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Attention: Mr Nicolas Michaleczek ([EBAamicuscuriae@epo.org](mailto:EBAamicuscuriae@epo.org)).

My ref: M50265A  
Your ref: G1/22 and G2/22  
Date: 18 July 2022

Dear Sir/Madam

**Amicus Curiae Brief**  
**In EBA Referrals G1/22 and G2/22 Re "Entitlement to priority"**

I submit the following amicus curiae in the G1/22 and G2/22 referrals.

Executive Summary

- These combined referrals from Board 3.3.04, G1/22 and G2/22, are both headed "Entitlement to priority".<sup>1</sup>
- Decision T844/18 held that the EPO has the power to examine right to claim priority, and Board 3.3.04 notes in making the referrals that it explicitly accepts that decision<sup>2</sup>.
- Question I of the referrals asks nevertheless whether the EPO has power to examine *successor in title* when examining right to claim priority.
- Question II of the referrals then asks whether a *succession in title* can be effected by the act of filing a PCT application naming joint applicants.
- The referrals therefore do not relate to right to claim priority, as the EPO's power to examine this is not challenged, but to successor in title; the referrals would be properly renamed as **G1/22 and G2/22 "Successor in title"**.
- The EPO has the power to, and does indeed, examine both right to claim priority and successor in title.
- Question I is inadmissible, unworthy of referral and not needed in order for Question II to be referred; though if Question I must be raised it can be answered in the affirmative, and without doubt.
- An answer to Question II seems necessary for a decision to be reached in that case.
- The referral of Question I should therefore be refused as inadmissible, and Question II reworded so it stands alone.

<sup>1</sup> <https://www.epo.org/law-practice/case-law-appeals/eba/pending.html>

<sup>2</sup> e.g. Decision T2719/19, reasons 24

### Referring a Question to the Enlarged Board of Appeal

Under the European Patent Convention<sup>3</sup> during proceedings in a case before a given Board of Appeal, a question can be referred to the Enlarged Board of Appeal (EBA) if a decision on that question is needed to make a decision on the case under appeal<sup>4</sup>. The justification for referring the question can be one of two options: (1) to ensure uniform application of the law<sup>5</sup> or (2) if a point of law of fundamental importance arises<sup>6</sup>. EBA referrals can be invoked under other circumstances, i.e., referrals not arising from a case before a Board of Appeal, but this is not relevant as the present referral is indeed by a Board of Appeal during proceedings on a case. Confusingly, and as explored in detail *infra*, Board 3.3.04 relies on neither justification as the basis for its proposed referral of Question I.

### Uniform Application of the Law

Admissibility of EBA referrals was the subject of discussion by G. Wesela-Bauman in epi, Issue 4, 2020<sup>7</sup>. The topic is also covered in detail in the EPO's published Case Law of the Boards of Appeal, Section V, B, 2.3.6<sup>8</sup>. Both are helpful for further details and citations, which are not overly repeated herein.

For the first option, it is clear that non-uniform application of the law must be identified and specified and be sufficiently severe to need rectification. It is not enough for there to be, say, just one decision that is contrary to the thrust of other decisions on the same point. It can also be the case that applying the same legal principles to different facts gives a different conclusion; this does not by itself indicate non-uniformity of application of the law.

### Point of Law of Fundamental Importance

For the second option, again there is helpful detail in the same epi article as noted above and in the following section of the Case Law of the Boards of Appeal, at Section V, B, 2.3.7<sup>9</sup>. As to when a point of law of fundamental importance arises, there are established guidelines. Conflicting decisions from two Boards of Appeal allow the President of the EPO to identify a point of law of fundamental importance<sup>10</sup> – so the same surely applies to referrals by a Board of Appeal, whether under option (1) or (2)?

G1/13 urges in favour of admissibility of a referral if the question

*“... could be relevant to a large number of similar cases and/or is important not only to the users of the European patent system but also to the Boards of Appeal and the EPO itself”*.<sup>11</sup>

On the other hand, a referral is inadmissible if the question(s) can be answered directly and unambiguously by reference to case law and guidelines of the EPC<sup>12</sup>. T844/18 noted

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<sup>3</sup> <https://www.epo.org/law-practice/legal-texts/html/epc/2020/e/ma1.html>

<sup>4</sup> EPC Article 112(1)(a)

<sup>5</sup> EPC Article 112(1), first clause

<sup>6</sup> EPC Article 112(1), second clause

<sup>7</sup> <https://information.patentepi.org/issue-4-2020/admissibility-of-referrals-before-t.html>

