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**Datasheet for the decision
of 22 June 2021**

Case Number: G 0004/19
Appeal Number: T 0318/14 - 3.3.01
Application Number: 10718590.2
Publication Number: 2429542
IPC: A61K35/74, A23L1/30, A61P37/08,
A61P1/12
Language of the proceedings: EN

Title of invention:
PREVENTION AND TREATMENT OF ALLERGIC DIARRHOEA

Applicant:
Société des Produits Nestlé S.A.

Headword:
Double patenting

Relevant legal provisions:
EPC Art. 52(3), 54(2), 54(3), 60(1), 63(1), 64(1), 66, 67(1),
76(1), 79, 79(3), 87, 88, 90(5), 94, 97(2), 112, 112(1),
123(2), 123(3), 125, 139(3), 177
EPC 1973 Art. 64(1), 67(1), 87, 165(1), 165(2), 166, 167
RPEBA Art. 9, 10

International Conventions

Vienna Convention on the Law of Treaties of 23 May 1969
Art. 11, 12, 14, 15, 31, 31(1), 31(2), 31(2)(a), 31(2)(b), 32,
32(a), 32(b), 33

Keyword:

Admissibility of referral - (yes)
Interpretation of Article 125 EPC
Procedural provision absent from the Convention
Supplementary means of interpretation under the Vienna
Convention on the Law of Treaties
Legal basis for a refusal under Article 97(2) EPC for double
patenting

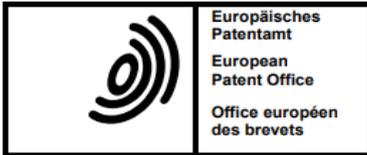
Decisions cited:

G 0001/97, G 0001/05, G 0001/06, G 0001/11, G 0001/14
T 0587/98, T 1391/07, T 1423/07, T 2461/10, T 2563/11
T 0879/12, T 1780/12, T 0318/14

Headnote:

1. A European patent application can be refused under Articles 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been 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. The application can be refused on that legal basis, irrespective of whether it
 - a) was filed on the same date as, or
 - b) is an earlier application or a divisional application (Article 76(1) EPC) in respect of, or
 - c) claims the same priority (Article 88 EPC) as the European patent application leading to the European patent already granted.



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Case Number: G 0004/19

D E C I S I O N
of the Enlarged Board of Appeal
of 22 June 2021

Appellant: Société des Produits Nestlé S.A.
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Representative: Lomholt, Stig Bredsted
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Referring decision: Interlocutory decision T 0318/14 of
Technical Board of Appeal 3.3.01 of the
European Patent Office of 07 February 2019

Composition of the Board:

Chairman: C. Josefsson
Members: T. Bokor
M.-C. Courboulay
J. Karttunen
W. van der Eijk
G. Eliasson
A. Ritzka

Summary of facts and submissions

I. By its decision in appeal case T 0318/14 dated 7 February 2019 (OJ EPO 2020, A104) and issued in writing on 20 December 2019, Board of Appeal 3.3.01 referred the following questions to the Enlarged Board of Appeal:

"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?"

II. The appeal before the referring Board (in the following "the Board") was against the decision of the Examining Division refusing European patent application No. 10718590.2 under Article 97(2) EPC in conjunction with Article 125 EPC. The

Examining Division found that claim 1 of the sole claim request on file was directed to subject-matter which was identical to the subject-matter claimed in European patent No. 2 251 021, which was granted for the European patent application from which the application-in-suit claimed priority. Granting a second patent on this claim was held to be contrary to the principle of the prohibition on double patenting (in the following also referred to as just "the prohibition"), this being an accepted principle in most patent systems, as stated in the Guidelines. The applicability of the prohibition was furthermore confirmed by an *obiter* statement in the Enlarged Board of Appeal's decisions G 1/05 and G 1/06. The Examining Division held that the prohibition also extended to European applications claiming an internal priority from another European application, and that decision T 1423/07 was not applicable because the applicants were different in that case.

III. The appellant applicant argued in its appeal that the prohibition did not apply in a situation of internal priority. Decisions G 1/05 and G 1/06 related to divisional applications, and applied only in that context. Decision T 1423/07 recognised the existence of a legitimate interest, namely the longer term of protection available to an applicant as a result of claiming an internal priority. The "*ne bis in idem*" principle could not support the prohibition either. Article 125 EPC was not a proper legal basis for prohibiting double patenting, because the issue was one of substantive law. The preparatory documents of the Convention, in particular points 665. and 666. of the Minutes of the Diplomatic Conference establishing the Convention, showed that at the Diplomatic Conference there was no agreement on this issue within the meaning of Article 31(2)(a) of the Vienna Convention on the Law of Treaties of 23 May 1969 (in

the following VCLT). Although there might have been a majority agreement on a prohibition, it was restricted to applications having the same filing date. Article 139(3) EPC could not provide a basis for the prohibition either. It demonstrated that double patenting was an issue left entirely to national legislation. A referral to the Enlarged Board was warranted. During the oral proceedings before the Board, the appellant requested as its main request the grant of a patent, and as an auxiliary request a referral to the Enlarged Board, for which purpose it agreed to the wording of the questions proposed by the Board.

- IV. To support its arguments, the appellant referred to several documents from the collection of the preparatory documents of the Convention (commonly referred to as the "*travaux préparatoires*"). They are treated in more detail in the Reasons of the present decision.
- V. The referring decision examined those provisions of the Convention which have so far been considered in the case law of the boards of appeal to be a possible legal basis for the prohibition, namely Articles 60(1), 63(1), 76(1) and 125 EPC. The Board regarded none of them as suitable for this purpose.
- VI. The Board's doubts as to the applicability of Article 125 EPC were based on two main lines of reasoning (Reasons, points 56. to 64.). First, the Board found that the wording and scope of Article 125 EPC in themselves, i.e. without the assistance of the *travaux préparatoires*, could not be construed as encompassing the principle of a prohibition on double patenting. Following the rules of interpretation stipulated by Articles 31 and 32 VCLT, Article 125 EPC as interpreted under Article 31 VCLT was neither ambiguous or obscure, nor manifestly absurd or unreasonable, and therefore

was not open to an interpretation under Article 32 VCLT which would also take into account the legislative intent derivable from the *travaux préparatoires*. Secondly, given the lack of agreement on the issue among all the Contracting States during the Diplomatic Conference, an interpretation of Article 125 EPC on the basis of a separate common agreement of all parties or an instrument accepted by all parties within the meaning of Article 31(2)(a) or (b) VCLT, respectively, was not possible either.

- VII. The preparatory documents relied on by the Board in connection with this and other points in its Reasons are treated in detail in the Reasons of the present decision.
- VIII. The President of the EPO was invited to comment on the referral, and third parties were given the opportunity to file submissions under Articles 9 and 10 of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA). Their submissions were forwarded to the appellant.
- IX. In his comments dated 21 September 2020, the President of the EPO submitted that the legal basis for the prohibition was Article 125 EPC. The legislative intent to prohibit double patenting under this article could be clearly derived from the preparatory materials of the Convention. The existence of this principle in the majority of the Contracting States could be inferred from their national legislation implementing Article 139(3) EPC. It was true that there had been no agreement by all parties on this issue during the Diplomatic Conference, but such an agreement was not necessary. The majority agreement could still be taken into account as the identifiable legislative intent, and thus as a supplementary means of interpretation under Article 32 VCLT. Recourse to the preparatory documents under Article 32 VCLT

was permissible for the purpose of confirming the above interpretation of Articles 125 and 139(3) EPC. Thus the Office's long-standing practice of applying the prohibition was correct, and was also supported by decisions G 1/05 and G 1/06 of the Enlarged Board.

- X. Amicus curiae submissions were filed under Article 10 RPEBA by several professional associations, companies and private persons. Two submissions were made anonymously. The majority of them supported the view that there is no proper legal basis under the Convention for a prohibition on double patenting or thus for the practice of the Office.
- XI. The appellant made no further submissions. Nor did it request oral proceedings before the Enlarged Board. Therefore the present decision can be issued in written proceedings without prior oral proceedings.

