

Internal distribution code:

- (A) [] Publication in OJ
(B) [X] To Chairmen and Members
(C) [] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 19 April 2010**

Case Number: T 1423/07 - 3.3.02

Application Number: 03771064.7

Publication Number: 1534296

IPC: A61K 31/55

Language of the proceedings: EN

Title of invention:

Use of a specific cyclic amine derivative or the pharmaceutically acceptable salts thereof for the treatment or prevention of heart failure

Patentee:

Boehringer Ingelheim Vetmedica GmbH

Opponent:

-

Headword:

Cyclic Amine derivative/BOEHRINGER INGELHEIM VETMEDICA GmbH

Relevant legal provisions:

EPC Art. 60, 63(1), 97(2), 125, 112(1)(a)
RPBA Art. 21
Guidelines C-IV, 6.4 (June 2005)
Section 18(5) UK Patents Act
Section 73(2) UK Patents Act
Section 31(5) IRISH Patents Act
L.614-13 Code de la Propriété Intellectuelle
L.614-14 Code de la Propriété Intellectuelle
§ 40.5 Deutsches Patentgesetz
Art. 4^{bis}(5) Paris Convention

Relevant legal provisions (EPC 1973):

-

Keyword:

"Main request: refusal of the application for double patenting
- (no)"
"No basis in the EPC"

Decisions cited:

G 0001/05, G 0001/06, T 0587/98, T 0307/03

Headnote:

1. In view of the fact that there are no principles of law generally recognised in the Contracting States for refusing a patent application for double patenting, refusal of a European patent application for double patenting cannot be based on Article 125 EPC.

2. If double patenting arises from internal priority, the applicant has a legitimate interest in the grant of the subsequent application claiming priority from an already granted European application with identical claims and identical Designated Contracting States in view of the fact that the filing date and not the priority date is the relevant date for calculating the 20-year term of the patent.

3. Article 60 EPC cannot be used as a basis for refusing a European patent application for double patenting either. In particular, Article 60 EPC cannot be interpreted such that the inventor or his successor in title has a right to the grant of one and only one patent from the EPO for a particular invention, with the consequence that claims comprising subject-matter included in the claims of an already granted patent of the same applicant are refused no matter whether or not the applicant has a legitimate interest in the grant of the subsequent application.



Case Number: T 1423/07 - 3.3.02

DECISION
of the Technical Board of Appeal 3.3.02
of 19 April 2010

Appellant: Boehringer Ingelheim Vetmedica GmbH
Binger Strasse 173
D-55216 Ingelheim/Rhein (DE)

Representative: Kebekus, Ulrich
Boehringer Ingelheim GmbH
CD Patents
Binger Strasse 173
D-55216 Ingelheim/Rhein (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 March 2007
refusing European patent application
No. 03771064.7 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: U. Oswald
Members: A. Lindner
J. Van Moer

Summary of Facts and Submissions

- I. European patent application No. 03 771 064.7 was refused by a decision of the examining division posted on 4 March 2007 on the basis of Article 97(1) EPC 1973 for unallowable double patenting.
- II. The following document was *inter alia* cited during the proceedings before the examining division and the board of appeal:
- (1) EP-B-1 362 590 (patent specification of the priority document of the contested application)
- III. The decision was based on claims 1-16 of the sole request filed with letter dated 28 April 2006.

Independent claim 1 of this request reads as follows:

"1. Use of cilobradine or a pharmaceutically acceptable salt thereof for the preparation of a pharmaceutical composition for the treatment or prevention of heart failure."

- IV. The arguments in the decision may be summarised as follows:

The claims on file were identical to the claims granted in the priority document EP-B-1 362 590. Since according to Guidelines C IV 6.4 and C VI 9.1.6 two European patents in the name of the same applicant must not contain claims of substantially identical scope, the contested application had to be refused.

