



## **AMICUS BRIEF FILED ON BEHALF OF AIPPI IN CASE G 4/19 PENDING BEFORE THE ENLARGED BOARD OF APPEAL OF THE EUROPEAN PATENT OFFICE**

### **WRITTEN STATEMENT IN ACCORDANCE WITH ARTICLE 10 OF THE RULES OF PROCEDURE OF THE ENLARGED BOARD OF APPEAL**

#### **I. INTRODUCTION**

The EPO has called for Amicus Briefs in case G 4/19, pending before the Enlarged Board of Appeal.

AIPPI herewith files our brief regarding the above referenced case.

The issue arises because the Applicant, Société des Produits Nestlé S.A., filed a patent application where “*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 European patent application No 09159932.4, the priority document of the present application.*” The Examining Division refused to grant the application, on the grounds that this was “*contrary to the principle of the prohibition on double patenting referred to in decisions G 1/05 and G 1/06*”. Nestlé appealed to the Boards of Appeal of the EPO and the case was heard as case T 0318/14.

The questions put to the Enlarged Board of Appeal are as follows:

*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?*

*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?*

*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?*



The specific question in this case is whether a patent application can be granted at the EPO if the claims are **identical** to those of the priority document, which has already been granted as a European Patent, but the questions posed to the Enlarged Board include two other situations that do not appear to be specific to the facts of this case: applications filed on the same date, and applications which are divisional applications of a prior application.

AIPPI's position can be summarized as follows:

1. The European Patent Convention provides no express legal basis or authority for the EPO to refuse to grant a patent specifically on the basis of a prohibition on double patenting.\
2. However, pursuant to Article 125 EPC, 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. One of the relevant principles is that abuses of process may be curtailed and prevented.
3. It is a question of fact and degree whether there is, in these specific factual circumstances, an abuse of process that has been committed by the filing of a second patent application with identical claims. Relevant factors that may be taken into account include: whether the applicant has a legitimate interest in the application, whether there were any defects in granting the first patent which would be remedied by a second patent, and whether the applicant seeks to inadmissibly extend the geographical scope of protection beyond the states designated in the first patent application.
4. As a matter of general principle AIPPI is not in favor of double patenting in the specific situation where the patents have identical claims (or claims of identical scope), with identical priority claims, identical patent terms and identical geographical scope. AIPPI's view is that if double patenting is not prevented by the EPO, Contracting States of the EPC should apply relevant provisions in their own national laws.

## **II. THE ISSUES IN DOUBLE PATENTING**

The prohibition on Double-Patenting seemingly finds its origins in the US patent system. There are in fact two types of double-patenting restrictions in the US: (i) same invention-type double patenting (which is statute based) and (ii) obviousness-type double patenting (which is a judicially created doctrine).

It originated at a time when US patents expired based upon their issuance date, so any later-expiring patent that claimed the same or similar subject matter actually extend the patent monopoly. Notwithstanding the elimination of this concern, now that US patents expire based upon their application date (not issuance date), the doctrine continues to be actively applied in the United States.

The basic idea behind the continued prohibition on double patenting is that of protecting third parties from abuse by Patent Proprietors who hold title to more than one patent on the same (same invention-type) or very similar (obviousness-type) subject matter. The concern largely arises because of the possibility that the overlapping or coextensive patents will be separately owned or controlled (such as after a sale or license), or separately enforced by the same or different entities, thereby limiting the ability of a third party to fully license an invention or have finality if a lawsuit is filed on the basis of only one of the patents. Separate licensing may also result in disparate treatment of licensees; and separate enforcement may result in inconsistent claim interpretation.

Accordingly, in the United States, the obviousness-type double patenting can be overcome by the filing of a so-called terminal disclaimer that effectively does two things: disclaims any patent life that extends beyond expiration of the first-to-expire patent and requires that the patents be commonly owned in order to be enforceable. 37 CFR 1.321(c), MPEP 1490.



The case as presented in G 4/19 is one of same invention-type double patenting, where the Examining Division refused to grant a patent with **identical claims** (actually one single identical claim) to those of the priority document, which had already been granted as a patent to the same applicant.