Reasons for the decision

A. Admissibility of the referral

A.1 Interpretation of the referred questions

1. The essence of Question 1 is as follows: is there any legal basis under the EPC for refusing an application on the ground of double patenting?
2. The Board set out in detail what it understood by the term "double patenting" (Reasons, points 17.-23.), and the Enlarged Board reads this term in the same sense. Nevertheless, while the basic question being asked may be put simply, there are good reasons why the Board was justified in wording Question 1 in a more differentiated manner, bearing in mind that the term "double patenting" itself may not be completely clear once isolated from the specific situations addressed in the referral and in the relatively small body of

existing board of appeal case law. First, a distinction must be made between the situation falling under Article 139(3) EPC (simultaneous protection by a national and a European patent) and double patenting in the narrow sense, where two or more European applications are involved (Reasons, points 19. and 21.). Secondly, the distinction between double protection (claims with overlapping scope) and double patenting also needs to be kept in mind (Reasons, point 24.). The Enlarged Board notes that the term double protection in German ("Doppelschutz") is also used to denote the situation governed by Article 139(3) EPC and comparable situations of parallel protection.

3. Even if "double patenting" is immediately understood in its narrow sense, the term alone may not be sufficient to indicate to the reader that the issue at stake in the referral is whether there is a legal basis in the EPC for prohibiting double patenting. While there is case law which deals specifically with the question of a legal basis for the prohibition, there are also decisions which concern rather the definition of "the same subject-matter" or "the same applicant" in the context of double patenting. The manner in which these elements are incorporated into the wording of Question 1 makes it clear that these points of law are not the subject of the present referral.
4. The referral gives no particular explanation why Article 97(2) EPC is mentioned in Question 1. The Enlarged Board takes it that its inclusion serves to distinguish a refusal of a patent application following examination by the Examining Division from other possible refusals, such as by the Receiving Section under Article 90(5) EPC. The main focus of the referral is on an analysis of the various provisions of the Convention which have been put forward in the case law

as the legal source of the double patenting prohibition (Articles 60, 63, 76, 125 EPC), and which as such may potentially be invoked in conjunction with Article 97(2) EPC as the legal basis for a refusal. The Board also stated that the referral does not extend to the question whether and how the prohibition might be applicable in opposition proceedings (Reasons, point 31.). Thus the Enlarged Board considers that the reference to Article 97(2) EPC makes it clear that the referred question is restricted to (the applicability of the prohibition during) substantive examination proceedings under Article 94 EPC before the Examining Division.

5. Question 1 does not mention the additional condition that both the granted and the potential European patent must have an effect in the same territory. Given the system of designations (Articles 66 and 79 EPC), and in particular the possibility to withdraw individual designations (Article 79(3) EPC), it is the Enlarged Board's understanding that in current Office practice an objection of double patenting is only raised if there are overlapping and still valid designations in both the granted patent and the application concerned. As it is clear from the Reasons of the referring decision that the Board was well aware of this condition (points 29. and 30.), the Enlarged Board considers that it is also implied in the question itself.
6. The essence of Question 2.1 is as follows: if there is a legal basis in the EPC for the prohibition on double patenting, are all three of the possible constellations in which double patenting may arise to be treated in the same manner? Common to these constellations is that the granted patent and the application both have the same effective date (point 18. of the Reasons).

7. Question 2.1 is to be answered only if the Enlarged Board finds that there is a legal basis in the EPC for the double patenting prohibition. The formulation "... *what are the conditions for such a refusal ... ?*" may appear very broad in scope and intended to cover all possible criteria for establishing the conditions to be met for the double patenting prohibition to apply. For example, the referral invites the Enlarged Board to clarify the conditions for a "[lack of a] legitimate interest", which G 1/05 and G 1/06 saw as a possible basis for the prohibition (Reasons, point 13.4). It also invites the Enlarged Board to clarify the concept of "the same invention" (Reasons, point 80.). The *amicus curiae* submissions also ask for the criteria to be applied in defining "the same applicant". It is nevertheless clear from the Reasons of the referring decision that the central point of question 2.1 is really an extension of question 1, namely whether the legal basis for the prohibition in the EPC, if there is one, is applicable to all three of the constellations listed, or to only one or two of them. The Enlarged Board will limit itself to answering question 2.1 in this sense.
8. As to question 2.2, it is clear that the Board is primarily interested in knowing if the reason given in T 1423/07 - a legitimate interest in a longer term of protection, having regard to the *obiter* statement of the Enlarged Board in G 1/05 and G 1/06, Reasons, point 13.4 - may establish an exception to the double patenting prohibition for applications having different filing dates, but the same priority date.
9. Questions 2.1 c) and 2.2 are also apparently restricted to cases of internal priority, in which both applications are European applications, with one of them serving as the

priority application for the other. However, as pointed out in the President's comments (point 104.), the same question may be asked in cases where two European applications with different filing dates claim priority from the same national application.

10. Furthermore, Questions 2.1 b) and c) already appear to be restricted to the (likelier) case in which the application filed earlier, (i.e. the application establishing the priority right, or the earlier application under Article 76 EPC - commonly referred to as the "parent application") is also granted first, and the examination of the subsequent application (i.e. the application claiming priority or the divisional application) is concluded later. However, any such restriction would appear to be unintended, and the question can be applied more generally to any procedurally related pairs of applications falling under the constellations of Question 2.1 b) and c), irrespective of which comes to grant first.

A.2 Admissibility criteria under Article 112 EPC

11. Article 112(1) EPC provides:
"In order to ensure uniform application of the law, or if a point of law of fundamental importance arises:
(a) the Board of Appeal shall ... refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. ...
(b) ..."
12. On this basis, a referral to the Enlarged Board by a board of appeal is admissible if there is conflicting case law in the application of the EPC, or if a point of law of fundamental importance arises. Notably, a point of law can be one of fundamental importance even without any conflicting case law.

The necessity to ensure the uniform application of the law may also arise without a high number of conflicting cases (G 1/11, Reasons, point 1.). Finally, a ruling by the Enlarged Board on the question must be decisive for the case before the board (G 1/14, Reasons, point 2.).

13. Question 1 of the referral concerns not merely the correct application of a legal provision, but whether certain procedures carried out by the Office have a proper legal basis. That the actions of public authorities cannot be arbitrary but must be based on the law is considered a fundamental principle of public law (principle of legality). Therefore the Enlarged Board also considers the referred question to be a point of law of fundamental importance, even without divergent or extensive case law on the issue. However, as the Board correctly identified, there is even divergent case law on the question whether any proper legal basis for a prohibition on double patenting exists at all (Reasons, points 43. to 46.), and the main part of the referring decision is dedicated to reviewing and analysing decisions in which different provisions of the EPC were identified as the possible legal basis for the prohibition, or the lack of a legal basis was perceived.
14. Questions 2.1 and 2.2 only become relevant if Question 1 is answered in the affirmative. They address issues which may not immediately appear to be questions of law of fundamental importance, but rather aspects of the application of the principle of the prohibition on double patenting. As already noted in point 7. above, Question 2.1 is formulated in such a way that it may be read as seeking an answer on all conceivable criteria for applying the prohibition. However, a question of such sweeping scope would certainly be inadmissible, given that the Enlarged Board has, as a matter

of principle, no powers to decide in advance on legal issues which have not yet arisen in a case before a board of appeal.

