

Registry of the Enlarged Board of Appeal

For the attention of Mr Nicolas Michaleczek (EBAamicuscuriae@epo.org).

Eindhoven, 1 September 2020,

Your reference: G 4/19 – “double patenting”

Our reference: case number G 4/19 - written statements in accordance with Article 10(1) RPEBA

Dear Sirs,

In OJ 2020, A66 (Online publication date: 29.05.2020), “Communication from the Enlarged Board of Appeal concerning case G 4/19 ”), third parties were given the opportunity to file written statements in accordance with Article 10(1) of the Rules of Procedure of the Enlarged Board of Appeal, until 1 October 2020.

Topic is the referral in accordance with Article 112(1)(a) EPC, whereby Technical Board of Appeal 3.3.01 has referred the following points of law to the Enlarged Board of Appeal by interlocutory decision of 7 February 2019 in case T 318/14:

1. Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent granted to the same applicant which 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 where 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 ofa European patent application on the basis of which a European patent was granted to the same applicant?

- 2.2 In particular, in the latter case, does an applicant have a legitimate interest in the grant of 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.

In my opinion:

1. A European patent application **cannot be refused** under Article 97(2) EPC for the reason that it claims the **same** subject-matter as a European patent granted to the same applicant which does not form part of the state of the art pursuant to Article 54(2) and (3) EPC. (No “double patenting objection” / No “double patenting prohibition”).
- 2.1 It is not relevant whether the European patent application under examination was filed
  - a) on the same date as, or
  - b1) as a European divisional application of first or higher generation in respect of, or
  - b2) as the parent application in respect of a European divisional application that is, or
  - b3) one of the patent applications in one or more chains of divisional applications (arising out of the same “founding” parent application) of which one is, or
  - c1) claiming the priority in respect of, or
  - c2) is the priority application for,a European patent application on the basis of which a European patent was granted to the same applicant: the European patent application under examination cannot be objected to under the EPC in proceedings before the EPO on the ground of double patenting.
- 2.2 If the Enlarged Board would however consider that a European patent application can be refused, on the ground of double patenting, under Article 125 EPC jo. lack of legitimate interest in obtaining two patents for the same invention as being considered a general principle of procedural law in contracting states -which is doubted in the detailed submission below-, it is submitted that it would not be up to the EPO Examining Division to decide whether the applicant has an interest and whether the interest is legitimate, but to the applicant himself and the applicant alone.

The legitimate character of the interest may have its origin in the filings themselves. For example, in cases c1) and c2), the applicant may have an interest in the grant of both the first application as well as the subsequent (priority-claiming) application. Such interest may be considered to be legitimate, for example, due to 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. As another example, in cases c1) and c2), it may also reside in a different territorial scope at the date of filing due to the accession of a new EPC Contracting state or

due to a new Extension or validation agreement getting into force in the meantime. In any of cases a)-c), such legitimate interest may, for example, reside in view of the fact that the applicant did not validate the earlier granted patent in all EPC states and now wants to validate the later granted patent in more, or different, countries.

- 2.3 Also, it is not relevant whether the claims of the European patent application and the other European patent granted to the same applicant are literally the same, are differently worded but have the same scope, are partially overlapping, are within the scope of the other, or fully encompass the scope of the other. In any of these cases, a refusal under the EPC cannot be based on a prohibition of double patenting.

If the Enlarged Board would consider that a European patent application can be refused under the EPC on the ground of double patenting, the Enlarged Board is also requested to give a detailed decision as to the extent of the prohibition: does the prohibition apply if the claimed subject-matter is identical in technical meaning and wording, does the prohibition apply if the claimed subject-matter is identical in technical meaning although possibly differently worded, does the prohibition apply if the claimed subject-matter is different but the scope of protection is identical (e.g., based in equivalents), does the prohibition apply if the claimed subject-matter overlaps in full or in part? (See also below)

- 2.4 If the Enlarged Board would consider that a European patent application can be refused under the EPC on the ground of double patenting objection, a detailed and exhaustive definition is requested of the extent and application of this double patenting prohibition such that there is no uncertainty as to the extent of the prohibition. In particular, the Enlarged Board is requested to consider issues such as:
- a) is the prohibition limited to exactly identical same subject-matter (same technical meaning of the claims) or does it also extend to the same scope of protection with different subject-matter (as T 1391/07 held; e.g., due to equivalence),
  - b) does the prohibition include non-identical but overlapping subject-matter:
    - b1) “dependent” subject-matter: overlapping with one scope fully contained in the other (narrow first, broad later; broad first, narrow late), e.g. 1-10% vs 3-5%, or X vs X+Y
    - b2) true overlap: overlapping without one scope fully contained in the other, e.g., X+Y vs X+Z, both comprising X+Y+Z
  - c) does the prohibition include subject-matter that is only different by a presence of a disclaimer;
  - d) is it relevant whether the designated states (EPC states, extension states, validation states) are the same at the time of filing, at the time of grant, or at the time of the second refusal (when the earlier granted patent may already have lapsed in some states); ...

e) what is the relevant scope of the earliest grant if that is later limited in opposition, in central limitation or revoked: if only the subject-matter at the date of grant EP1 is relevant, and the later grant EP2 is to a narrow scope, can the proprietor of the earliest grant EP1 than not limit to the claims of EP2? Is it relevant what the order of narrow and broad grant is?

f) would the prohibition also apply to amendments made in opposition?

g) the relevance of identify of applicants: does the prohibition only apply if the applicants are the same, or also if there is one applicant less or more? What is the effect of transfers of the patent application under examination and/or of the earlier granted patent before or after grant)? Should all applicants /patentees be different between the two patents to allow two grants on the same subject-matter? Does the prohibition apply as soon as there is one applicant/patentee in common (in view of all patentees having the same rights from the patent)?

I submit my observations and viewpoints in detail on the next pages.

Yours faithfully,



Roel van Woudenberg  
European Patent Attorney

**G 4/19: Detailed written statements in accordance with Article 10(1) of the Rules of Procedure of the Enlarged Board of Appeal****Referred questions**

The referred questions are cited for easy reference. The numbering of the referral is adhered to:

1. Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent granted to the same applicant which 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 where 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 latter case, does an applicant have a legitimate interest in the grant of 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.

**General**

1. I will first address Question 1.
2. In particular, I will discuss the applicability and relevance of various EPC provisions.
3. Art. 97 EPC provides that the EPO can only refuse an application if it does not meet the requirements of the EPC. The EPC does not prohibit double patenting explicitly. According to the Guidelines and the Case Law Book, the alleged prohibition of double patenting finds its legal basis in Art. 125 EPC, which provides:  
*“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.”*  
The alleged generally recognized principle relied on is lack of legitimate interest of obtaining two patents for the same subject-matter.  
The application of Art. 125 EPC and the “general principle” will be discussed in detail below.

4. Then, I will address the situations addressed in the sub-questions of 2.1, as well as some other situations which are in my view relevant in view of the topic of the referral. These other situations are within the scope of the first and/or second Question and have led to conflicting case law in the past, so should in my view also be explicitly addressed in the answer.
5. I also attach a presentation from Examination Matters 2016 and blogs from various authors including comments posted in reaction to those blogs.

## **First question**

2. The first question reads:  
*Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent granted to the same applicant which does not form part of the state of the art pursuant to Article 54(2) and (3) EPC?*
3. In my opinion, the answer to the first question shall be “No”. A European patent application cannot be refused under Article 97(2) EPC for the reason that it claims the same subject-matter as a European patent granted to the same applicant which does not form part of the state of the art pursuant to Article 54(2) and (3) EPC. (It could be of course be refused for other reasons in exceptional cases, such as if, after the earlier grant, new prior art is found or brought to the attention to the EPO via third party observations under Art.115 EPC that destroys the novelty or inventive step of the claims). My arguments are given below; they are summarized here first, and then expanded on in further detail.
4. Firstly, *the EPC does not provide for a prohibition of double patenting*, not explicitly nor via one of its Articles, in particular not via Art.125 EPC.
5. Secondly, *there is no need for a double patenting prohibition by the EPO*, as Art. 139(3) EPC already provides that national law has the authority to prescribe the effect of double patenting. Furthermore, as Art. 139(3) EPC provides that the national law if the applicable law, it is not appropriate nor correct to interpret the EPC such that it would provide for a double patenting prohibition – Art. 2(2) EPC.
6. Thirdly, *Art.125 EPC as basis for a double patenting prohibition is not correct* in my view as I do not share the view that it would be a generally recognized procedural principle. But even if it would be considered that lack of legitimate interest would be generally recognized procedural principle that would need to be applied because the EPC does not provide for a procedural provision (but see below), the prohibition would be based on a poorly defined and badly definable principle: legitimate interest. Such requirement is not consistent with the required legal certainty for applicants, proprietors and third parties.

7. In this context, it is noted that Case Law Book (2019) II.F.5.2 “Different subject-matter and scope of protection; overlapping subject-matter”, second paragraph writes:
- In T 587/98 (OJ 2000, 497) the examining division, relying on the Guidelines prohibiting "conflicting" claims, had refused a European patent application, filed as a divisional application, on the grounds that its subject-matter overlapped with that of the parent application and that in the overlapping region the same subject-matter was claimed; as legal basis for the refusal it invoked Art. 125 EPC. **The board held that Art. 125 EPC was not applicable to the case at issue since this article required "the absence of procedural provisions in the Convention" but the provisions governing divisional applications were self-contained and complete.** In addition a prohibition of "conflicting" claims in the wide sense applied by the examining division **would be a matter of substantive law** rather than a matter of procedure - and Art. 125 EPC was not applicable to substantive law. The board also found that there was **no express or implicit provision in the EPC** which prohibited the presence in a divisional application of an independent claim - explicitly or as a notional claim arrived at by partitioning of an actual claim into notional claims reciting explicit alternatives - which was related to an independent claim in the parent application (or patent, if it had already been granted) in such a way that the "parent" claim included all the features of the "divisional" claim combined with an additional feature.*
8. Lastly, *double patenting prohibition is not a ground of opposition under the EPC, nor is Art.125 EPC.* Not only is this a clear hint that double patenting is not meant to be prohibited, this would also create a strange asymmetry between pre-grant and post-grant proceedings for which there seems to be no justification (contrary to the asymmetry found for clarity examination; where G 3/14 clarified that, as a result of clarity not being a ground of opposition, some amendments cannot be examined for clarity --those that effectively leave a claim or claimed alternative unchanged-- whereas “true” amendments can be, as “true” amendments are to be examined to compliance with all requirements of the EPC).

***Relevant law is national law, not the EPC***

9. Art. 139(3) EPC provides:
- Any Contracting State may prescribe whether and on what terms an invention disclosed in both a European patent application or patent and a national application or patent having the same date of filing or, where priority is claimed, the same date of priority, may be protected simultaneously by both applications or patents.*

10. As a granted EP is not under EPC provisions anymore (except, as far as patentability and validity is concerned, Articles 138, 139 and 140 EPC, and except for opposition and central revocation & limitation), a granted EP is merely a plurality of national applications.
11. Further, Article 2 - European patent provides:
  - (1) *Patents granted under this Convention shall be called European patents.*
  - (2) *The European patent shall, in each of the Contracting States for which it is granted, have the effect of and **be subject to the same conditions as a national patent granted by that State, unless this Convention provides otherwise.***
12. Hence, if another EP appl is still pending after the first grant, EPC Art.139(./)140(.) (double patenting) applies: it is not the EPC, but it is **national law** that decides what the effect is of the two grants.
13. The EPC thus explicitly provides that double patenting by two EP patents is subject exclusively to national law and not subject to EPC -Art 2(2)-, such that there shall be no considerations during Examination, and not even during opposition of the first or second patent.
14. In view of the legal system set by Art. 139(3) and Art. 2(2) EPC (and Art. 64, see below) together, there is no room for the applicability of Art.125 EPC: that can only be applicable “In the absence of procedural provisions in this Convention”, while the EPC does provide provisions for the interaction of two subsequent grants.
15. Art.64 EPC - Rights conferred by a European patent-, reads:
  - (1) *A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date on which the mention of its grant is published in the European Patent Bulletin, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.*
  - (2) *If the subject-matter of the European patent is a process, the protection conferred by the patent shall extend to the products directly obtained by such process.*
  - (3) *Any infringement of a European patent shall be dealt with by national law.*
16. Also, Art.64(1) EPC provides that a European patent shall [...] confer, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.
17. Thus, where the national law allows double patenting, the EPC should not prevent the grant of a second patent. Refusing the second patent would deprive the applicant of the applicant’s right to a second patent in all the states that do allow double patenting, i.e., it

would deprive the applicant of the right that would be conferred by the grant of the second patent granted in that State.

18. Further, Art.64(3) also provides that any infringement is to be dealt with under national law. Thus, also infringement in case of double patenting is to be dealt with under national law. Thus, there is no need and also legal basis for a prohibition of double patenting in the EPC or during proceedings before the EPO.

***Alleged legal basis for double patenting prohibition by the EPO: Art. 60 EPC***

19. The argument used by some Boards that Art.60 “right to a EP patent for an invention” is to be understood as “right to one-and-only-one EP patent for an invention” has already been convincingly rejected by some Boards and is no longer followed.
20. The Guidelines also do not refer to such legal basis.
21. The Case Law Book (2019) II.F.5 “Double patenting”, 3<sup>rd</sup> paragraph also only mentions the relevant decision, but cites it as “T 307/03; but see also T 1423/07 and T 2461/10”, confirming that T 307/03 it is not followed.
22. So, no further comments as to this presumed legal basis are necessary nor appropriate here.

***Alleged legal basis for double patenting prohibition by the EPO: Art. 125 EPC (principles of procedural law) and lack of legitimate interest***

23. Case Law Book (2019) II.F.5 “Double patenting” opens with:  
*“This chapter primarily deals with double patenting arising from the filing of a divisional application, but also treats the matter as it may arise in other procedural situations. The leading decisions on the issue are G 1/05 (OJ 2008, 271) and G 1/06 (OJ 2008, 307), in which the Enlarged Board held that the principle of the prohibition on double patenting was based on the idea that the applicant had no legitimate interest in proceedings that gave rise to the grant of a second patent in respect of the same subject-matter for which he already held a patent, see in this chapter II.F.5.1. In T 318/14 questions concerning the prohibition of double patenting were once again referred to the Enlarged Board of Appeal (see below).*
24. The alleged prohibition of double patenting by the same applicant is based on Art. 125 EPC and lack of legitimate interest, or on Art. 125 EPC and alleged EPC-territory wide prohibition of double patenting.
25. Article 125 EPC - Reference to general principles – reads:

*“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.”*

26. Art. 125 EPC may thus only be applicable “in the absence of procedural provisions in the EPC”. In that absence, Art. 125 provides that “the principles of procedural law generally recognised in the Contracting States” shall be taken into account by the EPO.
27. It is submitted that it is not correct to apply Art. 125 EPC as legal basis for a double patenting objection: even if there would be law generally recognised in the Contracting States that applies in a double patenting situation, it cannot be considered to be a principle of procedural law but it would need to be considered a principle of substantive patent law. The objection relies on an assessment of identity of claimed inventions, which is not a procedural identity but an identity on the merits. It would be equally strange to consider the novelty requirement to be a procedural requirement. Double patenting is not an issue of procedural law or of (absence or presence of) procedural provisions.
6. This interpretation is confirmed by Case Law Book (2016) II.F.5.2, 2nd paragraph:  
*In T 587/98 (OJ 2000, 497) the examining division, relying on the Guidelines prohibiting “conflicting” claims, had refused a European patent application, filed as a divisional application, on the grounds that its subject-matter overlapped with that of the parent application and that in the overlapping region the same subject-matter was claimed; as legal basis for the refusal it invoked Art. 125 EPC. **The board held that Art. 125 EPC was not applicable to the case at issue since this article required “the absence of procedural provisions in the Convention” but the provisions governing divisional applications were self-contained and complete.** In addition a prohibition of “conflicting” claims in the wide sense applied by the examining division would be **a matter of substantive law rather than a matter of procedure - and Art. 125 EPC was not applicable to substantive law.** The board also found that there was no express or implicit provision in the EPC which prohibited the presence in a divisional application of an independent claim - explicitly or as a notional claim arrived at by partitioning of an actual claim into notional claims reciting explicit alternatives - which was related to an independent claim in the parent application (or patent, if it had already been granted) in such a way that the “parent” claim included all the features of the “divisional” claim combined with an additional feature.*
28. Furthermore, the EPC provides for a system of patentability requirement that is based on a novelty and inventive step w.r.t. the prior art as defined by Art.54(2) and, for novelty also, Art.54(3) EPC, together with Art. 87-89 EPC if priority is validly claimed as well as Art.76 EPC for divisionals. Same-date applications are fully covered by the scope of these provisions.

