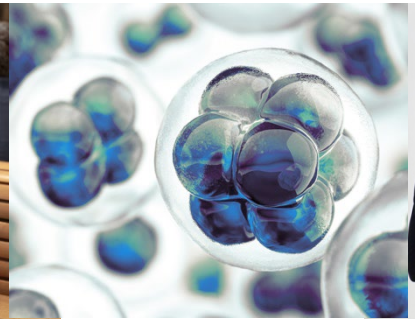
Europäisches Patentamt
European Patent Office
Office européen des brevets

Examination Matters 2021

Double patenting


Jürgen Scheuer
Gershom Sleightholme

Examiner
Senior expert

6-10 December 2021

Presenter

Jürgen Scheuer

- At the European Patent Office since 2000, chairing numerous opposition and examination proceedings in various technical fields
- Project manager for Faurecia SA from 1995 to 2000 in Audincourt and Ingolstadt
- Degree in Mechanical Engineering from RWTH Aachen (DE)

Presenter

Gershom Sleightholme

- At the European Patent Office since 1996, currently working in the field of diagnosis and vehicle technology
- Several years in the steel and automotive industries and in the British civil service
- Degree in Mechanical Engineering from the University of Melbourne; doctorate from the University of Cambridge

Contents

Double patenting

- Principle:
  No patent
  for the **S**ame invention
  having the **S**ame date
  by the **S**ame applicant
  with the **S**ame Patent office

- Purpose:
  To avoid unnecessary duplication of effort
  (See T0936/04, Catchword 1, 2.3).

Double protection – national patent vs. European patent

- National and European Patent for the same invention by the same applicant (Article 139(3) EPC)
- Example: DE of the same applicant granted although an EP exists (DE designated) for the same invention and the same priority date.
- DE national law does not explicitly forbid double patenting but explicitly forbids double protection § 34 PatG (Art. II § 8 IntPatÜbkG).
- Double protection forbidden in most (27) EPC contracting states.
- AT, DK, FI, HU and SE do not forbid double protection.

Double protection – national patent vs. EP with unitary effect

§ 26 EU Regulation 1257/2012

- "... **either** a national patent, a European patent with unitary effect, a European patent ... **or** a European patent with unitary effect in one or more other contracting states to the EPC which are not among the participating member states"
- Coexistence of national patent with EP with unitary effect?
- Case law will decide?

Contents

G4/19 – the questions (1/3)

"1. Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent which was granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC?"

G4/19 – the questions (2/3)

"2.1 If the answer to the first question is yes, what are the conditions for such a refusal, and are different conditions to be applied depending on whether the European patent application under examination was filed a) on the same date as, or b) as a European divisional application (Article 76(1) EPC) in respect of, or c) claiming the priority (Article 88 EPC) in respect of a European patent application on the basis of which a European patent was granted to the same applicant?"

G4/19 – the questions (3/3)

"2.2 In particular, in the last of these cases, does an applicant have a legitimate interest in the grant of a patent on the (subsequent) European patent application in view of the fact that the filing date and not the priority date is the relevant date for calculating the term of the European patent under Article 63(1) EPC?"

Contents

- Definition: double patenting vs. double protection
- G4/19 – the questions
- Legal basis (EP and national)
- German practice
- How can double patenting happen?
- Case law
- G4/19 – the answers
- Current EPO practice
- Conclusions

Double patenting Legal Basis EPC

- "Double patenting" is not mentioned *expressis verbis* in the EPC (unlike the Guidelines) thus not an explicit requirement to be met (Art. 97 EPC, Art. 101 (3) EPC).

- However
  - Art. 60 EPC Right to a European patent:
    (1) The right to a European patent shall belong to the inventor or his successor in title. ...
  - Art. 125 EPC Reference to general principles:
    In the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States.

Art. 125 EPC General Principles

- Protection of legitimate expectation
- Fair procedure (equal treatment-impartiality)
- Legal certainty
- Proportionality
- Procedural economy
- Good faith
- ...

