

Enlarged Board of Appeal
European Patent Office
80298 Munich
Germany



***Amicus curiae* brief in case G 1/15 (Partial Priority)
by The Chartered Institute of Patent Attorneys
(Article 10 RPEBA)**

About CIPA

The Chartered Institute of Patent Attorneys (CIPA) is the United Kingdom professional body which represents over 2000 UK patent attorneys. Most of our UK patent attorney members are also European Patent Attorneys. We also have a number of other members who are European Patent Attorneys while not fully qualified as UK patent attorneys. Our members play major roles not only in representing clients before the European Patent Office but also in advising clients about the effects of European patents after grant.

Introduction

Although the Paris Convention is not formally binding on the EPO, the Enlarged Board has held that the EPC is clearly not intended to contravene the basic principles concerning priority laid down in the Paris Convention (Decision G 3/93, Opinion, 4; Decision G 2/98, Reasons, 3).

Article 4F of the Paris Convention provides for the claiming of partial priorities:

“No country of the Union may refuse a priority or a patent application ... on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed ...”.

Partial priorities are of great practical importance, because it is normal (and to be encouraged) that applicants continue to develop their inventions during the priority year. Prof. Bodenhausen explains this:

“It frequently happens that, after a first application for a patent has been filed, subsequent applications in respect of the same invention for which the priority of the first application is claimed contain elements of the invention which were not present in the first application Under the Convention, such additions in later applications will not prevent priority from being

recognized for those other elements of the invention which were already present in the first application.” G.H.C. Bodenhausen, Guide to the Application of the Paris Convention , BIRPI 1969, WIPO Publication 611(E), page 54, point (d) ¹

So partial priorities are intended to benefit patent applicants. We do not believe that when the Paris Convention contracting states agreed Article 4F, they intended that a partial priority could instead have the poisonous effect that the first application might destroy the novelty of a subsequent application which claimed the partial priority from it. They even wrote into Article 4F that a patent application could not be refused on the ground that it claimed a partial priority.

Nor do we believe that this “poisonous priority” effect was the intention of the EPO Enlarged Board of Appeal when it wrote that claiming multiple priorities was subject to the condition “*provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters.*” (Decision G 2/98, Reasons 6.7)

Yet such destruction of the novelty of a subsequent application claiming a partial priority (and refusal not just of the priority but of the application itself) has been the ultimate effect. This has been the result of the developing interpretation given to the G 2/98 proviso by a succession of Technical Boards of Appeal (as documented in the referring decision T 0557/13).

We submit that this astonishing result not only fails to benefit patent applicants as intended, but it also contravenes basic principles concerning priority laid down in Article 4F of the Paris Convention. If it is not possible to clearly define a limited number of alternative subject-matters, partial priority may be refused. This runs counter to the more basic holdings of the Enlarged Board in Decisions G 3/93 and G 2/98.

We therefore welcome the present referral. In particular, we urge the Enlarged Board to examine carefully the legal basis for the proviso “*provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters.*” We have been unable to locate its basis, whether in the Paris Convention, in previous jurisprudence of the EPO Boards of Appeal, or in the FICPI Memorandum (Travaux Préparatoires, M 48/I, Section C) cited in Decision G 2/98.

We wish to note that the present partial priority issues are not confined to “poisonous divisional” situations, in which a divisional application is cited against its parent, or vice versa. The Annex below

¹ http://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf

lists several further example scenarios, in which the interpretation given by a number of Boards of Appeal to the proviso “a limited number of clearly-defined alternative subject-matters” leads to absurd results. One of these examples shows that issues can even arise in a competitive situation between two rival applicants.

1. Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document?

We submit that the answer to this question should be “no”, for the following reasons.

1.1 Priority is a right which stems from the first application in or for a Paris Convention or WTO country:

“Any person who has duly filed, in or for [a Paris Convention or WTO country] an application for a patent ... shall enjoy ... a right of priority during a period of twelve months from the date of filing of the first application.” Article 87(1) EPC, emphasis added, wording in [brackets] condensed.

This is closely modelled on the Paris Convention, Article 4A(1).

1.2 The priority right thus depends on the disclosure of that first application (the priority document). Article 87(1) EPC provides that the subsequent European application which claims the priority must be “in respect of the same invention”. However, since the priority right stems from the first application, we do not see a basis for imposing any further conditions on the subsequent application, unrelated to the disclosure of the first application. The applicant of the first application shall enjoy the priority, simply on the basis of the first application itself.

