



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Resolution of the Executive Committee, Barcelona, Spain, 2 to 5 November 2014

“Double Patenting”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Barcelona, Spain, 2 to 5 November 2014, passed the following Resolution:

Recognising that a fundamental principle underlying the patent system is that an applicant receives a time limited monopoly for the full scope of an invention as disclosed and claimed in one or more patent applications in exchange for disclosing the invention;

Observing that for various legitimate reasons an applicant may wish to pursue two or more patent applications for different variants or embodiments of an invention, for example by filing the applications simultaneously or by filing one or more applications divided or otherwise derived from their previously filed parent application, and the claims of these two or more applications may at least partially overlap in scope, and/or may relate to similar or related subject matter that is not considered to be patentably distinct;

Noting on the other hand that, in some jurisdictions, the patent authorities (patent office and/or courts) raise “double patenting” objections where co-pending applications and/or patents filed by the same applicant contain claims having at least partially overlapping scopes or relating to subject matter that is not patentably distinct, with the objective of avoiding a perceived possible harm to the public or third parties, which it is believed could result from granting the applicant multiple patents claiming similar or related inventions;

Observing that, in direct conflict with the fundamental principle underlying the patent system mentioned above, double patenting rejections may have the detrimental result that an applicant does not receive patent protection for certain variants or embodiments of the invention even though such variants or embodiments have been disclosed to the public in at least one of the patent applications, or the scope of protection obtained by an applicant might not be commensurate with the applicant’s full contribution to the art;

Believing that such resulting detriment to applicants significantly outweighs any perceived possible harm to the public or third parties which may result if multiple patents are granted to the same applicant;



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Further noting that the removal of the basis for such a double patenting objection by amending the claims to remove overlap between one patent application and another, or to render the claims of one patentably distinct with respect to the other, can often be difficult or impossible, and, if attempted, can leave substantial gaps in protection provided by the resultant amended claims;

Urges, in jurisdictions including specific provisions that prohibit double patenting:

- (1) that laws should be reviewed and, if necessary, amended in order to limit such provisions only to claims that have identical scope in co-pending applications and/or patents that have been filed by the same applicants, with the same effective filing date; or
- (2) if other types of double patenting objections must continue to be raised, including in circumstances where the claims of the two patents or applications are not patentably distinct or where claims simply overlap, that laws should be reviewed and, if necessary, amended so that an applicant or patentee can overcome the objection by a simple mechanism, such as offering to maintain common ownership between the two patents, without requiring amendment of the claims;

Also urges, in jurisdictions that do not include specific provisions to prohibit double patenting, but where double patenting objections are nonetheless raised:

- (1) that the patent authorities refrain from issuing double patenting rejections, and
- (2) that the patent authorities take steps to ensure that patents are not invalidated based on double patenting.