

in referral to the Enlarged Board of Appeal of the EPO

G1/22

Entitlement to priority

Dear Chair and Members of the Enlarged Board of Appeal,

The following questions were referred by decision T 2719/19 (OJ 2022 A36):

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

II. If question I is answered in the affirmative: can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where (1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and (2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and (3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?¹

1. I will address Question II only; I hence assume that Question I is answered in the affirmative.

I observe that the examination of the entitlement to priority by the EPO as designated or elected office may be restricted under Rule 51*bis*.2(iii) PCT.

2. Question II may have to be reformulated because it presents a set of facts rather than a question of whether Article 87(1) EPC must be interpreted in a certain way. Only a study of the reasons for the referring decision reveals the two legal theories that are presented by the referring Technical Board of Appeal as possible interpretations of Article 87(1) EPC, namely the PCT joint applicants approach and the possibility of a tacit transfer of the priority right (i.e. an assignment by implicit agreement).
3. Hence, the second question essentially entails the following sub-questions:
 - A. Whether party A is to be considered as an applicant of the subsequent application for the purposes of Article 87(1) EPC. This aspect is called the “PCT joint applicants approach” in the referring decision, r.14-19 and r.28 ff.
 - B. Whether party B is to be considered as the successor in title in the sense of Article 87(1) EPC in the proceedings before the EPO as a designated office by way of a tacit transfer of the priority right (r.38 and r.39).
4. As I will discuss hereinafter, in my view the “joint applicants approach” is not based on a tacit transfer of the priority right to co-applicants, such that these two legal concepts can be analysed independently.

¹ The referring decision was taken in consolidated cases T 1513/17 (opposition appeal) and T 2719/19 (appeal against a decision to refuse a patent application).

5. The statement in Question II that “the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention” is understood to mean that only lack of ownership of the priority right is to be considered as a ground for the possible invalidity of the claimed priority. Rephrasing this aspect of the question seems necessary because, in view of T 577/11, Article 4 of the Paris Convention is not directly applicable in proceedings before the EPO as a designated office. Moreover, lack of ownership of the priority right is equally a deficiency under Article 4 of the Paris Convention, such that the statement in the question strictly speaking predisposes the answer.
6. I will only discuss the case of the grant proceedings before the EPO as a designated office. The analysis is the same when the EPO acts as an elected office and for opposition proceedings before the EPO.
7. I will refer to the ‘earlier patent application’ as the priority application. I will refer to the subsequent application, being a PCT application which has entered the regional phase before the EPO as designated office, as a Euro-PCT application.²
8. Question II thereby deals with the substantive (in)validity of the priority claim. In the proceedings before the EPO as a designated office, this matter is governed exclusively by the EPC, even if the subsequent application is a Euro-PCT application (T 577/11).

A. First aspect: the PCT joint applicants approach

9. The joint applicants approach generally means that Art. 87(1) EPC is understood as not excluding that the (sole) applicant of the priority application shares his priority right with a third party by filing the subsequent application jointly with the latter (T 1933/12). In other words, Art. 87(1) EPC requires that the applicant of the priority application, or his successor in title, be *among the applicants* for the subsequent, priority-claiming filing. In such a case, if there was only one additional applicant for the subsequent filing, there is no need to provide proof of a transfer of the priority right to that additional applicant (still T 1933/12).

I observe that the above holding suggests that the joint applicants approach is not based on a (presumed or actual) tacit transfer of the priority right.

The joint applicants approach is not contested in the referring decision. The approach is, however, not without criticism in the literature.³

Importantly, there appears to be no international consensus on the matter. As I understand it, an assignment of the priority right may be required e.g. under Chinese

² I acknowledge that the term ‘Euro-PCT application’ is defined in Article 153(2) EPC to include all PCT applications in the international phase under current Rule 4.9 PCT with only rare exceptions.

³ D. Visser, *The Annotated European Patent Convention*, 25th edition (2017), Art.87(1):4.1 describing T 1933/12 as poorly reasoned. My personal view is that T 1933/12 is correct.

Patent Law and by the Eurasian Patent Office in case of an additional co-applicant of the subsequent application.

I therefore suggest that the Enlarged Board expressly confirms the joint applicants approach in the decision on the present referral.

