préparatoires. The requirements for validly claiming priority had been discussed in the Patents Working Group. An initial proposal under which the applicant would have had to submit proof of his entitlement to priority was rejected:

“It was not, in its view, desirable to allow the EPO to require of an applicant proof of his entitlement to avail himself of priority in cases in which the applicant and the proprietor of the first application were two separate persons. A provision on these lines would be contrary to Art. 27 (1) PCT. It was, however, pointed out by the BIRPI representative that Art. 27 (2) PCT did at least make it possible to require the applicant to make a statement. Although certain delegations had wished to include the requirements of a statement, this did not receive the support of the majority of the sub-Committee.”¹⁸
- 15 Fourth, like disputes about the entitlement to the patent, disputes about the right of priority should be fought out between the parties. If, however, it was the EPO’s task to hear such disputes, anyone could invoke a lack of entitlement to priority in opposition proceedings, in a “purely destructive” way, even if both parties were in perfect agreement.¹⁹

¹¹ *Bremi*, ‘A New Approach to Priority Entitlement: Time for Another Resolving EPO Decision?’, GRUR Int. 2018, 128, 129-132; see also *Bremi* in Singer/Stauder/Luginbühl, Europäisches Patentübereinkommen, 8th ed. 2019, Art. 87 para. 62, and *Bremi* GRUR 2021, 150, 153.

¹² T 29/16 paras. 3.4 et seq.

¹³ See also the overview of *Bremi*’s arguments given by Haedicke in Haedicke/Timmann (*supra* note 2), § 11 para. 299.

¹⁴ *Bremi* GRUR Int. 2018, 128, 130; T 29/16, paras. 3.4.5-3.4.7

¹⁵ *Bremi* GRUR Int. 2018, 128, 131.

¹⁶ *Bremi* GRUR Int. 2018, 128, 129.

¹⁷ *Bremi* GRUR Int. 2018, 128, 130; T 29/16, para. 3.4.1.

¹⁸ BR/51/70, Chapter 36, p. 16.

¹⁹ *Bremi* GRUR Int. 2018, 128, 131; *Bremi* in Singer/Stauder/Luginbühl, Europäisches Patentübereinkommen (*supra* note 11), Art. 87 para. 62.

3. Discussion

- 16 The EPO has jurisdiction to decide about the entitlement to the priority right if such jurisdiction is conferred on the Office by the EPC. Whether this is the case must be determined in accordance with the established international law principles of interpretation. The starting points are Articles 31 and 32 of the Vienna Convention on the Law of Treaties (VCLT). Although the VCLT is not formally applicable because not all EPO Contracting Parties are parties to the VCLT,²⁰ it is generally accepted that Articles 31 and 32 VCLT reflect international customary law.²¹ According to Article 31(1) VCLT, “a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.” The preparatory work is only a supplementary means of interpretation, to which recourse may be had if an interpretation according to Article 31 VCLT leaves the meaning ambiguous or obscure or leads to a result which is manifestly absurd or unreasonable (Article 32 VCLT).
- 17 The EPO or, more precisely, the Examining Division is responsible for the examination of European patent applications (Article 18 EPC). It is its duty to establish the state of the art for the purpose of assessing novelty (Article 54(2), (3) EPC) and inventive step (Article 56 EPC). In this context, it must determine the relevant date, which can either be the filing date (Article 54(2), (3) EPC) or the priority date (Article 89 EPC).²² Priority can be claimed under the conditions set out in Article 87(1) EPC. Thus, in principle, Article 87(1) EPC gives the EPO the right and makes it its duty to decide on whether a right of priority exists. Nothing in the wording of Articles 87, 88 EPC suggests that the EPO has the power to examine only some conditions of priority, but not others. In the words of the Technical Board of Appeal in the “CRISPR-Cas” case,²³ Article 87 EPC does not distinguish between the “where”, “when”, “what” and “who”.
- 18 There is no need for the EPC to explicitly provide that the EPO can require proof of entitlement to priority and that the EPO can reject the application if no such proof is furnished. It is an internationally accepted principle of procedural law that a person relying on a right must show that the requirements for acquisition of this right have been satisfied. Article 88(1) EPC does not provide otherwise. While this provision, in connection with the corresponding Rules, sets out some requirements for claiming priority, it does not address the burden of proof for the conditions set out in Article 87(1) EPC.
- 19 The context of Article 87 EPC, which, according to Article 31 VCLT, must be taken into account, extends to Articles 60 and 61 EPC.²⁴ While Article 60 EPC explicitly deals with disputes about the entitlement to the patent, there is no similar provision for disputes about the priority right. Under the maxim “expressio unius est exclusio alterius”, also known as an “argumentum e contrario”,²⁵ this is a strong argument for treating the priority right differently from the right to the patent. Under *Bremi*’s view, however, Article 60(3) EPC would have to be applied by

²⁰ France, Iceland, Norway, Romania and San Marino are not parties to the VCLT.

²¹ CJEU, case C-162/96, *Racke/Hauptzollamt Mainz*, ECLI:EU:C:1998:293, para. 24; *Giegerich* in Dörr/Schmalenbach, Vienna Convention on the Law of Treaties. A Commentary, 2th ed. 2018, Art. 62 paras. 103 et seq.

