
The right of priorities: Recent developments in EPO case law

Reported by *Dr. Rudolf Teschemacher*

Recent decisions passed by three different instances of the EPO have significant effects on the patentability of inventions under European patent law. All of them concerned the validity of patents to be assessed in opposition proceedings. Applicants should be aware of the consequences of these decisions. Avoidable mistakes when filing a European patent application and even previously may later result in the loss of the patent.

1. EPO, Enlarged Board of Appeal, decision of November 29, 2016, Case G 1/15, OJ EPO 2017, A82 – *Infineum USA L.P. v Clariant Produkte (Deutschland) GmbH*

Prior to decision G 1/15 of the Enlarged Board of Appeal (EBA), divergent case law created considerable legal uncertainty in respect to the application of Art. 88 (2), 2nd sentence, EPC on partial priorities. One line of case law interpreted the previous decision G 2/98 of the EBA to mean that partial priority can only be claimed if the relevant claim comprises alternative embodiments, one or some of which are covered by the priority. By contrast, these decisions did not acknowledge that partial priority was validly claimed if the subject-matter disclosed in the priority application was claimed in more general terms (e. g. by a broader range) in the European application claiming priority.

This had the consequence that a European application as a priority application could

become novelty destroying under Article 54(3) EPC for a more generically defined claim in the later European application claiming priority. In *Nestec v Dualit* [2013] EWHC 923 (Pat), the Patents Court for England and Wales followed this line of Board of Appeal decisions. The same approach created the problem of “poisonous divisionals”. In decision T 1496/11 of September 9, 2012, Board of Appeal 3.2.05 concluded that an embodiment disclosed in a divisional application could anticipate a generic claim of the parent application. While this decision was not followed by others and remained isolated, it added to the already existing uncertainty and made it difficult to advise applicants on how to use divisional applications.

In G 1/15, the EBA found that this restrictive practice did not have a basis in the EPC or the Paris Convention. The EBA restored legal certainty and answered to the referred question as follows:

Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic “OR”-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect.



*Dr. iur.
Rudolf Teschemacher,
Senior Consultant*

BARDEHLE PAGENBERG
Partnerschaft mbB
Patentanwälte Rechtsanwälte

Prinzregentenplatz 7
81675 Munich
T +49.(0)89.928 05-0
F +49.(0)89.928 05-444
info@bardehle.de
www.bardehle.com

ISO 9001 certified

**2. EPO, Technical Board of Appeal
3.3.07, decision of November 9, 2017,
Case T 282/12 – Coated tablets/
JOHNSON & JOHNSON**

It was foreseeable that the definition in G 1/15 which subject-matter may give rise to partial priority could not be without consequences for the assessment of what is the first application from which priority can be claimed within the meaning of Article 87 (1) EPC, corresponding to Art. 4A(1) of the Paris Convention.

The contested claim of the European application in case T 282/12 related to a coated tablet in which a feature for the structure of the tablet was defined by a range of 3 % to 33 % of a given length. This range was disclosed for the same tablet in the US continuation-in-part-application from which priority was claimed. However, a previous application in the US of which the priority application is the continuation-in-part already defined a narrower range of 5 % to 33 % and disclosed all other features. This means, that the previous application already gave rise to a right of priority for a tablet with the narrower range. On the basis of the principle laid down in G 1/15, the Board found that the claimed subject-matter had to be conceptually divided into two parts, i. e. 3 % to 5 % enjoying priority from the continuation-in-part disclosing a tablet with this part of the range as claimed for the first time and 5 % to 33 % not enjoying priority.

Since a prior use had been alleged exhibiting a value of 17 %, i. e. within the part of the range from 5 % to 33 % for which the priority was held to be not valid, the case was remitted to the Opposition Division for examination of prior use.

**3. EPO, Opposition Division, decision
concerning European patent 2 771 468
issued in writing on March 26, 2018
– *The Broad Institute, Inc. et al. v
Schlich, George et al.***

The contested patent relates to an essential aspect of the CRISPR technology for modifying genetic information. Although the decision, denying priority from a US provisional application, is only a first instance decision, the revocation of the patent pronounced in the oral proceedings on January 17, 2018 has resulted in many comments on blogs and elsewhere. In reaction, the proprietors of the patent stated in a press release that the decision is based on a technical formality and in conflict with international treaties. They immediately filed an appeal and expect that the Board of Appeal will resolve the problem not just for CRISPR patents, but for a wider range of European patents and applications claiming priority from US provisional applications.

The European patent was granted on the basis of a Euro-PCT application claiming priority from 12 US provisional applications. Not all the applicants of the provisional applications were indicated as applicants in the PCT application and the decisive question was whether this was detrimental to some of the priorities.

In their final submissions, the proprietors relied on 3 lines of arguments:

**(i) No competence of the EPO to
assess legal entitlement to the right
of priority**

According to the proprietors, ownership of the right to priority should only be a

matter for the national courts to decide and challenging the right of priority should only be allowed for the truly entitled person.