10. The joint applicants approach may be illustrated with the analogy of an exit ticket of a car park: upon handing in the exit ticket, one car (patent application) is allowed to leave the car park, irrespective of the number of people in the car. If the driver picks up a passenger, this is no problem. However, in case a driver and a passenger together buy a paper ticket and divide the ticket into halves, both halves must be handed in before the exit gate opens.
11. The joint applicants approach is generally understood as requiring that parties A and B are both applicants of the subsequent application (referring decision, r.15). However, it must first be considered whether this is the actual requirement under Art. 87 EPC.
12. The priority right under Art. 87 EPC is a subjective right, hence a right held by a holder (proprietor). The EPC defines the person who has duly filed the priority application or the successor in title of that person as the proprietor of the priority right.
13. A legal right, such as a subjective right, is complemented by a legal action through which the right can be exercised in law (“*ubi jus ibi remedium*”). Exercising a right in law hence requires performing the appropriate legal action in the prescribed manner. A characteristic of such legal actions for subjective rights is that not just anyone can validly perform the action, but only the holder of the right. The first sub-question is hence, more precisely, whether party A has exercised the priority right, which it possesses, in the correct way, i.e. whether party A has performed the legal act(s) prescribed for exercising the priority right.
14. The act of exercising the priority right could most logically be seen in filing the priority declaration (Art. 88(1) EPC). However, according to prevailing case law, the party must be entitled when filing the subsequent application (T 577/11 hn. 3). Hence, the prevailing view is that entitlement when filing the priority declaration (which can be filed later) is insufficient. Under this line of case law, filing the priority declaration can not be the relevant act.
15. Article 87(1) EPC refers, in the relevant part, to “for the purpose of filing a European patent application”. This phrase indeed specifies the act that needs to be performed by the holder of the priority right (T 1201/14; cf. Maibaum, *Die rechtsgeschäftliche Übertragung des Prioritätsrechts bei europäischen Patenten*, Kluwer, 2021, §48).
16. Said phrase corresponds to Article 4 Paris Convention which specifies “*pour effectuer le dépôt dans les autres États*”, already in the original version of 1883.

Turning to the *travaux* of the Paris Convention 1883, the proposal (of November 1880) that introduced the phrase “*pour effectuer le dépôt*” had as its primary purpose to clarify that a priority right also protects against public use of the invention in the priority period and not only against patent applications filed in the priority period.⁴ In other words, the phrase was not arrived to specifically address the question at hand of defining the requirements as to party status.

Because patent applications were filed for individual countries in 1880 and regional patent offices did not exist at that time, the situation of a patent application having different applicants for different designated states could not occur. This situation was hence never considered by the participants of the Conference. Therefore, applying the phrase in the context of PCT applications requires an interpretation taking into account both the developments since 1880 and the purpose of the Article 4 Paris Convention (J 8/20, r.4.3.3).

17. I suggest that especially in cases where party A, which is a natural person in the underlying appeal cases, has personally signed the PCT Request form as received on the international filing date (cf. Rule 4.15 PCT stating that all applicants must sign the request), party A has sufficiently participated in the act of filing of the application to meet the requirement of “*pour effectuer le dépôt*” under a grammatical interpretation of that term as well as under a systematic interpretation of that term.

This proposal is further supported by the finding in T 844/18 r.108 that “Article 4A(1) and (2) Paris Convention (and the basically identical Article 87(1) and (2) EPC) do not refer to the ‘inventor’ or the ‘applicant’ for a patent application: they refer to a person *who has carried out an act*, that of filing a patent application. This is immediately determinable upon the date of the filing - it is the person or persons who carried out the act of filing” (emphasis added). By analogy, the same applies to the filing of the subsequent application.

18. It is further observed that a PCT application in the international phase, i.e. before the entry into the regional phase before the EPO, has the characteristics of a unitary patent application in that it has a single text (different sets of claims for different designated states are not permitted under the PCT), even in case of different applicants for different designated states. Moreover, only a single applicant is entitled to act as the common representative, even in the case of different applicants for different designated states in the international phase (cf. R.90.3(c) PCT; for entry into the national/regional phase, only the applicants for the relevant designated states will be relevant under the law applied by the designated office).

It is correct that the PCT lacks a provision expressly referring to the unity of the application. However, I note that the wording of Art. 118 EPC, second sentence,

⁴ Minutes of the fourth meeting of the Conference on 09.11.1880, p.61; see also p.50 of the third meeting on 08.11.1880, available through WIPO at <http://dx.doi.org/10.34667/tind.30008>.

confirms rather than creates the principle of unity of the application in proceedings before the EPO.

