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Mankind may have no influence on black holes in our Milky Way system. The gravitational power of trademark protection in the intellectual property galaxy, however, can be brought back to reasonable proportions. The current black hole in this region need not last forever. The EU Court of Justice should put an end to the darkness as soon as possible.

## Articles

*Claudio Germinario\**

### Double Patenting in the Practice of the European Patent Office

#### *Introduction*

Double patenting was considered so rare and irrelevant until recently that neither the 1973 nor the 2000 version of the European Patent Convention (EPC) included any explicit provision on the matter. But in the last few years interest has grown, and double patenting is now a current subject of debate in specialized circles.<sup>1</sup> However, the case law of the Boards of Appeal of the European Patent Office (EPO) is so far very contradictory, and a referral of the subject to the EPO's Enlarged Board of Appeal (EBA) is foreseeable in the near future. This article aims to offer a few preliminary considerations on aspects and questions that might usefully be clarified by the EBA.

#### *I. What is Meant by "Double Patenting"?*

In the common interpretation of EPO practice, double patenting occurs when the same invention is protected by two patents or patent applications filed by the same applicant or patentee.

Double patenting occurs in the European procedure, for instance, when a divisional application claims subject matter that is literally or substantively identical to that claimed in the parent application or patent. Such an occurrence is increasingly frequent due to the growing use of voluntary divisional applications as precautionary measure against a final rejection or revocation.<sup>2</sup>

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1 See INGWER KOCH, "The Same Invention or Not the Same Invention – That is the Question. But What is the Answer?", International Federation of Intellectual Property Attorneys, 12th Open Forum, Munich, 8–10 September 2010; D. HARRISON & T. BREMI, "It is a Truth Universally Acknowledged ...' or Double Patenting and the EPC", February 2009 European Patent Institute Information 64–68; and <http://www.jenkins.eu/my-uploads/double-patenting-at-the-epo.pdf>.

2 However, this possibility has been strongly limited by the new Rule 36 EPC in force since 1 April 2010.



Double patenting also occurs when two independent applications are filed on the same date by the same applicant seeking protection for two independent elements, for instance two different pharmacological principles, but both applications include claims for the same combination of the two principles.

Double patenting may also arise when a European (or Euro/Patent Cooperation Treaty [PCT]) application claims priority right based on an earlier European (or Euro/PCT) application and both are prosecuted to grant.

There is also the rare and interesting case in which the *same* invention is protected in two concomitant patents or patent applications owned by two *different* applicants. Here again, the same invention is protected by two concomitant patent rights.

Therefore, regardless of the "official" interpretation, in practice there exist at least two types of double patenting: by the same applicant and by two different applicants.

This clarification is not merely academic, but offers indeed a significant contribution to assessing the legitimacy of double patenting under the EPC. If there is no explicit provision on same-applicant double patenting, provisions regulating two-applicant double patenting can easily be derived from Arts. 54(3) and 60(2) EPC.

Article 54(3) lays down that an interfering<sup>3</sup> EP application shall be considered as comprised in the state of the art versus a subsequent EP application claiming the same invention, if the former application enjoys an earlier effective (filing or priority) date. Consequently, when the two applications have the same effective date, each may be autonomously prosecuted to grant as if the other did not exist. This possibility is acknowledged in the Guidelines for Examination in the sole paragraph relating to "double patenting" (C-IV, 7.4): "The EPC does not deal explicitly with the case of co-pending European applications of the same effective date .... Should two applications of the same effective date be received from two different applicants, each must be allowed to proceed as though the other did not exist."

The same principle is confirmed by Art. 60(2) EPC: "If two or more persons have made an invention independently of each other, the right to the European patent shall belong to the person whose European patent application has the earliest date of filing ...."

If, on the contrary, two European applications have the same effective date, the right to each European patent will belong to each applicant independently from the other. Therefore, both Arts. 54(3) and 60(2) EPC legitimate *de facto* double patenting (of the second type) under the EPC.

<sup>3</sup> EP (or Euro/PCT) application published after the effective date of a subsequent EP application, but enjoying an earlier effective date.

## *II. Legal Questions Concerning Same-Applicant Double Patenting*

Double patenting raises the following questions, so far unanswered by EPO case law.

- If a prohibition against double patenting is accepted, what is its legal basis in the EPC?
- At what stage in the application process should the existence of double patenting be assessed?
- How may the status (i.e., filed application, amended application, refused or withdrawn application, granted patent, revoked patent) of the two patent documents, whose claimed subject matter is compared, influence double patenting?
- What is meant by “same invention”?