1.3 A partial priority under the Paris Convention likewise depends on the disclosure in the first application:

- *“No country of the Union may refuse a priority or a patent application ... on the ground that an application claiming one or more priorities contains one or more elements that were not*

included in the application or applications whose priority is claimed ...” Paris Convention, Article 4F.

- *“... [T]he right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed.” Article 88(3) EPC.*
- *“... [A]dditions in later applications will not prevent priority from being recognized for those other elements of the invention which were already present in the first application.” Bodenhausen, page 54, point (d), quoted above.*

1.4 We therefore submit that partial priority depends only on the disclosure of the first application, and on the extent to which the subsequent priority-claiming application concerns the same subject-matter as the first application. It acts to protect that subject-matter from intervening disclosures.²

1.5 Like a full priority, under Article 87(1) EPC the priority applicant shall enjoy this partial priority, simply on the basis of the first application. Like a full priority, we do not see a basis for imposing further conditions which do not relate to the disclosure of the first application.

1.6 In Decision G 2/98, Reasons 6.7, the Enlarged Board imposed the further condition *“provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters”* to multiple priorities. Subsequent case law has also applied this to partial priorities, as there seems to be no reason to make a distinction between them. However, we submit that it should not apply, since it is a further condition on the subsequent application, which does not relate to the disclosure of the first application. For example, we have been unable to find a basis for it in the FICPI Memorandum (Travaux Préparatoires, M 48/I, Section C), cited in Decision G 2/98. The priority date of any particular subject-matter should be determined simply from the filing date of whichever application first discloses it.

² *“Consequently, any subsequent filing ... shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention...”. Paris Convention, Article 4B.*

“... the very aim and object of the right of priority: the protection from novelty destroying disclosures during a period of twelve months from the date of filing of the first application...”. Decision G 2/98, Reasons, 5.

Application of partial priority to generic “OR”-claims

1.7 Decision G 2/98, Reasons 6.4 notes that the FICPI Memorandum (*supra*) can be said to express the legislative intent underlying Article 88(2), second sentence, EPC (which provides that “multiple priorities may be claimed for any one claim”). The Memorandum subsequently states in point 36 that the claiming of partial priorities should be governed by the same principles. We therefore submit that the Memorandum is also relevant to partial priorities of generic “OR”-claims under Article 88(3) EPC.

1.8 The Memorandum gives several examples of generic “OR”-claims³ :

- Broadening of a chemical formula. For example, the first application discloses a composition using chlorine; while the subsequent European application claims a halogen.
- Broadening of a range. For example, the first application discloses a narrow temperature range; while the subsequent European application claims a broader range.
- Broadening of a field of use. For example the first application discloses coating the inner wall of a pipe; while the subsequent European application claims coating the inner walls of hollow bodies more generally.

Discussions in professional circles have proposed other examples:

- The first application discloses a feature made from copper; while the subsequent European application claims that it is made from metal.
- The first application discloses that two members are fastened by a screw; while the subsequent European application claims “fastening means”.

1.9 Claiming priority has a function in relation to novelty. It acts to protect the subject matter of the first application from intervening disclosures (Paris Convention Article 4B; compare point 1.4 and footnote 2 above).

1.10 In the jurisprudence of the Boards of Appeal, both novelty and priority rely on essentially the same disclosure test. Subject-matter should be “directly and unambiguously derivable” (at least implicitly, using common general knowledge). In the case of priority, this is the main Conclusion of Decision G 2/98.

³ The Memorandum gives these examples in the context of claiming multiple priorities, but there seems to be no significant distinction between multiple and partial priorities. As noted, the Memorandum subsequently states that the claiming of partial priorities should be governed by the same principles.

1.11 However, the tests for novelty and full priority are not symmetrical⁴ :

- For novelty, the disclosure of a species can destroy the novelty of a more generic claim. More precisely, that follows **when the generic claim encompasses a species which is directly and unambiguously derivable from the prior art disclosure**. For example, the disclosure of a screw would destroy the novelty of a generic claim to “fastening means”.
- Under the “same invention” test of Decision G 2/98, the situation for full priority is different. A generic claim for a genus only benefits from full priority if the genus itself is directly and unambiguously derivable from the first application (the priority document). The disclosure of a species such as a screw does not provide full priority for a generic claim to “fastening means”.

In consequence, suppose that the first application disclosed only a screw, but the applicant developed the invention further during the priority year and realised that other fastening means also worked. If his later generic claim to “fastening means” had to rely only on full priority under G2/98, then an intervening disclosure of a screw would destroy the novelty of the generic claim. There have in fact been cases which only considered full priority, and where this was indeed the result. The referring decision T 0557/13 cites some of them.

