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Żyrardów, 24 September 2020

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Ref: Referral no. G 4/19

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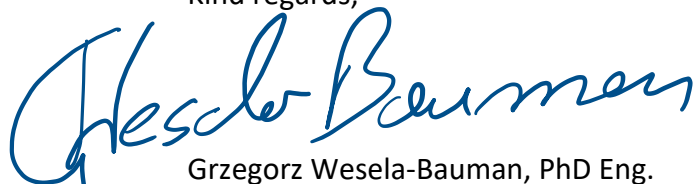
To: Mr Nicolas Michaleczek

Re: Third party statement / amicus curiae brief regarding G 4/19 (double patenting)

Dear Mr Michaleczek

In response to the Communication from the Enlarged Board of Appeal concerning case G 4/19, published in OJ EPO 2020, A66, on the basis of Art. 10 of the Rules of Procedure of the Enlarged Board of Appeal (OJ EPO 2015, A35) I hereby submit third party statement regarding referral number G 4/19.

Kind regards,


Grzegorz Wesela-Bauman, PhD Eng.

Attachments:

third party statement regarding referral number G 4/19

Third party statement regarding referral number G 4/19
Grzegorz Wesela-Bauman, PhD Eng., grzegorz.wesela-bauman@pirp.org.pl

**Third party statement regarding
referral number G 4/19
(double patenting)**

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I. Introduction

Impact of this referral

- 1.1. An application no. 10718590.2¹ (hereinafter referred to as “**the application**”) which has led to the referral in question is pertaining to a second medial use which is a subject of interest of chemist as myself. However, the matter of double patenting is much broader and can be found in patent applications from every field including, but no limited to, chemical, pharmaceutical, computer-implemented invention or mechanical.
- 1.2. From 2014 to 2018 each year between 8 000 and 10 000 patent applications were published while claiming internal priority². Assuming that this trend continues on and knowing that around 150 000 applications were published each year from 2014 to 2018, one might say that about 6% of all patent applications claim internal priority and, in theory, can be examine in view of compliance with prohibition on double patenting.
- 1.3. Therefore, the scope of this referral is, most likely, one of the broadest in terms of number of applications. The fundamental importance of this referral was also recognized in the interlocutory decision of T 318/14 (see Reasons point III. 16. therein).
- 1.4. For the above-mentioned reasons, I hereby fully support the intention of the Board of Appeal 3.3.01 of the European Patent Office (hereinafter referred to as “**the EPO**”) to clarify the practice of dealing with double patenting. Clarification in this referral may also help to clarify national practices on this matter.
- 1.5. In the end, as stated in grounds of the decision for referral G 3/08, point 7.2.5 of the Reasons:

“interpretation of the EPC is primarily the responsibility of the Boards of Appeal.”

¹ Entitled “*Prevention and Treatment of Allergic Diarrhoea*”, published under EP 2 429 542. Appeal number T 318/14.

² According to data available from an analysis of the EPO’s Bulletin.

II. Legal principle before the referral

1. The current practise of the EPO

Source of the current practise

- 1.1. The current practice of the first instance proceedings is described in the Guidelines for Examination in the EPO version November 2019 (hereinafter also referred to as “**the GL**”) in chapter G-IV, 5.4. The most important passages from the GL will be briefly mentioned below as they are important for this statement.

Lack of clear legal basis

- 1.2. The GL mentions that the European Patent Convention (hereinafter referred to as “**the EPC**”) does not deal with double patenting. It is also stated that the principle of refusing applications following prohibition of double patenting is recognized in the Contracting States to the EPC and was introduced into the EPO practice via *obiter dictum* in referrals G 1/05 and G 1/06.
- 1.3. The GL points that applications claiming same subject-matter as granted European patents should be refused under Art. 97(2) EPC in conjunction with Art. 125 EPC. Therefore, the GL indicate that refusal is due to an incompatibility with the EPC (Art. 97(2) EPC).
- 1.4. In other words, in the light of the current practice applications are refused due to incompatibility with the EPC despite that the EPC does not deal with double patenting during examination. This matter will be discussed more in-depth further in this statement.
- 1.5. The lack of clear legal basis for refusing applications is one of the important aspects of this referral. In this regard, the matter of reference to the general principle (Art. 125 EPC) forms another layer of this referral.

