



# Newsletter Edition 2/2019

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Still no decision on the Unitary Patent System

M I C H A L S K I



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P A T E N T   A T T O R N E Y S

# G 1/19? A New Referral to EPO's Enlarged Board of Appeal on Double Patenting

Following a period in which no referred questions were pending before the Enlarged Board of Appeal – at least until the re-referral of Case No. G 1/14 (now known as Case No. G 1/18) by the President of the EPO pursuant to Article 112(1)(b) – a Technical Board of Appeal has now once again referred questions of law to the Enlarged Board of Appeal pursuant to Article 112(1)(a).

In Applicant Complaint No. [T 318/14](#), for which a written decision from the Board of Appeal is not yet available, the specialist examiner in the examination procedure objected to the fact that the pending patent claims were identical to those in the priority application of the application, which was also an EP application. The applicant, for its part, invoked joint Decisions Nos. [G 1/05](#) und [G 1/06](#) as well as Decision No. [T 1423/07](#) and left the claims unmodified in two filed responses. The Examination Unit thereupon denied the application.

In its Decision No. G 1/05 (G 1/06), the Enlarged Board of Appeal accepted, under Point 13.4, that *'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.'* Thus, the Enlarged Board found *'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.'* By taking this position back in 2007 – in what was an apparently comparable situation – the Enlarged Board of Appeal seemed to clearly contravene the view taken by the applicant in the case at hand. So it may appear strange at first that the applicant chose to rely precisely on this statement by the Enlarged Board of Appeal.

The applicant argues, however, that the Enlarged Board of Appeal was actually stating its position on an entirely different issue, namely that of divisional applications, and that its own situation was in no way comparable: Since the protection period of 20 years is reckoned as of the filing date, this means that, for purposes of a follow-on application, a denial of the applicant's filing would rob the applicant of one of year of protection to which it was rightfully entitled. In the applicant's view, the Examination Unit's decision was placing it in a worse position than that of external priority.

In Decision No. [T 1423/07](#) cited by the applicant, a Technical Board of Appeal had already decided back in 2010 that a double patent which arises from internal priority entails a legitimate interest on the part of the applicant and that, in view of [G 1/05](#) ([G 1/06](#)), it would be superfluous to make a referral to the Enlarged Board of Appeal. The follow-on application was granted in this case.

Nonetheless, the Board of Appeal competent in the case at hand was evidently unwilling to follow Decision No. [T 1423/07](#). In its preliminary statement of position, it cited various decisions by Technical Boards of Appeal that featured contrasting evaluations. Decision No. [T 2461/10](#), for example, deviated from other decisions in holding that the evident legislative intent behind the *travaux préparatoires* was *'that a double patenting of the same invention in all three... case scenarios (submission of two European applications on the same day by the same person, parent/divisional application and priority application/follow-up application) should not be possible.'*<sup>1</sup> The Board of Appeal also pointed out that individual decisions had taken conflicting views on whether the objection of double patenting can be raised only if identical subject matter is involved or whether it is already sufficient if the claims being objected to fall under the already granted subject-matter of another filing by the same applicant.

<sup>1</sup> See Point 11 of the reasoning for Decision No. [T 2461/10](#)



## And in our own affairs...

As already announced, our annual Patent Seminar will take place at the Industrieclub in Düsseldorf on 11 April 2019. Our featured guest speakers will be Steffen Adams (thys-senkrupp Intellectual Property GmbH), Dr. Stefan Horstmann (Merck KGaA) and Dr. Hans Kornmeier (ifm electronic).

If you would like to attend this free-of-charge seminar, please email us your request along with your mailing address at [seminar@mhpatent.de](mailto:seminar@mhpatent.de)

The next Rhineland Biopatent Forum will be held on 6 June 2019 at our branch office in Düsseldorf.

If you would like to attend this free-of-charge seminar, please email us your request at [seminar@mhpatent.de](mailto:seminar@mhpatent.de).

The Board is now asking the Enlarged Board of Appeal to answer the question of whether an EP application can be denied if it lays claim to the same item as one already claimed in a European Patent that has been granted to the same applicant and that does not form part of the state of the art pursuant to Article 54 (2) and (3) EPC. Assuming this is affirmed, the Board of Appeal also asks whether it makes a difference if the filing date is not the same as that of already granted patent, particularly when the granted patent is a priority application.

