

**Enlarged Board of Appeal EPO, 13 June 1994,
Unlawful applicant - Latchways**

PATENT LAW

New application for invention - earlier application filed by a non-entitled person

- When it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Article 61(1) EPC, files a new European patent application in respect of the same invention under Article 61(1)(b) EPC, it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.

For the reasons which are set out below, the wording of Article 61 EPC does not on its proper interpretation exclude its application to cases where the unlawful applicant's earlier application is no longer pending when the lawful applicant files a new application pursuant to Article 61(1)(b) EPC.

5.3 For the same reason as set out in paragraph 4.2 above in connection with the Protocol on Recognition, the reference in Article 61(1) EPC to "the applicant" does not necessarily imply that, for Article 61 EPC to be applicable, there must be an existing applicant and therefore a pending application.

Furthermore, the phrase in Article 61(1) EPC "provided that the European patent has not yet been granted", which in fact constitutes a pre-condition for the applicability of Article 61 EPC, does not necessarily require that the application must still be pending. On the contrary, this phrase can fairly be interpreted as indicating that Article 61 EPC is only applicable in the case of a final decision which terminates a dispute concerning entitlement to a European patent application and is not applicable in the case of a dispute concerning entitlement to a granted European patent. This interpretation is confirmed by the contents of sub-paragraphs (a) to (c) of Article 61(1) EPC, which ensure that the EPO controls the stage before and including the making of a decision on the grant or refusal of the application, following appropriate action by the lawful applicant.

Thus there is nothing in the wording of Article 61(1) EPC, when read as a whole, which requires the existence of a pending application at the time when a lawful applicant takes action pursuant to Article 61(1)(b) EPC.

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Enlarged Board of Appeal EPO, 13 June 1994

(P. Gori G.D. Paterson F. Antony C.Payraudeau E. Persson R. Schulte P. van den Berg)

Decision of the Enlarged Board of Appeal dated 13 June 1994

G 3/92

[...]

Applicant: Latchways Limited

Headword: Unlawful applicant/LATCHWAYS

Summary of the Proceedings

I. During proceedings in appeal case J 1/91 (OJ EPO 1993, 281) which is before it, and following a request from the appellant, the Legal Board of Appeal has referred an important question of law to the Enlarged Board of Appeal under Article 112(1)(a) EPC in its decision dated 31 March 1992: the question is concerned with the extent of the remedies which are available to a true inventor (or his successors in title) under Article 61 EPC, in the circumstance that a person other than the true inventor has applied for a European patent.

II. A complete summary of the facts of the case which is before the Legal Board of Appeal is set out in the decision of referral identified above. For the purpose of answering the referred question of law, the relevant facts as set out in that decision may be more briefly summarised as follows:

In 1982 the appellant company was interested in exploiting a device which it had developed, and for this purpose details of the device were disclosed in confidence to a third party. Unknown to the appellant, this third party (the "unlawful applicant") in 1985 filed a European patent application (the "1985 application") in respect of such device, and this application was published later in 1985, but was deemed to be withdrawn in 1986 because no request for examination was filed in due time.

The appellant was at this time unaware of the 1985 application, and filed a European patent application in respect of the same device in 1987. A European search report was drawn up and transmitted to the appellant in 1988, which cited the earlier 1985 application, and thus made the appellant aware of the 1985 application for the first time.

The appellant accordingly referred a question to the Comptroller of the United Kingdom Patent Office under Section 12 of the United Kingdom Patents Act 1977, as to whether he was entitled to the grant of a European patent for the invention which is disclosed in the 1985 application. A Superintending Examiner acting for the Comptroller duly issued a decision dated 6 March 1990, in favour of the appellant.

Within three months, the appellant filed a new European patent application (the "1990 application") in respect of subject-matter disclosed in the 1985 application, pursuant to Article 61(1)(b) EPC. The Receiving Section of the European Patent Office issued a decision dated 27 December 1990, however, in which it was held that the 1990 application could not be dealt with under Article 61(1)(b) EPC because the 1985 application was no longer pending at the date of filing of the 1990 application, this, according to the Receiving Section, being a prerequisite for the application of Article 61 EPC.

This decision is based primarily upon a consideration of the wording of Article 61 EPC and its associated Rules 13 to 15 EPC: reference is also made to the "pre-

dominant concern for the public's legal certainty concerning patent matters", and to the possibility under the above provisions that a lawful applicant may assert his rights while an application by an unlawful applicant is still pending.

The appellant's appeal against the decision of the Receiving Section constitutes the case before the Legal Board of Appeal which is referred to above. The question which has been referred to the Enlarged Board of Appeal by the Legal Board of Appeal is as follows:

"Where it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Article 61(1) EPC, files a new European patent application in respect of the same invention under Article 61(1)(b) EPC, is it a pre-condition for the application to be accepted that the original usurping application still be pending before the EPO at the time the new application is filed?"