²² While the Examining Division, as a general rule, does not make any investigation as to the validity of a right to priority, it has to do so when priority assumes importance under Articles 54(3) and (3), see See Guidelines for Examination (2022), F-VI, para. 2.1.

²³ See *supra* para. 6.

²⁴ T 29/16, para. 3.4.5

²⁵ On the acceptance of this principle in international law see *Senegacnik*, ‘Expressio Unius (Est) Exclusio Alterius’ in Max Planck Institute for Comparative Public Law and International Law (ed.), Max Planck Encyclopedia of International Law, available online at opil.ouplaw.com (last visited on 29 March 2022).

analogy. Reasoning by analogy is possible in international law,²⁶ and there is no strictly logical reason to prefer an *argumentum e contrario* over an *argumentum per analogiam*. The conditions for reasoning by analogy are that there exists a lacuna in the Treaty which the drafters would have remedied, had they noticed it, and that both cases should be treated similarly.²⁷ Ironically, the argument from the travaux préparatoires relied on by *Bremi* is a powerful argument against the existence of a lacuna. The passage cited above²⁸ shows that the drafters of the EPC were well aware of the possibility of disputes about the entitlement to the priority right. Nevertheless, they did not refer to Article 60(3) EPC in Articles 87, 88 EPC or create a similar presumption, although it would have been easy to do so. What is more, there is an important difference between disputes about the entitlement to the patent on the one hand and priority on the other. The examination process and the determination of ownership can be separated without major problems. The question of whether A or B is entitled to grant does not affect the concept of invention, or novelty or inventive step. Priority disputes, on the other hand, are inextricably intertwined with the determination of novelty and inventive step. Both considerations militate against an application of Article 60 EPC per analogiam to disputes about the entitlement to priority rights.

- 20 In practice, denying the EPO jurisdiction to rule on the entitlement to priority would result in a dilemma. Either the EPO would have to stay examination and wait for the decision of the competent national courts or institutions. This would prolong the granting procedure and open up many routes for opportunistic strategical behaviour – such as a “priority torpedo action”²⁹ – by opponents. Or the EPO could apply Article 60(3) EPC per analogiam, as mentioned above, and presume the entitlement of the applicant. This approach, which is indeed suggested by *Bremi*,³⁰ is overly applicant-friendly³¹ as it strips the first applicant of his rights if there has not been a valid transfer of the priority right. The first applicant would unilaterally have to bear the burden of commencing potentially lengthy and difficult proceedings before national courts. This would potentially be a significant interference with the first applicant’s rights. The Contracting States would of course be free to provide for such a mechanism in a future revision of Articles 87, 88 EPC, but it would not be appropriate for the judiciary to solve the potential entitlement conflict one-sidedly in favour of the applicant.
- 21 Even apart from such conflicts, the determination of entitlement issues by the EPO is often in the best interest of both parties, as it is the fastest and most efficient way of resolving the dispute. It comes as no surprise that none of the parties to case T 1513/17, in which the reference to the Enlarged Board of Appeal was made, challenged the jurisdiction of the EPO. Unlike ownership disputes, many disputes about priority are probably rather straightforward, although this argument can only be made with some caution from an academic perspective. Determination of the first applicant is a purely formal exercise. While the transfer of the priority right requires a contract, the clause transferring the right is usually not a complex one. The applicant can be expected to obtain a valid transfer, and it seems fair for him to lose the priority right if he has not done so.
- 22 In addition, application of Article 60 EPC per analogiam might bar third parties from challenging the validity of a priority claim based on a lack of priority entitlement. In particular, this may result in a situation where a third party attacking the validity of a patent in opposition

²⁶ See Vöneky, ‘Analogy in International Law’, in Max Planck Encyclopedia of International Law (*supra* note 25).

²⁷ Vöneky, *ibid.*

²⁸ *Supra* para. 14.

²⁹ Haedicke in Haedicke/Timmann (*supra* note 2), § 11 para. 299.

³⁰ *Bremi* GRUR Int. 2018, 128, 130.

³¹ *Bremi, ibid.*, himself supports his argument with the public interest in the protection of innovation.

proceedings before the EPO would have to rely on the applicant of the first application to start proceedings against the patentee before national courts. If such proceedings were not initiated, the priority claim could not be challenged based on a lack of entitlement. This would result in the unfortunate situation that the patent could be invoked against any party, but only be invalidated by one party, i.e., the applicant of the first application, and only in proceedings before national courts or offices.

- 23 In sum, the Enlarged Board of Appeal should confirm the position well-established in the case-law of the Boards of Appeal and hold that the EPO has jurisdiction to determine who is entitled to claim priority.