<sup>8</sup> [https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clar\\_v\\_b\\_2\\_3\\_6.htm](https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clar_v_b_2_3_6.htm)

<sup>9</sup> [https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clar\\_v\\_b\\_2\\_3\\_7.htm](https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clar_v_b_2_3_7.htm)

<sup>10</sup> [https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clar\\_v\\_b\\_2\\_4\\_1.htm](https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clar_v_b_2_4_1.htm)

<sup>11</sup> Decision G1/13, reasons 2.1

<sup>12</sup> Decision G1/12, reasons 10; Decision J5/81, reasons 11; Decision J14/91, reasons 5.1

*“The Board has a discretion whether to refer questions, even if a point of law of fundamental importance is concerned (see decision T 0390/90, OJ 1994, 808, point 2). One of the applicable criteria is whether the question can be answered beyond doubt by the Board itself (see decision T 1242/04, OJ 2007, 421 point 10.3). In this case the Board has been able to answer the questions raised beyond doubt, hence no referral is necessary<sup>13</sup>”.*

#### The Questions Proposed for Referral by Board 3.3.04

With the above in mind, let us examine the questions proposed for referral and the justification provided by Board 3.3.04 so we can review the admissibility of the referral. I will start with the questions, which are these:

- I. 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?
- II. If question I 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
  - 3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

#### Question I

This Question needs some context from the referring decisions<sup>14</sup> because the referring Board 3.3.04 noted and approved specifically the decision in T844/18, addressing the

*“jurisdiction of the EPO to decide on the entitlement to the priority right”*

and Board 3.3.04 stated its agreement to the finding in T844/18

*“that there is no legal basis to relieve the EPO from the obligation to assess who has performed the act of filing the patent application as required by Article 87(1) EPC. The board in the present composition is inclined to agree with this conclusion.”<sup>15</sup> {emphasis added}*

Another point to be noted is that Question I asks whether the EPO has jurisdiction to examine successor in title issues with respect to Article 87(1) EPC. This reference to Article 87(1) EPC makes a distinction, therefore, in determining successor in title for the purpose of examining whether a priority claim is valid and determining successor in title for other, non-Article 87(1) EPC purposes, such as updating the EPO Register with who is to be the currently named applicant.

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<sup>13</sup> Decision T844/18, reasons 122

<sup>14</sup> Decisions 1513/17 and 2719/19, both of 28 January 2022

<sup>15</sup> e.g. Decision 2719/19, reasons 24

As a first aside, though useful for the current discussion, the second Question then asks whether, if the EPO *does* have power to examine successor in title for priority purposes, a valid claim to priority can be achieved by the PCT “Joint Applicants” approach.

As a second aside, a point of vocabulary / terminology is believed helpful at this point: in the submissions of the various parties and in the decisions/preliminary opinions leading to this attempted (the EBA could refuse it in whole or part) referral, and elsewhere<sup>16</sup>, the phrase ‘entitlement to the priority right’ and similar phraseology is used. I regard this as accidentally or even intentionally misleading, because it elides (i) entitlement, with (ii) right to claim priority under Article 87 EPC. I say misleading because the EPC is already clear that entitlement to a European patent is beyond the jurisdiction of the EPO<sup>17</sup>. By the choice of the word ‘entitlement’ in framing such issues, some say, ‘entitlement to the priority right’ is automatically beyond the EPO’s remit. This argument is pure sophistry, and I approve the avoidance of this misleading phrase in the Questions.

The referring decisions do, however, trip up over this terminology, saying for example:

*“a parallel was drawn with reference to the Travaux Préparatoires between the power to determine whether a party is entitled to a particular patent application, which the EPO does not have, and the power to decide on the entitlement to the priority right”<sup>18</sup>.*

Here, the juxtaposed use of ‘entitled’ and ‘entitlement’ incorrectly links true issues of entitlement (who is the legal owner) with the administrative process of examination of the formal right to claim priority.

I conclude in this second aside: (a) a better term is ‘right to claim priority’, stripped of any misleading reference to entitlement, and (b) Board 3.3.04 accepts T844/18 has decided the EPO has the power to determine right to claim priority. Question I thus asks whether the EPO has the power to examine successor in title *in order to exercise its accepted power of examining the right to claim priority under EPC Article 87(1)*.