- Legitimate interest to take legal action

Legitimate interest to take legal action (Rechtsschutzinteresse)

- General procedural principle of administrative law (not patent law).
- Objective: No one should seek needlessly for a legal act to be carried out by a public service or a court (cost, waste of resources).
- Principle is applied:
  - Rule 84 (1) EPC
  - Art. 105 / Rule 89(1) EPC, cf. T1713/11(intervention)
  - Art. 125 EPC G-IV 5.4 (double patenting)

Legitimate interest to take legal action – Examples

No legitimate interest:

- Opposition rejected (Patent maintained), Patent Proprietor has no legitimate interest in appeal proceedings.
- One party filing two oppositions (T9/00).

Legitimate interest:

- Example: Patent is revoked in opposition, adverse effect for the Patent Proprietor, Patent Proprietor has a legitimate interest in appeal proceedings.

Double patenting (National Law I)

- **IE Patents Act 1992, Section 31(5):**
  "Where two or more patent applications for the same invention having the same date of filing or the same date of priority are filed by the same applicant or his successor in title, the Controller may on that ground refuse to grant a patent in respect of more than one of the applications."

- **UK Patents Act 1977, Section 18(5):**
  Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

- **DE:**
  (§ 34 PatG - Art. II § 8 IntPatÜbkG double protection)

Double patenting (National Law II)

- **Title 35 (Patents) U.S. Code § 101 Inventions Patentable**
  Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- **Title 35 (Patents) U.S. Code § 121 Divisional Applications**
  If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor.

Interpretation of the EPC: Vienna Convention

Vienna Convention on the Law of Treaties

applicable to the EPC according to G1/83, G5/83.

- establishes Law of treaties
  - Art. 5 – The Vienna convention applies to any treaty which is a constitutional instrument of an international organization and to any treaty adopted within an international organization without prejudice to any relevant rules of the organization
- Section 3 Interpretation of treaties
  - Art. 31 General rule of interpretation
  - Art. 32 Supplementary means of interpretation

Art. 31 General rule of interpretation (principle)

- Good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.
- Any agreement relating to the treaty which was made between all the parties in connexion with the conclusion of the treaty; any instrument which was made by one or more parties in connexion with the conclusion of the treaty and accepted by the other parties as an instrument related to the treaty.
- Any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation;
- Any relevant rules of international law applicable in the relations between the parties.
- A special meaning shall be given to a term if it is established that the parties so intended.

Art. 32 Supplementary means of interpretation

"Recourse may be had to supplementary means of interpretation, including the **preparatory work of the treaty and the circumstances of its conclusion**, in order to

- confirm the meaning resulting from the application of article 31,
- or to determine the meaning when the interpretation according to article 31 :
  (a) Leaves the meaning ambiguous or obscure; or
  (b) Leads to a result which is manifestly absurd or unreasonable."

Travaux préparatoires

Munich diplomatic conference, 17.09.1973, Document M/PR/I, page 62, point 665, PDF page 5, see http://webserv.epo.org/projects/babylon/tpepc73.nsf/0/ED6B3BE8DD340281C1257427004818ED/$File/Art125eTPEPC1973.pdf:

"In connection with Article 125, it was established at the request of the United Kingdom delegation that there was majority agreement in the Main Committee on the following:
that it was a generally recognised principle of procedural law in the Contracting States that a person can be granted only one European patent for the same invention in respect of which there are several applications with the same date of filing."

Contents

- Definition: double patenting vs. double protection
- G4/19 – the questions
- Legal basis (EP and national)
- German practice
- How can double patenting happen?
- Case law
- G4/19 – the answers
- Current EPO practice
- Conclusions

German practice (1/5)

Federal Court of Justice (Bundesgerichtshof)

- X ZB 36/98 (28.03.2000) "Graustufenbild" (See II 2(c), page 9)
  - The scope of protection of the second (divided-out) patent can be broader than that of the parent.
  - Having an identical scope of protection for divisional and parent is out of the question (*ausgeschlossen*) because there is no recognisable interest worthy of protection (*schutzwürdiges Interesse*).
  - Identical scope can only be determined at the end of the examination phase.