15. In addition, the referral did not indicate that the Enlarged Board needs to clarify all the details of the referred questions. For example, it is not apparent that the definition of the "same invention" is a contentious issue in the case underlying the referral, given that the claims refused by the Examining Division are identical to the claims of the patent granted earlier (Reasons, point 3.).
16. For these reasons, the Enlarged Board reads Question 2.1 narrowly, and as essentially asking whether the possible legal basis in the EPC is equally applicable to the three identified constellations, or whether there may be reasons for treating them differently, for example by establishing an exception for one of them. Further questions which may arise in connection with double patenting, such as the question of the same invention or the same applicant, are not considered to be covered by the referral.
17. The Enlarged Board further notes with regard to the admissibility of Question 2.1 that the decisions cited in the context of the more specific Question 2.2. can also be considered to constitute conflicting case law for the purpose of answering Question 2.1. Thus, for example, there are decisions that view the *obiter dictum* of G 1/05 and G 1/06 as being restricted to divisional and parent applications (T 1423/07, Reasons, point 3.), while others view it as being more general in its scope, or at least as extending to applications linked by priority (T 2461/10, Reasons, point 14., confirmed by T 2563/11, Reasons, point 2.5).

18. One reason for a possible exception from the prohibition is identified in the more specific Question 2.2. For this question, too, the Board demonstrates that conflicting decisions exist (T 318/14, Reasons, points 65.-67.). The question's formulation appears to imply that the justification for a prohibition is the principle of (the lack of) a legitimate interest, following decisions G 1/05 and G 1/06. Thus the Enlarged Board proceeds on the assumption that it may only need to give a separate answer to this question if it concludes that the constellations of Question 2.1 may be treated differently from one another and that a prohibition on double patenting is indeed to be based on the principle of a legitimate interest in the proceedings.
19. The Enlarged Board is satisfied that a ruling on the referred questions (read narrowly) is necessary for the Board's decision on the appeal. The Enlarged Board also considers the structuring of the questions to be appropriate. Although the Board does not specifically say so, it can be inferred from the referring decision that, in the Board's own view, the case before it could potentially be decided at either a general level or a more specific level, depending on the answers of the Enlarged Board. This is reflected in the formulation of the referred questions.
20. Summing up, the Enlarged Board is satisfied that the referral is admissible. More specifically, each of the questions is admissible, provided that the requested clarification of the conditions for a refusal is restricted to those which are inseparable from the question of the legal basis for a refusal. A reformulation of the questions is not necessary. The observations made in points 9. and 10. above on the constellations covered by Question 2.1b) and c) can be taken into account in the formulation of the answers.

B. Substantive issues of the referral: Question 1.**B.1 Article 125 EPC as the suggested legal basis**

21. The Board analysed several provisions of the Convention with respect to their suitability as the proper legal basis for the prohibition on double patenting. From the referral and the totality of the case law it is clear that Article 125 EPC is the most often discussed and, at least *prima facie*, the most promising one. Article 125 EPC is also given in the EPO Guidelines for Examination as the legal basis for refusals, and consequently was also invoked as such by the Examining Division in the decision under appeal. It is therefore appropriate to start with this provision.

B.1.1 Applicability of Article 125 EPC to the question of double patenting

22. Article 125 EPC is titled "Reference to general principles" and provides that "[i]n 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".
23. The first question is whether the scope of Article 125 EPC or, more precisely, a procedural provision which is absent from the Convention but which may be established with the help of a principle of procedural law, may also extend to substantive issues. In the present case it can be asked if the missing, and as such hypothetical, provision which would govern the matter of double patenting could be classified as a procedural provision. Put differently, the term "procedural provision" requires interpretation.
24. The Enlarged Board's decision G 1/97 (OJ EPO 2000, 322) on the interpretation of Article 125 EPC is of no assistance in

the present case. Its finding, namely that Article 125 EPC does not permit the introduction of new procedures (Reasons, point 3.), does not provide an answer to the question whether the examination for double patenting may be covered by this article. At least, this possibility is not ruled out by G 1/97: a new procedure need not be introduced, as this examination can take place as part of the existing procedure for substantive examination under Article 94 EPC (see also point 71 of the President's comments).

25. In its review of the relevant decisions, the Board tended to agree with the approach of those decisions that considered double patenting to involve both procedural and substantive issues (Reasons, point 63., referring to T 1423/07), but it did not explain in detail its reasons for this position. It also pointed out that early decisions expressly denied the possibility that Article 125 EPC could regulate matters of substantive law (Reasons, point 43., with reference to T 587/98 (OJ EPO 200,497), Reasons, points 3.1, 3.2 and 3.5)
26. According to decision T 1423/07, double patenting also comprises procedural aspects, a finding which it held to be supported by the Minutes of the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents (in the following cited as R3), point 665. This source - in the reading of the deciding board - "*confirm[s] the procedural aspects of double patenting*". From this the deciding board concluded that the refusal of a European application for double patenting comprised procedural aspects as well as matters of substantive law, so that Article 125 EPC was applicable. T 1423/07 also concluded that, while some Contracting States applied the prohibition, it could not be shown to be generally recognised in the specific context of the pre-grant stage (Reasons, points 2.2.1 and 2.2.2).

27. The Enlarged Board also considers that a provision falling under Article 125 EPC may well cover issues which touch upon substantive matters, such as the scope of claimed subject-matter. This interpretation can be based on the Convention itself, without reference to the preparatory documents. Thus it is not ruled out that some issues which may be considered "substantive" are to be decided on the basis of a principle of procedural law.
28. It is settled case law of the Enlarged Board of Appeal that, even though the VCLT is not formally binding on the boards of appeal, it provides an appropriate source of international law for interpreting the Convention. This was also recognised by the referring decision in its application of Articles 31 and 32 VCLT.
29. These articles are in Part III, Section 3, VCLT (titled "Interpretation of Treaties") and are worded as follows (with non-relevant parts omitted):

Article 31 VCLT - 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 connection with the conclusion of the treaty;

(b) any instrument which was made by one or more parties in connection with the conclusion of the treaty and accepted by the other parties as an instrument related to the treaty.

(3)...

(4)...

Article 32 VCLT - Supplementary means of interpretation

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, or to determine the meaning when the interpretation according to article 31:

(a) leaves the meaning ambiguous or obscure; or

(b) leads to a result which is manifestly absurd or unreasonable.

30. In view of Article 177 EPC, which provides that the three texts of the Convention, in English, French and German, are equally authentic, it is furthermore appropriate to point to Article 33 VCLT, which also belongs to Part III, Section 3:

Article 33 VCLT - Interpretation of treaties authenticated in two or more languages

1. When a treaty has been authenticated in two or more languages, the text is equally authoritative in each language, unless the treaty provides or the parties agree that, in case of divergence, a particular text shall prevail.

2. ...

3. The terms of the treaty are presumed to have the same meaning in each authentic text.

4. ...

31. Normally, the systematic interpretation is the next method to be applied if, as a result of the grammatical (literal) interpretation, the ordinary meaning of a term remains insufficiently clear. The same principle is expressed in Article 31(1) and (2) VCLT by the statement that the terms of the treaty are to be interpreted in their context, the primary context being the text of the treaty itself.
32. Article 125 EPC is in Chapter I of Part VII of the Convention (Common Provisions). This chapter is titled "Common provisions governing procedure". The term "common" refers to Parts IV to VI, i.e. the grant, opposition and appeal procedures. These parts themselves are also devoted to procedural provisions, and most articles in the common provisions of Chapter I of Part VII are clearly of a procedural nature, in the sense that they do not touch on the substantive provisions of Part II of the Convention, in particular the provisions of Chapter I of Part II (Articles 52 to 57 EPC).
33. Thus it can be acknowledged that the provisions of Chapter I of Part VII are procedural in nature. The Enlarged Board is of the opinion that the minimal difference between the term "procedural provisions" in Article 125 EPC of Chapter I of Part VII and the wording "provisions governing procedure" in the Chapter's title is not intended to make a material distinction. The same applies to the German wording: "Vorschriften über das Verfahren" (Article 125 EPC) and "Vorschriften für das Verfahren" (Chapter I title). In the French version, the term "disposition[s] de procédure" appears in both Article 125 EPC and the title of Chapter I. On this basis, both the wording of Article 125 EPC and its position in the Convention indicate that it concerns

procedural provisions comparable to the preceding articles in this chapter.