Generally speaking, the established legal precedent of the Technical Boards of Appeal displays a tendency to construe the ban on double patenting ever more narrowly. But this tendency will probably not keep the Enlarged Board of Appeal from admitting the referred points of law. In this context, the Technical Boards of Appeal have increasingly focused on the question of whether the applicant has a legitimate interest in the renewed patenting. Given this tendency, the applicant's prospect would seem to be highly promising.

As far as we know, however, Decision No. T 1423/07 is the only decision till now to go so far as not to confirm the ban on double patenting even where the protected subject matter is completely identical. Moreover, the Enlarged Board of Appeal is unlikely to accord any great significance to trends in established legal precedence in and of themselves. Far greater weight will probably be given to the applicant's argument regarding unequal treatment of internal and external priority and to the question of how much weight the Enlarged Board of Appeal should accord to the points made in the *travaux préparatoires* (see above).

To sum up, we are proceeding on the assumption that the Enlarged Board of Appeal will reach a decision on double patenting under Case No. G 1/19 sometime in the years to come. Hopefully, this decision by the EPO's highest authority will serve to conclusively settle the matter.

## “Patent Law” committee to propose a revision of Article 53 EPC to the EPO's Administrative Council

The sensation-causing Decision No. [T 1063/18](#), which invalidated Rule 28(2) of the European Patent Convention (EPC),<sup>2</sup> is drawing wider repercussions. Said Rule 28(2) had stipulated that *'European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process.'* This decision directly contradicted the ones made by the Enlarged Board of Appeal in the *Tomate II* case ([G 2/12](#)) and *Brokkoli II* case ([G 2/13](#)), which had not affirmed such a preclusion of patenting but had instead deemed patenting to be possible in principle. This was consciously intended, moreover, given that the two aforementioned decisions had engendered political opposition, particularly in the wake of a Notice published by the EU Commission (in response to an enquiry from the EU Parliament), which stated that the legislative intent of the Biopatent Directive had been to preclude patent protection for such plants and animals.

After the Syngenta company's Application No. [EP 2 753 168](#) for pepper plants had been denied precisely on the grounds of this subsequently introduced Rule 28(2), and after Syngenta had appealed, Technical Board of Appeal 3.3.04 decided that the rulings of the Enlarged Board of Appeal regarding the interpretation of Article 53 EPC took higher precedence and that Rule 28(2) was inapplicable (while citing Article 164(2) EPC to the effect that articles take precedence over rules), and that the application was to be denied so that the issues of clarity and novelty could be clarified.



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<sup>2</sup> See the 6/2018 edition of our [Newsletter](#)

The “[Patent Law](#)” Committee at the European Patent Office, which advises the Administrative Council and, like the Council, consists of delegates of the Contracting States and the EPO’s President, determined [in its most recent meeting](#) that this decision was a point in need of resolution from the perspective of the Contracting States. Thus, the delegates of the Contracting States were unanimous in their refusal to accept the consequences of Decision No. T 1063/18. A majority within the Committee wanted to instead find a way to re-refer the matter to the Enlarged Board of Appeal. Many of the Contracting States also raised the question of whether the Administrative Council might be able to revise the EPC upon its own initiative.

It is therefore safe to assume that the Administrative Council of the EPC will discuss these two options at its next session and that it may already adopt a resolution at this time.

Under current law, the only way of referring the matter to the Enlarged Board of Appeal would have been through the Technical Board of Appeal in connection with Decision No. T 1063/18. The Board of Appeal saw no need to do this, however.<sup>3</sup> Apart from that, the President of the EPO could theoretically make a referral to the Enlarged Board of Appeal insofar as deviating decision-making practices were deemed to be involved. But where only a single Technical Board of Appeal is competent – as in the present case – this option is precluded *de facto* as well as *de jure*. And even if a way of referring the matter to the Enlarged Board of Appeal could be found, it would by no means be certain that the Enlarged Board of Appeal would arrive at the decision envisioned by the delegates of the EPC’s Contracting States.