1.12 We submit that this is exactly the problem that the notion of partial priority was intended to prevent, under the Paris Convention Article 4F. This is as set out by Prof. Bodenhausen in the quote in our Introduction above. The FICPI Memorandum explained that this principle should allow multiple and partial priorities even for a single claim. This obviates the need for complex claim drafting, unwieldy claim structures and a possible resulting lack of clarity. So we submit that Article 88(3) EPC should be construed accordingly.

1.13 Thus, in accordance with the FICPI Memorandum, a generic claim can claim a partial priority from a species disclosed in the first application (priority document). More precisely, that follows **when the generic claim encompasses a species which is directly and unambiguously derivable from the priority disclosure**. In accordance with the Memorandum, the generic claim benefits from the partial priority only to the extent that the species is disclosed in the first application. If the first application discloses a screw, it protects the novelty of a generic claim to “fastening means” from intervening disclosures, to the extent that the fastening means is a screw.

⁴ See also Decision G 2/98, point II(v) of the reasons for the referral by the President of the EPO

- 1.14 In point 1.11 (first bullet) and in point 1.13 above, we have deliberately highlighted wording which is almost identical. The disclosure test for partial priority under the Memorandum is the same as the disclosure test for novelty.⁵ This is to be distinguished from the test for full priority, which is not symmetrical with the test for novelty.
- 1.15 In a “poisonous priority” or “poisonous divisional” situation under Article 54(3) EPC, the same generic claim and the same species disclosed in the first application fall to be considered for both novelty and partial priority. Under our approach above, the partial priority exactly counterbalances the novelty attack. This means that the novelty attack must fail.
- 1.16 It should be acknowledged that if the disclosure in the first application is not clear, then the exact scope of the partial priority and of the novelty attack may likewise be unclear. However, in a poisonous priority situation this is unimportant, since the scope of both is identical. If the partial priority becomes relevant to protect the novelty of a subsequent claim from some other unrelated intervening disclosure, e.g. from a third party, then the onus would be on the applicant/patentee to show that this publication clearly falls inside the disclosure of his first application.
- 1.17 So why have things gone wrong with poisonous priorities? Decision G 2/98 pronounced the “directly and unambiguously derivable” test for full priority, but then also added point 6.7, requiring “a limited number of clearly defined alternative subject-matters” for multiple priorities. In a succession of cases that has subsequently been taken as an additional test also for partial priority, leading to an imbalance between the tests for novelty and partial priority. For the reasons in paragraph 1.16, we do not think that “clearly-defined” alternative subject-matters are necessary for legal certainty.

Application of partial priority in combination with multiple priorities

- 1.18 We will illustrate this with an example. Suppose the applicant has filed two priority applications within the priority year:
- Priority application P1 discloses an embodiment in which two members are fastened by a screw.

⁵ In both cases, of course, the “directly and unambiguously derivable” test should take account of what is implicit to the skilled person, and common general knowledge.

- After further work, the applicant files a second priority application P2. This provides an enabling disclosure for “fastening means”, with examples including nails, rivets, spring clips, adhesive etc.
- A European application EP1 is filed, claiming both priorities, with a generic claim in which the two members are fastened by “fastening means”.

1.19 The whole generic claim has a full priority from the date of P2, which disclosed “fastening means”. This protects the claim from a disclosure of any sort, arising on or after the date of P2. This is consistent with the simple case of partial priority, in which no application P2 has been filed. It effectively substitutes the date of filing of P2 for the filing date of the European application EP1. Compare Article 89 EPC.

1.20 As discussed above, on the basis of the FICPI Memorandum, we submit that the generic claim also has a partial priority from P1, to the extent that the fastening means is a screw. This protects the claim from a novelty attack under Article 54(3) EPC, based on another European application disclosing that the two members are fastened by a screw.

1.21 Thus, the generic claim is protected from an attack based on an application EP2 which is divided from EP1. It is also protected from an attack based on the priority application P1, if P1 is itself a European application which is subsequently published. And it is protected from an attack based on an intervening, subsequently published European application by a third party, disclosing the fastening with the screw, with a priority date between P1 and P2.

1.22 However, the generic claim would be open to attack in the event of an intervening disclosure prior to P2, disclosing two members fastened by a spring clip. Neither priority protects against this.

1.23 The priority from P2 effectively overlaps the priority from P1, rather than being a limited number of alternatives as envisaged by point 6.7 of G 2/98. Since both priority dates are within the twelve-month priority period, we see no problem with this. Under Article 89 EPC, either P1 or P2 counts as the effective filing date of the subject matter they respectively disclose.

