

in referral G 4/19 to the Enlarged Board of Appeal of the EPO

Dear Chair and Members of the Enlarged Board of Appeal,

The following questions were referred in referral **G 4/19** (OJ 2020 A66):

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

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

a) on the same date as, or

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

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

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

1. The referred questions concern double patenting by two or more patents granted by the EPO. The context of the questions in the referral decision T 318/14 includes the following:

“accepting double patenting does not exclude double protection being addressed by means of national legislation. Therefore, it appears that a proper legislative procedure would offer the more favourable context in which to make the choice to prohibit or to allow double patenting in respect of European patent applications” (T 318/14, r.75, fourth paragraph).

2. I will discuss this context of the questions first. I will submit some observations concerning Question 1 in § IV of this letter.

3. The referring Board’s remark that “accepting double patenting does not exclude double protection being addressed by means of national legislation” (r.75) can be interpreted in two ways:

A) Accepting double patenting *by two patents granted by the EPO* does not exclude double protection *between a national patent granted by a national patent office of an EPC Contracting State and a European patent granted by the EPO* being addressed by means of national legislation *of that State*; or

B) Accepting double patenting *by two patents granted by the EPO* does not exclude *that kind of* double protection being addressed by means of national legislation *of the EPC Contracting States*.

4. The first interpretation A) is as such unproblematic, although the sentence perhaps challenges the reader a bit by switching from one kind double protection to another without any notice. Moreover, the relevance (if any) of the second kind of double protection (involving a patent granted by a national patent office) for the present referral (concerning only patents granted by the EPO) is perhaps not immediately evident.
5. However, under the second interpretation B), the referring Board says that EPC Contracting States could prohibit double patenting caused by two patents granted by the EPO in their national patent laws. This is incorrect, in particular in view of the limited scope of Article 139(3) EPC and the ‘maximum approach’ enshrined in the EPC. I will discuss this first in § I and § II. I will briefly discuss the referring Board’s remark in r.61.2 concerning the pre-grant stage in § III.
6. Even though the passage cited above is not part of the referred questions and the Enlarged Board is not required to comment on it, I would like to submit comments on r.75, as it touches on a fundamental principle of the EPC, namely the already mentioned ‘maximum approach’, in other words the understanding that Articles 138-140 EPC give an exhaustive list of grounds for revocation of patents granted by the EPO in national procedures, such that that the Contracting States are prohibited by the EPC from introducing any further grounds for revocation of European patents in their national laws.
7. My view is based on the observation that (i) under the EPC, Contracting States are not free to provide for grounds for revocation of patents granted by the EPO in their national law, unless where the EPC explicitly authorizes so, and (ii) that Article 139(3) EPC, which involves such an authorization, is only concerned with “parallel filing routes”, i.e. the co-existence of patents granted by national patent offices and patents granted by the EPO (as well as the corresponding applications). I will discuss these two issues in respectively § I and § II.

I A role for national law?

8. I will first discuss that the EPC Contracting States are prohibited from introducing in their national laws any grounds for revocation of patents granted by the EPO which are additional to, or different from, the grounds of Article 138 - 140 EPC.
9. This prohibition is based on the ‘maximum approach’ which is enshrined in the final clause –‘unless this Convention provides otherwise’– of Article 2(2) EPC.
10. The ‘maximum approach’ entails that “a European patent can only be declared invalid in the States for which it was granted, by reasons provided for in the European patent law, and not by those provided for in the domestic patent laws” (K. Haertel *IIC* 1970 p.289-306 at p.297, also cited by J. Pila, *Modern Law Review* (72) 2009 p.436-462). The exhaustive character of Article 138(1) EPC is a

principle element of the ‘maximum approach’ which forms a foundation for the EPC (Van Empel, *The Granting of European Patents*, 1975, §58, §651). It may be added that the ‘maximum approach’ is a cornerstone of the legal certainty provided by the EPC for patent proprietors and hence also for the success of the European patent system (cf. Haertel, *op. cit.* p.302, “a large majority of the [user’s] organizations advocated the maximum approach”). In effect, the final clause of Article 2(2) EPC is to some degree the main rule (Stauder in Singer/Stauder/Luginbühl, *EPÜ*, 8th ed., Art. 2, note 4).