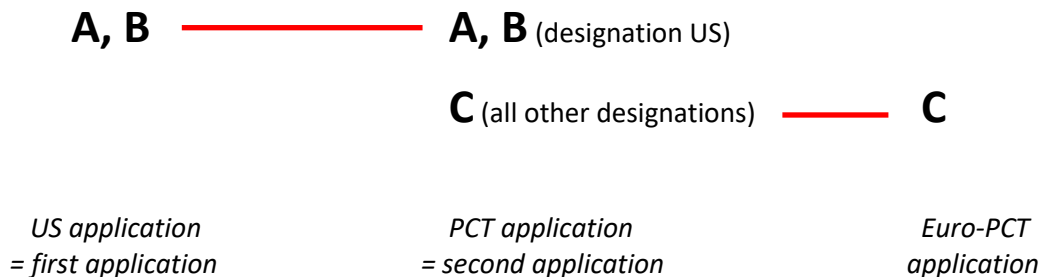
III. The “PCT joint applicants approach”

1. Background

- 24 According to Article 87(1) EPC, any person who has filed a patent application in a state party to the Paris Convention (PC) or his successor in title enjoy a right of priority during a period of twelve months from the date of filing of the first application. While the EPO is not a contracting state of the PC, Article 87(1) EPC mirrors Article 4A and C PC. Given that the EPC is a special agreement in the sense of Article 19 PC, the interpretation of Article 87(1) EPC must not contradict Article 4 PC.
- 25 The right of priority is of specific significance for international applications made under the Patent Cooperation Treaty (PCT). When a PCT application is made in accordance with the formal requirements set out in Article 11 PCT, the receiving Office accords as the international filing date the date of receipt of the international application. Usually, the international application is made subsequent to a national application concerning the same invention. It is thus commonplace that PCT applicants claim the priority of an earlier national application, as provided by Article 8 PCT.
- 26 The EPO can be a designated Office for PCT purposes. An international application for which the EPC is the designated Office is referred to as a “Euro-PCT” application. It is equivalent to an application initially made under the EPC (Article 153(2) EPC). In this case, the relevant date for determining the state of the art (Article 54 (2), (3) EPC) is the international filing date or, if priority has been claimed, the priority date.
- 27 A priority claim requires “double identity”: the first application and the subsequent application must be filed by the same applicant, and they must concern the same invention. The subsequent application can also be filed by the first applicant’s successor in title. In this case, succession in title must, in principle, be proved by the subsequent applicant.³²
- 28 Before US patent law was reformed by virtue of the “America Invents Act” (AIA), US patent applications could only be filed by the inventor. This requirement resulted in a split between US and international practice, as before the EPO and most national offices applications are usually filed by the company which is the inventor’s employer or his assignee. It was thus usual practice to file US patent applications in the name of the inventor and subsequent PCT applications with designated Offices other than the USPTO in the name of a company, namely the employer or assignee. A request for protection of inventions in the PCT contracting states may indicate different applicants for different designated states (PCT Rule 4.5(d)). Thus, it was possible to indicate the inventor as applicant for the US as designated state and a company as applicant for other designated Offices such as the EPO.
- 29 It is against this background that the present question arises. The first application was a US application made by the inventors A and B. The PCT application was made in the name of C for all

³² See, T 1008/96, para. 3.3; T 493/06, para. 8; T 0205/14, para. 3.5.

designated countries except the US, for which A and B were indicated as applicants. C would certainly enjoy a priority right for EPC purposes if it could show that the priority right had been assigned to it by A and B (and if all other conditions were satisfied). But it is open to doubt whether C can claim priority without such evidence, based on the fact that the PCT application was made by A, B and C, albeit for different designated countries.



2. The “joint applicants approach”: national application – EP application

- 30 The “joint applicants approach” has been recognized by the EPO Boards of Appeal for cases involving EP applications in which the first application was a national or an EP application.
- 31 In T 1933/12 the first application was a German application made by Porsche AG. The subsequent EPC application was made jointly by Porsche and ZF Sachs AG. The question arose whether both applicants enjoyed the priority right stemming from Porsche’s earlier German application. The appellant argued that this was not the case because the applicants were not identical: $A \neq AB$. The Boards of Appeal had already held that a single applicant did not enjoy a priority right if the first application had been made jointly with another person and if the right of priority had not been transferred to the second applicant ($AB \neq A$). The appellant argued that both situations should be treated alike. The Board of Appeal disagreed and allowed the priority claim. Article 87(1) EPC did not prevent an applicant from sharing his priority right with another applicant. The article only required the first applicant to be one of the applicants of the subsequent application. Hence, evidence of the transfer of the priority right was not required.³³
- 32 Meanwhile this approach has been included in the Examination Guidelines, which provide, at A.III.6.1:
- “However, in the case of joint applicants filing the later European patent application, it is sufficient if one of the applicants is the applicant or successor in title to the applicant of the previous application. There is no need for a special transfer of the priority right to the other applicant(s), since the later European application has been filed jointly. The same applies to the case where the previous application itself was filed by joint applicants, provided that all these applicants, or their successor(s) in title, are amongst the joint applicants of the later European patent application.”
- 33 The joint applicants approach has been criticized in the legal literature. Visser considers the reasoning in T 1933/12 to be “poor”. It was inconsistent with the earlier case-law according to which several applicants of the first application constituted an indivisible unity and with the general requirement that a successor in title had to furnish proof of the transfer of the priority right.³⁴

³³ T 1933/12, para. 2.4.

³⁴ Visser’s Annotated European Patent Convention, 2019, Art. 87 EPC, para. 4.1.

3. The “PCT joint applicants approach”: case-law and commentaries

34 Despite important differences, in several Opposition Division decisions³⁵ the same approach has been applied to Euro-PCT applications in situations such as the one under consideration here and outlined at para. 29 above.

