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Via Email: EBAamicuscuriae@epo.org

July 29, 2022

Our reference: 063351K  
Re.: **AMICUS CURIAE G1/22 AND G2/22**

Dear Mr. Michaleczek,

We herewith submit the attached Amicus brief.

With kind regards



Gregor König

(professional representative)

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## AMICUS CURIAE G1/22 AND G2/22

This brief is submitted as a Third-Party Statement under Art. 10 of the Rules of Procedure of the Enlarged Board of Appeal. It relates to **Question II** of the referral.

### A. INTRODUCTION

Question II of the referral reads:

*II. If question I is answered in the affirmative*

*Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where*

*1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and*

*2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and*

*3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?*

Below we show that the extent of unitary character of the PCT application sufficiently supports the joint applicants approach, that this would provide the highest degree of legal certainty (including cases of prior art documents with priority providing US only applicants but without access to any facts regarding transfer), and that the implied agreement approach based on an application (as promoted by the referring Board) in lack of the priority applicant's knowledge of the PCT filing would need to rely on the priority application rather than the PCT application in order to become relevant in practice.

### B. BASIS FOR JOINT APPLICANTS APPROACH

The present cases, as opposed to the case in T 1933/12, concern those multiple applicant settings where a PCT-application designates priority providing party A as applicant for US only and non-priority providing party B as applicant inter alia for regional European patent protection. In the PCT-application priority is uniformly claimed from the earlier patent application that had been filed by party A, i.e., the priority claim is not directed to any specific country or region.

This setting has become a problem for a significant number of US pre-AIA priority filings because often the assignment was done after the PCT filing i.e., after the priority year. However, the priority providing inventors were always listed as US only applicants for statutory reasons. Outside the US or post-AIA the transfer of priority rights is not as common required for pursuing international patent protection as the employer can file the priority application. Even if there was a difference in priority applicants and PCT applicants combined with a transfer issue the priority right providing party would not be listed as applicant in the PCT application – a condition for the joint applicants approach to apply in the first place. Further, in the US pre-AIA setting the priority applicant A will in nearly all cases, like in the present case, be an employee and applicant B the respective employer that has initiated both filings and borne the respective costs.

In the referring decision the joint applicants approach is discussed in a first and second line of reasoning, i.e., “ ... that the joint applicants approach can be applied to the present situation, relying in particular on Article 11(3) PCT and Articles 118 and 153(2) EPC.” in conjunction with Art. 118 EPC on the one hand and “... that a PCT joint applicants approach can be based on the unitary character of the priority right in the PCT and thus on the operation of the PCT alone.” (cf. margin no. 32.) on the other hand. Both lines, however, rely on the *unity of an application with differing designated states*, in one case derived from Art. 118 EPC and in the other derived from the character of the PCT application itself.

For the EPC, Art. 118 EPC conceptually defines the unity of the EPC application and multiple applicants as joint applicants where these are designated for differing Contracting States within the EPC. The PCT does not have a comparable provision but contains certain elements that confer aspects of uniformity to the PCT application. Both rights, EPC and PCT, are uniform at the outset and lose their uniformity at one point of the procedure – the PCT right prior grant, the EPC right post grant – but the predominantly uniform character at the outset cannot be ignored. Uniformity in procedure is a basic principle of both systems that both intend to overcome territoriality to a certain extent – as does the Paris Convention.

Ultimately both PCT and EPC lead to a bundle of territorial patents. Claiming priority is a procedural step that appears to be allocated closer to those aspects of the PCT that were intended to be simplified. While convenience is not a legal principle it seems to have been a goal of the contracting parties here.

For Art. 118 EPC it is clear, that its immediate effects are limited to EP and Euro PCT applications. In lack of this provision in the PCT but in view of the numerous unitary elements of a PCT application and various provisions with unitary character in the international phase a decision must thus be made between application and non-application of the simplifying joint applicants concept to the priority claim of a PCT application.

Below, we summarize the relevant aspects of uniformity in the PCT application and proceedings.