Additionally, the PCT does not permit specifying the priority claim differently for different designated states in the international phase. Hence the unity of the priority claim in the international phase is assumed under the PCT.

19. In conclusion, I submit that if party A participated in the filing of the PCT application, amongst other applicants, as an applicant for at least one designated PCT contracting state, by an appropriate act of party A on or before the international filing date, this is sufficient for Art. 87 EPC, even if the relevant designated state is not a contracting state of the EPC.
20. In the appeal cases at hand, the originally filed PCT Request form does not seem to be part of the public online file of the European patent and respectively patent application, such that it cannot readily be ascertained if the inventor (party A) personally signed it. If the precise manner in which party A was involved in the filing of the PCT application is considered relevant, the referring Technical Board of Appeal may have to examine the facts and evidence in the file in more detail.

The same considerations could come into play for a Euro-direct application if the Request for grant form, filed at the filing date, was not signed by the co-applicant that was also the applicant of the first application.

The precise facts can not be disregarded, in my view. It must be observed that a party can, at least as a matter of fact, simply name another person (or legal person) as co-applicant for an (economically unimportant) contracting state, even in the absence of any authorization of that party. Moreover, it can not be assumed that the priority application is still secret at the end of the priority year. Utility model applications, for example, are regularly published within a few weeks of filing. At least in the latter case, a party can (at least as a matter of fact) file a PCT application (or Euro-direct application) having the same text as the published utility model application, claiming priority of that utility model application, and listing the applicant of the utility model application as a co-applicant for an economically unimportant contracting state. For these reasons, the mere fact that a party is mentioned as an applicant in the request form, should not be treated as absolutely decisive for the purposes of Article 87(1) EPC.

If the PCT Request form in the cases at hand was signed by a patent attorney, as seems not unlikely, the question may arise if this patent attorney was properly authorized by party A. This issue, however, extends beyond the scope of the referral.

21. Nothing seems to preclude the Enlarged Board from concluding that the filing of the priority declaration is to be considered as the relevant act (cf. Maibaum, §50; see also German BPatG 11 W (pat) 14/09), though this may involve abandoning a line of case law of the Boards of Appeal.

If the filing of the priority declaration is taken as the relevant act, this filing constitutes an exercise of the priority right by party A because the filing of the priority declaration by the common representative in the PCT phase has the effect of an act by all applicants (Rule 90.3(c) PCT). This rule would then also settle the validity of the priority claim.

B. Second aspect: assignment by implicit agreement?

22. The second aspect of Question II is whether party B can be considered as a successor in title of person A. From the referring decision, r.38 and r.39, it is clear that there is no written assignment in the underlying appeal. The first sub-question of this second aspect is hence essentially if party B can be the successor in title in the sense of Art. 87(1) EPC based on an implicit assignment, i.e. whether a tacit transfer is possible or whether a written assignment (or some other formality) is required. If this question is answered in the affirmative, a further sub-question is if the facts specified in Question II are sufficient to conclude that a tacit transfer occurred.
23. It must be observed that the first sub-question is by no means restricted to the case of a Euro-PCT application claiming the benefit of priority of a USA patent application filed in the name of the inventors. The issue of tacit transfer equally comes up, for example, if a priority application is filed by a company X and the subsequent European application (or Euro-PCT application) is filed by a company Z (perhaps another legal entity in the same group).
24. Hence I will discuss the case of a direct European patent application instead of a Euro-PCT application to focus on the pertinent legal issue, namely whether a tacit transfer of the priority right under Art. 87(1) EPC is possible.
25. A few points are generally derived directly from the EPC. First, assignment of the priority right is possible; assignment is one way to become the successor in title in the sense of Art. 87(1) EPC.

Moreover, according to established case law, the priority right under Art. 87(1) EPC can be transferred independently of the ownership of the priority application. As an example, if a priority application is filed by a party X in Japan, party X can remain the applicant of the Japanese priority-founding patent application while a party Y is the holder of the priority right to be invoked in proceedings before the EPO by way of assignment from party X (cf. Maibaum §37).