Double patenting is covered by these provisions: two applications with same effective date (filing date or, if priority is validly claimed, priority date) are not prior art to each other and can both proceed to grant. Thus, it is incorrect to say that provisions governing double patenting are absent: the mentioned Articles cover provide for them. Art. 125 EPC can thus not be applicable. (See below for more details on what we can learn from Art.54(2) and 54(3) EPC.)

***Is lack of legitimate interest for double patenting a principle of procedural law generally recognised in the Contracting States?***

29. The application of Art. 125 EPC for lack of legitimate interest must be based on “principles of procedural law generally recognised in the Contracting States”
30. The comment in the Guidelines “prohibition of double patenting is widely applied in EPC states” is in my view incorrect.
31. National Law Tables, 20th edition, October 2019 – Table X -, shows that many states provide that the (earlier granted) national patent ceases to have effect (in full, or to the extent that it protects the same invention/ overlaps) when the EP patent is (later) granted or, if opposed, the opposition decision to revoke the opposition or to maintain the patent in amended form has become final. The details vary between states.
32. But not all prohibit double protection. Acc to Table X of the 20th edition, it is allowed/ not excluded by:
  - Austria: Simultaneous protection by national patents/utility models is not excluded.
  - Croatia: Simultaneous protection for utility models is allowed.
  - Denmark: Simultaneous protection is not excluded. Applies equally to utility models (a separate request is to be made).
  - Estonia: Simultaneous protection for utility models is allowed.
  - Finland: Simultaneous protection by national patents/utility models is not excluded.
  - Germany: Simultaneous protection for utility models is allowed.
  - Hungary: Simultaneous protection by national patents/utility models is not excluded.
  - Iceland: Simultaneous protection is not excluded.
  - Norway: Simultaneous protection by national patents is not excluded.
  - Poland: Simultaneous protection by national patents/utility models is not excluded.
  - Portugal: Yes
  - Sweden: Simultaneous protection by national patents is not excluded

i.e., 12 of 38 states do not exclude simultaneous protection by national patents and/or utility models. With such a very significant ratio, it does not seem fit to consider a double patenting prohibition a general principle.

33. Further, the states that do not allow it usually use the wording “to the extent that it protects the same invention”. Whether all states have the same interpretation of this sentence is not known. E.g., if the national appl is narrower than the EP, the narrower only mentions a species, and the later EP does not describe the species but only the genus and claims priority from the national appl (validly granted due to G 1/15, also for the specific state), there may be differences. Thus, an unknown number of EPC states that have a double patenting prohibition, may actually allow some types of double patenting that are -under the national law concerned- to the extent that it does not protect the same invention”, i.e., where the claims are not identical, or where the EP is broader than the national appl, or where the EP is narrower (so less vulnerable for late-discovered prior art), or due to difference categories (a method claim extending the scope to the product directly obtained vs a product claim extending to all methods to make the product).
34. Extension states and validation states are equally relevant as the EP may also lead to a (national) patent there, even though not mentioned in Art.125 EPC:
- Morocco: The coexistence of a national patent and a validated patent is not excluded.
  - Republic of Moldova: The co-existence of a national patent and a validated European patent is not excluded
35. The prohibition of double patenting is not a principle of procedural law generally recognised in the Contracting States; a significant number of Contracting States allow double patenting.

***Legitimate interest – what Art.54(2) and 54(3) EPC teach us***

36. Article 60(1) and (2) EPC and Art. 52(1), 54(2)-(5) EPC, in particular 54(2) and (3), together provides who gets a patent. The first-to-file principle of Art.60(2) is implemented in Art.52 and 54(2) and (3). In Art.52 and 54(2) and (3), the novelty and prior art/right requirements give no exceptions for applications filed by the same or by different applicants. Art.60(2) makes such a distinction, but this can be understood as there is no need to specify who has the right for a patent if there is only one inventor or successor in title / applicant.
37. Article 60 - Right to a European patent – reads:
- (1) The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee, [...]*

*(2) If two or more persons have made an invention independently of each other, the right to a European patent therefor shall belong to the person whose European patent application has the earliest date of filing, provided that this first application has been published.*

*(3) In proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right to a European patent.*

38. Thus, from Art.60 alone, one can conclude that the applicant exercises the inventor's or his successor in title's right to an EP patent (or rather, an undefined number of EP patents) which right is executed by the applicant), but that he loses the right if someone else filed an EP patent application for the same invention earlier – this being implemented via the novelty article.
39. As the EPC provides in Art.60, and implements via Art.54, that the applicant has the right, it is factually and legally not sound to conclude that the EPC does not have a provision for double patenting. On the contrary, Art.60 gives the applicant the right to as many EP patents as he wishes. Trying to invoke any other provision, be it Art.125 or any other provision from the EPC or outside the EPC, goes against what the EPC itself provides. It would be similarly strange if someone concludes that it is a general principle in EPC states that EP applications are filed between 7:00 am and midnight, such that any application filed between midnight and 7:00 is not validly filed, or would get the preceding day as the filing date. If there would be a need for a prohibition of double patenting by the EPC, the EPC would need to be amended, in particular Art.60 and/or Art.54.
40. There cannot be any objection in the following situation. An applicant files a first EP application directed to a first invention on a first date, describing in an enabling manner, for the first time, an invention in broad terms (e.g., a broad numerical range), claiming the same, and resulting in a grant. At some moment after the filing of the first application, the same applicant filed a second EP application, which could be considered a selection invention: it describes and claims a narrow range with a new and surprising effect in that range. The second EP application also results in a grant.
41. The only relevance for both applications to get granted, assuming that they are not filed on the same day, is that the narrow claim is filed after the broad claim. There is no relevance which of the two gets granted before the other. Thus, a grant to a broad claim does not prohibit a later grant to a narrow claim (within the scope of the broad claim), as long as the broad and narrow claims are novel and inventive. Likewise, does grant to a narrow claim not prohibit a later grant to a broad claim (encompassing the scope of the narrow claim), as long as the broad and narrow claims are novel and inventive. So, there is not a single valid reason

to not allow double patenting of an invention as claimed by the narrow claim by a specific claim to that narrow range and a more generic claim to the broad range encompassing the narrow range. There is nothing in the EPC that would make the time between the first and the second application relevant as long as the narrow application is filed after the broad application, be it after the publication of the first, before publication of the first, outside or within the priority period from the first (priority will not be valid for the narrow claim), or just one day.

42. As novelty (and inventive step) is not affected if the narrow application is not filed after, but at the same time, as the broad application, there is no effect on the allowability under Art.52-57 EPC. As the novelty article the prior art articles Art.54(2) and Art.54(3) are generally accepted as implementing “the first to file gets the patent, provided the application got published” of Art.60(1) and (2), the EPC provides explicitly that an EP patent is to be granted for any novel application. As 60(1) does not impose any limitation on the number of patents that can be granted to one, or more, applicants, the article also provides that the two patents should be granted “if file on the same day”.
43. There is nothing in the EPC that limits the right to the patent to something less than what is provided by the EPC itself by Art. 60(1) EPC (as implemented in the system of Art.54(2) and 54(3), effective date (priority Art 87(1); divisional Art.76(1)), novelty and inventive step.

### **Second question (2.1)**

44. The second question reads:

*If the answer to the first question is yes, what are the conditions for such a refusal and are different conditions to be applied where 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?*

45. It is noted that b) and c) are phrased in such a way the question not symmetrical between parent and divisional in (b) or priority application and subsequent application in (c). The asymmetry is assumed not to be intentional. It is proposed to rephrase the question as:
- If the answer to the first question is yes, what are the conditions for such a refusal and are different conditions to be applied where the European patent application under examination*

was filed

a) on the same date as, or

b1) as a European divisional application of first or higher generation in respect of, or

b2) as the parent application in respect of a European divisional application that is, or

b3) one of the patent applications in one or more chains of divisional applications (arising out of the same “founding” parent application) of which one is, or

c1) claiming the priority in respect of, or

c2) is the priority application for,

a European patent application on the basis of which a European patent was granted to the same applicant.

such that the question covers an earlier grant of any of all “EP family” members of the European patent application under examination.

46. For c), The Case Law Book (2016) II.F.5 “Double patenting” writes:

*For the matter of double patenting arising not from the filing of a divisional application but from **internal priority** see T 1423/07, in which the board held that double patenting was not prohibited for European applications claiming a European priority because of the applicant's clear legitimate interest in the longer term of protection possibly available with the later filing, in view of the fact that the filing date and not the priority date was the relevant date for calculating the 20-year term of the patent (see also T 2461/10, which also concerned a case of internal priority and which left this point open).*

## Second question – related situations and/or aspects

47. Apart from 2c, other situations with double or overlapping protection may arise:

48. Legitimate interest may well be argued for each of the following situations (a = two w same date/same pri; b = parent div; c = internal pri):

- a, b, c:

- Broad first, narrow later

- (1) Narrow is more robust; broad may always not be amendable

- Narrow first, broad later

- (1) Legitimate interest = broader scope

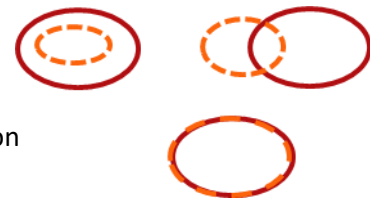
- (2) Disclaimer needed? Would usually be allowed G 2/10, but what if not possible?

- The Enlarged Board is requested to further expand on the suggested need for a disclaimer in G 2/10 r.4.5.5: “With this proviso, i.e. subject to the claimed



subject-matter fulfilling the requirements of the EPC, the applicant is free, i.e. he is entitled, not to claim protection for an embodiment or even a part of the disclosed invention. The applicant may, for example, be interested in obtaining a first quicker protection for a preferred embodiment and pursue the general teaching in a divisional application. *Whether or not and, if so, under what circumstances, in such a case a disclaimer would be necessary in order to avoid the so-called prohibition on double protection is a different matter.* It is sufficient to say that such procedural behaviour is not abusive and even legitimate.”

- a, b, c: narrow & within
- a, b, c: partial overlap
- c: interval pri: different states CS/ ext / val
- a, b, c: Depending and/or overlapping scope of protection
  - Equivalent with same scope of protection
  - If a double patenting prohibition would apply: Is it relevant that the subject-matter is the same, or that the scope of protection is the same?
  - If a double patenting prohibition would apply: Is it relevant that the subject-matter of one is fully or is encompassed by the other?
- a, b, c: An objection could easily be circumvented by transferring of second EP before grant, so different applicants; or by adding an applicant of convenience to not have exactly the same applicants (as required for a divisional but only at the moment of filing): is identity of applicants required, at which moment(s) in time, what is the effect of any transfer?
  - 1st application applicant A, second application applicant A+B
  - 1st application applicant A, second application applicant B (after transfer)
- a, b, c: Different designations
  - Internal priority around a day of accession or entry into force of a validation agreement
  - Earliest grant with less (i.e., withdrawn) designations
  - Earliest grant with less (still active) validations; before / after UPC into force
- a, b, c: Earliest grant was opposed and claims are to be amended:
  - Legitimate interest is to maintain the (earliest granted) patent in amended form
- Note: Euro-PCT vs one or more national entries (patent or utility model) is covered by PCT / national law



***Mere (partial) overlap***

49. For a mere (partial) overlap, the Case Law Book (2019) II.F.5 “Double patenting” writes:  
*“The technical boards have several times considered the notion of the "same subject-matter". A mere (partial) overlap does not prejudice the grant of a patent (see T 587/98, OJ 2000, 497; T 877/06; T 1491/06; T 1391/07; T 2402/10; T 2461/10; T 1780/12; T 621/15). See in this chapter II.F.5.2. On the relevance of the scope of protection for the issue of double patenting, see e.g. T 1780/12 and T 2563/11.”*
50. Case Law Book (2019) II.F.5.2 “Different subject-matter and scope of protection; overlapping subject-matter” gives a wide range of decisions, some of which allowing overlapping scope, some not. Clarity on this matter is highly needed.
51. E.g., this section in the Case Law Book, first paragraph:  
*“In T 118/91 and T 80/98, care was taken to avoid any risk of double patenting by ensuring that the subject-matter of the divisional application differed from that of the parent application. In T 118/91, in particular, the board stated that it could find nothing to support the contention that features forming part of the subject-matter of the divisional application could not be the subject of a dependent claim in the parent application. “*
52. Also, in the same section in the Case Law Book, second paragraph:  
*“In T 587/98 (OJ 2000, 497) the examining division, relying on the Guidelines prohibiting "conflicting" claims, had refused a European patent application, filed as a divisional application, on the grounds that its subject-matter overlapped with that of the parent application and that in the overlapping region the same subject-matter was claimed; as legal basis for the refusal it invoked Art. 125 EPC. **The board held that Art. 125 EPC was not applicable to the case at issue since this article required "the absence of procedural provisions in the Convention" but the provisions governing divisional applications were self-contained and complete.** In addition a prohibition of "conflicting" claims in the wide sense applied by the examining division would be a matter of substantive law rather than a matter of procedure - and Art. 125 EPC was not applicable to substantive law. The board also found that there was no express or implicit provision in the EPC which prohibited the presence in a divisional application of an independent claim - explicitly or as a notional claim arrived at by partitioning of an actual claim into notional claims reciting explicit alternatives - which was related to an independent claim in the parent application (or patent, if it had already been granted) in such a way that the "parent" claim included all the features of the "divisional" claim combined with an additional feature.”*
53. However, in the same section in the Case Law Book, 6th paragraph:

*“In T 2402/10 the respondent raised an objection of double patenting, since claim 1 had been amended during the opposition/appeal proceedings in such a manner that its scope fully **encompassed** the scope of the claims of the patent granted from the grandparent application. The board recalled the well-established case law that a principle of prohibition of double patenting existed on the basis that an applicant had no legitimate interest in proceedings leading to the grant of a second patent **for the "same subject-matter"** (G 1/05, OJ 2008, 271; G 1/06, OJ 2008, 307; see also T 1391/07, T 877/06, T 1708/06, T 469/03). In the case at issue, claim 1 contained technical features not required by any claim of the patent granted from the grant parent application. **Since the patent granted from the grant parent application and the patent in suit claimed different subject-matter, the question of double patenting could not arise.** The board noted that the respondent also referred to the headnote of T 307/03, according to which a double patenting objection could also be raised where subject-matter of the granted claim was encompassed by the subject-matter of the claim later put forward. **The board, however, saw this as no reason to depart from the mandatory requirement of "same subject-matter" invoked in decisions G 1/05 and G 1/06 and in the established case law.**”*

54. T 2402/10 thus distinguishes from T 307/03 based on “same subject-matter” invoked in G 1/05 and G 1/06. As a species is not the same as a parent, T 2402/10 allowed a later patent with a narrow scope fully encompassed within the broad scope of the earlier granted patent.

55. Whether that interpretation of “same subject-matter” is still correct since the partial priority decision G 1/15 may be doubted, in particular as G 1/15 addressed the relevance of identify between a conceptual **part** (rather than the complete claim) in the later application and subject-matter in the priority application.

Comments from the Enlarged Board to this aspect would be very much welcomed.