- V. The appellant (applicant) lodged an appeal against said decision.
- VI. The appellant filed an auxiliary request together with the statement of the grounds of appeal dated 23 July 2007.
- VII. In a telephone conversation on 15 May 2009, the appellant conditionally withdrew his request for oral proceedings: in the event that the main request was found allowable and the only issue at the oral proceedings was then the question of reimbursement of the appeal fee, the request for oral proceedings was withdrawn.
- VIII. The appellant essentially argued as follows:

In the present case, the double patenting resulted from a European application which was substantially identical to the content of the European priority document which had previously been granted. The EPC did not contain a basis in the form of an article or a rule which prohibited double patenting. Reference was made to Article 139(3) EPC, which stated that it was up to the Contracting States to prescribe whether and on what terms double patenting was acceptable.

The refusal resulted in a one-year loss of patent protection, since the time of protection was calculated from the filing date rather than from the priority date. Withdrawal of the patent serving as priority document would have put the appellant into an unfavourable situation, as the outcome of the grant procedure for the contested application was uncertain.

Even if granted, the patent was then still open to opposition.

- IX. The appellant requested that the decision under appeal be set aside and that a European patent be granted on the basis of the main request filed with letter dated 28 April 2006 or, alternatively, on the basis of the auxiliary request filed with the statement of the grounds of appeal dated 23 July 2007. Reimbursement of the appeal fee pursuant to Rule 103 EPC was also requested. Oral proceedings were requested in the event that the claims of the main request were not found allowable.

Reasons for the decision

1. The appeal is admissible.
2. *Double patenting - main request:*

In the present case, the double patenting arises from a European application (= contested application) which claims priority from an earlier European application which was granted (= document (1)). The claims of the two documents are identical and all the Designated Contracting States of document (1) are also designated in the contested application.

- 2.1 The examining division refused the application on the basis of the Guidelines. The relevant passage C-IV, 6.4 (June 2005) reads as follows:

"The EPC does not deal explicitly with the case of co-pending European applications of the same effective date. **However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention** [emphasis added by the board]. It is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. However, in the rare case in which there are two or more European applications from the same applicant definitively designating the same State or States (by confirming the designation through payment of the relevant designation fees) and the claims of those applications have the same filing or priority date and relate to the same invention (the claims conflicting in the manner explained in VI, 9.1.6), the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant. 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 EPC does indeed not contain any explicit provision which would prohibit double patenting. By invoking an "accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention", the above passage of the Guidelines makes reference to Article 125 EPC as a basis for not allowing double patenting. Therefore what has to be evaluated is whether a European application can be refused for double patenting on the basis of Article 125 EPC.

2.2 Article 125 EPC stipulates that

"in the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States".

This means that in order to base the refusal of a European application on Article 125 EPC, each of the following criteria must be met:

- (a) it must be a matter of procedural law;
- (b) the principles of general law invoked must be generally recognised in the Contracting States;
- (c) there must be an absence of procedural provisions in the EPC.

2.2.1 Re (a):

In decision T 587/98 (OJ EPO 2000, 497), which concerns double patenting arising from a divisional application, the board concluded that Article 125 EPC was not applicable, as prohibition of conflicting claims would be a matter of substantive law rather than a matter of procedure (see point 3.6 of the reasons).

However, double patenting also comprises procedural aspects. Reference is made to the minutes of the Munich Diplomatic Conference of 1973, M/PR/I, point 665, page 62, which confirm the procedural aspects of double patenting. The relevant passage reads as follows:

"In connection with Article 125, it was established at the request of the United Kingdom delegation that there was majority agreement in the Main Committee on the following: that it was a generally recognised principle of procedural law in the Contracting States that a person can be granted only one European patent for the same invention in respect of which there are several applications with the same date of filing."

The board concludes that refusal of a European application for double patenting comprises both

procedural aspects as well as matters of substantial law so that Article 125 EPC is applicable.

