



DOUBLE PATENTING

A FICPI STUDY



Outline

1. FICPI survey on double patenting.
2. Workshop and Resolution#1.
3. Conflicting applications Working Group.
4. ExCo and Resolution#2 on conflicting applications.



Double patenting

- Problems with double patenting encountered in Japan, Canada and New Zealand (in Japan double patenting can exist when no overlap).
- Carried out study, looking at double patenting when filing/priority dates are the same and where they are different.
- Results from 35 countries/regions presented at Workshop at ExCo in Kyoto in April 2014.
- Study highlighted wide range of approaches to double patenting.
- Resolution dealing with same filing/priority date situation passed in Barcelona in November in 2014.
- Resolution dealing with different filing/priority date situation passed in Toronto in June 2018.



Double patenting – Policy rationale

- Prevent inappropriate extension of patent term (eg, evergreening) (Canada, Czech Republic, Korea, New Zealand, and the United States).
- Double patenting conflicts with the nature of the exclusive rights provided by a patent (Australia, Korea, and Portugal).
- Prevent multiple infringement suits by different assignees asserting essentially the same patented invention (United States).
- Avoid confusion, public inconvenience, and public damage (New Zealand).
- Avoid cluttering the patent register (Czech Republic).



Double patenting – Policy rationale cont.

- Ensure cancellation proceedings are economically sustainable (Czech Republic).
- Needless to examine and grant protection for same subject matter twice (Colombia).
- Prevent a party from blocking the system by filing multiple identical applications on the same day (Greece).
- Prevent abuse of procedure (Greece).
- Applying for a patent requires a legitimate interest (Portugal).
- Res Judicata (Poland).



Double patenting – interesting results

- 9 countries (26%) do not permit double patenting objections to be raised when same applicant/inventors and the same filing/priority date (eg between parent and divisional).
- In the majority of countries (69%), only the claims of the “second” granted patent would be invalidated.
- In 3 countries, Singapore, Russia, and Korea, there is a risk that both patents may be invalidated based on double patenting.
- 13 countries (72%) of the 18 jurisdictions in which double patenting is a ground of invalidity of a granted patent allow the patent to be amended to overcome double patenting.
- Claims cannot be amended in Argentina, India, Poland, and Spain.



Double patenting workshop – Kyoto 2014

- A workshop was held at a FICPI ExCo meeting in Kyoto in April 2014.
- The results of the questionnaire were discussed and the various rationales for raising double patenting objections were considered.
- Focus of workshop was on same applicant/inventors and same filing/priority date since less complex.
- The main concern was that double patenting objections were being used to deny applicants protection for inventions they had made and for which they legitimately deserved protection.
- This concern needed to be weighed against the policy rationales for rejecting patents based on double patenting.
- The result was a resolution passed in Barcelona in November 2014.



FICPI resolution - Double Patenting

- **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;



FICPI resolution - Double Patenting

- **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;



FICPI resolution - Double patenting

- **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;
- **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;



FICPI resolution - Double patenting

- **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;



FICPI resolution - Double patenting

- **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.



FICPI resolution - Double patenting

- FICPI has discussed its resolution directly with IPONZ and JPO.
- Japan (and Korea) have a particular problem with double patenting between parent and divisional - see JP Article 39.
- Discussions are ongoing, but as yet no amendments.
- FICPI will continue efforts with JPO and IPONZ, and will discuss resolution with IPOS, CNIPA and KIPO.



Double patenting – conflicting applications

- In November 2002 WIPO's SCP focus its efforts on concluding a Substantive Patent Law Treaty (SPLT).
- Despite numerous meetings and draft possible SPLTs, negotiations were put on hold in 2006.
- In view of the continued interest of many WIPO member countries the Group B+ was established to move forward on substantive patent law harmonisation.
- One topic currently being considered by Group B+ is conflicting applications.



What is a conflicting application?

- A conflicting application is a patent application having a filing date (or priority date) earlier than that of an application or patent under consideration, but which was published later.
- Such an application is not true prior art in a first to file system, although it represents “secret” prior art in a first to invent system.
- In order to avoid double patenting, a patent system needs a mechanism for according priority to one applicant over another when applications are filed for the same invention.
- The terms “first to file” and “first to invent” are descriptions of the ways different patents systems have resolved this double patenting issue.



First-to-invent system

- The US pre-AIA patent system awarded priority to the first inventor, rather than the first-to-file.
- Interestingly, the post-AIA US patent system includes provisions carried over from the earlier first-to-invent system, such as the grace period, treatment of conflicting applications as prior art, and obviousness type double patenting.
- The US patent system has operated on first-to-invent principles for well over a hundred years, possibly since the first US Patent Act of 1790.
- An Examiner in charge of interferences was appointed in 1870.
- An earlier unpublished application is true prior art in the sense that it represents evidence of earlier invention.