56. Likewise, whether that interpretation of “same subject-matter” is still correct since the disclaimer decision G 1/03 may be doubted, in particular in view of its reason 4: “Therefore, its introduction is allowable also when drafting and filing the European patent application **without affecting the right to priority from the first application**, which does not contain the disclaimer.”

Comments from the Enlarged Board to this aspect would be very much welcomed.

57. T 2402/10 referred to G 1/05 and G 1/06, to clarify that a broad and narrow claim are not the same subject-matter and that a “double protection” of the narrow region by both is thus not considered “double patenting”.

58. But, G 2/10, r.4.5.5 reads:

*With this proviso, i.e. subject to the claimed subject-matter fulfilling the requirements of the EPC, the applicant is free, i.e. he is entitled, not to claim protection for an embodiment or even a part of the disclosed invention. The applicant may, for example, be interested in obtaining a first quicker protection for a preferred embodiment and pursue the general teaching in a divisional application. Whether or not and, if so, under what circumstances, in such a case a disclaimer would be necessary in order to avoid the so-called prohibition on double protection is a different matter. It is sufficient to say that such procedural behaviour is not abusive and even legitimate. The amici curiae also mentioned other possible reasons not related to the requirements for patentability for splitting an application up into different applications for different embodiments, for instance for licensing purposes.*

*Taking it to the extreme, if the idea were correct that a disclosed embodiment of the invention could not be disclaimed because it was presented in the application as part of the invention, then as a result no limiting amendment of a claim would be possible at all, since even in the case of a limitation by positively defined features the situation is that through this limitation something is excluded from the claim which was previously presented as being part of the invention. If by contrast, an embodiment is presented in the application as filed as not being part of the invention, but e.g. as belonging to the state of the art or as a comparative example, then it cannot be claimed at all.*

59. In the context of the current referral, the comment “*Whether or not and, if so, under what circumstances, in such a case a disclaimer would be necessary in order to avoid the so-called prohibition on double protection is a different matter*” in r.4.5.5 of G 2/10 needs further clarification. Comments from the Enlarged Board to this are very much welcomed.

### ***Manufacturing method and product claim – overlapping scope***

60. Case Law Book (2019) II.F.5.2 “Different subject-matter and scope of protection; overlapping subject-matter” writes:

*In T 1766/13 the board held that, with respect to the case at issue, a product and a method for its manufacture were not “the same subject-matter” in the sense of G 1/05 and G 1/06. According to T 1765/13, the same was true for the use of a product and a method of fabricating it. For a further case where parent application and divisional application did not relate to the same subject-matter, see T 1708/06*

61. Here, the scope of protection of the product claim comprises any method of making it, thus double protection arises from both claims. However, as the claims are directed to different subject-matter -already in view of them being in different categories- they are not “the same subject-matter” and thus cannot lead to a double patenting objection.

***Same subject-matter***

62. From the above, it is clear that an important element in deciding double patenting -if there would be such a prohibition- would be as to what the legitimate interest objection would need to be based on:
- Same subject-matter, in the sense of identical subject-matter, 1:1
  - Same scope of protection, also taking into account Art. 69 EPC and the Protocol, so including non-identical but equivalent subject-matter, i.e. identical scope, 1:1
  - Full or encompassed subject-matter, in the sense of genus-species
  - Full or encompassed scope of protection, including Art.64(2) EPC extending the scope of a method claim to a directly-obtained product, and including that the scope of protection of a product claim encompasses all possible methods of making those as well as all possible uses
63. Most of the case law cited in Case Law Book (2019) II.F.5.2 uses a very strict “same subject-matter” approach.
64. However, if lack of legitimate interest in protection the same thing twice is the relevant requirement, then it should be “same scope” that is the determining factor, as that defines the right that the patent gives – Art.69 EPC and its Protocol. That would however bar an applicant from getting two patents to two equivalents which are technically different if they are filed on the same day, but not if filed 1 day apart – where one is just an Art.54(3) prior right vs the other.
65. If a double patenting prohibition exists, it should thus not be relevant whether the claims of the European patent application and the other European patent granted to the same applicant are literally the same, are differently worded but have the same scope, are partially overlapping, are within the scope of the other, or fully encompass the scope of the other.
66. An answer to this question as to what the objection should be based on (subject-matter or scope of protection) is highly needed, if the Enlarged Board considers double patenting to be a ground for refusal under the EPC. Without such clarification, uncertainty for all stakeholders would remain.

**Third question (2.2)**

67. The third question reads:

In particular, in the latter case, does an applicant have a legitimate interest in the grant of 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 6(1) EPC.

68. The question is only relevant if the Enlarged Board would consider that a European patent application can be refused for the reason that claiming the same subject-matter as a European patent granted to the same applicant (double patenting objection) can be objected to under Article 125 EPC jo. lack of legitimate interest in two patents for the same invention as being considered a general principle of procedural law in contracting states -which is doubted in the detailed submission above-.
69. In that case, in my opinion, it would not be up to the EPO Examining Division to decide whether the applicant has an interest and whether the interest is legitimate, but to the applicant himself and the applicant alone.
70. In particular, in case c1/c2, the applicant may have a legitimate interest in the grant of the (subsequent) European patent application. Such legitimate interest may, for example, reside 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, or in a different territorial scope at the date of filing due to the accession of a new EPC Contracting state (a) or due to a new Extension or validation agreement getting into force in the meantime (a). Such legitimate interest may, for example, reside in view of the fact that the applicant did not validate the earlier granted patent in all EPC states and now wants to validate the later granted patent in more, or different, countries.
71. Further examples are given above.

## Conclusions

72. In my opinion, the questions should be answered as follows, and -if the Enlarged Board considers Double patenting a ground for refusal- further clarification is needed from the Enlarged Board:
  1. A European patent application **cannot be refused** under Article 97(2) EPC for the reason that it claims the **same** subject-matter as a European patent granted to the same applicant which does not form part of the state of the art pursuant to Article 54(2) and (3) EPC.
    - 2.1 It is not relevant whether European patent application under examination was filed
      - a) on the same date as, or
      - b1) as a European divisional application of first or higher generation in respect of, or
      - b2) as the parent application in respect of a European divisional application that is, or

b3) one of the patent applications in one or more chains of divisional applications (arising out of the same “founding” parent application) of which one is, or

c1) claiming the priority in respect of, or

c2) is the priority application for,

a European patent application on the basis of which a European patent was granted to the same applicant.

- 2.2 If the Enlarged Board would however consider that a European patent application can be refused for the reason that claiming the same subject-matter as a European patent granted to the same applicant (double patenting objection) can be objected to under Article 125 EPC jo. lack of legitimate interest in two patents for the same invention as being considered a general principle of procedural law in contracting states -which is doubted in the detailed submission below-, it would not be up to the EPO Examining Division to decide whether the applicant has an interest and whether the interest is legitimate, but to the applicant himself and the applicant alone.

In particular, in case c1, the applicant may have a legitimate interest in the grant of the (subsequent) European patent application. Such legitimate interest may, for example, reside 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, or in a different territorial scope at the date of filing due to the accession of a new EPC Contracting state (a) or due to a new Extension or validation agreement getting into force in the meantime (a). Such legitimate interest may, for example, reside in view of the fact that the applicant did not validate the earlier granted patent in all EPC states and now wants to validate the later granted patent in more, or different, countries.

- 2.3 Also, it is not relevant whether the claims of the European patent application and the other European patent granted to the same applicant are literally the same, are differently worded but have the same scope, are partially overlapping, are within the scope of the other, or fully encompass the scope of the other.

- 2.4 If the Enlarged Board would however consider that a European patent application can be refused for the sole reason that it claims the same subject-matter as a European patent granted to the same applicant (double patenting objection), a detailed and exhaustive definition would be appreciated of this so-called double patenting prohibition, covering e.g.:
- a) is it limited to exactly identical same subject-matter (same technical meaning of the claims) or does it also extend to the same scope of protection with different subject-matter (as T 1391/07 held; e.g., due to equivalence),
  - b) does it include non-identical but overlapping subject-matter:

- b1) “dependent” subject-matter: overlapping with one scope fully contained in the other (narrow first, broad later; broad first, narrow late), e.g. 1-10% vs 3-5%, or X vs X+Y
- b2) true overlap: overlapping without one scope fully contained in the other, e.g., X+Y vs X+Z, both comprising X+Y+Z
- c) does it include subject-matter that is only different by a disclaimer;
- d) is it relevant whether the designated states (EPC states, extension states, validation states) are the same at the time of filing, at the time of grant, or at the time of the second refusal (when the earlier granted patent may already have lapsed in some states); ...
- e) what is the relevant scope of the earliest grant if that is later limited in opposition, in central limitation or revoked: if only the subject-matter at the date of grant EP1 is relevant, and the later grant EP2 is to a narrow scope, can the proprietor of the earliest grant EP1 than not limit to the claims of EP2? Is it relevant what the order of narrow and broad grant is?
- f) would the prohibition also apply in opposition?
- g) the relevance of identify of applicants: does the prohibition only apply if the applicants are the same, or also if there is one applicant less or more? What is the effect of transfers of the patent application under examination and/or of the earlier granted patent before or after grant)?

Looking forward to your considerations and your decision/opinion,

Kind regards,



Roel van Woudenberg  
European Patent Attorney  
DeltaPatents  
1 September 2020

**Annexes**

Printouts of the following presentations, webpages and blogs, including comments, are attached:

- “Double patenting”, Jürgen Scheuer and Gershom Sleightholme-Albanis, WS10 at “Examination Matters 2016”, 14-15 June 2016, The Hague, The Netherlands
- “Double Patenting at the EPO - a new view”, David Pearce, March 20, 2009, IPKAT ([ipkitten.blogspot.com/2009/03/double-patenting-at-epo-new-view.html](http://ipkitten.blogspot.com/2009/03/double-patenting-at-epo-new-view.html) )
- “Derk Visser on Double Patenting”, David Pearce, March 24, 2009, IPKAT ([ipkitten.blogspot.com/2009/03/derk-visser-on-double-patenting.html](http://ipkitten.blogspot.com/2009/03/derk-visser-on-double-patenting.html))
- “Further developments on double patenting at the EPO”, David Pearce, April 30, 2010, IPKAT ([ipkitten.blogspot.com/2010/04/further-developments-on-double.html](http://ipkitten.blogspot.com/2010/04/further-developments-on-double.html))
- “Breaking: New referral to the Enlarged Board of Appeal on double-patenting”, Rose Hughes, February 22, 2019, IPKAT ([ipkitten.blogspot.com/2019/02/breaking-new-referral-to-enlarged-board.html](http://ipkitten.blogspot.com/2019/02/breaking-new-referral-to-enlarged-board.html))
- “T 1765/13 - Twins or clones? ”, Roel van Woudenberg, 13 May 2014, DeltaPatents Case Law Blog (<https://dp-patentlaw.blogspot.com/2014/05/t-176513-twins-or-clones.html>)
- “T 1780/12 - Antibodies for cancer treatment - double patenting?”, Nico Cordes, 16 May 2014, DeltaPatents Case Law Blog (<https://dp-patentlaw.blogspot.com/2014/05/antibodies-for-cancer-treatment-double.html>)
- “T 879/12 - Again, no double patenting ”, Roel van Woudenberg, 12 September 2014, DeltaPatents Case Law Blog (<https://dp-patentlaw.blogspot.com/2014/09/t-87912-again-no-double-patenting.html>)

## WS10 Double patenting

*Technical area: suitable for all technical backgrounds*

Double patenting – one applicant having two patents for the same invention – is not mentioned anywhere in the EPC, but applications can be refused because of it. This makes the issue intriguing. This workshop aims to help applicants understand current EPO examination practice. The Enlarged Board of Appeal has accepted obiter dictum the principle of prohibition of double patenting, at least for divisional applications, but has not ruled explicitly on the subject. The issue of double patenting normally arises in the case of divisional applications, but this is not the only route. For comparison's sake, German practice on double patenting (as distinct from double protection) will be considered, and the procedural law with respect to the principle of legitimate interest will be discussed. Certain decisions of the boards of appeal amongst the increasing body of case law on double patenting, including conflicting ones, will be examined in an attempt to show that the case law is converging. The current Guidelines for Examination concerning double patenting will be explained, focusing on the meaning of “identical subject-matter”. Various examples will be given to show when subject-matter is identical, and when it is not. A discussion on some as yet unresolved issues will conclude the workshop.

**Jürgen Scheuer**, DE, examiner, Vehicle Technology, EPO Berlin. Obtained a degree in mechanical engineering at RWTH Aachen. Worked as a project manager for Faurecia SA from 1995 to 2000 in Audincourt and Ingolstadt. Joined the EPO in 2000, where he is involved in and chairs numerous opposition and examination proceedings in various technical fields.



**Gershom Sleightholme-Albanis**, UK/AU, examiner, Vehicle Technology, EPO Berlin. Holds a degree in mechanical engineering from the University of Melbourne and a doctorate from the University of Cambridge. Worked for several years in the steel industry, at Jaguar Cars and in the British civil service prior to joining the EPO in 1996.





Europäisches  
Patentamt  
European  
Patent Office  
Office européen  
des brevets

# Examination Matters 2016

## Double patenting



Jürgen Scheuer and Gershom Sleightholme



Examiners in Vehicle Technology



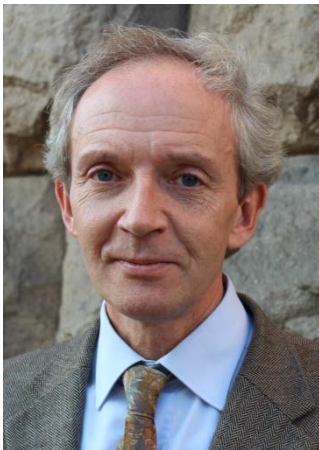
14-15 June 2016

# Speakers



**Jürgen Scheuer**, DE, [jscheuer@epo.org](mailto:jscheuer@epo.org)

- Joined the European Patent Office in 2000, involved in chairing numerous opposition and examination proceedings in various technical fields.
- He worked as a project manager for Faurecia SA from 1995 to 2000 in Audincourt and Ingolstadt.
- Degree in Mechanical Engineering from RWTH Aachen (DE).



**Gershom Sleightholme**, GB/AU, [gsleightholme@epo.org](mailto:gsleightholme@epo.org)

- Joined the European Patent Office in 1996, currently working in the field of vehicle technology.
- Worked for several years in the steel industry, at Jaguar Cars and in the British civil service.
- Degree in Mechanical Engineering from the University of Melbourne; doctorate from the University of Cambridge.

# Contents

- **Definition: double patenting vs. double protection**
- Legal basis (EP and national)
- German practice
- How can double patenting happen?
- Case law
- Current EPO practice
- Conclusions

# Double Patenting

- Principle:

**No patent**  
for the **Same** invention  
having the **Same** date  
by the **Same** applicant  
with the **Same** 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 filed by the same applicant ([Article 139\(3\) EPC](#))
- Example: DE of the same applicant is 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 is 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 [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

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# 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
  - ...
- 
- 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

## The Vienna Convention on the Law of Treaties

- is 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](http://webserv.epo.org/projects/babylon/tpepc73.nsf/0/ED6B3BE8DD340281C1257427004818ED/$File/Art125eTPEPC1973.pdf):

665. 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.