### C. EVIDENCE OF THE UNIFORM CHARACTER OF A PCT APPLICATION AND THE UNIFORM PROCEEDINGS UNDER THE PCT

#### I. MAIN OBJECTIVE OF THE PCT: PROCEDURAL UNITY

Procedural unity can be identified as a main objective of the PCT as it is set out already in the preamble of the PCT, reading *inter alia*:

*“Desiring to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries”*

Further, Art. 1(1) PCT determines the Contracting States to (emphasis added)

*“constitute a Union for cooperation in the filing, searching, and examination, of applications for the protection of inventions”*

which amounts to a single procedure, namely the filing of international applications for the protection of inventions in any of the Contracting States (see Art. 3(1) PCT).

## II. JOINT CHARACTER OF THE PCT FILING ACT AS REFLECTED IN NUMEROUS PROVISIONS AND PROCEDURAL ASPECTS

- a) **Only one PCT applicant entitled to file a PCT application is required:** Only one PCT applicant having the right to file a PCT application pursuant to Rule 18.3 PCT is required which has the consequence that then all remaining PCT applicants have the right to file a PCT application as a “unit”. This likewise applies to the Request for International Preliminary Examination (Chapter II) (Rule 54.2 PCT).
- b) **Filing with a single Receiving Office:** The PCT requires multiple PCT applicants to agree on a single Receiving Office pursuant to Article 10 PCT. One applicant having the right to file with this specific Receiving Office suffices, with all other PCT applicants then having as a “unit” the right to file the PCT application with this Receiving Office (Rule 19.2(i) PCT).
- c) **There is one single set of application documents:** The PCT requires multiple PCT applicants to file one single specification, one single abstract and one single claim set (Articles 5 *et seq.* and Rules 5 *et seq.* PCT). This requirement is applicable irrespective of any national requirements regarding the specific wording of the claims and irrespective of the designations of multiple applicants. Any later amendment of the claims affects all designated Contracting States (and all PCT applicants).
- d) **Common decision regarding PCT authorities:** The PCT requires a common decision regarding the ISA and regarding further PCT authorities (e.g., Rule 4.14bis PCT).

## III. UNIFORM SEARCH, UNIFORM EXAMINATION, AND UNIFORM PUBLICATION OF A PCT APPLICATION

Even if there are multiple PCT applicants and different Contracting States designated by these multiple PCT applicants (e.g., Articles 15, 21, 35 PCT), there is a **uniform search, examination, and publication**.

## IV. MULTIPLE PCT APPLICANTS ARE REQUIRED TO ACT AND DECIDE IN COMMON

- a) Common representation:** The PCT requires a (deemed) common representation (Rules 90.1 to 90.3 PCT) to ensure uniform requests even if the multiple PCT applicants have designated different states. The common representative acts for all PCT applicants pursuant to Rule 90.2(b) PCT, and actions of a common agent or common representative have the effect of acts by or for all PCT applicants (Rules 90*bis et seqq.* PCT).
- b) Withdrawal requires consent of all PCT applicants:** The PCT requires a signature of all PCT applicants (or the appointed common agent or appointed common representative) in case of a withdrawal of the PCT application, **of a designation** and likewise of a **withdrawal of the priority claim** (Rules 90*bis*3. to 90*bis*.5 PCT).

#### **D. CONCLUSION ON THE CHARACTER OF A PCT APPLICATION AND OF THE PCT PROCEEDINGS AND THE CONSEQUENCES FOR THE US ONLY SITUATION**

Under the PCT multiple applicants, even if they designate different states, are thus regarded as a “unit” and the PCT application itself as a “uniform right” as shown above. This is the basis for the uniform PCT procedure. This is likewise reflected in the provisions governing the priority claim of a PCT application.

Specifically, the PCT allocates the priority claim to the PCT application as such (Article 8 PCT), and provides for an undistinguished and joint generic priority claim as reflected in the PCT filing form. Further, a withdrawal of the priority claim affects all designated states in the absence of any provisions providing for a withdrawal only affecting specific designated states or specific PCT applicants (Rule 90*bis*.3 PCT).