III. Following the referral of the above question to the Enlarged Board of Appeal, the President of the European Patent Office requested to be given the opportunity to submit comments in writing on the referred question of law to the Enlarged Board of Appeal, pursuant to Article 11a of the Rules of Procedure of the Enlarged Board. The reason given for this request was that the case's interest and importance lies in that it concerns the basic principle of safeguarding the true inventor's rights within the European patent system. In its reply, the Enlarged Board invited the President to comment on whether Article 61 EPC safeguards the true inventor's rights in the case where a wrongful applicant has previously filed a European application, and has withdrawn such European application after its publication.

IV. On 5 November 1992 the President of the EPO submitted comments to the Enlarged Board supporting the Receiving Section's interpretation of Article 61 EPC, including references to the "preparatory documents" which preceded the drafting of Article 61 EPC. The main basis underlying the President's support for the Receiving Section's interpretation of Article 61 EPC is a concern that if Article 61 EPC is applicable even when an application by an unlawful applicant is no longer pending, this will lead to legal uncertainty in the sense that third parties may be misled by such withdrawal into commencing commercial activities which would subsequently be prejudiced if a lawful applicant is later allowed to file a new European application having the same subject-matter and the effective date of the earlier application by the unlawful applicant. According to the system envisaged by the President, a lawful applicant is therefore obliged to protect his interests by maintaining a watch on all relevant pending applications as soon as they are published pursuant to Article 93 EPC, so as to make himself aware of a pending application by an unlawful applicant in respect of subject-matter to which he is entitled, and in the event that he becomes aware of such an application by an unlawful applicant he should take immediate steps un-

der Rules 13 and 14 EPC to prevent the application by the unlawful applicant from being withdrawn or otherwise disposed of. Nevertheless, the President recognised that such a system could inevitably lead to inequitable results: for example, if an invention was stolen from the lawful applicant without his knowledge, and a European application by an unlawful applicant was then withdrawn immediately after its publication.

Reasons for the Decision

1. The referred question specifically concerns the interpretation of Article 61(1) EPC, which governs the procedural rights of a person who has been adjudged to be entitled to the grant of a European patent, as against the actual applicant in respect of a European patent application. However, Article 61 EPC is part of a system of legal process which is provided under the EPC for determining the right to a European patent application when this is in dispute, and for implementing such a determination. The terms of Article 61 EPC have to be interpreted in this context and in the light of the object and purpose of this system. It is accordingly necessary to consider in the first place the nature of this system and the place of Article 61 EPC within it, before considering the detailed wording of Article 61 EPC and the Rules which are intended to implement it.

2. According to Article 60(1) EPC, the right to a European patent shall belong to the inventor or his successor in title. Consequently, as a matter of law, only the inventor (or his successor in title) is entitled to apply to the EPO for the grant of a European patent and, subject to examination of the application for conformity with the patentability and other requirements of the EPC, to be granted a European patent for his invention. However, Article 58 EPC provides that a European patent application may be filed by any legal or natural person and Article 60(3) EPC provides that "For the purposes of proceedings before the EPO, the applicant shall be deemed to be entitled to exercise the right to a European patent". Consequently, as a matter of fact, a European patent application may actually be filed in respect of potentially inventive subject-matter by a person other than the inventor of such subject-matter or his successor in title, contrary to the legal right of the latter, and before the latter has himself filed a European patent application in respect of such subject-matter.

3. Under the European patent system, the EPO has no power to determine a dispute as to whether or not a particular applicant is legally entitled to apply for and be granted a European patent in respect of the subject-matter of a particular application. Determination of questions of entitlement to the right to the grant of a European patent prior to grant is governed by the "Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the grant of a European Patent" (the "Protocol on Recognition"), which is an integral part of the EPC. This Protocol gives the courts of the Contracting States jurisdiction to decide claims to entitlement to the right to the grant of a European patent, provides a system for determining which national court shall decide such claims in individual cases, and requires the mutual recognition of decisions

in respect of such claims, within the Contracting States to the EPC.

3.1 Article 1(1) Protocol provides that "The courts of the Contracting States shall ... have jurisdiction to decide claims, against the applicant, to the right to the grant of a European patent in respect of one or more of the Contracting States designated in the European patent application". In relation to any particular claim by an alleged lawful applicant against an actual applicant for a European patent, the particular Contracting State whose courts have jurisdiction to decide the claim is determined by the system of jurisdiction set out in Articles 2 to 8 Protocol. For any such claim, this system of jurisdiction designates the courts of one (and only one) Contracting State as the proper forum in which the claim must be decided.

After a court in a Contracting State has given a final decision on "the right to the grant of a European patent in respect of one or more of the Contracting States designated in the European patent application", Article 9(1) Protocol provides that such a decision "shall be recognised without requiring a special procedure in the other Contracting States". Furthermore, Article 9(2) Protocol provides that "The jurisdiction of the court whose decision is to be recognised and the validity of such decision may not be reviewed".

