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**Amicus curiae brief regarding G 4/19 –
Observations from a patent practitioner’s perspective**

I. Author’s theses

The prohibition of double patenting as a further patentability requirement

1. is not legitimate,
2. is disproportionate,
3. is too complex in practice,
4. will lower legal certainty.

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T 0318/14 of 7 February 2019 gives a thorough and well-founded summary and analysis of the legal provisions of the EPC, travaux préparatoires to the EPC and relevant case law pertaining to the question of whether the prohibition of double patenting should be a further patentability requirement for European patents or not. I fully agree with the summary of findings expressed in section 78 of this decision. The first question referred to the Enlarged Board of Appeal should be answered with “no”, based on the practical considerations outlined below:

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Amtsgericht Mannheim
PR 700452
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1. The prohibition of double patenting as a further patentability requirement is not legitimate since it has no basis in the EPC. T 0318/14 and the previous amicus curiae briefs expatiate on this.
2. The prohibition of double patenting as a further patentability requirement is disproportionate since the burdens involved with its application – as outlined below in section 3 – outweigh by far the possible negative impact a double patenting may have: An opponent would have to oppose two (or more) granted European patents instead of only one, with the need to pay two (or more) opposition fees. Furthermore, the patentee might misuse the patent rights by e.g. exclusively licensing parallel patents to different licensees or by assigning parallel patents to affiliated companies in order to be able to try different/contradictory defence strategies for challenged parallel patents. A large number of granted patents may be used as a vehicle to maximise market power and intimidate competitors. Such abuse of legal right will be dealt with by national courts. However, the patentee also has to face multiplied validations and annuities.
3. The prohibition of double patenting as further patentability requirement is too complex in practice. To illustrate this point, I will present two case scenarios for overlapping and identical claims in patent applications that are filed on the same date or claim the same priority.

3.1 In my first example, an inventor has found improved red, green and blue light emitting organic compounds (R, G and B respectively in the following), which result in an advantageous composition for use in an OLED display device like an OLED TV. In fact, the inventor has made three distinct inventions on improved red (R), green (G) and blue (B) emitter compounds. He files three European patent applications at the same date, containing (besides possible compound and device claims) one independent and one dependent composition claim each as follows:

Patent application 1:

1. OLED composition containing compound R.
2. The composition of claim 1, further containing compounds G and B.

Patent application 2:

1. OLED composition containing compound G.

2. The composition of claim 1, further containing compounds R and B.

Patent application 3:

1. OLED composition containing compound B.
2. The composition of claim 1, further containing compounds R and G.

Although there is no specific need for the dependent claim in each of the three patent applications, the inventor includes them because the combination of compounds R, G and B is an important embodiment of the invention, which shall therefore be searched by the EPO and considered in the EESR. Furthermore, the inventor wants to avoid later selection inventions on the combination of compounds R, G and B by competitors.

Obviously, the dependent claims of all three patent applications lead to an identical combination of features.

3.1.1 To avoid double patenting in the broad sense that claimed subject matter must not overlap, the deletion of the dependent claims in two or all three patent applications would not be sufficient since the independent main claims are still overlapping in that they all encompass compositions containing the three compounds R, G and B. Therefore, in order to avoid overlap of the claims in all three patent applications, claim 1 of patent application 2 would need to include the disclaimer “with the exception of compositions containing compounds G and R and with the exception of compositions containing compounds G and B”. Claim 1 of patent application 3 would likewise require a disclaimer “excluding compositions containing compounds B and R and excluding compositions containing compounds B and G”.

3.1.2 A double patenting objection can only be issued if the examiner in charge happens to know of the existence of the three overlapping patent applications since the EPC does not require the applicant to disclose all related patent applications to the EPO (unlike the USPTO).

Since all three inventions lie in the same technical field of OLED compositions, it may occur that the same examiner deals with all three patent applications.

However, there might be different examiners concerned with red, green and blue emitting compounds for OLEDs.

3.1.3 A simplified and more restricted approach for identifying possible double patenting could rely on double patenting as occurring only if claims of two patent applications or patents are identical in claim language or identical in claim features. Under this simplified or narrow concept, a claimed OLED composition containing compound R would not overlap with an OLED composition containing compound G since R and G are different claim features. However, a significant overlap in claim scope would not be prevented by this simplified approach, which leads to the question why such simplified double patenting objection should be implemented.

3.1.4 On the other hand, if the three OLED composition patent applications contain only the respective independent main claims, without mentioning the combination of R, G and B anywhere in the application text, a double patenting objection would typically not be put forward if the patent applications were filed at different filing dates, although the patent scope does certainly still overlap for the time period when all three patents are in force. No one would think of a double patenting objection in that case because separate inventions are covered in separate patent applications at separate points in time (albeit by the same applicant). Then, why would one make a double patenting objection only because those three patent applications are filed on the same date?

3.1.5 One could argue that in this example there are three distinct inventions, which can of course be covered in three separate patent applications, and the possible overlap and double patenting lies in the nature of the broad patent scope.

