

Amicus Curiae Brief for case G 4/19 before the Enlarged Board of Appeal

FEMIP is the European Federation of Patent Attorneys and Industrial Property Agents in Industry established in 1971. Its members are the corresponding national organizations of Austria, Denmark, Finland, France, Germany, Luxembourg, Norway, Sweden, Switzerland, the United Kingdom, and the Netherlands. It therefore represents the interests of a great number of the users of the European Patent System.

In this Amicus Curiae Brief FEMIP wishes to share its view on the referral of a point of law to the Enlarged Board of Appeal by the Technical Board of Appeal 3.3.01 by interlocutory decision of 7 February 2019 in case T 318/14.

The Technical Board of Appeal has the following questions to the Enlarged Board of Appeal:

1. Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent which was granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC ?

2.1 If the answer to the first question is yes, what are the conditions for such a refusal, and are different conditions to be applied depending on whether the European patent application under examination was filed

a) on the same date as, or

b) as a European divisional application (Article 76(1) EPC) in respect of, or

c) claiming the priority (Article 88 EPC) in respect of a European patent application on the basis of which a European patent was granted to the same applicant ?

2.2 In particular, in the last of these cases, does an applicant have a legitimate interest in the grant of a patent on the (subsequent) European patent application in view of the fact that the filing date and not the priority date is the relevant date for calculating the term of the European patent under Article 63(1) EPC ?

As laid out below, FEMIPi is of the opinion that the questions referred to the Enlarged Board of Appeal should be answered as follows:

Question 1: No

Question 2.1: is rendered moot in view of Question 1

Question 2.2: Yes (according to the vast majority of FEMIPi)

In FEMIPi's view, there is no statutory basis in the EPC for a rejection based on double patenting.

Article 60(1) EPC, 63(1) EPC or Article 76(1) EPC cannot serve as such basis, neither is Article 125 EPC a sufficient legal basis for a prohibition on double patenting. Indeed, only Article 139(3) EPC deals with double protection resulting from parallel filing routes for the same territory, leaving this entirely to national law.

It is noted that Article 139(3) EPC remained unchanged in the EPC2000. Hence there is also no unintended gap in the law, which might be filled by case law. Therefore, it would be improper for the EPC to introduce a new ground for refusal based on double patenting.

For a detailed reasoning we point to the decision T 318/14 which contains a very thorough and detailed analysis, which, along with its conclusions, is fully endorsed by FEMIPi.

If a prohibition on double patenting should ever be introduced into the EPC, the only way to do this would be by way of a Diplomatic Conference.

In regard of the question of the legitimate interest, even though strictly speaking question 2.2 is also rendered moot by the answer to question 1, it should be noted that the legitimate interest of the applicant can stem from at least two sources, one being the term of the second patent being calculated from the filing date of the second application, and another being the option to obtain protection for a different geographical scope upon validation of the second patent, e.g. due to accession of new EPC member states. In our view the EPO should not be the one to judge this matter. At any rate, it should be up to the applicant to decide on his interest in obtaining protection for his invention.