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ALERT

MARCH 2019



## Extension of Protection for Up to One Year Possible? New Referral on Double Patenting

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The prohibition of double patenting has long been debated at the European Patent Office and has led to divergent jurisprudence in the Boards of Appeal "BoA". Although the European Patent Convention "EPC" has no provision explicitly prohibiting double patenting, in decisions G 1/05 and G 1/06, the Enlarged Board of Appeal "EBA" acknowledged the principle of prohibition 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. However, these decisions were made in the context of divisional applications that result in the same filing date as a parent patent. As the 20-year patent term is calculated from the filing date, the parent and the divisional patents expire on the same day. There is, however, no clarification from the EBA regarding whether a legitimate interest exists in the case of a so-called "internal priority."

Internal priority refers to the situation in which a patent application claims priority from a previous patent application in the same jurisdiction. The EPC allows a first European patent application to proceed to grant when internal priority is claimed by a second European patent application. Under this scenario, the second European patent application claiming the same subject matter, if granted, will have a patent term ending up to one year later than the first European patent. However, the jurisprudence of the BoA has been divergent regarding whether in an internal priority situation, the applicant would have a legitimate interest in a second patent protecting the same subject matter.

In appeal case T 318/14 that leads to the new referral (see [link](#) to the minutes of the proceedings), the examining division refused the European application directed to subject matter identical to a granted European patent from which it claims priority. It will be interesting to see whether the EBA will recognize a legitimate interest in an additional year of protection. Although it is not often that both a European priority application and a subsequent application proceed to grant, such situations might have a solid strategic basis. For example, a quick grant of the priority application might secure initial funding through licensing, whereas an additional year of protection afforded by the follow-up application might be invaluable in fields such as biotech and pharma. Jones Day will continue to monitor the appeal case and keep you apprised of its development.



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