34. However, Chapter I also contains Articles 123(2) and (3) EPC, which are applied daily in the Office, with the former also serving as a legal basis for a refusal under Article 97(2) EPC. Therefore, from a formal point of view, Articles 123(2) and (3) EPC are procedural provisions. On the other hand, they cannot be perceived as being purely procedural, because they require the subject-matter of the claim to be determined when they are applied in the course of examination or opposition proceedings. Notably, in G 1/05 and G 1/06 the Enlarged Board held compliance with Article 123(2) EPC to be a substantive requirement, to be examined by the Examining Division (Reasons, point 3.3).
35. The above demonstrates that in the system of the EPC, the term "procedural provision" may well extend to provisions requiring a substantive examination of the subject-matter claimed. More particularly, provisions in Chapter I of Part VII may allow the refusal of a patent application under Article 97(2) EPC for reasons other than non-compliance with the substantive patentability requirements of Chapter I of Part II of the Convention (Articles 52 to 57 EPC).
36. Thus the Enlarged Board concludes that, from a purely systematic point of view, Article 125 EPC may provide a legal basis for the regulation of double patenting - whether this means permitting or prohibiting it - even though a consideration of substantive issues such as "the same subject-matter" may be involved as well.

B.1.2 Prohibition of or permission for double patenting as a generally recognised principle of procedural law in the practice of the Contracting States

37. Since it has been concluded that Article 125 EPC may serve as the legal basis for a prohibition on double patenting, the next question is whether such a principle exists and is generally recognised in the Contracting States.
38. The Enlarged Board is not aware of any reliable source which would directly confirm this proposition as a fact. The sources cited in the referring decision (Reasons, point 60.) or in the comments of the President of the EPO, e.g. the regularly updated compilations by the EPO of the relevant provisions of national law (cited as N5 in the referring decision), only document the practice of the Contracting States concerning the implementation of Article 139(3) EPC, but cannot provide direct information about their practice on double patenting in the narrow sense, i.e. about the possibility of granting two national patents, analogously to double patenting in the context of European patents only, as explained in point 2. above. It appears that the Office can do no more than infer from the general practice on the interpretation of Article 139(3) EPC that the double patenting prohibition is also a generally recognised principle (points 80. and 81. of the President's comments). The above-cited facts are certainly consistent with the assumption that the prohibition on double patenting in the narrow sense is also recognised and applied in the majority of the Contracting States. Still, it remains the case that there are no data available to the Enlarged Board which would allow it to safely establish the practice in all or at least the majority of the Contracting States and therefore to confirm the applicability of the prohibition under Article 125 EPC on that basis.

B.1.3 The prohibition as an embodiment of the principle of a legitimate interest in the proceedings (implications of G 1/05 and G 1/06)

39. The President of the EPO submitted that the *obiter dictum* of the Enlarged Board in G 1/05 and G 1/06 approved the practice of the Office. The EPO Guidelines for Examination in their present version (March 2021) also refer to those decisions in connection with double patenting, see Guidelines, G-IV 5.4. Although that particular part of the Guidelines is not quoted in point 93. of the President's comments, at point 94. G 1/05 and G 1/06 seem to be associated with the proposition that the necessity of having a legitimate interest in the proceedings is a generally recognised principle of procedural law in the Contracting States. However, in those decisions the Enlarged Board did not explain in what way the prohibition on double patenting should be derived from the principle of a legitimate interest. This is understandable, given that G 1/05 and G1/06 were not directed to this specific question. The Enlarged Board furthermore did not seem to be relying on Article 125 EPC when it stated its acceptance that the "*principle of prohibition exists on the basis of the lack of legitimate interest in the proceedings leading to a second patent*" and concluded from this that the practice of the EPO was not objectionable (G 1/05 and G 1/06, Reasons, point 3.14). Nor was there even a statement by the Enlarged Board that it regarded a legitimate interest in the proceedings to be a generally recognised principle of procedural law, which might have allowed the inference that Article 125 EPC should apply. In fact, the only firm conclusion which may be drawn from the Enlarged Board's *obiter* remarks in G 1/05 and G 1/06 is that the lack of a legitimate interest may provide an explanation for the prohibition.

40. Furthermore, the Enlarged Board's statement in the Reasons, point 13.4, that it "accepts" the existence of the prohibition and that the practice of the Office did not appear objectionable must be seen in context, in particular that of point 13.5 of the Reasons. There the Enlarged Board explained, with reference to the submissions of the President of the EPO (point VIII(d). in G 1/05 and G 1/06) that recognising the prohibition could not prevent applicants from keeping a series of divisional applications pending while containing the same subject-matter. The conclusion reached by the Enlarged Board in point 13.5 would have applied a *fortiori* if the Office had not applied the prohibition. Thus the Enlarged Board had no reason to question the Office's practice, because confirming it was not required for the purposes of its own decision. Nor was the practice of the Office called into question in the case law at that time, even by decision T 587/98 (*supra*), which was cited by the referring decision (Reasons, point 43.) as questioning the applicability of Article 125 EPC to questions of substantive law. In fact, T 587/98 carefully restricted its findings to the question of a broader claim wholly encompassing a narrower claim in cases of divisional applications (Headnote and Reasons, point 3.7), but it did not go so far as to cast doubt on the general principle of a prohibition on double patenting.
41. Accordingly, unreservedly approving the double patenting prohibition on the basis of the *obiter dictum* in G 1/05 and G 1/06 would not be appropriate for the purpose of the present referral.
42. In sum, from the foregoing (points 38. to 41.) alone, the Enlarged Board is unable to conclude that the prohibition on double patenting is a principle generally recognised in the

Contracting States. It is therefore necessary to have recourse to other sources.

B.2 Recourse to the preparatory documents of the Convention (the "*travaux préparatoires*")

43. The referring decision discussed whether the provisions of the VCLT could justify turning to the preparatory documents of the EPC for guidance. The Board held that under Article 32 in conjunction with Article 31 VCLT it was not possible to do so for the present case. This appears to have been because it found that neither condition of Article 32 VCLT was fulfilled. That is, for the issue of double patenting, an interpretation of the Convention, here Article 125 EPC, using the rules of interpretation laid down in Article 31 VCLT did not (a) leave its meaning ambiguous or obscure, or (b) lead to an obviously nonsensical (i.e. absurd) or unreasonable result (Reasons, point 59.). At least, no other conclusion can be drawn from the Board's statements there that "*[t]he majority opinion set out in point 665 of document M/PR/I cannot be relied on ... as a supplementary means of interpretation*" and that "*neither of these alternatives [conditions (a) and (b) of Article 32 of the Vienna Convention] applies to the point of law under consideration*".
44. The EBA concurs with the Board's findings with respect to condition (b): as is clear from the whole context of the underlying case, the EPC may permit or it may prohibit double patenting. Neither possibility is obviously nonsensical or unreasonable. Granting two or more patents on the same invention to the same applicant may appear highly undesirable, but it is difficult to view it as outright nonsensical or clearly unreasonable. With regard to the other option, i.e. the *status quo* as set out in the Guidelines for Examination, it has never been argued that the practice of the Office is obviously nonsensical or unreasonable, but

simply that it lacks a proper legal basis. It has never been argued either that the existing practice is in any way manifestly unjust. Thus the Enlarged Board agrees that condition (b) is not applicable.