German practice (2/5)

Federal Court of Justice (Bundesgerichtshof)

- X ZR 28/06 (22.12.2009) "Hubgliedertor II" (See V, pages 39, 40)
  - The patents are not identical because the characteristics of claim 1 of the parallel patents are not the same.
  - Therefore there can be no question of double patenting.
- For further decisions of the Federal Court of Justice, see X ZB 18/01 (30.09.2002) and X ZR 89/07 (16.12.2008).

German practice (3/5)

Federal Patent Court (Bundespatentgericht)

- 23W (pat) 703/03 (07.08.2003)
  - Double patenting – duplicating the right of protection – are fundamentally to be avoided (see III, 1).
  - Depends on claims to be granted, not as filed in the divisional.
  - Double patenting is not a grounds for revocation (PatG § 21 Abs 1) (in opposition).
  - The patent office has an obligation to avoid double patenting by considering the claims of the first granted patent.
  - See also similar reasoning in 10 W (pat) 47/01 (II, 2(b)).

German practice (4/5)

Federal Patent Court (Bundespatentgericht)

- 3 Ni 8/11 connected to 3 Ni 9/11 (02.12.2012)
  - The patents are not identical because the wording of claim 1 of the parallel patents is not the same, nor is the description the same, which is to be used to determine to scope of the claims (see III, 1).
  - The question of legitimate interest does not need to be considered for non-identical subject-matter.

German practice (5/5)

Federal Patent Court (Bundespatentgericht)

- 5 Ni 19/12 (03.07.2013)
  - A party had argued that an internal EP priority claim is invalid for another EP application because it would lead to double patenting; Art. 54(3) EPC was intended to avoid double patenting.
  - This argument was considered not convincing.

- For further decisions of the Federal Patent Court, see 17 W (pat) 31/00 (10.05.2001); 23 W (pat) 2/01 (13.02.2003); 23 W (pat) 9/02 (15.07.2004); 23 W (pat) 25/02 (21.10.2003); 10 W (pat) 27/02; 23 W (pat) 3/03; 20 W (pat) 46/04; 17 W (pat) 43/06; 2 Ni 21/05 (25.01.2007); 17 W (pat) 20/08; 12 W (pat) 24/10 (05.12.2013); 18 W (pat) 17/14 (24.01.2014)

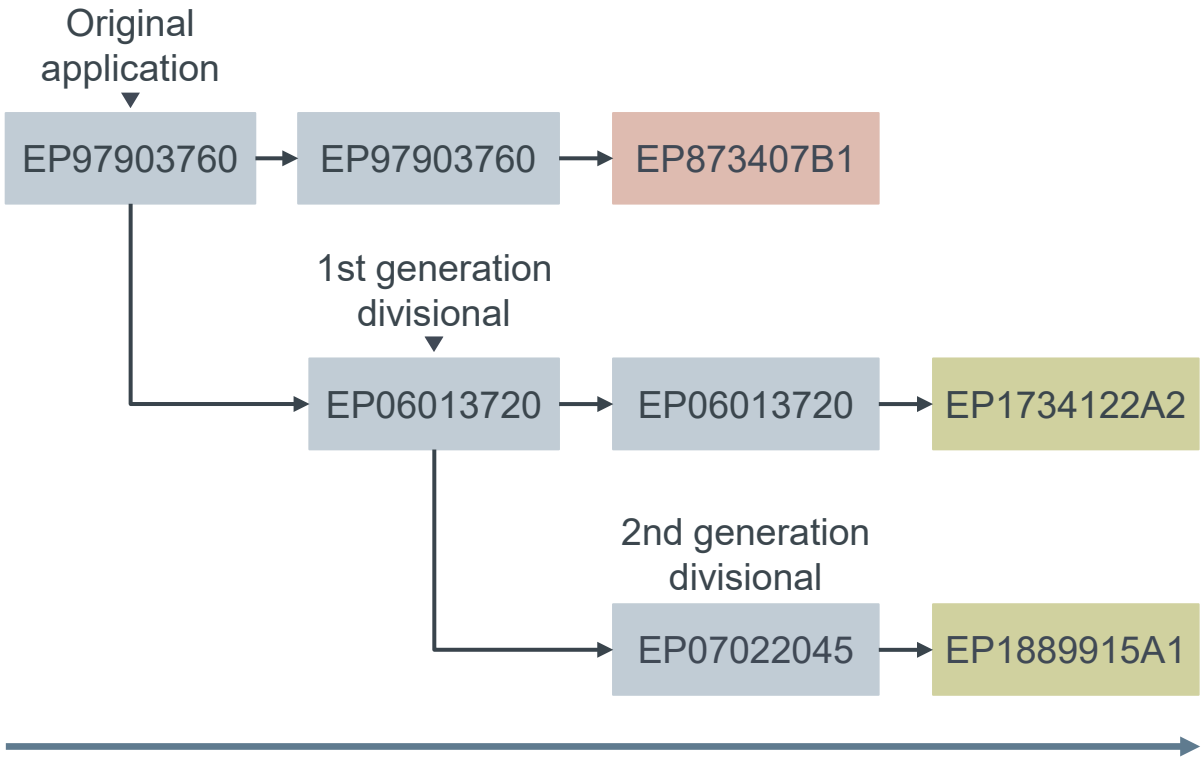
Contents

- Definition: double patenting vs. double protection
- G4/19 – the questions
- Legal basis (EP and national)
- German practice
- How can double patenting happen?
- Case law
- G4/19 – the answers
- Current EPO practice
- Conclusions

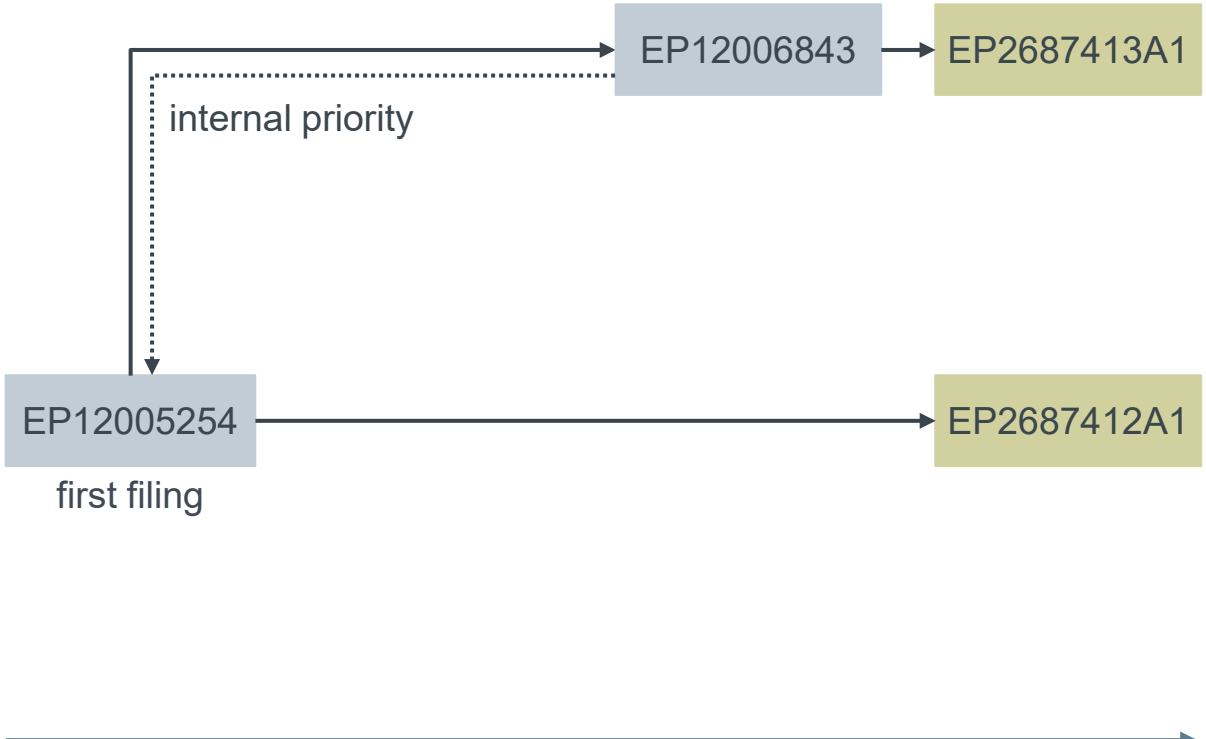
How can double patenting happen?

