

DECISION G4/19 OF THE ENLARGED BOARD OF APPEAL OF THE EUROPEAN PATENT OFFICE REGARDING DOUBLE PATENTING

On 22 June 2021, the highest instance of the European Patent Office, the Enlarged Board of Appeal, rendered its long-awaited decision on whether or not a European patent application can be refused during examination under the European Patent Convention if it claims the same subject-matter as a European patent which has already been granted to the same applicant, even if such granted European patent – and the application on which it is based – do not form part of the state of the art for assessing patentability of the European application under examination.

SUMMARY

In its decision G4/19, the Enlarged Board of Appeal (EBoA) of the European Patent Office (EPO) had to decide on several questions referred to it by a Technical Board of Appeal (T0318/14). These questions relate to the practice at the EPO to refuse patent applications on the grounds that the claims under examination are identical with the claims of a European patent already granted to the same applicant, and even though the application under examination and the patent enjoy the same relevant date (filing date or priority date, as the case may be). For instance, the EBoA had to decide the question whether different filing and therefore expiry dates constitute a legitimate reason to allow grant of identical claims.

The EBoA first interprets the questions referred to it, and takes the position that these questions (merely) ask for the possible legal basis for a prohibition of double patenting in the European Patent Convention (EPC), and, in the affirmative, whether such prohibition is equally applicable to three specifically-identified (formal) constellations. These alternative constellationsⁱ are

- 1) identical filing date of the European application under examination, on the one hand, and of the granted European patent (or rather the European application on which it is based), on the other hand;

- 2) a parent-divisional relationship between the European application under examination and the granted European patent; and
- 3) identity of priority date, but difference in filing date, of the European application and the already-granted European patent.

The EBoA in G4/19 does expressly not consider further interesting questions in connection with the issue of double patenting, such as the question of “the same invention”, or of “the same applicant”.ⁱⁱ

As a starting point, the EBoA takes the position that the prohibition of double patenting does indeed have such legal basis in the EPC, and allows for the refusal of European patent applications during examination. It then goes on to confirm that this prohibition is applicable to each of the three constellations, and that, i.e., different filing and therefore expiry dates do not constitute a valid reason to allow an exception to such prohibition. Unfortunately, and because of the restrictive interpretation of the referral, further interesting aspects of the prohibition of double patenting were not decided upon.

THE DECISION

Article 139(3) EPC stipulates that EPC contracting states 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.ⁱⁱⁱ Moreover, the EPC contains provisions regarding **two European** patent applications having a different date of filing or, if priority is claimed, date of priority.^{iv} Specifically, and in accordance with Article 54(3) EPC, a European application enjoying an earlier effective date than the European patent

application or patent to be assessed will be taken into account as prior art, even if not published before the effective date of the European patent application or patent to be assessed, but will then be taken into account for the purposes of the novelty assessment only.

In contrast thereto, the EPC contains no (express) statement on the relationship between two European patents or patent applications enjoying the same effective date. Still, it is established practice of the EPO to refuse, under certain circumstances, European patent applications having the same applicant and enjoying the same effective date as a previously-granted European patent. This is because the current Guidelines for Examination in the EPO (see Part G – Chapter IV, 5.4) take the position that it is an “*accepted principle in most patent systems*” that two patents cannot be granted to the same applicant for one invention. Also, the EBoA had previously already accepted *obiter dictum* that the principle of the prohibition on double patenting is based on the notion that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if the applicant already possesses one granted patent for that subject-matter (see EBoA decisions G 1/05 and G 1/06). Given the importance of the issue, there is comparatively little case law and guidance available to European patent practitioners on how to overcome an objection of double patenting, when such objection is raised by an EPO Examining Division.

The Board in T1423/07 in 2010 recognised the existence of a legitimate interest, namely the *longer term of protection* available to an applicant/patentee as a result of claiming an internal priority. For the Board in that decision, the fact that the EPC does not contain any specific provisions relating to double patenting was decisive: in the absence of such provisions, a refusal of a European patent application for double patenting should not be possible. EBoA decisions G 1/05 and G 1/06 were considered to be not pertinent as they dealt with questions regarding divisional applications (having identical ultimate expiry dates), whereas T1423/07 dealt with a European patent application which had a filing date about one year after the priority application (on which the previously-granted European patent was based).

Other decisions (T2461/10 and T2563/11) considered the *obiter dictum* in G1/05 and G1/06 (that a prohibition of double patenting under the EPC exists) to be more

general in scope, or at least as extending to any applications linked by priority.

