

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 24 November 2021**

Case Number: T 0318/14 - 3.3.01

Application Number: 10718590.2

Publication Number: 2429542

IPC: A61K35/74, A23L1/30, A61P37/08,
A61P1/12

Language of the proceedings: EN

Title of invention:

PREVENTION AND TREATMENT OF ALLERGIC DIARRHOEA

Applicant:

Société des Produits Nestlé S.A.

Headword:

Double patenting

Relevant legal provisions:

EPC Art. 97(2), 125

Keyword:

Double patenting (yes)

Decisions cited:

G 0001/05, G 0001/06, G 0004/19

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0318/14 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 24 November 2021

Appellant: Société des Produits Nestlé S.A.
(Applicant) Entre-deux-Villes
1800 Vevey (CH)

Representative: Elleby, Gudrun
Société des Produits Nestlé S.A.
Avenue Nestlé 55
1800 Vevey (CH)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 26 September
2013 refusing European patent application No.
10718590.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman A. Lindner
Members: T. Sommerfeld
L. Bühler

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 10718590.2, which is based on an international application published as WO 2010/130661, under Article 97(2) EPC "in conjunction with Article 125 EPC".
- II. The examining division found that claim 1 of the sole claim request on file was directed to subject-matter which was "100% identical" to the subject-matter claimed in European patent No. 2 251 021, which was granted on the basis of European patent application No. 09159932.4, the priority document of the present application. This was held to be contrary to the principle of the prohibition on double patenting referred to in decisions G 1/05 and G 1/06.
- III. The applicant (hereinafter the appellant) lodged an appeal against this decision, requesting that the decision be set aside and that a patent be granted according to the main request filed with the statement of grounds of appeal (which is identical to the claims refused by the examining division). It also requested reimbursement of the appeal fee pursuant to Rule 103 EPC and, as an auxiliary request, the referral of a question to the Enlarged Board of Appeal.
- IV. By interlocutory decision dated 7 February 2019, questions on the prohibition on double patenting were referred to the Enlarged Board of Appeal.
- V. By decision G 4/19 dated 22 June 2021, the Enlarged Board of Appeal answered the questions as follows:

- "1. A European patent application can be refused under Articles 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC.
- 2.1 The application can be refused on that legal basis, irrespective of whether it
- a) was filed on the same date as, or
 - b) is an earlier application or a divisional application (Article 76(1) EPC) in respect of, or
 - c) claims the same priority (Article 88 EPC) as the European patent application leading to the European patent already granted.
- ..."

VI. In a communication under Rule 100(2) EPC, the board informed the appellant of its preliminary opinion that, in light of the answers given by the Enlarged Board of Appeal, the appeal was likely to be dismissed.

VII. In reply to the board's communication, the appellant asked for a decision on the state of the file.

Reasons for the Decision

1. A refusal based on the prohibition on double patenting presupposes that the applicant of a European patent application has already been granted an identical European patent (decisions G 1/05 and G 1/06, OJ EPO 2008, 271 and 307, point 13.4); in its decision G 4/19 the Enlarged Board of Appeal did not address the requirements relating to the "same applicant" and the "same application" since this issue was not considered

to be covered by the referral, see G 4/19, points 7 and 16).

2. The subject-matter of the claims currently on file and on which the examining division based its refusal of European patent application No 10718590.2 (i.e. claims 1 to 9 of the main request re-submitted with the statement of grounds of appeal) is identical to the subject-matter of the claims of European patent No. 2251021, which was granted on the basis of European patent application No. 09159932.4, the priority document of the present application. Moreover, no request for limitation or revocation (Article 105a EPC) is pending in respect of European patent No. 2251021. The requirement of identical subject-matter is therefore fulfilled.
3. The patentee of European patent No. 2251021 was Nestec S.A. The same company filed European patent application No. 10718590.2 under consideration in the present appeal. Nestec S.A. merged with Société des Produits Nestlé S.A. with effect from 27 May 2019. As a result of the merger, Nestec S.A. ceased to exist and was removed from the companies register. By way of universal succession, Société des Produits Nestlé S.A. became the proprietor of European patent No. 2251021 and of the contested European patent application No. 10718590.2. Thus, the requirement of "same applicant" is fulfilled.
4. In the light of decision G 4/19 (point 2.1c) of the Order) and the observations above, the examining division's refusal of European patent application No. 10718590.2 under Articles 97(2) and 125 EPC was justified. The appeal is therefore to be dismissed and the request for reimbursement of the appeal fee under

Rule 103(1) (a) EPC on the grounds of a contravention of the rule of law (see the statement of grounds of appeal, page 10, point 4) is to be refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated