

Europe

Double patenting at the European Patent Office

Introduction

Until recently, double patenting was considered so irrelevant and rare that neither the 1973 nor the 2000 version of the European Patent Convention (EPC) included any explicit provision on the matter. While double patenting has increased in relevance, case law on the subject from the European Patent Office (EPO) remains contradictory, with decisions diverging on fundamental principles. However, growing interest in the subject may soon lead to a referral to the EPO's Enlarged Board of Appeal (EBA). This chapter offers some preliminary considerations on aspects that might require clarification by the EBA.

The meaning of double patenting

In EPO practice, 'double patenting' occurs when the same invention is protected by two patents or patent applications filed by the same applicant/patentee. This occurs in European procedure when, for instance, a divisional application claims subject matter that is literally or substantively identical to that claimed in the parent application/patent. This happens increasingly frequently, owing to the growing use of voluntary divisional applications as precautionary measures against a final rejection or revocation, although this possibility has been limited by the new Rule 36 of the EPC, which entered into force on April 1 2010.

Double patenting may also occur when a European (or Euro/Patent Cooperation Treaty (PCT)) application claims a priority right based on an earlier European (or Euro/PCT) application and both are prosecuted to grant.

Legal questions concerning double patenting: two patents, same applicant

Double patenting raises the following questions, unanswered by EPO case law:

- If a prohibition on double patenting exists, what is its legal basis in the EPC?
- When should the existence of double patenting be assessed?

- How may the status of the two patent documents (ie, filed application, amended application, refused/withdrawn application, granted patent, revoked patent), the claimed subject matter of which is compared, influence double patenting?
- What is the precise definition of 'same invention'?

Case law

The EPO's argument, adopted mainly at first instance, for justifying the prohibition of double patenting is: "It is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention." (See *Guidelines for Examination* (latest edition) C-IV, 7.4.)

In other words, although there is no explicit legal basis for the prohibition in the EPC, this prohibition is legitimate by analogy (Article 125 of the EPC), with the patent systems of most EPC contracting states allegedly including an equivalent principle. The boards have only recently investigated whether, or to what extent, this statement is correct.

Case law is contradictory on the legal basis for prohibiting double patenting.

Analysis of some 50 board of appeal decisions that deal, directly or indirectly, with double patenting reveals that most decisions excluded the existence of double patenting because the overlapping patent documents (eg, parent and divisional applications) did not protect technically identical inventions. Thus, the condition of 'same invention' was not met. In these cases, therefore, the boards did not feel the need to identify clearly any legal grounds for prohibiting the double patenting.

Other recent decisions, such as T0877/06 (December 2 2009) and T1391/07 (November 7 2008), accepted that the mere fact that the scope of protection notionally conferred by a claim in a divisional application would partially overlap with that of the granted parent patent did not prejudice the grant of a patent because no double patenting issue would arise.

Decision T0587/98 (May 12 2000) took the same line.

It stated that there is no express or implicit provision in the EPC prohibiting an independent claim in a divisional application that is related to an independent claim in the 'parent' application in such a way that the parent claim includes all the features of the 'divisional' claim combined with an additional feature. In practice, when the parent patent claims two associated elements – A and B – and the divisional document claims either of the two elements alone, no double patenting occurs.

The general principle that the same invention cannot be protected by two patents/patent applications owned by the same person was also accepted by the EBA in Decisions G0001/05 and G0001/06 (June 28 2007), which stated: "The Board accepts that the principle of prohibiting 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."

However, it is unclear which EPC provision requires a 'legitimate interest' for filing a European patent application. Help in interpreting the EBA's apodictic affirmation "that an applicant has no legitimate interest" may be found in the nearly concomitant decision, T0307/03 (July 3 2007), in which the competent board sought a legal basis for the double patenting prohibition directly in the EPC.

According to T0307/03, the prohibition of double patenting lies in Article 60(1) of the EPC: "The right to a European patent application shall belong to the inventor or his successor in title."