35 This approach is summed up in an EPO notice of March 2014 concerning the requirements of Euro-PCT applications:

“In the case of joint applicants filing the international application with the EPO as receiving Office and claiming priority from an earlier application, it is sufficient that one of the applicants is the applicant for that earlier application, or his successor in title. Since the international application has been filed jointly, thereby showing the consent of the applicant for the earlier application, there is no need for a special transfer of priority right to the other (additional) applicant(s). Likewise, no transfer of priority right is needed where the earlier application was filed by joint applicants, provided that all of them, or their successor(s) in title, are amongst the joint applicants for the international application.”³⁶

36 While this notice does not explicitly refer to situations where the applicants of the earlier application are listed on the subsequent Euro-PCT application as applicants for particular states only (here “US only”), this reasoning has nonetheless been adopted by Opposition Divisions as follows:

“The rationale of the right of priority is to safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention, thereby alleviating the negative consequences of the principle of territoriality in patent law (see e.g. T 15/01, at 32). In view of this rationale, the priority owning applicant(s) must be able to claim his priority right in a later joint application independently of assignments of the priority right to his co-applicant(s). Under EPC law, the effect of the priority claim extends to the application as a whole, even if the co-applicants are not the same in respect of different designated Contracting States. Article 118 EPC explicitly stipulates the principle of unity of the European patent application in such a case unless otherwise provided in the EPC. Article 89 EPC does not provide for such an exception.

In the absence of any relevant prevailing PCT provision, the same applies in respect of a Euro-PCT application in the procedure for grant of a European patent before the EPO as designated Office (Article 11(3) PCT, Articles 153 (2), 150(2) EPC). As of the date of filing, the international application has the effect of a regular national application (Article 11(3) PCT) and Article 153(2) EPC explicitly states that such an application shall be equivalent to a European patent application. No prevailing law can be derived from Article 8 PCT in connection with Article 4 of the Paris Convention. Furthermore, PCT practice as evident from the PCT request form appears to take the same approach. This form provides in Box VI for an undistinguished generic priority claim for the whole application.

Therefore, under Articles 87(1), 153(2) EPC the priority right owning applicant(s), even if he is/they are the applicant(s) for certain designations only can introduce the priority right into the PCT application as a whole. This effect cannot be considered lost by the mere fact that the application upon entry in the European phase is processed as European application and the priority owning applicants are not entitled to the grant of a European patent because they had not been designated as applicants for the designation EP.”³⁷

³⁵ Opposition decisions on patents EP B 1 737 491 of 1.2.2019; EP 2 940 004 of 26.04.2019; EP 2 215 124 of 8.03.2019; EP 2 288 717 of 11.11.2020.

³⁶ Notice from the European Patent Office concerning the requirements to be observed when filing an international application with the EPO as a PCT receiving Office, OJ A 33 of 31.3.2014.

³⁷ Opposition decision on patent EP 1 737 491 of 1.2.2019.

- 37 So, in essence, the Opposition Division concludes from Article 153(2) EPC that EPC applications and PCT applications are to be treated alike and extends the principle of unity of application (Article 118 EPC) to PCT applications. According to the Opposition Division, there are no prevailing PCT provisions which would suggest otherwise. On the contrary, the Opposition Division regards the design of the PCT application form as evidence of one “undistinguished generic priority claim for the whole application”.
- 38 So far, this approach has not been confirmed by the Boards of Appeal. On the contrary, there are cases in which the joint applicants approach would have applied, but in which the Board of Appeal nevertheless required proof of the transfer of the right of priority.³⁸
- 39 The German Federal Supreme Court³⁹ and the Court of Appeal of The Hague⁴⁰ have not applied the joint applicants approach in situations similar to the one under consideration in this opinion either. The Düsseldorf Court of Appeal in an application for interim relief⁴¹ and the German Federal Patent Court,⁴² however, have recently showed sympathy for the EPO’s approach. Both courts left the question of whether the joint applicants approach applied open and held that in the case of joint PCT applicants the transfer of the priority right could be presumed anyway.
- 40 In the legal literature, the application of the joint applicants approach to Euro-PCT applications finds supporters,⁴³ but it has also been criticized. *Bremi* argues that the situations “first application, two applicants – second application, one applicant” and “first application, one applicant – second application, two applicants” should be treated alike, and that the joint applicants approach is hence inconsistent with the case-law according to which there is no identity of applicants if earlier applicants do not join the later application.⁴⁴ Also, the PCT joint applicants approach results in the application of the EPC, i.e. the *lex loci protectionis*, to the relationship between the applicants, which, according to generally recognized conflict of law principles, should be governed by the (national) law applicable to the contract between the applicants. The Opposition Divisions simply assume that all applicants claim the right of priority together, whereas the applicable national law might allow them to decide about the priority claim separately. Also, if A and B owned a right and C joined them, national law might impose conditions under which C could also exercise this right.⁴⁵ *Druschel* and *Kommer*⁴⁶ argue that a PCT application is not as such equivalent to an EPC application, but only insofar as the EPC has been listed as the designated Office. For the same reason, Article 118 EPC do not apply to the PCT application as a whole, but only to the Euro-PCT application. The design of the PCT application form cannot affect substantive law: evidently a form filled in by an applicant who does not have any rights to the invention does not acquire title by just filling in the form.
- 41 In its reference, the Board of Appeal appears to disagree with the position that the joint applicants approach established under the EPC can be applied to PCT applications naming different applicants for different states via Article 11(3) PCT and Articles 118 and 153 EPC. According to the

³⁸ See, for example, T 0205/14.

