

EPO Set To Clarify Priority And Divisional Application Problem

Law360, New York (August 20, 2015, 10:19 AM ET) --

The right of priority was first introduced by the Paris Convention for the Protection of Industrial Property in 1883 and is now an important part of patent law around the world. The general idea of the priority right is to allow inventors to file one initial application in one country and then to file subsequent applications for other countries within one year of the priority application. This was meant to enable inventors to obtain worldwide protection for an invention without the need to file applications in all countries on the same day. The concept of priority has been considered so important that it is included in national patent laws and even the Patent Cooperation Treaty acknowledges the right to priority. The European Patent Convention (EPC) acknowledges the Priority right in Article 87 EPC.

The right to priority was initially mainly required because of the slowness of travel. At the time of the signing of the Paris Convention in 1833, sending a patent application, e.g., from Europe to Japan would have taken several months. Obtaining worldwide protection in such a world without the right of priority would therefore have been logistically impossible.

In today's world of instant communication, this is no longer a problem; it could hence be argued that the right to priority is an anachronistic relic from the past. However, the right to priority has not lost its importance, only the implications of said law have changed. Instead of curbing problems related to large delays in communication, it is now often used to obtain a search report in order to determine whether it makes sense to proceed with a worldwide patenting strategy in light of the existing prior art. It also allows inventors and smaller entities to gather funds from investors during the priority year to enable them to proceed with the worldwide patenting of their invention. The priority right is therefore still a vital element of patent law.

Recent Developments in the Use of the Right to Priority

At the time of the Paris Convention, it seemed evident that only the same exact application as the priority application would be able to enjoy the priority right. However, since the time to transmit an application anywhere on the planet has dramatically decreased, it has become common practice to amend the application during the priority year. This new practice led to the following type of questions:



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When is an application entitled to the priority date of the earlier application? And which amendments are acceptable without the right of priority being lost?

The European Patent Office is notoriously strict with respect to amendments to a patent application. One of the important cases regarding the material right of priority was the so called Snackfood decision, T 73/88. In this decision, the board recognized the right to priority of a claim, even though the claim contained an additional feature which was not disclosed in the priority application.

The Snackfood decision was widely disputed. The Enlarged Board of Appeal finally settled the matter with its decision G 2/98 in which it ruled that the right to priority only applies to the “same invention.” The Enlarged Board of Appeal thereby clearly established that a claim could only enjoy priority if it was disclosed directly and unambiguously in the priority document.

However, the same decision also allowed claims to enjoy partial priority, provided the claim language “gives rise to the claiming of a limited number of clearly defined alternative subject-matters.” With this decision it therefore became possible to have a claim in which a first set of embodiments enjoys the priority and a second set of embodiment does not. The condition being that there are only a “limited” number of embodiments in the claim.

The Influence of G 2/98 on Priority and Divisional Applications

While G 2/98 established the possibility of partial priority, it also opened Pandora’s box. Indeed, the Enlarged Board of Appeal did not provide an exact definition of what a “limited” number of embodiments is. As a result, different boards of appeal have over the years arrived at different conclusion depending on how they interpreted this edict from the Enlarged Board of Appeal. Indeed, in some cases, the boards of appeal ruled that the claims enjoyed partial priority, and in others, that they did not. However, the legal consequences of such divergent rulings are very different from each other. A ruling that an application does not enjoy any priority from its priority application opens the possibilities for applications of the same family to become poisonous for each other.

In many cases, the loss of the priority right is of no consequence. This is the case, for example, if no relevant prior art document was published between the priority date and the application date. However, if an application claims a broader subject matter than its priority document, the question of priority becomes essential. Indeed, if the priority does not hold, the priority application can potentially become novelty-destroying for the later, broader application. This is because the narrower application has an earlier filing date than the broader application. Therefore, if the earlier application is not linked to the broader application by the priority right, it becomes part of the state of the art against which the novelty of the broader application is evaluated (article 54(3) EPC). The applicant’s own priority application therefore becomes novelty destroying for his subsequent broader application.

This problem could be circumvented if the broader application enjoyed partial priority (i.e., priority for the subject matter disclosed in the priority application). In T 1222/11 for example, the Board decided that the embodiments of the claim of the later application that were disclosed in the priority document enjoyed the priority date. The novelty of those embodiments could therefore not be taken away by the priority document. Since the other embodiments were not disclosed in the priority document, they were also novel over this document. If applied to all cases, this decision would have eliminated the possibility of a priority document or a divisional application becoming prior art according to Article 54(3) EPC.