From this sentence, the board deduced that under the EPC, the principle of prohibiting double patenting applies and the inventor has a right to the grant of one, and only one, EPO patent for a particular invention. Once a patent has been granted to the inventor, this right to a patent has been exhausted. The decision offers no clearer motivation for that deduction. The board's conclusions are founded on an innovative, but not necessarily acceptable, construction of Article 60.

However, if confirmed, this decision will give reason for concern.

Since Article 60(1) of the EPC defines who is entitled to an European patent, the fact that the right to a (second) patent is considered exhausted means that the applicant is not entitled to such a second patent. In other words, the prohibition on double patenting derives not from lack of 'legitimate interest', as affirmed by the EBA, but from lack of 'legitimate entitlement'. The consequence is that a divisional application for the same invention should be considered inadmissible, even before allowability is examined.

This would appear to anticipate the time for assessing double patenting from the examination/grant procedure to a very early examination phase. This way of processing a divisional application contradicts the principle laid down by the EBA in G0001/05 and G0001/06 (Reason 13.4):

Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO [of prohibiting double patenting in divisional applications]...However, this principle could not be relied on to prevent the filing of identical applications, as this would run counter to the prevailing principle that conformity of the applications with the EPC is to be assessed on the final version put forward.

In other words, a finding of double patenting may result only from substantive examination of the claimed subject matter, which, however, is prevented by a preliminary judgment of inadmissibility as in T0307/03.

Moreover, this decision, if confirmed, would influence invalidity actions before national courts against nationally validated European patents. In fact, T0307/03 would *de facto* include double patenting among the grounds for revoking an European patent pursuant to Article 138(1)(e) of the EPC, which provides that a European patent may be revoked on the ground that "(e) the proprietor of a European patent is not entitled under Art. 60 (1) EPC".

In the recent Decision T1423/07 (April 19 2010), another board of appeal disagreed with the findings of T0307/03, on the grounds of well-motivated and exhaustive arguments.

T1423/07 deals with the situation in which double patenting arises from filing a European application (or Euro/PCT) claiming a priority right from an earlier identical European application (or Euro/PCT), both prosecuted to grant. The EPO's Examining Division refused the second application because of the bar against double patenting established by Guidelines C-IV 6.4 (now 7.4) and C-VI 9.1.6. By invoking the "accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention", the Examining Division found a legal basis for prohibiting double patenting in Article 125 of the EPC.

In T1423/07 the board for the first time carried out an analysis of EPC contracting states' patent systems. The result was that the 'common accepted principle' applies only in a very specific situation: namely, when the same invention is double protected by a granted national patent (normally the national priority) and by the corresponding granted European patent (claiming priority from the former) validated in the same state. In these specific circumstances, the granted national patent

automatically ceases to have legal effect. However, this exclusion of double patenting concerns a very specific situation in post-grant procedure. On the contrary, the board's enquiry showed that only three national systems envisage the exclusion of double patenting in the pre-grant procedure – within the context of internal priority.

For this reason, the board concluded that since only a few national patent systems of contracting states provide a basis for refusing a patent application on the grounds of double patenting, there is no principle of law generally recognised in contracting states for refusing a European patent application on the ground of double patenting.

With regard to Article 60 of the EPC, Decision T1423/07 is clear and unequivocal in diverging from the previous interpretation of T0307/07. The board was unable to find in Article 60 any exhaustion of an applicant's right to have a second patent claiming subject matter already protected in a previous granted patent. On the contrary, the lack of explicit provisions on double patenting in the EPC was considered decisive. The board consequently held that the application could not be refused under Article 60 of the EPC for double patenting.

Legitimate interest

T1423/07 discusses the legitimate interest of the applicant. As in G0001/05 and G0001/06, the EBA, while accepting that the prohibition against double patenting exists in principle, indicated as the reason for this the fact that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject matter. The absence of a legitimate interest is also invoked in many national systems as the basis for the same exclusion.

