



G 4/19 Amicus Curiae Brief from epi

The Institute of Professional Representatives before the European Patent Office (**epi**) is the professional body representing all representatives entered on the List held by the EPO (European Patent Attorneys). Currently **epi** has about 12,300 European Patent Attorneys as members coming from each of the 38 Contracting States of the European Patent Convention (EPC) who work either in industry or in private practice.

The Reference to the Enlarged Board of Appeal

epi welcomes this referral to the Enlarged Board of Appeal (EBA) and trusts that this will increase legal certainty and improve clarity regarding the question of double patenting.

epi considers that the reference to the EBA is admissible. There are clearly diverging decisions from different Boards of Appeal as outlined below.

epi files the present *amicus curiae* brief in order to assist the EBA in its deliberations.

1 Background

In **T 0138/14** (7 February 2019) a Technical Board of Appeal (TBA) decided to refer the following questions to the EBA:

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 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 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?*

The referral is based on conflicting decisions T 1423/07 and T 2461/10.

In T 1423/07 of 19 April 2010, a TBA concluded that there is no principle of law generally recognised in the contracting states for refusing a European patent application on the ground of double patenting (see points 2.2.2 and 2.2.3 of the Reasons). Moreover, in this decision, the TBA considered that, where the conflicting application is a European application claiming priority from a previous European application that has already been granted, the application cannot be refused on the basis of a prohibition on double patenting. The relevant date for calculating the 20-year term is not the priority date but the filing date (Article 63 EPC). This means that the refusal of the later application would deprive the applicant of almost one year of protection. Therefore, that TBA considered that the applicant had a legitimate interest in the grant of the later patent (see points 2.2.4.1 of the Reasons).

In decision T 2461/10 of 26 March 2014, a different TBA concluded (see point 11) that it follows from the history of the origin of the EPC that there was broad agreement that double patenting of the same invention in three situations (filing of two European applications on the same day by the same person, parent application / divisional application and priority application / application claiming priority from the priority application) should not be possible. That TBA held that there was no requirement for an explicit Article or Rule in the EPC, since it followed from general procedural principles. That TBA specifically referred to the Minutes of the 10th meeting of Working Party I, held in Luxembourg from 22 to 26 November 1971, BR/144/71, pages 63-66, points 117-120 (see copy attached).

The application under appeal in T 0138/14 is a second EP application claiming priority from a first EP application and with claims identical to the claims granted on the basis of the first EP application.

2 All Questions – same subject matter

2.1 To answer the referred questions, it is first necessary to decide what is meant by “same subject matter”.

2.2 There is no explicit definition of this term in the EPC. The phrase “same subject matter” is used only once in the EPC, namely in Art 87(4) EPC, which reads as follows:

*A subsequent application in respect of the **same subject-matter** as a previous first application and filed in or for the same State shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.*

It is established that, in this situation, the phrase “same subject matter” follows the Gold Standard (G2/98 point 9 and G 2/10 point 4.3).

2.3 In the decisions of the EBA in G1/05 and G1/06 concerning prohibiting of double patenting, there is an *obiter dictum* which also uses the phrase “same subject matter”:

*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. However, this principle could not be relied on to prevent the filing of **identical applications** as this would run counter to the prevailing principle that conformity of applications with the EPC is to be assessed on the final version put forward (see point 3.2 above) (emphasis added).*

G1/05 and G1/06 dealt with the question of whether a divisional application could be filed with claims identical to those granted on a parent application. The decision in G1/05 and G1/06 does not distinguish between the phrases “same subject matter” and “identical subject matter”.

2.4 In the Travaux Préparatoires: Munich Diplomatic Conference 10/9-5/10 1973, Document N1, § 667 and 668 a similar question was discussed.

667. The FICPI delegation wondered what was meant in this instance by the same application or the same patent; did it mean that the content was substantially the same or that the patent claims were substantially the same?