However, other boards interpreted the decision G2/98 strictly and denied partial priority to claims that

in their view disclosed more than a “limited number of clearly defined” embodiments. By denying partial priority, these boards found that an application or patent could lack novelty in view of a published priority application or a divisional application. Examples of such cases are T 1443/05, T 2311/09, T 1127/00, T 1877/08 and T 476/09.

An exemplary case is T 2311/09. The claim under dispute read as follows:[1]

1. An isolated chemoattractant protein capable of attracting eosinophils and of inducing eosinophil accumulation and/or activation in vitro and in vivo and which shows substantially no attractive effect for neutrophils in vivo, consisting of or comprising an amino acid sequence having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1, or a fragment of said chemoattractant protein which retains its biological activities.

The Board of Appeal outlined in its decision, that the requirement for claiming priority of "the same invention," referred to in Article 87(1) EPC, meant that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC had to be acknowledged only if the skilled person could derive the subject matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole (Headnote of decision G 2/98 (OJ 2001, 413)). It stated that the chemoattractant protein according to claim 1 of the main request and auxiliary request 1 were characterised as "consisting of or comprising an amino acid sequence having at least 40% identity with the amino acid sequence set out in SEQ ID No. 1."

In contrast, according to the board, the relevant paragraphs on page 3 of the first priority and the second priority document, GB 9318984.3 (P1) and GB 9408602.2 (P2), respectively, stated that "other guinea pig eotaxins will generally have at least 50% overall identity with the sequence shown in Figure 3b" (lines 12-13) and that "an eotaxin from a species other than guinea pig will have at least 40% overall identity with the sequence set out in Figure 3b. (lines 32-33)." Figure 3b of document P1 disclosed SEQ ID No. 1 of the patent application. However, according to the board documents, P1 and P2 did not provide a direct and unambiguous disclosure of a broader claim, i.e., any further eotaxin variants, such as for instance non-naturally occurring variants, i.e., sequences that cannot be found in a guinea pig or a species other than guinea pig, which are also encompassed by claim 1 as granted.

Finally, the board states in its decision that there is no partial priority right for the protein with 100 percent sequence identity with SEQ ID No. 1 because the claim does not comprise a limited number of clearly defined alternative subject matters (cf. decision G 2/98, Reasons 6.7).

While the authors of this article do not know the history of the above-mentioned patent family, the case could simply be the consequence of a lesser and more experienced patent drafter being responsible for the priority application and the later application respectively. Should such an instance be held against the applicant?

For applicants it would clearly be advantageous if partial priority was always granted for all embodiments disclosed in the priority application, as was decided in case T 1222/11. This would indeed effectively eliminate the possibility of poisonous priority and divisional applications.

Referral T 557/13 to the Enlarged Board of Appeal

In a recent decision, one board of appeal finally decided that the question of the possibility of poisonous

priority and divisional applications should be settled once and for all. The board in T 557/13 extensively discussed the importance and relevance of earlier decisions, particularly of G 2/98 and T 1222/11, and decided to refer the following questions to the Enlarged Board of Appeal:

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?
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?
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?

The questions appear to be well worded and carefully considered. The first question is the most important and essentially asks whether a poisonous priority or divisional application can even occur under the provisions of the EPC. If the Enlarged Board of Appeal answers this question with "no," i.e., the partial priority cannot be refused, poisonous priority and divisional applications would no longer be possible.

The other questions relate to the interpretation of decision G 2/98. They are meant to prompt the Enlarged Board of Appeal to provide guidance as to how to assess whether a claim comprises "a limited number of clearly defined alternative subject-matters." If the Enlarged Board of Appeal rules that partial priority can be denied (question 1), the answers to the other questions should provide suitable guidance as to how the "right to partial priority" should be applied.

Present Situation

The Enlarged Board of Appeal may simply do away with poisonous applications. The board however could also formulate detailed criteria for the assessment of partial priority in keeping with decision G 2/98. We await this decision with anxiety. In the meantime, we would advise our clients to withdraw their priority applications prior to publication in order to ensure that they do not become poisonous. Further, if a party is subject to a proceeding, be it in prosecution, opposition or appeal, in which a question relating to a poisonous application has arisen, we recommend requesting the stay of proceedings provided this step is procedurally beneficial to said party. It could well be that the president of the EPO orders the stay of all such proceedings.

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[1] Various auxiliary requests were likewise pending.

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