3.1.6 It must be questioned whether the narrow concept of double patenting (3.1.3 above) helps to ensure that a person is granted only one European patent for the same invention and for one filing date or not.

The term “claims the same subject matter” in the first question referred to the Enlarged Board of Appeal needs to be defined in order to distinguish double patenting from double protection (see Sections 21 to 24 of T 0318/14 adopting

a narrow definition). According to the referring Board of Appeal, the term “claims the same subject matter” refers to the narrow concept outlined above in Section 3.1.3, whereas an overlap in claimed subject matter as discussed in above Section 3.1.1 is a matter of double protection, but not double patenting and therefore not covered by the present referral. Within this logic, why should double patenting be detrimental to the European patent system, but double protection not?

Even if one accepts that double patenting only relates to identical claim language or identical claim features for “claiming the same subject matter”, the assessment of double patenting is complex in practice as soon as two conflicting claims are not identical in claim language, but still identical in claim features. For example, household detergent compositions contain an active ingredient which can be described as surfactant, surface-active agent or wetting agent. All three expressions mean the same thing with different wording. Therefore, a patent claim directed to a detergent composition comprising a surfactant is identical in claim features to a patent claim defining a detergent composition comprising a surface-active agent, although both claims are not identical in claim language.

It needs technical expertise and thorough investigation to identify the double patenting for claims identical in features, but not language.

Further narrowing the concept of double patenting to identical claim language would be insufficient: Then, a “rebranding” of a technical claim feature would be sufficient to overcome a double patenting objection.

It will be complex in practice to identify claims that are identical in claim features, but not identical in claim language. Identical claim language cannot be the criterion because a mere rewording of identical subject matter would be sufficient to evade double patenting.

3.2 In my second example, two inventions concern one (chemical) product and are based on one (preferred) embodiment which will be found as the sole example in both patent applications.

Mixed oxides of Cu, Zn and Al are known catalysts useful for a specific chemical reaction, the steam reforming of methanol. The catalyst is prepared by one step coprecipitation of Cu-, Zn- and Al-compounds and subsequent burning (calcining) of the obtained precipitate to form the mixed oxide.

3.2.1 The inventor made two inventions improving the known Cu-Zn-Al mixed oxide catalyst: The microscopic structure of the catalyst on the one hand, and the shape of the (solid) catalyst on the other hand.

The microscopic structure of the catalyst was improved by a two-step precipitation of the Cu-, Zn- and Al-compounds, instead of (one step) coprecipitation, which, followed by calcination, led to an improved catalytic behaviour.

Furthermore, the inventor found that very small catalyst tablets of 1.5 mm diameter and 1.5 mm height had advantageous properties (e.g. with regard to activity and abrasion), when compared to bigger tablets.

3.2.2 A first patent application contained the following claims:

1. Cu-Zn-Al-mixed oxide catalyst obtainable by two-step precipitation of Cu-, Zn- and Al-compounds, followed by calcination.
2. The catalyst of claim 1 in the form of 1.5 mm diameter, 1.5 mm height tablets.

At the same time, it appeared that catalyst tablets with 1.5 mm diameter and 1.5 mm height might be patentable irrespective of catalyst composition. Therefore, a second patent application was filed on the same day, claiming

1. A catalyst tablet having a diameter of 1.5 mm and a height of 1.5 mm.
2. The catalyst tablet of claim 1, made of Cu-Zn-Al-mixed oxide.
3. The catalyst tablet of claim 2, wherein the mixed oxide is obtainable by two-step precipitation, followed by calcination.

Both patent applications contained an identical single example describing the two-step precipitation, followed by calcination and tableting to form the 1.5 mm diameter, 1.5 mm high catalyst tablets. They furthermore contained an explanation of how the two-step precipitation and/or the catalyst tablet size improved the catalytic behaviour.

3.2.3 Patent application 1 was granted without amendments.

Patent application 2 was granted in amended form due to prior art, the main claim including the feature of dependent claim 2. Former dependent claim 3 was made the (sole) dependent claim 2:

1. A catalyst tablet having a diameter of 1.5 mm and a height of 1.5 mm, made of Cu-Zn-Al-mixed oxide.
2. The catalyst tablet of claim 1, wherein the mixed oxide is obtainable by two-step precipitation, followed by calcination.

3.2.4 The dependent claims of both patents – again – contain an identical feature set, leading to a possible double patenting objection. The independent claims overlap significantly, but have different claim features: Patent 1 defines the catalyst by the two-step precipitation, which distinguishes the catalyst from the prior art coprecipitated catalysts. However, (one-step) coprecipitated catalysts are not covered by the main claim.

In patent 2, on the other hand, the specific small catalyst tablets of claim 1 cover both the prior art coprecipitated mixed oxide as well as the two-step precipitated mixed oxide, thereby being broader in this respect than patent 1.