668. The United Kingdom delegation interpreted it as meaning that the patent claims were the same.

2.5 The meaning of “same subject-matter” was also discussed in T2461/10:

21. *Im vorliegenden Fall liegt folglich **keine Identität** der Schutzgegenstände von Prioritätspatent und Anmeldung vor, sondern nur eine Überlappung ihrer Schutzbereiche: Die in den Ansprüchen 12 und 13 des Prioritätspatents unter Schutz gestellten Gegenstände unterfallen zwar dem Schutzbereich der Ansprüche 1, 6, 7 und 13 der Anmeldung, sind jedoch erheblich enger definiert als die Schutzgegenstände der letztgenannten Ansprüche. **Es stellt sich daher die Frage, ob das Verbot der Doppelpatentierung so weit reicht, dass es auch solche Fallkonstellationen erfasst.***

22. *Die Rechtsprechung der Beschwerdekammern hat sich bislang überwiegend gegen eine derartige Ausdehnung des Doppelpatentierungsverbots ausgesprochen. In*

der Entscheidung T 587/98 (ABI. EPA 2000, 497) wurde diese Rechtsfrage für das Verhältnis Stammanmeldung/Teilanmeldung ausführlich erörtert, wobei die Beschwerdekammer 3.5.02 zu folgender Schlussfolgerung gelangte (s. Punkt 3.7 der Gründe):

"The board concludes that there is no express or implicit provision in the EPC which prohibits the presence in a divisional application of an independent claim - explicitly or as a notional claim arrived at by partitioning of an actual claim into notional claims reciting explicit alternatives - which is related to an independent claim in the parent application (or patent if, as in the present case, it has already been granted) in such a way that the 'parent' claim includes all the features of the 'divisional' claim combined with an additional feature."

23. In der späteren Entscheidung T 1391/07 vom 7. November 2008 nahm die Beschwerdekammer 3.4.02 auf die grundsätzliche Billigung des Doppelpatentierungsverbots durch die Große Beschwerdekammer in den Entscheidungen G 1/05 und G 1/06 Bezug, lehnte jedoch eine Ausdehnung dieser Praxis auf den Fall der teilweisen Überlappung des Schutzbereichs ab (s. Punkte 2.5 und 2.6 der Gründe). In der Entscheidung T 1491/06 vom 20. Dezember 2011 befasste sich die Beschwerdekammer 3.5.04 mit einem Anspruch einer Teilanmeldung, der gegenüber einem Anspruch des Stammpatents enger, gegenüber einem anderen Anspruch jedoch weiter war, und konnte hierin einen Verstoß gegen das Doppelpatentierungsverbot erkennen (s. Punkte 3.2 bis 3.4 der Gründe). Entsprechende Äußerungen finden sich in einer Reihe weiterer Entscheidungen (vgl. etwa T 2402/10 vom 10. Mai 2012 und die dort in Punkt 8 der Gründe genannten Entscheidungen).

24. Eine entgegengesetzte Rechtsauffassung ist bislang soweit ersichtlich - nur in der Entscheidung T 307/03 -(ABI. EPA 2009, 418, Punkte 5.2 und 5.3 der Gründe) vertreten worden. Der Einwand wegen Doppelpatentierung könne auch dann erhoben werden, wenn der Gegenstand des erteilten Anspruchs im Gegenstand des später eingereichten Anspruchs enthalten sei, d.h. wenn der Anmelder den Gegenstand des bereits erteilten Patentanspruchs erneut patentieren lassen wolle und zusätzlich Patentschutz für einen anderen Gegenstand begehre, der im bereits erteilten Patent nicht beansprucht wird. Sei der Gegenstand, der zweimal patentiert würde, sowohl im schon erteilten Patent als auch in der anhängigen Anmeldung die bevorzugte Ausführungsart der Erfindung, könne das Ausmaß der Doppelpatentierung nicht als geringfügig vernachlässigt werden.