Lack of definition of the same applicant

- 1.6. The cited GL points that prohibition pertains to the same applicant. The identity of an applicant is obvious when we are discussing natural persons. However, there is no clarity on how to identify identical legal persons for the purpose of double patenting. E.g. is a subsidiary should be treated as identical as the parent company or not or is identity related to number of shares.
- 1.7. The legal definition of same person at least for the purpose of double patenting should also be part of this referral.

Conclusions

- 1.8. The current practise of the EPO with respect to double patenting is based on refusing applications due to incompatibility with the EPC despite the EPC does not deal with double patenting during examination (i.e. on basis of Art. 97(2) EPC).

- 1.9. There is no clear guidance on identifying identical legal persons which leads to problems in application of prohibition of double patenting to legal persons.

2. Impact of the current practise on the application

The same subject-matter

- 2.1. The Examining Division found that claim 1 from the application is identical to the granted patent no. 2 251 021³. This patent is a priority for the application. It should be noted that it is explicitly stated in the GL, G-IV 5.4 that double patenting may occur in connection with a priority claim.
- 2.2. It follows that the first instance understands the prohibition of double patenting from the GL as prohibition of grant for the application having at least one claim claiming same subject-matter and a granted patent. This understanding seems to be in line with the GL which mention the same subject-matter.

The legal basis

- 2.3. The legal basis invoked in the grounds of the negative decision refusing grant and dated September 26, 2013 were the same as in the GL, i.e. Art. 97(2) EPC in conjunction with Art. 125 EPC. Therefore, the Examining Division followed the GL and refused a patent due to incompatibility of the application with the EPC⁴.

The same applicant

- 2.4. The application was filed in the name of Nestec S.A. and the priority application was also filed in the name of Nestec S.A. Therefore, the same entity was mentioned in the application as applicant as in the priority as the proprietor. However, in the course of the appeal proceedings the application was transferred to Société des Produits Nestlé S.A.
- 2.5. The transfer occurred between two legal entities. This opens the question of if the applicant is still the same. It seems not, but, again, there is no test for differentiating of two legal entities. Assuming that these two legal entities are different applicants, the patent should now be granted for the application. That is, even if the granted patent will be re-transferred post-grant again to Nestec S.A. effectively leading to validation of the granted European patent for the same proprietor and for the same subject-matter as previously granted patent.

³ The Examining Division refused grant despite different wording of claims, i.e. the priority claims “for treating and preventing” and the application claims “for use in treatment and prevention”. There is no indication that this difference in wording pertains to a different scope of protection.

⁴ In the annex to the communication dated July 2, 2013, the Examining Division indicated that the application did not meet the requirements of the EPC.

Appeal and the referral

- 2.6. A negative decision for the application was issued on September 26, 2013 and an appeal was filed on November 26, 2013. During the proceedings before the Board of Appeal three questions were referred to the Enlarged Board of Appeal.

The questions

- 2.7. The following questions were referred to the Enlarged Board of Appeal:

Q1: *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?*

Q2.1: *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?

Q2.2: *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?"*

- 2.8. Said questions will be analysed in the next chapter. Subsequently, an analysis of admissibility of the referred questions will be given. Finally, a set of suggested answers to the questions will be presented.

III. Analysis of the questions

1. Purpose of this chapter

- 1.1. This chapter is devoted to analysis of the scope of the questions. Interplay as well as possible redundancies between the questions is discussed. A possible way of rephrasing selected questions is also presented.
- 1.2. Suggested answers to the questions with a discussion are presented in the subsequent chapter.

2. The first question (Q1)

The legal basis

- 2.1. The first question (hereinafter also referred to as “**the Q1**”) effectively tries to establish if Art. 97(2) EPC can be considered to be the legal basis for a refusal. It should be noted that the Q1 does not invoke Art. 125 EPC and, thus, said question itself diverges from the GL and from the grounds of the decision which lead to this referral. Specifically, the GL and the grounds indicated Art. 97(2) in conjunction with Art. 125 EPC (see chapter G-IV, 5.4) as the legal basis.
- 2.2. The question does not consider a possibility to refuse a patent due to double patenting using a different legal basis (e.g. Art. 125 EPC).

