"The same invention or not the same invention": That is the question. But what is the answer?

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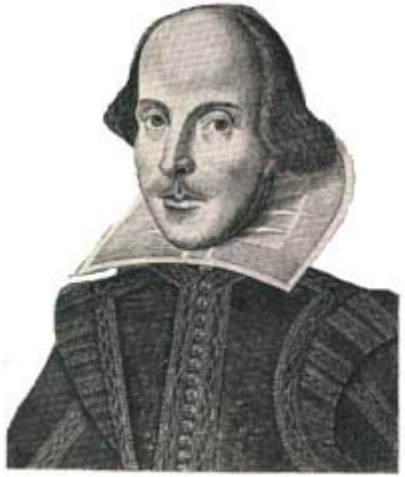

Hamlet:

Hamlet
"To be, or not to be, that is the question:
Whether 'tis nobler in the mind to suffer
The slings and arrows of outrageous fortune,
Or to take arms against a sea of troubles
And by opposing end them. To die—to sleep.
.....
The fair Ophelia! Nymph, in thy orisons
Be all my sins remembered."

Ophelia
"Good my lord,
How does your honour for this many a day?"

- *William Shakespeare, Hamlet Act 3, scene 1,*

Attempt at an interpretation:

- Whether or not Shakespeare endorsed Hamlet's sentiments, he rose to the occasion with a truly great speech on the perennial philosophical topic of human "being".
- TO BE, OR NOT TO BE, THAT IS THE QUESTION
- Hamlet doesn't simply ask whether life or death is preferable.
- Hamlet's dilemma is focused on life versus death or more precisely on action versus inaction.

"The same invention or not the same invention": That is the question.

- The definition of double patenting is an essential part of the answer:
- The established practice of the European Patent Office:
- An objection of double patenting should be raised if the subject-matter of one of the claims of the application under examination is identical to the subject-matter of a claim of another application from the same applicant or a granted patent therefor.
- The issue of double patenting arises in relation
  - to **divisional**-parent application,
  - between **priority-successive** application,
  - to **two (parallel) patent applications** filed by the same applicant on the same date claiming the same subject-matter.

Travaux préparatoires EPC 1973 (1)

*"The Working Party agreed that an **applicant wishing to protect the same invention** by means of several applications filed at the same time, **could only be granted a single patent**. It was the opinion that this was a **generally recognised**, if unwritten, legal **principle** and that a specific provision in the Convention was therefore not necessary."*

- *Doc. No. BR/144/71, point 117, page 64*
  10th meeting of the Working Party I of the Luxembourg Inter-Governmental Conference, 22-26 November 1971

Travaux préparatoires EPC 1973 (2)

- *"It was established at the request of the UK delegation that there was **majority agreement in the Main Committee** on the following: that it was a **generally recognised principle of procedural law in the Contracting States that a person can be granted only one European patent for the same invention** in respect of which there are several applications with the same date of filing."*

- *"The Norwegian delegation stated that it could not agree to this principle in its present general form since under Scandinavian law it was possible in theory to grant two patents to an applicant for the same invention."*

  - *Doc. No. M/PR/I points 665, 666, page 62*
    Minutes of the proceedings of Main Committee I of the
    Munich Diplomatic Conference, 10 September - 6 October 1973

Travaux préparatoires EPC 1973 (3)

- *"The **FICPI** delegation wondered what was meant in this instance by the **same application or the same patent; did it mean that the content was substantially the same or that the patent claims were substantially the same**?"*

- *"The UK delegation interpreted it as meaning that the **patent claims were the same**."*

  - *Doc. No. M/PR/I points 667, 668, page 62*
    Minutes of the proceedings of Main Committee I of the
    Munich Diplomatic Conference, 10 September - 6 October 1973

Case law of the Boards of Appeal (1)

- ***point 3.6***

  *"There is a legal presumption that the **institution of divisional application thus defined in the Convention is self-contained and complete**."*

  *"A prohibition, if any, of **"conflicting" claims** in the wide sense would be a **matter of substantive law rather than a matter of procedure - and Article 125 EPC is not applicable to substantive law**."*

- ***point 3.7***

  *"There is **no express or implicit provision** in the EPC **which prohibits** the presence in a divisional application of an independent claim which is related to an independent claim in the parent application (or patent if it has already been granted) in such a way that the 'parent' claim includes all the features of the 'divisional' claim **combined with an additional feature**."*

  T 0587/98, not published

Case law of the Boards of Appeal (2)

- ***point 13.4***

  *"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."*

  "However, this principle could not be relied on to prevent the filing of identical applications as this would run counter to the prevailing principle that conformity of applications with the EPC is to be assessed on the final version put forward."