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# German practice

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

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

## Federal Patent Court (Bundespatentgericht)

- 23W (pat) 703/03 (07.08.2003)
  - Double patentings – 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

Federal Patent Court (Bundespategericht)

- 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

## 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)

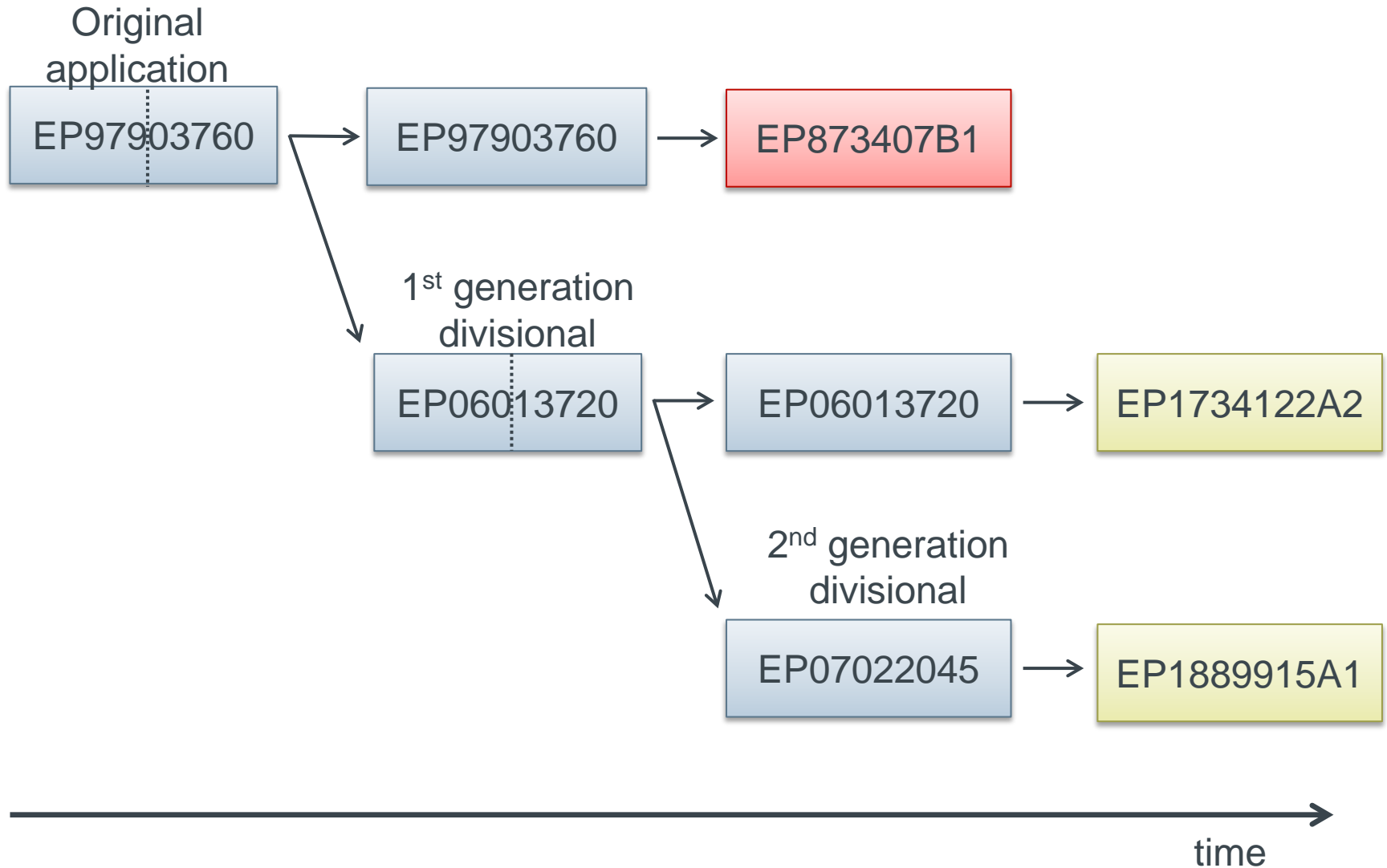
# Contents

- Definition: double patenting vs. double protection
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- **How can double patenting happen?**
- Case law
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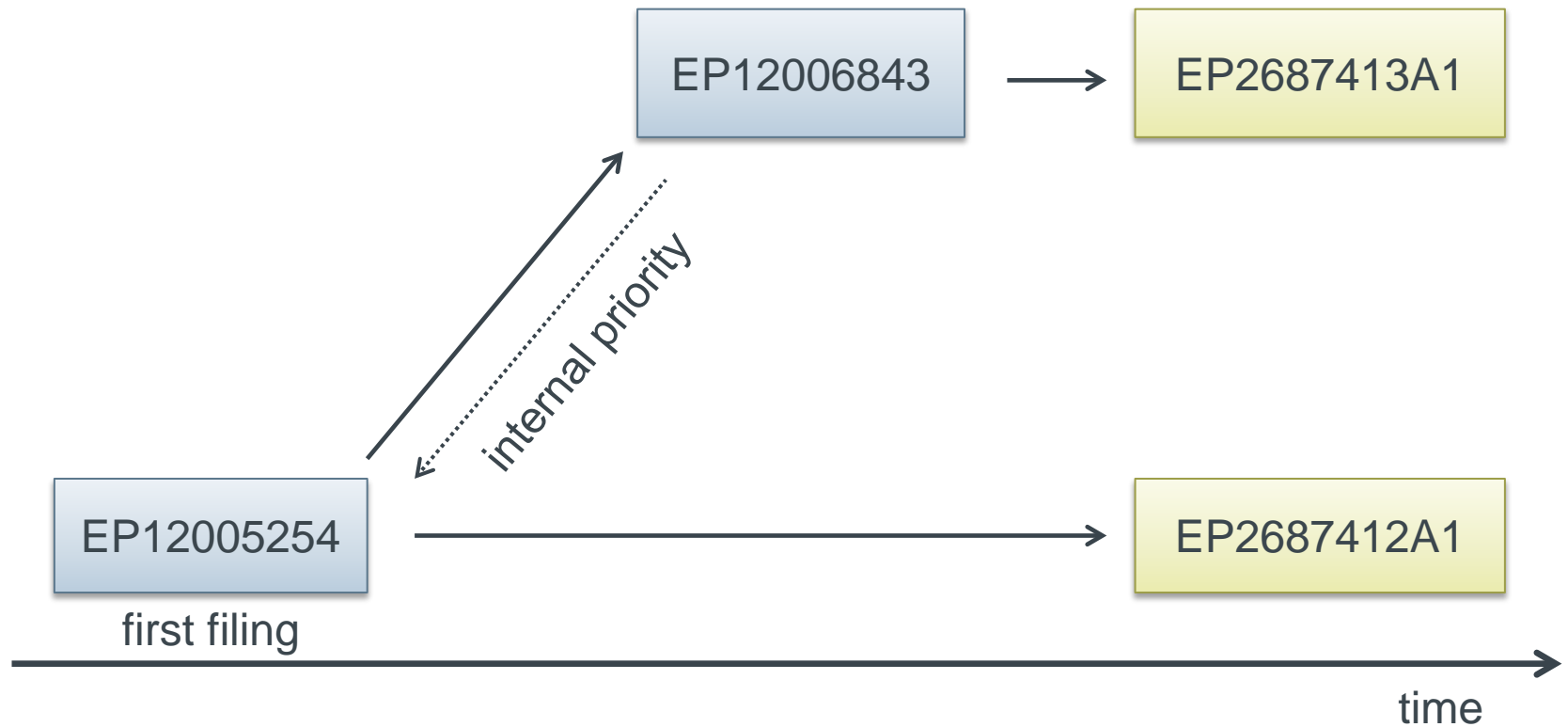
# How can double patenting happen?

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

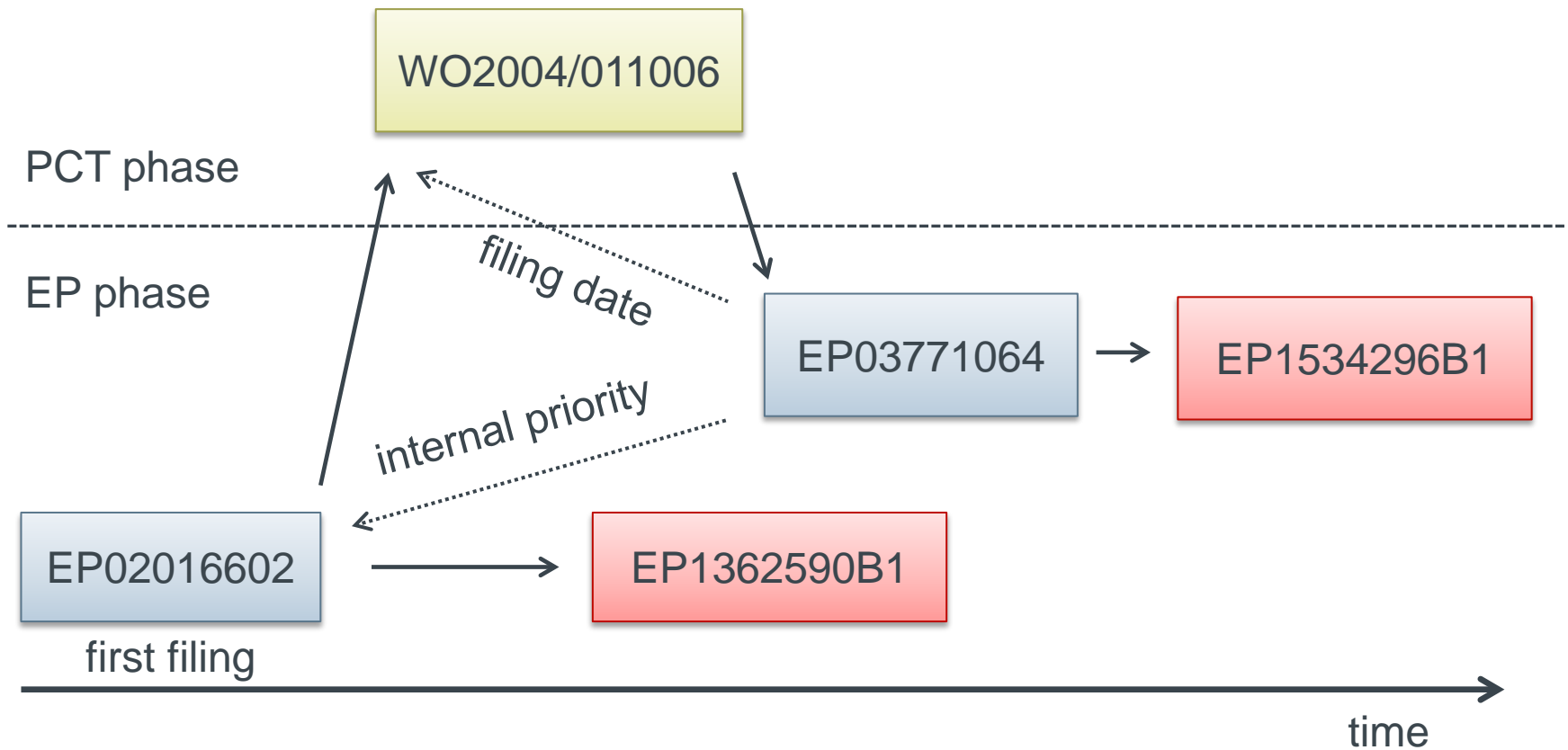
# Divisional application (T0879/12)



# Internal priority type 1



# Internal priority type 2 (T1423/07)



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## 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 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 related to double patenting explicitly, but to filing of and amendments to divisional applications.
  - Nevertheless the Enlarged Board 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 can not 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 DG3.

## 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) 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 (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 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.
  - DG3: 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).

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# Current EPO practice

[Guidelines, G-IV, 5.4 Double patenting](#) (November 2015)

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

# 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):
  - “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).”

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# Conclusions

- The principle of the prohibition of double patenting is now generally 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 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 probably also covers the special case of related applications linked by internal priority (see T2461/10, section 14; T1155/11, section 22).

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Home / double patenting / epo / patents / Double Patenting at the EPO - a new view

## Double Patenting at the EPO - a new view

David Pearce Friday, March 20, 2009 - double patenting, epo, patents

It is generally thought at the EPO that it is a Bad Thing to have two patents granted to the same applicant to cover the same invention. This is known as Double Patenting, and there are provisions under national law to prevent this from happening (section 18(5) of the UK Patents Act 1977, for example). Unfortunately for the EPO (and as confirmed by T 587/98), there is no such provision in the EPC. Or so the IPKat thought.

According to the recently issued decision **T 307/03** (currently available from epoline on application 00118123.9, and from the IPKat's file store here), it is Article 60 EPC that we should be looking at (and not, as the IPKat previously thought, Article 125). The Board's reasoning is as follows:

“Article 60 EPC (identically worded under the EPC 1973 and 2000) states 'The right to a European patent shall belong to the inventor or his successor in title' [...] From this the Board deduces that under the EPC the prohibition of double patenting applies and that the inventor (or his successor in title) has the right to the grant of one and only one patent from the European Patent Office for a particular invention as defined in a particular claim. Once a patent has been granted to the inventor (or his successor in title) this right to a patent has been exhausted, and the European Patent Office is entitled to refuse to grant a further patent to the inventor (or his successor in title) for the subject-matter for which he has already been granted a patent" (point 2.1 of the reasons) ”

The IPKat will leave others to determine whether this reasoning is sound or not, but in the meantime he would like to suggest that it might be time to ask the Enlarged Board a couple of questions, since we now have two decisions that clearly arrive at different answers to the same question. These questions could, for example, be:

- “
1. If 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, does the EPC have a provision to, on that ground, refuse to grant a patent in pursuance of more than one of the applications?
  2. If so, what is this provision and how should it be applied?
- ”

Does anyone out there have a suitable appeal in which these questions can be raised?

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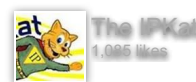
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- Selected by United States Library of Congress for inclusion in its historic collections of materials related to Legal Awards 2010.
- Top Patent Blog poll 2009: 3rd out of 5
- "Favourite Patent Blog" poll and 2nd out of 5
- "Most-read" poll.
- ComputerWeekly IT Law and Governance **the Year**, 20 August 2008.
- **Best of the Blogs**, Times Online, 21 August 2008





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16 Comments:

Anonymous

Friday, 20 March 2009 at 10:24:00 GMT

This decision does not at all solve the issue and because of the unconvincing and also otherwise problematic basis (Article 60 belongs to Chapter II of the EPC which relates to entitlement to apply and obtain a Patent rather than excluding anything: it even allows double patenting for the same invention by two different inventors when the application has the same filing date) most certainly will not be followed by other Boards.

Although there appears to be nothing against refusing identical claims from one applicant the issue becomes more complicated when, for example, overlapping claims are concerned or claims have to be amended in opposition and appeal proceedings. Simply refusing those on the basis of the conclusions of T307/03 appears highly questionable.

[Reply](#)

Graham

Friday, 20 March 2009 at 10:47:00 GMT

I am not at all sure about interpreting "a European patent" as "one and only one European patent". Can we use the same logic to infer that Article 58 EPC, which says "a European patent application may be filed by any natural or legal person", means that any person can file "one and only one" patent application, and once you have filed a patent application, that's your lot, your rights are exhausted and you can't file any more European patent applications? I think the Board in T 307/03 have read more into the word "a" than the drafters of the EPC intended.

[Reply](#)

Anonymous

Friday, 20 March 2009 at 12:10:00 GMT

back to basics, EP patent comes into force upon validation, which is governed by national laws, so EPC does not need to include an exclusion on the basis of double patenting. So while one may file a second patent application claiming a previously patented invention, depending on the national law, its validation in individual member countries would not be valid at all. Article 60 details on entitlement of patent filing period. Article 125 is too general to specify any exclusion period.

[Reply](#)

Anonymous

Friday, 20 March 2009 at 12:47:00 GMT

This reminds me of the decision on claiming priority only once.

Looking at the on-line file, it appears that the oral proceedings were in July 07. The written decision seems to have only just issued, in March 09.

Nearly 2 years to write a decision!

[Reply](#)

CynSkeptic

"Nearly 2 years to write a decision!" Friday, 20 March 2009 at 14:00:00 GMT

... that's how long it took them to come up with this lame Art. 60 justification for the decision they made at the time...?