*If Question I is Admissible, the Answer to Question I is “Yes”*

Article 87(1) permits a successor in title to exercise the right to claim priority, and this derives straight from the Paris Convention Article 4, reproduced here (from its 28 September 1979 version) just to confirm the precise wording:

*“4A (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed”<sup>19</sup>.*  
{emphasis added}

If there is a conflict of laws in determining under which law the succession in title is determined – and I don’t say there is – then this has not prevented the EPO from actually

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<sup>16</sup> e.g. in T844/18

<sup>17</sup> EPC Article 60(3)

<sup>18</sup> e.g. Decision 2719/19, reasons 26

<sup>19</sup> <https://wipo.lex.wipo.int/en/text/288514>, Article 4A(1)

examining and determining succession in title. T205/14 did examine successor in title, noting:

*“Since the provisions of the EPC do not lend themselves to an autonomous determination of the requirements for the transfer of right of priority, the validity of such transfer is a matter of national law<sup>20</sup>”.*

T1201/14 also examined successor in title, saying similarly:

*“In any event, as the EPC contains neither guidance as to the formal requirements for a valid transfer of the ownership of the right of priority nor conflict-of-laws provisions for that purpose, national law is commonly relied upon by the departments of the EPO...”<sup>21</sup>*

Just as examples from a non-limiting list, decisions in which EPO Boards of Appeals have found basis for examining and have indeed examined successor in title include J19/87, T160/13, T1008/96, T382/87 and, as mentioned, T205/15 and T1201/14.

There is also no exclusion in the articles of the EPC, carving out successor in title, whether as part of the examination under Article 87(1) or otherwise, from the jurisdiction of the EPO. Thus, nothing in the EPC takes away the EPO's jurisdiction to examine successor in title. On a case-by-case basis the EPO will hear the parties as to which national law is applicable, but the unavoidable point is that the EPO has the power to and does examine and determine successor in title for the purposes of examining the right to claim priority.

To end in this section, Decision T844/18 noted it had applied

*“the established case law of the EPO and the Boards of Appeal as regards assessment of priority claims, the so-called “all applicants” approach (i.e. matching of all applicant names; also called “same applicant” approach). This approach requires that all of the persons listed as applicants for the priority application are also listed as applicants for the subsequent application, allowance being made for successors in title<sup>22</sup>”.* {emphasis added}

There is no doubt the EPO has the power to examine successor in title, and the EPO uses that power. We already know, and Board 3.3.04 accepts, the EPO has power to examine right to claim priority. If Question I were admitted it can only be answered (effectively *again*) in the affirmative.

#### *Consequences of answering Question I in the negative*

It is sensible to consider some consequences of a negative response to Question I.

At present, the EPO examines successor in title when carrying out the administrative task of determining whether the applicant is able to benefit from a right to claim priority from an earlier application under Article 87(1) EPC.

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<sup>20</sup> T205/14, reasons 3.6.3

<sup>21</sup> T1201/14, reasons 3.1.2

<sup>22</sup> T844/18, Summary, VIII

When the earlier application is in the name of Applicant A and so is the priority-claiming, later application no issues arise – priority can be confirmed (assuming other requirements for a valid priority claim, e.g. same invention, are also met). A negative response would make no difference. Of course, few if any contested priority-same applicant cases have this fact pattern.

When the earlier application is in the name of Applicant A and the priority-claiming, later application is in the name of Applicant B and there an effective and timely transfer of the right to claim priority from A to B, then under the current practice of the EPO, again, no issues arise – priority can be confirmed (making the same assumptions as above). But the effect of a negative response to Question I would be that the right to claim priority cannot be examined, B cannot be acknowledged as successor in title and the claim to priority may fail, despite the fact the validity of the priority claim should clearly be confirmed. This cannot be an outcome in the public interest.

When the earlier application is in the name of Applicant A and there is an effective and timely transfer of the right to claim priority from A to B, but the priority-claiming, later application is (or effectively remains) in the name of Applicant A, then under the current practice of the EPO, priority will be rightly denied (e.g. when the fact of the transfer comes to light in an opposition). But the effect of a negative response to Question I would be that the successor in title cannot be examined, B cannot be acknowledged as successor in title and the earlier and later applications are seen as being in the same name. Priority may then be upheld, wrongly, at the EPO. The opportunity for reversal would exist but only through later proceedings at national level, adding a further burden of cost and time and uncertainty for all, including third parties. This too cannot be an outcome in the public interest.

#### *Admissibility - Conflicting Decisions*

In raising Question I, Board 3.3.04 identifies no conflicting decisions.

Board 3.3.04 does identify, however, an *ex officio communication* (not a Board of Appeal decision) said to be relevant, issued in the run-up to Decision T419/16. Interestingly, that *ex officio* communication was issued by ... Board 3.3.04.

Board 3.3.04 does also identify, however, an *ex officio communication* (not a Board of Appeal decision) said to be relevant, issued in the run-up to Decision T845/19. Interestingly, that *ex officio* communication was again issued by ... Board 3.3.04.