In current practice, the situation regularly arises that, prior to grant of a European patent, a divisional European patent application is filed, in accordance with Article 76 EPC, to potentially capture claim scope that goes beyond the scope of the claims of the already-granted European patent (“the parent”).

The EBoA in G4/19 now initially answers the basic question, namely whether there is any provision in the EPC that would allow for a double patenting objection to be validly raised. Taking recourse to the Vienna Convention on the Law of Treaties, and relying on preparatory documents of the EPC (the “*travaux préparatoires*”), the EBoA in G4/19 comes to the conclusion that the prohibition of double patenting is based on Article 125 EPC. Article 125 EPC provides that

“[I]n 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 EBoA notes that Article 125 EPC is dealt with in the Minutes of the Proceedings of Main Committee I to the 1973 Munich Diplomatic Conference (“the Minutes”). Point 665. of said minutes is worded as follows (in the English version):

*“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.**”* [Emphasis added]

The fact that the agreement (on the prohibition of double patenting) did – then – not find unanimous support does according to the EBoA not preclude it from being taken into account because e.g. the agreed texts of the EPC were also (only) established by majority vote. Therefore, Article 125 EPC in the opinion of the EBoA provides the legal basis for the prohibition of double patenting. Even though the applicant in the case underlying G4/19 argued that the prohibition is only applicable in the case of several applications with “the same date of filing”, see

the above reference to the Minutes, the EBoA considered this to be an inadvertent inaccuracy, and that “effective date” must have been meant.

In light of the above findings, the EBoA concludes that the prohibition on double patenting also extends to applications having a common priority. In the event of identity of applicants and identity of claimed subject-matter, the prohibition applies to all three constellations,

- 1) identical filing dates of the European application under examination, on the one hand, and of the granted European patent (or rather the European application on which it is based), on the other hand;

- 2) a parent-divisional relationship between the European application under examination and the granted European patent; and

- 3) identity of priority date, but difference in filing date, of the European application and the already-granted European patent.

The only further precondition that needs to be met for an objection of double patenting to be proper is that there must be overlap in EPC country designations.

RELEVANCE IN PRACTICE

The first constellation, i.e. two European patent applications having the same filing date and relating to the same subject-matter, but not being related by family/priority, seems to be rare in practice. Only one of the applications can be taken to grant, and the other application will be objected to by the EPO if it claims the same subject-matter and has the same applicant/patentee.

Regarding the third constellation, if a follow-up European patent application claims priority from a European patent application, the conclusion is that the priority application should not be taken to grant, even if having received a positive indication of patentability in a European Search Report. Rather, this allowable claim scope is best pursued in the follow-up European application, to take full advantage of the additional 12 months of patent protection.

The second constellation seems to be the most relevant in practice, where the two European applications, one already having proceeded to grant of patent, are in a parent-divisional relationship. Unfortunately, the EBoA in G4/19 does not answer important follow-up questions, and leaves room for further discussion:

- 1) How is it to be assessed whether the two claim sets, i.e. the claims of the already-granted European patent and the claims of the European patent application under examination, claim “*the same subject-matter*”?

- 2) Is *any* difference in claim scope sufficient to render an objection of double patenting moot? Does an objection of double patenting arise if the claim scope pursued in the (still-pending) divisional patent application is in part broader than the claim scope of the already-granted (parent) patent? What about the situation where the claim scope of the European patent application is broader and fully encompasses the claim scope of the already-granted parent patent? What about a divisional patent application with claims that are fully within the scope of the claims of the already-granted patent?

- 3) Can a double patenting objection be overcome easily by transferring the European patent application to a party that is different from the patentee of the already-granted European patent?

These follow-up questions will ultimately have to be decided by case law, presumably by a further decision of the Enlarged Board of Appeal of the EPO. If you have any questions in the meantime, please contact:

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ⁱ In the case at hand (follow-up application EP10718590.2), there was identity of applicants and identity of claimed subject-matter (with priority application EP09159932.4).

ⁱⁱ As the referral to the EBoA would have been inadmissible had the questions as phrased by T0318/14 been interpreted more broadly, as also covering these further questions.

ⁱⁱⁱ For instance, a national German patent simply ceases to have effect to the extent a European patent with effect for Germany claims priority from a German patent application that the granted German patent is based on (Article II Section 8(1) of the German Law on International Patent Conventions. Similarly, Section 18 () 5 of the UK Patents Act stipulates that, if a UK patent and a European patent (UK) have been granted for

the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, the Comptroller shall give the proprietor of the UK patent an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.

^{iv} In the following, the filing date or, if priority is validly claimed, priority date, of the European application or patent will be referred to as "the effective date".