45. However, it is difficult to see why the ordinary means of interpretation pursuant to Article 31 VCLT do not leave the meaning of the Convention ambiguous or even obscure with respect to double patenting. It is clear from the referral that over thirty years of case law have not been able to settle the issue. The ambiguity of the Convention with respect to the question of double patenting is also implicitly confirmed by those decisions that have dealt with the questions of the same applicant or the same invention (see e.g. T 1391/07, Reasons, point 2.5, T 1780/12, Reasons, points 8.-10., T 879/12, Reasons, point 13., and the further decisions cited there). The fact that these questions were examined indicates that the deciding boards could not have been fully convinced that there is no prohibition on double patenting under the EPC. Had they been convinced, it would not have been proper for them to decide on the questions of the same invention and the same applicant, as these questions would have been irrelevant.
46. The Enlarged Board does not endorse the opinion that the interpretation of the Convention (in itself) provides a clear answer. It rather takes the view that Article 125 EPC is worded in such general terms that, for this reason alone, its potential scope can be considered to be ambiguous. As explained in point 36. above, based on a systematic interpretation, the regulation of double patenting does not seem to be excluded from the scope of Article 125 EPC. Thus the Convention is not clear, but rather silent on this issue. The result of a systematic interpretation may still require

confirmation. Accordingly, it is not at all apparent why supplementary means of interpretation, and in particular the preparatory documents of the EPC, cannot or should not be used in order to determine the position under the Convention or the meaning of Article 125 EPC with regard to double patenting. On the contrary, there are good reasons, including on the basis of Article 32 VCLT, for consulting the *travaux préparatoires*. Indeed, as the cited cases show, in the past both the boards and the Enlarged Board have turned to the *travaux préparatoires* as a matter of course for assistance in interpreting Article 125 EPC.

B.2.1 Double patenting in light of the *travaux préparatoires*

47. In the following, reference will be made to certain documents among the preparatory documents of the Convention. The references used are listed below. They replace the usual full references for the sake of brevity, and also the numbering N1 to N4 used by the appellant and in the referring decision because parts of the *travaux préparatoires* that were not included in the extracts filed by the appellant will also be referred to.

R1: A collection of the comments by the participating governments and other bodies on the draft provisions of the future Patent Convention, as established by the 6th meeting of the Inter-Governmental Conference for the setting up of a European System for the Grant of Patents, held in Luxembourg from 19 to 30 June 1972 (in short: the 6th Meeting). The comments are listed as "M9 to M29" in the documentation maintained by the European Patent Office on the *travaux préparatoires*. R1 also contains the extract filed as N2 in the referral proceedings.

R2: The Minutes of the 6th meeting of the Inter-Governmental Conference, listed by the EPO as BR/219 e/72. It contains N4.

R3: The Minutes of the Diplomatic Conference, titled "Minutes MDC 1973" in the EPO documentation (English version). It contains N1.

R4: The Minutes of the 10th meeting of Working Party I of the Inter-Governmental Conference, listed by the EPO as BR/144 e/71. It contains N3.

M/34: The Draft Rules of Procedure of the Diplomatic Conference. The reference used by the EPO is maintained. It is to be noted that this Draft was adopted without amendments and became the final Rules of Procedure, see R3, point 10, page 13.

These documents are also accessible to the public via the website of the EPO (see <https://www.epo.org/law-practice/legal-texts/epc/archive/epc-1973/travaux/documents.html>, at the time of writing).

48. It appears undisputed that the last recorded statement on the present issue of the competent legislator, the Diplomatic Conference, is the agreement in point 665. of R3. The significance of this agreement must be evaluated in light of the legislative work done both at and before the Diplomatic Conference. Before looking at the preparatory work of the Convention dating back even earlier, for the purpose of answering Question 1 it is sufficient to start with the 6th Meeting.
49. By the time of the 6th and final Meeting in June 1972, Article 125 already had its present wording and numbering,

and consequently was also part of the Draft Convention after the closure of the Inter-Governmental Conference following the 6th Meeting. It was clear that the documents adopted by the Inter-Governmental Conference would form the basis of the work of the planned Diplomatic Conference (R1, Introduction, point 4, last paragraph).

B.2.1.1 Minutes of the 6th Meeting (R2)

50. As acknowledged in the referring decision, a common understanding was already reached during the discussions on Article 125 at the 6th meeting that double patenting was not possible (Reasons, point 56., referring to N4). This common understanding was recorded in R2 under point 49. The exact wording is as follows:

"Article 125

49. During discussion of this Article the Conference established that the European Patent Office may not grant more than one European patent to the same person for the same invention being the subject of applications filed on the same date.

The Conference also established that the European Patent Office is entitled to correct any slips which it may make."

Apart from these two issues (i.e. the double patenting prohibition and error correction *ex officio*), no further details are recorded in R2 of the discussions concerning Article 125.

51. The participating governments and bodies were invited to submit comments on the drafts, including the Draft Convention (R1, Introduction, points 4 and 6). Comments that were received before 15 May 1973 were published by the German Government in preparation for the Diplomatic Conference (R1,

Introduction, point 6). Comments on Article 125 by two participating governments are known to the Enlarged Board.

B.2.1.2 M/28, Comments by the Norwegian Government in R1

52. Norway took part in the Inter-Governmental Conference from the beginning (R1, Introduction, point 2) and submitted comments. The complete submission of the Norwegian Government in M/28 is on pages 341-349 of R1; it was received by the Secretariat on 5 May 1973. The comment on Article 125 is in point 11 of M/28 (R1, page 346). The English version is worded as follows:

"In connection with Art. 125 the sixth meeting of the Inter-Governmental Conference "established that the European Patent Office may not grant more than one European patent to the same person for the same invention being the subject of applications filed on the same date" (Minutes par. 49). However, in the Norwegian opinion, it follows from Art. 52(3) that applications filed on the same day do not at all constitute novelty hindrance against each other and that an applicant may thus without detriment to himself file several applications on the same day. Under the circumstances, a possible restriction as established at the sixth meeting should be expressly stated in the Convention."

B.2.1.3 M/10, Comments by the UK Government in R1

53. The tabular summary compiled by the Secretariat of the Diplomatic Conference of the comments contained in R1 (pages 12-14) only mentions Norway as submitting comments in the context of Article 125 (R1, page 13, right-hand column, at the bottom). In fact, the comments of the UK Government also address the issue of double patenting in the same context. Reference is made to document M/10 (pages 41 to 49 in R1). These comments of the UK delegation in M/10 were not included

under Article 125 in the tabular summary in R1, given that Article 125 was not mentioned. M/10 was submitted to the Secretariat earlier than M/28, on 29 March 1973.

54. M/10, point 2, is titled "GENERAL" and contains the following:

"We would prefer the understandings recorded under paragraph 49 of the minutes of the Conference in June 1972 to be mentioned also in the records of the Diplomatic Conference."

This point in M/10 apparently refers to point 49 of R2 (see point 50. above).

B.2.1.4 Minutes of the Diplomatic Conference (R3), point 665.

55. The work of the Diplomatic Conference was regulated by the Rules of Procedure (M/34). These were adopted unanimously at the beginning of the Conference (R3, point 10, page 13). The Rules specified the organs of the Conference: the Plenary, various Committees, Working Parties and Rapporteurs (M/34, Rules 3(2) to 3(4)). The Main Committees had to establish the draft texts, for submission to the Committee of the Whole (M/34, Rule 12(5)). The Committee of the Whole had to adopt the texts for submission to the Plenary (M/34, Rules 3(2) and 36(2)). Main Committee I was tasked with examining Part VII of the Draft Convention (M/34, Rule 12(2)), including Article 125. All government delegations were entitled to participate in all three Main Committees and in the Committee of the Whole (M/34, Rules 12(6) and 14(2)). The decisions of the various organs required a qualified (two-thirds) or simple majority of the votes, abstaining delegations being considered as not voting (M/34, Rules 36 and 37). Decisions in the Main Committees and Working Parties required a simple

majority (except for reconsideration of proposals under Rule 34).

56. Article 125 is dealt with in the Minutes of the Proceedings of Main Committee I, points 665. to 669., with points 665. to 668. being dedicated to the issue of double patenting, while point 669. records the unanimous opinion that the EPO may correct inadvertent errors. Point 665. is worded as follows in the English version:

"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."

57. On closer scrutiny, the statement as recorded in the English version "it was established ... that it **was a ... principle ... in the Contracting States** that ... only one **European patent** [can be granted] ..." (emphasis by the Enlarged Board) appears somewhat puzzling. A comparison with the German and French versions (see point 58. below) shows that it may be a mistranslation. An alternative explanation could be that the original English text put to the vote first mentioned the granting of only one (national) patent as the recognised principle of procedural law, from which it followed that no more than one European patent should be granted for the same invention, but that this was then shortened and thus erroneously redacted for the English version of the minutes.