Thus, there is a certain likelihood that a decision by the Administrative Council will serve to integrate the patent preclusion of Rule 28 into Article 53(b), thereby making the preclusion permanent. The Administrative Council’s competence to revise articles, which is by rights reserved to a diplomatic Conference of Contracting States pursuant to Article 172 of the EPC, is being justified on the basis of Article 33(1) EPC, which states that the Administrative Council is authorised *„to amend Parts II to VIII and Part X of this Convention, to bring them into line with an international treaty relating to patents or European Community legislation relating to patents.’*

The aforementioned Article 53 belongs to Part II of the Convention; the lack of concordance with the legal regulations of the EU arises, in the view of the delegates of the Contracting States, from the above-referenced [Notice](#) issued by the EU Commission. Interestingly enough, however, the Notice and the possibility that it might necessitate a different interpretation of Article 53 EPC were topics already discussed in Decision No. T 1063/18.<sup>4</sup> The Board of Appeal noted, however, that according to Article 267(2) of the EU Treaty, the competence to interpret directives rightfully lies with the European Court of Justice, and that the Notice per se therefore had no “legal authority.”

It remains to be seen whether or not the European Patent Convention will actually be amended and whether this amendment will stand scrutiny, whereby it is also unclear who is actually competent to decide this. Is it the Boards of Appeal themselves? Or the Enlarged Board of Appeal? Or is no legal instance competent? Thus, our assessment in the 6/2018 edition of our Newsletter – i.e. that the delegates of the EPC’s Contracting States could well take Decision No. T 1063/18 as an open affront – has proved correct. There is evidently a consensus among the delegates of the EPC’s contracting states that animals and plants should be precluded from patentability.

#### And in our own affairs...

Dr. Stefan Michalski will be the featured panellist for the topic „Effective Portfolio Management“ at the [IPBC Korea](#) to be held in Seoul, South Korea on 5 April 2019.

Dr. Aloys Hüttermann will give a talk on Constitutional Complaint No. BvR 739/17 at the [Annual Convention of EPLIT](#) in Vienna, Austria on 5 April 2019.

Guido Quiram will moderate the workshop “How Big Data, IoT and AI Impact Consumer Products” at the [LESI Annual Conference in Yokohama](#), Japan on 27 May 2019.

<sup>3</sup> See Points 38 and 39 of the reasoning for the Decision

<sup>4</sup> See, for example, Points 28 and 29 of the reasoning for the Decision

# Still no decision on the Unitary Patent System

As the March 29 Brexit deadline looms ever closer without any political settlement in sight, there is also nothing new to report about Germany's Federal Constitutional Court (*Bundesverfassungsgericht*). With one exception: In the Annual Preview for 2019, Constitutional Complaint No. 2 BvR 739/17 once again appears on the list of cases the Court is thinking of adjudicating during the year. It is now almost two years since the complaint was first submitted – a disappointment to those who hoped that the Court would give the case priority, given that it involved the unusual circumstance of a piece of legislation being blocked shortly before being signed into law by Germany's Federal President.

This means that, barring unforeseen events (e.g. if Great Britain withdraws its application under Article 50 of the EU Treaty, which it could do unilaterally according to ECJ Ruling No. *C - 621/18*), the Unitary Patent System will not be able to come into force with Great Britain as an EU Member State, even if a positive ruling by the Federal Court of Justice were to lead to immediate German ratification. The possibility has been raised that Great Britain could nonetheless remain within the Unitary Patent System.<sup>5</sup> But even under the best-case scenario, this would require corresponding political will in Britain as well as in the remaining Member States. Moreover, the ECJ would have the final say on the matter. The point has been made that the Federal Constitutional Court could and should state its position on the constitutionality of a Unitary Patent System that includes Great Britain by way of an *obiter dictum*, given that a failure to do may well invite further constitutional complaints.

Generally speaking, the political will to introduce the Unitary Patent System seems to remain intact, provided the Federal Constitutional Court gives the green light. On the other hand, recent statements to the effect that ratification would presuppose corresponding legal certainty – like the one made by the competent Department Head *Karcher*<sup>6</sup> – tend to indicate that Great Britain will participate only if the corresponding legal flanking measures are treated as essentially final and non-appealable by the ECJ and only if the Federal Court of Justice, too, does not throw up any obstacles. If it comes to a hard Brexit, however, then a Unitary Patent System with the participation of Great Britain would probably be impossible – although this would at least provide the desired legal certainty.



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<sup>5</sup> See the 3/2016 edition of our [Newsletter](#).

<sup>6</sup> E.g. at the Mannheimer Patenttage 2018 convention held in Heidelberg in November 2018