



Update on G 4/19 – Enlarged Board of Appeal referral on double patenting

The referring Board's written decision sheds further light on the points of law to be considered by the Enlarged Board and the referral's possible implications

Following the publication of the minutes of oral proceedings in February 2019 (reported in our earlier note [here](#)), in December 2019 Technical Board of Appeal 3.3.01 issued its long-awaited written decision in case T 318/14 (available [here](#)).

The decision refers questions to the Enlarged Board of Appeal on the EPO's practice of prohibiting double patenting. The referral is now pending as case G 4/19.

Key points

The referred questions

The Enlarged Board has been asked to consider three questions, which can be summarised as follows:

1. What is the legal basis, if any, for refusal of a European patent application where the applicant has already obtained a European patent for the same subject-matter?
2. If there is legal basis, do the conditions for refusal differ depending on whether the conflicting applications are parallel European filings, a European parent and its divisional or a European filing claiming the priority of another European application ('internal priority')?

3. In the case of internal priority, does an applicant have a legitimate interest in the grant of a second patent on the priority-claiming European application in view of the fact that the patent would expire later than a patent granted on the earlier application?

Timeline

Based on the average of the timelines in the 10 most recent referrals to the Enlarged Board, we expect a decision in G 4/19 around mid-2021.

Stay of proceedings

In the meantime, the President of the EPO has issued an Official Notice (OJ 2020, A20; available [here](#)), announcing that all proceedings before EPO examining divisions (including limitation proceedings) and opposition divisions in which the decision depends entirely on the outcome of G 4/19 will be stayed *ex officio* until the Enlarged Board issues its decision. The EPO's Guidelines ([E-VII, 3](#)) also mention that proceedings may be stayed on request of a party or the parties.



According to the Official Notice, cases that might be stayed are those in which the claims define the 'same subject-matter' as a European patent granted to the same applicant and having the same effective date and where there is at least overlapping territorial scope of protection.

The scope of the term 'same subject-matter'

The referring Board's decision suggests that the referral will focus on the legal basis and conditions for the prohibition on double patenting between conflicting European filings that have *identical* claim scope (e.g. point 23). Indeed, the referring decision states that any questions of whether double patenting may also exist between claims of non-identical (e.g. overlapping or encompassing) scope are not relevant to the case at hand (point 24, last paragraph).

Therefore, the Enlarged Board may not give guidance on the degree of similarity required between two sets of claims in order to trigger a double patenting objection.

Assessment of double patenting in EPO post-grant proceedings

In the case that led to this referral, the double patenting problems arose during pre-grant examination proceedings.

Double patenting is not listed as one of the aspects to be examined during EPO post-grant limitation proceedings (Rule 95(2) EPC). Double patenting is also not listed as a ground for opposition (Article 100 EPC). T 936/04, however, states that 'in clear cases' it is within the discretion of the EPO to raise a double patenting objection in opposition or appeal proceedings against amended claims that are filed during those proceedings.

The referring Board's decision states that the applicability of any double patenting prohibition during post-grant proceedings is outside of the scope of the referral (point 31, second paragraph).

Nevertheless, we note that the EPO's Official Notice mentioned above states that opposition and limitation proceedings may also be stayed if their outcome depends entirely on the Enlarged Board's decision in G 4/19.

It is therefore possible that the Enlarged Board may provide some guidance on the relevance of double patenting in limitation and opposition proceedings.

Potential implications of the Enlarged Board's decision

The Enlarged Board's answers could have broad implications.

For example, the Enlarged Board might decide that the EPO cannot, as things stand, refuse European patent applications on the basis of double patenting because there is no legal basis to do so. Applicants could then obtain multiple European patents with identical claims, potentially over a period of time, and those patents could in principle take effect in the same state(s) – subject to any relevant national law. Such an outcome would therefore likely shift the issue to national proceedings of the contracting states.

The Enlarged Board might alternatively confirm that the EPO can continue to refuse European patent applications on the basis of double patenting *unless* the applicant is deemed to have a legitimate interest in the grant of a further patent. Such an outcome is likely to raise further questions regarding the precise situations in which such a 'legitimate interest' may be acknowledged, for example in light of potentially different publication dates of the European patent applications and hence different start dates of provisional protection under Article 67 EPC, the possibility of covering a different territorial scope, the risk of oppositions or national validity challenges, etc.



More detailed analysis and commentary

The EPO's current practice on double patenting

An objection of double patenting is typically raised during EPO pre-grant examination proceedings where identical subject-matter is pursued by the same applicant in two or more European applications (or in a pending European application and a granted European patent) that have the same effective filing date and designate the same state(s).

