Getting your priorities straight

Morten Garberg
European and British Patent Attorney | Partner
Introduction

Same Invention & Partial Priority

First Application

Transfer of Priority Rights

Burden of Proof
Overview

Introduction

Same Invention & Partial Priority

First Application

Transfer of Priority Rights

Burden of Proof
Article 87 EPC

- (1) Any person who has duly filed, in or for (a) any State party to the Paris Convention for the Protection of Industrial Property or (b) any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.
Enlarged Board of Appeal:

The requirement for claiming priority of "the same invention" means that priority is acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the priority application as a whole (G 2/98)

This is the same strict test also applied by the EPO for assessing:
• Added matter, and
• Novelty
Partial Priority: Article 88 EPC

(2) Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries. Where appropriate, multiple priorities may be claimed for any one claim...

(3) If one or more priorities are claimed in respect of a European patent application, the 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.

...The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2) EPC, second sentence, is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters (G2/98)
Scenario 1: “Lemons or Oranges”

US1:

EP1:

OR
Scenario 1: “Lemons or Oranges”

Lemons: Priority Date

Oranges: Filing Date
Scenario 2: “Citrus Fruit”

US1:

EP1:

What now?
Scenario 2: “Citrus Fruit”
Scenario 2: “Citrus Fruit”

Citrus Fruits which are not Lemons: Filing Date

Lemons: Priority Date
According to the Board in T 476/09, the claimed range represents a continuum of a numerical range of values which does not correspond to distinct alternative embodiments.
Consequently, no separable alternative embodiments can be identified within this continuum which could enjoy the priority date.

As a result, priority is completely lost.

This line of reasoning was also adopted in T 1127/00 (broadening of chemical formulae), T 184/06 & T 1443/05 (broadening of composition claims) and T 1877/08 (broadening of numerical ranges).
Lenient approach to Partial Priority:

T 1222/11 and T 571/10 adopt a more lenient approach to partial priority (with reference to FICPI memorandum):

Ranges 10-15, 15–20, and 20-25 are a limited number of clearly defined alternative subject-matters as required by G 2/98.
• This divergence in case law resulted in the referral of this issue to the Enlarged Board of Appeal (G1/15)

• Decision recently issued

• Conclusion: partial priorities are possible even when the claim does not expressly separate out the alternatives

• In practice, this will likely resolve the toxic divisional problem

• But can it maybe cause other problems...
<table>
<thead>
<tr>
<th>Overview</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Introduction</strong></td>
</tr>
<tr>
<td><strong>Same Invention &amp; Partial Priority</strong></td>
</tr>
<tr>
<td><strong>First Application</strong></td>
</tr>
<tr>
<td><strong>Transfer of Priority Rights</strong></td>
</tr>
<tr>
<td><strong>Burden of Proof</strong></td>
</tr>
</tbody>
</table>
Article 87 EPC

(1) Any person who has duly filed, in or for (a) any State party to the Paris Convention for the Protection of Industrial Property or (b) any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.
Claim to “Citrus Fruit”

**US1:**
Example 1: Lemons
Claim 1: Lemons

**US2:**
Example 1: Oranges
Claim 1: Citrus Fruit

**EP1:**
Example 1: Oranges
Claim 1: Citrus Fruit
Priority Status: “Citrus Fruit”

For Lemons, US2 was not the first application – hence no priority.

See e.g. T 1222/11

Citrus Fruits which are not Lemons: Priority Date

Lemons: Filing Date
Conclusions

• Partial priority broadly established in G1/15
• Fear of toxic divisionals now almost gone
• Knock-on effect of partial loss of priority leads to risks
• Careful management needed when filing a series of related cases
Article 87 EPC

(1) Any person who has duly filed, in or for (a) any State party to the Paris Convention for the Protection of Industrial Property or (b) any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.
• Mixed case law on this
• General EPO rule: the right to claim priority must be transferred before the subsequent application is filed
• T 62/05: assignment must be in writing and signed by both parties
• J 19/87: transfer must have been validly effected under the relevant national law
• T 517/14: National law to be applied is that which governs the transfer of the right
Introduction

Same Invention & Partial Priority

First Application

Transfer of Priority Rights

Burden of Proof
What level of proof is required?

• EPO decides most matters on “balance of probabilities”
Example: T 1056/01 – the any-way-up cup
So, what happened here?

- Applicant filed a UK application (1)
- They wanted to withdraw the application (1) and file another application (2) for the same invention
- Reason: a desire to use application (2) to claim priority from when filing e.g. at the EPO
T 1056/01 – Opponent:

- No priority as the prio doc was not the first application
- An earlier application existed and was withdrawn
- The earlier application was (likely) still pending at the UKIPO at the time the priority application was filed (7 April)
T 1056/01 – Patentee

• UKIPO date of publication of withdrawal is not the same as the date of withdrawal
• UKIPO did not publish the actual date of withdrawal (and also had no record)
• The Opponent had not proven that the first application was still pending on 7 April
• As this was part of Opponent’s novelty attack, Opponent had the burden of proof
• If doubt exists, Patentee should get the benefit of doubt
T 1056/01 – Decision

• Date of withdrawal is a fact in patentee’s favour
• Patentee has the burden of proof for such facts
• Level of evidence required is high – Opponent has no access to it
• **Possibility** that it was withdrawn in time not enough to save priority
• Priority not acknowledged
Thank you for your attention!

Morten Garberg  
mgarberg@hoffmanneitle.com