25. Die erkennende Kammer schließt sich aus den nachstehenden Erwägungen nicht der in T 307/03 vertretenen Rechtsauffassung an, sondern folgt der überwiegenden Rechtsprechung:

Die Große Beschwerdekammer hat in ihren oben zitierten obiter dicta (s. Punkt 7) das Bestehen eines Doppelpatentierungsverbots für die Fälle gebilligt, in denen in den jeweiligen Anmeldungen bzw. Patenten der gleiche Gegenstand beansprucht wird. Es bedeutet aber einen Unterschied, ob ein Gegenstand spezifisch beansprucht oder nur von dem Schutzbereich eines Anspruchs, der auf einen allgemeineren Gegenstand gerichtet ist, erfasst wird. So hat etwa die Große Beschwerdekammer in ihrer Entscheidung G 1/98 (ABI. EPA 2000, 111) im Zusammenhang mit der Auslegung des

Ausschlusses der Patentierung von Pflanzensorten (Artikel 53 b) EPÜ) deutlich gemacht, dass das Patentierungsverbot nur dann greift, wenn Pflanzensorten individuell beansprucht werden, aber noch nicht, wenn der zu prüfende Anspruch Pflanzensorten nur "umfasst".

Hinzu kommt folgende Erwägung: Würde man von einem Anmelder aufgrund des Verbots der Doppelpatentierung verlangen, den speziellen Gegenstand, auf den ein Anspruch eines ihm bereits erteilten Patents gerichtet ist, aus dem allgemeineren Gegenstand, der mit seiner anhängigen Anmeldung verfolgt wird, auszuklammern, entstünde für ihn die Gefahr, sich Einwänden nach Artikel 123 (2) - und zusätzlich nach Artikel 76 EPÜ im Falle einer Teilanmeldung - auszusetzen. Die Berechtigung derartiger Einwände ist jedoch keinesfalls einfach zu beurteilen, da die Zulässigkeit von Änderungen, die einen Disclaimer ursprünglich positive offenbarer Ausführungsformen enthalten, nach der Rechtsprechung der Großen Beschwerdekammer (G 2/10, ABI. EPA 2012, 376) zwar nicht von vornherein ausgeschlossen ist, jedoch eine Abwägung aller Umstände des Einzelfalls erfordert.

26. *Die Kammer kommt daher zu dem Ergebnis, dass das Verbot der Doppelpatentierung im vorliegenden Fall einer Patenterteilung gemäß der von der Anmelderin mit Schreiben vom 9. Februar 2010 eingereichten Anspruchsfassung nicht entgegensteht. Die angefochtene Entscheidung ist somit aufzuheben (emphasis added – a translation of these parts of the decision is appended to this brief).*

From the above, we can conclude that “same subject matter” means “the identical subject matter”.

2.6 Summing up the above, **epi** is of the opinion that “same subject matter” should be interpreted to mean “identical subject matter”. **epi** has applied this interpretation in its analysis and opinions on the answers to the questions to be answered in G4/19.

3 Question 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?

3.1 This question clearly requires a review of Article 97(2) EPC, which reads as follows:

If the Examining Division is of the opinion that the European patent application or the invention to which it relates does not meet the requirements of this Convention, it shall refuse the application unless this Convention provides for a different legal consequence.

It is therefore necessary to determine whether “the Convention”, i.e. the EPC, provides basis for rejecting an application on the basis of alleged double patenting.

3.2 The EPC does not explicitly prohibit double patenting.

The EPC only contains one Article which refers explicitly to double patenting. This is Article 139(3) EPC. However, this Article does not relate to the prosecution of European patent applications or to the validity of European patents in opposition or appeal proceedings. It only relates to the relationship between patents granted by the EPO and patents granted by a national patent office. Article 139 (3) EPC authorizes the contracting states to prescribe whether and under what conditions the same invention can be protected simultaneously through European and national patents with the same filing or priority date and the same applicant.

Thus, the decision on allowing double protection in respect of a nationally granted patent and a patent granted by the EPO is exclusively to be made by each contracting state and the EPO has no involvement in such decisions.

A large number of the contracting states have made use of this authorization and restricted the possibility of such double protection whereas other contracting states allow such double protection.

Thus, the EPC itself does not provide any explicit basis for an Examining Division to refuse an application or for an Opposition Division to revoke a patent on the basis of double patenting. This must also be the case for the TBAs and the EBA.