The Opposition Division finds that, under Articles 87 to 89 EPC, the EPO has to assess the validity of the priority claim in order to determine patentability requirements. Thus, it cannot simply rely on the applicant's declaration on the entitlement to the priority right for determining the relevant state of the art. Rather, it has to examine whether the applicant of the European patent application was the applicant of the first application or is his successor in title. This is in line with EPO's established practice, relevant case law and the legal history of the EPC.

(ii) Any person within the meaning of Article 87(1) EPC should mean anyone of a plurality of co-applicants of the first application

The proprietors submitted that it is the purpose of the priority right to assist the applicant in obtaining international protection. According to them, this can only mean to assist each of the co-applicants of the first application indiscriminately. They stated that third parties' interests are sufficiently guaranteed by the "same invention" requirement.

In the end, the Opposition Division does not agree. The text of the Convention ("Any person", "Jedermann", "Celui qui") does not give a clear answer as to whether, in the case of co-applicants, "all applicants" or "any of them" is meant, although the French version is the more restrictive one. Neither did

the *travaux préparatoires* of the EPC or the Paris Convention provide a clear reading. However, a basis for the "all applicants" approach can be found in the first commentaries on the Paris Convention as well as in EPO and national practice and case law. The Opposition Division discusses whether claiming priority by one co-applicant may be considered an act of exploitation which would not exclude the other co-applicants, but notes that this approach would lead to the far-reaching consequence of a multiplication of proceedings with identical content. In any case, there are no exceptional circumstances for the Opposition Division to deviate from the practice established by the Guidelines and consistent case law requiring that the right of priority has to be exercised by all co-applicants of the first application or their successors in title.

(iii) Any person "who has duly filed" – to be assessed under US law

Under US law, the person who has duly filed a provisional application as the first application is a person who has contributed to the invention as claimed in the application claiming priority. Considering that the US provisional(s) disclosed multiple inventions and that some of the inventors/applicants of the provisionals did not contribute to the inventions claimed in the PCT application in the case at hand, the proprietors suggest that US law should be decisive for assessing "who has duly filed".

The Opposition Division disagrees. It holds that, under the Paris Convention, national law only applies to assessing

whether the first application is to be accorded a filing date. It does not refer to a condition of substance, in the sense that the person filing the first application should be entitled to the invention. It states that this approach is consistent with Article 5 of the Patent Law Treaty which does not foresee any entitlement to the invention by the person filing the application. The Division argues that Article 8(2)(b) PCT invoked by the

proprietors is not relevant in the present context since it is concerned with internal priorities whereas the priority at issue is a Convention priority for which Article 8(2)(a) PCT refers to the Paris Convention. Thus, under the Paris Convention and the EPC, the right to claim priority is derived from the formal filing of the first application, irrespective of the status of inventor.

Remarks

This is not the place to discuss the merits of the appeal in the CRISPR case but it may be expected that the proprietors will spare no pains to get the decision of the Opposition Division set aside. It has been counted that the EPO file has some 42 000 pages, many will be added in appeal proceedings. Maybe a point of law of fundamental importance will be argued and a referral to the EBA be requested.

The present difficulties arise from the fact that the system of provisional applications establishing US internal priority and introduced in 1995 was not conceived analogously to priority under the Paris Convention. Rather, the specific aspects of the US first-to-invent system were the determining factors. At the outset, it was not even possible to get a patent granted on a provisional application. This raised doubts whether a provisional application was “an application for a patent” within the meaning of Article 4A(1) of the Paris Convention (see the Notice of the President of the EPO in OJ EPO 1996, 81). Only later was the problem solved with the possibility

to transform a provisional application into a regular application (35 U.S.C. § 111b(5), 2nd sentence). Nevertheless, the system of provisional applications remains amalgamated with questions of inventorship which are outside of the scope of the Paris Convention. While the Paris Convention does not restrict the freedom of the Member States how to establish a system of internal priorities, national provisions on internal priorities cannot modify the requirements of the Paris Convention on priorities in its Article 4.

Those users of the European patent system not sharing the proprietors’ optimism about the result of the appeal proceedings will be well advised to take appropriate precautionary measures in case their right of priority becomes relevant and contested. There are two alternatives:

a) The applicants of the first application remain the applicants for the application claiming priority. Any necessary transfer is made after that point in time. In the international phase of an interna-



tional application, the indications on the applicant(s) are amended on a request under Rule 92*bis* PCT.

b) If the applicants for the application claiming priority are not the same as the applicants of the first application, all co-applicants of the first application who are not co-applicants of the application

claiming priority have to transfer their right of priority to at least one of the co-applicant(s) of the application claiming priority before filing the latter. Appropriate documentation of the transfer fulfilling the civil law requirements of the applicable law has to be kept available.