- Divisional applications Article 76 EPC
- Internal priority
- Similar applications filed on the same day by the same applicant

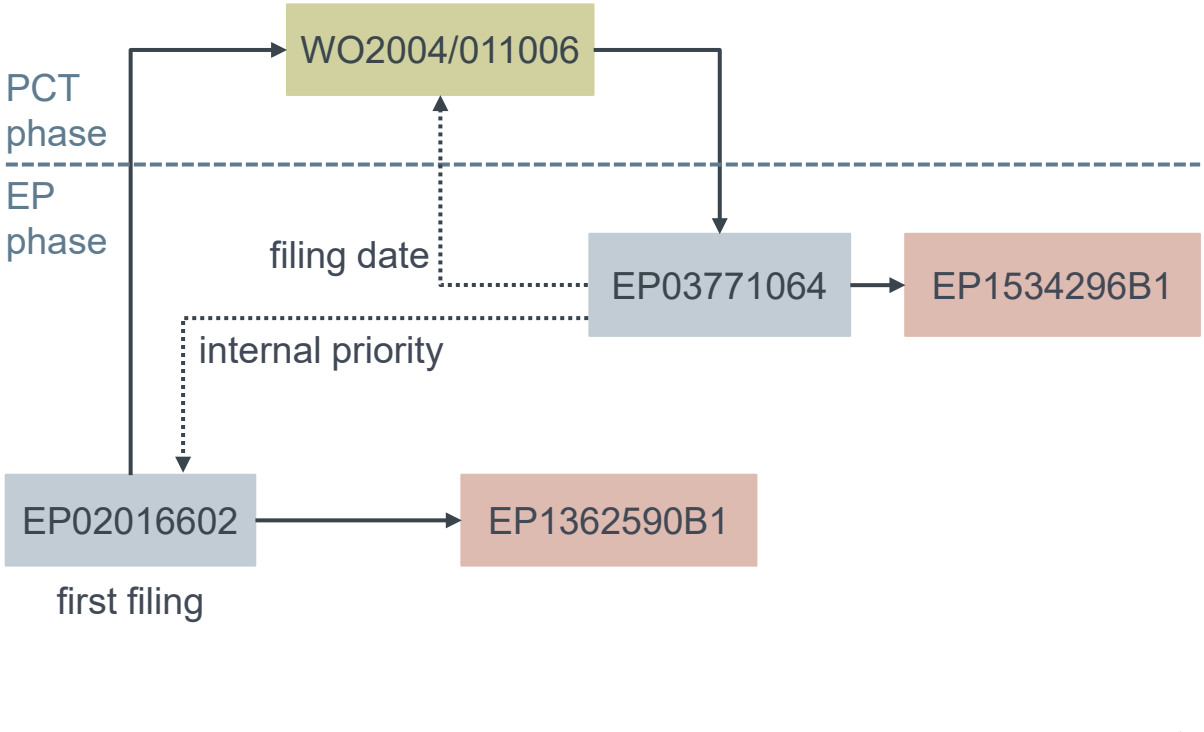
Divisional application (T0879/12)



Internal priority type 1



Internal priority type 2 (T1423/07)



Contents

- Definition: double patenting vs. double protection
- G4/19 – the questions
- Legal basis (EP and national)
- German practice
- How can double patenting happen?
- Case law
- G4/19 – the answers
- Current EPO practice
- Conclusions

Case law – two early cases

- T372/88 (08.12.1988)
- Subject-matter overlapping, but not identical, therefore no double patenting.
- No articles referred to, only EPO Guidelines.
- T587/98 (12.05.1998)
- Only appears to have compared independent claims in parent (A+B) and divisional (A implicitly with or without B): overlapping, not identical.
- EPC is self-contained and complete regarding divisional applications; double patenting would be a matter of 'substantive law' but A.125 is limited to 'procedural provisions'

Case law – a landmark

- G1/05 and G1/06 (28.06.2007), referred to in Guidelines
  - These related decisions did not relate to double patenting explicitly, but to filing of and amendments to divisional applications.
  - Nevertheless the Enlarged Board of Appeal stated in both cases (see section 13.4):
    The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor.
  - No articles referred to in this context.
  - Following boards considered:
    - what is the legal basis?
    - what does "same subject-matter" mean?