- ***point 9.1***

  "(The Board accepts) the principle that the divisional application is a separate and independent application and is, if not specifically provided otherwise, to be treated in the same manner and subject to the same requirements as an ordinary application."

  G 1/05, OJ EPO 2008, 271; G 1/06, OJ EPO, 2008, 307

Case law of the Boards of Appeal (3)

- ***Point 2.1***

  *"**Article 60 EPC** states 'The right to a European patent shall belong to the inventor or his successor in title.'"*

  *"**From this** the Board deduces that under the EPC **the principle of prohibition of double patenting applies and that the inventor (or his successor in title) has a right to the grant of one and only one patent from the EPO for a particular invention as defined in a particular claim**."*

- ***Point 2.3***

  "The EPC, unlike certain national legislation, contains neither in the Convention itself nor in the Implementing Regulations thereto any specific provisions relating to double patenting. The Board does not regard this as decisive: "

  "double patenting is expensive and most patent proprietors would not wish to incur the expense. The legislator cannot be expected to have made provisions to regulate what will on grounds of economics alone be a very rare occurrence."

  *"The Board can recognize **no legitimate interest in anyone having two or more identical patents with the same claims and the same priority dates,** yet even this extreme case would have to be allowed if no prohibition of double patenting were considered to exist under the EPC."*

  T 0307/03, not published

Case law of the Boards of Appeal (4)

- ***Point 2.5***

  *"This Board's conclusion is also in line with point 9.1 of these Enlarged Board decisions (G 1/05 and G 1/06), as the application of **the principle of the prohibition of double patenting is independent** of whether the granted patent and the application were **originally co-pendent independent applications** or have resulted from one being a **divisional of the application for the other**."*

- ***Point 3.2***

  *"**The Board considers that once the earlier patent has been granted the double patenting objection exists irrespective of the fate of the granted patent being relied on for the double patenting objection**."*

  *"The background to this appeal illustrates one of the potential **evils which the prohibition of double patenting is designed to avoid**."*

  *"If the proprietors of the granted patent wishes to defend a claim in terms of claim 1 of the present Main Request, this should be in the appeal proceedings on the granted patent. To allow the patent proprietors to abandon the granted patent, but continue with some of the same claims in the present application would **simply lengthen the time until a final decision is reached** and **involve more instances of the EPO**."*

  *"Also the so-far successful **opponents to the patent granted on the parent application would not have a position as parties in proceedings on the present application**, even though the issues to be decided on the granted patent and the present application appear substantially identical. This would be unfair on them."*

  T 0307/03, not published

Case law of the Boards of Appeal (5)

- ***Point 2.5***

  *"To avoid this objection of double patenting the appellants would have had to **confine the claimed subject-matter** in the present application to subject-matter **not already patented in the patent granted on the parent application**."*

  *"This would then allow the examination procedure to focus on the question of whether this claimed subject-matter (for which there is not already a granted patent) meets the requirements of **Articles 123(2) and 83 EPC**, as well as the other requirements of the EPC."*

T 0307/03, not published

Case law of the Boards of Appeal (6)

- ***Point 2.2.5***
  *"Irrespective of whether or not the EPC lacks procedural provisions in connection with double patenting, **Article 125 EPC does not provide a basis for refusing a European application on the ground of double patenting**."*

- ***Point 2.3.2***
  *"**Contrary to** the reasoning applied in decision **T 307/03**, this board is convinced that the fact that the EPC does not contain any specific provisions relating to double patenting is decisive:"*

  *"in the absence of such provisions, **a refusal of a European patent application for double patenting is not possible irrespective of whether or not double patenting is a rare occurrence**."*

- ***Point 3***
  *"The Board concludes that the present decision is **not in contradiction** with decisions **G 1/05 and G 1/06**, so that a referral to the Enlarged Board of Appeal according to Article 112(1)(a) is not necessary."*

  T 1423/07, not published

Case law of the Boards of Appeal (7)

- **Travaux préparatoires EPC 1973**
  Generally recognised principle of procedural law in the Contracting States that a person can be granted only one European patent for the same invention

- **T 0587/98**
  Art. 125 EPC is not applicable to substantive law.

- **G 1/05, G 1/06**
  A 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.

- **T 0307/03**
  The principle of prohibition of double patenting **applies under Art. 60 EPC.**

- **T 1423/07**
  Neither Art. 125 EPC nor Art. 60 EPC provides a basis for refusing a European application on the ground of double patenting.

Balance of legitimate interests

- Legitimate interest in more than one patent for the same invention?
  - Inventor/Applicant?
- Legitimate interest in no more than one patent with identical subject matter?
  - Third parties/Public as the whole?
- Legitimate interest in no further prosecution of a patent application with identical subject matter to a granted patent?
  - Patent Offices?