[Reply](#)

Anonymous Friday, 20 March 2009 at 14:12:00 GMT

Although the patent application in question probably got what it deserved, if the decision is applied to refuse a divisional application because it has claims overlapping those of the parent it may be necessary to change an Applicant's patenting strategy. I have prosecuted cases where, for commercial reasons, a quick grant was required and the Applicant has prosecuted narrow claims to expedite acceptance and filed a divisional application in an attempt to obtain broader/overlapping claims. In the past the EPO has generally allowed such cases providing there has not been substantial identity of claims. If such cases are to be refused on the grounds of "double patenting" I wonder if we may have to explore a disclaimer to the claim of the parent. More questions for the Enlarged Board?

[Reply](#)

Anonymous Friday, 20 March 2009 at 14:50:00 GMT

I am afraid that the 3rd reaction is wrong: an EP patent has effect from its grant date and because of the grant by the EPO.

In EPC states that have an EPO language and that have joined the London Agreement (i.e. CH, DE, FR, GB, LU, MC), there is no validation whatsoever, and the same holds in other EPC states that have an EPO language (viz. AT, BE, IE) if the EP patent is granted in their national language. Anyhow, any "validation" is just filing a translation and paying a fee, without the national patent office having any right to look into the merits of the EP patent outside the framework of any revocation proceedings. The legal effects of any failure to meet any validation requirements are only that from the validation deadline, the patent is void ab initio, so that within the first 3 months from grant by the EPO the EP patent could have been used in court to get an injunction.

Also, an EP patent can only be revoked on the grounds listed in Article 138/139, so that e.g. Section 18(5) of the UK Patents Act 1977 cannot be used against an EP patent (apart from the fact that even under UK law it does not seem to be a revocation ground but only a ground for the Comptroller to refuse to grant a patent, which does not apply to EP patents as they are granted by the EPO rather than by the Comptroller).

While perhaps relying on Article 60 is somewhat too innovative, the same effect could perhaps be obtained on the basis of Article 125 in view of the general legal principle that without sufficient interest one does not have an action.

[Reply](#)

Anonymous Friday, 20 March 2009 at 15:23:00 GMT

This looks similar to the logic for double patenting rejections in the USPTO, based on 35 U.S.C. 101 "...may obtain a patent...". See MPEP 804 and 1504.06.

[Reply](#)

MaxDrei Saturday, 21 March 2009 at 09:15:00 GMT

So, on the day of oral proceedings, back in 2007, was there a knee jerk decision (the ratio to be worked out later), followed by two years of behind closed doors discussion with "interested circles" about whether European patent law should be "harmonised" with US 35 USC 101, justified by the need to wipe out a plague of cascading divisionals? Now we're all more relaxed about the number of divisionals, calm and reasoned logic can expose the absurdity of this decision. I see it as DOA, just like the "claim priority once, and that's your lot" decision. See how the Dutch courts deal with streams of divisionals: "Don't come back to my court again, Medinol, till you've got one of your endless string of divisionals past the TBA". BTW, what will the EBA do to the Brimelow Art 52 (ie 35 USC 101) questions now flying? Let's be optimistic shall we, folks, while the Americans struggle with the deficiencies of their 1952 Statute, let's enjoy the self-congratulatory feeling, that the elegant corpus of patent law found in the original 1973 EPC is once again seeing off a detractor.

David, why raise the questions. In civil law mainland Europe, a rogue decision is simply ignored, and then it "goes away". Does anybody today worry about the "just one chance to claim priority" rogue decision?

[Reply](#)

Anonymous Saturday, 21 March 2009 at 13:49:00 GMT

The comments of the Board relating to the possible withdrawal of the earlier granted patent are also, to me, somewhat inaccurate. Since the parent was revoked in opposition proceedings with this decision

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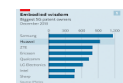
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 **Comments from the EPO President on the patentability of computer-implemented simulations (G 1/11)**

being under appeal, withdrawal of the appeal would mean that the patent would be revoked ex tunc so no double patenting objection could possibly arise.

Reply

Erik

Monday, 23 March 2009 at 17:53:00 GMT

When taking a peek in the Minutes of the Munich Diplomatic Conference (document M/PR/I) one can simply read the answers to the questions raised by David. Point 665 of the Minutes (Art. 125 EPC) reads the following:

“In connection with Article 125, it was established at the request of the United Kingdom that there was majority agreement in the Main Committee on the following: that it was a generally recognized 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.”

From this passage it follows that the international legislator regarded Article 125 EPC as the legal basis for a double patenting prohibition.

Surprising to see that more than 10 years after T 587/98, this passage never has been mentioned or discussed. Clearly, what is missing in the Guidelines (part C-IV par. 7.4) is a reference to Art. 125 EPC.

Reply

Derk Visser

Tuesday, 24 March 2009 at 15:26:00 GMT

The issue of double patenting was extensively discussed in the preparatory documents of the EPC 1973. Since double patenting was regarded as an issue relating to patents, not to patent applications, and the EPC did not relate to the maintenance of patents, it was left to the contracting states to permit or prohibit simultaneous protection (Travaux Préparatoires 1969, BR/7 e/69, p. 8 point 17). The Inter-Governmental Conference in 1972 endorsed this view, a large majority of the interested circles being in favour of this (BR/168/72). As a consequence, the EPC does intentionally not contain a prohibition on double patenting.

The board of the recent decision T307/03 was probably unaware of the above (see reason 2.3 of the decision). Hence, its attempt and probably any attempt, to base a prohibition of double patenting on the present EPC results in a contortion of the law.

Use of Art.60 as a basis for prohibiting double patenting in the recent decision T307/03 is legally not sound, because the provision relates to who has the right to a patent, not to the constitution of the right, as already stated in the first comment of this blog. The same applies to Art.58, which relates to who may file.

Art.125 cannot be used to introduce a prohibition on double patenting in the EPC, because the text of the provision makes abundantly clear that it relates to procedural matters only, not to substantive issues such as double patenting (see also T587/98 r.3.6). The statement on double patenting in relation with Art.125 in the Munich Conference, cited by Erik in the above contribution, shows that the UK delegation could benefit from some training in the EPC.

Art.139(3) is not intended as a general prohibition on double patenting. Its purpose is to avoid that for a single invention both a European and a national patent is granted. It was intended as a first step towards abolition of national patents (Travaux Préparatoires 1962, 3076/IV/62-D, p. 114a).

The sections C-IV,7.4 and C-IV,9.1.6 of the Guidelines are no basis for refusing an application on the ground of double patenting (T587/98 r.3.5 and 3.6).

The statement in decision G1/05 r.13.4 regarding a refusal on the ground of double protection as being non-objectionable, appears to be an oversight on the part of the EBoA.

The legislator clearly missed the opportunity of the EPC2000 to introduce the prohibition in the law. In spite of the clear statements of the legislator that double protection should be dealt with at a national level, most national laws do not have a provision to this end. It is surprising that such a broadly supported principle has not been codified at both international and national level. Hence, we will probably have to put up with case law stretching provisions far beyond the intention of the legislator.

Reply

Anonymous

Wednesday, 31 March 2010 at 09:16:00 BST

Very interesting Derk. Anybody know where I can find the Travaux Préparatoires for EPC 1973 online? The EPO only appears to have the Travaux Préparatoires for EPC 2000. Thanks!

Reply

Derk Visser

Tuesday, 25 January 2011 at 17:16:00 GMT

The Travaux Préparatoires of the EPC 1973 will be made available on the EPO website soon. Please check the website.

Reply



Eric

Friday, 22 February 2019 at 07:56:00 GMT

Board 3.3.01 has decided to refer a question to the Enlarged Board of Appeal, in connection with the issue of double-patenting. Decision T 318/14 is not published yet but the minutes are available on the EP register at <https://register.epo.org/application?number=EP10718590&lng=en&tab=doclist>

1. Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent granted to the same applicant which 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 where 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 latter case, does an applicant have a legitimate interest in the grant of 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?

Reply



Rose Hughes

Friday, 22 February 2019 at 12:10:00 GMT

Thanks Eric - see: <http://ipkitten.blogspot.com/2019/02/breaking-new-referral-to-enlarged-board.html>

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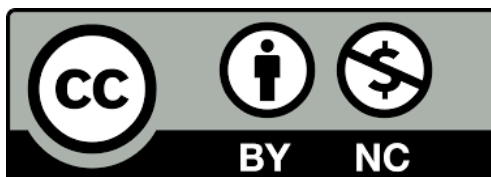
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Home / double patenting / epo / patents / Derk Visser on Double Patenting

## Derk Visser on Double Patenting

David Pearce Tuesday, March 24, 2009 - double patenting, epo, patents

The IPKat commented a few days ago on a recent, as yet unpublished, decision of the EPO Board of Appeal, in which the Board considered that Article 60 EPC provided basis for prohibition of double patenting. This prompted a few comments, including one apparently made by Derk Visser, a name which will be well known at least to all EQE candidates. Derk's comment is worth reproducing, if only for the benefit of those who do not keep track via the IPKat's comment feed. He writes:

“The issue of double patenting was extensively discussed in the preparatory documents of the EPC 1973. Since double patenting was regarded as an issue relating to patents, not to patent applications, and the EPC did not relate to the maintenance of patents, it was left to the contracting states to permit or prohibit simultaneous protection (Travaux Préparatoires 1969, BR/7 e/69, p. 8 point 17). The Inter-Governmental Conference in 1972 endorsed this view, a large majority of the interested circles being in favour of this (BR/168/72). As a consequence, the EPC does intentionally not contain a prohibition on double patenting.

The board of the recent decision T307/03 was probably unaware of the above (see reason 2.3 of the decision). Hence, its attempt and probably any attempt, to base a prohibition of double patenting on the present EPC results in a contortion of the law.

Use of Art.60 as a basis for prohibiting double patenting in the recent decision T307/03 is legally not sound, because the provision relates to who has the right to a patent, not to the constitution of the right, as already stated in the first comment of this blog. The same applies to Art.58, which relates to who may file. ”

“Art.125 cannot be used to introduce a prohibition on double patenting in the EPC, because the text of the provision makes abundantly clear that it relates to procedural matters only, not to substantive issues such as double patenting (see also T587/98 r.3.6). The statement on double patenting in relation with Art.125 in the Munich Conference, cited by Erik in the above contribution, shows that the UK delegation could benefit from some training in the EPC. ”

“Art.139(3) is not intended as a general prohibition on double patenting. Its purpose is to avoid that for a single invention both a European and a national patent is granted. It was intended as a first step towards abolition of national patents (Travaux Préparatoires 1962, 3076/IV/62-D, p. 114a). ”

“The sections C-IV,7.4 and C-IV,9.1.6 of the Guidelines are no basis for refusing an application on the ground of double patenting (T587/98 r.3.5 and 3.6). The statement in decision G1/05 r.13.4 regarding a refusal on the ground of double protection as being non-objectionable, appears to be an oversight on the part of the EBoA.

The legislator clearly missed the opportunity of the EPC2000 to introduce the prohibition in the law. In spite of the clear statements of the legislator that double protection should be dealt with at a national level, most national laws do not have a provision to this end. It is surprising that

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- ComputerWeekly IT Law and Governance **Best of the Year**, 20 August 2008.
- **Best of the Blogs**, Times Online, 21 August 2008.



such a broadly supported principle has not been codified at both international and national level. Hence, we will probably have to put up with case law stretching provisions far beyond the intention of the legislator." ”

The IPKat thanks Derk for his contribution, and wonders what led this particular Board to arrive at their apparently unsound line of reasoning, particularly when they had nearly 2 years to consider it. Is there more to it than meets the eye, or is this simply another 'rogue' decision that will be quietly swept under the carpet (or, perhaps, overturned by the Enlarged Board) in due course?

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18 Comments:

Anonymous Tuesday, 24 March 2009 at 21:17:00 GMT

There probably is more than meets the eye, in my opinion.

In T587/98 the board gave a solid reasoning on why the prohibition of double patenting has no basis in the EPC.

Nevertheless, in G1/05 (point 13.4), the enlarged board explicitly sanctions the practice in first instance of not allowing double patenting, but:

- it does not provide a legal basis for this practice
- it does not refer in any way to T587/98
- the question is only dealt with "en passant"

Therefore, maybe in order to clarify matters, it was necessary to have two incompatible decisions to fulfill the requirements of Art. 112(1)(b) EPC, and hence a bogus reason (come on, interpreting "a" as "one and only one" is pretty far-fetched) was found to nevertheless come to a different conclusion than T587/96 ?

Reply



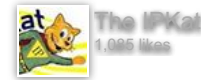
David Wednesday, 25 March 2009 at 06:40:00 GMT

I have no idea what made me spell Derk's name incorrectly. Apologies. Maybe I was thinking of Douglas Adams...

Reply

Anonymous Wednesday, 25 March 2009 at 08:19:00 GMT

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There is nothing more than meets the eye ...

The boards are completely independent from the president of the EPA and can refer any relevant question to the EBA on their own motion (A. 112(1)(a)EPC). They do not need two incompatible decisions for that.

This is nothing more than a strange decision that will very probably fade away with time ...

Reply

Anonymous

Wednesday, 25 March 2009 at 09:28:00 GMT

"In connection with Article 125, it was established at the request of the United Kingdom that there was majority agreement in the Main Committee on the following: that it was a generally recognized 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."

"The statement on double patenting in relation with Art.125 in the Munich Conference, cited by Erik in the above contribution, shows that the UK delegation could benefit from some training in the EPC".

Is it not oversimplistic to say that the UK delegation got it wrong ?

Is it not an issue of where does the limit between procedural matters and substantive issues lie, according to common law tradition as opposed to civil law tradition ?

In common law, is not everything basically a question of procedural law ?

Reply

Anonymous

Wednesday, 25 March 2009 at 10:37:00 GMT

It would be wise to consider what the consequences would be of allowing more than one patent for the same invention. Consider the question of oppositions at the European level (Art. 99 EPC). If a company is allowed to file divisional applications claiming the same subject matter as the previous "parent" application, this would lead to the existence of duplicated rights (with the same priority and filing dates as the parent patent - Art. 76) and would require a potential opponent to file more than one opposition and pay more than opposition fee in order to remove the IP rights to that subject matter. This is clearly unfair. Fairness is a matter of procedural law (re Art. 125) and it is also a generally accepted legal principle in the EPC member states (indeed the Enlarged Board mentioned the concept of the applicant having no "legitimate interest" in having more than one patent for the same invention). If a prohibition of double patenting cannot be interpreted as being a part of the EPC, then likewise it would not appear possible to consolidate opposition proceedings against multiple patents for the same invention - since this would require then same degree of interpretation of the EPC as a ban on double patenting requires.

It is unfortunate that the legislator did not see fit to resolve this in the EPC-2000 revision, however, the working group "Patente" (involved in the drafting of EPC\_1973) were unanimous in their opinion that double patenting was not acceptable and this can be seen in the travaux preparatoires to EPC\_1973. Furthermore, it is not advisable to simply dismiss the opinion of the Enlarged Board of Appeal, since although the statements made constituted an obiter dictum, they do carry significant weight, when considering their source, although again it is unfortunate that a legal source was not given as a basis for this obiter dictum.

I do agree that the use of Art. 60 in the latest decision would appear to be a distraction from the main issue. While T587/98 ruled out the application of Art. 125, I believe that this was not correct, because as indicated above, the issue of not granting multiple patents for the same invention is only indirectly a matter of substantive law (since it becomes necessary to assess whether or not an application is claiming the same invention as a granted patent), however, the reason behind the ban is one of fairness and "legitimate interest" and as such, IMHO, Art. 125 is applicable.

I share the desire of all sides of this debate for clarification and I would welcome the referral of this question to the Enlarged Board be it by a Technical Board of Appeal or by the President of the EPO.

Reply

MaxDrei

Wednesday, 25 March 2009 at 10:44:00 GMT

Some people mistakenly think that the "novelty" provision in any patent law is there to prevent "double patenting". Such people get excited about the use of divisionals because they think it is a loophole in the "no double patenting" law of novelty. They forget that you simply can't use divisionals to extend the 20 year max term on monopoly. We in Europe have Art 54(3) and so don't need to get involved in the American "double patenting" and "terminal disclaimer" superstructure to the basic provisions of "first to file" patent law. Why must we agonise over problems of patent law that might be inherent in US law but were eliminated in Europe when the EPC 1973 came into effect? China had a "one child per couple" law. Are we now to have a "only one patent per patent application" law in Europe?