11. The ‘maximum approach’ was essentially adopted during the 2nd meeting of the Inter-Governmental Conference held 13-16 January 1970 (BR/26 e/70 page 3, point 8), thereby fundamentally departing from the preparatory work of Working Party I and from the ‘minimum’ approach which was until then followed in the Preliminary Draft (cf. Haertel *op. cit.* p.297).
12. Therefore, under the EPC, Contracting States have no freedom to address double patenting caused by multiple patents granted by the EPO by adding a ground for revocation, nullity or otherwise invalidity in their national patent laws.
13. In the event that double patenting by multiple patents granted by the national patent office is addressed by national law in a Contracting State through a *procedural* provision, such a procedural provision applies equally in (judicial or administrative) proceedings pertaining to European patents in that state in view of Article 64(3) EPC. For instance, suitable national procedural provisions may include mandatory joinder of proceedings, and estoppel. Therefore, nothing in the EPC prevents the Contracting States from addressing possible abuse of procedure by double patenting, also in case of double patenting by two patents granted by the EPO.

For instance, a national court may declare an infringement action inadmissible because of double patenting caused by two or more patents granted by the EPO, or may even award an anti-suit injunction to prevent harassing of accused infringers based on multiple patents for the same invention granted by the EPO.¹

14. In conclusion, EPC Contracting States are prohibited from introducing in their national laws double patenting caused by two patents granted by the EPO as ground for revocation unless Articles 138-140 EPC would permit so, which is not the case as I will now discuss.

¹ See e.g. District Court The Hague, 5 August 2004, ECLI:NL:RBSGR:2004:AQ6495; see also more recently Court of Appeal The Hague 21 April 2020, ECLI:NL:GHDHA:2020:1624, point 4.2.38; both decisions are available through the ECLI search engine at www.ecli.eu.

II Substantive scope of Article 139(3) EPC

15. The referring Board notes in r.78 that Article 139(3) EPC deals with double protection resulting from parallel filing routes for the same territory, and that this matter is left entirely to national law. This observation of the referring Board seems entirely correct. The ‘parallel filing routes’ refer to the European filing route and the national filing route, which coexist under the EPC system. Article 139(3) EPC leaves the Contracting States freedom to regulate the case of double protection from a European patent granted by the EPO on the one hand and a patent granted by a national patent office of a Contracting State on the other hand (or the respective patent applications).
16. However, the referring Board gives a much more sweeping statement in r.73.2 where it says that “Article 139(3) EPC [...] allows the Contracting States complete discretion in how they legislate on double protection”.

In this statement, the discretion of the Contracting States is no longer restricted (or at least not explicitly) to “double protection resulting from parallel filing routes”; i.e. the discretion is no longer restricted to double protection resulting from the coexistence of the European and the national filing routes and appears to also cover double protection by two patents granted by the EPO.

The same applies for the referring Board’s statement in r.75.3 that “[p]reventing double protection, on the other hand, is a matter of national law, and Article 139(3) EPC allows the Contracting States complete discretion in this regard”, in that this statement also appears to cover double protection by two patents granted by the EPO (especially since r.75.3 also refers to “the same subject-matter being claimed twice in a European patent granted to the same person”).
17. Understood in this way, the statements in r.73.2 and r.75.3 are too broad in my view.
18. In the literature contemporaneous with the adoption of the EPC, Article 139(3) EPC is seen as regulating the co-existence of the European and national filing systems. See, e.g., Van Empel, §658, Mathély, *Le droit européen des brevets d’invention*, 1978, p.420-421; and Singer, *Das Neue Europäische Patentsystem*, 1979, p.44: “für prioritätsgleiche nationale und europäische Patentanmeldungen und Patente stellt Artikel 139(3) es den Vertragsstaaten frei, den Doppelschutz zuzulassen oder zu verbieten. Im letzteren Fall kann der Jeweilige Staat dem europäischen Patent oder dem nationalen Patent den Vorrang geben”. Singer further refers to Article 80 of the Community Patent Convention 1976. None of the cited literature suggests that Article 139(3) EPC is about anything else.
19. In conclusion, it is submitted that Article 139(3) EPC deals *only* with double protection resulting from parallel filing routes for the same territory, and only this matter is left entirely to national law in Article 139(3) EPC. Therefore, Article

139(3) EPC does permit Contracting States to introduce double patenting by two or more European patents as a ground for revocation of a European patent granted by the EPO.

20. In conclusion, national legislation of the EPC Contracting States is not a proper legislative procedure in which to make the choice to prohibit or allow double patenting in respect of two or more patents granted by the EPO.

The second sentence of the referring Board's remark in r.75 cited above is hence correct if understood as follows: "it appears that a proper legislative procedure *namely a revision of the EPC, in any case not a national legislative procedure*, would offer the more favourable context in which to make the choice to prohibit or to allow double patenting in respect of *two or more* European patent applications".