3.2 Under Article 167(2) EPC, a Contracting State to the EPC may reserve the right to provide that it shall not be bound by the Protocol on Recognition. Under Article 167(3) EPC, such a reservation can only have effect for a limited period of time. Article 1(3) Protocol provides that for the purposes of the Protocol, the term "Contracting State" refers to a Contracting State which has not excluded application of the Protocol on Recognition under Article 167 EPC.

3.3 Thus, in accordance with the above provisions of the Protocol on Recognition, a claim to the right to the grant of a European patent can only be decided before a court of the appropriate Contracting State; this is the only forum in which a lawful applicant may commence proceedings to establish his right. Furthermore, when such a claim has been decided in a final decision of such a national court in favour of a lawful applicant (B) and against an unlawful applicant (A) for a European patent application, that decision has to be recognised in all the other Contracting States which are bound by the Protocol. Under the Protocol on Recognition, subject to Articles 10 and 11(2) thereof, recognition is automatic and as of right.

3.4 When a national court of the appropriate Contracting State decides an individual case concerning a claim to entitlement to the grant of a European patent under the Protocol on Recognition, it will apply the particular national law which governs determination of the case, which may or may not be its own national law, within the framework of its own legal system. Without the system of jurisdiction and recognition provided by the Protocol on Recognition, an individual case concerning a dispute as to who has the right to apply for a European patent could be the subject of proceedings in more than one national court, and could be decided differ-

ently in different national courts. It would then be impossible for the EPO to deal with one applicant (i.e. the lawful applicant) in respect of the European application which is the subject of such proceedings.

The above provisions of the Protocol on Recognition avoid such difficulties. A claim to the entitlement to the grant of a European patent is decided by a court of just one Contracting State, and whatever the result in that court, its decision is recognised in all the other Contracting States which are bound by the Protocol. This system of jurisdiction set out in the Protocol has its counterpart in Article 61 EPC, by which a dispute concerning the legal right provided by Article 60(1) EPC, having been decided by the appropriate national court, can be implemented and enforced for the purpose of the granting procedure before the EPO. Following the initiation by the lawful applicant (B) of a new procedure before the EPO in accordance with Article 61 EPC, the EPO is required to deal thereafter in such new procedure with the lawful applicant (B) in place of the unlawful applicant (A).

4. Turning now to the particular problem of interpretation which underlies the referred question of law, this concerns a situation where the earlier European patent application which was filed by an unlawful applicant is no longer pending before the EPO (because it has been withdrawn, deemed to be withdrawn, or refused) when the lawful applicant files a new application for a European patent pursuant to Article 61(1)(b) EPC. The earlier application may have ceased to be pending either before or after the lawful applicant commenced proceedings before a national court claiming his right to the grant of a European patent.

The referred question of law assumes that "it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent", and is concerned with the case where the earlier application was not pending before the EPO (because it had been deemed to be withdrawn) when the lawful applicant commenced the proceedings before a national court which led to the final decision.

In such a case, if Article 61 EPC is to be applicable, the question arises as to whether such final decision is a decision within the meaning of Article 61(1) EPC: in particular, is such final decision a decision which "has to be recognised on the basis of the Protocol on Recognition", having regard to the fact that the proceedings which led to the final decision were commenced at a time when there was no longer a pending application before the EPO?

4.1 Article 1(1) Protocol gives jurisdiction to such national courts to decide claims to the right to the grant of a European patent "against the applicant" in respect of a European patent application. In his comments in support of the Receiving Section's decision, the President has suggested that the words "against the applicant" in Article 1(1) Protocol should be interpreted as referring to an existing applicant, and therefore require the existence of a pending application, and that the Protocol on Recognition does not apply to a case where the unlawful applicant's earlier application is no longer pending.

4.2 In the Enlarged Board's view, the wording of Article 1(1) Protocol when read as a whole, does not exclude the jurisdiction of national courts in a case where the unlawful applicant's earlier application is no longer pending, but is apt to cover any case where an earlier European patent application has been filed by an unlawful applicant, whether or not such application is still pending.

4.3 In fact, if the jurisdiction of national courts was excluded under the Protocol on Recognition in cases where an unlawful applicant's earlier application was no longer pending, this would lead to a situation where such an unlawful applicant could himself control the exclusion from such jurisdiction of the lawful applicant's claim against him. By withdrawing his own application after its publication, an unlawful applicant could prevent the lawful applicant from obtaining European patent protection for his invention, and could thus ensure his own freedom to use the invention which he misappropriated. If the Protocol on Recognition were so interpreted, the legal system under the Protocol would effectively invite such manipulation by an unlawful applicant. In the Enlarged Board's view, such a legal situation would be unreasonable and unacceptable, and the condoning of such manipulation cannot have been intended under the Protocol on Recognition.

4.4 In a case where the unlawful applicant's earlier application has been published, and is no longer pending at the time when a claim to the right to the grant of a European patent is made to a national court, the establishment of the lawful applicant's right to the grant may potentially prejudice third parties who have commenced commercial activities involving the subject-matter of the earlier application on the assumption that such subject-matter is in the public domain and cannot therefore be the subject of a European patent. In general, the longer the interval between the time when the earlier application ceases to be pending and the time when the lawful applicant's right is established by a national court, the greater the possibility of such third party prejudice.

