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To the Registry of the Enlarged Board of Appeal
Att. Mr Nicolas Michaleczek
EBAamicuscuria@epo.org

Written statement for case G 4/19 before the Enlarged Board of Appeal

About us

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At Ericsson we are dedicated to research and innovation, leading the development of cellular technology – from 2G to 5G. Around 17 percent of Ericsson's annual global revenue is invested in research and development (R&D) and we have the leading portfolio in the industry, with over 54,000 granted patents.

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Questions referred to the Enlarged Board of Appeal in case T0318/14

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

- a) on the same date as, or
- b) as a European divisional application (Art. 76(1) EPC) in respect of, or
- c) claiming the priority (Art. 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 latter case, does an applicant have a legitimate interest in the grant of 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 Art. 63(1) EPC?

**Re Question1:**

It is evident from T0318/14 that question 1 aims at providing guidance on the existence or non-existence of a principle of prohibition of double patenting with respect to European patents of the same applicant and whether the EPO or boards of appeal have basis to restrict grants of patents on this ground where doubts have been raised whether there is legal basis in the EPC.

Technical Boards of Appeal decision T 1423/07, which is mentioned as one of the conflicting decisions in the referring decision T0318/14, points out that there is no principle of law generally recognized in the contracting states for refusing a patent application on the ground of double patenting (cf. Points 2.2.2 and 2.2.3 of the Reasons).

On the other hand, as T 2461/10 emphasizes, the Travaux Préparatoires consider that it is a generally accepted principle of law that only one patent shall be granted to one applicant for the same invention (see points 8 to 11 of the Reasons), and that this principle is linked to Art. 125 EPC. T 2461/10 also refers to Enlarged Board of Appeal decisions G 1/05 and G 1/06 which recognize, even if only in an *obiter dictum*, the existence of a prohibition of double patenting based on the consideration that an applicant does not have a legitimate interest in obtaining a second patent for the same subject-matter. Also, for example, German jurisdiction has found that there is no legitimate interest in granting several patents arising from applications from one and the same applicant with identical contents and priority dates (BPatGE 21, 223, also cited in T 1423/07).

While it appears that double patenting is generally disfavored by the contracting states, the two aforementioned contradicting decisions of the Technical Boards of Appeal exist and thus clarification by the Enlarged Board of Appeal is welcomed. It is further noted that question 1 makes explicit reference to the term of “the same subject-matter” which we consider as crucial for this issue and which will be elaborated in this letter further down when addressing question 2.1.

Conclusion: While we are answering Question 1 with “yes”, we want to emphasize that the criteria for refusing an application based on double patenting must be clear and well defined, particularly regarding the term “the same subject-matter”.

Re Question 2.1:

While Enlarged Board of Appeal decisions G 1/05 and G 1/06 recognize a prohibition of double patenting, these decisions do not provide reasoning other than referring to a lack of legitimate interest, nor do they address the specific cases of a potential double patenting issue according to question 2.1.

Thus, notwithstanding a confirmation of the principle of prohibition of double patenting by the Enlarged Board, the second question 2.1 addressing the conditions for the EPO refusing a European patent application on the ground of double patenting is – beside being a question of fundamental importance from a legal perspective – also a question of fundamental practical importance where clarification is certainly needed in order to ensure the uniform application of the law.



T0318/14 summarizes the conditions according to G 1/05 and 1/06 for refusal as follows (numbering added):

1. There are two or more European patent applications of the same applicant
2. which have the same effective date, i.e. the date of the actual filing as referred to in Article 54(2) EPC or, where priority is claimed, the priority date as referred to in Article 89 EPC, and therefore do not form part of the state of the art according to Article 54(2) and (3) EPC in respect of each other,
3. at least overlap in their territorial scope of protection, and
4. claim the same subject-matter in their final version for grant.

A further condition/question, not listed under the conditions in T0318/14 - but very clearly stated in G1/05 and G1/06 13.4 1st sentence - would be:

5. has said applicant of said two or more European patent applications no legitimate interest?

Condition 5 is often intermingled in the assessment of conditions 1-4 above, as one may understand G1/05 and G1/06 such that there is no legitimate interest to obtain a further patent if conditions 1 to 4 are fulfilled. Nevertheless, there may be cases where condition 5 is independent of conditions 1 to 4 - like the case of a priority/subsequent application addressed in Question 2.2 - so that a clearer separation is desirable.

Re condition 1: It is without a question that "two or more European patent applications" in question here can originate from (1) independent filings, (2) divisional application(s), or (3) internal priority. Regarding the second condition, "the same applicant", in the first place this has to be understood to mean the same person, i.e. the same legal entity. Nevertheless, it should be clarified whether the criterion of "the same applicant" is also fulfilled in cases where the applicants of the two or more European Patent Applications are affiliated companies, or when one of these applications has been transferred to another applicant, also in order to prevent any abuse.

Re condition 2: This condition appears to require no discussion.

Re condition 3: If the two or more European patents do not overlap in their territorial scope of protection, the issue of double patenting does not arise. Hence, it would be required that said two or more European patent applications do not designate the same contracting states, or the European Patents arising therefrom have legal effect in different contracting states. In this respect, it appears to be sufficient to prevent double patenting if the designation states of a second application do not overlap with the contracting states in which an already granted patent claiming the same subject-matter has legal effect (i.e. is in force) at the time of grant of the second application.

Re condition 4: It is evident from G 1/05 and G1/06 point 13.4 3rd sentence that the claims of the EP applications "in their final versions", e.g. EP1 as granted and EP2 as submitted for grant (and not as filed) must be compared, however, clarification by the Enlarged Board on the term "same subject-matter" is very much needed and welcomed.