## *III. Legal Basis in the European Patent Convention: Case Law*

The EPO’s argument, adopted mainly at first instance for justifying the prohibition of double patenting, follows: “It is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention.”<sup>4</sup>

In other words, in the absence of any explicit legal basis in the EPC, the prohibition of double patenting is legitimate by analogy (Art. 125 EPC) with the patent systems of most EPC contracting states, which include an allegedly equivalent principle. The boards have only recently investigated whether, or to what extent, this statement is correct.

Case law is contradictory concerning the legal basis for prohibiting or allowing double patenting. Analysis of some 50 decisions of the Boards of Appeal which deal directly or indirectly with double patenting reveals that most decisions denied the existence of double patenting because the two “overlapping” patent documents (e.g. parent and divisional applications) did not protect technically identical inventions. Thus the condition of “same invention” was not met.

In these cases, therefore, the boards did not feel the need to clearly identify any legal basis for justifying the prohibition against double patenting. Case T1708/06 of 28 June 2010 is probably the most recent of such decisions. Other recent decisions, such as T0877/06 (2 December 2009) or T1391/07 (7 November 2008), accepted that the mere fact that the scope of protection notionally conferred by a claim in a divisional application would partially overlap with that of the granted parent patent did not prejudice the grant of a patent because no issue of double patenting would arise.

Along the same lines, decision T0587/98 (12 May 2000) stated that there is no express or implicit provision in the EPC prohibiting the presence in a

<sup>4</sup> See Guidelines for Examination, latest edition, C-IV, 7.4.

divisional application of an independent claim ... which is related to an independent claim in the parent application in such a way that the "parent" claim includes all the features of the "divisional" claim combined with an additional feature.

In practice, when the parent patent claims two associated elements, A and B, and the divisional document claims either of the two elements alone, no double patenting occurs (for interpretation of "same invention" see Harrison and Bremi, *supra*).

The general principle that the same invention cannot be protected by two patents or patent applications owned by the same person was acknowledged and accepted also by the EBA, in decisions G0001/05 and G0001/06 (28 June 2007): "The Board accepts that the principle of prohibiting of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject matter, if he already possesses one granted patent therefore."

However, it is unclear which EPC provision indicates "legitimate interest" as a requirement for a valid filing of an EP application. Help in interpreting the EBA's apodictic statement "that an applicant has no legitimate interest ..." is found in the nearly concomitant decision, T0307/03 (3 July 2007), in which the board sought the legal basis for the prohibition against double patenting directly in the EPC. According to T0307/03 the prohibition of double patenting is provided by Art. 60(1) EPC, which states: "The right to a European patent application shall belong to the inventor or his successor in title ..."

From this sentence, the board deduced that under the EPC the principle of prohibition of double patenting applies and that the inventor has a right to the grant of one and only one European patent for a particular invention. Once a patent has been granted to the inventor, this right to a patent has been exhausted. The decision offered no clearer or more extensive motivation. Therefore, the board's conclusions appear to be founded on a very original, but not necessarily acceptable, construction of Art. 60.

Yet, if confirmed, this decision would raise reasons of concern.

Since Art. 60(1) EPC defines who is entitled to an EP patent, if the right to a (second) patent is considered exhausted, then the applicant is not entitled to a second patent. In other words, the prohibition against double patenting would not derive from lack of "legitimate interest", as affirmed by the EBA, but from lack of "legitimate entitlement". Consequently, a divisional application for the same invention should be considered inadmissible, even before allowability is examined.

This proviso would appear to anticipate the time for assessing double patenting from the examination or grant procedure to the very early "examination on filing" stage. This way of processing a divisional application contradicts the principle laid down by the EBA in G0001/05 and G0001/06 (reason 13.4):

Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO ... [prohibiting double patenting in divisional applica-



tions]. However, this principle could not be relied on to prevent the filing of identical applications, as this would run counter to the prevailing principle that conformity of the applications with the EPC is to be assessed on the final version put forward.

In other words, a finding of double patenting may only arise from substantive examination of the claimed subject matter, which however would be prevented by a preliminary judgement of inadmissibility as in T0307/03.

Moreover, this decision, if confirmed, would influence invalidity actions before national courts against nationally validated EP patents. In fact, T0307/03 would de facto integrate double patenting among the grounds for revoking an EP patent pursuant to Art. 138(1)(e) EPC, which provides that "a European patent may be revoked ... on the ground that: ... (e) the proprietor of a European patent is not entitled under Art. 60(1) EPC". Yet this would appear to be an extremely strict interpretation of Art. 138 EPC.

In decision T1423/07 (19 April 2010), another board totally disagreed with the findings in T0307/03, on well-motivated and exhaustive grounds. Decision T1423/07 deals with the circumstance in which double patenting would arise from the filing of a European application (or Euro/PCT) claiming priority right from an earlier identical European application (or Euro/PCT), both prosecuted to grant. The EPO's Examining Division refused the second application because of the bar against double patenting under Guidelines C-IV 6.4 (now 7.4) and C-VI 9.1.6. The Examining Division invoked the "accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention" and referred to Art. 125 EPC as the legal basis for prohibiting double patenting.