First-to-file system

- The UK only adopted a first-to-file system in 1883 (same year as Paris Convention).
- Prior to 1883 patents were granted to the first applicant to prosecute their application through to grant.
- Once the first patent was granted for an invention, it was not possible to grant another patent to a different applicant for that same invention.
- This was the result of a decision *In Re Bates and Redgate's* application, L.R. 4 Ch. 577 (1869).
- However, where both applications were filed on the same day, separate patents could be granted to both applicants. See *In Re Dering's* patent 13 Ch 393. (1879).



First-to-file system

- The UK Patents Act was amended in 1883 to include a provision which accorded priority to the first applicant: first-to-file.
- In 1907 a “prior claiming” approach was adopted to accord priority to the first applicant, while avoiding double patenting.
- This required the later applicant to subtract from their claims subject matter claimed in a patent granted on an earlier application.
- If the earlier application or patent was abandoned, or the claims amended to remove the overlap, later applicant received full protection.
- Prior claiming is still the test in India, and, until recently was applied in other countries such as Australia and New Zealand. Also applied in DE and FR prior to EPC, and in JP (and KR) until 1970s.



Problems with prior claiming

- Delay was a problem - the later filing applicant was required to wait until the fate of the earlier application (or applications) was known before examination could be completed.
- The prior claiming system did not allow an earlier applicant to confidently dedicate their invention to the public (in view of potential for later applicant to obtain a patent).
- The problems led to adoption of the "whole of contents novelty" approach to prevention of double patenting found in the EPC, and adopted in various other countries, including AU, NZ and SG.
- Similar approach adopted in JP, KR and CN without reference to "novelty" or "prior art" (protection against self collision in JP/KR).



Prior claiming to whole of contents

- First move - Strasbourg Convention on Unification of Certain Points of Substantive Law on Patents for Inventions 1963.
- From 1961 to 1963 the Council of Europe, through the Bureau of the Committee of Experts on Patents, carried out work on the development of a *Convention on Unification of Certain Points of Substantive Law on Patents for Inventions*.
- There was significant debate about the treatment of conflicting applications
- The Committee of National Institutes of Patent Agents (CNIPA) was particularly concerned about any attempt to include unpublished matter in the state of the art – preferring a prior claiming approach.



Prior claiming to whole of contents

- Final Convention included Articles 4 and 5.
- Article 4 specified that contracting states “may consider” the content of an earlier filed application as “comprised in the state of the art”.
- Article 5 permitted contracting states to exclude earlier filed applications from the state of the art for the assessment of inventive step.
- Accordingly, it was optional whether or not a contracting State considered the whole of contents of an earlier filed later published application as part of the state of the art.
- Even if a country did decide to include it as part of the state of the art, there was a further option to exclude it from any assessment of inventive step.



European Patent Convention

- On 21 May 1969 the “Inter-Governmental Conference for the setting up of a European System for the Grant of Patents” decided to draw up a draft Convention.
- The first preliminary draft stipulated in Article 11(3) that the contents of an earlier application for a European patent published on or after the filing date or priority date would be considered as comprised in the state of the art.
- Two variants were included in Article 13, one excluding the whole contents from assessment of inventive step, and another indicating that the whole contents can be used for inventive step, provided that each application was considered separately (this second variant was removed from the second draft).



European Patent Convention

- Final version of the EPC including the whole of contents novelty provisions adopted at Munich Diplomatic Conference in 1973.
- Concerns were expressed by COPRICE: "*the majority of COPRICE considers that the "prior claim approach" is clearer and more equitable.*"
- A warning was given by CPCCI: "*The situation created by Article 52, paragraph 3, could be a source of confusion, in particular since there is a danger that it will influence the application of Article 54. The problem which Article 52, paragraph 3, sets out to cover does not relate to the assessment of novelty but to a conflict between two applications; it is as such that it should be dealt with.*"



Why “novelty”?

- The whole of contents approach goes broader than is required to avoid double patenting, requiring the later applicant to effectively exclude all subject matter that could have been claimed in the earlier application.
- This approach is justified on the basis of expediency, because it avoids the need to wait for the earlier patent or patents to be granted before finalising the scope of the claims of the later application.
- The approach allows earlier applicant to dedicate invention to the public.
- However, it is important to appreciate that application of the whole of contents approach is not a true assessment of novelty, but a mechanism to avoid double patenting.



Novelty and double patenting

- What is the difference between assessing novelty and assessing double patenting using whole of contents novelty?
- When assessing “novelty” one is looking for a contribution made by the applicant over the state of the art, i.e. looking for what has been added.
- In contrast, a whole of contents novelty assessment provides a mechanism for identifying the subject matter to be subtracted from later claims to avoid potential for double patenting.
- If the claim can be considered novel over the earlier disclosure, then the earlier disclosure must have been subtracted.
- While subtracting the subject matter of granted claims of earlier application avoids double patenting, the whole of contents novelty approach has procedural advantages.



