

---

### **Entitlement to priority under the European Patent Convention Decisions G1/22 and G2/22 of the Enlarged Board of Appeal of the European Patent Office dated October 10, 2023**

*Reported by Dr. Niels Malkomes and Dr. Georg Anetsberger*

---

**With its decisions G1/22 and G2/22, the Enlarged Board of Appeal of the European Patent Office (EPO) not only settled the question which jurisdiction and which law is applicable for assessing whether a party is entitled to claim priority under Article 87(1) EPC in favor of the EPO's competence and the autonomous law of the EPC. The EBoA moreover circumvented the disputed concept of the "PCT joint applicants approach" in favor of the even more generic approach that there is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with the formal requirements as stipulated by Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.**

#### **1. Summary of Facts and Submissions**

The decision G1/22 concerns opposition appeal proceedings re European patent EP 1 755 674, whereas the decision G2/22 concerns appeal proceedings re a divisional application of the opposed patent's patent family. Both appeal cases were consolidated pursuant to Art. 10(2) RPBA.

The European patent application underlying the opposed patent was published as international application WO 2005/110481 with the filing date of May 16, 2005 (the

"PCT application") and claims the priority of the US provisional patent application No. 60/571,444, filed on May 14, 2004 (the "priority application"). The priority application was filed in the name of three inventors. The PCT application names the three inventors as inventors and as applicants for the United States of America (US) only. For all designated States except the US, it names Alexion Pharmaceuticals, Inc. and the University of Western Ontario as applicants. The opposed patent was granted on November 19, 2014. Since the University of Western Ontario assigned their right to the patent application to Alexion Pharmaceuticals, Inc. in 2007, the opposed patent names the latter as the sole patent proprietor (the "patent proprietor", later the "appellant").

The opposed patent was revoked after opposition proceedings, as the priority claim was found invalid because only the priority right of one of the three inventors had been assigned to the patent proprietor (the applicant at that time). As a consequence, the opposition division found that the subject matter of claim 1 of the main request lacked novelty over D20 and D21 which were published after the priority date but before the filing date.

Regarding the divisional application, the same issues concerning the formal priority were invoked during the examination proceedings, so that the divisional application was refused because D20 and D21 were found to be novelty-destroying prior art.



Dr. Niels Malkomes  
*German and European Patent Attorney, UPC Representative, Partner*



Dr. Georg Anetsberger  
*German and European Patent Attorney, UPC Representative, Partner*

BARDEHLE PAGENBERG  
Partnerschaft mbB  
Patentanwälte Rechtsanwälte

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

ISO 9001 certified

The proprietor and the applicant, respectively, filed appeals (*ex-parte* appeal T 2719/19 and *inter partes* appeal T 1513/17) allocated to the same board of appeal. In both cases, the appellant argued that the priority right derived from the priority application was valid and documents D20 and D21 were thus not prior art.

The proprietor in particular argued that the so-called “*joint applicants approach*” should similarly apply to PCT applications having different applicants for different designated states (hereinafter, this approach is referred to as “*PCT joint applicants approach*”). The “normal” “*joint applicants approach*” (cf. T 1933/12) in general relates to the scenario where a party A is applicant for the priority application and parties A and B are applicants for the later application. As found to be undisputed in the referring decision, party B can benefit from the priority right to which its co-applicant A is entitled and a separate transfer of the priority right to party B is not needed.

### **2. The Appeal Proceedings and the referring Decision**

The referring BoA decided, in accordance with the requests of all parties, to refer “*a question concerning the PCT joint applicants approach*” (referred question II below) to the EBoA.

In view of the parties’ position that the questions to the EBoA should include a question regarding the jurisdiction of the EPO to decide on the entitlement to the priority right, the referring BoA also sought a final decision on the “jurisdiction issue”. To justify the referral of that question, the

referring BoA noted that the jurisdiction of the EPO to decide on the entitlement to the priority right had been extensively addressed and supported in T 844/18, whereas the opposite position was taken in certain communications of boards in cases that were eventually resolved without a decision on the issue of entitlement to priority.

Consequently, the referring BoA referred the following questions to the EBoA for decision:

I.

Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

II.

