Dear All,

At the outset, we would like to thank EPO and the participants for the very interesting and constructive meeting of the SACEPO WG Guidelines

During the meeting we discussed a paragraph that was inserted in G-IV, 5.4 related to double patenting. According to the insertion

> *The prohibition of double patenting applies to three types of combinations of European applications by the same applicant: two applications filed on the same day, parent and divisional applications, or an application and its priority application.*

In relation to this new paragraph, it was mentioned that the prohibition in respect of the third type of combinations, namely the combination of an application and its priority application was based on decision T2402/10.

We have carefully examined decision T2402/10 as well as other decisions relating to double patenting and we would like to draw your attention to the following:

- The reasons of the decision T2402/10 do not provide any argument supporting the prohibition of the third type of combinations.
- On the contrary, decision T1423/07 clearly holds that no double patenting issue arises from internal priority: *"Headnote 2: If double patenting arises from internal priority, the applicant has a legitimate interest in the grant of the subsequent application claiming priority from an already granted European application with identical claims and identical Designated Contracting States in view of the fact that the filing date and not the priority date is the relevant date for calculating the 20-year term of the patent."*
- Decision T1423/07 is also discussed in the publication of the Case law (edition 2016) in Part II-F, 5 as follows: "*For the matter of double patenting arising not from the filing of a divisional application but from* ***internal priority*** *see* ***T 1423/07****, in which the board held that double patenting was not prohibited for European applications claiming a European priority because of the applicant's clear legitimate interest in the longer term of protection*

*possibly available with the later filing, in view of the fact that the filing date and not the priority date was the relevant date for calculating the 20-year term of the patent (see also **T 2461/10**, which also concerned a case of internal priority and which left this point open).”*

From the above we are of the opinion that the inserted paragraph at least in respect of the third type of combinations is not correct and should be deleted from the Guidelines.

We remain at your disposal for any further clarification

Yours

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epi members of SACEPO WP Guidelines

4 December 2018