Reply

Anonymous

Wednesday, 25 March 2009 at 11:43:00 GMT

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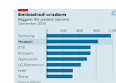
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**The Cofemel decision well beyond 'simple' issue of designs and copyright**



**Comments from the EPO President on the patentability of computer-implemented simulations (G 1/18)**

There is clearly no "legitimate interest" in having the "same invention" considered twice. For example, an applicant filing a divisional for the "same invention" just before his appeal is dismissed before the board has no "legitimate interest" in doing so. The same is true for having his application examined twice for the "same invention". This is a matter of procedural law which falls under A.125 EPC. However, the "same invention" has to be exactly that, namely the claims have to be directed to the same subject-matter, and not merely overlapping the ones of the other application.

As somebody remarked, an applicant may have an interest in having a restricted patent being granted quickly and then proceeding with an enlarged scope in a divisional application.

In my view, the prohibition of double patenting applies only for applications having the same independent claims and the legal basis is A 125 EPC in connection with the lack of legitimate interest ("mangelndes Rechtsschutzbedürfnis").

Reply

Anonymous

Wednesday, 25 March 2009 at 12:46:00 GMT

A referral of the "double patenting" question to the EBA most probably will not help. What can the EBA do other than confirm their earlier opinion in that there is no "legitimate interest" to allow "double" patenting?

However, ignoring the clear cut case of identical claims, the interesting questions are: when exactly does a "double patenting" issue arise and what are the limits of "double patenting", both questions almost always being linked to the particular facts of the case to be decided.

I am confident that the boards of appeal will give due consideration to a well argued position put forward by a party and decide in a sensible manner. Who knows, perhaps the present blog entries will also have a positive effect !

Reply

MaxDrei

Wednesday, 25 March 2009 at 13:04:00 GMT

Yes but:

1) Sometimes what a TBA finds to be the "same" invention is incomprehensible. In such cases, natural justice requires that Applicant be given another chance through the vehicle of a divisional, with different claim wording, to define the valuable inventive concept.

2) And, where's the harm, in this pursuance of interest, that might or might not be "illegitimate"? Those claims to the "same" inventive concept ought to get an instant Refusal Decision, but this would be after Applicant has stumped up all the official fees. Lots of money for almost no work. I'm all in favour of replenishment of official coffers in this way. If the mischief is that Applicant has good reason to believe that its identical claims (same substance, even if superficially non-identical form) might get through, at the n'th time of asking, and if his competitors must make allowance for that happening, there's an easy solution for the EPO: just be more robust in announcing "We decided that already. Refused, for the same substantive reasons"

3) Put yourself in the position of an Applicant that gets refused by the TBA for having added matter. Should he get a second run at the TBA, with claims purged of the matter which the TBA (surprisingly) finds to be new?

Reply

Anonymous

Wednesday, 25 March 2009 at 15:33:00 GMT

The real objection to double patenting is that the holder of multiple patent rights to the same invention is free to mount multiple infringement actions against the same or different alleged infringers. It matters not if one of the identical patents is declared invalid, since the patentee can simply fall back on one of the identical divisionals.

The basic rule is that an inventor is rewarded with one patent (and only one patent) per invention. There is no possible justification for allowing more than one patent for exactly the same invention. Divisionals are intended to deal with cases in which protection was being sought for more than one invention in a single application. In such a case (and only in such a case) is a divisional justified.

Applicants who use the divisional route to patent exactly the same invention time and time again are abusing the system and it is unfortunate that EPO examiners continue to allow them to get away with it. This is: (i) in conflict with the basic principle of patent law referred to in the EPO Guidelines which prevents double patenting; (ii) deeply anti-competitive; and (iii) undesirable because it can create a considerable burden on both Courts and litigants in national infringement proceedings.

Reply

Anonymous

Wednesday, 25 March 2009 at 16:59:00 GMT

Of course, things would be easier if we would know what exactly "the same invention" meant. It appears that that "the same invention" gets a different meaning in T307/07 when compared to the concept of "the same invention" explained in G2/98.

Reply

MaxDrei

Wednesday, 25 March 2009 at 17:10:00 GMT

Anybody agree with me, that the "Anonymous" who posted at 3.33 is addressing us from the top of an ivory tower? He thinks he can tell when two claims, worded differently, are or are not directed to "exactly the same invention". Can you?. It is not as if all claims simply recite "Molecule X". Sometimes they are framed to protect a concept in mechanical engineering, supported by mere embodiments. EPO rejection of anything not found verbatim in the app as filed keeps the lid on the "divisionals as double patents" problem, no? judges in NL and GB give short shrift to such patents, and the loser pays. Anonymous, where do you live? Is it Germany? For which national courts is the problem unbearable? Can you give us examples? Above, I gave you Medinol in NL.

Reply

Anonymous

Wednesday, 25 March 2009 at 19:30:00 GMT

I surely hope that the decision T307/07 is not a result of the EPO's, and apparently other's, paranoiac attitude towards divisionals. Of course there is abuse but that is nothing new and could have been solved easily by administrative measures suggested in G1/05. Only if such measures would have proven inadequate should the legislator become active (reasons 13.5 in G1/05). But no, things have developed differently now that the EPO has its "raising the bar" project; why not go to the extremes immediately?

Reply

Anonymous

Wednesday, 25 March 2009 at 20:06:00 GMT

"The statement in decision G1/05 r.13.4 regarding a refusal on the ground of double protection as being non-objectionable, appears to be an oversight on the part of the EBoA."

Apparently not when comparing the names of the members in G1/05 and T307/03.

Reply

Anonymous

Wednesday, 25 March 2009 at 21:20:00 GMT

@anonymous 3:33:

"it is unfortunate that EPO examiners continue to allow them to get away with it"

I'm afraid you're barking up the wrong tree. The reason why these cases ended up with the BoA in the first place, is because EPO examiners disallowed the double patenting, and in fact do so quite consequently.

Reply

Erik

Thursday, 26 March 2009 at 22:18:00 GMT

Going back to Derk's remarks, I fully agree with the conclusion regarding the EPC2000: that is a missed opportunity. The arguments regarding Art. 125 EPC however are less convincing in my opinion.

Indeed, double patenting was extensively discussed in the travaux. A nice "summary" regarding the discussions on collision and double patenting can be found in G1/03 (see point 2.1.1):

"According to the "prior claim" approach, the claims of the later application had to be compared with the claims of the earlier application in the granted version. The purpose of this approach was to avoid double patenting."

One of the reasons that the prior claim approach was not introduced in the EPC was because:

"the EPO was not a competent body to assess the scope of protection of the patent, since this had to be determined for the comparison with the later application under the prior claim approach pursuant to the applicable national law. For these reasons, the prior claim approach was not considered to fit into the European patent system."

Nevertheless, despite the fact that no double patenting prohibition provision was introduced in the EPC for the above reasons, the UK delegation requested to have in writing in the Minutes of the Diplomatic conference (a rather authoritative document amongst the documents forming the travaux) that the Main Committee (not only the UK delegate) regarded the double patenting prohibition as a principle of procedural law:

"In connection with Article 125, it was established at the request of the United Kingdom that there was majority agreement in the Main Committee on the following: that it was a generally recognized 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."

Such statement simply cannot be dismissed by saying that they were wrong. On the contrary, I would

like to argue that the UK delegation very cleverly "opened" a backdoor for introducing a double patenting prohibition (when required).

The problem regarding the EPO not being competent of assessing of the scope of protection was clarified ten years later in G2/88 (see point 3.3):

"The protection conferred by a patent is determined by the terms of the claims (Article 69(1) EPC), and in particular by the categories of such claims and their technical features. In this connection, Article 69 EPC and its Protocol are to be applied, both in proceedings before the EPO and in proceedings within the Contracting States, whenever it is necessary to determine the protection which is conferred."

That only leaves the notion of "principles of procedural law" in Art. 125 EPC .

In T 587/98 the Board appears to imply (the reasoning in 3.6 is not very clear in that sense) that the double patenting prohibition is a matter of substantive law without any further substantiation. Indeed, as some commentators already mentioned, determination whether a provision or a principle is one of procedural or substantive law may be counter-intuitive and may depend on the jurisdiction or the system of law (common law-continental law). For example, in Dutch law transitional provisions for a newly introduced law are regarded as substantive law. Similarly, the principle of *res judicata* - regarded by the Boards as a general principle of procedural law under Art 125 (T 167/93) - is in some countries held to be one of substantive law.

Apparently, the UK delegation wanted to shortcut such discussions by introducing an unambiguous statement in the travaux.

Reply

Anonymous

Wednesday, 26 August 2009 at 10:22:00 BST

What else could - but hopefully will not - be easily concluded from Art. 60(1) EPC stating "Das Recht auf **das** europäische Patent steht **dem Erfinder** oder **seinem** Rechtsnachfolger zu" / "The right to a European patent shall belong to the **inventor** or **his** successor in title" / "Le droit au brevet européen appartient à **l'inventeur** ou à **son** ayant cause"?

1: The patent belongs to one and only one inventor.

2: The one inventor must be male.

3: The one male inventor may obtain one and only one patent in (his) life time.

Anything else?

This may reduce the backlog, of course...

Reply

Anonymous

Sunday, 1 November 2009 at 16:53:00 GMT

The last comment is great. Congratulations !

I have a suggestion to overcome T307/03 with exactly the same claim set as in a previous application : just assign the second application to your wife, husband, subsidiary, or parent company (choose whichever is the easiest for you) the day before the decision is supposed to be taken. They should be no double patenting objection this way !

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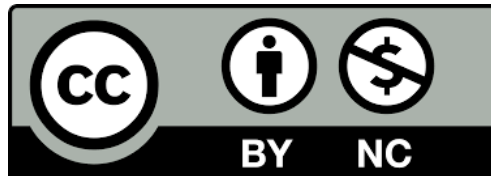
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Home / / Further developments on double patenting at the EPO

## Further developments on double patenting at the EPO

David Pearce Friday, April 30, 2010

Thanks to the excellent EPLaw patent blog, the IPKat has learned of a recent EPO decision, T 1423/07 (available from EPOline here), in which the technical board disagrees with the view taken in T 307/03 (reported by the IPKat here, with commentary from Derk Visser here) on the matter of what, if any, basis there is in European patent law for refusing an application on the grounds of double patenting.

The argument in T 307/03 was based on the rather strange reasoning that Article 60 EPC allowed an inventor the right to be granted one, and only one, patent for his invention. This reasoning does not appear to have been agreed with by anyone else (or at least no one willing to admit it), and is thought by the IPKat to have been one of an occasional series of rogue decisions that the EPO technical boards of appeal like to throw up now and then to keep us all on our toes (anyone remember all that fuss about divisional applications a while ago?).

This now seems to have been shown to be the case, as the technical board in T 1423/07 have stated quite clearly that there is no way that Article 60 could provide basis for refusing a European application under Article 97(2) for double patenting. Contrary to T 307/03, the board in this case found that "the fact that the EPC does not contain any specific provisions relating to double patenting is decisive: in the absence of such provisions, a refusal of a European patent application for double patenting is not possible irrespective of whether or not double patenting is a rare occurrence" (reasons, point 2.3.2).

Since the technical board in this case also found that there was no reason to refer questions to the Enlarged Board, the IPKat wonders if this will be an end to the matter or if there are likely to be further grumbings about double patenting in the future. Merpel and Tufty both suspect that this is an issue that is not likely to go away just yet.

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- Top Patent Blog poll 2009: 3rd out of 5 "Favourite Patent Blog" poll and 2nd out of 10 "Most-read" poll.
- ComputerWeekly IT Law and Governance **the Year**, 20 August 2008.
- **Best of the Blogs**, Times Online, 21 August 2008.



Anonymous Saturday, 1 May 2010 at 02:37:00 BST

In point 2.2.1, the Board answers the question whether double patenting is a matter of procedural law in the affirmative by referring to a passage from the minutes of the Munich Diplomatic Conference of 1973 that reads:  
 "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 is 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."

Amazingly, after citing this passage the Board goes on to answer the question whether the prohibition of double patenting is a principle generally recognised in the Contracting States in the negative! What?

Reading the comments below the IPKat's March 2009 post, I see that Derk Visser agrees with T 587/98 that double patenting is not a procedural issue. However, I would say it certainly is a procedural issue, albeit with a substantive criterion. This is quite common, e.g. the principle of *res iudicata* is without any doubt a procedural principle, but to apply it one needs to answer the substantive question whether the matter to be decided is the same.

Reply

Anonymous Saturday, 1 May 2010 at 10:37:00 BST

I would believe that it is important in this decision that because the other patent was the priority application, filed about one year before the present application, the applicant has a legitimate interest in getting a patent on the second application, as that second patent would expire about one year later than the earlier patent.

From the discussion on the Enlarged Board of Appeal decisions G 1/05 and G 1/06, as well as the discussion of German case-law in this decision, I would draw the conclusion that absent any such legitimate interest, the EPO ban on double patenting is still very much alive.

Reply

Anonymous Saturday, 1 May 2010 at 14:24:00 BST

I agree that the fact that the patent on the priority application expires one year earlier could give a sufficient legitimate interest in the sense of G 1/05 and G 1/06.

However, the Board in T 1423/07 goes much further and explicitly states that the prohibition on double patenting is not a generally recognised principle of law in the Contracting States (point 2.2.3), and that a refusal for double patenting is not possible (point 2.3.2). The decision clearly conflicts with point 13.4 of G 1/05 and G 1/06, even though it is possible to reconcile its concrete end result with point 13.4.

If the (new) president wants, he can safely refer the question of double patenting to the EBA. There are sufficient conflicting decisions, and *obiter dicta* count too (G 3/93, point 2).

Reply

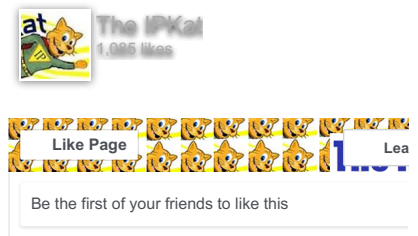
Anonymous Sunday, 2 May 2010 at 15:12:00 BST

This decision states that (i) there is a legislative consensus in the EPC member states that double patenting is not permitted (ii) that this is a matter of procedural law (such that Art.125 EPC might apply) but, (iii) that there is no consensus in the EPC states as to how to deal with such cases. The decision states that only three states provide for the **refusal** of a patent application by reason of double patenting (Eire, the UK and Germany) whereas all other EPC states which forbid double patenting prevent this from occurring by an automatic loss of rights (e.g. deemed withdrawal or deemed revocation of the earlier filed application/patent when the later one relating to the same invention and claiming the earlier one as priority is filed). The Board then stated that, although there is a general consensus on not allowing double patenting, only a minority of states apply refusal as a sanction. Since the sanction applied by the Examining Division in this case was to refuse the application which duplicated the protection, then, according to the Board, Art.125 EPC could not be applied because this is a sanction not generally recognised in the EPC states.

This decision then went on to exclude the application of G1/05 and G1/06 (which found that double patenting between divisional and parent applications should be prevented) because in this case, the double protection was afforded by a European priority and a subsequent European application claiming that European application as priority and, as pointed out above, there is a year's difference in the life of the patent granted on the earlier and later filed applications.

However, not preventing double patenting because of the lack of a consensus in the EPC states on a **procedure** for preventing it, when at the same time clearly indicating that there is a consensus that double patenting is not permitted, is a little odd. There is no other sanction available under the EPC to deal with these cases, so what is effectively said is that there is a generally recognised principle that

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double patenting should not be permitted because of the general application of general principles under Art.125 EPC, but at the same time, this cannot be enforced.