The conditions for refusal

- 2.3. The first question also indicates conditions which are to be met by an application to be refused due to prohibition of double patenting. These conditions are:
 - *same* subject-matter, and
 - *same* applicant as already granted European patent, and that
 - the already granted European patent *cannot be* prior art under Art. 54(2) and Art. 54(3) EPC.
- 2.4. The first condition, the same subject-matter, can be understood in line with the current practice, i.e. where the claim to be refused has the same scope of protection as already granted claim. An alternative interpretation can be envisaged, i.e. that any invention falling under the scope of the claim to be refused cannot be claimed in another patent owned by the same applicant. The former scenario is more reasonable as it can be examined in a straight-forward fashion whereas the latter requires deliberation on a scope of protection and thus consultation of the description (cf. Art. 69(1) EPC). Therefore, the same scope of protection is the test for the same subject-matter.
- 2.5. The second condition, the same applicant, becomes difficult to examine when it comes to legal persons / legal entities. Will applicant be the same in case of

transfer of an application between a subsidiary and a parent company or between two subsidiaries? There is also a matter of selling companies or mergers.

- 2.6. The third condition, not being prior art under Art. 54(2) and (3) EPC, seems straightforward even though it is constructed as a negative sentence and not as positive (similar to a disclaimer). It seems that this condition effectively excludes prior art as defined in the EPC and, hence, there is no collision with examination done under Art. 52(1), Art. 54(1) and Art. 56 EPC.

Conclusions

- 2.7. The first question is difficult to be answered directly as any possible answer would require providing definitions of the same applicant in case of legal entities. Also, this question in its current form does not allow for refusing of patents due to prohibition of double patenting on a different legal basis.

Rephrasing of the Q1

- 2.8. It seems that the Q1 could be rephrased to:

“Can a patent be refused for a European patent application on the grounds of prohibition of double patenting?”.

An answer to such question would not require deliberation on legal basis. Additionally, the Q1 in this reformulated form does not require deliberation on definition of the same applicant in case of legal entities.

- 2.9. Rephrasing questions was already made in another referral, i.e. G 3/19. Therefore, since rephrasing of questions was admissible therein it has to be admissible herein as well.

3. The second question (Q2.1)

Dependency on the first question (Q1)

- 3.1. In the present form, an answer to the second question (hereinafter also referred to as “**the Q2.1**”) can only be given if the answer to the first question is “yes”. In other words, the second question requires accepting that the legal basis for refusal is Art. 97(2) EPC (only).
- 3.2. The dependency in the second question on the Q1 should be sustained, however only if the Q1 would be rephrased as indicated above.

The conditions for refusal

- 3.3. The second question asks about the conditions for refusal. However, the Q1 as originally formulated already provides conditions for refusal, i.e. same subject-matter, same applicant as already granted European patent and that the European patent cannot be prior art under Art. 54(2) and (3) EPC. Therefore, a positive

answer to the Q1 already gives answer to the Q2.1. I believe that this was not the intention and this redundancy can be solved by rephrasing the first question.

The conditions for refusal for specific types of applications

- 3.4. I fully support that the Q2.1 explicitly mentions specific types of applications in which double patenting may occur. Thereby, answer to the Q2.1 must take them under the account even if only in *orbiter dictum*.
- 3.5. This is especially important since without mentioning specific types of applications, types (a) (same filing date date) and (b) (divisional application) would be treated the same since as by virtue of Art. 76(1) EPC any divisional application has the same filing date as its parent (i.e. formally point a) comprises point b)).
- 3.6. The third type of application, i.e. with priority claimed under Art. 88 EPC is especially important. The situation described in point (c) pertains to "*internal priority*".
- 3.7. It should be underlined that the Paris Convention did not envisaged claiming of internal priority as it only allows for claiming of priority for applications filed in a different country. This has two major consequence. The first is that there are no regulations in the Paris Convention dealing with double patenting occurring by priority claim. The second is that it is up to a national legislation to introduce the internal priority to patents since this type of priority is not part of the Paris Convention. As a result, conclusion of this referral may also have an impact on national practice of dealing with double patenting in cases of internal priority.