Case law – a controversial decision

- T307/03 (03.07.2007 published just after G1/05 and G1/06)
  - no legitimate interest in anyone having identical patents but it would have to be allowed if not prohibited by EPC.
  - prohibition of double patenting is deduced from A. 60 EPC: "The right to a European patent shall belong to the inventor or his successor in title".
  - double patenting exists irrespective of the fate of the granted patent (see section 3.2)
  - claim cannot be broader than the granted claim, i.e. not just identical claims are excluded.

Case law – defining "same subject-matter"

- T877/06 (02.12.2009), referred to in Guidelines
  - No objection of double patenting if subject-matter of claims is overlapping, but not identical (see section 5.2).
- T1391/07 (07.11.2008)
  - Similar to T877/06, but also considered whether the "scope of protection" was identical (see section 2.4).
- T1491/06 (20.12.2011)
  - See section 3.5.1: subject-matter of a method claim (in the grandparent patent) is not the same as that of an apparatus claim (in the application), despite similarity of features.

Case law – defining "same subject-matter" (pharma)

- T0879/12 (27.08.2014) and T1780/12 (30.01.2014)
  - Grandparent: Swiss-type claim "Use of X for the manufacture of a medicament for the treatment of Y" is a purpose-limited process claim.
  - 2nd generation divisional: A.54(5) claim "X for use in the treatment of Y" is a purpose-limited product claim.
  - Claim category is different and therefore the claims are not identical, the scope of protection is different and so there is a legitimate interest, hence no double patenting.
  - See also similar T0803/10 (06.06.2014): refused in examination for double patenting, overturned by Boards of Appeal.

Case law – another controversial case

- T1423/07 (19.04.2010)
  - The case concerned an application with inner priority (see earlier slide), i.e. different filing dates, unlike a divisional.
  - An applicant does have a legitimate interest in extending the term of protection by a second identical patent for the same invention.
  - Double protection (national and EP) is not possible in 27 out of 35 EPC contracting states, i.e. a generally recognised principle of law (p. 7).
  - Double patenting prohibited explicitly only in IE and UK (in DE by jurisprudence), i.e. no generally recognised principle of law and so A.125 cannot be used (see section 2.2.3).
  - A. 60 cannot be used either, since it is part of section of EPC dealing with "Persons entitled to apply for and obtain a European patent" (see section 2.3.2).

Case law

- T1423/07 (19.04.2010) continued
  - Change of ownership (Section 2.4): the first patent remained the property of Boehringer Ingelheim Pharma GmbH; the second application was later transferred to Boehringer Ingelheim Vetmedica GmbH. This therefore represents two applications received from two different applicants, each of which must be allowed to proceed as if the other did not exist (cf. Guidelines), no double patenting.
  - No conflict with G1/05 and G1/06, which do not relate to inner priority.

Case law – the A.125 connection

- T2461/10 (26.03.2014), referred to in Guidelines
  - Also concerned inner priority (cf. 1423/07).
  - A.54(3) EPC does not apply (Section 4).
  - lack of legitimate interest in double patenting is a general principle of procedural law in the sense of A. 125 EPC (Section 7).
  - Travaux préparatoires (early 1970s) show that this was explicitly the view of the parties, and therefore did not require mention in EPC (Section 8).
  - The travaux préparatoires also show that the general principle of prohibition of double patenting explicitly included inner priority (Section 8).
  - The connection with A.125 EPC is explicitly mentioned (Sections 9, 10).
  - The applicant certainly has an interest in extending the patent term, but not necessarily a legitimate interest (Section 14), cf. double protection.
  - Last question left open because in this case the subject-matter was not identical (Section 15, 16).