2.2.2 Re (b):

The evaluation of the principles of general law generally recognised in the Contracting States reveals that the majority of the Contracting States do not allow double patenting in a situation where there is both a national patent and a European patent designating the same Contracting State. Thus, section 73(2) of the UK Patents Act 1977 reads:

"If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent."

In France, this situation is governed by Article L.614-13 of the Code de la Propriété Intellectuelle:

"Where a French patent covers an invention for which a European patent has been granted to the same inventor or to his successor in title with the same filing date or the same priority, the French patent shall cease to have effect at either the date on which the period during which opposition may be filed against the European patent expires without opposition having been filed or the date on which the opposition proceedings are closed and the European patent is maintained. However, where a French patent has been granted at a date later than either of the dates, as appropriate, laid down in the foregoing paragraph, such patent shall not take effect. The

subsequent lapse or annulment of the European patent shall have no effect on the provisions of this Article."

Most Contracting States have provisions similar to the French law, i.e. the national patent ceases to have effect in case of double patenting with a European patent. These Contracting States include Belgium, Bulgaria, Croatia, Cyprus, the Czech Republic, Estonia, Germany, Greece, Italy, Latvia, Liechtenstein, Luxembourg, Malta, Monaco, the Netherlands, Portugal, Romania, Slovakia, Slovenia, Spain, Switzerland and Turkey. Double patenting in this situation is also not allowed in Ireland where, as in the United Kingdom, the national patent is revoked in such a case, and in Macedonia as well as in Lithuania. In Austria, Denmark, Finland, Hungary, Iceland, Norway, Poland and Sweden, simultaneous protection by a national patent and a European patent is not excluded (see National law relating to the EPC, 14th ed., table X).

In view of the fact that double patenting involving a national patent and a European patent is not possible in the great majority of the Contracting States (27 out of 35), it has to be concluded that this principle of law is generally recognised in the Contracting States.

However, this exclusion of double patenting concerns a very specific situation in the post-grant procedure, i.e. a situation where, as mentioned above, a granted national patent and a granted European patent claim the same invention. It does not relate to double patenting in the pre-grant stage involving a patent already granted and a patent application going through the grant process.

A European patent application can be refused under Article 97(2) EPC or, as in the present case, under Article 97(1) EPC 1973 if it or the invention to which it relates does not meet the requirements of the EPC. If therefore the application is refused for double patenting, the absence of subject-matter already claimed in a granted European patent by the same applicant must be a requirement that **the European application** must meet in order to be granted. The refusal of a European patent application based on Article 125 EPC therefore requires the existence of principles of law generally recognised in the Contracting States which refer to the pre-grant procedure and which allow the **refusal of a national patent application for double-patenting**. Such provisions exist in Ireland and in the United Kingdom:

Section 31(5) of the Irish Patents Act 1992 reads:

"Where two or more patent applications for the same invention having the same date of filing or the same date of priority are filed by the same applicant or his successor in title, the Controller may on that ground refuse to grant a patent in respect of more than one of the applications."

Section 18(5) of the UK Patents Act 1977 reads:

"Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications."

However, no further patent convention in the Contracting States could be found in which the refusal

of a patent application for double patenting is provided for.

The German patent law does not contain such a provision either. However, case law does exist in Germany for not granting patent applications in case of double patenting on the ground that there is no legitimate interest (see BPatGE 21, 223). Thus, the headnote in case BPatGE 21, 223 reads:

"There is no legitimate interest in granting several patents arising from applications from one and the same applicant with identical contents and priority dates."
[translation by the board]

2.2.3 To summarise:

There is a general principle of law generally recognised in the Contracting States for not allowing double patenting arising from a granted national patent and a granted European patent, but this does not provide a basis for refusing a European application under Article 97(2) EPC or Article 97(1) EPC 1973 at the pre-grant stage.

