

Eric Cogniat  
Rue d'Entre-deux-Villes 10  
1814 La Tour-de-Peilz  
Switzerland

**Registry of the Enlarged Board of Appeal**  
Richard-Reitzner-Allee 8  
D-85540 HAAR

By email: [EBAamicuscuriae@epo.org](mailto:EBAamicuscuriae@epo.org)

1<sup>st</sup> October 2020

Attn: Mr Nicolas Michaleczek, Registrar

**Re: Amicus curiae in connection with Referral G 4/19**

Dear Mr Chairman and Members of the Enlarged Board of Appeal,

The Technical Board of Appeal 3.3.01 (TBA) has referred the following questions to the Enlarged Board of Appeal (EBA)<sup>1</sup>:

*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?*

The observations below are my personal views only.

---

<sup>1</sup> T 318/14, 7 February 2019, OJ EPO 2020, A104

1. In this referral, double-patenting is to be understood in a narrow sense, that is, when the same applicant requests the grant of a second European patent which claims the same subject-matter as a previously granted European patent, for overlapping designated states, and where the two applications enjoy the same effective date (priority and/or filing date).

2. The first question asks whether the first grant should influence the assessment of the second application. The second question addresses different filing scenarios, and whether the applicant's interest should be accounted for.

3. I believe that the first question should be answered in the negative. Therefore, the second question would not need to be addressed. If the Enlarged Board considers that the first question should be answered in the affirmative, then I submit that questions 2.1(a) and (b) are not relevant to the case at hand, and that an applicant does have a legitimate interest in the grant of a second patent 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 (questions 2.1(c) and 2.2).

4. I also support the conclusion of the referring board that *"a proper legislative procedure would offer a more favourable context for establishing a sound legal basis for a prohibition on double patenting"*<sup>2</sup>.

### **Interpretation of the EPC – Vienna Convention on the Law of Treaties**

5. The question of double patenting has undoubtedly been discussed between the parties during the Travaux Préparatoires. However, I submit that an agreement was not reached between the parties on this question. Therefore, this lack of agreement cannot be considered as a procedural gap that would need to be filled under Article 125 EPC.

6. Double patenting was discussed during the Inter-Governmental Conference in 1971. The Working Party I even decided that *"the minutes of the Diplomatic Conference would have to contain a declaration explaining that it was not possible for an inventor to obtain two patents for the same invention"*<sup>3</sup> (emphasis added). A few months later, a similar statement was made during the 1972 Inter-Governmental Conference<sup>4</sup>. On this occasion, the Norwegian delegation commented that such a

---

<sup>2</sup> T 318/14, Reasons 78.

<sup>3</sup> Minutes of the 10<sup>th</sup> meeting of Working Party I of the Inter-Governmental Conference, Luxembourg, 22 to 26 November 1971, BR/144 e/71, point 119. Document N3 in the appeal proceedings.

<sup>4</sup> Minutes of the 6<sup>th</sup> meeting of the Inter-Governmental Conference, Luxembourg, 19 to 30 June 1972, BR/219 e/72, point 49. Document N4 in the appeal proceedings.

*“possible restriction (...) should be expressly stated in the Convention.”*<sup>5</sup> (emphasis added). On this occasion, the Norwegian delegation did not expressly oppose the prohibition of double patenting, but it did insist that an express provision should be included in the Convention if double-patenting was to be prohibited.

7. This view was repeated by the Norwegian delegation during the Diplomatic Conference in 1973. It stated that *“it could not agree to this principle [of a prohibition of double patenting] in its present general form”*<sup>6</sup>, i.e. in the form proposed by the British delegation<sup>7</sup>. When a first party expressly *“[cannot] agree”* with a statement of a second party, it means that the first party disagrees with this statement. The disagreement expressed explicitly by the Norwegian delegation cannot be viewed as a lack of opposition. Reaching such a result would distort the express disagreement on this topic and the statements made previously that a restriction should be expressly stated in the Convention for double patenting to be prohibited.

8. The minutes of the Diplomatic Conference show that there was no agreement between all the parties on the double patenting issue, contrary to the requirement of Article 31.2(a) of the Vienna Convention. If need be, the Travaux Préparatoires confirm<sup>8</sup> that a specific provision was needed in the Convention if double-patenting was to be prohibited.

9. Therefore, a general prohibition of double patenting cannot be derived from the Travaux Préparatoires, from the Diplomatic Conference nor from the Convention. In fact, the European Patent Office (EPO) even acknowledges that an express provision against double patenting does not exist in the EPC: *“The EPC does not deal explicitly with the case of co-pending European applications of the same effective date filed by the same applicant”*<sup>9</sup>.

10. In its decision T 1423/07<sup>10</sup>, the Technical Board of Appeal 3.3.02 reviewed the approaches of the Contracting States regarding simultaneous protection by a national and a European patent, i.e. in the context of Article 139(3) EPC. Some States allow simultaneous protection between a European patent and a national patent, other States consider that the effects of the earlier filed national patent or patent application

---

<sup>5</sup> Comments by the Norwegian Government on the preparatory documents for the Munich Diplomatic Conference, Document M/28, page 346, point 11. Document N2 in the appeal proceedings.