Conclusions

- 3.8. In the present form the second question asks about conditions for refusal which are already given in the first question. However, if the first question is rephrased to

"Can a patent be refused for a European patent application on the grounds of prohibition of double patenting?",

the second question does not require rephrasing.
- 3.9. It is highly beneficial that the second question explicitly asks about applications filed on the same date, divisional applications and applications with internal priority. This referral has to take these types of applications under the account.
- 3.10. Clarification when it comes to double patenting in internal priority is important also for national practice, especially when the possibility of claiming internal priority was introduced recently.

4. The third question (Q2.2)

- 4.1. The third question (hereinafter referred to as “Q2.2”) also pertains to applications claiming so called “*internal priority*”. Internal priority occurs when two applications having the same territorial scope (e.g. European patent applications having effect in the same contracting states⁵) are claiming priority one from another. The second application (i.e. the one filed later) claims priority from the first one (the earlier one) and this type of priority is called internal priority.
- 4.2. This question mentions a legitimate interest. There is no definition in the EPC of a legitimate interest. The reasons of the decision in T 318/14 (point II 7) points that a legitimate interest is a principle of a procedural law. As explained therein, a legitimate interest requires that the result intended to be achieved by a request be reasonable and acceptable in law.
- 4.3. The third question aims at establishing whether there is a legitimate interest in grant of a patent claiming internal priority. The result of internal priority is an extension of protection term for an invention up to 12 months (i.e. by the priority period). Therefore, for answering the third question it has to be discuss and analysed whether extension of term of protection for an invention by claiming internal priority is reasonable and acceptable by law.
- 4.4. There are two possible interpretations of this question and its relation to the prohibition of double patenting:

- assuming that the prohibition of double patenting is a part of the examination before the EPO, a legitimate interest in extending the term of protection can form an exception to this prohibition.

In other words, assuming that every application infringing prohibition of double patenting will be refused by the EPO, the applications claiming internal priority should be exceptionally allowed for grant,

or

- assuming that the prohibition of double patenting is not a part of the examination before the EPO, a lack of legitimate interest in extending the term of protection can form a separate obstacle in granting patents.

In other words, assuming that applications are not examined on compliance with the prohibition of double patenting by the EPO, the applications claiming internal priority should either way not be allowed for grant by the EPO.

⁵ For the discussion of the territorial scope, see VI. Secondary remarks.

Conclusions

- 4.5. This question requires analysis of whether extension of term of protection by up to 12 months for an invention by claiming internal priority is reasonable and acceptable by law.
- 4.6. The third question offers a possibility to limit the extent of prohibition of double patenting by allowing to grant a patent if a party is seeking extension of term of protection for an invention by the use of internal priority or the third question is about another obstacle in granting patents claiming internal priority which is not related to prohibition of double patenting, i.e. the lack of legitimate interest.

5. Conclusions from the analysis of the questions

The first question (Q1)

- 5.1. The first question already diverges from the GL and from the decision which lead to this referral and asks if only Art. 97(2) EPC can form the basis for refusal due to double patenting. (i.e. the GL and the grounds of the decision mention Art. 97(2) in conjunction with Art. 125 EPC). Additionally, in such a formulated question there is no room for suggesting a different legal basis for refusal due to double patenting, i.e. a negative answer to this question might be due to disagreement with the selected legal basis rather than with the fact that patents should be refused in general due to prohibition of double patenting.
- 5.2. This first question may be rephrased to *“Can a patent be refused for a European patent application on the grounds of prohibition of double patenting?”*. Rephrasing was considered to be admissible in G 3/19 and, thus, should be admissible in this referral.
- 5.3. The first question mentions also 3 conditions for an application to be refused (i.e. same subject-matter, and same applicant as already granted European patent, and that the already granted European patent cannot be prior art under Art. 54(2) and Art. 54(3) EPC.) It seems that effective answer to this question will require providing explanations to what the same applicant is in case of legal entities.