### III. EPO HAS NO AUTHORITY TO REFUSE TO GRANT A PATENT ON THE BASIS OF A PROHIBITION ON DOUBLE PATENTING

It is noteworthy that there is no legal provision in the European Patent Convention which specifically forbids double patenting at the EPO, i.e. the granting of more than one patent for the same invention to an applicant. The Guidelines for Examination at the European Patent Office state exactly this at G IV 5.4, first sentence (emphases added):

#### Double patenting

**The EPC does not deal explicitly with the case of co-pending European applications of the same effective date filed by the same applicant.** However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention. The Enlarged Board of Appeal has accepted *obiter dictum* that the principle of the prohibition on 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 the same subject-matter if he already possesses one granted patent for that subject-matter (see [G 1/05](#), and [G 1/06](#)).

The EPC does not provide any specific legal basis for the Examining Divisions of the EPO to refuse to grant a patent application to a Proprietor who has already patented the same invention.

It is also noteworthy to indicate that a majority of the Contracting States of the EPC have provisions in place to prevent the granting of an EP Patent and a National Patent covering the same invention in accordance with Article 139(3) EPC.

The situation can thus, at least, be dealt with on a National level in each Member State of the EPC, based on explicit legal provisions.

However, Article 125 EPC 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” (emphasis added). One of the relevant principles is that abuses of process may be curtailed and prevented. This principle is present at least in the laws of the United Kingdom and the Republic of Ireland.

An abuse of process has also consistently been recognised as part of the legal order under the EPC, for example in: T 1019/92, T 724/03, T 17/91, T 1955/13, T 154/95. There is no reason why it should be limited in application to just one specific type of issue or proceeding under the EPC.

Whether there is an abuse of process in the context of a specific patent application depends on the facts of the case, which can be submitted by the parties or be examined on the initiative of the EPO (Article 114(1)). It might be relevant, for example, to examine whether:

- There applicant has a legitimate interest in the grant of the second patent;
- Whether there was a procedural defect in the grant of the first patent, and whether that defect was the fault of the applicant;
- Whether there is an inadmissible geographical extension in designated states which would give an applicant a second opportunity (after the relevant time limits have expired) to designate further states;



- Whether the second patent is attempt to rejuvenate a patent, when the first patent has already been revoked e.g. in Opposition proceedings and it would be contrary to the decision of the Opposition Division to grant a second patent to replace an already-revoked first patent.

#### IV. THE SPECIFIC CASE IN G 4/19

As a matter of general principle AIPPI is not in favor of double patenting in the specific situation where the patents have identical claims (or claims of identical scope), with identical priority claims, identical patent terms and identical geographical scope.

But the present case does not fall within the above requirements.

The present case is a question of “internal priority” claiming, a practice which is permissible under the EPC, and which is made use of by applicants on a regular basis. The Examining Division, and the Board of Appeal would appear to have taken exception to the practice of “internal priority”.

To briefly explain what this means: an applicant files a European patent application A. During the 12-month priority period, the applicant files an EP application B claiming priority from application A. Some applicants then abandon application A and continue only with prosecution of application B. Others allow both to proceed to grant. In the present case, if A and B have identical claims and both patents are granted, the Patent Proprietor will have obtained protection for their invention over a period of 21 years.

The long-accepted practice of claiming “internal priority” cannot be put into question without proper legislative basis. To the extent provisions may be found in law, they are provisions of member countries applicable at the national level.

#### V. CONCLUSION

In conclusion, the EPC provides no specific legal basis for the EPO to refuse the grant of a patent specifically based on the possibility of double patenting. However, AIPPI believes that it is appropriate and, under Article 125 EPC the EPO shall, take into account commonly applied provisions of procedural law. Preventing an abuse of process is such a provision.

Whether an abuse of process is present in a specific situation depends on the facts of the situation. Double patenting could indicate the presence of an abuse of process.

AIPPI is not in favor of double patenting in the specific situation where the patents have **identical claims (or claims of identical scope)**, with identical priority claims, identical patent terms and identical geographical scope, and believes that pursuant to the EPC it should be dealt with by Contracting States if it is not dealt with by the EPO.

AIPPI thus proposes the following responses to the questions put to the Enlarged Board of Appeal in G 4/19:

*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?*

Yes, if the filing of the patent application constituted an abuse of process.



*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?*

*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?*

All of the factors in 2.1 and 2.2 would be relevant when examining whether there has been an abuse of process.