From the EPO's own booklet "National law relating to the EPC" it can be seen that the question of double patenting is handled differently in various jurisdictions:

- contracting states that prohibit double patenting, i.e. the national patent is revoked upon grant of the European patent at the end of the opposition/opposition period: Ireland, North Macedonia, Lithuania and the UK
- contracting states that prohibit double protection, i.e. the national patent ceases to have effect, for the common parts, upon grant of the European patent, at the end of the opposition/opposition period: Albania, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Estonia, France, Germany, Greece, Italy, Latvia, Liechtenstein, Luxembourg, Malta, Monaco, the Netherlands, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Switzerland and Turkey, as well as past and current (Bosnia and Herzegovina, Montenegro) extension states.
- contracting states that allow double patenting/protection: Austria, Denmark, Finland, Hungary, Iceland, Norway, Poland, Portugal, Sweden, as well as Morocco and Moldavia (validation states).

Many of the member accept double patenting, and the EPO should thus not prevent double patenting in those states.

3.3 It has been argued that Article 125 EPC could be relied on to provide an implicit basis in the EPC for a prohibition on double patenting. Article 125 stipulates that:

In the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States.

It can be seen from this that Article 125 relates only to procedural law. An Examining Division can only refuse an application under Article 97(2) EPC and an Opposition Division can only revoke a patent under Article 101(2) EPC. These are provisions of substantive patent law. It is therefore clear that Article 125 EPC cannot be relied on at all.

3.4 Even if (which is not the case) it was possible to rely on Article 125 EPC, the conditions in Article 125 EPC are clearly not satisfied. Article 125 specifically refers to taking into account principles of procedural law “generally recognised” in the Contracting States. In the case of double patenting, it is clear that this condition is not met.

In the Travaux Préparatoires to EPC 1973, Article 125 and the question of double patenting were discussed:

Article 125 – Reference to general principles

665. 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.

666. The Norwegian delegation stated that it could not agree to this principle in its present general form since under Scandinavian law it was possible in theory to grant two patents to an applicant for the same invention.

The Minutes, and especially Minute 666, show that such an absence of a prohibition on double patenting was deliberate due to disagreement.

Therefore, the legislative history of Article 125 EPC shows that it cannot be used as basis for introducing a prohibition on double patenting because there was no general acceptance that there should be such a prohibition.

3.5 Taking the Vienna Convention into consideration in the interpretation of the EPC

epi is also of the view that the Vienna Convention on the Law of Treaties (VCLT) is relevant to the questions to be addressed by the EBA. First it must be considered if the VCLT applies to the EPC.

VCLT Article 4 states:

Article 4. NON-RETROACTIVITY OF THE PRESENT CONVENTION

Without prejudice to the application of any rules set forth in the present Convention to which treaties would be subject under international law independently of the Convention, the Convention applies only to treaties which are concluded by States after the entry into force of the present Convention with regard to such States.

In G 5/83, point 5, it is stated that:

The text of Articles 31 and 32, Vienna Convention, has been reprinted in the Official Journal of the EPO, as noted above, and need not be repeated here. The effect of these provisions, so far as concerns interpretation of the EPC can, however, be summarised in the following rules: (1) The treaty must be interpreted in good faith. (2) Unless it is established that the Contracting States intended that a special meaning should be given to a term, the terms of the treaty shall be given their ordinary meaning in their context and in the light of the object and purpose of the EPC. (3) The context, for this purpose, is the text (including the Preamble and Implementing Regulations) and any agreement made between all the parties in connection with the conclusion of the treaty (e.g. the Protocol to Article 69 EPC). (4) There shall also be taken into account: - any subsequent agreement between the parties regarding interpretation or application of the provisions. - any subsequent practice which establishes the agreement of the parties regarding interpretation. - any relevant rules of public international law. (5) The preparatory documents and the circumstances of the conclusion of the treaty may be taken into consideration - in order to confirm the meaning resulting from the application of the previous rules or - to determine the meaning, when applying those rules either leaves the meaning ambiguous or obscure or leads to a manifestly absurd or unreasonable result.