The practice is not based on any explicit provision in the EPC but is based, for example, on *obiter dictum* statements in Enlarged Board decisions G 1/05 and G 1/06. In these decisions, the Enlarged Board said that an applicant has no 'legitimate interest' in the grant of a second patent to the same subject-matter. More specifically, at point 13.4 of G 1/05 and G 1/06 the Enlarged Board said:

"The Board accepts 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 if he already possesses one granted patent therefor. Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent."

Accordingly, the EPO's Guidelines for Examination ([G-IV, 5.4](#)) set out that an application may, in certain situations, be refused on the basis of double patenting:

"... 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 withdraw overlapping designations, or choose which one of those applications he wishes to proceed to grant. If he does not do so, once one of the applications is granted, the other(s) will be refused under Art. 97(2) in conjunction with Art. 125."

The EPO's current practice therefore avoids the situation where an applicant could obtain multiple granted European patents having identical scope of protection and potentially taking effect in the same territory.

The case underlying this referral

A similar situation unfolded in the case underlying this referral. Nestec S.A. filed a first European patent application, 09159932.4, on 11th May 2009. In 2012, the first application was granted as European patent EP2251021B1, with claim 1 reciting: *"Composition comprising Bifidobacterium breve CNCM I-3865 (NCC2950) for use in the treatment or prevention of allergic diarrhoea"*.

On 7th May 2010, Nestec S.A. filed a second European patent application, 10718590.2, claiming priority from that earlier application. In the second application, Nestec pursued claims that are in substance identical to those already granted on the first application, with only minor differences in wording. For example, claim 1 of the second application reads: *"Composition comprising Bifidobacterium breve CNCM I-3865 (NCC2950) for treating or preventing allergic diarrhoea"*.

Consistent with the EPO's practice set out above, the Examining Division refused the second application on the basis of double patenting, stating that the claims are identical to those already granted for the first application. Nestec appealed the refusal to the Technical Board of Appeal, which resulted in the present referral to the Enlarged Board of Appeal.



The decision of the Technical Board to refer questions to the Enlarged Board

The Technical Board's written decision spans some 80 paragraphs and explores in detail the legislative history and case law surrounding the EPO's practice on double patenting. It highlights those aspects which, according to Board 3.3.01, require clarification by the Enlarged Board.

The Technical Board first considered Nestec's argument that G 1/05 and G 1/06 are not applicable to a situation of internal priority, on the basis that, in point 13.4, second sentence, of G 1/05 and G 1/06 the Enlarged Board referred to double patenting specifically between parent and divisional applications only. However, the first sentence in point 13.4 is worded in more general terms. On that basis, the Technical Board concluded that G 1/05 and G 1/06 set out a general principle that is not limited to parent and divisional applications and therefore also applies, in principle, to double patenting in the situation of internal priority (point 14).

The Technical Board next considered whether there is nevertheless a 'legitimate interest' in the applicant obtaining two patents with identical scope in the situation of internal priority, in light of the second patent's later maximum expiry date relative to the first patent.

Article 63(1) EPC provides that the term of a European patent shall be 20 years from the date of *filing* of the application. In the case at hand, the 20-year term of the first patent, i.e. the patent granted on the basis of the applicant's first application, would end on 11th May 2029. If the EPO granted the applicant a patent based on the second application, that patent's 20-year term would end around a year later, on 7th May 2030.

The additional period of protection constituted, according to Nestec, a legitimate interest in the grant of the second patent.

In an attempt to resolve the matter, the Technical Board considered in detail T 1423/07 and T 2461/10.

T 1423/07

In T 1423/07, Technical Board 3.3.02 seems to have acknowledged that an applicant may indeed have a legitimate interest in the grant of a second patent in the situation of internal priority, in light of the second patent's later expiry, therefore precluding a rejection on the ground of double patenting (point 2.2.4.1).

However, in that case, the applicant had additionally transferred the second application (from "Boehringer Ingelheim Pharma GmbH" to "Boehringer Ingelheim Vetmedica GmbH") some time after filing of the application. In light of the transfer, the Board held that "*... therefore, double patenting as defined above no longer exists ...*", because the patentee of the first application and the applicant of the second application were "*... no longer identical ...*" (point 2.4).

The second patent was therefore eventually deemed allowable by the Board, not because the applicant's legitimate interest in its grant was affirmed despite notional double patenting, but because the transfer was deemed to have resolved any double patenting issues that may have existed prior to the transfer.

This in itself arguably raises complicated questions regarding the concept of the "same applicant" in the context of double patenting, as opposed to, e.g., in the context of the right to claim priority (which extends to a person's successor in title) and the point in time at which it is to be assessed¹.

