

Double Patenting under the EPC?

*A spotlight on the decision G 4/2019
of the Enlarged Board of Appeal of the EPO*

TBK

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1. Introduction

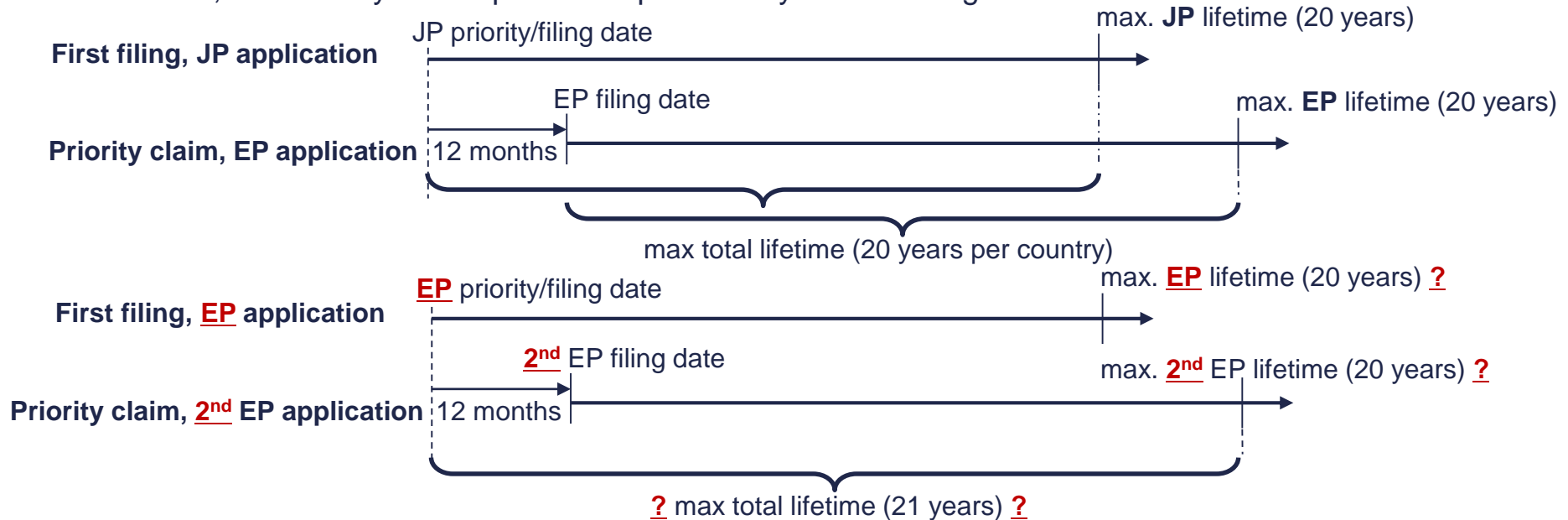
1.1. Pre-requisites - legal framework

- Pre-requisites for grant of patent:
 - Single invention per patent (application)
 - Art. 82 EPC: „... *shall relate to one invention only*...”
 - No patent protection beyond 20 year limit
 - Art. 63 EPC: „...*term ...of the patent shall be 20 years from the date of filing*“
 - No double patenting (cf. Guidelines for Examination Part G, Chapter IV, sec. 5.4)
 - accepted principle in most patent systems:
 - “*two patents cannot be granted to the same applicant for one invention*”
 - “... an applicant has *no legitimate interest* in ...the grant of a second patent for the same subject-matter, if the applicant already possesses one granted patent for that subject-matter” (see [G 1/05](#), and [G 1/06](#)).

1. Introduction

1.2. “Playing the game” by claiming priority?

- Maximum of 21 years of protection for one invention by claiming *European* priority?
- However, limit of 20 years of protection per country as from filing date



- Extension of protection via 2nd EP up to 21 years for the same invention?

2. Double Patenting

2.1. Details

- The EPC does not explicitly deal with the case of co-pending European applications of the same effective date filed by the same applicant
- However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one, i.e. “the same”, invention due to lack of legitimate interest
- Double patenting typically needs to be considered when the claims of a divisional application overlap with the claims of its parent application
 - Necessity to determine how much overlap between the claims of the two applications is permissible
 - mere (partial) overlap does not prejudice the grant of a patent
 - „same subject matter / invention claimed“ is typically not present, if one differing feature is present

2. Double Patenting

2.2. Prohibited and Permissible

- The prohibition of double patenting applies to three types of combinations of European applications by the same applicant
 - two applications filed on the same day
 - a parent and its divisional application
 - an application and its (European) priority application
- However, it is permissible to allow an applicant to proceed with two applications having the same description which do not claim the same subject-matter
- 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

2. Double Patenting

2.3. Actions to avoid double-patenting

- In the rare case in which there are two or more European applications from the same applicant 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 applicant should be invited to perform one of the following:
 - amend one or more of the applications in such a manner that the subject-matter of the claims of the applications is not identical
 - withdraw overlapping designations
 - choose which one of those applications is to proceed to grant
- If the applicant does not do so, once one of the applications is granted, the other(s) will be refused under Art. 97(2) EPC in conjunction with Art. 125 EPC.