The extent to which a national court, when deciding upon a claim under Article 1(1) Protocol in a case where the earlier application is no longer pending, should take into account any delay by the lawful applicant in commencing and prosecuting proceedings to establish his right and the possibility of consequent third party prejudice, is a matter to be considered by national courts.

5. As mentioned in paragraph 3.4 above, Article 61 EPC enables a lawful applicant who has established his right to the grant of a European patent in a final decision of a national court to initiate proceedings before the EPO in his own name.

The provisions of Article 61 EPC must clearly be interpreted so as to be consistent with and to fulfil the objectives of the system of jurisdiction described in paragraphs 3 to 3.4 above, which gives the national courts of the Contracting States competence to decide disputes as to the right to the grant of a European patent. This system of jurisdiction, in combination with

the provisions of Article 61 EPC and the Rules which are intended to implement it, provides a co-ordinated legal process for granting the appropriate remedy, in a case where an unlawful applicant has applied for a European patent contrary to the legal rights of the inventor or his successors in title which are set out in Article 60(1) EPC. It would be contrary to such legal process if a lawful applicant who has established his right to the grant of a European patent in a final decision by the appropriate national court in accordance with the Protocol on Recognition, was thereafter excluded from using the centralised procedure of Article 61(1) EPC.

5.1 According to Article 61(1) EPC, the lawful applicant (being "a person referred to in Article 60(1) EPC other than the applicant") may, within the three-month time limit following such a final decision by the appropriate national court and "provided that the European patent has not yet been granted", with reference to the unlawful applicant's earlier application,

"(a) prosecute the application as his own application in place of the applicant,

(b) file a new European patent application in respect of the same invention, or

(c) request that the application be refused."

5.2 For the reasons which are set out below, the wording of Article 61 EPC does not on its proper interpretation exclude its application to cases where the unlawful applicant's earlier application is no longer pending when the lawful applicant files a new application pursuant to Article 61(1)(b) EPC.

5.3 For the same reason as set out in paragraph 4.2 above in connection with the Protocol on Recognition, the reference in Article 61(1) EPC to "the applicant" does not necessarily imply that, for Article 61 EPC to be applicable, there must be an existing applicant and therefore a pending application.

Furthermore, the phrase in Article 61(1) EPC "provided that the European patent has not yet been granted", which in fact constitutes a pre-condition for the applicability of Article 61 EPC, does not necessarily require that the application must still be pending. On the contrary, this phrase can fairly be interpreted as indicating that Article 61 EPC is only applicable in the case of a final decision which terminates a dispute concerning entitlement to a European patent application and is not applicable in the case of a dispute concerning entitlement to a granted European patent. This interpretation is confirmed by the contents of sub-paragraphs (a) to (c) of Article 61(1) EPC, which ensure that the EPO controls the stage before and including the making of a decision on the grant or refusal of the application, following appropriate action by the lawful applicant.

Thus there is nothing in the wording of Article 61(1) EPC, when read as a whole, which requires the existence of a pending application at the time when a lawful applicant takes action pursuant to Article 61(1)(b) EPC.

5.4 As to Article 61(2) EPC, this provides that when a lawful applicant files a new European patent application pursuant to Article 61(1)(b) EPC, Article 76(1)

EPC (which is concerned with European divisional applications) shall apply mutatis mutandis to the new application. That is, in particular, provided that the new application is filed "only in respect of subject-matter which does not extend beyond the content of the earlier application as filed", the new application "shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right of priority" of the earlier application by the unlawful applicant. It follows from this provision that, provided that the new application does not contain added subject-matter with respect to the earlier application, the content of the earlier application does not form part of the state of the art under Article 54(1) EPC with respect to the new application.

There is therefore nothing in Article 76(1) EPC which requires the existence of a pending application at the time when a lawful applicant files a new application pursuant to Article 61(1)(b) EPC.

5.5 It is to be noted that Article 61(2) EPC only refers to paragraph 1 of Article 76 EPC, so that this reference is of very limited scope.

In particular, Article 61(2) EPC does not refer to Article 76(2) EPC, which requires that a European divisional application "shall not designate Contracting States which were not designated in the earlier application".

There appears to be a good reason for this lack of reference to Article 76(2) EPC, in that a lawful applicant who files a new application pursuant to Article 61(1)(b) EPC may designate in his new application only those Contracting States designated in the (earlier) European patent application "in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to the Convention" (see Article 61(1) EPC). This is clearly a different consideration.

Furthermore, Article 61(2) EPC does not refer to Article 76(3) EPC, which concerns the procedure to be followed when filing a divisional application under Article 76(1) EPC, the special conditions applying to such a divisional application, and the time limit for paying the filing, search and designation fees on such a divisional application and which refers to the Implementing Regulations in this connection.