Further, according to established case law, the priority right for different patent offices can be transferred independently, i.e. in the example above, another party Z can be the holder of the priority right to be invoked in proceedings before the Chinese patent office (cf. Maibaum, §21; and in particular KPA 16.12.1905, BPMZ 1906

p.127-130, in translation: “as many Contracting States [to the Paris Convention]⁵, as many independent rights [of priority].”⁶

26. Moreover, in proceedings before the EPO, the Board or the first instance department must be convinced that the alleged assignment has taken place, using the relevant standard of proof (e.g. balance of probabilities or up to the hilt). The standard of proof, the burden of proof and the permitted means of evidence are determined by the EPC in proceedings before the EPO. Under Art. 117 EPC, the means of evidence are not restricted, and the principle of free evaluation of evidence applies (cf. T205/14, r.3.6.1 which disagrees with T62/05, r.3.8).

27. Furthermore, the EPC does not expressly provide a substantive rule for transferring the priority right of Art. 87 EPC (i.e. the priority right to be invoked before the EPO), e.g. whether a written assignment is necessary (Maibaum, §55).

The EPC furthermore does not expressly provide that recourse is to be had to national law on this point (cf. Maibaum §122; M. Beck, *Conflicts of Laws in Proceedings Before the European Patent Office*, IIC 48(8), 925-952, 2017, open access at <https://repository.uantwerpen.be/>; §2). Moreover, international organizations do not seem to invariably apply a national law each time a treaty is silent; often an autonomous interpretation is used to arrive at an answer (see also Maibaum §122 citing only decisions of Technical Boards of Appeal as the basis for having recourse to national law).

Additionally, the EPC does not provide any rule to determine the applicable national law (T 1201/14, r.3.1.2), nor can such a rule be directly derived from the EPC (Maibaum, §65, §82).

28. Hence, there is a lacuna, or gap, in the law. This lacuna is to be filled in a praetorian way (T 318/14, r.72; G 2/08, r.5.9) or possibly, in the future, by primary or secondary legislation.

29. Subject to very recently published decision J 8/20, discussed below, the main argument for having recourse to national law set out in T 205/14 is that developing a complete property law system raises issues that cannot be resolved under the EPC (cf. Maibaum, §122). However, for the lack of conflict-of-laws rules (private international law rules) in the EPC, the same applies to having recourse to some national law.

30. A disadvantage of having recourse to national law is that the selected national law may treat priority rights as being unassignable (e.g., for USA law, the “right of

⁵ Regional patent offices, such as the EPO, did not exist at the time the decision was given; nor the PCT.

⁶ Original: ‘*Soviel Unionsstaaten, soviel selbständige Rechte*’. Copies of the decision as published in BPMZ 1906 p.127-130 are available from the German Patent Office. A French translation was published in *Prop. Ind.* 1906 issue 9, p.134-136, available at https://www.wipo.int/edocs/pubdocs/fr/intproperty/120/wipo_pub_120_1906_09.pdf.

priority is personal to the United States applicant”, T. Breimi in epi Information 1/2010, p.21; see also Beck, *op. cit.* §6.4.2) thereby directly conflicting with Art. 87(1) EPC.

31. Nevertheless, I assume that the approach J 8/20 r.4.2.2. will be followed such that the concept of ‘successor in title’ in Art. 87(1) is treated as a notion of the EPC, just as for Art. 60(1) EPC. Hence, following J 8/20, “[it] must be interpreted uniformly and autonomously. (...) [The] concept of successor in title implies an interaction with national law. Indeed, the EPC has not established a comprehensive, self-sufficient legal order and private law. This does not mean that [Article 87(1) EPC] constitutes a pure reference to national legislation devoid of any content. "Successor in title" has an ordinary meaning under Article 31(1) of the Vienna Convention on the Law of Treaties (1969) ("VCLT"): it refers to a situation where a pre-existing right goes from one subject (the legal predecessor [...]) into the sphere of another (the legal successor [...]). National law governs the question of whether the transfer is valid or has occurred by operation of a contract, inheritance or other rules of law”.

J 8/20 then adds, in the context of Art. 60(1) EPC, that “[since] the EPC is silent on the matter with the exception of employment relationships, a national court seized with the issue will identify the applicable rules according to their domestic conflict of laws-provisions”.

The difficulty in the present case is that the EPO is the body seized but lacks (domestic) conflict-of-laws provisions.

B.I. Conflict-of-laws analysis

32. Assuming recourse is to be had to some specific national law, in line with J 8/20, the lacuna caused by the lack of conflict-of-laws rule has to be filled.
33. The principle of *lex loci protectionis* is a customary recognized, basic international principle for intellectual property rights and may therefore be considered first (Maibaum, §201).

