

Enlarged Board of Appeal  
European Patent Office  
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Germany

Attn. Mr Wiek Crasborn  
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Date: 2020-Jan-16

Subject: Amicus Curiae brief regarding G 4/19  
Patentability of computer implemented simulations  
resulting from T 0318/14, EP application no.: 10718590.2

Dear Sirs,

In the above-mentioned decision, the following questions of law have been referred to the Enlarged Board of Appeal:

1. 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 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 where 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 ofa European patent application on the basis of which a European patent was granted to the same applicant?
  - 2.2 In particular, in the latter case, does an applicant have a legitimate interest in the grant of the (subsequent) European patent application in view of the fact that the filing date and not the priority date is the relevant date for calculating the term of the European patent under Article 63(1) EPC?



Regarding these questions, we respectfully observe as follows:

## Background

As mentioned in the referring Board of Appeal's decision,

- I. The appeal lies from the decision of the examining division in which European patent application 10718590.2, based on an international application published as WO 2010/130661, was refused under Article 97(2) EPC "in conjunction with Article 125 EPC".
- II. The examining division found that claim 1 of the sole claim request on file was directed to subject-matter which was "100% identical" to the subject-matter claimed in European patent No 2 251 021, which was granted on European patent application No 09159932.4, the priority document of the present application. This was held to be contrary to the principle of the prohibition on double patenting referred to in decisions G 1/05 and G 1/06.

## Admissibility

The referral is admissible because a new aspect arises that has not yet been dealt with by the Enlarged Board of Appeal's earlier decisions G 1/05 and G 1/06, viz. whether the prohibition on double patenting also arises if by obtaining a second patent for the same invention, the applicant gets protection for a longer period.

While question 1 has already been dealt with by the Enlarged Board of Appeal's earlier decisions G 1/05 and G 1/06, the referral is admissible and necessitated by Article 21 of the Rules of Procedure of the Boards of Appeal as the referring Board of Appeal considers deviating from those Enlarged Board of Appeal decisions, at least in the present case in which the applicant could obtain about a year extra protection.

However, in question 2.1, the elements a) and b) are irrelevant for deciding the case to be decided by the referring Board of Appeal, and to that extent, question 2.1 is inadmissible. As mentioned in the online Case Law of the Boards of Appeal, [section 2.3.3 Relevance of the referred question for the underlying case](#),

"The referred question must not have a merely theoretical significance for the original proceedings which would be the case if the referring board were to reach the same decision regardless of the answer to the referred question ([G 3/98](#), OJ 2001, 62; [G 2/99](#), OJ 2001, 83; see also [T 547/08](#)). It must be relevant for deciding the case in question ([G 2/04](#), OJ 2005, 549; [T 2136/16](#)), or the Enlarged Board must be satisfied that "answers to the questions referred are necessary for each Board of Appeal to be able to dispose of their respective appeals on the correct legal basis" ([G 1/05](#), OJ 2008, 271; [G 1/06](#), OJ 2008, 307; see also [G 2/06](#), OJ 2009, 306). In [T 154/04](#) (OJ 2008, 46; see also [J 16/90](#), OJ 1992, 260; and [T 1044/07](#)) the board held that the answer to

the referred question must be "essential to reach a decision on the appeal in question"."

If you nevertheless wish to say something on questions 2.1 a) and/or b), e.g. in an obiter dictum, we respectfully submit that in those cases there is no reason to deviate from the prohibition on double patenting as acknowledged in your earlier decisions G 1/05 and G 1/06, as in these cases, an applicant has no legitimate interest whatsoever in getting two patents with the same scope.

## Substance

As regards the legal basis for the no double patenting practice, we believe that Article 125 EPC is the appropriate legal basis. As the referring Board of Appeal has mentioned, the travaux préparatoires (Document M/PR/I, 64, No 665) of the EPC state:

"In connection with Article 125 it was established at the request of the United Kingdom delegation that there was majority agreement in the Main Committee on the following: that it was a generally recognised principle of procedural law in the Contracting States that a person can be granted only one European patent for the same invention in respect of which there are several applications with the same date of filing."

This preparatory work can be taken into account in the interpretation of Article 125 EPC under Article 32 of the Vienna Convention on the law of treaties. We do not believe it to be relevant that one state (viz. NO) is reported to have a different view; the travaux préparatoires correctly mention that there was a majority agreement, and Article 32 of the Vienna Convention on the law of treaties does not limit taking the travaux préparatoires into account to situations in which the negotiating states are unanimous.

### *Article 32. SUPPLEMENTARY MEANS OF INTERPRETATION*

Recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of article 31, or to determine the meaning when the interpretation according to article 31 :

- (a) Leaves the meaning ambiguous or obscure; or
- (b) Leads to a result which is manifestly absurd or unreasonable.

Also, while not all national laws of the EPC states may contain a clear prohibition on double patenting, it is a common principle of procedural law that absent a sufficient interest, there is no action, i.e. no right to start legal proceedings. In French: point d'intérêt, point d'action. This does not only apply to civil law, but also to administrative law.