The option to designate different contracting states for different applicants in the PCT filing form therefore does not affect the fundamental principle of uniform proceedings and of the uniform character of a PCT application itself. Designation does not affect the priority claim allocated to the PCT application as such and the joint applicants approach does not affect designation.

There is thus a solid basis for applying the concept of a uniform application and therewith of joint applicants to the PCT application.

Irrespective of this, the design of the PCT application form has a material effect on the priority claim. The intent of the applicants expressed in the PCT application form distinguishes on the level of the designation but not on the level of the priority claim as it defines the expressed will of the applicants making use of this form. As this form appears to have been used by all affected applicants it can be considered as generally defining the applicants will which in this case is a uniform priority claim and a distinction only on the level of designations.

That the international application is of a collection of a multitude of different national and regional patent applications does not exclude that the applicants express a common use of a priority right in the application form.

The joint applicants approach does also not contradict any recognized conflict of law principles, as the Paris Convention itself, in order to simplify international valid filing for IP protection, already overcomes the territoriality of the filing act and ignores all national provisions and requirements that go beyond Art. 4 PC. Like the Paris Convention, the PCT aims *“to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries”* (cf. Preamble PCT, Recital 3).

#### **E. THE JOINT APPLICANTS APPROACH GUARANTEES A HIGH LEVEL OF LEGAL CERTAINTY – ALSO WITH RESPECT TO PRIORITY CLAIMS IN THE PRIOR ART**

The joint applicants approach based on the unitary character of the PCT application lead to the highest degree of legal security for all parties including the public. Applying this legal concept does not require separate evidence of a transfer of rights. This would simplify the procedure, as envisaged by the PC and PCT, and, as an important legal certainty point, the public could largely rely on the application documents (i.e., the PCT filing form) at face value to assess the legal situation. For any agreement-based solution the public does not have access to any facts regarding any transfer.

For assessing priority claims in prior art documents this problem applies to all parties. Prior art documents originating in pre-AIA filings raise the question of a valid priority claim on a regular basis if a timely assignment document is not publicly available. This would be resolved by the joint applicants approach.

The assumption of valid transfer can be rebutted by counter-evidence which would sufficiently safeguard the rights of the priority applicants in the balance of interests.

## F. TRANSFER OF RIGHTS

The joint applicants approach must be distinguished from what the referring Board considers appealing and discusses as a third line of reasoning in margin nos. 34. *et seqq.* This line of reasoning is based on a transfer of rights by agreement rather than on the concept of joint applicants. The Board assesses the application as one possible justification for an **implicit agreement** and thus, legally, a transfer of rights by agreement. Legally, there are no issues with this approach except for the applicable law for such agreement. The EBA will have to decide whether it follows the EPC as *lex loci protectionis*.

In any event, relying on the PCT application as basis for an implicit agreement, while legally being straightforward, will not solve the problem. Every implicit agreement requires some kind of knowledge of the parties to the agreement. At least the specific knowledge of the PCT filing on the part of the inventors is missing in many cases affected by Question II. Unless the general knowledge that the priority application filed in the name of the employee for the employer may be used for international filings is considered sufficient it will not be easy to justify implicit agreement based on the PCT application.

Below we analyze in detail the factual background for an implicit agreement based on the PCT application. We then suggest a comparable but more reliable concept for the implicit agreement **based on the priority application**. This concept would take into account that in most cases, as in the present one, there is a special relationship between the parties, i.e., the priority applicants are employees with a contractual relationship to their employers at the priority date. The involvement of the priority applicants and inventors in the priority application as opposed to the PCT application as a rule would allow a safe application of the implicit transfer concept promoted by the referring Board. The rights of the priority providing inventors would nevertheless be safeguarded since the assumed implicit intent could be overruled by facts presented by the priority providing inventor. This would also exclude the present third party attempt of abusing transfer of priority issues to destroy otherwise fully valid patents where there is no issue between the parties to the transfer.