58. Either way, the proper interpretation of this statement is rather that it "... **followed from** the ... principles of procedural law in the Contracting States that only one European patent [can be granted]...". This is clear from the corresponding German version of the minutes ("BerichteMUCDK" in the EPO documentation): "... *Aus den allgemein anerkannten Grundsätzen des Verfahrensrechts der Vertragsstaaten **ergibt sich, dass** ...*". The French version ("M-PR" in the EPO documentation) conveys the same: "... *il **découle** des principes de procédure généralement admis dans les Etats contractants qu'il ...*".
59. It is also apparent that the UK motion recorded in point 665. of R3 is the direct consequence of the UK's comment in M/10. The Enlarged Board is not aware that this issue is treated anywhere else in the Minutes of the Diplomatic Conference. The only fact derivable from the wording of points 665. and 666. (the latter is discussed below) is that the majority position was established and recorded. This majority agreement appears to have been established without preceding debate, as no discussion is recorded or even hinted at. This may also be concluded from the fact that FICPI's question and the UK's response on the definition of the "same invention" were recorded in detail (points 667. and 668. of R3). The referring decision noted that the issue was no longer mentioned by the Rapporteur of Main Committee I in his report to the Committee of the Whole (Reasons, point 58.).

B.2.1.5 Minutes of the Diplomatic Conference (R3), point 666.

60. According to the minutes, the Norwegian delegation made a statement after the vote on the agreement referred to in point 665. Point 666. records the statement as follows:
"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."

61. This statement is compatible with the fact that the agreement recorded in point 665. was a majority agreement. Otherwise, as mentioned above, there is no indication in the minutes or elsewhere in the *travaux préparatoires* that either double patenting or Article 125 was the subject of any further debate. Accordingly, this agreement is not only the last recorded statement of the competent legislator, but can also be taken as the expression of its final and unchanged intention on the question of double patenting.

B.2.2 Interpretation of the agreement in point 665.

62. The significance for the issue of double patenting of a majority agreement being reached and recorded in the minutes is not difficult to establish. In view of the wording of Article 125 EPC, and the fact that the agreement was explicitly linked to this article in the minutes, the straightforward interpretation of the agreement is that the (potential) Contracting States agreed that the prohibition on double patenting was a generally recognised principle of procedural law in the Contracting States and as such applicable under Article 125 EPC.
63. In the opinion of the Enlarged Board, there can be little doubt that an agreement established among the delegations was mentioned in the records for a purpose, and that this had to be clear to all delegations. The work of a diplomatic conference for establishing an international treaty is a serious matter, in which recorded agreements must carry weight. The purpose of the agreement recorded in point 665. of R3 is clear: it was to provide an interpretation of Article 125 EPC and have the provision applied in accordance

with this interpretation. As is evident from the literature (and from the preparatory documents of the Vienna Convention itself), the practice of consulting the preparatory materials in order to determine the legislative intent behind treaty provisions was already long established in international law, even if this practice was not always accepted without reservation.

B.2.3 Reservations expressed in the referring decision

64. The Board noted that the issue of double patenting arose during the discussions on Article 125 of the Convention, and that up to the Diplomatic Conference it was common ground that double patenting should not be possible. Nevertheless, the Board finally held that it could not be established beyond doubt that the prohibition on double patenting could indeed fall under Article 125 EPC or that an agreement to this effect was reached. It concluded: "The documents of the Munich Diplomatic Conference, however, fail to demonstrate that there was still agreement on the principle ..." (Reasons, point 58.). The Board's doubts appear to have been based on various factors emerging from the minutes: that a declaration at the Diplomatic Conference was originally planned (Reasons, point 57., referring to N3 and N4) but did not materialise, that the agreement was not reported to the Committee of the Whole, and that only a majority, not a unanimous, agreement was reached (Reasons, point 58., referring to N1, i.e. points 665. and 666. of R3).
65. The Enlarged Board does not share the Board's reservations. The various factors which it mentioned in connection with the agreement of point 665., and which were also put forward by the appellant, do not cast doubt on the validity of the agreement or its applicability for the interpretation of the Convention. On the contrary, the agreement as recorded was

sufficient for its purpose, it did not require additional follow-up, and there is no indication that it lost support.

B.2.3.1 Lack of unanimous agreement among the contracting parties

66. The referring decision came to the conclusion that the events recorded in points 665. and 666. of R3 could not demonstrate the existence of a common understanding or agreement among all Contracting States for the purposes of Article 31 VCLT, and could not be used either for establishing the prohibition in place of an express provision in the Convention through the application of Article 32 VCLT (Reasons, point 59.). This view may be correct if it is based on the premise that the events recorded in points 665. and 666. were evidence of only an attempt, and as such an unsuccessful act, to bring about a common understanding. However, in light of document M/10, it is clear that the "establishment of the majority agreement" was not merely an attempt, but a successful motion from the UK delegation, the primary purpose of which was to ensure the "mentioning in the records" of the previously established agreement on the principle of the prohibition.
67. The fact that the agreement did not find unanimous support does not preclude it from being taken into account as a means of interpreting the Convention. The agreed texts of the Convention were also established by majority vote, and even the adoption of the Convention as a whole only required a two-thirds majority of the Plenary (M/34, Rules 36(1) and (2)). Each State participating in the Conference was also entitled not to sign the Convention, or to sign it with certain reservations (Article 167 EPC 1973). However, Article 125 could not be the subject of a reservation. From this it is clear that the adoption of the Convention by a Contracting State did not mean that, at the stage of the negotiations during the Diplomatic Conference, each and every Contracting

State already had to agree specifically to each and every Article and Rule. The common agreement of all parties concerning the scope of the Convention as a whole was only achieved and attested by their signatures, followed by the appropriate ratification (Articles 165(1) and (2) EPC 1973, Articles 11, 12 and 14 VCLT), or by accession (Article 166 EPC 1973, Articles 11 and 15 VCLT).

B.2.3.2 Intended declaration referred to in R4

68. It was argued by the appellant and also mentioned in the referring decision (Reasons, point 57.) that earlier documents suggested that there was to be a declaration on double patenting, instead of an express provision in the Convention. As recorded in point 119. of R4, it was decided that such a declaration should be contained in the minutes of the Diplomatic Conference. This point of R4 is also cited in the referring decision (Reasons, point 55.). The appellant argued that the agreement referred to in point 665. of R3 was not the intended declaration because it added the condition of the same filing date. The referring decision did not endorse this argument, but does appear to have agreed with the appellant that the agreement of point 665. could not be considered to be the aforementioned declaration (Reasons, points 57. and 58.), possibly because of the lack of unanimity and the absence of any follow-up.
69. In the Enlarged Board's judgement, apart from the fact that R3 does not use the word "declaration" but "agreement" in point 665, there is no apparent reason why that agreement should not be taken as the intended interpretative declaration. The UK Government's comments in M/10 make it clear that the motion of the UK delegation had the same objective as the foreseen declaration and that it effectively achieved the same result. The UK proposed that the

"understandings [established at the 6th meeting should] be mentioned also in the records of the Diplomatic Conference". Clearly, that happened, and once the agreement of point 665. was recorded, any further declaration was unnecessary.

B.2.3.3 Omission of the agreement by the rapporteur of the Main Committee I

70. The foregoing conclusion also accords with the fact that the issue was no longer mentioned by the rapporteur of the Main Committee I in his report to the Committee of the Whole. The double patenting issue was discussed on several levels and occasions and the text of Article 125 remained unchanged. Establishing the agreement of the majority did not require any amendment to the text of the Convention, nor could it be seen as a resolution or recommendation, the adoption of which would have been in the competence of the Plenary (M/34, Rule 3(2)).
71. The absence of any mention in the rapporteur's report to the Committee of the Whole confirms that the issue was not controversial and did not entail any serious discussion, as explained in point 59. above. Reference is made to the following account on page 183 of R3, in Chapter C, I. Preliminary Remark: "*[t]he present rapporteur considered it his duty to give the Committee of the Whole as comprehensive a survey as possible of the discussions of Main Committee I and the decisions which resulted therefrom. With this in mind items of discussion which were of lesser importance or which were more of a drafting nature have been deliberately ignored even where they led to amendments to the text*". For example, the unanimous opinion on the error correction in point 669 of R3 was not mentioned either by the rapporteur. Indeed, his report concentrates on the truly contentious issues. Given that the agreement of point 665. did not change the wording of Article 125, there was even less reason to mention it.