In an attempt to summarize the findings of relevant EP case law, it is stated on page 19 of T0318/14 "a comparison was made between the claims, defined by their categories in



combination with their technical features, in the final version submitted for grant, and the claims, again defined by their categories in combination with their technical features, of a patent already granted to the same applicant.”

In summary, case law refers to the same subject matter in two claims if:

- i. the categories of both claims are the same, and
- ii. the technical features of both claims are the same.

It is without doubt, that if the claims of two or more European patents in their final version are identical (as it is the case in T0318/14), the “subject-matter” of the two or more European patents must be regarded as “the same”.

As confirmed by G 2/10 and, also mentioned in T0318/14, it is accepted to first seek patent protection for a preferred embodiment and then to pursue the general teaching in a divisional application. As the claims of the parent and divisional application are alike “defined by their categories in combination with their technical features” they clearly differ as the claims of the parent application on the preferred embodiment contain more (specific) technical features. Consequently, these claims do not claim “the same subject-matter” because their technical features are different.

Studying G 2/10 in more detail, it is stated that it is not abusive and even legitimate to first seek quicker protection for a preferred embodiment and pursue the general teaching in a divisional application. Thereby, the Enlarged Board in G 2/10 solves the question by merely referring to a legitimate interest and does not elaborate on whether and why it considers the criterion of “same subject-matter” to be fulfilled.

Based on decisions T 0080/98 and T 1391/07 which consider the conferred scope of protection as at least one factor to establish the same subject-matter, claims as addressed in G 2/10 (a claim directed to a more specific embodiment and a claim directed to a more general technical teaching) do not constitute the same subject-matter. Similarly, T 2563/11 defines the subject-matter of a claim by its category and technical features, the latter being again different for such claims.

In conclusion, when two claims contain different features, they must be considered to not be the same subject-matter, no matter whether the scope of protection of one is encompassed in the other or not. In such cases it would thus not be necessary to establish a particular legitimate interest, because this is simply not a case of double patenting, and it would also not matter which of these claims is granted first.

From a substantial and procedural point of view, it would thus be appropriate to assess the term “the same subject-matter” in this context to be understood as the claims of the two or more European patents having identical scope of protection.

Re condition 5: It has been accepted in G2/10 that there is a legitimate interest for obtaining a first quicker protection for a preferred embodiment and pursue the general teaching in a divisional application. The reverse situation, i.e. first to obtain a general teaching in a first European patent and then to cover one or more embodiments in one or more further EP applications, has however to our knowledge not yet been addressed by any EPO Board of Appeal decision.



Applicants in modern and fast-changing industries often prosecute patents to get a first indication on patentability with a broader scope. Then in a second step when market, technology and/or products are settled and more mature, it is clearer which embodiment(s) are of more value. Often such valuable embodiments are derived from specific disclosure in the specification which may not be properly reflected in a (dependent) claim of the already granted patent. Hence, patent(s) on specific and more valuable embodiment(s) must be obtainable without facing the objection of double-patenting. This constitutes a legitimate interest for first obtaining a broader protection and subsequently protection for more specific embodiments in a sequence of patents.

Furthermore, there is no doubt that different applications can experience different times from filing till grant. Consider the example of two parallel applications (arising from independent filings, divisional filings or internal priority), wherein one seeks protection for a preferred embodiment and the other one seeks protection for the general teaching with broader scope. If now, by chance, the more specific one is granted first, the broader one would, following G 2/10, be allowable. It would be incomprehensible if in the alternate case – the broader application being granted first – the second (more specific) application would be refused, because it would merely be a matter of chance – and not of law – which is granted first. In both cases, the patent proprietor obtains two independent patents which can be enforced in the same way, i.e. if there were any detrimental effects to the public that are to be avoided by a prohibition of double patenting, prohibiting one scenario while allowing the other would not help to mitigate these effects.

Conclusion: As to Question 2.1, the appropriate conditions for a refusal, at least in cases (a) and (b), are that the applications in question (1) have the same person respectively legal entity as applicant, (2) have the same effective date, (3) at least overlap in the territorial scope in which they have legal effect, (4) have claims with identical scope of protection (identical category and identical technical features), and (5) there is no legitimate interest. Case (c) is to be handled differently, see Question 2.2.

Re question 2.2

The third question 2.2. addresses the issue of double patenting in an internal priority scenario and whether there is legitimate interest for the applicant given by the fact that the expiry date of the subsequently filed application is extended by maximum 1 year into the future compared to the earlier filed priority application.

In fact, one must acknowledge that an applicant has indeed a legitimate interest to obtain a longer term of protection as offered by the filing of a subsequent application claiming priority of an earlier application. It seems undue to deny an applicant of this possibility based on the priority of a European Patent Application, while he can enjoy this advantage if the priority arises from a foreign application or an application from one of the Contracting States.

On the other hand, such cases may put a certain burden on the public as then two patents claiming the same subject-matter (in the sense elaborated above) may exist. Thus, it may be considered to require the applicant to abandon the priority application, or any patents originating therefrom, when claiming priority therefrom or at least before proceeding to grant with the subsequent application, if in both the same subject-matter is claimed. As a comparison, the German Patent Act stipulates that a German priority application is deemed withdrawn when its priority is claimed for a subsequent German patent application.



Conclusion: Despite conditions 1 to 4 of question 2.1 being fulfilled, there is a legitimate interest in obtaining a longer term of protection for a subsequent application claiming priority of an earlier application, such that this should not be refused.

Ericsson AB

DocuSigned by:
Christina Petersson

Christina Petersson
Chief Intellectual Property Officer

DocuSigned by:
Gabriele Mohsler
B2A0F017C15140B...
Gabriele Mohsler
VP Patent Development