Practice of the EPO (1)

- It is **permissible** to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions.

- An applicant of two or more applications definitively designating the same State or States and the claims of those applications having the same filing or priority date and relate to the same invention, should be told that he **must either amend one or more of the applications** in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant.

  – Guidelines for Examination C-IV, 7.4

Practice of the EPO (2)

- An **objection** of double patenting should **only** be raised if the **subject-matter of a claim** of the application is **identical** to the subject-matter of a claim of the related application. This only applies if the applicants of the two applications are the same.

Practice of the EPO (3)

- **Example 1:**
- Dependent claim 3 of the granted parent application relates to a composition comprising features a, b, c and d.
- Claim 1 of the divisional application also relates to a composition comprising features a, b, c and d.
- Claim 1 of the divisional application is **identical** to claim 3 of the granted parent application.
- Therefore an **objection of double patenting should be raised**.

Practice of the EPO (4)

- **Example 2:**
- Claim 1 of the divisional application relates to a composition comprising features a, b, c and d.
- Claim 1 of the parent application relates to a composition comprising features a, b and c.
- Claim 1 of the parent application is broader than claim 1 of the divisional application.
- **No objection of double patenting should be raised** since the two claims are **not identical**.

Amendments (1)

- ***Amendments (Article 123(2) EPC***

- ***Point 3.***

  "In order to determine whether or not the subject-matter of a claim in a patent extends beyond the content of the application as filed it has to be examined whether that ***claim comprises technical information which a skilled person would not have directly and unambiguously derived from the application as filed****."*

- ***Point 3.1***

  "Such an amendment resulting in ***isolating a specific feature from a particular embodiment and generalising it in a claim*** *would only be allowable, provided the* ***skilled man*** *would have readily recognised this feature as not so closely associated with the other features of this embodiment as to determine the effect of that feature of the invention as a whole in a unique manner and to a significant degree."*

  "To dismantle particular exemplary compositions into isolated features and ***to generalize one single feature thereof over the whole scope of claim 1 covering compositions with different components in different amounts provides the skilled person with technical information which is not directly and unambiguously derivable from the application as filed****."*

  – T 2017/07, not published

Amendments (2)

- ***Amendments (Article 123(2) EPC***

- ***Point 2.2***

  *"(If the wording 'consisting of' does not appear in the application as originally filed) the replacement in Claim 1 of '**comprising'** by '**consisting of' creates a criticality** as to the presence of only the metal complexes A_1, A_2 or A_3 and an activating cocatalyst in the composition which is not present as a subcombination in the application as originally filed. Claim 1 of the main request therefore contains added subject-matter."*

- ***Point 2.3***

  *"Thus, it is not appropriate to draw from the rather general statements the conclusion that no other component should be present during the formation of the composition, i.e. that the application as originally filed is directed to a composition **consisting of** metal complex and activating cocatalyst."*

  – T 1063/07, not published

Practice of the EPO

- **Disclaiming disclosed subject-matter**

- If a disclaimer excludes subject-matter corresponding to embodiments described in the original application as being part of the invention, the disclaimer cannot be allowed in view of Art 123(2) EPC if it is to restore novelty over an anticipation under Article 54(2) EPC that is not considered to be an accidental anticipation under G1/03.

- If a disclaimer excludes subject-matter corresponding to embodiments described in the original application as being part of the invention, the disclaimer can be allowed in view of Art 123(2) if it is to restore novelty over an accidental anticipation under Article 54(2) EPC or over a disclosure under Article 54(3) and (4) EPC or if it is to exclude subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.

Referral to the Enlarged Board of Appeal

- After deliberation by the Board, the following interlocutory decision was given:

- **To refer ex officio the following question to the Enlarged Board of Appeal:**

  "Does a disclaimer infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?"

  – T_1068/07 - 3.3.08, Minutes of the oral proceedings of 25 June 2010

The same invention or not the same invention": That is the question. But what is the answer?

- To be or not to be? The **answer** is given by the skilled person!
- No further patent should be given for identical subject-matter to the same applicant.
- The EPO has to draw a balance of legitimate interests.
- **No applicant has a legitimate interest in double patenting.**
- The competitor has a legitimate interest not to be confronted with more than one patent for the same invention with identical subject-matter in a claim.
- The concept of the "same invention" should not differ for the questions of novelty, claiming priority, selection inventions, admissible amendments, sufficiency of disclosure and double patenting.
- The question whether a disclaimer infringes Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed will be answered by the Enlarged Board of Appeal.

Europäisches Patentamt
European Patent Office
Office européen des brevets

Thank you for your attention!