I will address in §39 the question of how to identify a law of an EPC contracting state as applicable in case the *lex loci protectionis* is the EPC.

Maibaum convincingly argues that the priority right is not an intellectual property right *stricto sensu* (Maibaum, §187). She then concludes that for this reason, the principle of *lex loci protectionis* does not apply (Maibaum, §201). In my view, Beck’s reasoning that the principle must be extended is more convincing: “the *lex loci protectionis* appears to be the theoretically soundest choice to govern the actual transfer. If the *lex loci protectionis* determines under what conditions a patent right is granted, it also determines to whom it is granted and who is entitled to the right; this reasoning may easily be extended to the entitlement to the priority right that may be invoked before the authorities of the *locus protectionis*” (Beck, *op. cit.* §6.4.1, footnote omitted).

34. Following Maibaum’s analysis for the moment, it may indeed be more precise to consider the priority right to be a *Gestaltungsrecht*, as Maibaum does, because it gives the holder the right to modify a legal aspect of the subsequent filing, namely the prior-art cut-off date by filing a unilateral declaration with the EPO (Maibaum, §188-190). However, establishing the conflict-of-laws rules to be applied by the EPO for the assignment of such a specific type of rights, which may not be clearly recognized as a separate category of rights in many contracting states to the EPC, may be even more challenging.

It is understood that German courts apply the conflict-of-laws rules that are applicable to assignments of claims in the event of an assignment of a *Gestaltungsrecht* (Maibaum, §226, §188, and §226 and §262 all referring to §413 BGB, German Civil Code). Hence, the conflict-of-laws rule in proceedings before German courts is Article 14 EU Regulation 593/2008 (Rome I). Maibaum concludes that this extends beyond the proper scope of the Rome I Regulation (Maibaum, §252) but that application by analogy is justified, as a matter of domestic German conflict-of-laws rules (Maibaum, §253). The reason is a gap in the German Civil Code caused by the deletion of certain former provisions thereof (Maibaum, §262). This is, however, a circumstance specific to German law and indeed purely a matter of domestic German conflict-of-law rules.

35. If Article 14 Rome I Regulation is to be applied by analogy, it must be decided whether the possible requirement of a written assignment (as opposed to a tacit transfer) is governed by paragraph 1 or 2 of Article 14 Rome I Regulation. It is observed that the EPO is the debtor in the sense of that provision (when applied by analogy), in any case clearly neither the assignor nor the assignee (which would be party A and B in the referral). Hence, Article 14(2) appears to be the relevant provision since that provision deals with “the relationship between the assignee [i.e. party B] and the debtor [i.e. the EPO] [and] the conditions under which the assignment (...) can be invoked against the debtor [i.e. the EPO]”, as well as the “assignability” of the claim [i.e. the priority right].⁷
36. At this point, the reasoning of Maibaum in §272 can not be followed. Article 14(1) Rome I only covers “the relationship between assignor [i.e. party A] and assignee [i.e. party B] under a voluntary assignment (...) of a claim [i.e. the priority right] against another person (the debtor) [i.e. the EPO]”. Recital 38 does not change this because it specifies that “Article 14(1) also applies to the property aspects of an assignment, *as between assignor and assignee* in legal orders where such aspects are treated separately from the aspects under the law of obligations”, i.e. not the property aspects as between assignee and debtor (nor does recital 38 simply refer to “the property aspects of an assignment between assignor and assignee”). Hence, these

⁷ See also Benkard/*Grabinski* EPÜ 3rd ed. Art.87 §5 referring to Art. 14(2) Rome I regulation.

property aspects are restricted *ratione personae* (cf. CJEU C-548/18 concluding that Art. 14(1) does *not* cover third-party effects of assignments of claims).

37. Article 14(2) Rome I refers to “the law governing the assigned (...) claim”, i.e. the law governing the assigned priority right in the context of the present referral (*not*: the law governing the priority-founding patent application). The question is hence what the law governing the assigned priority right is.

