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## DOUBLE PATENTING - A NEW DECISION FROM THE EPO

The European Patent Convention (EPC) does not contain any provision either allowing or prohibiting double patenting. As a result, the topic occasionally comes before the Board of Appeal (BoA) of the European Patent Office (EPO).

In a recent case, the BoA has ruled on a situation where the same company owned a granted European patent with certain independent claims and a certain description, and also wanted to obtain a patent on a divisional of the granted European patent with independent claims identical to those of the granted European patent, but with a broader description.

Specifically, the company argued that as a result of the broader description, the claims of the divisional - albeit identical to those of the granted patent - would be interpreted more broadly and thus were ultimately different from those of the granted patent.

In its decision, the BoA reiterated the established approach of the EPO on double patenting, whereby what matters is the “claimed subject-matter” (i.e. the exact wording of the claims) rather than the “protected subject-matter” (i.e. the scope of protection conferred by the claims when interpreted in light of the description and the drawings, where applicable). This is also in line with the EPO’s usual approach, whereby – since in all proceedings before it (be they examination proceedings, opposition proceedings or appeal proceedings) the EPO is only concerned with, and competent for, validity and not infringement – the EPO does not consider the scope of protection of the claims strictly speaking, which is considered to be more pertinent to infringement, but rather considers the claimed subject-matter.

This approach is actually advantageous for applicants as it allows the same entity to obtain from the EPO the grant of two European patents (e.g. one parent patent and one divisional patent) with overlapping claims, given that overlapping claims are not identical and thus do not lead to double patenting as defined in EPO practice.

The BoA further addressed the company’s argument whereby the company had a legitimate legal interest in obtaining the patent on the divisional with claims identical to those of the parent patent. Specifically, the company explained that in the event of litigation the divisional patent, thanks to its broader description, would confer on the company a broader scope of protection and thus a better position against its competitors. To this the BoA replied that it did not consider this to be a legitimate interest for the simple reason that, at the relevant procedural time, the company had approved the text of the parent patent intended for grant, and thus had also approved the narrower description. Furthermore, and quite importantly, the BoA noted that deciding that two European patent cases with identical claims but different descriptions and/or drawings could lead to two European patents being granted to the same company meant essentially rendering the double patenting prohibition moot, as all that would be required would be an ever-so-slight difference in the description or in the drawings.

This finding appears reasonable in the interest of third parties, as it prevents a proliferation of European patents with identical claims owned by the same entity, while at the same time leaving the possibility for that entity to obtain more than one European patent with overlapping claims unaffected.

The above BoA decision thus strikes a very positive balance in safeguarding the position of all users of the EPO system, be they applicants, opponents or third parties, and is a confirmation of the EPO’s attention to the concrete and practical interests of all those users.