This question is also discussed in the Case Law of the Boards of Appeal, 9th edition III.H.1.1. It is concluded that:

“It is established in the jurisprudence that the principles of interpretation provided for in Art. 31 and 32 Vienna Convention are to be applied when interpreting the EPC.”

Therefore, we can conclude that the VCLT does apply to the EPC.

In the VCLT, is stated that:

Article 31. GENERAL RULE OF INTERPRETATION

1. A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.
2. The context for the purpose of the interpretation of a treaty shall comprise, in addition to the text, including its preamble and annexes:
 - (a) Any agreement relating to the treaty which was made between all the parties in connexion with the conclusion of the treaty;
 - (b) Any instrument which was made by one or more parties in connexion with the conclusion of the treaty and accepted by the other parties as an instrument related to the treaty.
3. There shall be taken into account, together with the context:
 - (a) Any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions;
 - (b) Any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation;
 - (c) Any relevant rules of international law applicable in the relations between the parties.
4. A special meaning shall be given to a term if it is established that the parties so intended.

A requirement of Article 31.2(a) VCLT is that the agreement must be made between **all** parties.

Document M/PR/I, § 665 states:

665. 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.

A majority agreement is not the same as the agreement of all parties. In § 666 the Norwegian delegation specifically stated that it disagreed:

666. The Norwegian delegation stated that it could not agree to this principle in its present general form since under Scandinavian law it was possible in theory to grant two patents to an applicant for the same invention.

3.6 Taking the Minutes of the 10th meeting of Working Party I into consideration in the interpretation of the EPC.

The Minutes of the 10th meeting of Working Party I, held in Luxembourg from 22 to 26 November 1971, BR/144/71, pages 63-66, points 117-120, discuss the double patenting question in respect of divisional applications.

In Document BR/144/71 Section 119 (cited below) it is stated that the Working Party 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:

119. The Working Party finally 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.

However, such declaration was not included in the Minutes of the Diplomatic Conference. In view of the disagreement on this question according to M/PR/I, § 665, **epi** is of the opinion that such declaration was deliberately omitted, showing that there was not unanimous agreement that double patenting should be prohibited.

3.7 Not Taking the Decision in G 1/05 and G 1/06 into consideration in the interpretation of the EPC.

In the consolidated decision for G 1/05 and G 1/06, the EBA considered the question of whether a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extended beyond the content of the earlier application, can be amended later in order to make it a valid divisional application.

In the analysis in G 1/05 and G 1/06, the EBA discussed the situation of double patenting briefly and made an *obiter dictum* in point 13.4:

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. However, this principle could not be relied on to prevent the filing of identical applications as this would run counter to the prevailing principle that conformity of applications with the EPC is to be assessed on the final version put forward (see point 3.2 above).

It is clear that the EBA in that case had not been presented with any arguments on the point. It is also clear that the EBA in that case did not provide any detailed analysis of the point and

did not provide any legal basis for its comment that there is a basis for a prohibition of double patenting.

epi is of the opinion that the *obiter dictum* in G 1/05 and G 1/06 was neither reasoned nor substantiated by any legal basis and therefore no weight should be given to this *obiter dictum*.

3.8 Summing up the above analysis:

- i. There is nothing in the wording of the EPC that prohibits double patenting.
- ii. The legislative history of the EPC shows that the question of prohibiting double patenting was considered and rejected.
- iii. There was no common practice between the Contracting States concerning double patenting, and that is why there was no prohibition of double patenting in the EPC.
- iv. The only reference in the EPC to prohibiting double patenting is in relation to double patenting between European patents and national patents and leaves this matter in the hands of the Contracting States to decide as they wish in their territory.
- v. There is no power for the EPO to refuse a European application for double patenting in the face of national equivalents, even if there is a national equivalent in every Contracting State.
- vi. The absence from the EPC of a prohibition against double patenting was deliberate and built into the EPC at its outset.
- vii. The practice of prohibiting double patenting in proceedings before the EPO is therefore a practice outside the legislative framework and history of the EPC.
- viii. Providing a judicial prohibition against a practice that the Contracting States considered, and decided not to prohibit, is legislation in a different guise: The Boards of Appeal are not a legislature.

