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DOUBLE PATENTING AT THE EUROPEAN PATENT OFFICE: AN OPEN QUESTION?

In a decision published in the official journal of the European Patent Office (EPO) in September 2020, a Board of Appeal (BoA) of the EPO has referred a number of questions to the Enlarged Board of Appeal, the highest instance of the EPO. These questions relate to the circumstances in which the EPO can refuse a European patent application on the sole basis that it contains claims that are identical to those of an already granted European patent.

This issue derives from the following:

- i) the European Patent Convention (EPC) does not contain any provisions explicitly prohibiting double patenting,
 - ii) the EPC does not exclude European patent applications claiming priority from an earlier European patent application, but here too the EPC does not contain any provisions on whether the two European patent applications should lead to patents with non-identical claims,
- and, most importantly,
- iii) with respect to divisional applications, the EPC simply requires that a divisional application:
 - is filed prior to the grant of the parent application, and
 - is filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed.In other words, the EPC does not contain any provisions explicitly indicating that divisional applications can be filed only in respect of subject-matter that has been excised from the claims of the parent application.

The third aspect is the most important because, in the absence of any provisions relating to the equivalent of a US-style continuation application, many applicants normally use European patent applications to restart or reopen examination.

In its decision, the BoA has now referred the following questions to the Enlarged Board of Appeal:

- “1. Can a European patent application be refused ... if it claims the same subject-matter as a European patent which was granted to the same applicant and does not form part of the state of the art [for the European patent application]?*
- 2.1 If the answer to the first question is yes, what are the conditions for such a refusal, and are different conditions to be applied depending on whether the European patent application under examination was filed (a) on the same date as, or (b) as a European divisional application ... in respect of, or (c) claiming the priority ... in respect of a European patent application on the basis of which a European patent was granted to the same applicant?*
- 2.2 In particular, in the last of these cases, does an applicant have a legitimate interest in the grant of a patent on the (subsequent) European patent application in view of the fact that the filing date and not the priority date is the relevant date for calculating the term of the European patent ...?”*

Until now, the EPO had considered that the same applicant can proceed with two European patent applications having the same description but having non-identical claims, even if the claims of the two European patent application partially overlap. This could be the case e.g. when the applicant wants to obtain an initial, quicker protection for a preferred embodiment and then pursue the general teaching in a divisional application.

On the other hand, the EPO had considered that when the same applicant has two European patent applications with the same filing or priority date, and those applications have perfectly identical claims, the applicant must either amend one or more of the applications so that the subject-matter of the claims of the applications is not identical, or choose which one of those applications he or she wishes to proceed to grant.

This new referral to the Enlarged Board of Appeal is therefore important as it may impact the way in which European divisional applications have been used until now.