This is exactly the same question as considered already in KPA 16.12.1905, BPMZ 1906 p.127 (which applied the then Article 11 Introductory Law of the German Civil Code, in translation: “*the form of an act is governed by the laws which apply to the legal subject in which the object of the act falls*”). The judicial panel in that absolute landmark decision concluded, based on extensive systematic reasoning starting from first principles, that a priority right is established by the law of the country where it can be invoked (*not* by the law of the state of first filing⁸), and hence also governed by that law, which law accordingly also governs the formal requirements for an assignment of the right (see Maibaum, §67, §68). According to Wieczorek, this reasoning was widely accepted in the (German) literature (Wieczorek, *Die Unionspriorität im Patentrecht*, 1975, p.144).

The reasoning of Maibaum in §271, last sentence, that the priority right is governed by the law of the country of first filing, can not be followed, if only because it is no further explained.

Similarly, the German decision concluding that the law of the country of first filing applies, thereby departing from a century of case law (BGH X ZR 49/12 *Fahrzeugscheibe*, reasons 12), is remarkable for the brevity of its reasoning, which consists of a string reference to a number of handbooks. It may be added that the court in *Fahrzeugscheibe* applied Art. 33(2) EGBGB which referred to “*das Recht, dem die übertragene Forderung unterliegt*” such that the question appears to have been in substance exactly the same as in KPA 16.12.1905.

The practical difficulty that the parties may not yet have decided in which countries subsequent applications are to be filed at the time of assignment of the priority right, cannot alter the fact that a priority right that is to be invoked before the EPO is established and governed by the EPC. This observation can therefore not be decisive.⁹

38. In my view conflict-of-law rules and principles, therefore, identify the *lex loci protectionis* of the subsequent application as the national law which governs the question of whether the transfer of the priority right is valid.

⁸ Idem: Court of Appeal The Hague 30.07.2019, ECLI:NL:GHDHA:2019:1962, point 4.9 of the reasons in translation: “The right of priority is therefore not, as the parties seem to assume, a right conferred by the legal system of the country where the priority application is filed”.

⁹ See Court of Appeal The Hague 30.07.2019, ECLI:NL:GHDHA:2019:1962, point 4.16 of the reasons; but see Benkard/*Grabinski* EPÜ 3rd ed. Art.87 §5.

B.II. Supranational law as lex loci protectionis and further reference to a law of an EPC contracting state

39. However, in the case at hand, the subsequent application was filed with the EPO and the relevant priority right is the one to be invoked before the EPO, which is created by the EPC. Hence, the EPC would be the applicable law under Art. 14(2) Rome I Regulation. The EPC, however, does not provide for substantive rules regarding the assignment of the priority right beyond indicating the assignability (Maibaum, §194).¹⁰
40. This is not an uncommon problem for unitary supranational rights. The priority right at issue is such a unitary right in the proceedings before the EPO, i.e. it can not be invalid for some designated states and valid for other designated states.
41. There are various examples of federal states or supranational organizations establishing unitary rights at the federal or supranational level while having different systems of property and contract law in different territorial units. Examples are Art. 7 of the Unitary Patent Regulation (EU 1257/2012); Art. 19 of the EU Trademark Regulation (EU 2017/1001) and Art. 27 EU of the Community Design Regulation (EU 6/2002).

It may be added that Art. 7 of the Unitary Patent Regulation is based on Art. 39 of the Community Patent Convention 1976 which was also the predecessor to the comparable provisions in the EU Trademark Regulation and the EU Community Design Regulation. This set of provisions hence shows a European consensus on the matter.

42. Following the proposal of Ruhl, *Unionspriorität*, 2000, p.99, Art. 7 of the Unitary Patent Regulation can be applied by analogy. However, because the priority right is an unregistered right, it could be argued that only Art. 7(3) Unitary Patent Regulation can be applied, such that the law of the headquarters of the European Patent Organisation is applicable, i.e. German law. This means that a tacit transfer is possible (§398 and §413 German Civil Code).

An alternative approach can be found in Art. 27(2) EU Community Design Regulation for unregistered community designs.

B.III. Internal vs. external conflict-of-law rules

43. Identifying the applicable law in the context of supranational unitary intellectual property rights appears to fall outside the field of international conflict-of-laws rules (cf. Art. 22(2) Rome I Regulation). Indeed, the co-existence of Art. 7 Unitary Patent Regulation (and the corresponding provisions for EU trademarks and design rights)

¹⁰ This also plays a role if BGH X ZR 49/12 *Fahrzeugscheibe* were to be followed and the priority application is a European patent application.

with the Rome I Regulation, confirms that both deal with different kinds of conflict-of-laws rules, notwithstanding Article 22 Rome I Regulation.

