



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION  
VON PATENTANWÄLTEN

## Written statement for case G 4/19 before the Enlarged Board of Appeal

14 June 2020

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including European patent attorneys, national patent attorneys and patent agents in all EPC<sup>1</sup> contracting and extension states.

**FICPI** aims to study administrative and legislative reforms and improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its members' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

**FICPI** is pleased to have the opportunity to provide this written statement for case G 4/19 in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

### I. Case G 4/19

The following questions have been referred to the Enlarged Board of Appeal in case T 0318/14:

*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*

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*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?*

## **II. FICPI's comments**

### **1. Findings of the referral**

The referral contains a detailed study (around 50 pages) on double patenting. At the end of the study, the Board reached the following conclusions:

- *There is no express provision in the EPC which prohibits double patenting.*
- *It is not clear whether such a prohibition became an implicit part of the Convention by way of an agreed statement or similar instrument adopted at the Munich Diplomatic Conference.*
- *The legislator did not introduce an express prohibition on double patenting at the Diplomatic Conference for the revision of the EPC in 2000. Article 139(3) EPC remained unchanged.*
- *A prohibition on double patenting cannot be based on Article 60(1) EPC.*
- *Neither Article 63(1) EPC nor Article 76(1) EPC offers scope for the idea of a prohibition on double patenting.*
- *It is questionable whether Article 125 EPC is appropriate as a legal basis for a prohibition on double patenting. This provision cannot serve to introduce a new condition for patentability (or a ground for refusal).*
- *Article 139(3) EPC deals with double protection resulting from parallel filing routes for the same territory. This matter is left entirely to national law.*
- *If a prohibition on double patenting with respect to European patent applications may be introduced at all, this could be by way of case law filling an unintended gap in the law. However, in view of the policy considerations involved, it appears that a proper legislative procedure would offer a more favourable context for establishing a sound legal basis for a prohibition on double patenting.*

FICPI fully agrees with and endorses the Board's conclusions and adds that, according to Article 52(1) EPC, "European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application." (emphasis added).

Therefore, the EPC does not prohibit double patenting and in fact obliges the EPO to grant a patent when the prescribed substantive requirements of patentability are met. The EPO already grants



identical patents on separate applications where applicants/proprietors are not the same.

## 2. G 1/05 and G 1/06

FICPI observes that decisions G 1/05 and G 1/06, mentioned at point 23 of the referral, are not focused on double patenting but only accept, *obiter dictum*, the practice of the EPO on double patenting, introducing the concept of a “legitimate interest” as follows:

*“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.”*

In this respect, FICPI believes that it is not a task of the EPO to assess whether an applicant has a legitimate interest in the grant of a second patent.

Moreover, there are situations in which such a legitimate interest may exist, e.g. in the case mentioned in question 2.2 of the referral, as acknowledged by the board in T 1423/07.

Thus, “legitimate interest” should not be a condition for refusing or allowing the grant of a patent and, even if it were, there should be no automatic presumption that an applicant may not have a legitimate interest in the grant of a second patent for the same subject-matter.

## 3. EPO Guidelines

According to the EPO Guidelines (G-IV, 5.4) a second application should be refused because *“once one of the applications is granted, the other(s) will be refused under Art. 97(2) in conjunction with Art. 125.”* However, it is questionable whether Article 125 EPC can be invoked to introduce through the Guidelines a completely new ground for refusal, as explained in detail at points 43 to 64 of the referral, since it is very unlikely that the legislator simply forgot to include provisions on double patenting both when drafting (1973) and revising (2000) the EPC.

Thus, the issue of double patenting should be left to the national law of the EPC contracting states, some of which have already adopted different solutions according to their needs.

Furthermore, two European patents for the same subject-matter may be validated in different contracting states, thus confirming that double patenting must be dealt with on a national level. For example, if a first European patent is validated in three contracting states only (which may be necessary when in an early phase of an invention/company early patent protection is required but money is limited) and a later patent is validated in all contracting states, a double patenting issue may arise in only the three contracting states in common, while for the remaining contracting states there is no issue at all, even if they have national stipulations for preventing double patenting.