Next, Board 3.3.04 identifies another *ex officio communication* (again, not a Board of Appeal decision) issued in the run-up to Decision T239/16. That communication<sup>23</sup> does ask whether the EPO has the power to examine the right to claim priority (notably using the ‘entitlement’ terminology) but reaches no conclusion against or in favour. In the final decision in that case this question was not considered. Further, Decision T239/16 came before T844/18 which has subsequently decided that the EPO *does* have the power. The *ex officio* communication, not a decision, in T239/16 is hence of no relevance whatsoever.

Lastly, Board 3.3.04 identifies a **commentary** (again, not a Board of Appeal decision, and in fact not even issued by the EPO) by Breimi<sup>24</sup> said to question the power of the EPO to

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<sup>23</sup> See EP1591122, communication of 14 June 2017

<sup>24</sup> The citation given is: “Singer/Stauder/Luginbühl, EPÜ, 8. Auflage, Art. 87, Rdn 61”

examine right to claim priority. The same Bremi was an expert witness in T844/18, submitting several similarly worded declarations giving his personal opinion on the absence, in his view, of the EPO's jurisdiction. As a further reminder, T844/18 considered Bremi's declarations as well as many other declarations and submissions and decided the EPO *does* have the relevant power. The commentary, not a decision and not even from the EPO, is also hence of no relevance whatsoever.

Finally, I would add in this sub-section I cannot recall the EPO ever *declining* to examine successor in title when relevant to examining validity of the right to claim priority. On the contrary this issue is a mainstream component of opposition (and related appeal) practice when there is a challenge available to the effective filing date of the claimed subject matter in a patent under opposition, or alternatively that of the prior art.

Decision 1201/14 put it this way:

*“Given that the right of priority confers on its owner a benefit of an exceptional kind, it is of the utmost importance for third parties to have certainty as early as possible so as to be able to determine the patent application's effective filing date and the relevant prior art, with its crucial effect on patentability<sup>25</sup>”.*

I estimate that with help from a few other representatives who file and defend oppositions thousands of cases could be listed in which successor in title was examined by the EPO as part of the routine process of examining right to claim priority and effective date of the prior art.

#### *Admissibility - Point of Law of Fundamental Importance*

In raising Question I, Board 3.3.04 makes no references to a point of law of fundamental importance.

#### *Admissibility - Justification provided by Board 3.3.04*

What justification is given by Board 3.3.04 in support of the referral of Question I?

Board 3.3.04 records that

*“the jurisdiction of the boards to decide on the entitlement to the priority right had not been explicitly questioned during the written proceedings. Indeed, none of the parties presented arguments in their written submissions why the present standing practise is incorrect or why the reasoning in, for example decision T 844/18, is incorrect other than a reference to decision J 11/95 made by respondent I<sup>26</sup>”.*

This does not quite tally with the record because the respondent in T2719/91 did propose an EBA referral to ask if the EPO can determine successor in title and then if answered in the affirmative to ask, in effect, whether the PCT Joint Applicants approach can validly transfer the right to claim priority<sup>27</sup>.

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<sup>25</sup> T1201/15, reasons 3.2.1.3

<sup>26</sup> e.g. Decision T2719/19, reasons 25

<sup>27</sup> T2719/19, Respondent submission of 15 September 2021, para. 1.24

Board 3.3.04 seem nevertheless to be expanding this request from the Respondent into a question of right to claim priority, as per Question I of the referral, of their own accord, and as explained herein without due justification.

I have discussed already the reference to communications and commentaries (none of them being decisions) by Board 3.3.04.

The Board's justifications for referring Question I are that

*“the issue will therefore, in spite of the decision in case T 844/18, most likely be raised again”*

and then that

*“if questions regarding priority are to be referred to the EBA on a related matter, this is a convenient opportunity to have a final decision on the ‘jurisdiction issue’ as well<sup>28</sup>”. {emphasis added}*

There is already adverse criticism on this failure to properly justify the referral, i.e. failure to meet the criteria of Article 112(1) EPC, in an epi article<sup>29</sup> by a previous Chair of Board 3.3.04. Without repeating many of the points well made in that article, I can distil Board 3.3.04's justifications given for referring Question I into (i) others will ask the same question of jurisdiction, and (ii) let's do this solely for the convenience. I would ask in reply: so what, and convenient for whom? It is certainly not in the public interest to refer Question I – for details, see *supra* and *infra*.