<sup>6</sup> Minutes of the proceedings of the Main Committee I during the Diplomatic Conference, Munich, 10 September to 6 October 1973, M/PR/I, page 71, point 666. Document N1 in the appeal proceedings.

<sup>7</sup> *ibid.*, point 665.

<sup>8</sup> Article 32 Vienna Convention: *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 (...).* (emphasis added)

<sup>9</sup> Guidelines for Examination in the European Patent Office, November 2019 edition, G-IV, 5.4

<sup>10</sup> T 1423/07 dated 19 April 2010, Cyclic Amine derivative/BOEHRINGER INGELHEIM VETMEDICA GmbH, Reasons 2.2.2.

“cease” after the later-filed European patent is granted<sup>11</sup>, and some other States revoke the earlier-filed national patent, give an option to the applicant to request suspension of the substantive examination of the national application<sup>12</sup>, or refuse the earlier-filed national application.

11. Based on these contrasted approaches, allowing double patenting as narrowly defined here would not lead to a result which is manifestly absurd or unreasonable<sup>13</sup>.

### **Double patenting and divisional applications**

12. In decision G 1/05, the EBA considered it *“unsatisfactory that sequences of divisional applications each containing the same broad disclosures of the original patent application, by means of at least an unamended description, should be pending for up to twenty years”*<sup>14</sup>

13. This may be a concern for third parties. Indeed, consecutive divisional application will be published at different dates, in their order of filing. As a result, monitoring may be needed even after a patent has been granted in order to know whether a new divisional application has been filed or not. In this context, the EBA also stated that if administrative measures proved inadequate, *“it would be for the legislator to consider where there are abuses and what the remedy could be.”*<sup>15</sup>

14. An attempt was made in this direction with an amendment of Rule 36 EPC<sup>16</sup>. A 24-month time limit was introduced for filing divisional applications, with various trigger events<sup>17</sup>. The aim of this amendment was to limit the use of divisional applications as a tool for prolonging the pendency of subject-matter before the EPO<sup>18</sup>. This rule was very difficult to implement<sup>19</sup> and did not meet its aim.

15. In a later decision<sup>20</sup>, following a user consultation, the Administrative Council reinstated the former wording of Rule 36 EPC and introduced an additional fee as part of the filing fee for 2<sup>nd</sup> generation (and higher) divisional applications. Interestingly,

---

<sup>11</sup> At the end of the opposition period and subject to the outcome of opposition proceedings

<sup>12</sup> Article 62 OBI (Switzerland)

<sup>13</sup> Article 32(b) Vienna Convention.

<sup>14</sup> G 1/05, OJ EPO 2008, 306, Reasons 13.5.

<sup>15</sup> *ibid.*, last sentence

<sup>16</sup> OJ EPO 2009, 296, Decision of the Administrative Council of 25 March 2009 amending the Implementing Regulations to the European Patent Convention (CA/D 2/09)

<sup>17</sup> The time limit was computed for a whole patent family, based on the date of the first substantive examination report, and whether the divisional application was filed spontaneous or as a reaction to a lack-of-unity objection.

<sup>18</sup> EPO Administrative Council document dated 27 Sept. 2013, CA/89/13, paragraph 6.

<sup>19</sup> *ibid.*, paragraphs 11-12.

<sup>20</sup> OJ EPO, 2013, 501, Decision of the Administrative Council of 16 October 2013 amending Rules 36, 38 and 135 of the Implementing Regulations to the European Patent Convention (CA/D 15/13)

*“[t]he necessity for clear provisions against double patenting”*<sup>21</sup> was already noted from users’ feedback in the report preparing for the reinstatement of Rule 36 EPC.

16. However, despite an attempt to regulate the practice of filing consecutive divisional applications and the identification that there was a necessity for clear provisions against double patenting, the Administrative Council has not decided on this question, whether in the context of divisional applications or in the other contexts identified in this referral.

### **Double patenting and internal priority**

#### *Information to the public*

17. In the context of an internal priority, the priority and the subsequent patent applications are published in the same time frame, that is, 18 months after the earliest priority date. As a result, third parties are informed of the co-existence of two European patent applications (almost) simultaneously.

18. This coexistence is either actual, when two European patent applications are at stake, or only potential, when a European patent application and a PCT application are at stake, because publication of the PCT application occurs during the International stage, usually before the European regional stage has started.

19. In the latter case, third parties will need to monitor the PCT application to know whether it will mature into a Euro-PCT application. But in reality, this “monitoring hurdle” exists whether the PCT application was filed with a priority claim or without, and whether the claimed priority arises from an earlier European patent application, a patent application filed in a Contracting State or a non-contracting state.

#### *Term of protection of the invention*

20. In all cases, third parties can readily assess the maximum term of the two applications (20 years from the filing date) and cannot be taken by surprise. In fact, third parties are faced with the same potential term of protection, whether a European patent application claims priority from an earlier European patent application or from one, or several, national patent applications.