In T1423/07 the board carried out, for the first time, an exhaustive analysis of the EPC contracting states' patent systems. The result was that the "common accepted principle" applies only in a very specific situation, namely when the same invention is protected by a granted national patent (normally the national priority) and by the corresponding granted EP patent (claiming priority from the former) validated in the same state. In these specific circumstances, the granted national patent ceases automatically to have legal effect.

However this exclusion of double patenting concerns a very specific situation in post-grant procedure. In fact, the board's enquiry showed that only three national systems envisage the exclusion of double patenting in pre-grant procedure – within the context of internal priority.

For this reason, the board concluded that since only a few national patent systems of EPC contracting states provide for refusing a patent application on the ground of double patenting, there is no principle of law generally recognized in the contracting states for refusing an EP application on such a ground.

Concerning Art. 60 EPC, decision T1423/07 clearly diverges from the interpretation previously given in decision T0307/07. The board was unable to find in Art. 60 any exhaustion of the right of an applicant to have a second

patent claiming subject matter already protected in a previous granted patent (see Harrison and Breimi, *supra*). On the contrary, the board considered decisive the lack of explicit provisions relating to double patenting in the EPC, and therefore held that the contested application could not be refused under Art. 60 EPC for double patenting.

#### *IV. When is the Right Time for Assessing Double Patenting?*

Provided that the prohibition against double patenting has a legal basis in the EPC, the reference by the EBA (G0001/05, G0001/06, reason 13.4) to "the prevailing principle that conformity of the applications with the EPC is to be assessed on the final version put forward", touches on another much-debated issue: namely the time at which an examining division may raise an objection, or even refuse an application, on the ground of double patenting. A first condition derivable from G0001/05 and G0001/06 is that the objection cannot be raised until at least one of the two "parallel" patent or patent applications has been granted, since before grant the applicant has no definite right to the invention, but merely a provisional right. A second condition laid down directly by the EBA is that the examination of the alleged double patenting is only allowed on the final version [of the application] put forward, therefore at the end of the examination procedure, when no substantive patentability objection still remains outstanding. One of the consequences of the principle set by the EBA is that a double patenting objection is not justified insofar as the invention is only provisionally protected by two parallel pending applications, since neither of the two is yet in a final fixed (granted) form, but both are still open to possible amendments.

It is interesting to draw a comparison with the US patent system, which provides for statutory<sup>5</sup> and non-statutory<sup>6</sup> double patenting rejection.

The US Guidelines for Examination (MPEP 804) clearly state that the examiner who becomes aware of two co-pending applications filed by the same inventive entity is allowed to make the applicant aware of the potential double patenting problem if one of the applications becomes a patent and to issue a "provisional" rejection (i.e., envisaged rejection) on the ground of double patenting. However, rejection of an application cannot be concretely finalized unless the objection of double patenting is the only rejection remaining outstanding. In other words, the examiner is allowed to refuse an application for double patenting at the very end of the examination procedure, when any other possible patentability objection has been set aside.

Therefore, the principle that double patenting should only be assessed when the same invention is protected both by a granted patent and, provisionally, by a patent application in its final version seems to deserve most credit. This

<sup>5</sup> When the subject matter of the two patent applications is identical according to the novelty criterion.

<sup>6</sup> When the subject matter of one patent application lacks inventiveness with regard to the other.

principle rules out any possibility of fictitiously invoking double patenting on the basis of an alleged identity of claims in their intermediate, not final, forms. It also raises the issue of whether a double patenting objection is legitimate when the earlier patent, or parent patent, has been revoked during an opposition or an opposition appeal procedure.

In fact, by virtue of Art. 68 EPC, the European patent shall be deemed not to have had, from the outset, the effects specified in Arts. 64 and 67, to the extent that the patent is revoked. Since this effect is *ex tunc*, the condition that the invention is protected by a granted patent is not fulfilled and this circumstance should make any double patenting objection moot.

For this reason, the very timing of the two parallel procedures seems to play a decisive role, and needs to be carefully analyzed by the EPO instances before raising the objection.

### V. Legitimate Interest

The legitimate interest of the applicant is discussed in T1423/07. We have seen how the EBA accepted in G0001/05 and G0001/06 the principle of prohibition against double patenting on the ground that an applicant has no legitimate interest in the grant of a second patent for the same subject matter. The absence of a legitimate interest is also invoked in some national systems as the basis for the same exclusion.

However T1423/07 made clear that where double patenting results from an internal priority (EP application claiming priority from an earlier identical EP application) the applicant indisputably has a legitimate interest in having a second patent granted, since the second patent will expire one year later than the earlier one (priority patent). Therefore, if the lack of legitimate interest is the reason justifying the prohibition of double patenting, it definitely does not apply in T1423/07.