There appears to be a good reason for not finding a reference to Article 76(3) EPC in Article 61(2) EPC, in that Article 61(3) EPC itself contains equivalent provisions governing the procedure to be followed when a lawful applicant files a new application under Article 61(1)(b) EPC, and therefore makes it plain that the provisions of Article 76(3) EPC are not applicable to such a new application under Article 61(1)(b) EPC.

5.6 Article 61(3) EPC also refers to the Implementing Regulations as containing the procedure to be followed, the special conditions which are applicable, and the time limit for paying the relevant fees, in respect of a new application which is filed pursuant to Article 61(1)(b) EPC.

The Implementing Regulations to Part II of the EPC, which contains Articles 52 to 74 EPC, are found in

Rules 13 to 23 EPC; and the Implementing Regulations to Part III of the EPC, which contains Articles 75 to 89 EPC, are set out in Rules 24 to 38 EPC. It follows that the Implementing Regulations for Articles 60 to 61 EPC are found in Rules 13 to 16 EPC (in particular the Implementing Regulations for Article 61 EPC are found in Rules 15 and 16 EPC), whereas the Implementing Regulations for Article 76 EPC are found only in Rule 25 EPC. In particular, Rule 25 EPC is not an Implementing Regulation for Article 61(3) EPC.

The current version of Rule 25 EPC states that "the applicant may file a divisional application on the pending earlier European patent application". This means that the existence of a pending application is a special condition to be complied with when an applicant files a European divisional application. It does not mean that the existence of a pending earlier application (by the unlawful applicant) is a pre-condition for the filing of a new application pursuant to Article 61(1)(b) EPC.

It is to be noted that Rule 15(1) EPC states that if the earlier application (by the unlawful applicant) is still pending at the time when a new application (by the lawful applicant) is filed pursuant to Article 61(1)(b) EPC, such earlier application "shall be deemed to be withdrawn on the date of filing of the new application". This provision would of course be entirely inappropriate with respect to the parent application of a divisional application, and this reinforces the above conclusion that the Implementing Regulations for Article 61 EPC are in Rules 15 and 16 EPC (and not in Rule 25 EPC), whereas the Implementing Regulations for Article 76 EPC are found in Rule 25 EPC.

5.7 Rules 13 and 14 EPC are Implementing Regulations in respect of Article 60 EPC. They presuppose that the earlier application (by the unlawful applicant) is pending at the time when the person claiming to be the lawful applicant commences proceedings before a national court of a Contracting State, claiming his entitlement to grant, and they are intended to be applicable in that factual situation.

However, in the Enlarged Board's view, this does not mean that the existence of a pending earlier application is essential, either at the time when the lawful applicant commences proceedings before a national court, or at the time when the lawful applicant files a new application pursuant to Article 61(1)(b) EPC. Rules 13 and 14 EPC, like all Implementing Regulations, are subsidiary to the Articles of the EPC in the sense of Article 164(2) EPC. They are applicable in cases where the earlier application is pending when the lawful applicant commences proceedings before a national court, and they are not applicable or relevant to cases where the earlier application is no longer pending at the time when proceedings before a national court are commenced. That is the full effect of Rules 13 and 14 EPC. Rule 15(1) EPC presupposes that the earlier European patent application is still pending at the time when the lawful applicant files a new application pursuant to Article 61(1)(b) EPC, and is therefore similarly inapplicable and irrelevant in a case where there is no pending application in existence at that point in time.

Rule 15(2) and (3) EPC is clearly applicable, however, whether or not there is a pending application in existence at that point in time, as is Rule 16 EPC.

In the Enlarged Board's view, therefore, the wording of Rules 13 to 16 EPC does not lead to the conclusion that Article 61(1)(b) EPC is inapplicable unless the earlier application (by the unlawful applicant) is still pending at the time when the new application is filed.

5.8 In the Enlarged Board's judgment, having regard to what is set out in paragraphs 5.3 to 5.7 above and also to what is said in paragraph 5 above, the proper interpretation of Article 61 EPC is that, in cases where the earlier application (by the unlawful applicant) is no longer pending at the time when a final decision in favour of the entitlement of the person claiming to be the lawful applicant is issued by a national court, although clearly Article 61(1)(a) and (c) is obviously not applicable, nevertheless Article 61(1)(b) EPC is applicable, and this allows the lawful applicant to file and prosecute a new application before the EPO in respect of his invention.

6. In a case where an unlawful applicant's earlier application has been published and thereafter ceases to be pending, as discussed in paragraph 4.4 above, it is possible that a third party may commence commercial activities involving the subject-matter of such earlier application, on the assumption that such subject-matter is in the public domain and cannot thereafter be protected by a European patent. The subsequent filing of a new application under Article 61(1)(b) EPC (with an effective filing date of the date of filing of the earlier application), could then potentially prejudice the activities of such third party. However, if following grant of a European patent the lawful applicant commenced infringement proceedings against such a third party, a national court concerned with such infringement proceedings would be able to take account of the special circumstances surrounding the alleged infringing activities when deciding on the case.

