

Double trouble

THE CASE:

G 4/19

Enlarged Board of Appeal of the European Patent Office

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Cohausz & Florack's **Lauren Schweizer** and **Natalie Kirchhofer** examine the Enlarged Board of Appeal of the European Patent Office's G 4/19 decision on double patenting prohibition

The case underlying G 4/19¹ dealt with a European patent application that claimed priority from a European patent granted to the same applicant for identical subject matter. The application was refused under Article 97(2) of the European Patent Convention (EPC) in conjunction with Article 125 of the EPC, based on the legal principle of double patenting prohibition.

This principle states that two patents cannot be granted to the same applicant for one invention, however, no explicit provision to this regard exists in the EPC. Currently, refusals based on this provision rely on G 1/05 and G 1/06, which accept the principle to the extent that the applicant has "no legitimate interest" in the grant of a second patent for the "same subject-matter."

The applicant in G 4/19 appealed the decision, questioning the legal basis of the refusal and the prohibition's applicability to applications with different filing dates (as is the case with priority pairs). The applicant further argued that it had a legitimate interest, namely additional patent protection.²

Upon appeal, the responsible board assessed a number of EPC provisions, but found that none provided suitable basis for the prohibition. To settle the issue, it referred three questions to the Enlarged Board of Appeal (EBA), which revolved around the following issues (paraphrased):

- Whether there is a legal basis for refusing a European patent application on the grounds of the double patenting prohibition;
- Whether this applies to all constellations of double patenting; and
- Whether an extended patent term (as is the case with priority pairs) provides a legitimate interest that would allow double patenting of the same subject matter.

In response, the EBA in G 4/19 decided that indeed, Art 125 EPC provides legal basis for the prohibition of double patenting. This was based on an extensive review of the preparatory

documents of drafting the EPC, from which it was concluded that there was clear legislative intent during drafting to prohibit double patenting of European application pairs.

Typically, Article 125 EPC objections relate to generally accepted procedural principles, eg, procedural equality of all parties to proceedings and principles of good faith. Following G 4/19, the principle of the prohibition of double patenting can be added to that list.

Given the overriding consensus in the case law that the prohibition exists, and given that many national laws do not allow such double protection, the barring of double patenting in G 4/19 was expected.

The EBA went on in G 4/19 to explain that this prohibition of double patenting is a general principle, which is not only applicable to application pairs having the same filing date (as in G 1/05 and G 1/06), but also extends to pairs that claim the same priority date (eg, priority pairs like in the present case).

Since the extended patent term was the only reason that double patenting would be allowable in G 4/19, it seems settled that extended patent protection does not provide a "legitimate interest" or an escape from the principle of double patenting prohibition.

However, the application-patent pair underlying G 4/19 claimed "100% identical" subject matter and thus (as typically the case) the EBA did not elaborate on this issue. It did, however, expressly distinguish between double patenting (identical claim scope) and calls double protection (overlapping claim scope). This strongly suggests that the barring of double patenting will only apply to the cases of identical claim scopes and not to cases of overlapping claim scopes. This is in line with the majority of case law on this topic.³

In our opinion, even though G 4/19 did not officially address the issue of what constitutes "same subject matter," it did confirm that a narrow application of the double patenting prohibition principle is appropriate. In particular, we see no reason for the EPO

Practical immediate action points

- We expect future application of the double patenting prohibition to be limited to more or less identical claims.
- Applicants are encouraged to actively argue against misinterpretations of G 4/19, should they occur.

to deviate from its current practice and we expect future application of double patenting prohibition to be limited to more or less identical claims. Importantly, a mere overlap of claim scope should not be detrimental to grant. Applicants are encouraged to actively argue against misinterpretations of G 4/19 and, if necessary, appeal any adverse decisions taken in this regard in order to gain legal certainty on this important matter post G 4/19.

Footnotes

1. T 0318/14, Appl. 10718590.2
2. The 20-year patent term is calculated from the filing date, not the priority date.
3. See eg, G 2/10, T 1391/07; T 587/98, T 1491/06, T 2461/10, T 2402/10. See notable deviation in T 1423/07.

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