³⁹ BGH GRUR 2019, 271 – Drahtloses Kommunikationsnetzwerk.

⁴⁰ Gerechtshof Den Haag, *Biogen and Genentech v. Celltrion*, ECLI:NL:GHDHA:2019:1962, on this judgment see also *infra* para. 51.

⁴¹ OLG Düsseldorf, case 2 U 25/20, GRUR-RR 2021, 249, paras. 33-39 – Cinacalcet II; paras. 126-131.

⁴² BPatG case 4 Ni 8/20, GRUR-RS 2021, 30260.

⁴³ *Haedicke* in *Haedicke/Timmann* (*supra* note 2), § 11 para. 325.

⁴⁴ *Bremi* GRUR 2021, 150, 152, similarly, with respect to the joint applicants approach in general, *Visser* (*supra* note 34).

⁴⁵ *Bremi*, ‘Übertragung und Ausübung des Prioritätsrechts’, GRUR 2021, 150, 152.

⁴⁶ *Druschel/Kommer*, ‘Die formelle Priorität europäischer Patente’, GRUR 2022, 353, 357-359.

Board's position, the effects of Article 118 EPC are limited to EP applications.⁴⁷ The Board of Appeal highlights that the very fact that different applicants can be named for different states of a PCT application must be construed as meaning that the applicants' status is limited to these states.

- 42 The Board of Appeal also indicates disagreement with the view that the priority right has a unitary character under the PCT.⁴⁸
- 43 However, the Board of Appeal appears to be impressed by a judgment of the Court of Appeal of the Hague, which – unlike the Boards of Appeal – applied the *lex loci protectionis* principle to the right of priority.⁴⁹ On this basis, the Court of Appeal concluded that the EPC was applicable, which did not require any particular formalities for assigning a priority right. The Board discusses whether, on this basis, the mutual filing of a PCT application by A and B could be construed as an implicit transfer of the priority right from A to B.⁵⁰ It should be pointed out, however, that the Court of Appeal of The Hague did not simply regard the jointly made PCT application as an implicit transfer but interpreted the agreement between the parties in considerable detail.⁵¹

4. Discussion

4.1 The issue is determined by the PCT, not by the EPC.

- 44 The “joint applicants approach” in the case of Euro-PCT applications cannot be based on Articles 153(3) and 118 EPC. This approach does not do justice to the difference between PCT applications and initial EP applications. At closer sight, the answer to the problem cannot be found in the EPC but requires a closer analysis of the wording and the systematic context of the PCT and its rules.
- 45 Article 153(2) EPC only provides that Euro-PCT applications satisfy the requirements of an EPC application. It cannot be interpreted to mean that the PCT application as a whole is equivalent to an EPC application, as a simple consideration shows. If A and B are listed as PCT applicants for the US only, and C for all other designations, Article 153(2) EPC does not provide that A and B would be entitled to the European Patent as PCT co-applicants.
- 46 The unity of the application as set out in Article 118 EPC is a consequence of the fact that the EPC establishes a unitary search, examination and granting procedure with a unitary result. The PCT, on the other hand, merely aims “to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries”,⁵² while staying short of a common granting procedure. Even the international search report and the international report on patentability are not binding, but only preliminary. This militates against an unqualified application of Article 118 EPC to a PCT application as a whole.
- 47 Thus, Articles 153(2) and 118 EPC certainly apply to the PCT application to the extent that it mentions the EPO as designated Office. In this respect, it is equivalent to an application initially filed with the EPO, and only with respect to applicants mentioned as applicants for the EPO the application is unitary pursuant to Article 118 EPC. But the EPC does not answer the crucial question if a PCT application is only a bundle of independent applications to the designated Offices, as Rule 4.5(d) suggests, or whether a PCT application is unitary, as the patent owner in the case under consideration argues.

⁴⁷ T 1513/17 and T 2719/19 para. 31.

⁴⁸ T 1513/17 and T 2719/19 para. 33.

⁴⁹ T 1513/17 and T 2719/19, para. 37.

⁵⁰ T 1513/17 and T 2719/19, paras. 38-41.

⁵¹ *Gerechtshof Den Haag, Biogen and Genentech v. Celltrion*, ECLI:NL:GHDHA:2019:1962, paras.4.31 - 4.40.

⁵² PCT, Preamble, Recital 4.

4.2 PCT applications are not unitary in terms of substantive law.

- 48 Unlike the EPC, the PCT does not provide for a unitary examination and grant procedure. As *Landry* aptly puts it:

“One should think of the international application as of a collection of a multitude of different national and regional patent applications, which are processed centrally in the first phase – the so-called international phase –, but for which in the subsequent second phase – the so-called national phase – the respective national or regional granting procedures must be carried out (...).”⁵³

In other words: a PCT application is in effect a bundle of national or regional applications which are combined for the sake of administrative convenience. PCT applications for several designated states are *parallel* applications, not *joint* applications.