In view of the fact that only two national patent conventions of the Contracting States and the case law of a third Contracting State provide a basis for refusing a patent application for double patenting, there is no principle of law generally recognised in the Contracting States for refusing a European patent application on the ground of double patenting.

2.2.4 In the present case, where double patenting is caused by internal priority, the number of Contracting States

providing a basis for refusing an application for double patenting is further reduced to two, as the German case law, which denies a legitimate interest, does not apply for the following reasons:

2.2.4.1 Article 63(1) EPC stipulates that "the term of the European patent shall be 20 years from the date of filing of the application". The relevant date for calculating the 20-year term is not the priority date but the filing date (see in this context also Article 4^{bis}(5) of the Paris Convention). This means that the refusal of the contested application deprives the appellant of almost one year of protection, since the starting date for calculating the 20-year term is shifted from 21 July 2003 (filing date of the contested application) to 25 July 2002 (priority date of the contested application = filing date of document (1)). Therefore, the appellant has a legitimate interest in the grant of the contested application. In this context it is noted that the presence of two identical sets of claims in a granted patent and in a patent application of the same applicant is not a sufficient reason for denying a legitimate interest. All the rights arising from these documents, including the period of patent protection, have to be taken into consideration. As a consequence, the German case law is not relevant in the present case.

2.2.4.2 According to the German patent law, an earlier application from which a subsequent application claims priority is deemed withdrawn with the declaration of priority according to § 40(5). This means that double patenting arising from an internal priority cannot occur according to German law, as the earlier

application cannot proceed to grant. It is important to note that it is the earlier and not the subsequent application claiming priority from the earlier application that cannot proceed to grant. In this way, the legitimate interest of the applicant in terms of the period of protection is guaranteed.

2.2.5 As a consequence, irrespective of whether or not the EPC lacks procedural provisions in connection with double patenting (see point 2.2 (c) above), Article 125 EPC does not provide a basis for refusing a European application on the ground of double patenting.

2.3 Article 60:

2.3.1 In decision T 307/03 of 3 July 2007 (unpublished), it was decided that Article 60 EPC provided a basis for refusing a European application for double patenting. Article 60 EPC stated that "The right to a European patent shall belong to the inventor or his successor in title", from which it could be deduced that under the EPC the principle of double patenting applied, as the inventor or his successor in title had a right to the grant of one and only one patent from the EPO for a particular invention as defined in a particular claim. Once a patent had been granted, this right to a patent had been exhausted and the EPO was entitled to refuse to grant a further patent to the inventor or his successor in title for the subject-matter for which he had already been granted a patent (see point 2.1 of the reasons). The fact that the EPC did not contain any specific provisions relating to double patenting was not decisive, as the legislator could not be expected to have made provisions to regulate what would on

grounds of economics alone be a very rare occurrence. The board could recognise no legitimate interest in anyone having two or more identical patents with the same claims and the same priority dates (see point 2.3 of the reasons).

2.3.2 Article 60 EPC is integrated into Chapter II of Part II of the EPC, which concerns "Persons entitled to apply for and obtain a European patent - Mention of the inventor", and it is the purpose of Article 60 EPC to define to whom the right to a European patent belongs. This board cannot see how Article 60 EPC could serve as a basis for refusing a European application under Article 97(2) EPC for double patenting, it cannot agree that Article 60 EPC can be interpreted such that the inventor or his successor in title has a right to the grant of one and only one patent from the EPO for a particular invention, with the consequence that claims comprising subject-matter included in the claims of an already granted patent of the same applicant are refused no matter whether or not the applicant has a legitimate interest in the grant of the subsequent application. Contrary to the reasoning applied in decision T 307/03, this board is convinced that the fact that the EPC does not contain any specific provisions relating to double patenting is decisive: in the absence of such provisions, a refusal of a European patent application for double patenting is not possible irrespective of whether or not double patenting is a rare occurrence.

