

ARTICLE

WILL THE ENLARGED BOARD OF APPEAL RESCUE THE DOUBLE PATENTING PRACTICE ?

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In 2007, the Enlarged Board of Appeal adopted the principle of the prohibition of double patenting^[1], and this principle was then integrated into the Guidelines^[2]. The cases leading to the 2007 decisions were based on divisional applications.

The issue of double patenting is again presented before the Enlarged Board in the G4/19 case, this time in a case concerning internal priority. The Enlarged Board is questioned ^[3]

- on the existence of a legal basis prohibiting double patenting,
- on the application of this prohibition in cases of parallel filings, divisional applications and internal priority, and
- on the applicant's legitimate interest in obtaining the grant of a European patent application on the basis of a subsequent European patent application (internal priority)^[4] .

The solution of the Enlarged Board could have the consequence of calling into question the current practice of the European Patent Office (EPO), or to broaden this practice and to clarify the basis and the conditions for application of the prohibition of double patenting. In the meantime, all examination, limitation and opposition proceedings in which the outcome depends "entirely" on the decision of the Enlarged Board, are stayed^[5].

In the case that gave rise to the referral, the Examining Division refused a patent application from Société des Produits Nestlé as its claims was directed to a subject-matter that was "100% identical"^[6] to its priority, as granted. For the Examining Division, this is therefore a case of double patenting (identity of: applicant, effective date, claimed subject-matter and at least part of the territories) between two European applications, commonly referred to as internal priority.

The questioning of the prohibition of double patenting based on Article 125 of the European Patent Convention (EPC) by the Board of Appeal

Article 125 of the EPC provides that in the absence of a procedural provisions in the EPC, the EPO shall take into account principles generally recognized in the the Contracting States in this matter^[7].

The Board of Appeal which referred to the Enlarged Board of Appeal rejected the application of article 125 of the EPC, stating that:

- The prohibition of double patenting would constitute a ground for rejection amounting to an additional requirements of patentability and would exceed the purpose of Article 125 of the EPC^[8].
- It appears from the travaux préparatoires that there was at least one dissenting opinion and that there was therefore no unanimous agreement^[9].

It is followed in this by many *Amicus Curiae*^[10].

Conversely, the President of the EPO considers that Article 125 EPC could serve as a basis for this prohibition^[11]. Indeed, the President of the EPO affirms that the conditions for the application of Article 125 of the EPC are met, because there is no legal provision in the EPC on double patenting^[12] (i), that this principle does not necessarily need be exclusively of procedural law^[13] (ii) and that there is a generally recognized procedural principle (iii).

In the search for a generally recognized procedural principle, the President of the EPO and AIPPI refer to different procedural principles.

For the President of the EPO, there is a general principle of the prohibition of double patenting which can be deduced from the travaux préparatoires of the EPC^[14], the national legislations of the Contracting States^[15] and Article 4(2) of Regulation 1257/2012 on patents with unitary effect^[16].

On its side, AIPPI refers to the general principle of abuse of process^[17]. AIPPI also notes that this principle exists in the United Kingdom and Ireland.

The conditions for the implementation of such a prohibition are eagerly awaited. It could be an opportunity to redefine the balance between the legitimate interest of the applicant and the legal certainty for third parties.





For the President of the EPO, the absence of legitimate interest to have multiple patents for the same invention is presumed when the applications have: an identical effective date, an identical applicant, an identical subject matter and an at least partially identical territory (in this case, the President of the EPO considers that the applicant has a legitimate interest in obtaining an additional year's protection by choosing to proceed with successive patent applications, but it is recalled that two identical patents cannot coexist)[18].

In addition, the President of the EPO specifies that the assignment of one of the applications should not allow to dismiss an objection based on the prohibition of double patenting[19]. Moreover, the applicant has no legitimate interest in obtaining a second patent for an identical subject matter to an earlier application which the applicant himself has withdrawn or amended[20]. On the contrary, many *Amicus Curiae* develop long lists of examples of legitimate interests[21].

In conclusion, the decision of the Enlarged Board of Appeal should clarify the practice of the EPO to either maintain (or even broaden) the *status quo* on double patentability, or, alternatively, put an end to this practice and let the Contracting States meet and amend the EPC. The prohibition of double patenting is not always strictly applied by the EPO, giving rise to objectionable practices. Some applicants, particularly in the pharmaceutical field, multiply patents of the same family with subject-matters that are at least very close - or even identical (up to eleven applications in the same family, over 4 generations).

[1] G1/05 and G1/06

[2] EPO Examination Guidelines: G-IV, 5.4

[3] The questions put by the Board of Appeal in decision T318/14 are as follows:

1. Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent which was granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC ?

2. If the answer to the first question is yes, what are the conditions for such a refusal, and are different conditions to be applied depending on whether the European patent application under examination was filed

a. On the same date as, or

b. As a European divisional application (Article 76(1) EPC) in respect of, or

c. Claiming the priority (Article 88 EPC) in respect of a European patent application on the basis of which a European patent was granted to the same applicant?

2.2 In particular, in the last of these cases, does an applicant have a legitimate interest in the grant of a patent on the (subsequent) European patent application in view of the fact that the filing date and not the priority date is the relevant date for calculating the term of the European patent under Article 63(1) EPC ?

[4] Interlocutory Decision T318/14 February 7, 2019

[5] Notice from the European Patent Office, of February 10, 2020, concerning the staying of proceedings due to the referral G 4/19: OJ 2020, A20

[6] Decision of the Examining Division September 26, 2013

[7] The application of this article requires that two cumulative conditions are met: the absence of a procedural provision in the EPC (i), that the procedural principle invoked is generally accepted in the Contracting States (ii).

[8] Paragraphs 63 and 64 of Interlocutory Decision T318/14

[9] Paragraph 73 of Interlocutory Decision T318/14

[10] Notably: the *Amicus curiae* of the EPI, the Chartered Institute of Patent attorney (CIPA) and the CNCPPI

[11] Paragraphs 72 and 85 of the Comments of the President of the EPO of September 21, 2020

[12] Paragraphs 67 and following of the Comments of the President of the EPO September 21, 2020

[13] Paragraph 71 of the Comments of the President of the EPO of September 21, 2020

[14] See paragraph 75 of the Comments of the President of the EPO September 21, 2020.



[15] See paragraph 80 of the [Comments of the President of the EPO](#) September 21, 2020.

[16] Article 4(2) of Regulation 1257/2012 provides that: "*The participating Member States shall take the necessary measures to ensure that, where the unitary effect of a European patent has been registered and extends to their territory, such European patent shall be deemed not to have taken effect as a national patent in their territory on the date of publication of the mention of the grant in the European Patent Bulletin.*" »

[17] AIPPI Amicus Curiae of October 1, 2020

[18] Paragraph 118 of the Comments of the President of the EPO September 21, 2020: withdrawal or amendment of the EP priority application.

[19] Paragraph 122 of the Comments of the President of the EPO September 21, 2020

[20] Paragraph 124 of the Comments of the President of the EPO September 21, 2020

[21] Notably: the Amicus curiae of the EPI