7. It should be added that the remedy provided by Article 61 EPC to a lawful applicant whose invention has been taken in breach of confidence and made the subject of a European patent application by an unlawful applicant is legally quite distinct from the protection provided under Article 55(1)(a) EPC to a lawful applicant whose invention has been disclosed in breach of confidence. Article 55(1)(a) EPC provides that a disclosure due to or in consequence of an evident abuse in relation to the applicant or his legal predecessor shall not be taken into consideration as part of the state of the art at the filing date of a European patent application by the lawful applicant for the application of Article 54 EPC, provided that such disclosure occurred no earlier than six months preceding the filing of the European patent application by the lawful applicant. Thus the protection provided to a lawful applicant under Article 55 EPC following a disclosure resulting from an evident abuse only extends for a period of six months following such a disclosure, whereas the protection provided to a lawful applicant under Article 61 EPC is not governed by any such specified time limit

(whether or not the earlier European patent application by the unlawful applicant remains pending). Nevertheless, as discussed in paragraphs 4.4 and 6 above, the system provided by Article 61 EPC and the Protocol on Recognition enables the effect of the passage of time upon the lawful applicant's legal rights to be taken into account in an appropriate manner, in cases where the earlier European patent application filed by the unlawful applicant ceases to be pending before the EPO.

8.1 A minority of the members of the Enlarged Board have taken a different view, arguing as follows:

Article 1 EPC establishes a system of law common to the Contracting States, for regulating the grant of patents for invention. To this end it is the task of the EPO to examine patent applications to ascertain whether patents can be granted on them (see Articles 18 and 94 EPC). Examination presupposes a validly pending application. If a patent application has not, or not yet, been filed, a patent cannot be granted. Nor can a patent be granted on an application which, though filed, has since irrevocably lapsed.

The EPC makes no provision for claiming the filing date of a lapsed application, nor for claiming its priority date after expiry of the priority year. If the intention had been to make an exception to this principle, a corresponding provision would have been necessary in Article 61(1)(b) EPC to provide for such a new application. There is none, so the general principle that it is not possible to claim either the filing date of an earlier application which has lapsed before the date of filing of the new application or its priority date after the expiry of the priority year applies also to any new application under Article 61(1)(b) EPC. It follows that under Article 61(1)(b) EPC, the earlier application must still be pending at the time of filing the new application if the applicant filing the new application wishes to claim for his own application the filing date or, after expiry of the priority year, the priority date of the earlier application.

8.2 If a person who has been adjudged entitled to the grant of a European patent under Article 61(1)(b) EPC files a European patent application and if the earlier application of the unlawful applicant is still pending, according to Article 61(2) in conjunction with Article 76(1) EPC the application of the injured party is deemed to have been filed on the date of filing of the earlier application and have the benefit of any right to priority.

If on the other hand the injured party files an application under Article 61(1)(b) EPC and the earlier application of the unlawful applicant is no longer pending at the time of filing the new application, the injured party can no longer claim the filing date and priority date of the earlier application, which has already irrevocably lapsed. This can be deduced from Article 61(2) EPC, which states that the provisions of Article 76(1) EPC shall apply *mutatis mutandis* to new applications filed under Article 61(1)(b) EPC. This means that the provisions of Article 76(1) EPC relating to divisional applications are thus applicable also to new applications under Article 61(1)(b) EPC.

Divisional applications may however only be filed if the parent application is still pending. While this is not expressly stated in Article 76(1) EPC, it follows necessarily from the term divisional application, because only something in existence (i.e. the parent application) can be divided. Conceptually, the filing of a divisional application requires that the parent application be pending. This is further a generally recognised principle for the division of patent applications, as can be seen from, for example, Article 4 G of the Paris Convention. This principle is reiterated in Rule 25(1) EPC, which allows the applicant the right within a certain time limit to "file a divisional application on the pending earlier European patent application". As a result of the reference in Article 61(2) to Article 76(1) EPC, it is a prerequisite for a new application under Article 61(1)(b) EPC that the earlier application should still be pending. As in the case of a divisional application, a new application can only validly be filed if the earlier application is still pending.

8.3 The requirement under Article 61(2) in conjunction with Article 76(1) EPC that the earlier application must still be pending at the time of filing the new application is confirmed by Article 61(1) EPC.

According to Article 61(1)(b) EPC, a person adjudged by a final decision to be entitled to the grant of a European patent may file a new European patent application in respect of the same invention within a period of three months "provided that the European patent has not yet been granted".

This provision firstly makes it clear that Article 61(1) EPC cannot be applied if the European patent has already been granted. The emphasis on the fact that the European patent should "not yet" have been granted further makes it clear that the procedure should still be in the pending application stage. Consequently, it must still be possible as a matter of procedural law for a patent to be granted. If procedurally the grant of a patent is not possible, whether because no application was filed in the first place or because the application has since lapsed, the legal requirement laid down in Article 61(1) EPC, namely that the European patent should "not yet" have been granted, is not met. In the case of an application which, for whatever reason, has lapsed, it is not possible to say that the patent has "not yet" been granted. The word "yet" in Article 61(1) EPC logically presupposes that it should still be possible for the patent to be granted. This requirement is however only met if the European patent application in respect of which the European patent has not yet been granted is still pending.