2. Double Patenting

2.4. Exceptions

- However, if the claims of those applications (*two or more European applications from the same applicant 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*) are merely partially overlapping, no objection should be raised
- Should two applications of the same effective date be received from two different applicants, each must be allowed to proceed as though the other application did not exist.
- Although the issue of “Double Patenting” has been known for years, it is still is a “hot topic”
→ the EPO’s Enlarged Board of Appeal decision G 4/19 (Double patenting) – June 22, 2021

3. Decision G 4/19 (Double patenting) – June 22, 2021

3.1. Basics

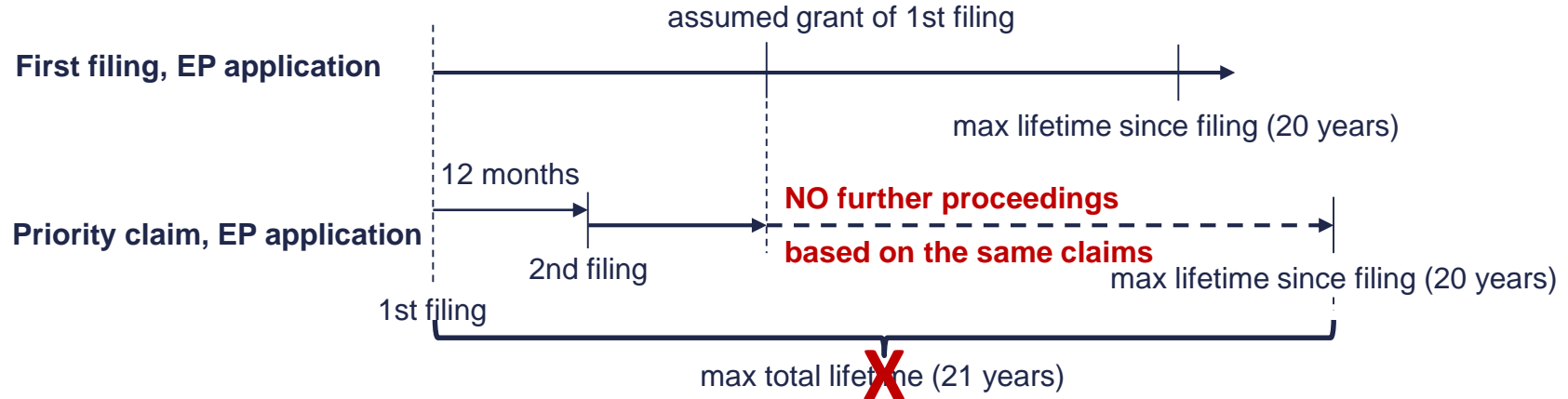
- A European patent application claiming the same subject matter as a *granted* European patent (i.e., not just a co-pending EP application) which has been granted to the same applicant and has the same effective date can be refused.
- Refusal is possible, irrespective of the following:
 - Whether it was filed on the same date as the European patent already granted
 - Whether it is a parent application or a divisional application of the European patent already granted
 - Whether it claims the same priority as the European patent already granted.
- For an applicant, several important aspects/consequences may arise from G 4/19 (Double patenting)

Full text of the decision: <https://www.epo.org/law-practice/case-law-appeals/recent/t140318ex1.html>

3. Decision G 4/19 (Double patenting) – June 22, 2021

3.2. Details to consider

- Applicant may keep in mind, that if he has already achieved grant of an EP patent on a certain subject matter, grant of claims for the “*same*” subject matter in later examination proceedings is denied
- Applies, too, if the patent that was granted earlier is the priority application of the later-examined application
- The “advantage” of a longer term of protection (due to the later filing date) will not occur for the applicant
- Longer patent term is not regarded as legitimate interest for allowing such double patenting



4. Conclusion

- ❖ Watch your IP portfolio & “keep an eye” on your patent family’s development, especially if one family member is granted
- ❖ However, G 4/19 still leaves some aspects open
 - The extend of “overlap” was not discussed/evaluated → the concept of “*same subject matter*” was not addressed by eBoA, i.e. the question what “*overlap*” precisely means still remains unclear
 - Previous case law not overruled: 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
(see e.g.: https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clr_ii_f_5_1.htm)
 - Applicability of the rules on double patenting in opposition proceedings: not answered.

Previous case law still to consider: It is within the discretion of the ...EPO to raise the objection in opposition or opposition appeal proceedings against ...*amended claims*, but ...only *in clear cases*.

Though, “double patenting” is still *no reason for opposition*.

(see e.g.: https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clr_ii_f_5_3.htm)

Please feel free to ask questions!



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