The second question (Q2.1)

- 5.4. The second question asks about conditions for refusal despite that it depends on the first question and that the first question already defines conditions for refusal (i.e. same applicant, same subject-matter etc.). It follows that a positive answer to the first question already forms a part of an answer to the second question. This seems redundant. Rephrasing the first question (Q1) as suggested above will solve this redundancy.
- 5.5. This question asks also if the conditions are different for applications with same filing date (including divisional applications, which by virtue of Art. 76(1) have

always date of filing of their parent applications) or claiming so called internal priority under Art. 88 EPC.

- 5.6. Conclusion of this referral for applications with internal priority may affect national practice since only by national legislation internal priority can be claimed (the Paris Convention allows only for claiming external priority). This may be especially relevant for jurisdiction in which the possibility of claiming internal priority was introduced recently.

The third question (Q2.2)

- 5.7. The third question is focused solely on applications with internal priority. It does also invoke a legitimate interest, which was not defined in the EPC. In view of the definition of a legitimate interest invoked in the Reasons of the decision in T 318/14, the third question requires analysis of whether extension of protection for an invention by the priority period is reasonable and allowable in law.
- 5.8. This question is about a possibility of granting an exception to prohibition of double patenting when the applicants tries to extend the protection by filing another application for the same invention while claiming internal priority or about prohibiting grant due to a lack of legitimate interest in granting patents to applications claiming internal priority.
- 5.9. The answer to the third question does not depend on the questions Q1 and Q2.1. Therefore, any answer given to these questions should not influence any answer to the third question (Q2.2).

IV. Admissibility

1. Introduction

- 1.1. This referral was made during pending appeal proceedings and following a request from the applicant. Additionally, as mentioned in point I.1 of this statement (impact of this referral), this referral can affect ca. 6% of all patent applications examined by the EPO. Therefore, due to its impact, answer to this referral forms a fundamentally important point of law.

2. Questions Q1 and Q2.1

- 2.1. Due to said redundancy in the Q1 and the Q2.1 when it comes to the conditions for refusal, it seems that after reformulating the Q1 into *“Can a patent be refused for a European patent application on the grounds of prohibition of double patenting?”* the reformulated Q1 will be admissible as a response to this question will affect the decision under the appeal.
- 2.2. The Q1 as originally formulated is not admissible as it asks about a refusal under Art. 97(2) EPC only and thus not about the actual grounds under which the application was refused (i.e. Art. 97(2) EPC in conjunction with Art. 125 EPC). Therefore, any answer to this question is not applicable to the facts of the case.
- 2.3. The Q2.1 is admissible in part relating to conditions for refusal. Indicating a proper legal basis as a part of the answer to Q2.1 will influence the decision under appeal.
- 2.4. It seems that points a) and b) in the Q2.1 are not admissible as they are not relating to the facts of the case and, thus, any answer to them will not affect the decision under appeal.
- 2.5. Admissibility of point c) in the Q2.1 is not clear as it is not clear whether we have the same applicant or not. Depending how the Board defines a test for differentiating legal persons, this question may be admissible (if the applicant is the same as in the priority application) or inadmissible (if the applicant is different).⁶

3. Question Q2.2

- 3.1. The third question (Q2.2) is admissible as it pertains to the facts of the case as the application is a subsequent application having a different filing date and same priority date.

⁶ The double patenting occurs when there is the same applicant for an application as the proprietor of already granted patent. During the proceedings, the application has been transferred from one legal entity to another. Therefore, if it will be considered that said two entities are different applicants, the application no longer infringes the prohibition of double patenting. Hence, if the applicants are different, this referral is inadmissible as prohibition of double patenting is no longer relevant for the case.

- 3.2. Assuming that the application will fall under prohibition of double patenting, a legitimate interest may allow for excluding this application from prohibition and allow for grant. Alternatively, assuming that the application will not (for any reason) fall under prohibition of double patenting, a lack of legitimate interest may still prohibit granting of a patent for the application.
- 3.3. Hence, any answer will have an impact of the decision under appeal.

4. Conclusions

- 4.1. The Q1 as originally formulated is not admissible.
- 4.2. The reformulated Q1 into *“Can a patent be refused for a European patent application on the grounds of prohibition of double patenting?”* is admissible.
- 4.3. In the Q.2.1, point c) may be admissible and this depends on definition of legal person. Points a) and b) are not admissible. Specifically, points a) and b) are not related to the facts of the case and any answer to them will not affect the decision under the appeal.
- 4.4. The Q.2.2 is admissible as an existence or a lack of existence of legitimate interest will have an impact on the decision under the appeal.