- 49 For administrative purposes, the national and regional applications are treated as one. There is one single application form, in the case of several applicants they are all required to sign certain declarations, and in order to allow PCT applications by applicants from several countries, it is sufficient if at least one of them satisfies the formal application requirements such as residence in the country of the receiving Office.
- 50 But there is nothing in the PCT to suggest that the national or regional parts of a PCT application are also treated as unitary in terms of substantive law. Substantive patent law has not been harmonized internationally beyond the minimum standards provided by the PC and the TRIPS Agreement. So far, all international attempts at concluding a Substantive Patent Law Treaty have been unsuccessful.⁵⁴ The International Search Report and (if demanded by the applicant) the results of the International Preliminary Examination are not binding on the designated Offices.
- 51 In particular, the validity of a priority claim is not determined during the international phase.⁵⁵ The matter is taken into consideration for the purposes of establishing international preliminary reports on patentability, but the International Searching Authority can only do so tentatively. In the national phase, the designated Offices can determine issues of priority differently.⁵⁶
- 52 The fact that the PCT application form only provides for one single box for the priority claim does (of course) not have any impact on substantive law. Suppose that the successor in title files the PCT application without the first applicant joining. In this case, the International Searching Authority will not investigate if the applicant is entitled to claim priority. But if there has been no transfer of the priority right or if the transfer is invalid, the fact that the applicant filled in the box on the application form does not give him any substantive entitlement.
- 53 There is nothing to suggest that several applicants constitute a “unity” in a more than formal way. Unlike the EPC, the PCT does not refer to “joint applicants”, although this wording was suggested in some amendment proposals to the 1968 and 1969 drafts.⁵⁷ Applicants are not required to have

⁵³ *Landry* in Haedicke/Timmann (*supra*, note 2), § 6 para. 18 (translated by AO).

⁵⁴ *Straus/Klunker*, ‘Harmonisation of International Patent Law’, IIC 2007, 907, 909-916.

⁵⁵ PCT Applicant’s Guide, para. 5.060.

⁵⁶ There are also other examples where different national parts of a PCT application are treated differently. For example, under specific circumstances, different national parts of one PCT application may be accorded different filing dates (Rules 20.8(c) and 82ter PCT).

⁵⁷ See the observations made by Japan and the Asian Patent Attorneys Association at the Washington Diplomatic Conference of 1970, see the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, pp. 190-191, 206 (available at <https://www.wipo.int/export/sites/www/pct/en/texts/pdf/washington.pdf>).

a common agent,⁵⁸ although the Rules reflect that the appointment of a common agent will often be convenient.

- 54 Thus, it appears wrong to assume that there are no prevailing PCT provisions. While the PCT does not explicitly deal with the issue of entitlement to the right of priority among several applicants, it is based on the concept that the national or regional applications, which are combined in a PCT application, are to be treated separately in terms of substantive law. They are *parallel applications*, not *joint applications*. From the perspective of the designated Office, only the part of the application with the respective destination is relevant.

4.3 The PCT joint applicants approach is inconsistent with the conflict of law regime.

- 55 The right of priority is transferable. There are no provisions in the EPC which rule the validity of the transfer.⁵⁹ Hence the validity of the transfer is a matter of national law.⁶⁰ In T 0205/14, the Board of Appeal referred, as an example, to “the question whether it is sufficient to have a declaration by the transferor only or whether an employee may transfer all its future rights in an invention to an employer”.⁶¹ These questions could not, according to the Board, be resolved under the EPC.
- 56 The Boards of Appeal tend to apply the law which is applicable to the legal relationships between the transferor and the transferee,⁶² in particular, in the case of employment relations, the law applicable to the contract of employment.⁶³
- 57 In the case under consideration here, US law, or more precisely, the state law determined by US conflict of law principles would be applicable.
- 58 The PCT joint applicants approach by-passes the correct determination of the applicable law and in effect subjects the legal relations between the applicants to the EPC, i.e. to the *lex loci protectionis*.⁶⁴ This is not only inconsistent with the Boards of Appeal’s position with respect to the law applicable to transfers and with generally recognized conflict of laws principles. It may also strip the first applicant of a protection afforded to him by national law. National contract laws usually protect parties who give up rights in several respects. For example, contracts may be void or voidable in the case of misrepresentation or if conflicting with public policy. Common law jurisdictions also require consideration for the transfer to be valid. Application of the PCT joint applicants approach has the effect of a transfer, but it does not allow the EPO to determine validity according to the applicable law.

4.4 A common application does not give rise to a presumption of transfer.

- 59 One might object that the first applicant has, after all, signed the PCT application. The fact that he has participated in the application might give rise to a presumption of transfer. This approach is indeed adopted by the Düsseldorf Court of Appeal and, following the Düsseldorf court, by the

⁵⁸ PCT Applicant’s Guide, para. 11.003.

⁵⁹ In particular, there is no requirement that the transfer be in writing, see T 160/13 para. 1.1, T 205/14 paras. 3.6 et seq. and Pahlow, ‘Die Übertragung des Prioritätsrechts nach Art. 87 ff. EPÜ, GRUR Int. 2017, 393, 397, whereas some older decisions required formal proof, see T 62/05 paras. 3.8, 3.9.

⁶⁰ T 1008/96, para. 3.6.3.

⁶¹ *Ibid.* para 3.6.2.

