

Double Patenting before the EPO

by Peter Kitzmantel
Chairman of a Technical Board of Appeal and
Member of the Enlarged Board of Appeal of the EPO (retired)
Partner of Patentbuero Paul Rosenich AG www.rosenich.com

In the European Patent Convention (EPC) there exists no explicit prohibition of double patenting, i.e. the granting of two (or more) patents for the same invention by the same applicant.

Notwithstanding the EPO recognizes the principle that an applicant already in possession of a patent is denied the granting of a second patent for the same subject matter, a principle especially confirmed for divisional applications by the two EBA decisions **G 0001/05** and **G 0001/06** dated June 26, 2007 (OJ EPO 2008, 271 and 307; Reasons 13.4).

Accordingly, the **Guidelines for Examination C-IV, 7.4** read:

“The EPC does not deal explicitly with the case of co-pending European applications of the same effective date. However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention. However, in the rare case in which there are two or more European applications from the same applicant definitively designating the same State or States and the claims of those applications have the same filing or priority date and relate to the same invention (the claims conflicting in the manner explained in VI, 9.1.6), the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant.”

Further the **Guidelines for Examination C-VI, 9.1.6** read:

“The parent and divisional applications may not claim the same subject-matter (see IV, 7.4). This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable. As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B.”

As a reason for denying double patenting **G 0001/05** and **G 0001/06** state the lack of a legitimate interest of the applicant in proceedings leading to the grant of a second patent for the same subject matter if he already possesses one granted patent therefor.

This statement is the pivotal point of **T 1423/07** dated April 19, 2010 for its denying of a double patenting objection in the case of a (subsequent) application based on the inner priority of a first EP application with the argument that – because of the calculation of the 20-year patent term beginning with the filing date (not the date of priority) – a legitimate interest must be accepted on the basis of

the by one year longer patent term of the subsequent application; this in contrast to the patent term of divisional applications which is based on the filing date of the parent application.

As regards the issue whether – in spite of the absence of an explicit double patenting prohibition in the EPC - the refusal of said subsequent application under Article 97(2) EPC could be based on the principles of procedural law generally recognized in the Contracting States enshrined in Article 125 EPC, T 1423/07 concluded that this was not possible because in the large majority of member states such a principle did not exist for applications; as opposed to the prohibition of double patenting concerning the co-existence of an EP- and a national patent for the same invention which was well accepted by the majority of member states.

T 1423/07 takes also issue with some conclusions of **T 0307/03** dated July 3, 2007, a decision published after G 0001/05 and G 0001/06 but taken earlier, and disputes the assumption therein that Article 60(1) EPC, first sentence could be interpreted to implicitly contain the principle that an applicant could only get one single patent for one invention, by concluding: *“The right to a European patent shall belong to the inventor or his successor in title”*. From the words “the right” T 0307/03 deduced an exhaustion of the right for further patent protection for the same invention once a first application had been filed. The lack of an explicit prohibition of double patenting in the EPC was, according to T 0307/03, just due to little need and high costs; moreover, the principle set out in **T 0009/00** was to be considered, namely that because of the absence of a legitimate interest *“no one is entitled to have an administrative authority or a court take a second substantive decision on a case which has already been settled (ne bis in idem)”*.

Concerning the question whether and to what extent double patenting is a problem in the relation between a parent application and its divisional the case law discusses two issues:

- on the one hand whether an objection of double patenting may be made in the case that the parent application/patent ceased to exist, and
- on the other hand the problem of overlapping subject matter

As to the first issue it is stated in **T 0114/06** dated July 29, 2008 that an objection of double patenting cannot be made during the prosecution of a divisional application when the parent application had been abandoned. This is in line with the older decision **T 0441/92** dated March 10, 1995 which held that there is no collision of rights in a situation where features of the parent application are introduced into the divisional at a point in time where the parent application had already been refused. In contrast thereto the afore-cited T 0307/03 found that an objection of double patenting is to be raised during the prosecution of a divisional application even when the earlier granted parent had been abandoned; the reason being that inventive features should be defended in appeal proceedings of the parent application and not via the path of a divisional application because this would not only cause a lengthening of the procedure engaging more instances of the EPO, but would also deprive an opponent against the parent application of its there (partly) successful party position.

As to the problem of overlapping subject matter, **T 0587/98** (OJ EPO 2000, 497) held that there was no express or implicit provision in the EPC prohibiting the existence of an independent claim in a divisional application (explicit or as an alternative in a claim) which in addition to all features of the independent “parent” claim comprises a further feature. In the view of this board it must be assumed that the EPC provides a complete and closed definition of the legal institute “divisional application”; the prohibition of “colliding” claims in a broader sense was unknown to the EPC and such a prohibition could also not be deduced from Article 125 EPC because this article - moreover only applicable if the EPC would be devoid of regulations concerning the prosecution of divisional

application (not being the case) - was not applicable to substantive law. [The afore-mentioned T 1432/07 is however of the opinion that Article 125 EPC may also be applied to aspects of procedural law].

Similarly to T 0587/98 the later decision **T 1391/07** dated November 11, 2008, dealing with a divisional application refused because of double patenting with the parent patent, held that neither the EPC nor G 0001/05 or G 0001/06 contained a provision allowing the refusal for double patenting of non-identical but overlapping inventions.

This is also in line with the much older decision **T 0118/91** dated July 28, 1992 which did not consider as an unallowable double protection the introduction of features of the divisional application into dependent claim 4 of the parent application. This was in agreement with the Guidelines C-VI, 9.1.6 and did not entail an “unfair burden” to competitors. The main argument of the (losing) opponent in appeal was that by the filing of the divisional application the feature was no longer available for insertion into claim 4 of the parent application because this would lead to double patenting.

In contrast to the decisions which do not, in situations of overlap, see any problem of double protection, the afore-mentioned T 0307/03 found that an objection of double patenting could be made in the case of overlapping subject-matter if the subject of the granted claim was comprised by the subject-matter of the subsequently filed claim (i.e. this claim being broader with regard to one feature), particularly in the situation that the relevant subject-matter constituted a preferred embodiment of the granted patent as well as of the pending application; in this case the extent of double patenting could not be neglected as being minor.

As to the issue whether an objection of double patenting should/could be raised in opposition/opposition-appeal proceedings when the divisional application is still pending, decision **T 0936/04** dated April 24, 2008 found that – irrespective of the fact that double patenting was no ground of opposition and was moreover rather an issue of the divisional than the parent application – the raising of such an objection would be within the discretion of the EPO and should be made only in clear cases; the purpose of the prohibition of double patenting being the avoidance of double work without committing the EPO to a complex comparison.