V. Suggested answers to the questions

1. The first question (Q1) as originally formulated

- 1.1. This question is inadmissible as presented above. However, some comments on any possible answer will be given.

Refusal vs withdrawal

- 1.2. The Q1 indicates Art. 97(2) EPC as the legal basis for refusal. The provision of this article is refusal of a grant due to incompatibility with the EPC, unless this Convention provides for different legal consequences. The EPC does not provide any consequences for infringing prohibition of double patenting and, thus, only consequences that is left under Art. 97(2) EPC is refusal.
- 1.3. It seems however that refusal of grant is not a proper response for a request to grant a patent infringing prohibition of double patenting. A refusal in the EPC is when the application does not satisfy either formal or substantive requirements listed in the EPC. For example. Art. 90(5) EPC refuses application due to incompatibility with formal requirements while Art. 97(2) EPC refuses application due to incompatibility with substantive requirements.
- 1.4. On the other hand, an application is withdrawn when an applicant fails to perform a procedural step. For example, application is withdrawn if no translation is filed under Art. 14(2) EPC or no response is given to an invitation under Art. 94(4) EPC or if no renewal is paid under Art. 86(1) EPC.
- 1.5. In view of the above, since the EPC does not have a substantive provision pertaining to the prohibition of double patenting in examination, a refusal due to incompatibility with the EPC is not a proper response to a request for granting a patent infringing prohibition of double patenting.
- 1.6. Under the current practice, an applicant is invited to limit his application such that said application will not infringe prohibition of double patenting. Therefore, failure to response to this invitation should, in view of the examples given above, yielded a withdrawal of said application and not refusal. It follows that Art. 97(2) EPC cannot be used and thus a negative answer should be given to the first question as originally formulated.

Res iudicata

- 1.7. The *res iudicata* doctrine pertains to a procedural step in which a court or an administrative body discards a request to initiate the proceedings for a case for which the proceedings were already concluded. In other words, from the standpoint of code of administrative and civil proceedings, *res iudicata* is a procedural principal and not a substantive one. Therefore, Art. 97(2) EPC which is connected with examination of substantive / formal requirements does not

pertain to the doctrine of *res iudicata*. It follows that said doctrine cannot be invoked under Art. 97(2) EPC and thus a negative answer to the first question is given.

- 1.8. Article 125 EPC refers to general principals of procedural law which are recognized in the Contracting States. The doctrine *res iudicata* is recognised among the Contracting States and, as mentioned, pertains to a procedural step. Therefore, under Art. 125 EPC *res iudicata* could be introduced into the EPC. However, Art. 125 EPC is not part of the Q1 and, hence, a negative answer should be given to the first question.

Conclusion

- 1.9. Refusal is not an appropriate response for an application infringing the prohibition of double patenting and such an application should be considered to be withdrawn in view of lack of appropriate response to an invitation to exclude from this application subject-matter which infringes the prohibition of double patenting. As a result, Art. 97(2) EPC is not adequate legal basis.
- 1.10. The prohibition of double patenting can be introduced via doctrine of *res iudicata*, but said doctrine is a part of procedural law and, thus, outside of scope of refusal under Art. 97(2) EPC. It seems that said doctrine could be introduce via Art. 125 EPC.
- 1.11. **Therefore, an answer to the Q1 as originally formulated is NO.**

2. The first question (Q1) as reformulated

- 2.1. The first question (Q1) when reformulated into

“Can a patent be refused for a European patent application on the grounds of prohibition of double patenting?”

asks whether prohibition of double patenting should form part of substantive examination or whether enforcing of this prohibition should be left to the Contracting States.

- 2.2. It follows that there are two possibilities: a substantive examination by the EPO or a national examination by the Contracting States.

