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Boards of Appeal
of the European Patent Office

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via fax

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Amicus Curiae brief – G 4/19

It is our view that the questions referred to by Board 3.3.01 in T 318/14 may need to be extended in order to clarify further potential scenarios which may arise with double patenting.

Namely, the issue at stake in T 318/14 may not have allowed or motivated the referring Board to draft further questions. Indeed, while the case at stake in T 318/14 concerns double-patenting of an internal priority situation, further issues with double patenting may arise with a parent and divisional application.

Accordingly, we propose to extend the questions posed by Board 3.3.01 as follows:

- Question 1 referred to the Enlarged Board in T 318/14 is proposed to be furthered as follows (amendments are underlined):

- 1a. Can a European patent application be refused under Article 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 Articles 54(2) and (3) EPC?

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1b. Can a European patent application be refused under Article 97(2) EPC if it claims subject-matter which encompasses¹ claimed subject-matter of a European patent granted to the same applicant which does not form part of the state of the art pursuant to Articles 54(2) and (3) EPC?

- Question 2.1 referred to the Enlarged Board in T 318/14 is proposed to be furthered as follows (amendments are underlined or struck-through)

2.1 If the answer to ~~the first~~ question 1a or 1b 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?

- New Question 2.2 is proposed (amendments are underlined):

2.2 If the answer to either question 1a or 1b is no, is it nevertheless necessary in view of the established practice of EPO's first-instance departments to avoid the prohibition on double patenting?

- New Question 2.3 is proposed:

2.3 If the answer to question 2.2 is yes, is it an appropriate measure to avoid the prohibition on double patenting by the introduction of a disclaimer for overlapping or identical subject-matter between a granted patent and a EP-patent application?

¹ For example, the granted patent has an Independent claim 1 which relates to a composition comprising product X. Dependent claim 2 further characterizes the composition to comprise product X and product Y. The divisional application has an Independent claim 1 which relates to a composition comprising product X and product Y. Thus, the divisional application encompasses claimed subject matter of the granted patent.

- Question 2.2 referred to the Enlarged Board in T 318/14 is proposed to become Question 2.4 (amendments are underlined or struck-through):

2.4 In particular, in case ~~the last of these cases~~ of question 2.1 c) 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?

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