If double patenting is a problem [that some countries permit double patenting indicates it not to be a problem in practice] the problem should be solved legislatively [either at the level of the EPC or the Contracting States] and not through judicial interpretation.

3.9 For the reasons outlined above, the **epi** is of the opinion that the answer to Question 1 should be “No”.

Thus, **epi** is of the opinion that a European patent application can NOT 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.

If, contrary to **epi**'s opinion, refusal of subject matter for the reason of double patenting, could be possible under Article 97(2) EPC, it should **only** be applied in cases concerning (1) identical subject-matter (identical wording of the claims), (2) same applicant, (3) same filing date, (4) same priority date and (5) same or overlapping designated states.

4 Question 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 of a European patent application on the basis of which a European patent was granted to the same applicant?

(These three types a), b) and c) will be addressed separately below)

4.1 If the EBA has concluded that the answer to question 1 is “yes”, such a conclusion must be founded on the *obiter dictum* in G 1/05 and G 1/06 (emphasis added):

*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 ...*

This *obiter dictum* is entirely based on an applicant’s “legitimate interest”. Thus, according to the *obiter dictum*, an applicant has no legitimate interest in the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor. In such a case, then he cannot have such a second patent.

On the other hand, it must then be concluded that where the applicant **has** a legitimate interest in the grant of such a second patent, then he **can** have such second patent.

The question is thus, what is meant by “legitimate interest”?

The EPC does not explicitly define this phrase. However, the phrase “legitimate interest” is frequently applied by the Boards of Appeal:

T 239/16: The board stated that according to the notice trivial reasons would clearly not justify acceleration. It followed from the scenarios in the notice that the term "legitimate interest" was not to be construed as requiring compelling reasons. Rather, objective reasons had to be put forth that warranted giving the appeal priority.

T 2434/09: If a European patent application is finally deemed to be withdrawn after an admissible appeal against a decision refusing it has been filed, the appeal can usually be considered disposed of, because there is no possibility of a European patent being granted for the application. However, where, as in the case before the board, the sole aim of the appeal is to obtain a finding by the board that a substantial procedural violation occurred in the first instance proceedings, such that the appealed decision is to be set aside and the appeal fee reimbursed, the appeal cannot be dealt with in this way. In these circumstances the appellant has a legitimate interest in receiving a decision on the merits of the appeal.

The term “legitimate” generally means “conforming to the law or to rules”.

Considering the above, **epi** is of the opinion that the phrase “legitimate interest” should be interpreted to mean that the applicant has an objective reason that is not prohibited by law.

Thus, to answer the question 2.1, **epi** applies the following interpretation of the *obiter dictum* in G 1/05 and G 1/06:

Where the applicant has an objective reason for the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor, then he can have such a second patent.

4.2. **epi** is of the opinion that the scenarios a), b) and c) as explained in point 4. above are not a matter of conditions. The scenarios are just different.

In view of **epi**'s opinion in point 3.9 above, applications of type a) and b) should be treated differently from applications of type c). Type c) is different because it does not meet the premises of a double patenting case. Types a) and b) may be refused where there is (1) identical subject-matter (identical wording of the claims), (2) same applicant, (3) same filing date, (4) claims the same priority or priorities and (5) same or overlapping designated states.

It should be noted that in the case where EP1 and EP2 claims a common priority, e.g. the same earliest priority but EP2 claims an additional later priority date. In such case, EP2 should not be refused if EP1 has been granted.

4.3 **epi** considers that an applicant of a type a) or type b) application might have subjective reasons for pursuing several patents with same subject matter. However, in case of an application of type a), we must distinguish between applications claiming the same priority or priorities (**In the following referred to as applications of type a1**) or applications that does not (**In the following referred to as applications of type a2**). Even with the same filing date, having an additional priority might be an objective reason. The priority claim may have been forgotten in either application, and it may be too late to add it or correct.

For applications of type a1) and type b) it is not immediately clear if such an applicant will have any objective reasons.

Thus, based on the presumption that the answer to Question 1 is “yes”, **epi** is of the opinion that a European patent application of type a1) or type b) might 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, unless where the applicant has an objective reason.