Examination by the EPO

- 2.3. Examination of applications on compliance with prohibition of double patenting, without any doubts, elongates the procedure and, thus, the public is left longer without a decision. At the same time, the applicant even having a positive opinion with regards to novelty and inventive step cannot be sure if the grant will be issued. Therefore, sustaining central examination by the EPO is not beneficial for the paste of examination and for the legal certainty of the public.

- 2.4. The examination is made *ex officio* and, thus, it creates additional burden on the Examining Divisions to establish whether there is a European patent with at least one claim claiming same subject-matter as the examined application. Sustaining examination of prohibition of double patenting by the EPO will be another (in addition to clarity) statutory requirement not taken under the account during opposition proceedings.
- 2.5. The prohibition of double patenting is examined at the last stage of substantive examination, i.e. before grant, and, thus, can easily be by-passed by transferring of application to another legal / natural person until the decision to grant is issued. After that, the application can be re-transferred back effectively leading to validation of patent violating prohibition of double patenting.⁷

National examination

- 2.6. A national examination of compliance with the prohibition of double patenting leads to a faster examination before the EPO as it does not put an additional burden on Examining Divisions.
- 2.7. Examination at a national level does not leave much room for by-passing of said prohibition by transferring of an application shortly before grant and then re-transferring after grant.
- 2.8. It would be easy to implement a national examination of the prohibition of double patenting by application of Art. 139(3) EPC *mutatis mutandis*.
- 2.9. Finally, each Contracting State would be able to decide if and on which conditions allow for patents infringing prohibition of double patenting.

Conclusion and final remarks

- 2.10. Examination of compliance with prohibition of double patenting can be done either by the EPO or at a national level.
- 2.11. Examination of this prohibition by the EPO seems not favourable as it:
 - elongates examination and increase legal uncertainty,
 - forms another difference in examination done by Examining Divisions and Opposition Divisions since the prohibition is not a ground for opposition under Art. 100 EPC, and
 - is easy to by-pass by simple transferring of an application before grant and re-transferring of the application shortly after the grant, but before validation period ends.
- 2.12. Examination at a national level does not have the above-mentioned drawbacks and allows each Contracting State to decide if and on which conditions allow for

⁷ Transfer can be made post-grant following procedure under R. 85 EPC implementing Art. 71 EPC.

patents that infringe the prohibition of double patenting. Additionally, this would be easy to implement by application of Art. 139(3) EPC *mutatis mutandis*.

2.13. It follows that, European patent application should not be refused a grant due to prohibition of double patenting. **Therefore, the answer to the first reformulated question is NO.**

2.14. To back-up this, one could argue that the EPO may require to indicate in the description of a patent application any application which would be relevant for examination of compliance with double patenting, i.e. application / patents which claims same subject-matter and granted for the same applicant and which does not form part of the states of the art under Art. 53(2) and (3) EPC.

3. The second question (Q2.1)

3.1. As discussed, the second question in points a) and b) is inadmissible.

3.2. Since the second question relies on a positive answer to the first question, **the answer to the second question is NO.**

4. The third question (Q.2.2)

4.1. This question relates to double patenting originating from claiming internal priority from another European patent application.

4.2. Filing of another application by the same applicant and claiming priority is reasonable and acceptable by the EPC. Therefore, an applicant has a legitimate interest in performing these acts. This does not change when the priority application is the same as the subsequent application claiming priority.

4.3. In particular, Art. 88(4) EPC mentions a disclosure of a specific element and, hence, sets a lower limit for granting priority claim (i.e. disclosure of at least one specific element), but does not set an upper limit in amount of disclosure. Therefore, Art. 88 EPC allows for having identical disclosure of a priority application and the subsequent application.

4.4. Wording of Art. 63(1) EPC also does not stand in the way of extending the term of protection of an invention by the use of internal priority as both the priority application and the subsequent application will expire in 20 years from their filing dates. Also, Art. 63(2) EPC specifically allows the Contracting States to extend the term of protection as specified in Art. 63(1) EPC and, hence, even assuming that Art. 63(1) EPC establishes prohibition of double patenting, Art. 63(2) EPC allows the Contracting States to grant exception to this prohibition ultimately leading to an extension of term of protection.