In paragraph 13.4 of its decisions G 1/05 and G 1/06, the Enlarged Board of Appeal has stated:

13.4 The Board accepts that the principle of prohibition of double patenting exists **on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one**

**granted patent therefor.** Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent. ... (*emphasis added*)

We believe paragraph 13.4 of G 1/05 and G 1/06 to be sound, as the public too is entitled to legal certainty. For example, it should not be possible for a patentee to litigate based on the second patent if the patentee was not successful in litigating the first patent, and a competitor should not have the burden to handle two revocation actions against two identical patents.

Paragraph 13.4 of G 1/05 and G 1/06 was, however, stated in the context of a parent application and a divisional application, which are entitled to the same filing date, so that any patents (to be) granted on these applications will thus expire on the same date.

In the case at hand, however, the patent granted on the priority application will expire earlier than the expiry date of a patent if granted on the application that has been refused, and the appellant claims that because of that difference in expiry dates, he is entitled to be granted a second patent.

While the appellant's reasoning is not without merit, the result of a grant according to the appellant's main request would be that as long as the patent granted on the priority application still exists, the appellant would have 2 identical European patents. And that is undesired (unjustifiably burdensome) for the appellant's competitors, while for as long as the patent granted on the priority application exists, the applicant has no legitimate interest in having 2 European patents with the same or overlapping scope.

In view thereof, we believe that the appellant's main request should only be allowed if

- the applicant files a revocation or limitation request under Article 105a EPC to ensure that the European patent granted on the priority application is either cancelled or limited so as to become different from the European patent to be granted on the subsequent application; this revocation or limitation request may be conditional on the EPO indeed granting a European patent with the desired scope on the subsequent application, or
- the European patent granted on the priority application has lapsed, or is deemed to be void ab initio, with effect for all states still designated in the subsequent European patent application, before the EPO decides on granting a European patent on the subsequent European application.

An amendment obtained by a limitation request under Article 105a EPC would have the same effect as a disclaimer hinted at by the Enlarged Board of Appeal in paragraph 4.5.5 of its decision G 2/10 in the context of first seeking a relatively narrow patent that could relatively easily be granted, and then seek a broader patent by means of a divisional; the scope of the

first, relatively narrow, patent would then have to be excised from the scope of the second, relatively broad, patent.

In the present case, where the applicant seeks to obtain a 2<sup>nd</sup> European patent that is identical to the 1<sup>st</sup> European patent that has already been granted on the priority application, only a revocation of the 1<sup>st</sup> European patent would be appropriate, unless the 1<sup>st</sup> European patent no longer exists for the states still designated in the 2<sup>nd</sup> European patent application.

It is noted that a somewhat similar system exists in Chinese patent law: it is possible to simultaneously file a utility model patent application and an invention patent application for the same invention. As the utility model patent application is not subject to a full substantive examination, it may be quickly granted. If and when later on, CNIPA intends to grant a patent on the parallel invention patent application, the applicant is asked to give up the utility model patent, as without abandoning the utility model patent, the invention patent cannot be granted in view of the prohibition on double patenting. This abandonment of the CN utility model patent has no retro-active effect.

We respectfully submit that the comments in paragraph 2.4 of T 1423/07 on the identity of the owner of the patent granted on the priority application and the subsequent application appear to be irrelevant, as an applicant should not be allowed to simply escape the prohibition on double patenting by assigning one of his rights. Doing so would impose a too high burden on the applicant's competitors.

## Conclusion

In view of the above, we suggest to answer the questions as follows:

1. 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 Article 54(2) and (3) EPC?

*Answer: yes, absent a legitimate interest to be raised and substantiated by the applicant.*

- 2.1 If the answer to the first question is yes, what are the conditions for such a refusal and are different conditions to be applied where the European patent application under examination was filed
  - a) on the same date as, or
  - b) as a European divisional application (Article 76(1) EPC) in respect of, or
  - c) claiming the priority (Article 88 EPC) in respect ofa European patent application on the basis of which a European patent was granted to the same applicant?

*Answer:*

- a) *the question is inadmissible as being irrelevant for the case to be decided*

- b) *the question is inadmissible as being irrelevant for the case to be decided*
- c) *a European patent can only be granted for the same invention as already protected by a European patent granted on the priority application if*
1. *the applicant files a revocation or limitation request under Article 105a EPC regarding the European patent granted on the priority application so as to ensure that there are no multiple European patents with the same or overlapping scope with the same priority date, which request may be conditional on the EPO indeed granting a patent with the desired scope on the subsequent application; or*
  2. *the European patent granted on the priority application has lapsed, or is deemed to be void ab initio, with effect for all states still designated in the subsequent European patent application, before the EPO decides on granting a European patent on the subsequent European application.*

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

*Answer: yes.*

We hope that the above suggestions are useful.

Yours faithfully,  
Philips International B.V.  
Intellectual Property & Standards



L.J. Steenbeek.