In addition, considering the non-application of G1/05 and G1/06 because of the difference of one year in the protection from divisional cases, it is worth noting that the applicant has a free choice to pursue the later filed application to grant and is not required to pursue the earlier application to grant. Consequently the applicant has the possibility to determine the start and end of the 20 year term. He could file the earlier EP application, claim it as priority for a later filed EP application, allow the earlier application to lapse and then pursue to grant the later filed one, thus gaining one year. All that matters is that there are not two patents for the same invention.

It is also worth mentioning that if two patents are granted for the same subject matter in such cases, any person wishing to annul the patent rights in respect of the subject matter duplicated in these two applications and in respect of the 19 years of overlap of protection between them, would have to file two oppositions at the EPO and pay twice the procedural fees and incur twice the costs.

National nullification proceedings before the courts of the member states may allow consolidated proceedings but there is no precedent for this before the first instance departments of the EPO.

I feel that this matter needs to go the Enlarged Board of Appeal, so that, whatever the outcome, the matter will be settled. Possibly if the Enlarged Board did allow double patenting, it might also indicate that consolidation of opposition cases at the EPO might be allowed, thus mitigating the disadvantages for any potential opponent.

Reply

Anonymous

Monday, 3 May 2010 at 16:13:00 BST

Ah, but consolidated proceedings could only be achieved if the patentee agreed (unlikely) or if the Division/Board decided that the opponent was right that there was double-patenting - which could well require a procedure, oral proceedings, appeal etc. etc. all of its own! Even then, the consolidated procedure could end up lasting twice as long since two sets of dependent claims could form the numerous alternative requests of the patentee. Two proceedings into one doesn't necessarily halve the time/cost/effort...

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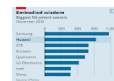
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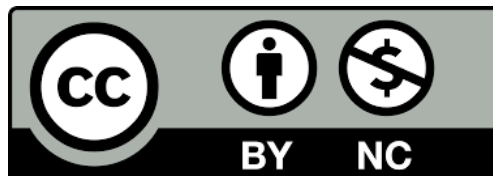
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## Breaking: New referral to the Enlarged Board of Appeal on double-patenting

▲ Rose Hughes Friday, February 22, 2019 - [Article 125 EPC](#), [Article 60 EPC](#), [divisionals](#), [double patenting](#), [EBA](#), [epo](#), [G 1/05](#), [internal priority](#), [Nestec](#), [T 318/14](#)

### An EPO Board of Appeal has referred the question of double-patenting to the Enlarged Board of Appeal (EBA).

The issue of double-patenting has been considered before by the EBA, in [G 1/05](#) and [G 1/06](#). In these decisions the EBA proposed that the principle that double patenting should be prohibited given that an applicant "had no legitimate interest in proceedings that gave rise to the grant of a second patent in respect of the same subject-matter for which he already held a patent" ([G 1/05](#), r. 13.4).

However, there are two situations where the issue of double patenting may arise - divisional applications and internal priority. In the latter case, it seems that an applicant may have a legitimate reason for the second patent, as this will have a later expiry date than the first (patent term being determined by filing date and not priority date).

Since [G 1/05](#) there have been conflicting TBA decisions on the issue of double patenting in the case of internal priority. The TBA in [T 1423/07](#) found that legal basis for preventing double patenting can not be found in [Article 125 EPC](#) or [Article 60 EPC](#), and that an applicant may have a legitimate interest in the pursuing the second application in cases of internal priority (Headnotes 1-3) (IPKat post [here](#)). By contrast, the TBA found in [T307/03](#) that [Article 60 EPC](#) prevents double patenting even in cases of internal priority (Headnote 1) (IPKat post [here](#)).

In a welcome move, the technical board of appeal (TBA, 3.3.01) in [T0318/14](#) have now referred the following questions to the Enlarged Board:

1. Can a European patent application be refused under [Article 97\(2\) EPC](#) if it claims the same subject-matter as a European patent granted to the same applicant which 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 where the European patent application under examination was filed

- on the same date as, or
- as a European divisional application ([Article 76\(1\) EPC](#)) in respect of, or
- 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?



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2.2. In particular, in the latter case, does an applicant have a legitimate interest in the grant of 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 **appealed decision** was a rejection from the Examining Division of application **EP2429542**. The application was rejected on the grounds that the claims covered subject matter 100% identical with the granted priority application (**EP09159932**) and the reasoning of **G 1/05**.

In the **statement of grounds of appeal**, the applicant (Nestec) argued that:

"1. In view of the fact that there is no principle of law generally recognized in Contracting States for refusing a patent application for double patenting, refusal of a European patent application for double patenting can not be based on **Article 125 EPC**,

2. If double patenting arises from internal priority, the applicant has a legitimate interest in the grant of the subsequent application claiming priority from an already granted European application with identical claims and identical Designated Contracting States in view of the fact that the filing date and not the priority date is the relevant date for calculating the 20-year term of the patent."

The TBA decision (T0318/14) has not yet been issued but the minutes of the oral proceedings can be found **here**. The IPKat will bring you further commentary as the case progresses.

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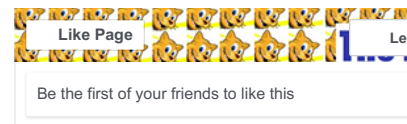
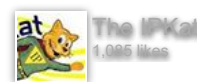
3 Comments:

**Anonymous** Friday, 22 February 2019 at 13:48:00 GMT  
As a practitioner in the U.S., I am not familiar with the term "internal priority." Can someone please provide a definition?  
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 **Rose Hughes** Friday, 22 February 2019 at 14:10:00 GMT  
Re. Anonymous  
Internal priority is where the priority claim is to a previous national application filed in a designated EPC contracting state or to a previous European application. See T 0015/01, r. 26  
[Reply](#)

 **Eric** Friday, 22 February 2019 at 14:49:00 GMT  
May I add that the Board also considered the situation where two EP applications are filed on the same date by the same applicant. This situation may also lead to a double-patenting objection (preliminary opinion of the board pt 5.2, and G-IV, 5.4 ). This corresponds to alternative a) of question 2.1.  
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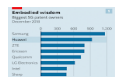
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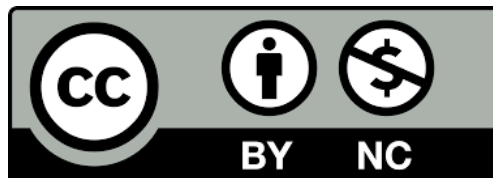
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TUESDAY, 13 MAY 2014

## T 1765/13 - Twins or clones?



Photo by [Koshy Koshy](#) obtained via [Flickr](#).

This is an appeal against a refusal by the examining division on the ground that the parent and the divisional application may not claim the same subject-matter (no "double patenting").

First instance decisions of the EPO raise such objections based on the -presumed- "accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention", even though the EPC does not deal explicitly with the case of co-pending European applications of the same effective date filed by the same applicant (Guidelines (2013) G-IV, 5.4). The Guidelines also indicate that it is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. The applicant may, for example, be interested in obtaining a first quicker protection for a preferred embodiment and pursue the general teaching in a divisional application (see G 2/10). However, in the rare case in which there are two or more European applications from the same applicant, the claims of those applications have the same filing or priority date and relate to the same invention, the applicant should be told that he must either amend one or more of the applications in such a manner that the subject-matter of the claims of the applications is not identical, or choose which one of those applications he wishes to proceed to grant. If he does not do so, once one of the applications is granted, the other(s) will be refused under Art. 97(2) in conjunction with Art. 125. If the claims of those applications are merely partially overlapping, no objection should be raised (see T 877/06). (Guidelines (2013) G-IV, 5.4). In other words, cloned claim sets are not allowed -also not if worded differently-, whereas twin claim sets are allowed -look similar, but are different-.

European patent application EP 11175939.5 is a divisional application of EP 05789669.8, published as EP-A-1 730 830 (the "parent application"), now granted as EP-B-1 730 802 (the "parent patent"). A further divisional application EP 11175941.1 is pending (see T 1766/13 of 17 April 2014). All applications were filed in the name of LG Chem, Ltd., KR. They claim the same priority date of 29 March 2004 and designate the same contracting states DE, FR and GB.

The present divisional application EP 11175939.5 was refused by the examining division on the ground that the parent and the divisional application may not claim the same subject-matter (no "double patenting"). In the decision to refuse, the examining division relied in particular on G 1/05 and G 1/06 and the Guidelines C-IX, 1.6, and G-IV, 5.4.

The applicant appealed the decision.

In his arguments, the applicant argued that the granted claims were respectively directed to a cathode active material for a secondary battery and a lithium secondary battery comprising such a cathode

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active material, whereas all claims now pending were directed to the use of a battery comprising the inventive cathode. The appellant submitted that the present claims could not reasonably give rise to an objection of double patenting because they related to an aspect, namely the use for a specific purpose, fundamentally different from the objects (i.e. a cathode active material per se and a lithium secondary battery per se) of the previously granted claims. The appellant argued that the test for double patenting was not whether the disclosed subject-matters in the parent and divisional applications were the same, but whether the claims of the two cases were "for the same subject-matter". These arguments were consistent with the case law of G 1/05 and G 1/06.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the use-claims 1 to 4, correspondingly amended description pages, and drawing pages as originally filed.

## Reasons for the Decision

### 2. Double patenting

2.1 The decision of refusal was based solely on the ground that an unallowable "double patenting" existed having regard to claims 1 and 5 of the granted parent patent EP-B-1 730 802. Said claims were directed to a cathode active material for a secondary battery and a lithium secondary battery comprising such a cathode active material, respectively (see point II of this decision).

2.2 In contrast, new claim 1 and dependent claims 2 to 4 are use claims. Thus present claim 1 is directed to the use of a lithium secondary battery, comprising the specific cathode of the invention, as a high-power, large-capacity power source in an electric or hybrid vehicle, whereas the granted claims of the parent application relate to products, namely a cathode active material and a lithium secondary battery. Thus the use claims of the present divisional application relate to a subject-matter different from the subject-matters of the granted claims of EP-B-1 730 802.

The present use claims are also distinct from the claims directed to a method for fabricating a lithium manganese-metal composite cathode, claimed in co-pending application EP 11 175 941.1 and found allowable in appeal case T 1766/13 (of 17 April 2014).

2.3 The Enlarged Board of Appeal observed in G 1/05 (OJ EPO 2008, 271, Reasons 13.4) and G 1/06 (OJ EPO 2008, 307): "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. Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application **claims the same subject-matter** as a pending parent application or a granted parent patent" [emphasis added RvW].

Evidently, with respect to the present case, a product and its use are not "the same subject-matter" in the sense of G 1/05 and G 1/06. The same is true for the use of a product and a method of fabricating it.

2.4 This is consistent with the Guidelines, C-IX 1.6, instructing as follows: "The parent and divisional applications may not claim the same subject-matter (see G-IV, 5.4). ... The difference between the claimed subject-matter of the two applications must be clearly distinguishable."

According to the Guidelines G-IV, 5.4, "it is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions."

Both criteria are clearly fulfilled in the present case.

2.5 Therefore, applying the case law of the Enlarged Board of Appeal, the objection of double patenting cannot be upheld against the claims as amended. The decision under appeal therefore has to be set aside.

### 3. Interlocutory revision

(...)

3.2 In view of the provision of Article 109(2) EPC, the examining division is prevented from commenting as to why it did not consider the appeal well-founded and rectify its decision. It is therefore not for the board to speculate. However, as the appellant explicitly drew attention to the possibility of granting interlocutory revision in view of the amended claims (see grounds of appeal, page 3), the examining division's failure to rectify constitutes a substantial procedural violation (see T 647/93; OJ EPO 1995, 132).

3.3 According to Rule 103(1) EPC, the appeal fee is to be reimbursed in full in the event of interlocutory

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## LABELS

[accidental anticipation](#)

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[ada](#)

[added subject matter](#)

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[Art. 113 EPC](#)

[Art. 113\(1\) EPC](#)

[Art. 114\(1\) EPC](#)

revision or where the board of appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

While pointing to the substantial procedural violation (see point 3.2), in the present case the board does not consider it equitable to reimburse the appeal fee, since neither the examination procedure leading to the contested decision nor the decision itself were tainted with procedural shortcomings. The necessity for the appellant to file an appeal arose from the decision of the examining division itself (refusal due to double patenting), not from the later incorrect handling by the examining division, i.e. not from the denial of interlocutory revision (see T 794/95 of 7 July 1997, Reasons, point 5).

#### 4. Remittal

According to Article 11 RPBA, a board is to remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.

In the present case, the occurrence of a substantial procedural violation was noted. Reasons not to remit are not apparent to the board.

As the claims have been substantially amended to the extent of creating a fresh case, which is a further argument for a remittal, and in order not to deprive the appellant of the possibility to have its case decided by two instances, the board exercises its power under Article 111(1) EPC to remit the case to the examining division for further prosecution.

(...)

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

*This decision has European Case Law Identifier: ECLI:EP:BA:2014:T176513.20140424. The whole decision can be found [here](#). The file wrapper can be found [here](#).*

*Another recent decision -T 1780/12- discusses (lack of) double patenting objections between Swiss-type claims and second medical use claims. See especially Reasons 16-25 of T 1780/12.*

GEPLAATST DOOR [ROEL VAN WOUDEBERG](#) OP 10:30  


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FRIDAY, 12 SEPTEMBER 2014

## T 879/12 - Again, no double patenting



*This is an appeal against the decision of the examining division to refuse a European patent application, a second-generation divisional application. The examining division had held that the second-medical use claim in the purpose-limited format of Art.54(5) EPC related to the same subject-matter as the Swiss-type claims as granted with the grandparent application. The Board followed the argumentation of earlier [T 1780/12](#) (taken by another board), and held the examining division to be wrong. Followers of our blog may find the differences with the conclusion in [T 1570/09](#) interesting, where the Board denied the simultaneous presence of both claims in a single application (see e.g., [T 1570/09](#), r.4.1 and r.4.8).*

**Summary of Facts and Submission**

III. The applicant (appellant) submitted its statement of grounds of appeal and, in a further submission, referred to the identity of the legal issues in the present case and in decision T 1780/12 of 30 January 2014, taken by another board.

IV. Claim 1 of the request before the board, which is identical to the request before the examining division, reads as follows:

"1. An Apo-2 ligand for use in a method for treating cancer, wherein the Apo-2 ligand is:  
 (a) a polypeptide comprising amino acid residues 41-281 of Figure 1A (SEQ ID NO: 1);  
 (b) a polypeptide comprising amino acid residues 114-281 of Figure 1A (SEQ ID NO: 1);  
 (c) a polypeptide consisting of amino acid residues 114-281 of Figure 1A (SEQ ID NO: 1);  
 (d) a polypeptide consisting of amino acid residues 1-281 of Figure 1A (SEQ ID NO: 1); and  
 (e) a polypeptide which is a fragment of (a), (b), (c), or (d); and

wherein the cancer is squamous cell carcinoma, small cell lung carcinoma, non-small cell lung carcinoma, neuroblastoma, pancreatic cancer, glioblastoma multiforme, cervical cancer, stomach cancer, bladder cancer, hepatoma, breast cancer, colon carcinoma, head and neck cancer, prostate cancer or ovarian cancer and the Apo-2 ligand induces apoptosis in the cancer cells."

Dependent claims 2 to 8 refer to specific embodiments of the subject matter of claim 1.

V. Claim 1 of the grandparent application as granted reads:

"1. Use of an Apo-2 ligand for the preparation of a medicament for the treatment of cancer, wherein the Apo-2 ligand is:

(a) a polypeptide comprising amino acid residues 41-281 of Figure 1A (SEQ ID NO:1);  
 (b) a polypeptide comprising amino acid residues 114-281 of Figure 1A (SEQ ID NO:1);  
 (c) a polypeptide consisting of amino acid residues 114-281 of Figure 1A (SEQ ID NO:1);  
 (d) a polypeptide consisting of amino acid residues 1-281 of Figure 1A (SEQ ID NO:1); and  
 (e) a polypeptide which is a fragment of (a), (b), (c), or (d); and

wherein the cancer is squamous cell carcinoma, small cell lung carcinoma, non-small cell lung carcinoma, neuroblastoma, pancreatic cancer, glioblastoma multiforme, cervical cancer, stomach cancer, bladder cancer, hepatoma, breast cancer, colon carcinoma, head and neck cancer, prostate cancer or ovarian cancer and the Apo-2 ligand induces apoptosis in the cancer cells."