## **G. ALTERNATIVE: EMPLOYEE ACT OF PROVIDING THE INVENTION FOR FILING OF THE PRIORITY APPLICATION AS A RELIABLE BASIS FOR IMPLICIT AGREEMENT**

As mentioned above, the cases affected by Question II generally relate to employee/employer settings. The *implicit agreement* based on the PCT application form, suggested as a general solution for the priority issue by the referring Board can, however, not become relevant if there is no involvement by the priority providing applicant (employee). Assuming a (rebuttable) implicit agreement between employee and employer upon filing **of the priority application** may solve this problem.

### **I. THE REGULAR LACK OF INVOLVEMENT IN THE PCT FILING BY THE US ONLY APPLICANTS**

The typical “US only applicant” priority issue occurs in US pre-AIA employee-employer settings, where the employer was forced by law to file the application in the name of the employee inventor and obviously then did so at his own initiative and costs. The employer then typically filed the subsequent PCT application in his name – often by an agent – i.e., designating himself for everything but US (inter alia for EP), and the employee (priority applicants) mandatorily for US only. The US only applicants, as employees, did not themselves instruct the agent and will often not have been involved at all. The PCT filing form was typically signed by an employer representative or agent under Rule 90 PCT in the name of the employer and of the employee(s), but there was typically no employee signature on the PCT form or on the power of attorney. While, before 2004, a power of attorney, or any missing signature of an applicant, could still be filed under Rule 90.4 PCT with retroactive effect after the filing date of the PCT application within the time limit of Rule 26.2, for all cases as of 2004, a power of attorney no longer needed to be filed with the USPTO as a PCT receiving office, and if it was filed it was only signed by the employer. This can be seen e.g. in the case of EP 1 951 304 B1 of T 2842/18.

Thus, there will regularly be no available evidence of US only applicant knowledge of the PCT filing and, after 2003, no retroactive effect after filing of missing parts under Rule 26.2 PCT.

In most of the affected cases it is hard to imagine that the filing of the PCT application, in lack of a signature on the application, or on the power of attorney for the agent by the priority applicants, can provide a reliable basis for an implied agreement to transfer the priority rights.

### **II. SOLUTION IN RELYING ON THE AGREEMENT IMPLIED BY THE PRIORITY FILING**

The concept of priority right transfer by *implicit agreement based on a filing act* as promoted by the referring Board could be applied to the majority of cases affected by Question II, if one relied on the filing of the priority application rather than of the PCT application. The priority application may appear more remote than the PCT application. However, the facts supporting implied agreement will include employee knowledge of the filing and can further rely on the special relationship between employer and employee, as well as the knowledge that the filing in his name was only the result of statutory requirements and will be used for other purposes.

Specifically, if an employer wished to pursue patent protection for an invention of his employee pre-AIA, the employer had to file the priority application in the name of the employee. Thus, the inventor employees filed the pre-AIA priority application on the initiative, in the interest and at costs of their employer. It was an act performed for the employer from the start and this was known to each employee. Therefore, the inventor employees were regularly only an instrument of the employer's interest without any own interest of the employees in filing and pursuing the priority application. In other cases, if any, the employee could and still can provide evidence to the contrary and safeguard his rights.

In this setting, it is thus fair to assume *implicit agreement* by the priority applicant to grant the employer the right to claim priority based on their conduct which is materialized in the filing act and the preparation of the priority application(s) and supported by the special relationship.

If the EBA follows the referring Board and decides for the EPC as applicable law for the priority right transfer then implied agreement to transfer under the EPC could also be derived from the typical US employment contract, even in cases where there is only equitable title.

### III. THE MISSING PRIORITY APPLICANT

The approach suggested above is not limited to those priority applicants named on the PCT application but extends to all priority applicants. As opposed to the joint applicants approach, the approach suggested above would also solve the priority issue in cases where a priority applicant was completely missing on the PCT application because the missing PCT applicant is nevertheless applicant of the priority application. He has thereby provided

*implicit agreement*. The joint applicants approach requires him to be named as US only applicant on the PCT filing form.

As a result, the act of involvement in the filing of the priority application by the US employed inventor can be considered as *implicit agreement* of the employee to provide to the employer the priority rights for further use in international filings.

A handwritten signature in black ink, consisting of a stylized 'K' and 'König' written in a cursive script.

Gregor König

Düsseldorf, July 28 2022