B.2.3.4 Lack of proof of a final agreement

72. The Enlarged Board sees no circumstance indicating a lack of a final agreement or any change of opinion. It is not plausible that a change of opinion on double patenting could have occurred without any record in the minutes. In connection with the agreement the only dissent recorded is the statement of the Norwegian delegation in point 666. in R3 (see point 60. above) explaining only after the majority agreement was established why it could not support the UK's proposal. The Rules of Procedure expressly provided the possibility for delegations to explain their votes, even after a vote was held (M/34, Rule 39). It follows that Norway's dissent does not imply that the issue was still open. Re-opening the debate, while possible, would have been difficult: if a delegation still wished to assert the view that the principle of the prohibition or its application by way of Article 125 was wrong, it would have had to make a proposal for reconsideration, which in turn would have required a two-thirds majority (M/34, Rule 34).
73. Moreover, if the understanding with regard to the prohibition on double patenting previously established at the 6th Meeting and confirmed in point 665. of R3 had lost support, it would have deserved a mention by the rapporteur of the Main Committee I as well. The delegations in the Committee of the Whole would have had to be aware of such a situation when submitting the texts to the Plenary, likewise the delegations in the Plenary when voting for the Convention as a whole, including Article 125 in unamended form. The President of the EPO argues similarly (at point 40.) when he states that a subsequent change of view at such a late stage would have been reflected in the minutes.

B.2.4 Agreement in point 665. of R3 as a supplementary means of interpretation under Article 32 VCLT

74. Article 32 VCLT mentions both the preparatory work of a treaty and the circumstances of its conclusion as supplementary means of interpretation. The agreement recorded in point 665. of R3 must be seen as an integral part of the legislative process, and not as intended to be a separate agreement or separate instrument of the parties possibly falling under Article 31(2)(a) or (b) VCLT and requiring the consent of all parties. If the texts of the Convention could be adopted by a two-thirds majority vote, and draft articles could be established by simple majority, it would not have made sense to expect explanatory statements to be adopted unanimously. Given that the Plenary of the Diplomatic Conference agreed to task Main Committee I with the preparation of the draft wording of Article 125 on behalf of the Plenary (the Committee of the Whole also being an organ of the Plenary, cf. M/34, Rule 3(2)), it was only logical that any interpretation of Article 125 should also be discussed in Main Committee I. Against this background, the agreement recorded in point 665. of R3 was established in accordance with the rules on decision-making which the Diplomatic Conference laid down for itself, and to that extent it is no less suitable as a means for determining the common intention of the Contracting States than any of the express provisions in the Convention.
75. It is true that the agreement recorded in point 665. of R3 is neither an agreement under Article 31(2)(a) VCLT nor an instrument under Article 31(2)(b) VCLT, as also noted in the comments of the President of the EPO (at point 42.). Nevertheless, it is a suitable and admissible means for determining the intention of the contracting parties concerning the scope and meaning of Article 125 EPC, and of

the Convention more generally. Since an interpretation in accordance with Article 31 VCLT alone or in conjunction with the case law cannot dispel the ambiguity surrounding the question of double patenting, the meaning of the Convention is to be determined by establishing the intention of the parties. Pursuant to Article 32(a) VCLT, this may be done by recourse to the preparatory work of the treaty and the circumstances of its conclusion.

76. Summing up, the proposition that the majority agreement on double patenting as recorded in point 665. of R3 cannot be taken into account in interpreting the Convention is not tenable. The preparatory documents demonstrate with overwhelming certainty that there was a real and effective agreement that the European Patent Office should prohibit double patenting by taking into account principles of procedural law generally recognised in the Contracting States, i.e. by a direct application of Article 125 EPC. Furthermore, there must have been a common understanding among the potential signatories to the Convention that this majority agreement was made on behalf of the Plenary of the Diplomatic Conference and recorded with the purpose of defining the scope of Article 125, and that therefore the principle expressed in the agreement formed part of the Convention.

B.3 Other suggestions for a legal basis

77. In view of these findings, it is not necessary to examine the other provisions proposed as the proper legal basis for the prohibition on double patenting, i.e. Articles 60(1), 63(1) and 76(1) EPC. Nor is it necessary to determine the conditions for a legitimate interest in the proceedings or to examine if there is a need to fill a lacuna in the Convention. The analysis above shows that the prohibition is

to be derived from the legislative intention underlying the Convention and that no lacuna exists.

B.4 Consequence of the established legislative intent for Article 125 EPC

78. Article 125 EPC expressly empowers and, indeed, possibly even instructs or obliges the European Patent Office to take into account ("berücksichtigt", "prend en consideration") generally recognised principles of procedural law, where the Convention is silent. Therefore, since the competent legislator, here the Diplomatic Conference, established that the prohibition on double patenting was a generally recognised principle as a question of fact, and in addition made it clear that this was a principle falling under Article 125 EPC as a matter of interpretation of the law, the Office was thereby not only empowered to apply this principle but effectively also duty-bound to do so.
79. At the time of signing of the Convention, the statement of the delegations in point 665. of R3 had to be taken as proof that the principle of the prohibition on double patenting was a generally recognised principle in the Contracting States, and therefore the Office was correct to apply it from the start. No information has been brought to the Enlarged Board's attention, nor has it been argued, that this situation might have changed, for example through the accession of new Contracting States, or as a result of more recent legislation in the Contracting States. Accordingly, there is no reason to conclude that the principle is no longer to be applied by the EPO.
80. Overlapping designations under Article 79 EPC are an additional precondition for the prohibition to apply. Neither the key statement in point 665. of R3 nor the previous agreement in point 49 of R2 provide an explanation of why the

EPO must take this into account. However, there was no need for the records of the discussions at the Diplomatic Conference to make express mention in this context of the precondition of overlapping territorial effect because this principle was stated to originate in the Contracting States and is an inherent feature of national patents. On the other hand, the statements of Working Party I in the second and fourth paragraphs of point 118. of R4 (cited in point 90. below) show that the legislator was aware that double patenting only arises in the event of overlapping designations. Moreover, if the Office did not take this additional precondition into account, i.e. if it refused to grant a second European patent regardless of the status of the respective designations, the effect of such a strict prohibition would go beyond the scope of the original national principle and thus deprive it of its legal basis.

81. For all these reasons, Question 1 is to be answered in the affirmative.

C. Questions 2.1 and 2.2

C.1.1 Question 2.1

82. The above findings of the Enlarged Board confirm that on the question of double patenting under the EPC in the narrow sense the intent of the legislator is derivable from the preparatory documents of the Convention. According to this legislative intention, the prohibition is applicable "*for the same invention in respect of which there are several applications with the same date of filing*". In view of the general wording used, it is probable that different conditions for the constellations set out in Question 2.1 were not envisaged.

83. The appellant argued that the agreement was restricted to applications with the same filing date, and for this reason the constellation of Question 2.1(c) was not covered. However, as the preparatory documents show, the final agreement referred to in point 665. of R3 was a confirmation of the earlier agreement at the 6th Meeting (point 49 of R2). The referring decision pointed out that the earlier agreement also contained the condition of the same filing date, but that this was likely to have been an inadvertent inaccuracy (Reasons, point 56.). It is reasonable to assume that this inaccuracy was taken over when the agreement in point 665. of R3 was established and recorded. As noted in point 80. above, the additional requirement that has been consistently applied by the Office, namely that the prohibition only applies where the application under examination and the already granted patent have common designated states, was not contained in the agreement of point 665. of R3 either.
84. Furthermore, the agreement in point 665. of R3 is not to be read as a legal provision in the usual sense, but rather as what it was intended to be, namely the expression of a general principle. Therefore, it cannot be expected to have been formulated with the precision of a legal provision. Against this background, the Enlarged Board considers that the requirement of the same date as stated in point 665. of R3 is to be understood as the same "effective date", in line with the explanation in point 18. of the Reasons of the referring decision, such that applications with a common priority are also covered by the prohibition.