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Dependent claims 2 to 8 refer to specific embodiments of the subject matter of claim 1, specifying the same additional features as claims 2 to 8 of the request before the board.

### Reasons for the Decision

Double patenting

2. The sole ground for refusal of the present patent application was the prohibition of double patenting.

3. Under the EPC 1973 a patent for a further medical application could, pursuant to a line of case law first set out in decision G 5/83 (OJ EPO 1985, 64), be granted for a claim directed to the use of a substance or composition for the manufacture of a medicament for a specified therapeutic application (so called "Swiss-type claim") (cf. "Case Law of the Boards of Appeal of the EPO", 7th edition 2013, I.C.6.2.1, 144).

During the course of the revision of the EPC 2000, former Article 54(5) EPC 1973 ("first use in a medical method") was renumbered to become Article 54(4) EPC and a new Article 54(5) EPC was introduced to provide protection for second medical uses. The new Article 54(5) EPC eliminates any legal uncertainty on the patentability of further medical uses. It unambiguously permits purpose-restricted product protection for each further new medical use of a substance or composition already known as a medicine (cf. "Case Law of the Boards of Appeal of the EPO", *ibid.*).

4. Claim 1 of the present application is in the form of a purpose restricted product claim ("An Apo-2 ligand for use in a method for treating cancer"; cf. item IV above) according to Article 54(5) EPC 2000. Claim 1 of the grandparent application was granted in the "Swiss-type" format ("Use of an Apo-2 ligand for the preparation of a medicament for the treatment of cancer"; cf. item V above) under the provisions of Article 54(5) EPC 1973.

5. The examining division stated in its decision that a claim directed to a second or further medical use claim under Article 54(5) EPC 2000 was considered to be directed to the same subject-matter as a "Swiss-type" claim directed to the same medical use, in the sense that both these claims concerned the same invention claimed in a different format.

6. The principle of the prohibition of double patenting is based on the idea that the applicant has no legitimate interest in proceedings that give rise to the grant of a second patent in respect of the same subject-matter for which he already holds a patent (cf. Reasons 13.4 of decision G 1/05, OJ EPO 2008, 271).

7. The decisive issue is therefore whether the subject matter of claim 1 of the present application is the same as the subject matter of claim 1 of the grandparent application.

8. The present case has much in common with the case underlying decision T 1780/12 of 30 January 2014.

The crucial issue for the main request underlying said decision was also whether the subject matter of a claim directed to a new medical use of a known compound was the same, irrespective of whether the claim was in the "Swiss-type" format or in the format according to Article 54(5) EPC 2000.

Furthermore, the board notes that points 1 and 3 to 8, and, with the exception of a single sentence, all of point 2, of the decision of the examining division underlying the present appeal (see item VI above) can be literally found in points 2 to 10 of the decision of the examining division underlying appeal case T 1780/12 (cf. item VII of decision T 1780/12).

9. Like in the present case, a parent application had been granted with claims in the "Swiss-type" format for the use of a composition comprising a biologically effective amount of an anti-aminophospholipid antibody, or antigen-binding region thereof, in the manufacture of a medicament for the treatment of cancer. A divisional application (underlying T 1780/12) had been filed with a main request comprising purpose-restricted product claims referring to a composition comprising a biologically effective amount of an anti-aminophospholipid antibody, or antigen-binding region thereof, for the treatment of cancer. Further claims, referring to features specifying a mechanism of action, were identical in both types of claims.

The examining division had refused the main request of the divisional application under Article 97(2) EPC in conjunction with Article 125 EPC because, in its view, claim 1 before it related to the same subject matter as granted claims 1, 24 and 25 of the parent application.

10. Regarding the issue of what constitutes the subject matter of a claim, the board in T 1780/12 concluded, by reference to decision G 2/88 (OJ EPO 1990, 93), that the category or type of claim and its technical features constitute its subject matter (cf. T 1780/12, Reasons 11 to 13). It was therefore necessary to establish whether or not the subject matter of the claims as defined by their categories in combination with their technical features was the same.

[T 879/12 - Again, no double patenting](#)

[T 1354/13 - Late filed request](#)

[T 1570/09 - Getting both](#)

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11. The board stated that Swiss-type claims of the form "Use of X for the manufacture of a medicament for the treatment of Y" are construed as purpose-limited process claims while claims formatted in accordance with Article 54(5) EPC as "X for use in the treatment of Y" are construed as purpose-limited product claims. The categories of the claims are therefore different (cf. T 1780/12, Reasons 16). Regarding the technical features, the board concluded that both sets of claims defined the same compound and the same therapeutic use, but that the Swiss-type claims comprised in addition the feature of manufacturing a medicament while the claims of the request before it did not (cf. T 1780/12, Reasons 17).

The board therefore decided that the subject matter of the claims of the main request before it was different from the subject matter of the Swiss-type claims of the parent application.

12. The board also dealt with the examining division's argument that "double patenting is concerned with the substantial identity of claimed subject matter and is not related to the (only potential) variance in granted protection".

13. In this respect, the board in case T 1780/12, agreed with the finding in decision T 1391/07 of 7 November 2008, that an applicant's lack of legitimate interest in patenting the same subject matter twice, invoked by the Enlarged Board in decision G 1/05 (cf. point 6, supra) could not be invoked in the case in which the scopes of protection only partially overlapped as there was no objective reason to deny the legitimate interest of an applicant in obtaining a protection different from that of the parent patent already granted (cf. T 1780/12, Reasons 19). Any potential variance in the scope of protection afforded by the claims was therefore crucial to the decision to be taken.

Based on point 3.3 of the Reasons of decision G 2/88, the board concluded that the category of a claim and its technical features constitute its subject matter and determine the protection conferred (cf. T 1780/12, Reasons 21). Thus, contrary to the examining division's view, the claimed subject matter and the scope of protection conferred by the claims are intrinsically linked.

Since the purpose limited process claim (Swiss-type claim) and the purpose-restricted product claim according to Article 54(5) EPC 2000 belonged to different categories and differed in at least one technical feature, they differed in the scope of protection afforded (cf. T 1780/12, Reasons 20 to 22). There was no manifest objective reason to deny the legitimate interest of the appellant in pursuing claims drafted in accordance with Article 54(5) EPC 2000 and thereby obtaining protection different from - albeit partially overlapping - with that of "Swiss-type" claims of the parent application already granted (cf. T 1780/12, Reasons 25).

14. This board agrees with the legal assessment in decision T 1780/12 in that the scope of the claims in both cases is different, and considers its conclusions to be directly applicable to the present case.

15. In the present case, the claims of the patent application and the grandparent application define the same compound (an Apo-2 ligand defined by features (a) to (e)), and the same therapeutic use (the treatment of the same cancers, as specified in the claims (cf. items IV and V, above). But the subject matter of claim 1 is defined in the format of a purpose-restricted product claim, whereas the subject matter of claim 1 of the grandparent patent is defined in the Swiss-type format.

Since the categories of the claims are different and there is at least one difference in the technical features defining the claimed subject matter (the manufacture of a medicament), the subject matter defined by the claims and the scope of protection conferred by the claims are different.

16. The board therefore decides that granting a patent on the basis of claims 1 to 8 would not lead to double patenting.

17. Since the board does not uphold the decision under appeal, there is no need for oral proceedings (cf. item VIII, above).

18. As the decision under appeal is exclusively concerned with the issue of double patenting (cf. item II above) the Board decides to remit the case to the department of first instance for further prosecution (Article 111(1) EPC).

#### Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of

claims 1 to 8, filed under cover of a letter dated 22 October 2009.

*This decision has European Case Law Identifier: ECLI:EP:BA:2014:T087912.20140827. The whole decision can be found [here](#). The file wrapper can be found [here](#). Photo "Swiss flags" by [Janet McKnight](#) obtained via [Flickr](#).*

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LABELS: [ART. 54\(5\) EPC](#), [DOUBLE PATENTING](#), [PURPOSE-LIMITED CLAIM](#), [SECOND MEDICAL USE](#), [SWISS-TYPE CLAIM](#), [T 1570/09](#), [T 1780/12](#)

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FRIDAY, 16 MAY 2014

## T 1780/12 - Antibodies for cancer treatment - double patenting?

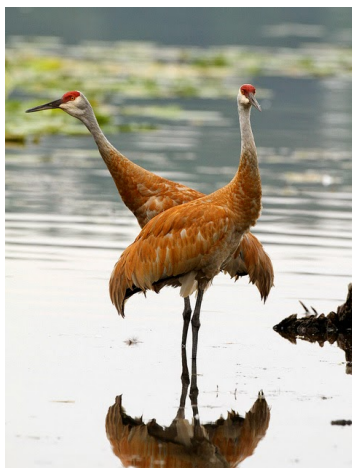


Photo by [Dawn Huczek](#) obtained via [Flickr](#).

This is an appeal against the Decision of the Examining Division refusing a European patent application (hereinafter "EP2"), with EP2 being a divisional application of a European patent application which has been granted (hereinafter "EP1").

The Examining Division refused the divisional application under Article 97(2) EPC in conjunction with Article 125 EPC ("double patenting").

Claim 1 of EP1 read:

"1. Use of a composition comprising a biologically effective amount of an anti-aminophospholipid antibody, or antigen-binding region thereof, in the manufacture of a medicament for the treatment of cancer by killing tumor vascular endothelial cells of a vascularised tumor".

Claim 1 of the main request before the Examining Division read:

"1. A composition comprising a biologically effective amount of an anti-aminophospholipid antibody, or antigen-binding region thereof, for the treatment of cancer by killing tumor vascular endothelial cells of a vascularised tumor, inducing coagulation in tumor vasculature or destroying tumor vasculature."

In the decision under appeal the Examining Division held that:

"A claim directed to a second or further medical use claim under Article 54(5) EPC is considered to be directed to the same subject-matter as a Swiss type claim directed to the same medical use, in the sense that both these claims concern the same invention claimed in a different format". The examining division also considered that "(...) double patenting is concerned with the substantial identity of claimed subject-matter and is not related to the (only potential) variance in the granted protection."

With its statement of grounds of appeal the appellant filed a new main request of which claim 1 was identical to claim 1 of the main request before the Examining Division.

The appellant requested that the decision of the examining division be reversed insofar as it resulted in refusal of this application. The arguments of the appellant:

"The claims of EP1 were formatted in accordance with decision G 5/83. It was widely accepted that this format of claim was a purpose-limited process claim. By comparison, the claims of the present application (EP2) were formatted in accordance with Article 54(5) EPC 2000. These claims were

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*purpose-limited product claims, i.e. the product when packaged for that use. (...) The fact that these claim formats differed in scope was confirmed by the Enlarged Board of Appeal in decision G 2/08.*

*Decisions G 1/05 and G 1/06 referred to the same subject-matter. If the claims were not at least substantially identical in scope, they could not constitute the same subject matter. A process claim and a product claim could not be substantially identical in scope. For the reasons stated above, the claims were clearly distinguishable in scope and therefore were not directed to the same subject matter."*

#### Reasons for the Decision

5. The examining division based its refusal (see section VII above) on established practice of the EPO departments of first instance (see Guidelines for Examination, C-VI, 9.1.6 and C-IV, 7.4) and decisions G 1/05 and G 1/06 of the Enlarged Board of Appeal (OJ EPO 2008, 271 and 307, respectively).

(...)

7. These passages of the Guidelines for Examination thus restrict the prohibition of double patenting to applications claiming the same invention, and more specifically to parent and divisional applications claiming "the same subject-matter". Thus, pursuant to the Guidelines, in order to determine whether or not the same invention is claimed, the claimed subject-matter has to be determined first.

(...)

10. Therefore, the board finds it appropriate to address first the issue of what constitutes the claimed subject-matter in the case under consideration.

#### Subject-matter

11. In decision G 2/88 (OJ EPO 1990, 93, see point 2 of the reasons) the Enlarged Board of Appeal was confronted with two points of law concerned with the interpretation and effect of patent claims. The Enlarged Board of Appeal considered (ibid., point 2.6 of the reasons) that: "(...) the subject-matter of a claimed invention involves two aspects: first, the category or type of the claim, and second, the technical features, which constitute its technical subject-matter."

(...)

13. In the board's judgement, it follows from decision G 2/88, supra, that the category of a claim and its technical features constitute its subject-matter and determine the protection conferred. This board is not aware of any different, commonly accepted definition of the term "subject-matter" in the context of a claim. While the board agrees with the examining division that EP1 and the present application relate to the same invention, the board concludes that the approach taken by the examining division when finding that the same invention *eo ipso* had to mean that the same subject-matter was claimed is neither supported by the Guidelines nor by the case law.

14. In the present case, what has to be considered and decided is whether or not the subject-matter of the claims, as defined by their categories in combination with their technical features, is the same for the claims granted for EP1 and pending for the main request.

15. The appellant disputes that the subject-matter of the claims granted for EP1 is the same as that of the main request (see section XVI above).

16. Claims 1, 24 and 25 of EP1 are formatted in accordance with decision G 5/83, supra, as so-called Swiss-type claims (see section III above for the complete wording of the claims). These claims take the form "Use of X for the manufacture of a medicament for the treatment of Y", i.e. they are purpose-limited process claims. The claims of the main request are formatted in accordance with Article 54(5) EPC (see section IV above for the complete wording of the claims). These claims take normally the form "X for use in the treatment of Y" and are construed as purpose-limited product claims. Thus, the categories of the claims granted for EP1 and of the claims pending as main request, respectively, are different.

17. As regards the technical features, both set of claims define the same compound and the same therapeutic use but the claims of EP1 comprise in addition the manufacture of a medicament while the claims of the main request do not (again, see sections III and IV above for the complete wording of the claims). The board concludes that the claimed subject-matter is different between EP1 and the main request.

#### Scope of protection

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18. The examining division further held (see section VII above) that "double patenting is concerned with the substantial identity of claimed subject-matter and is not related to the (only potential) variance in the granted protection".

(...)

21. As set out in decision G 2/88 (supra, see reasons, point 3.3) the "(...) determination of the "extent of the protection conferred" by a patent under Article 69(1) EPC is a determination of what is protected in terms of category plus technical features (...)".

22. It follows from the above analysis (see points 16 and 17) that the claims under consideration belong to different categories, i.e. purpose-limited process claim vs. purpose-limited product claim and differ in addition in at least one technical feature. It is generally accepted as a principle underlying the EPC that a claim to a particular physical activity (e.g. method, process, use) confers less protection than a claim to the physical entity per se, see decision G 2/88 (supra, reasons, point 5). **It follows that a purpose-limited process claim also confers less protection than a purpose-limited product claim. The scope of protection sought by the invention claimed pursuant the present main request is thus noticeably different from the scope of protection conferred by claims 1, 24 and 25 of EP1, see also decisions T 0795/06 of 18 March 2010 (points 6.3 to 6.4 of the reasons) and T 1635/09 of 27 October 2010 (points 14 and 15.1 of the reasons).**

(...)

25. It follows from the above analysis that the subject-matter and the scope of protection conferred by claims 1 (...) granted for EP1 differ from the subject-matter and the scope of protection conferred by claim 1 of the main request. **The board is thus satisfied that there is no manifest objective reason to deny the legitimate interest of the applicant in pursuing claims drafted in accordance with Article 54(5) EPC and thereby obtaining protection different from - albeit partially overlapping - with that of the Swiss-type claims of the parent patent already granted.**

26. The board concludes that the grant of a patent on the basis of present claim 1 would not lead to double patenting. The appeal is thus allowable.

*This decision has European Case Law Identifier: ECLI:EP:BA:2014:T178012.20140130. The whole decision can be found [here](#). The file wrapper can be found [here](#).*

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