

## **The Same Invention**

The topic of “the same invention” is almost inexhaustible, and indeed central to patent practice. There is probably no dispute in principle that this concept should be the same when dealing with questions of novelty, priority and allowability of amendments and the Enlarged Board and the Technical Boards of Appeal have repeatedly so found in the past. However, the devil is in the details, and we would like to discuss three of these details in more depth.

### **1) Double Patenting**

Until a while ago, the EPO did not appear overly concerned about double patenting if the two applications at stake claimed the same priority and were owned by the same applicant (e.g. in the case of a parent application and a divisional application). It was assumed that the parent and the divisional application may not claim “the same subject matter” (Case Law Book, 5<sup>th</sup> edition, 2005, page 287), but what does this actually mean in cases where the subject matter is partly the same, partly different? In T118/91 the board stated that it could find nothing to support the contention that features forming part of the subject-matter of the divisional application could not be the subject of a dependent claim in the parent application. This would not lead to “double patenting” in its “normal sense”. In T587/98 the board took no issue with claims of a divisional application on the grounds that its subject matter overlapped with that of the parent application. In the board’s view there was no express or implicit provision in the EPC which prohibited the presence in a divisional application of an independent claim, which was related to an independent claim in the parent application in such a way that the “parent” claim included all the features of the “divisional” claim combined with an additional feature. Thus, it seems that the concept of “the same subject-matter” was given a narrow interpretation. It will be reviewed whether this is still the practice of the EPO today and what the legal basis might be for rejecting an application for double patenting reasons. In T307/03 one board drew on Art 60 EPC to refuse an application due to double patenting, but another board in T1423/07 rejected this approach and also saw a difficulty in applying Art 125 EPC to such a situation. The current guidelines for examination state: „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.” Well and good, but what exactly does this mean?

### **2) Amendments – The Composition Trap**

In the past, when you had a claim that was e.g. directed to a composition comprising 10-20% of a salt, you generally had no problem amending this claim into one relating to a composition comprising 10-20% of a salt wherein the salt is sodium chloride, provided that there was basis in the description of the application as filed that sodium chloride is a (preferred) embodiment of “salt”. However, following a new line of case law starting with T2017/07 and meanwhile confirmed in T1312/08, this appears to be no longer possible. In T2017/07 the board held that such an amendment would extend the scope of protection, whereas a limitation to a composition containing “sodium chloride” as the

“sole” salt would contravene Art 123(2) EPC. The board in T 2017/07 also did not allow the substitution of “comprising” by “consisting of” (confirmed in T1063/07, different opinion expressed in T457/98).

In T1410/95, the board rejected the applicant’s argument that an application would implicitly disclose a combination of parameters each of which was disclosed as “preferred” in the application as filed, because a skilled person would always consider a combination of different preferred features of the invention as implicitly disclosed. Therefore, according to this board, it is not a sufficient basis for a claim directed to a combination of A’, B’, C’ and D’, that the original application disclosed a combination of A, B, C and D and provided information that A is preferably A’ etc. What would have been additionally required is a clear and unambiguous disclosure that these preferred features could also be combined with each other (just as the general features A, B, C and D). Disclaimers may also present problems in this regard, see T1443/05 vs. T1107/06.

The effect of this new case law seems to be that the applicant’s/patent proprietor’s options to amend the application/patent have been or will be seriously curtailed. This should be discussed and perhaps leads to the interesting question on who should determine what “the same invention” actually is: the (technically) skilled person, or the (legally) skilled jurist? Or in other words: Is the concept of “the same invention” one that is to be determined more or less photographically, or does it leave room for some technical interpretation by a skilled person? And where should the line be drawn?

### **3) Selection Inventions**

Selection Inventions present special difficulties for the concept of “the same invention” under various aspects. Firstly, the question is whether the same standards can/should be applied to substance selection inventions and selection inventions in numerical ranges? This question is now particularly debated in Germany, where the existing FCJ case law on numerical ranges (*Chrom-Nickel-Legierung, Inkrustierungsinhibitoren*) is at variance with the new case law on substance selection inventions (*Olanzapine*). Secondly, the EPO’s famous three-part-test established in T198/84 comprises three criteria which a numerical range must satisfy to be considered novel vis à vis a prior art range. It would not appear to be sufficient for novelty if only the boundaries of the numerical range are different (narrower); in such a case the two ranges would still be considered as “the same invention”. However, if an applicant tried to amend a broad range by introducing narrower limits not expressly disclosed in the application as filed, he would inevitably encounter objections under Art 123(2) EPC, because his invention would not be considered as the same as originally filed.

Finally, it is an interesting question whether one can expand the concept of sameness also to infringement cases. On the one hand, it is fair to say that an embodiment cannot infringe a patent if (substantially) differs from the broadest claim in at least one feature; if the defendant carries out the same invention as claimed in the patent, he will be found to infringe. On the other hand, how should this principle be applied in the case where the (accused) infringing embodiment is a true selection invention, which is not disclosed or foreshadowed in the patent, but covered by its main claim?

There will be a lot to discuss and we look forward to it.