III Temporal scope of Article 139(3) EPC: pre-grant and post-grant

21. On a separate note, the referring Board in r.61.2 states that "it is clear from the wording of Article 139(3) EPC that the co-existence of two identical patents is not to be prevented at the pre-grant stage, but only after the grant of a European patent".
22. This analysis in r.61.2 is not supported by the actual wording of Article 139(3) EPC in my view.
23. Article 139(3) EPC reads: "[a]ny Contracting State may prescribe whether and on what terms an invention disclosed in both a *European patent application* or patent and a *national application* or patent having the same date of filing or, where priority is claimed, the same date of priority, may be protected simultaneously by *both applications* or patents." (emphasis added)
24. Hence, the wording of Article 139(3) EPC conveys rather the opposite because it explicitly states that Contracting States may prohibit the protection "simultaneously by both applications". For instance, a Contracting State may provide that a published European patent *application* can be cited as prior art (possibly: for novelty only) against national patents and patent applications filed with the national patent office and having the same effective date; i.e. irrespective of the grant of that European application.
25. It is true that in practice most Contracting States specify that the national patent ceases to have effect or is revoked after the grant of the patent by the EPO, or even after the conclusion of any opposition proceedings under Article 99 EPC. The Board in T 1423/07, r.2.2.2 concluded that this post-grant practice of the Contracting States does not support a general procedural principle under Article 125 EPC for the European pre-grant proceedings. However, this does not change the fact that Contracting States are free under Article 139(3) EPC to adopt a provision

in national law which attaches effects not only to patents granted by the EPO, but also to (published) European patent applications.

26. For completeness' sake, the phrase 'the co-existence of two identical patents' in r.61.2 appears to relate to the combination of one patent granted by a national patent office and one patent granted by the EPO in view of the scope of Article 139(3) EPC as set out hereinabove.

IV Question 1: no non-statutory grounds for refusal in the EPO grant procedure

27. As to Question 1, I refrain from expressing an opinion as to whether or not any one or more of the Articles of the EPC must be interpreted as meaning that double patenting is a ground for refusal of European patent applications.

I note that the Enlarged Board when acknowledging the prohibition of double patenting as a ground for refusal in G 1/05, r.13.4, first and second sentence, which sentences appear to be *obiter* in any case, did at least not explicitly interpret any particular provision of the EPC and did not explicitly apply the usual methods of legal interpretation, such as the grammatical, historical, systematic, teleological and dynamic interpretation method. On the other hand, the Enlarged Board also did not indicate that said ground is a non-statutory or unwritten ground for refusal.

28. However, in line with the referral decision, I will assume that none of the current EPC provisions implies that double patenting is a ground for refusal. The next question might then be whether a non-statutory, judicially created ground for refusal of patent applications by the EPO can be adopted by the Enlarged Board, in particular whether there is any precedent for doing so under the EPC.

Of course, USA patent law has the non-statutory, judicially created, obvious-type double patenting rejection (USPTO Manual of Patent Examining Procedure §804.II.B) and the corresponding possibility to file a terminal disclaimer to obviate the rejection, i.e. a statutory disclaimer of a part of the patent term (not of subject-matter) which disclaimer must further declare that the patents will remain commonly owned in the future (35 U.S.C. 253(b); 37 CFR 1.321(c)).

29. In T36/19, the Board considered whether the applicant 'still [had] a legitimate interest in the continuation of the grant and appeal proceedings', which the Board found was the case. However, the Board did not indicate any possible legal basis for this test, nor did it precisely indicate the possible consequences. It is submitted that this (recent) decision is not sufficient precedent for the introduction of non-statutory grounds for refusal in the EPO grant proceedings.

G 1/05, r.13.4, first and second sentence, appear to be *obiter*, and at least do not expressly introduce an unwritten ground of refusal.

30. The question arises if there is fundamentally a role for unwritten, or non-statutory, judicially-created grounds for refusal in the grant procedure before the EPO.

I submit that the answer to this question should be no, in view of legal certainty for applicants and in view of a systematic interpretation of the EPC.

31. In any case, the Contracting States are free under the EPC to amend it to introduce any ground for refusal they may find desirable.
32. It seems desirable the Enlarged Board either clarifies how the holding in G 1/05, r.13.4 first and second sentence follows from a legal interpretation of one or more of the Articles of the EPC, or modifies said holding in response to Question 1.
33. The above observations are my personal views only.

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Respectfully submitted,

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c/o V.O. Patents & Trademarks
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