



29 July 2022

FAO: Mr Nicolas Michaleczek (EBAamicuscuriae@epo.org)
Registrar of the Enlarged Board of Appeals
European Patent Office
D-80298
GERMANY

Dear Members of the Enlarged Board of Appeal,

Re: Amicus Curiae Brief on questions referred to the Enlarged Board of Appeal in case G1/22 & G2/22

We are writing to provide Intellectual Property Owners Association (IPO)'s view on the question referred to the Enlarged Board of Appeal (EBA) in G1/22 & G2/22. IPO is pleased to be able to provide its opinion on the questions referred and thanks the EBA for its invitation to file amicus briefs in this case.

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

The IPO Board of Directors, which approved the filing of this brief, is listed in the appendix of this letter. IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

Summary of answers to questions

Q1: "Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?"

IPO considers that the answer to this question should be NO. Further discussion is set out below.

Q2: "If question 1 is answered in the affirmative

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

- 1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States including regional European patent protection and
2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

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

IPO considers that this question does not need an answer because of the answer given above to question 1. However, IPO supports the validity of the so-called PCT Joint Applicants Approach, as discussed further below.

Detailed discussion of Q1

IPO considers that the answer to question 1 should be NO, i.e. that the EPC does not confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title under Article 87(1)(b) EPC to the right to claim priority. This is a logical conclusion given that there is no explicit reference in the EPC conferring such jurisdiction on the EPO. It is also consistent with the position set out in Article 60 EPC that a European patent applicant is assumed to be entitled to the rights in a European patent arising from an application filed in its name:

Article 60(3) EPC

In proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right to a European patent.

It is established that under Article 60 EPC the EPO has no jurisdiction to adjudicate disputes relating to entitlement to a European patent and that this is a matter of national law. It follows that the EPO should not have jurisdiction to adjudicate disputes relating to the right to claim priority, which is related to and often directly linked to the right to the patent itself. There is no basis in the EPC for a distinction between the jurisdiction of the EPO with respect to entitlement to the patent and entitlement to claim priority.

Furthermore, from a practical perspective, IPO considers that the EPO is not a suitable forum for fair and efficient adjudication of the questions necessary to determine whether a party is a valid successor in title to the right to claim priority. As the referring Board notes¹, these questions often relate to the application of national law to agreements between natural and legal persons. This places an undue burden on the EPO to fairly adjudicate whether rights have transferred between parties by reference to the national law of potentially any country in the world.

Finally, IPO considers it disproportionate to confer such jurisdiction on the EPO, which may lead to applicants and patent holders being unfairly disadvantaged in proceedings before the EPO if they are unable to provide internal confidential documents relating to a relevant transfer of priority rights, where the failure to provide such documents could lead to adverse consequences.

If the EBA disagrees with our answer to question 1 and takes the view that the EPO does have some jurisdiction to determine whether a party validly claims to be a successor in title, IPO urges the EBA to place some restrictions on the circumstances in which the EPO has such jurisdiction. This is necessary to avoid an unfettered jurisdiction with all the problems that would arise as we have set out above.

¹ T1513/17, Reasons 37

IPO's position on this additional point is that, if the EPO has any jurisdiction, it should be only in the case when the party raising such a challenge has themselves established a legitimate interest in the right to claim priority. This would safeguard the rights of patent holders and avoid speculative challenges to the priority claim as are seen all too often now in opposition proceedings by uninterested (sometimes unnamed) opponents. It would also balance the interests of third parties with genuine ownership interest in the priority rights, in much the same way as those are balanced in the national laws of EPC contracting members states in so far as they relate to entitlement to a patent. For example, section 37 of the UK Patents Act 1977 limits the availability of post grant entitlement proceedings to a person "*having or claiming a proprietary interest in or under the patent.*" It would be consistent for similar restrictions of the EPO's jurisdiction to determine the validity of the claim of successor in title to be included here, if the EBA disagrees with our answer of NO to question 1.

Detailed discussion of Q2

IPO considers that no answer is required to question 2 because of the answer given above to question 1 (NO) and the formulation of the referring Board's question ("*If question 1 is answered in the affirmative...*"). However, if the EBA disagrees with our answer to question 1, IPO has the following comments.

As an initial point, IPO considers that in answering question 2 there should be no tacit acknowledgment that the EPO has jurisdiction to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC in all circumstances. Question 2 sets out a specific fact pattern in sub-points 1, 2 and 3 and IPO considers that in answering this question, the EPO's jurisdiction to determine whether a party is a valid successor in title should be limited to scenarios matching these specific facts.

With the above point considered, should an answer to question 2 be required, IPO's view is that the answer should be YES. IPO supports the validity of the PCT Joint Applications Approach to resolve the question of priority entitlement in the fact patterns set out in sub-points 1, 2 and 3 of question 2.

IPO agrees with the validity of the PCT Joint Applicants Approach because it follows established EPO case law on the validity of formal priority entitlement set out by the Boards in earlier decisions on the more general Joint Applicants Approach. For example, in T1933/12 the Board acknowledged that²:

"...Article 87(1) EPC does not preclude the (individual) applicant of the first application from sharing his right of priority with a third party by filing a priority application together with the latter. Thus, if the priority-claiming application is filed jointly by several applicants, not all of these applicants also have to be applicants or successors in title of the applicants of the first application...

In such a case, in which only one additional applicant is added to the subsequent application, there is no need for proof of the transfer of the right of priority to this other applicant (see: Breimi, loc. cit., Art. 87 para. 56)."

² T1933/12, Reasons 2.4

Endorsing the validity of the PCT Joint Applicants Approach would be consistent with existing jurisprudence of the Boards of Appeal. It would also be consistent with a subsequently issued Notice of the EPO President³ which set out that:

“9. In the case of joint applicants filing the international application with the EPO as receiving Office and claiming priority from an earlier application, it is sufficient that one of the applicants is the applicant for that earlier application, or his successor in title. Since the international application has been filed jointly, thereby showing the consent of the applicant for the earlier application, there is no need for a special transfer of priority right to the other (additional) applicant(s). Likewise, no transfer of priority right is needed where the earlier application was filed by joint applicants, provided that all of them, or their successor(s) in title, are amongst the joint applicants for the international application.”

As a final point, endorsing the PCT Joint Applicants Approach would also be in line with the principle of legitimate expectations, based on the approach taken to date by several different opposition divisions that have endorsed its validity in their recent decisions.

Although IPO considers that the answer to question 2 should follow our comments above, if the EBA disagrees and decides to answer question 2 NO (i.e. rejecting the PCT Joint Applicants Approach) IPO requests that the decision not have retroactive effect, i.e. that the EBA's decision does not apply to European patents and applications having an earliest priority date before the issuance of the decision.

Conclusion

IPO thanks the EBA for its consideration of this submission.

Sincerely,



Karen Cochran
President

³ Notice from the European Patent Office concerning the requirements to be observed when filing an international application with the EPO as a PCT receiving Office, OJ EPO 2014, A33

APPENDIX

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