Footnotes:

¹ We note that in the case underlying this referral, following the oral hearing in February 2019 before the Technical Board, the applicant requested the recordal of a transfer (as the result of a company merger) at the EPO such that the second application now formally stands in the name of "Société des Produits Nestlé S.A." as the applicant, effective from 31st May 2019, for all designated states. While the first patent formally remains on the European Patent Register in the name of "Nestec S.A.", it appears that an equivalent transfer to "Société des Produits Nestlé S.A." has been registered directly at the various national patent offices. It is unclear whether the Enlarged Board will consider and comment on this development in its decision.



T 2461/10

In decision T 2461/10, Technical Board 3.3.08 cast doubt on the Board's reasoning in T 1423/07. Specifically, Board 3.3.08 noted that an *applicant's* interest in obtaining a second patent to, effectively, extend the term of protection for an invention, is not necessarily to be acknowledged as a *legitimate* interest. Indeed, the Enlarged Board in G 1/05 and G 1/06 stated in its *obiter dictum* that it is a general principle that "... *an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter ...*", which principle therefore must also apply where internal priority is involved.

The Board in T 2461/10 also questioned the legal consequences of allowing double patenting in cases of internal priority. More specifically, the Board noted that allowing double patenting in cases of internal priority effectively awards an applicant 21 years of patent protection for identical subject-matter (provided that the patents both take effect in one and the same state), which would be contrary to Article 63(1) EPC which foresees only 20 years of term. In the Board's view, the applicant should instead choose whether to proceed to grant with the priority application *or* the later application. However, the Board in T 2461/10 did not arrive at a final conclusion on this point – the Board had decided that, for a different reason, namely because the claimed subject-matter was found to be merely overlapping and not identical, there was no double patenting in that particular case.

The Board's comments in T 2461/10, however, casting doubt on T 1423/07 and pointing *towards* a prohibition of double patenting in the case of internal priority where the subject-matter is identical, seemed to chime with the Board in the present case. It concluded that it "... *sees some merit in the reservations expressed by the board in point 14 of T 2461/10. Article 63(1) EPC could be regarded as posing an obstacle to double patenting when it arises from internal priority, irrespective of whether the prohibition exists as a general principle*" (point 14).

In light of these apparent divergences in the EPO's case law, specifically where internal priority is involved, the Board concluded that the present appeal cannot be resolved "... *until this point of law is clarified by way of a referral to the Enlarged Board of Appeal ...*" (point 15).

Legal basis for the prohibition on double patenting

The remaining parts of the Board's decision deal with double patenting under the EPC more fundamentally, discussing in some detail whether there is any legal basis in the EPC at all for refusing a European patent application on the ground of double patenting with another European application/patent. The Board found that there is also conflicting case law in this regard.

In particular, Article 125 EPC (in conjunction with Article 97(2)) is currently cited in the EPO's Guidelines (G-IV, 5.4, above) as legal basis for refusing a European application on the basis of double patenting. However, having reviewed the legislative history of the EPC, the Board concluded that "... *it is doubtful that Article 125 EPC is an appropriate legal basis for prohibiting double patenting ...*" (point 64).

The Board finally considered whether, in the absence of legal basis in the EPC for prohibiting double patenting, there is nevertheless an 'unintended gap in the law' which the Enlarged Board should now fill by way of case law. The Board seems to suggest that the Enlarged Board should not do so – any prohibition on double patenting should be introduced, if at all, through "... *a proper legislative procedure ...*" to ensure that there is agreement between the contracting states on harmonising double patenting with respect to European patent applications.



The decision concludes with a summary of the Board's findings at paragraph 78, reproduced here:

"78. The main conclusions by the board can be summarised as follows:

- *There is no express provision in the EPC which prohibits double patenting.*
- *It is not clear whether such a prohibition became an implicit part of the Convention by way of an agreed statement or similar instrument adopted at the Munich Diplomatic Conference.*
- *The legislator did not introduce an express prohibition on double patenting at the Diplomatic Conference for the revision of the EPC in 2000. Article 139(3) EPC remained unchanged.*
- *A prohibition on double patenting cannot be based on Article 60(1) EPC.*
- *Neither Article 63(1) EPC nor Article 76(1) EPC offers scope for the idea of a prohibition on double patenting.*
- *It is questionable whether Article 125 EPC is appropriate as a legal basis for a prohibition on double patenting. This provision cannot serve to introduce a new condition for patentability (or a ground for refusal).*
- *Article 139(3) EPC deals with double protection resulting from parallel filing routes for the same territory. This matter is left entirely to national law.*
- *If a prohibition on double patenting with respect to European patent applications may be introduced at all, this could be by way of case law filling an unintended gap in the law. However, in view of the policy considerations involved, it appears that a proper legislative procedure would offer a more favorable context for establishing a sound legal basis for a prohibition on double patenting."*

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