What about CN, JP, KR?

- Prior to the 1970s, Japan (Korea) had prior claiming approach
- In 1970s Japan (and Korea) adopted a similar approach to Europe, but did not adopt a novelty test.
- Whole of contents is not considered to be part of the state of the art
- Instead, there is a prohibition on granting patents containing subject matter that is “identical” to subject matter disclosed in an earlier application.
- However, there is protection against self collision.
- China has a similar approach, although there is no protection against self collision.
- Singapore has whole of contents novelty approach.



FICPI - conflicting applications

- FICPI set up a working group to consider conflicting applications.
- Working group included members from Australia, Canada, Sweden, France, China, Germany, Israel, Brazil, Japan, Korea, the United Kingdom and the United States.
- FICPI studied the papers prepared by Group B+ in relation to conflicting applications.
- The work of the group was subsequently extended to cover grace period and prior user rights, these being other topics being considered by Group B+.
- FICPI noted that previous attempts to harmonise the law relating to conflicting applications between 1983 and 2006 had failed (PLT, SPLT) due to US insistence that earlier application be citable for inventive step.



FICPI - conflicting applications

- FICPI took the approach of looking at problem from first principals: why do need provisions to address resolve conflicts between applications filed on different dates?
- It became clear that the problem to be addressed was avoidance of double patenting.
- It also became clear that the contents of earlier filed unpublished applications is not prior art in a first to file system, and the contribution made by a later applicant should not be judged with reference to that contents.
- The prior claiming approach was considered to deal completely with double patenting, but created an administrative burden.
- However, prior claiming approach acknowledged that both the earlier and later applicants were deserving of a patent, subject to avoiding double patenting.



FICPI - conflicting applications

- FICPI considered principles set out by Group B+ sub-group:
 - (i) the grant of multiple patents for the same invention in the same jurisdiction should be prevented;
 - (ii) the patent system should allow for the protection of incremental inventions while ensuring that patent rights are not unjustifiably extended;
 - (iii) any system which allows incremental inventions to be patented should:
 - (a) balance the interests of inventors to protect incremental improvements on their own inventions with the interests of third parties to operate in the same field; and
 - (b) promote innovation and competition.
- FICPI took the view that the European approach to addressing double patenting (conflicting applications) best satisfied these principles.



FICPI - conflicting applications

- Applying a “novelty”- type assessment to the earlier application provides a simple mechanism for identifying the subject matter which must be subtracted from the later claims (leaving no gaps).
- Novelty is a straight-forward test and that can be applied relatively consistently across jurisdictions.
- Test is easy for applicants, examiners, third parties, practitioners, judges etc to understand – has been applied successfully in EP for decades.
- There would also be no requirement for examiners to raise or justify inventive step objections based on such earlier applications, and applicants would not have to respond to such objections.
- Because all applicants are treated the same, there is no need for protection against self-collision.



FICPI - conflicting applications

- While the approach involves subtraction of more subject matter from the later claims than required to avoid double patenting, it does not require subtraction of “equivalents”, which would complicate the analysis.
- The additional subject matter subtracted (beyond what is needed to avoid double patenting) is justified based on gains in administrative efficiency.
- A fair balance between the rights of the two inventors is achieved, and there is recognition that both have made inventions over the actual state of the art.
- The potential for double patenting is avoided.
- The need to wait for the grant of claims in respect of the earlier application, as required by a prior claiming approach, is also avoided.
- Allows first applicant to confidently dedicate subject matter to the public without fear of re-monopolisation.



Why is a gap a problem?

- The US system that applies an inventive step assessment to earlier filed later published applications leaves a “gap” in the protection accorded to the second applicant.
- The “gap” will include subject matter disclosed and enabled by the second applicant, but which is considered obvious in view of disclosure in earlier application.
- In JP, KR and CN, the legislation prohibits (subject to protection against self collision in JP/KR) the granting of a patent encompassing subject matter “identical” to subject matter in earlier application.
- BUT – interpreted as “substantially identical” based on invention itself, rather than on claim scope – therefore “gap” is created.



Why is a gap a problem?

- The second applicant is denied patent protection of an invention they have made, described and enabled in their patent application.
- They are denied protection for inventions not the same, but considered obvious over disclosure of earlier application in the US, and for inventions not identical, but substantially identical, to inventions disclosed in earlier applications in JP/KR and CN.
- Denying such protection is not necessary to avoid the potential for double patenting – this can be achieved by requiring subtraction of identical subject matter.
- Third parties, and the first applicant, can exploit the subject matter disclosed and enabled by the second applicant in the “gap” with impunity.



