Double Patenting in the EPO

The issue of "double patenting" arises in the EPO when one applicant files two European patent applications with closely related claims and the same effective filing date. Two situations where double patenting commonly needs to be considered are:

- when the claims of a divisional application overlap with the claims of its parent application; and
- when a first European patent application claims priority from a second European patent application and the claims of the first application overlap with the claims of the second application.

Under such circumstances it is necessary to determine how much overlap between the claims of the two applications should be permitted. The case law has developed such that the EPO will generally allow substantial overlap between the claims.

Double Patenting Law and Practice in the EPO

The European Patent Convention (EPC) contains no explicit statutory prohibition against double patenting. However, the Guidelines for Examination in the EPO indicate that "it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention" (Guidelines, section G-IV-5.4).

Our day-to-day experience of prosecution in the EPO is that substantial overlap between the claims is permitted. If we obtain grant of claims to a narrow species in a parent application, the EPO is very likely to allow claims to a broader genus that encompasses the species in a divisional application (and vice versa). For example, a parent application could contain a claim specifying copper, and a divisional application could contain a broader claim specifying any metal. We find that objections of double patenting are generally upheld only where there is no practical difference between the subject-matter of the claims.

Consistent with our experience, the Guidelines for Examination in the EPO state that:

"… in the rare case in which there are two or more European applications from the same applicant … and the claims of those applications … 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."

and that

"If the claims … are merely partially overlapping, no objection should be raised."

This approach is supported by the case law of the EPO's Boards of Appeal, as summarised below.

In Board of Appeal Decision T587/98 (Divisional claim conflicting with parent/Komag, Inc.), a European patent was granted with relatively narrow claims, and the applicant filed a divisional application to try to secure grant of broader claims whose scope covered the granted parent case claims. The Board decided it was allowable to pursue such overlapping claims.

In G1/05, the EPO's Enlarged Board of Appeal accepted 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". Thus, the Enlarged Board did acknowledge that, at least in some situations, an objection of double patenting might be applied in order to reject a European patent application.

However, we believe that the reference by the Enlarged Board to the "same subject-matter" can be correlated with the reference to "identical subject-matter" in the EPO's Guidelines for Examination. Indeed, G1/05 is expressly referred to in this section of the Guidelines. On that basis, G1/05 does not prevent applicants from pursuing two patents for non-identical, but overlapping, subject-matter.

In another Enlarged Board case, G2/10, the Board noted that an applicant may, for example, be interested in obtaining a first, quicker protection for a preferred embodiment and pursuing a general teaching in a divisional application. The Board stated that such procedural behaviour is not abusive and is even legitimate. The Board also hinted that there are circumstances in which a proviso (or a "disclaimer" to use the EPO's jargon) of subject-matter in a potentially conflicting claim may be used to avoid double patenting.

In Board of Appeal Decision T307/03 (Double patenting/ARCO), which issued shortly after G1/05 in July 2007, an unusually harsh line was taken on the scope of the prohibition against double patenting. For some time, this Decision led to a view that double patenting objections may be raised more frequently than had previously been the case.

In more detail, the Board in T307/03 denied a "legitimate interest" within the meaning discussed in G1/05 and therefore refused a divisional application for double patenting over its parent case. The claims of the divisional application fully encompassed the claims granted in the parent patent. The Board took the view that the claims of the parent and divisional had the same subject-matter at their hearts and that the Applicant was trying to use the divisional to re-patent subject-matter found to be unpatentable in the opposition against the parent patent. However, the Board's reasoning in this Decision has been criticised because it relied on a provision in the European Patent Convention, Article 60 EPC, that says nothing about double patenting and whose purpose is instead to define to whom the

right to a European patent belongs.

The reasoning of the Board in T307/03 has since been disregarded, and even expressly disapproved, in a growing number of further Board of Appeal Decisions. For example, T307/03 was criticised in T1423/07 (Cyclic amide derivative/Boehringer Ingelheim Vetmedica GmbH). Double patenting objections raised by Examining Divisions or Opponents in relation to overlapping, but non-identical, claims have also since been rejected in cases such as T1391/07 (Thermal-type air flow measuring instrument/Hitachi, Ltd., et al.), T877/06 (Filter Element/Donaldson Company, Inc.), T2402/10 (Prostaglandin derivatives/Pfizer) and T1491/06 (Apparatus for preventing rounding errors/Sony Corporation).

Significantly, the Board in T1391/07 expressly stated that it saw

"… no basis for extending [the scope of a double patenting objection] to cover claims … conferring … a scope of protection overlapping with each other only partially in the sense that some, but not all of the embodiments notionally encompassed by one of the claims would also be encompassed by the other one of the claims."

This conclusion was specifically approved in T877/06 and T1491/06, and indeed its reasoning is clearly reflected in the latest version of the EPO's Guidelines for Examination, as discussed above.

The above case T1423/07 is interesting for another reason, in that it addressed a situation where the claims of two European patent applications were substantially identical. In this case, the Board of Appeal decided that there was a "legitimate interest" to obtain two patents of identical scope as the second application claimed priority from the first application (rather than being a divisional application) and therefore had an extra year of patent term. The Board decided that the second application could be allowed to proceed with claims that were identical to claims already granted in the parent application. However, this approach conflicts with an Enlarged Board of Appeal decision, G 4/19, which issued more recently and is discussed below. It therefore seems unlikely that Boards will follow the approach taken in T1423/07 in the future.

In 2014 the Board of Appeal in T1780/12 (Cancer Treatment/Board of Regents, The University of Texas System) considered a divisional application relating to the second medical use of a known substance. The claims were presented in the purpose-limited product form that has been permitted since EPC 2000 entered into force on 13 December 2007. The Examining Division had refused the divisional application for double patenting over the parent application, which contained corresponding claims in purpose-limited use form.[1]

In overturning the refusal, the Board of Appeal stated that such purpose-limited product claims relate to different subject-matter and have a different scope of protection from claims in the purpose-limited use form. The Board thus concluded that granting the claims would not lead to double patenting.

Decision G 4/19 of the Enlarged Board of Appeal

In G 4/19, the Enlarged Board confirmed that the EPO can rely upon Article 125 EPC as the legal basis to refuse applications for unallowable double patenting, despite there being no explicit statutory prohibition.

In contrast to T1423/07 discussed above, the Board held that an application can be refused for double patenting when it claims priority from a previous application directed to "the same subject-matter" (regardless of the extra patent term enjoyed by the later application).

In light of this, the Board did not feel that it needed to address the question of whether or not the additional term enjoyed by the later application constitutes a "legitimate interest" in obtaining two patents of identical scope. It appears that the Board considered the bar against double patenting for the same subject matter to be absolute, with no exceptions where a "legitimate interest" exists.

Conclusion and Practical Points

The EPO's case law suggests that double patenting objections are unlikely to arise provided that the claims in question can be shown to have non-identical scope. A mere difference in wording of claims is unlikely to suffice. However, a double patenting objection should be avoided where one of the claim sets contains a meaningful feature that is not present in the other claim set.

Please do not hesitate to contact us should you have any questions or require any advice about the issues raised in this briefing.

Footnotes

1. The claim form "use of X for the manufacture of a medicament for therapeutic application Y" was approved by the Enlarged Board of Appeal in its decision G 5/83 (EISAI) and until December 2007 was the only means of claiming second and further medical indications of a known substance or composition having a previously known medical utility. Such claims remain available for European applications that have a priority date of earlier 29 January 2011 (for later applications only the purpose-limited product claim form is permitted).

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