4.4. **epi** considers that an applicant of a type a2) application **does** have an objective reason for pursuing several patents with same subject matter, having same filing date and where one of the patents claims at least one priority that is not claimed in the other patent.

In this situation, the claimed subject matter may not have same priority date. In our opinion this alone provides an objective reason.

4.5. **epi** considers that an applicant of a type c) application **does** have an objective reason for pursuing several patents with same subject matter, namely the reason of obtaining an additional year of patent protection.

epi finds that the reason that an additional year of patent protection obtained in scenario c) substantiates an objective and therefore legitimate interest for the applicant to obtain a second patent for the same subject-matter.

epi also notes that the *obiter dictum* in G1/05 and G1/06 does not distinguish between cases of type a), b) or c). In this context, it is also noted that many T decisions only concern cases of type a) or b).

Type of application	Summary reason	Decision code
two EP applications filed on same day, claiming priority of same two US applications	> No overlap between claims of granted patent and application at issue	1994_0169_T
Divisional	> No overlap between claims of granted parent patent and opposed patent as amended	1998_0080_T
Divisional	> Parent claim overlaps all the features of divisional claim combined with an additional feature	1998_0587_T
divisional application in view of parent patent	> A60EPC => only one patent > claims of patent at issue overlap fully claims of granted patent	2003_0307_T
Divisional	> no overlap between claims of application at issue and claims of parent and other copending divisional applications	2003_0425_T
Divisional	> Claims of divisional identical to claims of granted parent patent > No legitimate interest for second grant	2005_0001_G
Divisional	> other pending applications need not be considered for double patenting objection	2006_1491_T
Divisional	> simple overlap in scope of protection not enough basis for double-patenting objection	2007_1391_T

divisional application in view of parent patent	> no overlap between claims of application at issue and claims of parent patent	2009_1225_T
Divisional	> not the same subject matter	2011_0649_T
Divisional	> review of double patenting throughout a patent family (two granted patents and application under review) > claimed subject matter encompassed by granted claims > no issue with double patenting	2011_1155_T
Divisional	> patent in suit narrower than parent	2011_2533_T
Divisional	> parent and divisional do not have the same description, but what matters is the claims, not the description	2011_2563_T
Divisional		2012_0434_T
Divisional	> direct application of T 1780/12	2012_0879_T
Divisional	> subject-matter of a claim = 1) category of claim, and 2) technical features	2012_1780_T
Divisional	> subject-matter of application under review (method claims) different from that of granted parent patent (product claims)	2013_1765_T
Divisional	> subject-matter of application under review (method claims) different from that of granted parent patent (product claims)	2013_1766_T
Divisional	> subject-matter of claim 1 of application under review would be identical to that of claim 2 of the parent patent	2013_1871_T
Divisional	> purpose-limited product claims (application under review) vs Swiss-type claims (parent patent)	2014_0013_T
Divisional	> subject-matter of a claim = 1) category of claim, and 2) technical features > purpose-limited product claims belong to different category than Swiss-type claims	2014_0015_T

4.6 Summing up the above analysis, **epi** is of the opinion that the answer to Question 2.1 should be as follows:

Based on the presumption that the answer to Question 1 is “yes”, a European patent application of type a) or type b) can 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.

A European patent application of type c) **cannot** 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, because the applicant has an objective reason for pursuing several patent with same subject matter, namely the reason of obtaining an additional year of patent protection.

5. Question 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?

5.1 The answer to this question is already contained in the answer to Question 2.1, namely that an applicant **does** 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.

6. Summary

epi is of the opinion that the answers to the questions should be as follows:

Question 1 – No, which means that the remaining questions do not need to be answered.

However, if, contrary to the opinion of **epi**, the EBA answers Question 1 as “yes”, then:

Question 2.1(a) – Yes for applications of type a1) (applications with same priority/priorities)

– No for applications of type a2) (application without same priority/priorities)

Question 2.1(b) – Yes

Question 2.1(c) – No

Question 2.2 – see answer to Question 2.1.