FICPI resolution – conflicting applications

- After consideration of issues above, Working Group put proposed resolution to ExCo at meeting in Toronto, June 2018.
- The resolution was put forward together with a position paper on substantive law harmonisation, presenting positions on grace period and prior user rights.
- FICPI also took view that PCT applications that do not enter national phase in a jurisdiction should not be considered conflicting applications.
- Harmonisation paper represented the first “position” paper of any organisation presented to the B+ subgroup.
- AIPPI subsequently adopted a resolution on conflicting applications that was completely consistent with FICPI’s position.



FICPI resolution – conflicting applications

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Toronto, Canada from 3 to 5 and 8 June 2018, passed the following Resolution:

- **Agreeing** that the International patent system would benefit from some harmonisation of substantive patent laws, particularly in relation to the treatment of earlier filed but later published applications (“conflicting applications”);
- **Supporting** the efforts of Group B+ to achieve international harmonisation in relation to treatment of conflicting applications;



FICPI resolution – conflicting applications

- **Considering** the various proposals put forward to Group B+ by user groups including the Industry Trilateral, composed of IPO, AIPLA, BusinessEurope and JIPA, for potential approaches to achieve harmonisation in relation to the treatment of conflicting applications;
- **Appreciating** that in a first-to-invent system the earlier filed application is treated as secret prior art against the later application (subject to protection against self-collision mechanisms) while in a first-to-file system the earlier application is not actual prior art, but can give rise to the potential for double patenting, which should be avoided;



FICPI resolution – conflicting applications

- **Further appreciating** that the alternatives of the so called “prior claiming” approach and the “whole of contents” novelty approach adopted in first-to-file countries recognise that both first and second applicants may make useful, albeit the same or similar, contributions over the actual state of the art, and to be equally deserving of patent protection, but avoid double patenting;
- **Understanding** that while a “prior claiming” approach is sufficient to avoid double patenting, this approach is not preferred since it is often necessary to wait for the claims of the earlier application to be finalised before examination of a later application can be completed;



FICPI resolution – conflicting applications

- **Observing** that the problems associated with the “prior claiming” approach have been resolved within Europe and various other countries with first-to-file systems by adopting a “whole of contents” approach, according to which the whole disclosure of an earlier filed application is “deemed” to be part of the state of the art, requiring the later applicant to subtract from their claims the entire disclosure of the earlier application, such that any potential for double patenting is removed;
- **Further observing** that although the “whole of contents” approach involves deeming the disclosure of the earlier application to be part of the state of the art, it is not an actual assessment of the novelty of the claims over the disclosure, but a tool for determining the subject matter that needs to be subtracted from the claims of the later application to avoid potential double patenting;



FICPI resolution – conflicting applications

- **Acknowledging** that the “whole of contents” approach to the treatment of conflicting applications has formed part of the European Patent Convention since its commencement and has provided a predictable and effective mechanism for resolving conflicts between applications filed on different dates since that time;
- **Further acknowledging** that the “whole of contents” approach to the treatment of conflicting applications can be applied in the same manner to earlier applications filed by the same or different applicants with the result that no additional protection against self-collision or terminal disclaimers are required;



FICPI resolution – conflicting applications

- **Believing** that any harmonised approach to the treatment of conflicting applications must be relatively simple and easy to understand, based on well-established principles of patent law, and strike a proper balance between the interests of applicants, third parties and the general public, and also between large companies and small entities, including individual inventors; and
- **Additionally believing** that requiring later applicants to subtract more from their claims than necessary to avoid the potential for double patenting without sufficient justification may extend the balance too far in favour of earlier applicants, and that the introduction of protection against self-collision and terminal disclaimers would introduce additional complexity which is not warranted given the successful operation of the “whole of contents” approach for many years;



FICPI resolution – conflicting applications

- **Cautions** Group B+ and Authorities against adopting a mechanism for the treatment of conflicting applications that has not been tried and tested within a first-to-file patent system of a major jurisdiction, including mechanisms that represent a hybrid or composite system comprising elements borrowed from a first-to-invent system; and
- **Urges and encourages** Group B+ and Authorities to adopt the “whole of contents” novelty approach as a model system for international harmonisation of the treatment of conflicting applications.



More information

- See FICPI Position Paper on Patent law Harmonisation:
https://ficpi.org/_uploads/gonzo/FICPI-WP-2018-001-Patent_Law_Harmonization.pdf
- See “The Problem with Secret Prior Art” (Michael Caine):
<https://dcc.com/app/uploads/2018/10/Article-The-problem-with-secret-prior-art.pdf>



THANK YOU

MICHAEL CAINE