C.1.2 Conclusions from the Minutes of the 10th Meeting of Working Party I (R4)

85. That the prohibition on double patenting applies to all three of the constellations set out in referred Question 2.1 is confirmed by the parts of the preparatory work that preceded

the final conclusion expressed in point 665. of R3. The Enlarged Board sees no reason to conclude, nor was any put forward in the referring decision, that those parts of the *travaux préparatoires* which treat the various aspects of this question, i.e. the applicability of the prohibition in the different constellations of Question 2.1, are not a reliable source for exploring the legislative intent, or that the positions expressed there were later replaced by contrary ones. Nor is there any indication in the *travaux préparatoires* or elsewhere that, despite mentioning no particular conditions, the final explicit statement of the legislator, i.e. the agreement recorded in point 665. of R3, was for some other reason intended not to be generally applicable. Indeed, the Board expressed the view (Reasons, point 55.) that the *travaux* do not seem to support any exception for European applications having different filing dates but a common priority, because, as attested by R4 (see points 117-120), the double patenting prohibition was also discussed for such applications, and not only for divisional applications. Other decisions cited in the referring decision, e.g. T 2461/10 (*supra*, Reasons, point 14.), came to the same conclusion.

86. The Enlarged Board concurs with these findings of the referring decision and T 2461/10. Points 117. and 118. of R4 provide a clear indication that the legislator's intention to exclude protection for the same subject-matter covered not only parent-divisional pairs of applications but also applications with a common priority, because each point contains an identical statement to this effect (see also the referring decision, Reasons, point 55., where these statements are cited). Formally, point 117. is directed to divisional applications (Article 137a of the then Draft Convention), but its first paragraph already makes clear that

the considerations are to be extended to parallel applications (i.e. constellation a) of Question 2.1) as well. Point 118. explicitly addresses applications with a common priority, thus demonstrating that the prohibition is also applicable to those.

87. Reference is also made to the comments of the President of the EPO, point 27., and to decision T 2563/11 (supra, Reasons, points 2.4 and 2.5), where the deciding board noted that point 120 of R4 provided a more detailed explanation of why, in the context of divisional applications, a provision prohibiting claims directed to the same subject-matter had been deleted, and why this provided support for the prohibition being of a more general nature. The same conclusion was drawn by the Board in the referring decision, Reasons, point 69., in connection with its analysis of Article 76(1) EPC. A comparison of the original and the amended wording of Article 137a (European divisional applications) illustrates this point.

Article 137a(2) as approved at the 9th meeting of Working Party I (in October 1971) was worded as follows:

"(1)...

(2) The claims of the earlier application and any divisional application shall exclude the matter for which protection is sought by any of the other applications. Where possible, the description and drawings of each application shall relate only to the matter for which protection is sought by that application. However, when it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a cross-reference to that other application."

(source: BR/134 e/71, cf. Introduction, point 2, explaining that this draft was the outcome of the 9th meeting of Working

Party I and that it would be discussed at the 10th meeting; also cited in the referring decision, Reasons, point 54.)

Following the deletions made at the 10th Meeting, Article 137a(2) had this wording:

"(2) Where possible, the description and drawings of the earlier and any divisional application shall relate only to the matter for which protection is sought by the respective application. However, when it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a cross-reference to that other application."

(source: BR/139 e/71, cf. R4, point 4)

88. Considered in isolation, the deletions from the wording of Article 137a of the Draft Convention may not point to a general prohibition on double patenting, but could on the contrary appear to endorse the possibility of claiming identical subject-matter. However, the correct explanation is to be found in the aforementioned point 120. of R4, and in this regard, rather than the English text (quoted by the President of the EPO in point 27. of his comments), it is more instructive to look at the German version (BR/144 d/71): *"Um einem Umkehrschluss aus Artikel 137 a Absatz 2 vorzubeugen, der dahin gehen könnte, dass - ausser bei Teilanmeldungen - die Patentansprüche späterer Anmeldungen denselben Gegenstand enthalten dürfen wie die Ansprüche früherer Anmeldungen, beschloss die Arbeitsgruppe, Satz 1 dieser Bestimmung zu streichen."* Thus the German version makes it clearer that the deletion was meant to prevent any inverse conclusion that only divisional applications had to be directed to different subject-matter, whereas other applications of the same applicant were permitted to claim the same invention. The French version (BR/144 f/71) conveys

the same sense as the German. Thus point 120. of R4 is consistent with the conclusion of the Enlarged Board's above reasoning that the prohibition on double patenting is general and applies to all the constellations of Question 2.1.

89. Thus the Enlarged Board considers that the *travaux préparatoires* do not point to any special circumstance or condition inherent in the identified constellations which would lead to the conclusion that any of the three constellations should be treated differently from the others with respect to the prohibition on double patenting. This gives the answer to Question 2.1.
90. The appellant also argued that the last sentence in the fourth paragraph of point 118. of R4 suggests that in cases of internal priority the legislator accepted an extended term of protection in respect of states designated in both the priority and the subsequent application. The following is stated there: "*The Working Party came to the conclusion that even when an applicant claimed the priority of an earlier European patent application, he should not be able to obtain the same patent twice for the same invention in the same designated States. It was not necessary, however, to provide a rule to this effect in the Convention. Under the present version of the Paris Convention, there would have to be an extended term for those States which were designated twice*".
91. However, this statement has to be read together with the condition described at the end of the second paragraph of point 118. of R4, namely the assumption that the earlier application would have been withdrawn in the meantime: "*The majority of the delegations considered that Article 73 of the Convention [Priority right, essentially corresponding to Article 87 EPC 1973 and Article 87 EPC 2000] did not in*

*principle prevent an applicant from claiming the priority of an earlier European patent application, while Article 8 of the PCT in fact makes provision for this in respect of international applications. It did appear doubtful whether a State which had been designated in the earlier application could be designated again in the later European application, as this could lead to the term of the patent being extended by the time between the filing of the two applications **in the case of the earlier application being withdrawn during that time**" (emphasis by the Enlarged Board). In the third paragraph of point 118. the Working Party established that the problem of an extended term was likely to disappear due to expected amendments to the Paris Convention (mentioned as the "Paris Union"). As a result, the extended term referred to can be understood as a combination of the term of protection under Article 64(1) EPC with that of provisional protection under Article 67(1) EPC (at that time Articles 18 and 19, which essentially corresponded to the articles of the EPC 1973 and the present articles). In light of this, the statement of the Working Party relied on by the appellant does not concern the situation of double patenting in the narrow sense, nor does it contradict the Working Party's preceding explicit statement that a second patent cannot be granted for the same invention even in the case of internal priority.*

C.2 Question 2.2

92. In light of the above findings, it is clear that the legislator's intention with respect to the prohibition on double patenting also extends to applications having a common priority. As stated above, the answer to Question 2.1 is that the prohibition applies to all three constellations identified. It follows that Question 2.2 does not require a separate answer.

Order

For these reasons, it is decided that the questions referred to the Enlarged Board of Appeal are answered as follows:

1. A European patent application can be refused under Articles 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been 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 The application can be refused on that legal basis, irrespective of whether it
 - a) was filed on the same date as, or
 - b) is an earlier application or a divisional application (Article 76(1) EPC) in respect of, or
 - c) claims the same priority (Article 88 EPC) as the European patent application leading to the European patent already granted.
- 2.2 In view of the answer to Question 2.1 a separate answer is not required.

The Registrar:

The Chairman:



N. Michaleczek

C. Josefsson

Decision electronically authenticated