An analogy can be made with USA law. Because the USA is a federal state, it has both interstate and international choice-of-law (or conflict-of-law) rules, e.g. rules to determine if a matter is governed by domestic or foreign law, rules to determine, if domestic law applies, whether federal law or state law applies, and rules to determine, if state law applies, which state's law applies (cf. T 1103/15, r.1.7).

In the appeal case at hand, similarly, these three types of conflict-of-law rules need to be applied: whether foreign or domestic law applies, domestic law being the *lex loci protectionis*, if domestic law applies, whether the matter is governed by the EPC or by the law of an EPC contracting state, and if the law of an EPC contracting state is to be applied, which one.

The first type may be referred to as an *external* conflict-of-law rule; the third type as an *internal* conflict-of-law rule.¹¹ Indeed, one of the characteristics of the Rome I Regulation, which provides external conflict-of-law rules, i.e. not for purely domestic cases, is the universal application (Art. 2 Rome I Regulation), i.e. the designated law can be that of a non-EU state, whereas Art. 7 Unitary Patent Regulation, which provides internal conflict-of-law rules, can only designate the law of a participating state.¹²

44. It must be observed that internal and external conflict-of-law rules start from a different premise, i.e. address a different kind of problem.

In particular, external conflict-of-law rules (e.g. as in the Rome I Regulation) are to be applied as soon as a case has an international aspect, i.e. is not completely domestic. Even if domestic law provides a clear substantive rule on the issue, the court seized may have to apply a foreign law under an external conflict-of-law rule. For external conflict-of-law rules, it is completely irrelevant whether the designated law provides for a clear rule on the substantive issue or not (but it is assumed that the designated law answers all substantive issues, even if there are no statutory provisions in said law).

On the other hand, internal conflict-of-law rules are to be applied *only* if it is concluded that the supranational instrument does not regulate the matter at hand.¹³

¹¹ The second type may be seen as a vertical conflict-of-laws rule.

¹² Incidentally, J 8/20, r.4.2.2 seems to find implicitly that the EPC governs the matter under Art. 60(1) EPC (first type conflict-of-laws rule) and to decide that recourse is to be had to national law for certain issues, such as the validity of a transfer because of lack of substantive provisions on those issues in the EPC (second type conflict-of-laws rule, see in particular §5 of r.4.2.2). In other words, if Article 60(1) EPC would have required a written assignment for a transfer, there would be no further reference to a national law. Hence, the national court seized with the issue should identify the applicable substantive rules (applicable to the right of Article 60(1) EPC as an object of property) by applying some internal conflict-of-law rules, i.e. rules of the third type, analogous with Art. 7 Unitary Patent Regulation.

¹³ Cf. Art. 27(1) Community Design Regulation, initial clause; Art. 19(1) EU Trademark Regulation, initial clause; Art. 39(1) Community Patent Convention 1976, initial clause.

Moreover, internal conflict-of-law rules of a federal state are also to be applied if the case is completely domestic to the federal state, namely if the matter is governed by state law rather than federal law.

It is therefore observed that the inclusion of substantive provisions in the EPC (or in secondary legislation) specifying the manner of assignment of priority rights may obviate the application of internal conflict-of-law rules.

B.IV. Application of law to the specified facts

45. If the EPO is to apply national law to determine the validity of a tacit transfer of a priority right, such national law determines not only whether a tacit transfer is possible, but also the conditions. Application of such national law in a particular case seems beyond the scope of a referral to the Enlarged Board.
46. Only in case an autonomous interpretation of Article 87 EPC is used to determine whether a tacit transfer is possible and if so, under what requirements, can the question be answered whether the facts specified in Question II are sufficient to conclude that a tacit transfer of the priority right occurred.
47. For such a case of autonomous interpretation, I submit that permission of the proprietor of the priority right to file the subsequent application and to claim the benefit of priority for that subsequent application should be treated as a tacit transfer of the priority right. Such permission can also be given in advance, i.e. even before the filing of the priority application, e.g. in an employment contract wherein an employee agrees that all patent applications for inventions made by the employee as part of the employment will be made by and for the benefit of the employer, or by an employee implicitly or explicitly consenting to the filing of patent applications by the employer for the employer's own benefit.

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48. The above observations are my personal views only.

Respectfully submitted,

/ Peter de Lange /

c/o V.O. Patents & Trademarks
Utrecht, The Netherlands

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