#### *Opposition*

21. It is also worth noting that the present European patent application 10718590 claims priority from the application which matured into European patent EP 2251021. European patent EP 2251021 was not opposed. If the present application is granted, a new opposition period will be available to third parties who have overlooked the initial grant, or who have become interested in this invention in the interval.

---

<sup>21</sup> CA/89/13, paragraph 16.

22. Thus, in some cases, granting two patents could cause the hurdle of needing to file two oppositions. In this situation, the EPO could very well introduce a joinder procedure, or a fee reduction for existing opponents. In other cases, such as the present case, granting two patents gives third parties a second chance of challenging the validity of the claimed invention.

### **Double patenting and double protection at the European Patent Office**

23. The current practice of the EPO is not satisfactory on several grounds. It does not prevent double protection of an invention. For instance, patents with overlapping claims can be granted by the EPO. So, the same invention may very well be claimed in different manners in two or more European patents having the same effective date. This may be the case, for instance, when a dependent claim of a first patent has the same scope as an independent claim of another patent.

24. Also, the EPO will not raise a double patenting objection if the two European patent applications at stake are assigned to different parties, even if the two parties belong to the same group of companies. This was the case in decision T 1423/07<sup>22</sup>.

25. Finally, the question of double patenting or double protection is only virtual during the pre-grant phase. It becomes actual only when the (second) patent is validated in the same designated State(s) as the first patent.

### **Request for revocation of the European patent**

26. It has been proposed that in case of double patenting, the second patent could be granted subject to revocation of the first patent under Article 105a EPC.

27. A first observation is that opposition proceedings have precedence over a request for revocation<sup>23</sup>. Therefore, the grant of the second patent would be delayed until a final decision has been reached in the opposition proceedings. Alternatively, the patent owner could accelerate things by stating that he disagrees with the text of the patent in the pending opposition proceedings. The patent would then be revoked<sup>24</sup>, possibly without a substantive decision.

28. In such a situation, the opponent would probably have to file an opposition against the second patent, either after “early” revocation of the first patent in

---

<sup>22</sup> T 1423/07, Reasons 2.4.

<sup>23</sup> Article 105a(2) EPC and Rule 93(1) EPC

<sup>24</sup> Examination Guidelines, D-VI, 2.2, and D-VIII, 1.2.5

opposition proceedings, or after its revocation following a request under Article 105a EPC, without the benefit of a joined opposition procedure for instance (see § 22).

29. A second observation is that revocation of the patent has a retroactive effect. This is a much harsher outcome for the patentee than the effect of simultaneous protection adopted by most of the Contracting States, namely that the earlier-filed patent ceases to have effect when the later-filed European patent is granted. This mechanism operates only for the future, it is similar to a surrender or a lapse of the earlier-filed patent.

### **Approach taken by the Contracting States: national internal priority and Article 139(3) EPC**

30. Claiming internal priority for national patent applications is allowed in several Contracting States, with various procedural consequences. For instance:

- France: when a later filed French patent application claims priority from an earlier filed French patent application, the earlier-filed application or patent will cease to produce its effects upon grant of the later-filed patent for the common parts<sup>25</sup>. In other words, two patents may be granted successively, but only the later-filed patent will remain in force for the subject matter in common between the two, and for up to 20 years from the filing date of the later filed patent.
- Switzerland: when a patent application is used to claim internal priority and substantive examination of this application is not finished, the applicant may request that substantive examination be suspended until the later-filed patent is granted<sup>26</sup>. If an inventor, or his successor in title, is granted two patents for the same invention, having the same filing or priority date, the patent granted on the earlier filed application ceases to produce its effect for the common scope of protection<sup>27</sup>.

31. These two examples show that some Contracting States admit that two patents having the same filing or priority date could be granted to the same inventor<sup>28</sup> for the same invention, but that only the later filed patent will survive. This avoids double protection of the same invention.

32. Implicitly, these Contracting States also recognise that the applicant may obtain a patent protection for up to 21 years from the priority date, but still 20 years from the filing date of the later-filed patent application. At the same time, these Contracting

---

<sup>25</sup> Article L. 612-3 CPI (France)

<sup>26</sup> Article 62a OBI (Switzerland)

<sup>27</sup> Article 20a LBI (Switzerland)

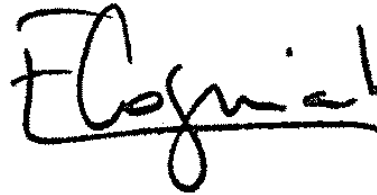
<sup>28</sup> Or his successor in title.

States have procedural provisions to ensure that only one of the two (national) patent will be enforceable at any given time.

33. A similar approach is observed when a national patent and a European patent are at stake, through the implementation of Article 139(3) EPC by the Contracting States.

34. In view of this, the EPO should not be more restrictive than the Contracting States, who seem to acknowledge that applicants may have a legitimate interest in the grant of a second patent, at least in the context of internal priority, even if it may lead to a term of protection of 21 years from the (internal) priority date.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'E. Cogniat', with a horizontal line underneath the name.

Eric Cogniat  
European patent attorney