On the other hand, the board is aware that the above considerations do not automatically apply to the different circumstances of decisions G0001/05 and G0001/06, in which double patenting did not result from a case of "internal priority", but from the filing of a divisional application, which in any case maintains the same expiration terms as the parent patent.

But was the EBA correct in stating that "an applicant has no legitimate interest" in filing a divisional application and obtaining a second patent claiming the same or part of the same subject matter, already protected in the previously granted patent?

One point is indisputable: the applicant's willingness to bear the costs of a new application shows that the applicant has an interest. Voluntary divisional applications are often filed as a precaution in case the parent application is refused or the parent patent revoked. A divisional application claiming the same subject matter, or at least a relevant part of the subject matter of the parent patent, minimises the risk of a total loss of rights and ensures the possibility of prosecuting examination of at least part of the subject matter.



Therefore, the real point is not whether the applicant has an “interest” – the answer is obvious – but rather whether this interest is “legitimate”.

In the author’s opinion, filing divisional applications as a precautionary measure can never be qualified as illegitimate, abusive or unlawful unless it clearly contravenes an EPC provision. There are only two categories of acts with regard to EPC: acts violating the law, which are an abuse, and acts not violating the law, which are fully legitimate. There is no grey area in which acts complying with all EPC provisions may be qualified as “ethically” inadmissible.

On this point the EBA was very clear in G0001/05 and G0001/06, when it stated, in relation to the EPC 1973:

On Art. 76(1) and Rule 25 as presently worded, the EBA sees no adequate basis for defining any additional requirements to be imposed on divisional applications ...

It appears that what applicants consider a legitimate exploitation of the procedural possibilities afforded by the EPC, others consider an abuse in relation to the law as they think it ought to be rather than as it is.

The Board finds it unsatisfactory that sequences of divisional applications each containing the same broad disclosures of the original patent application ... should be pending for up to twenty years.

Still, the EBA recognised that in the EPC 1973 there was no prohibition against such a use of divisional applications, and accordingly suggested: “If administrative measures ... to minimize the possibility for the applicants to keep alive subject matter on which the Examining Division had already given a negative opinion ... are not adequate, it would be for the legislator to consider where there are abuses and what the remedy could be.”

In other words, although the practice may be unsatisfactory, the EBA admitted that in EPC 1973 there was no provision against the filing of divisional applications totally or partially identical to a previous parent patent or parent application. Hence, such a practice could not be considered as an abuse of the procedure.

In the meantime, the European legislator adopted new remedies – aimed at limiting the possibility of filing voluntary divisional applications – by introducing new Rule 36 EPC. This provision set a shorter time span for filing divisional applications, thus quantitatively limiting their use as means for redressing loss of rights. However, this remedy, besides limiting in time the possibility of filing divisional applications, did not actually introduce any substantive prohibition against double patenting. The inevitable conclusion is therefore that also within the context of the EPC 2000 and new Rule 36, the legislator voluntarily refrained from introducing clear and explicit provisions prohibiting the filing of divisional applications identical or partially identical to a previous parent application or patent. For this reason, it seems very ineffective to invoke the absence of legitimate interest to justify the prohibition of double patenting.

On the other hand, the case law of the Boards of Appeal had already set a well-defined and insuperable limit to the possibility for the applicant to keep alive subject matter on which the EPO instances have already given a negative opinion, by refiling the same subject matter in divisional applications. As clarified in T0051/08 (7 May 2009), this limit is the point in time at which such a subject matter becomes *res iudicata*. In other words, an invention on which a final decision has been taken by the Board of Appeal in the parent application or patent cannot be pursued in a divisional application.

In sum, EPO case law does not offer any uniformly accepted solutions to the many legal issues raised by the practice of double patenting. Guidance from the EBA is needed to clarify the many controversial points of law described above and ensure the correct exercise of rights.

Yinliang Liu\*

## Patenting Business Methods in the United States and Beyond – Globalization of Intellectual Property Protection is Not Always an Easy Game to Play\*\*

Forrest runs with a group that follows behind him.

Forrest: "Anyway, like I was saying, I had a lot of company. My Momma always said you got to put the past behind you before you can move on. And I think that's what my running was all about."

Forrest stops running. The group stops behind him. Forrest stands and looks as the group waits expectantly. Forrest turns and look.

"Forrest Gump" by Eric Roth

### Introduction

Ever since the early 1990s, especially the enforcement of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) of 1 January 1995, intellectual property (IP) protection has been entering into a period of globalization, with a threshold laid down by TRIPS and earlier international instruments, including the Paris Convention for the Protection of Industrial

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