2. If the answer is yes, subject to certain conditions, is the proviso "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" in point 6.7 of G 2/98 to be taken as the legal test for assessing entitlement to partial priority for a generic "OR"-claim?

3. If the answer to question 2 is yes, how are the criteria "limited number" and "clearly defined alternative subject-matters" to be interpreted and applied?

4. If the answer to question 2 is no, how is entitlement to partial priority to be assessed for a generic "OR"-claim?

These questions 2, 3 and 4 are only applicable if the Enlarged Board disagrees with our response to Question 1. In that event, we submit that the approach detailed in Decisions T1222/11 and T571/10 would be preferable.

Under that approach, the claim is conceptually divided into a limited number of clearly defined alternative subject-matters. These correspond to (a) one or more subject-matters disclosed in the first application(s), for which one or more partial priorities are available; and (b) the remainder of the generic claim, for which no priority is available.

The partial priorities would be allocated in the same way as we have discussed in our response to Question 1, e.g. points 1.4 and 1.13. Namely, in accordance with Bodenhausen and the FICPI Memorandum, the generic claim benefits from the partial priority only to the extent that subject-matter is disclosed in the first application.

5. If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Article 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon?

This question need only be answered if the Enlarged Board disagrees with our responses to Questions 1–4. In particular, we believe that the answer to Question 1 should be “no”. Otherwise it would lead to the absurd results in the situations described in the Annex below. These are not limited to parent-divisional relationships, and are therefore not addressed by this Question 5.

We believe that addressing the partial priority issues raised in the referred Questions 1-4 would produce a more just outcome in each of these scenarios. Attention is drawn to the fact that the last of the scenarios below is not even a case of “self-poisoning”, but a competitive situation between two rival applicants.

While a “no” answer to Question 5 would alleviate the problems in cases with parent/divisional relationships, we therefore urge the Enlarged Board to consider our responses to Questions 1-4.

Annex

In addition to European applications with a parent-divisional relationship, partial priority problems may also arise in the following cases:

- A first European application EP1 is followed by a subsequent European application EP2 which claims priority from it. EP2 has a generic “OR”-claim which is broader than the disclosure of EP1, reflecting further development work performed during the priority year. If EP1 is published, then it may destroy the novelty of EP2’s claim under Article 54(3) EPC.
- An applicant files a first application P1 (national or European), which discloses an embodiment for solving a particular problem, comprising features A+B+C, with an optional feature D. Further work during the priority year shows that A+B+D solves a separate problem from A+B+C, and that for this purpose C is not essential and D can be replaced with alternative elements having a similar function.

Two subsequent European applications EP1 and EP2 are then filed in parallel, both claiming priority from P1. EP1 discloses A+B+C+D and claims A+B+C, optionally with D. EP2 has a generic “OR”-claim covering the embodiment A+B+D, in which the feature D is claimed functionally (to cover its possible alternatives).

The main claim of EP2 does not have full priority. The claim to A+B+D covers a large number of functional variants, so the proviso to G 2/98 point 6.7 is also not satisfied. The disclosure of the embodiment A+B+C+D in EP1 then destroys the novelty of EP2’s claim to A+B+D.

- Two competitors BlueCo and RedCo both independently make an invention consisting of an embodiment X1. Both companies file respective first national patent applications P1 and P2, both disclosing X1, but BlueCo files several months before RedCo’s similar application.

BlueCo continues working, developing further embodiments X2 and X3, and discovering a general principle X. Within 12 months of P1, but after RedCo’s filing of P2 (of which they have no knowledge), they file a subsequent European application EP1 claiming priority from P1. EP1

has a generic “OR”-claim covering the principle X. This is supported and enabled across its scope by the disclosure of the embodiments X1, X2 and X3, but it also covers a large number of other variants.

RedCo does no further work. Within 12 months of P2, they file a subsequent European application EP2 claiming priority from P2, which describes and claims only the embodiment X1.

In due course, RedCo’s EP2 is published, and cited against BlueCo’s EP1 under Article 54(3) EPC. BlueCo’s generic “OR”-claim to X cannot benefit from the full priority of P1. Nor does it satisfy the proviso to G 2/98 point 6.7. RedCo’s disclosure of the embodiment X1 destroys the novelty of BlueCo’s generic claim.

Yet in this factual situation, BlueCo ought surely to win the priority contest outright, and their generic claim ought to be held valid. BlueCo’s first application disclosing X1 was clearly ahead of RedCo, they had done more work, and they had made a broader, more meritorious invention.