2.3.3 It could be argued that in such a case the rights to the patent granted on the basis of the earlier application could be given up. However, this argument

is futile, as the EPC does not provide a basis therefor: the priority right of the EPC does not include a provision corresponding to § 40(5) of the German law, which would prohibit the grant of the earlier application and thus prevent double patenting in a case of internal priority in the first place (see point 2.2.4.2 above). Furthermore, there are no means of forcing an applicant to abandon an already granted patent as a prerequisite for granting the subsequent application either.

2.3.4 As a consequence, the contested application cannot be refused under Article 60 EPC for double patenting.

2.4 Identity of the parties:

Double patenting as understood in this decision requires that the parties of the conflicting patents or patent applications are identical. In the present case, the patentee of document (1) is Boehringer Ingelheim Pharma GmbH. Boehringer Ingelheim Pharma GmbH also filed the contested application as international application WO 2004/011006 on 21 July 2003, which entered the European phase as EP 03 771 064.7 on 12 January 2005. In the Declaration of Assignment dated 27 April 2007, Boehringer Ingelheim Pharma GmbH assigned, transferred and set over the entire right, title and interest in and to the above-mentioned protective rights, including priority rights of EP 03 771 064.7 to Boehringer Ingelheim Vetmedica GmbH. The transfer was registered by the EPO on 4 May 2007. No transfer was effected in connection with document (1).

In view of the above transfer, the patentee of document (1) and the applicant of the contested application are no longer identical. As a consequence, the present case resembles the situation described in the last sentence of the paragraph of the Guidelines mentioned above, which explains that where two applications of the same effective date are received from two different applicants, each must be allowed to proceed as though the other did not exist. Formally, therefore, double patenting as defined above no longer exists.

The board is aware that such a unilateral transfer of rights might in certain Contracting States not be allowable under all circumstances. Thus, Article L. 614-14 of the French Code de la Propriété Intellectuelle reads:

"Where a French patent application or a French patent and a European patent application or a European patent have the same filing or priority date, cover the same invention and belong to the same inventor or to his successor in title, those parts which are common may not be transferred, pledged, mortgaged or their exploitation rights assigned independently of each other on pain of nullity."

However, this is a question of the subsequent national phases, for which the board is not competent. As a consequence, the application cannot be refused for double patenting, as the parties of the conflicting patent documents are not identical.

3. *Decisions G 1/05 and G 1/06:*

According to Article 21 RPBA a referral to the Enlarged Board of Appeal shall be made if a board considers it

necessary to deviate from an interpretation or explanation of the convention contained in an earlier opinion or decision of the Enlarged Board of Appeal. In point 13.4 of decisions G 1/05 and G 1/06 (OJ EPO 2008, 271 and 307, respectively), the Enlarged Board of Appeal accepts that the principle of prohibition 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 therefor. However, point 13.4 of said decisions concerns double patenting in connection with divisional applications. With divisional applications the filing date and, as a consequence, the 20-year term according to Article 63(1) EPC are the same as with the earlier application(s) on which the divisional application(s) is/are based. Therefore, the present case differs from this situation in that it concerns double patenting arising from internal priority where the conflicting documents have different filing dates. As a consequence, the board concludes that the present decision is not in contradiction with decisions G 1/05 and G 1/06, so that a referral to the Enlarged Board of Appeal according to Article 112(1)(a) is not necessary.

4. *Reimbursement:*

The examining division, being bound by the instructions given by the Guidelines, acted correctly in refusing the present application. Nevertheless, the application was refused under Article 97(1) EPC 1973 for non-compliance with a non-existent requirement of the EPC. The refusal therefore infringed the applicant's fundamental right that there should be a legal basis

for any requirement relied on to invoke Article 97(1) EPC 1973. Since the appellant was obliged to file the present appeal to overcome this refusal, the board judges it to be equitable that the appeal fee should be reimbursed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of the first instance for further prosecution on the basis of the main request filed with letter dated 28 April 2006.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman

N. Maslin

U. Oswald