It thus follows from both Article 61(2) in conjunction with Article 76(1) EPC and from Article 61(1) EPC that a new European patent application under Article 61(1)(b) EPC can only be filed if the earlier application is still pending.

8.4 The provision of Article 61 EPC, as drafted by the legislator, represents a well-balanced and fair resolution of conflicting interests. A reasonable compromise had to be found between on the one hand the interests of the true owner of an invention filed by an unlawful

applicant and, on the other, the interests of the public, who should be able safely to assume that lapsed European applications cannot subsequently be resurrected by the EPO without limit of time. The resolution of this problem of conflicting interests as provided by Article 61(1) EPC gives the lawfully entitled applicant the right to prosecute someone else's existing application in his own name, be it by simple substitution of the applicant in accordance with Article 61(1)(a) EPC or be it by formulating in his own words a new European patent application in respect of the same invention in accordance with Article 61(1)(b) EPC. These legal provisions give the person lawfully entitled to file the application a limited right to prosecute someone else's application while at the same time safeguarding the interests of the public in that they prevent the public from being taken by surprise by the grant of a patent on an application which has long since lapsed irrevocably.

8.5 The provisions of Chapter I of Part II of the Implementing Regulations, which govern the procedure to be followed in the event of the applicant or proprietor lacking due title, all presuppose that the earlier application by the unlawful applicant is still pending at the date of filing the new application under Article 61(1)(b) EPC.

This is of particular significance because the provisions in the Implementing Regulations originate from the same source - the Munich Diplomatic Conference - as Article 61 EPC, thus making them highly authoritative for the interpretation of Article 61 EPC.

Thus under Rule 13 EPC the EPO will stay proceedings for grant involving an applicant, if a third party provides proof to the EPO that he has opened proceedings against this applicant. If a decision which has become final has been given, the EPO communicates to the unlawful applicant that the proceedings for grant will be resumed from a specified date unless a new European patent application under Article 61(1)(b) EPC has been filed. In this case the earlier, still pending application filed by the unlawful applicant is deemed to be withdrawn pursuant to Rule 15(1) EPC.

Further, the Munich Diplomatic Conference made provision to prevent an unlawful applicant prejudicing the rights of the true applicant by withdrawing the European patent application. Rule 14 EPC expressly provides that, under the preconditions stated therein, an applicant can withdraw neither the European patent application nor the designation of any Contracting State.

All the provisions of the Implementing Regulations contained in Rules 14 to 16 EPC for implementing Article 61 EPC thus confirm that for Article 61(1) and (2) EPC it is a prerequisite for the valid filing of a new application under Article 61(1)(b) EPC that the earlier application filed by the unlawful applicant should still be pending. The Munich Diplomatic Conference regulated the implementation of hardly any other article in the Implementing Regulations in the same detail as it did in Article 61 EPC. Taken in conjunction with Rules 13 to 16 EPC, Article 61 EPC provides a self-contained, logically consistent system which exhaustively covers all aspects of procedure in cases where

the applicant lacks due title. The provisions taken as a whole clearly show that it is a precondition for the filing of a new application under Article 61(1)(b) EPC that the earlier application should still be pending.

8.6 The preparatory documents for the European Patent Convention also make sufficiently clear that for Article 61(1)(b) EPC to be applied, the earlier application must be pending.

At its 10th meeting in Luxembourg from 22 to 26 November 1971 (document BP/144/71 dated 16 December 1971), the Intergovernmental Conference for the setting up of a European system for the grant of patents discussed four models for regulating the right to the grant of a European patent. Following in-depth discussions, the solution now embodied in Article 61(1)(b) EPC was chosen. This solution is defined in the above document as follows: if there is a final decision in favour of a person, he can submit a new application and claim the date of filing and the priority date of the earlier application. As from the date of filing the new application the earlier application is deemed to be withdrawn for all the designated Contracting States in respect of which the decision was taken or by which it is recognised. For the remaining States the previous application could be maintained and continued to grant by the initial applicant (cf. No. 41, BP/144/71). It is emphasised that the person truly entitled could file a new application in place of the original application. If no new subject-matter were included, the new application would then receive the same filing date and priority date as the original application. At the same time the original application would be deemed withdrawn for the designated States in respect of which the decision was taken or recognised (see No. 47 of BP/144/71).

8.7 If it were permissible for a new application to claim the filing date and priority date of an application which has long since lapsed, this would unacceptably prejudice third parties.