3.2.5 Again, deletion of the dependent claims in both patents would maintain the overlap in the significantly different claim features of the independent claims of both patents. No “simplified” double patenting objection can be issued to the overlapping main claims due to the different claim features.

However, in order to avoid overlapping claim scope, the main claim of patent application 2 would require the disclaimer “with the exception of catalysts ob-

tainable by two-step precipitation of Cu-, Zn- and Al-compounds, followed by calcination". As a downside, this disclaimer would also exclude the sole example of patent application 2 from the claim. Inventive step might then be at risk since there remains no example supporting advantageous properties of the claimed catalyst. Removing the overlap with patent 1 might lead to a denial of inventive step since preparation of the catalysts by coprecipitation was known and two-step precipitation might be considered as an obvious alternative to the known one-step coprecipitation in the absence of a documented surprising or advantageous effect.

3.2.6 It is, however, quite likely that patent applications 1 and 2 would not be examined by the same examiner due to the difference in claim features. Therefore, without the applicant notifying the EPO, it would be hard for the patent examiner(s) to allocate a possible double patenting objection.

3.2.7 At least my second example is not theoretical only, but actually occurred to me in 1997. Two patent applications were drafted and filed on the same day, leading to EP 0 901 982 B1, granted on 05.12.2001 for a process and catalyst for steam reforming of methanol, and EP 0 901 815 B1, granted on 26.11.2003 for a Zn-Cu-Al mixed oxide catalyst having the form of tablets with no double patenting objection during examination. To further complicate the issue, both of EP'815 and EP'982 additionally contained independent use claims for steam reforming methanol, which obviously overlap, too.

When drafting the corresponding priority patent applications DE 197 39 746 A1 and DE 197 39 773 A1, as well as the following EP patent applications, I was aware of a possible double patenting objection and therefore did not mention the two-step precipitation in the specification and example of EP'815 (patent 2), while describing the 1.5 mm diameter and 1.5 mm high tablet in example 1. In EP'982 (patent 1), on the other hand, a dependent claim defined only a broader size range for a catalyst tablet, and the specific 1.5 mm diameter and 1.5 mm high tablet was mentioned in the specification, but not used in the example (which describes 20 mm x 3 mm tablets being crushed to split employed for the catalyst test).

Both patent examples refer to the identical 67 wt% CuO, 26.4 wt% ZnO, 6.6 wt% Al₂O₃ catalyst composition, but the two-step precipitation and the specific physical properties derived therefrom are only mentioned in EP'982 (patent 1). Such (successful) precautionary measures for evading a possible double patenting objection make a full and accurate double patenting analysis by the Examining Division complex and time-consuming (and both patent applications need to be identified as possibly conflicting in the first place).

3.3 Therefore, Examining Divisions would need to inquire with each applicant about the potential existence of related EP patent applications. Even then, due to different claim language it will be a very complex issue to correctly identify potentially doubly patented subject matter, which would not lead to a speeding up of the examination proceedings.

4. The above examples show that the assessment of double patenting is too complex in practice in order to be performed with the necessary reliability and consistency. However, when double patenting as a further patentability requirement cannot be applied with the required reliability and consistency, this leads to a lack of legal certainty for the patentability finding.

II. Conclusion

- 1.** I accept that a person should be granted only one European patent for the same invention in respect of which there are several applications with the same date of filing. However, first it must be clarified which is the proper test for finding “the same invention”: Are the scopes of protection, the subject matters or the technical features of the claims to be compared? Must the subject-matter of the respective claims be identical in wording or technical features or is an overlap sufficient for a double patenting objection? What is the proper test to ascertain whether two or more European patent applications are directed to the same subject matter or not?
- 2.** Simply looking for “photographically” identical claims in parallel patent applications/patents in a “simplified” or narrow approach will not be sufficient for preventing double patenting (and could as well be dealt with under *res judicata/ne bis in idem*, see sections 76 and 77 of T 0318/14).

3. If two patents cannot be granted to the same applicant for one invention, can two patents be granted to him for two overlapping inventions? The appeal underlying T 0318/14 is easy in this respect: it does not concern claims of overlapping scope, but claims that are identical.
4. Concluding from a patent practitioner's point of view, the practical applicability of a further patentability requirement prohibiting double patenting is questionable. It should be borne in mind that the omission of a double patenting objection cannot be corrected in later opposition proceedings (as it is the case for incomplete prior art searches) since double patenting is no ground for opposition.

Therefore, a European patent application should not be refused under Article 97(2) EPC 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 pursuant to Article 54(2) and (3) EPC.

Double patenting objections should be dealt with in national patent systems, the need arising only if conflicting patented subject-matter is in fact identified in a validating country. In a likewise manner, although mentioned in Article 69 EPC and the accompanying protocol, scope of protection is typically assessed in national patent proceedings.

5. **Remark:** The above theses and arguments reflect only the undersigning attorney's private opinion and not necessarily that of Isenbruck Bösl Hörschler PartG mbB or any clients thereof.

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