#### *Admissibility – Conclusions re question I*

Noting the following as discussed above:

- T844/18 has already decided that the EPO has the jurisdiction to examine right to claim priority.
- Board 3.3.04 has said it accepts and approves Decision T844/18.
- There are no conflicting EPO decisions on whether the EPO has power to determine successor in title for the purposes of priority examination
  - By contrast, the EPO consistently and without exception does and has done just that, i.e. examined successor in title before deciding whether priority is validly claimed
  - The EPO also routinely examines successor in title for the purpose of updating the EPO register
- Board 3.3.04's observation that this is a “convenient opportunity” to refer this question provides no basis under the EPC for a referral.
- Board 3.3.04's observation that “the issue [...] will be raised again” also provides no basis under the EPC for a referral.
- The *ex officio* **communications** said to support a referral emanate principally from Board 3.3.04 itself.
- Board 3.3.04 identifies no fundamental point of law needing referral.
- Question I can be answered unambiguously based on existing decisions, guidelines and practice of the EPO and its Boards of Appeal.

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<sup>28</sup> e.g. Decision T2719/19, reasons 26

<sup>29</sup> <https://information.patentepi.org/issue-1-2022/how-much-priority-for-entitlement-to-priority.html>

**I conclude with respect to Question I:**

- **The referral with respect to Question I is inadmissible.**
- **If the referral is admitted then the answer is yes, without doubt: the EPC does 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.**

I next observe: in relation to Question I

- If the answer were to be no, the EPO does not have jurisdiction to examine successor in title under Article 87(1)(b) EPC, then having regard to the fact it has been doing just that and examining successor in title under Article 87(1)(b) EPC since the EPO opened its (metaphorical) doors to patent applications, such a radical change in practice can only be effective in a forward-looking sense; based on previous instances of paradigm-shifts at the EPO the effective date of such a change in practice would be determined by the EBA, e.g. taking effect after publication of the decision; this change would not affect any existing oppositions / appeals and would not affect the cases on which the question was referred<sup>30</sup>.
- Board 3.3.04's action in framing this referral in circumstances that so woefully fail the criteria for admissibility, causing untold disruption to countless examination, opposition and appeal proceedings, is unacceptable for a Technical Board of Appeal and quite irresponsible; this is even more the case given the future effective date of any change – though to be clear there is absolutely no need for nor justification for a change.
- The stark nature of the inadmissibility of the referral of Question I indicates Board 3.3.04 has strayed from trying to apply the law – which has already been unambiguously decided – to trying to change the law; such an action is *ultra vires* for an EPO Technical Board of Appeal.
- A change of law in this area of the right to claim priority is not in the public interest. The current law is clear and unambiguous and enables the EPO to examine a claim to priority and allocate a priority date as the effective filing date for the purpose of examining patentability (and determining the prior art landscape, for which effective filing date must also be determined). If the law were to change so that EPO did not have jurisdiction to examine successor in title under Article 87(1)(b) EPC then for examination of patentability would the EPO *perforce* allocate the priority date or the filing date for affected applications? Article 89 EPC provides that the date of priority shall count as the date of filing, but this is only *after examination* of the right to claim priority. If the EPO could not examine right to claim priority then would the applicant be stuck with the filing date<sup>31</sup>? That subsequent question would have to be addressed, but has not been, and could only be the subject of further, lengthy and bitterly contested proceedings. Again, such an outcome would not be in the public interest.

**Question II**

In this submission, I decline to argue with respect to the admissibility of Question II nor as to the merits of the (implied?) proposal that the PCT “Joint Applicants” approach can result in a valid succession in title, i.e., a valid transfer of the right to claim priority by the act of filing a PCT Request form.

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<sup>30</sup> G9/93, reasons 6.1; G5/93, 2<sup>nd</sup> paragraph of Order

<sup>31</sup> Those advocating a change in the law should be careful what they wish for!

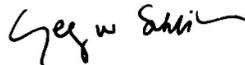
Instead, I am concerned that this Question II may indeed be worthy of referral and the presentation of Question I as being an alleged *pre-requisite* to Question II is subterfuge. Let's assume for argument's sake that Question II is worthy of referral. We might *accidentally* address Question I, which is inadmissible and unworthy, in order to refer the truly worthy question. This set up is, however, pretty transparent.

Continuing to assume Question II is worthy of referral, it cannot be beyond the EBA to reformulate Question II independently of question I.

**I submit with respect to Question II:**

- **Question II should be reformulated into a question concerning the PCT "Joint Applicants" approach with no reference to or need for an answer to Question I.**
- **Question I can then be dispensed with.**

Yours faithfully



**George W Schlich**