For instance, if it were permissible, the new application could be validly filed well beyond the date on which the earlier application had lapsed. Third parties using the subject-matter of the application in the period between the lapse of the earlier application and the filing of the new application would retrospectively become infringers. Such third parties would have no defence because, unlike Article 122(6) EPC, Article 61 EPC does not grant such third parties a continued right freely to use the invention. The lack of such provision is explained by the fact that it is not required, because in drawing up the Convention it was presupposed that there would be a transition from the earlier application to the new application without any gap in between. Indeed, the possibility of a new application being filed in respect of an earlier application which is no longer pending was not even envisaged.

If the legislator had considered this to be permissible, it would surely have safeguarded any third parties whose rights are affected by the subsequent revival of the lapsed application, because such third parties using an invention after the lapse of an earlier application had the right to rely on no patent being granted for the in-

vention concerned. From the date of publication by registration in accordance with Rule 92(1)(n) EPC of the date on which the European patent application is refused, withdrawn or deemed to be withdrawn, any third party may use the invention of a previously pending patent application without having to fear being enjoined from use or sued for damages. The public is entitled to rely on the legally required entries made by the EPO in the Register of Patents.

The only case in which a lapsed application may later be revived is provided for in Article 122 EPC, which allows for re-establishment of rights where rights have been lost due to non-observance of a time limit. However, this is not only subject to stringent conditions, in particular the requirement that all due care required by the circumstances has been taken, but is also narrowly restricted by the time limits for filing the request. Furthermore, third parties commencing use of an invention in the period between the lapse of the application and the registration of the date of re-establishment of rights in the Register of European Patents pursuant to Rule 92(1)(u) EPC are protected by a legal right to continued use, which means that their reliance on the registration of the lapse of an application in the Register of Patents is not dishonoured.

A similar provision safeguarding third parties would be required in Article 61 EPC if it were permissible to file a new application under Article 61(1)(b) EPC regardless of whether the earlier application was still pending or not. In particular, a continued right of use would have to be provided to protect third parties, and provision be made to inform the public, for the entry in the Register of Patents of the date on which the lapsed earlier application was revived as a result of the filing of a new application.

However, the case law is not authorised to make such a serious change to the EPC and its Implementing Regulations which exceeds the scope of a judicial decision, as it is equivalent to a revision of the rules governing the filing of European patent applications by persons lacking due title, which revision is under Article 172 EPC the prerogative of the Conference of the Contracting States.

The assumption that it is permissible to file a new application under Article 61(1)(b) EPC when the earlier application has irrevocably lapsed would prejudice the legitimate interests of third parties, which in the interests of legal certainty is not acceptable.

The disadvantageous consequences to such third parties cannot be eliminated in the Contracting States in the case of possible infringement cases between the proprietor of a patent granted in respect of a new application and a third party which used the invention between the lapse of the earlier application and the filing of the new application. The national law in many of the Contracting States recognises a right to continued use, but it takes such different forms in the individual countries that attempts to standardise it in Europe have so far remained unsuccessful. This is the reason why, despite many years of endeavour, it has still not been possible to resolve the problem of a right to continued

use derived from a prior use or prior possession of the knowledge of the invention for the Community Patent Convention.

Even disregarding the very different approaches found in the Contracting States, a right to continued use is still not capable of producing a solution of the problem of the protection of third parties. Under the national law of most of the Contracting States, use by the third party must have begun prior to the filing date or priority date. However, the filing date or priority date of a new application under Article 61(1)(b) EPC is, according to Article 61(2) in conjunction with Article 76(1) EPC, the filing date or priority date of the earlier application. If the use started after this date, that is after publication of the lapse of the earlier application in the European Patent Bulletin, third parties cannot invoke a national right of right to continued use with respect to the European patent precisely because this right relates to prior use and not use between the date of lapse and revival.

8.8 Moreover, it cannot be inferred from the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the grant of a European Patent that it is possible to file a new application under Article 61(1)(b) EPC if the earlier application is no longer pending at the time of filing the new application. The Protocol merely regulates the jurisdiction of the courts for legal proceedings against applicants to determine the right to the grant of a European patent, and the recognition of a final decision issued in one Contracting State in the other Contracting States. The question referred to the Enlarged Board of Appeal is not concerned with these matters. The Board which referred the question had already decided that the Comptroller had jurisdiction to issue a decision concerning the right to the grant of a European patent, and there is no doubt that this decision will be recognised in the other designated Contracting States, which is why these questions were not referred to the Enlarged Board for decision. The Protocol permits no conclusions to be drawn with respect to the question referred to the Enlarged Board of Appeal as the Protocol contains no provisions regulating this.

8.9 For these reasons it is held that under Article 61(1)(b) EPC a new European patent application in respect of the same invention filed by an unlawful applicant in an earlier application and claiming its filing date and priority date could only be filed if the earlier application is still pending at the time of filing the new application.

9. The majority of the members of the Enlarged Board of Appeal having carefully considered the views presented by the minority, maintains its position in accordance with paragraphs 1 to 7 above.

ORDER

For these reasons it is decided that:

When it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Article 61(1) EPC, files a new European patent application in respect of the same invention under Article

61(1)(b) EPC, it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.