If question I is answered to the affirmative, can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

### 3. The Decision of the Enlarged Board of Appeal

#### The situation prior to G1/22 and G2/22

The EBoA considered the case law to be substantially uniform (at least during the past 10 or 15 years when there was a significant increase in cases where the entitlement to priority was challenged) insofar as the EPO is viewed to have jurisdiction to decide who is entitled to claim priority.

However, the EBoA considered the case law to be diverging or has not developed much in many aspects when it comes to the question how the EPO should decide disputes on entitlement.

According to consistent case law, national law is applicable to the succession in title addressed in Article 87(1) EPC (see e.g. T 1201/14, Reasons, point 3.1.2, with further references) (cf. point 62).

As the EPC does not contain conflict of law rules for the determination of the applicable national law except for the provision in Article 60(1) EPC that for employee inventions the right to a European patent shall be determined in accordance with the law of the state in which the employee is mainly employed or in accordance with the law of the state in which the employer has the place of business to which the employee is attached, there exist a variety of different options, none of which had a clear preference in the EPO case law so far: “*lex originis*” (law of the country where the first application was filed), “*lex loci protectionis*” (law of the country where the subsequent application was filed),

“*lex loci contractus*” (law of the country which is agreed upon in the relevant contract), “*lex domicilii*” (law of the country where at least one of the parties to the transfer has its residence).

The respective national law was applied by the Boards of Appeal in cases where the applicable national law was determined. Parties were regularly requested to file evidence (such as a legal opinion from an independent law expert) concerning the effects of the applicable national laws (see already J 19/87, Facts and Submissions, point VIII).

National courts applied conflict of law rules, such that for instance the German Federal Court of Justice (cf. X ZR 14/17 – Drahtloses Kommunikationsnetz, point 71) ruled that the validity of the transfer of a right to claim priority for a European patent application is subject to the laws of the state of the priority application (*lex originis*).

The referring BoA considered that it was “*far from clear*” that the legal requirement for the transfer of priority rights by agreement should be assessed under national law, as the EPC does not contain any conflict of laws rules (referring decision, Reasons, point 37). The referring BoA moreover drew the conclusion from earlier case law that the EPC did not seem to impose any formal requirements for the transfer of priority rights by agreement. Rather, the referring BoA suggested the rationale that an implicit agreement could be sufficient to bring about the transfer of the priority right for the EPC territory (cf. Reasons, points 38, 67).

Regarding the question of different applicants of the priority application and the subsequent application, the EBoA discusses not only the “*joint applicants approach*” but also the “*all applicants approach*” used, for example, in decision T 844/18 (Facts and Submissions, point VIII). In the latter case, four inventors were applicants of the priority application and only three of them filed the subsequent PCT application (encompassing the European application) and claimed priority. The priority claim failed to meet the requirement of the “*all applicants approach*”, i.e., that all applicants of the priority application must also be applicants of the subsequent PCT application for which the priority is claimed.

### The rationale of the EBoA

The EBoA argued that priority rights are autonomous rights under the EPC and should be assessed only in the context of the EPC, regardless of any national laws, since the creation, the existence and the effects of the priority right are governed only by the EPC (and by the Paris Convention through its relationship with the EPC) (cf. Reasons of the decision, point 85). Moreover, in view of Article 87(1) EPC, the EPO has to assess all aspects of the right of priority (“where”, “what”, “when” on the one hand and “who” on the other; T 844/18, Reasons, points 12 to 20) without distinction (cf. point 91).

The priority right has to be strictly distinguished from the applicant’s entitlement to the application. For the latter, the EPO does not have competence, in line with Art. 60(3) EPC (cf. point 79).

The EBoA further considered that the EPO should adapt itself to the lowest standards established under national laws and accept informal or even tacit transfers of priority rights under almost any circumstances. The EBoA even considered, as a sidenote, that the well-known requirement that the transfer of the right of priority needs to be concluded before the filing of the subsequent European patent application is questionable (see point 100). According to the EBoA, the latter is however of little practical relevance, as the EBoA relies on the presumption that priority entitlement is presumed to exist on the date on which priority is claimed for the subsequent European application (see point 100).