Yet T1423/07 makes it clear that where double patenting results from an internal priority (an European patent application claiming priority from earlier identical European patent application), the applicant indisputably has a legitimate interest in having a second patent granted, since the second patent's expiry term is one year later than that of the earlier patent (priority patent). Therefore, if the lack of legitimate interest is the reason justifying the prohibition against double patenting, it definitely does not apply to T1423/07.

On the other hand, the board is aware that the above considerations do not automatically apply to the different circumstances in G0001/05 and G0001/06, in which double patenting resulted not from a case of internal priority, but from the filing of a divisional application which, in any case, maintains the same expiry term as the parent patent.

But was the EBA correct in affirming that “an

applicant has no legitimate interest” in filing a divisional application and obtaining a second patent claiming the same subject matter, or a part thereof, already protected in the previously granted patent?

One point is indisputable: willingness to bear the cost of the new application shows that there is an interest. Besides, voluntary divisional applications are often filed as a precautionary measure in case the patent application is refused or the parent patent revoked. The aim is to minimise the risk of a total loss of rights and ensure the possibility of prosecuting the examination of at least part of the subject matter of the possibly refused/revoked parent document.

Therefore, the real question is not whether the applicant has an interest, but rather whether that interest is legitimate.

In the author's opinion, filing a divisional application as a precautionary measure cannot qualify as illegitimate, abusive or unlawful, unless it clearly contravenes EPC provisions. With regard to the EPC, there are only two categories of action: actions that violate the law, representing an illegitimate abuse, and actions that do not violate the law, which are fully legitimate. There is therefore no room for actions which, though compliant with all EPC provisions, may be considered ethically inadmissible.

The EBA was very clear on this point in G0001/05 and G0001/06 when it affirmed, in relation to EPC 1973:

On Art. 76(1) and Rule 25 as presently worded the EBA sees no adequate basis for defining any additional requirements to be imposed on divisional applications...

It appears that what applicants consider a legitimate exploitation of the procedural possibilities afforded by the EPC, others consider an abuse in relation to the law as they think it ought to be rather than as it is.

The Board finds it unsatisfactory that sequences of divisional applications each containing the same broad disclosures of the original patent application... should be pending for up to 20 years.

However, the EBA recognised that in the EPC 1973 there was no requirement prohibiting this use of divisional applications, and accordingly suggested: “If administrative measures...to minimize the possibility for the applicants to keep alive subject-matter on which the Examining Division had already given a negative opinion...are not adequate, it would be for the legislator to consider where there are abuses and what the remedy could be.”

In other words, although the practice may be unsatisfactory, the EBA admitted that in the EPC 1973 no provision prohibited the filing of divisional applications

that are totally or partially identical to a previous parent patent or parent application. Hence, the practice could not be considered an abuse of procedure.

It is well known that in the meantime, the European legislature has introduced new remedies, aimed at limiting the possibility to file voluntary divisional applications. This is the new Rule 36 of the EPC which, by setting a shorter timeframe for filing divisional applications, quantitatively limits their use as means for redressing the loss of rights. However, it is immediately evident that this remedy, beyond limiting in time the possibility of filing divisional applications, does not introduce any explicit prohibition against double patenting. Therefore, also within the context of the EPC 2000 and the new Rule 36, the filing of divisional applications that are identical or partially identical to a previous parent application/patent is a legitimate interest for the applicant.

In conclusion, it seems that the absence of a legitimate interest cannot be invoked to justify a prohibition against double patenting.

On the other hand, the case law of the boards of appeal already imposes a well-defined and insuperable limit on the possibility for an applicant to keep alive subject matter on which the EPO instances have already given a negative opinion by refiling the same subject matter in divisional applications. As clarified by T0051/08 (May 7 2009), this limit is the point in time at which the subject matter becomes *res judicata*. In other words, an invention on which a final decision has been taken by the board of appeal in the parent application/patent cannot be pursued in a divisional application.

In summary, EPO case law offers no uniformly accepted solutions to the legal problems raised by double patenting. It is to be hoped that the EBA will clarify the issue, ensuring the correct exercise of rights.



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