



Since 1950 IP Protection in the Heart of Europe

No. 07 - July 21, 2021

DOUBLE PATENTING: THE EUROPEAN PATENT OFFICE ISSUES A LANDMARK DECISION

The European Patent Convention (EPC) does not contain any specific provisions regarding the possibility for the same applicant to obtain two European patents for the same invention. As a result, in the past the Boards of Appeal of the European Patent Office (EPO) have issued various decisions taking varying and sometimes conflicting positions regarding the issue of double patenting.

The debate has now culminated in a decision by the EPO's Enlarged Board of Appeal, i.e. the EPO's authority of highest instance, which holds that the EPC must be interpreted as precluding the possibility for the same applicant to obtain two European patents for the same invention and for the same EPC states.

In the decision, the Enlarged Board of Appeal had to answer the following main question:

"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]?"

The Enlarged Board of Appeal reviewed the EPC, as well as the preparatory works that had resulted in the creation of the EPC, following a diplomatic conference of the EPC "founding" states, and concluded that even though the EPC does not contain an explicit provision addressing double patenting, the preparatory works show that the majority of the EPC "founding" states supported the notion that no two (or more) European patents should be granted to the same applicant for the same invention and for the same EPC states, if those European patents claim the same filing or priority date.

The Enlarged Board of Appeal thus found that *"[a] European patent application can be refused [in examination] if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art [for the European patent application]."*

The Enlarged Board of Appeal clarified in its decision that the above finding therefore applies to:

- a) Parent and divisional applications filed at the EPO;
- b) European patent applications claiming the same priority (e.g. from a national patent application);
- c) European patent applications claiming priority from an earlier European patent application;
- d) European patent applications claiming the same filing date.

The Enlarged Board of Appeal further clarified that the above finding means that the EPO can raise an objection against a European patent application that falls within one of the above categories during examination of that patent application, while it did not address the question of whether this objection could be raised in opposition proceedings (the latter question goes beyond the scope of the questions actually referred to the Enlarged Board of Appeal in this case).

The Enlarged Board of Appeal also clarified that the double patenting prohibition applies only to European patent applications designating the same EPC states. Thus, if the already-granted European patent designates only certain EPC states and the still-pending European application designates only other EPC states, then the double patenting prohibition does not apply.

Lastly, the Enlarged Board of Appeal did not expressly address or review the definition of "same invention", for the simple reason that in the case that resulted in the referral to the Enlarged Board of Appeal the claims of the granted European patent and those of the pending European application were literally identical. It is worth noting that previous case law of the EPO Boards of Appeal established that claims with only overlapping scope, but not identical scope, are not considered to be directed at the "same invention".

The Enlarged Board of Appeal's decision finally clarifies a point of law that had remained open and was highly debated over the past decades. This decision will be particularly important when filing and prosecuting divisional applications.