Based thereon, the EBoA further developed the rationale of the “*Rebuttable presumption of entitlement to claim priority*”: entitlement to priority should in principle be presumed to exist to the benefit of the subsequent applicant of the European patent application if the applicant claims priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations. Said rationale particularly considers that fulfilling the formal requirements – including, *inter alia*, the filing of the usually still unpublished priority application in time – is usually impossible without the cooperation of the priority applicant. Overall, said rationale of the EBoA takes into account

- (i) that the priority applicant or its legal predecessor must under normal circumstances be presumed to accept the subsequent applicant’s reliance on the priority right,
- (ii) the lack of formal requirements for the transfer of priority rights and

(iii) the necessary cooperation of the priority applicant with the subsequent applicant to allow the latter to rely on the priority right.

The EBoA considered that said approach applies to any case in which the subsequent applicant is not identical with the priority applicant but receives the support of the priority applicant required under Article 88(1) EPC. Neither does it matter whether the subsequent European application stems from a PCT application nor it is relevant whether and to which extent the members of a plurality of co-applicants for the priority application overlap with the group of co-applicants for the subsequent application (cf. point 107).

The decision emphasizes that like the priority entitlement in general, the presumption of its existence and the rebuttal of this presumption is subject to the autonomous law of the EPC only and that there is consequently no leeway for the application of national laws on legal presumptions and their rebuttal (cf. point 111).

### Order

In view of the above, the EBoA decided that the questions of law referred to the EBoA are answered as follows (cf. also the headnote):

#### I.

The European Patent Office is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC.

There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.

#### II.

The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).

In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A as applicant for one or more designated States and party B as applicant for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.

---

### Remarks

---

Particularly US applicants seeking protection for their inventions by EP patents, in particular via PCT applications, will be relieved by the rebuttable presumption of legal validity of the entitlement to claim

priority established in G1/22 and G2/22. Up until the relevant provisions of the America Invents Act came into effect in 2012, US patent applications had to be filed with the inventors as applicants.

Particularly European patents claiming priority to these applications will continue to be in force for another decade, and these patents will greatly benefit from the EBoA's rebuttable presumption.

Point 110 of the decisions of the EBoA leaves no doubts that the typical approach of challenging the validity of the entitlement to priority by throwing doubts and pleading ignorance that the formal requirements – whereof at least some of the crucial facts are typically solely within the sphere of the applicant and hardly publicly available – were actually met is not sufficient. Rather, the party challenging the entitlement to priority must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority.

The fact that the presumption of entitlement exists on the date on which the priority is claimed which may date back some considerable amount of time does not make the opponent's life easier either.

The EBoA however points out that, even though the rebuttable presumption in favor of the priority entitlement is subject to the autonomous law of the EPC, national laws may still need to be considered (see point 133). As an example, the EBoA mentions that the existence of legal entities being parties in transfers of priority rights may be relevant and may need an assessment under national laws.

Thus, even though challenging the validity of the entitlement to priority has become more difficult for third parties, some points of attack still remain. Nevertheless, the typical opponent's strategy applied before

G1/22 and G2/22 will require substantial refinement.

Other possible points of attack mentioned by the EBoA are bad faith behavior of the subsequent applicant or the outcome of other proceedings such as litigation before national courts about the title to the subsequent application (cf. point 108).

Notably, the rebuttable presumption of entitlement to claim priority also applies to EP patent applications and patents that are cited in proceedings before the EPO and that claim a priority, such that it may be easier to establish these documents to be prior art.

The EBoA considered that the presumption of entitlement exists on the date on which the priority is claimed (and thus not on the date on which the subsequent application is filed). According to Rule 52 of the implementing regulations of the EPC, the declaration may still be made within sixteen months from the earliest priority date claimed and thus even after filing the subsequent application. Insofar, it does not seem to be entirely clear whether the EBoA even gave up the hitherto well-known principle that the transfer of the right of priority needs to be concluded before the filing of the subsequent European patent application. Notably, the EBoA states at another place in the decisions and in line with EPO case law (T 1201/14, Reasons, point 3.1.1.1; T 577/11, Reasons, point 6.5, Catchword 3; T 1946/21, Reasons, point 2.3) that (cf. point 68) the *“requirement that the right of priority has to be transferred before the filing of the subsequent application can be described as a requirement based on autonomous substantive law under the EPC”*, deduced from the wording of Art. 87(1) EPC.