Case law – opposition

- T0936/04 (24.04.2008), same Board as T307/03
  - The case concerned the parent, which had been through opposition. The divisional was still in examination (not yet granted).
  - Appellant (Opponent) questioned i.a. whether there was a legitimate interest in filing claims for the parent in opposition identical with those of the divisional in examination (XII(b)), and whether the opposition division - for the same claims - could override the examination division.
  - BoA: Opposition division should disregard any double patenting objection since the related application had not been granted. Examination division should then avoid allowing claims granted in the parent.
  - Double patenting is not a ground of opposition (Catchword 1, section 2.3), but the objection of double patenting can be raised ("in clear cases") against amended claims in opposition or opposition appeal proceedings.
  - Purpose behind prohibition of double patenting is to avoid unnecessary duplication of effort (Catchword 1, section 2.3).

Case law – convergence

- T1155/11 (25.03.2015)
  - "The prohibition of double patenting is an accepted principle in the jurisdiction of the Boards of Appeal, on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter" (Section 21, emphasis added).
  - Prohibition of double patenting appears to apply to all three double patenting routes (Section 22).

Content

- Definition: double patenting vs. double protection
- G4/19 – the questions
- Legal basis (EP and national)
- German practice
- How can double patenting happen?
- Case law
- G4/19 – the answers
- Current EPO practice
- Conclusions

G4/19 – the answers (1/2)

"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."

G4/19 – the answers (2/2)

"2.1 The application can be refused on that legal basis, irrespective of whether it

a) was filed on the same date as, or

b) is an earlier application or a divisional application (Article 76(1) EPC) in respect of, or

c) claims the same priority (Article 88 EPC) as the European patent application leading to the European patent already granted.

2.2 In view of the answer to Question 2.1 a separate answer is not required."

Current EPO practice

Guidelines, G-IV, 5.4 Double patenting

- "legitimate interest"
- "same effective date", "same filing or priority date"
- "not identical"
- "refused under Art. 97(2) in conjunction with Art. 125 EPC"

The meaning of "identical"

Examples

(i) Dependent claim 3 of the granted parent application relates to a composition comprising features a, b, c and d. Claim 1 of the divisional application also relates to a composition comprising features a, b, c and d. The subject-matter of claim 1 of the divisional application is identical to the subject-matter of claim 3 of the granted parent application. Therefore an objection of double patenting should be raised.

(ii) Dependent claim 3 of granted application EP1 relates to a composition comprising features a, b, c and d. Claim 1 of application EP2 having the same filing date as EP1 also relates to a composition comprising features a, b, c and d. The applicant for EP2 is different from EP1. Since the applicants are different, there is no double patenting and no objection of double patenting should be raised.

(iii) Claim 1 of the granted divisional application relates to a composition comprising features a, b, c and d. Claim 1 of the parent application relates to a composition comprising features a, b and c. Claim 1 of the parent application is broader than claim 1 of the granted divisional application, but no objection of double patenting should be raised since the subject-matter of the two claims is not identical.

Legitimate interest is the key

"Effective date"

- Article 89 Effect of priority right
  - "The right of priority shall have the effect that the date of priority shall count as the date of filing of the European patent application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2."
- Article 89 does not mention Article 63 Term of the European patent
  - "The term of the European patent shall be 20 years from the date of filing of the application."
- The 20-year term therefore begins on the EP filing date, not the priority date.
- For PCT applications EP filing date = PCT filing date, see Article 153(2) EPC:
  - "An international application for which the European Patent Office is a designated or elected Office, and which has been accorded an international date of filing, shall be equivalent to a regular European application (Euro-PCT application)."

Contents

- Definition: double patenting vs. double protection
- G4/19 – the questions
- Legal basis (EP and national)
- German practice
- How can double patenting happen?
- Case law
- G4/19 – the answers
- Current EPO practice
- Conclusions

Conclusions

- The principle of the prohibition of double patenting is now accepted in the EPO and is examined.
- Prohibition of double patenting is based on the notion that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for identical subject-matter if he already possesses one granted patent for that subject-matter (see G4/19; G 1/05 and G 1/06).
- The prohibition is based on Article 125 EPC, since the concept of legitimate interest is a generally recognised principle of procedural law in the contracting states.
- The prohibition also covers the special case of related applications linked by internal priority (see G4/19; T2461/10, section 14; T1155/11, section 22).