⁶² T 205/14 para. 3.6.5, T 517/14 para. 2.7.5; *Druschel/Kommer* GRUR 2022, 353, 355; a largely similar approach is adopted by the German courts, see also BGH GRUR 2019, 271 para. 73 – Drahtloses Kommunikationsrecht; *Harguth*, ‘Risiken bei der Übertragung von Prioritätsrechten’, GRUR 2019, 1134, 1135-1136. The Court of Appeal of The Hague, however, has recently applied the *lex loci protectionis* principle: *Gerechtshof Den Haag, Biogen and Genentech v. Celltrion*, ECLI:NL:GHDHA:2019:1962, paras. 4.7 et seq.

⁶³ T 205/14 para. 3.6.5., T 517/14, para. 2.7.5.

⁶⁴ *Bremi* GRUR 2021, 150, 152.

Federal Patent Court.⁶⁵ In its reference, the Board of Appeal also shows some sympathy for this reasoning.⁶⁶ Under this approach, the true reason why the later applicant can claim priority is not the joint application as such but the transfer of the right of priority, which can be presumed.

- 60 But such a presumption would go too far, and it would not sufficiently protect the interests of the first inventor.
- 61 First, it is possible that the PCT application is filed without the knowledge of the first inventor. While the PCT request for an international application must be signed by all applicants, the receiving Office will not invite the applicant to furnish missing signatures when the request is signed by at least one of the applicants.⁶⁷
- 62 Second, and relatedly, a co-applicant who signs a PCT request may not be aware that he is giving up a right of priority which would require a separate transfer.
- 63 Third, in practice, in the majority of cases the PCT request is only signed by an agent (commonly) appointed by the applicants. There is no general presumption that such agent has authorization to transfer a priority right between parties. Such agent is usually a patent attorney or a patent agent and is commonly only authorized to act on behalf of the applicants before the receiving Office and the WIPO. Also, as the joint filing of a PCT application by several applicants is usually handled by one agent for all applicants, the agent's signature on the PCT request cannot serve as an indication of a transfer of the priority right between two parties. One agent generally cannot act on behalf of two parties that are on opposite sides of the transfer of a right. In other words, one commonly appointed agent cannot transfer the right to claim priority from one party to another by signing a PCT request on behalf of all applicants.
- 64 Finally, the conflict of law considerations made above at para. 56 also militate against a presumption of transfer. According to the convincing approach of the Boards of Appeal, the validity of the transfer must be determined under the law which is applicable to the relations between the parties. This law may require formalities and further conditions of transfer, for example valid consideration. Again, a presumption of transfer based on the common application could by-pass national rules which protect the first applicant.

4.5 There is no reason for an exception to the rule that a transfer must be proved

- 65 Thus, the general rule applies: "If entitlement to priority is challenged, a successor in title, who desires to take advantage of the priority of a first application and who asserts that priority is rightly claimed from the first application, has to prove its entitlement to that right, which includes a valid transfer of the right of priority."⁶⁸
- 66 Neither the EPC provisions nor the PCT system justify a departure from this rule in the case of several PCT applicants.
- 67 It should be added that it is difficult to see a justification for the difference the EPO draws between the scenario "AB (first application) ≠ A (second application)", in which proof of transfer is required, and the scenario "A (first application) = AB (second application)", in which, according to the EPO, the joint applicants approach applies and makes a proof of transfer unnecessary.⁶⁹

⁶⁵ See *supra*, notes 41 and 42. While the German Federal Supreme Court has not applied this presumption so far, it does accept that the right of priority can be transferred by implied transfer when German law is applicable, see BGH GRUR 2013, 712 para. 13 – Fahrzeugscheibe.

⁶⁶ T 1513/17 and T 2719/19 paras. 38-41.

⁶⁷ PCT Applicant's Guide, para. 5.088.

⁶⁸ T 1008/96, para. 3.5.

⁶⁹ See *Visser, supra* note 34.

- 68 Of course, the “PCT joint applicants approach” is convenient for the second applicant, as it saves him the trouble of giving evidence of the transfer. But mere convenience is not a legal principle. It has been shown that neither Articles 153(2), 118 EPC nor the fact that applications for several countries are combined for administrative purposes in the international phase of the PCT system justify a departure from the legal principle that a successor in title can only claim a right of priority if he can give evidence of the transfer.

IV. Conclusions

- 69 The EPO has jurisdiction to determine who is entitled to claim priority. The Office has the right, and indeed the duty, to determine whether the EPA applicant is “any person” or a “successor in title” within the meaning of Article 87(1) EPC.
- 70 A PCT application is a bundle of national or regional applications which are combined for administrative purposes, but which are separate in terms of substantive law. They are parallel applications, not joint applications.
- 71 Both Article 153(2) EPC and Article 118 EPC do not apply to the “bundle” of the entire PCT application, but only to the application to the extent that the EPO is named as the designated Office.
- 72 Applicants who make one single PCT application for several designated states are not “joint applicants” in the sense that they would form a legal unity. Applications made by A and B for country X and by C for country Y are legally independent, even if they are combined for the sake of administrative convenience.
- 73 A joint applicants approach for Euro-PCT applications would by-pass the established conflict of law rules according to which the validity of a transfer of the priority right must be determined by the national law which is applicable to the relations between the first and the second applicant. The initial applicant should be given the protection afforded to him by the applicable national law.
- 74 There is no sufficient factual basis for a presumption of transfer based on the fact that the first and second applicants filed one single PCT application. Such a presumption would equally by-pass the determination of the applicable law and the determination of validity by the applicable national law.
- 75 The “PCT joint applicants approach” may be convenient for the second applicant, as it saves him the trouble of proving transfer. But at the same time it affects the rights of the first applicant. Convenience is not a legal principle, and there is no convincing legal reason for departing from the basic principle that a successor in title who claims priority must give evidence of the transfer in the case of both applicants filing one single PCT application.



Munich, 29 March 2022

Prof. Dr. Ansgar Ohly

Professor Dr Ansgar Ohly: Curriculum Vitae

Studies and legal education

1986–1991	Studies of law, University of Bonn
1991	First State Exam
1991–1992	Studies of law, University of Cambridge (Trinity Hall)
1992	Master of Law (LL M)
1993–1996	Practical legal training (Referendariat) at the Munich Court of Appeal (OLG München) (one-year leave for doctoral studies)
1996	Second State Exam

Postgraduate academic qualification

1992–1995	Scholar at the Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich
1995	Defence of doctoral thesis, Ludwig Maximilian University, Munich
1997–2001	Head of Department (1997-1998: European Law Department, 1998-2001: Commonwealth Department) at the Max Planck Institute
6-9/1998	Visiting Scholar, Boalt Hall, University of California, Berkeley
2001	Submission and defence of “second thesis” (“Habilitation”), Ludwig Maximilian University Munich

Positions previously held

4-9/2001	Associate Professor (Lehrstuhlvertreter), University of Karlsruhe
10/2001-2/2002	Associate Professor (Lehrstuhlvertreter), University of Bayreuth
3/2002-9/2012	Professor at the University of Bayreuth, Chair for Private Law and Intellectual Property Law
2003-2010	Lecturer, Master Program „Intellectual Property“, Swiss Institute of Technology (ETH) Zürich
4/2006-9/2012	Vice-speaker, since 2011 speaker of the German Research Foundation (DFG) Graduate School 1148, “Intellectual Property and the Public Domain”, University of Bayreuth

Present position

Since 10/2012	Professor at the University of Munich, Chair for Civil Law, Intellectual Property and Competition Law
Since 10/2003	Faculty member, Munich Intellectual Property Center, München
Since 10/2009	Visiting Professor, Faculty of Law, University of Oxford
Since 3/2010	Lecturer at CEIPI, Strasbourg
2011 and 2018	Visiting Professor at the Huazhong University for Science and Technology, Wuhan (PR of China)
Since 2014	Visiting Senior Member, St Peter’s College, Oxford
Since 4/2014	Expert of the German University Association (Deutscher Hochschulverband) for copyright law
Since 7/2014	Co-editor of “Gewerblicher Rechtsschutz und Urheberrecht” (GRUR)
Since 2015	Honorary Benchers, Middle Temple

Since 2016	Chairman of the Commission for the Safeguarding of Good Academic Practice of the Ludwig Maximilian University Munich
2018-2019	Member of expert committee in charge of reforming the “Guidelines for Safeguarding Good Scientific Practice” Code of the German Research Foundation (DFG)
10-12/2019	Visiting Professor, Engelberg Center, NYU, New York

Selected Publications¹

Books (authored or co-authored)

1. Fälle zum Recht des Geistigen Eigentums [Case-book on Intellectual Property Law], 3rd ed., Beck, Munich 2022 (co-authors: F. Hofmann, H. Zech)
2. Geschäftsgeheimnisgesetz, Kommentar [Trade Secrets Act – Commentary], Beck, Munich 2020 (co-authors: H. Harte-Bavendamm, B. Kalbfus)
3. The jurisdiction of European courts in patent disputes, EPO training manual, Munich 2018
4. UWG, Kommentar [Commentary on the German Act against Unfair Competition], 7th ed., Beck, Munich 2016 (co-author: O. Sosnitza)

Books (edited or co-edited)

5. Schricker/Loewenheim, Urheberrecht, Kommentar [Schricker and Loewenheim on Copyright Law], 6th ed., Beck, Munich 2020 (co-editor and author of commentary on §§ 28-31, 33-35, 132, 137 UrhG, co-editors: U. Loewenheim, M. Leistner)
6. Research Handbook on Information Law and Governance, 2021, Edward Elgar, Cheltenham 2021 (co-editors: S.K. Sandeen, C. Rademacher)
7. Transition and Coherence in Intellectual Property Law – Essays in Honour of Annette Kur (co-editors: N. Bruun, G. Dinwoodie, M. Levin), Cambridge University Press, Cambridge 2021
8. The Europeanization of Intellectual Property Law, Oxford University Press, Oxford 2013 (co-editor: J. Pila)

Articles and book chapters

9. Der Ausgleichsanspruch gemäß § 139 I 4 PatG als Rechtsfortwirkungsanspruch [Compensation in Lieu of an Injunction under § 139 I 4 Patents Act], Gewerblicher Rechtsschutz und Urheberrecht (GRUR) 2022, 303-309
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¹ Of 9 authored or co-authored books, 12 edited or co-edited books, 60 journal articles and 57 book chapters.

11. Urheberrecht im digitalen Binnenmarkt – Die Urheberrechtsnovelle 2021 im Überblick [Copyright in the Digital Single Market – an Overview of the Copyright Reform of 2021], in: Zeitschrift für Urheber- und Medienrecht (ZUM) 2021, 745-755
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