Therefore, the part of the EPO Guidelines which purport to preclude double patenting should be removed, since it is not supported by the EPC or its Implementing Regulations.



#### 4. Conclusions

In view of the above, FICPI believes that double patenting should not be prohibited by the EPO and should be left for the national laws of the EPC contracting states.

Further considerations on double patenting, in line with the present conclusions, are contained in FICPI resolution **EXCO/ES14/RES/003** of 2014, a copy of which is enclosed.

#### III. Suggested answer to the referred questions

FICPI requests that the questions referred to the Enlarged Board of Appeal should be answered as follows:

1. No
- 2.1 Not applicable according to the negative response to question 1
- 2.2 Yes

Roberto Pistolesi  
Secretary general

Encl.: FICPI resolution EXCO/ES14/RES/003



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#### **IMPORTANT NOTE:**

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniører Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industrial (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Colombia, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Peru, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a provisional national section in Poland and individual members in a further 41 countries and regions.

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## Resolution of the Executive Committee, Barcelona, Spain, 2 to 5 November 2014

### “Double Patenting”

**FICPI**, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Barcelona, Spain, 2 to 5 November 2014, passed the following Resolution:

**Recognising** that a fundamental principle underlying the patent system is that an applicant receives a time limited monopoly for the full scope of an invention as disclosed and claimed in one or more patent applications in exchange for disclosing the invention;

**Observing** that for various legitimate reasons an applicant may wish to pursue two or more patent applications for different variants or embodiments of an invention, for example by filing the applications simultaneously or by filing one or more applications divided or otherwise derived from their previously filed parent application, and the claims of these two or more applications may at least partially overlap in scope, and/or may relate to similar or related subject matter that is not considered to be patentably distinct;

**Noting on the other hand** that, in some jurisdictions, the patent authorities (patent office and/or courts) raise “double patenting” objections where co-pending applications and/or patents filed by the same applicant contain claims having at least partially overlapping scopes or relating to subject matter that is not patentably distinct, with the objective of avoiding a perceived possible harm to the public or third parties, which it is believed could result from granting the applicant multiple patents claiming similar or related inventions;

**Observing** that, in direct conflict with the fundamental principle underlying the patent system mentioned above, double patenting rejections may have the detrimental result that an applicant does not receive patent protection for certain variants or embodiments of the invention even though such variants or embodiments have been disclosed to the public in at least one of the patent applications, or the scope of protection obtained by an applicant might not be commensurate with the applicant’s full contribution to the art;

**Believing** that such resulting detriment to applicants significantly outweighs any perceived possible harm to the public or third parties which may result if multiple patents are granted to the same applicant;



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**Further noting** that the removal of the basis for such a double patenting objection by amending the claims to remove overlap between one patent application and another, or to render the claims of one patentably distinct with respect to the other, can often be difficult or impossible, and, if attempted, can leave substantial gaps in protection provided by the resultant amended claims;

**Urges**, in jurisdictions including specific provisions that prohibit double patenting:

- (1) that laws should be reviewed and, if necessary, amended in order to limit such provisions only to claims that have identical scope in co-pending applications and/or patents that have been filed by the same applicants, with the same effective filing date; or
- (2) if other types of double patenting objections must continue to be raised, including in circumstances where the claims of the two patents or applications are not patentably distinct or where claims simply overlap, that laws should be reviewed and, if necessary, amended so that an applicant or patentee can overcome the objection by a simple mechanism, such as offering to maintain common ownership between the two patents, without requiring amendment of the claims;

**Also urges**, in jurisdictions that do not include specific provisions to prohibit double patenting, but where double patenting objections are nonetheless raised:

- (1) that the patent authorities refrain from issuing double patenting rejections, and
- (2) that the patent authorities take steps to ensure that patents are not invalidated based on double patenting.