4.5. In summary, an applicant has a legitimate interest in obtaining patents infringing prohibition of double patenting by claiming internal priority as both filing and claiming priority are allowable in law and same disclosure of the priority

application and the subsequent application flow from the Art. 88(4) EPC. Additionally, Art. 63(2) EPC allows the Contracting States to extend the term of protection and, thus, support extension of term of protection by claiming internal priority.

- 4.6. It follows that a legitimate interest does not stand in the way of granting patents claiming internal priority and thereby extending the term of protection for an invention.

5. Conclusions

- 5.1. The answer to the **first question (Q1) as originally formed is NO**

since refusal under Art. 97(2) EPC is not a proper response to an application infringing prohibition of double patenting.

- 5.2. The answer to the **first question as reformulated is NO**

since it is more reasonable to leave the decision to the Contracting States
and

since there is no reason to prolong examination before the EPO with examination of compliance with the prohibition on double patenting.

- 5.3. The answer to the **second question (Q2.1) is NO**

since in points a) and b) is inadmissible
and

since this question depends on a positive answer to the first question (Q1).

- 5.4. The answer to the **third question (Q2.2) is YES**

since claiming same subject-matter is required by Art. 88 EPC and, hence, Art, 88 EPC supports internal priority claims

and

extending of term of protection by the Contracting States is envisaged by Art. 63(2) EPC and thus extending of protection is reasonable and acceptable in law.

VI. Secondary remarks

1. Territorial effect relevant for double patenting

- 1.1. Territorial effect is relevant for examination of double patenting.
- 1.2. Definition of double patenting provided in the interlocutory decision T 318/14 is provided using different expressions pertaining to territorial effect. Specifically, in point
 - III. 17 it is mentioned that prohibition is when the granted patents have “*effect in the same territory*”,
 - III. 18 it is mentioned that prohibition occurs when there is an “*overlap in territorial scope*”, and in point
 - III. 21 “*identical or at least overlapping scope*” is mentioned with reference to double patenting.
- 1.3. The expression “*effect in the same territory*” used in the interlocutory decision can be understood differently, depending on the stage at which the application is in the granting process.
 - i. It may be understood in line with Art. 3 EPC, i.e. effect occurs at the time of filing of a request of grant of a European patent and said effect is for all designated contracting states.⁸

It follows that the examination of double patenting can be done by taking under the account the effect of the application on filing date. This examination can be done by Examining Divisions.
 - ii. A designation of a contracting state can be withdrawn under Art. 79(3) EPC and, thus, a European patent application can be examined only for some of the contracting states.

As a result, the examination of double patenting can be done by taking under the account the effect of the application during examination and before grant. Up till grant, this examination can be done by Examining Divisions.
 - iii. The application and the granted patent will lose its effect *ab initio* in line with Art. 65(3) EPC when translation requirements under Art. 65(1) EPC are not met for a given country.

It follows that the examination of double patenting can be done by taking under the account only the Contracting states in which the patent is in force (i.e. has an effect following successful validation). This

⁸ In view of Art. 79(1) EPC all the Contracting states are designated on filing.

examination can only be done by the Contracting States and not by Examining Divisions.

2. Moment at which the examination takes place

- 2.1. The GL, G-IV, 5.4 are underlying that the designation of states in a patent application is relevant for the purpose of examination of double patenting. It seems that the GL are indicating that effect taken under the account is the one mentioned in (ii), i.e. the territorial effect for which a grant is to be issued. This seems not in order.
- 2.2. A strict interpretation of the requirements of territorial effect should allow to grant a European patent for countries in which the earlier patent claiming the same subject-matter was not validated. It flows from the fact that the earlier patent does not have any effect in countries in which there was no validation and thus the subsequent patent can be granted for the remaining territories.
- 2.3. Therefore, any examination of compliance with the prohibition of double patenting should be done after grant and, hence, can only be done by the Contracting States.

3. Conclusions

- 3.1. Examination of compliance with prohibition of double patenting after validation takes place after Examining Divisions lost their power and, hence, this examination can only be done by the Contracting States.
- 3.2. A lack of validation results in lack of effect *ab initio* of a European patent in a given country. Irrespectively of whether prohibition of double patenting will be enforced by the EPO, granting of a subsequent European patent should be allowable for the territories in which the previous patent was not validated.



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