

ARTICLE

# IMPARTIAL TO PARTIAL PRIORITIES: QUESTIONS REFERRED TO THE EPO'S ENLARGED BOARD OF APPEAL

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Article 123 EPC. As easy as '1-2-3'? Well guess again. Somewhere between its lines hides a notorious concept in the field of patents. The inescapable trap. The fear of each attorney. Your granted claim involves added matter and there is no way to restore unless you violate the principles of patent law by shifting the scope of your patent. As the Dutch would say: it is like shooting yourself in the foot. And recent EPO practice gave rise to believe there may be another way of doing that, by pulling the trigger with the so-called poisonous priority.

### **POISONOUS PRIORITIES**

Priority. The right of an applicant to claim the filing date of his first application if, within 12 months, he files another application in respect of the same invention. At the Paris Convention back in 1883, all was set-up in order to help the inventor to protect his ideas. Fast-forward to nowadays, some practices within the EPO show that the priority claim may actually backfire on the patentee.

So how do priorities become toxic? The story begins with the common situation of further technical developments during the priority year, maybe even driven by new insights from the search report received somewhere during that priority year. Tricky situations arise when the later application EP2 claims for instance broader subject-matter than was originally disclosed in the first application EP1. Just consider the following 'AND claim' situation: you have a first application disclosing features 'A, B AND C', what happens if in your subsequent application you claim 'A, B, C AND D'? Or alternatively: first the invention was in a combination of 'A and B', and you later find that a claim on 'A' alone would suffice? In Europe, since G2/98 all is crystal clear: for such 'AND claims', you lose priority. Hands up. Any publications during the priority year could be used against you. (And you have the right to remain silent.) (But it is better not to.)

So far so good. But what if your first application gets published and still discloses embodiments within the

scope of your claim? Indeed, you have gotten yourself an Article 54(3) EPC (prior right) anticipation! So that is how priorities can be poisonous to the fate of an application.

### **THE 'TOXIC DIVISIONAL' ATTACK**

If you thought you could control this toxic issue by not having your priority document available as a prior right document, you can forget it. A 'venomenon' in the EPO case law similar to this is the controversial 'toxic divisional' attack. As soon as you filed divisional applications with the subject-matter which is found in the priority document, the problem walks in through the back door. With decision T1496/11 setting the tone, the popularity of using the toxic divisional weapon during opposition/appeal has increased, much to the concern of practitioners. 2/4

### **THE ANTIDOTE: GOING FROM 'HANDS UP' TO GETTING YOUR HANDS ON PARTIAL PRIORITY, BUT HOW?**

So where is the antidote? In the G2/98 decision, the EPO's Enlarged Board of Appeal tried to provide one by introducing a test for establishing partial priority. If the priority document discloses 'a limited number of clearly defined subject matters', then these would keep their priority date as part of a claim in a later application, even if they were claimed together with extensions to the subject-matter introduced at the later filing, as long as the resulting claim also contains 'a limited number of clearly defined alternative subject-matters'. Such claim would hence have multiple effective filing dates.

At the time, the legislator envisaged to allow partial priority for an 'OR claim' situation, e.g. if the priority document discloses 'A' and the subsequent application claims 'A OR B', then feature A would enjoy priority and feature B would get the filing date. The legislator also suggested allowing multiple effective filing dates for the situation where a species is disclosed in the priority document and its genus is subsequently claimed, as long as that genus encompasses 'a limited number of clearly defined alternatives', e.g. the priority document discloses 'rat' and the subsequent application claims 'rodents', then 'rat' would enjoy priority and the other rodent species (a limited number and arguably clearly defined alternatives) would get the filing date.



And there is the twist: when is a subject-matter clearly defined? Does the priority document have to explicitly spell out the alternative embodiments, e.g. literally mention all other rodent species except for rats? Or would it be sufficient that these alternative embodiments may be conceptually identified on the basis of the priority document? In other words, would it be sufficient that the skilled person may 'directly and unambiguously' derive these alternatives from the priority document?

### **A CHRONOLOGICAL CIRCLE FOR INTERPRETING G2/98: FROM BROAD TO NARROW TO BROAD AGAIN?**

Years ago, T665/00 took a brave interpretation of G2/98 and set the stage for the discussion on this issue. The situation: the priority document discloses an example in which microspheres are used with a specific mass of  $0.04 \text{ g/cm}^3$ ; the subsequent application claims microspheres with a specific mass of  $< 0.1 \text{ g/cm}^3$ . Thus, a single point value is used to claim priority for a range which contains an infinite amount of possible values: how limited and clearly defined is that?

Strictly speaking and according to the G2/98 test, such priority claim is invalid. Consequently, the subsequent application would get the filing date, rendering the priority document toxic as Article 54(3) EPC prior art. Despite the priority claim being invalid in T665/00, the Board decided that the example in the priority document could not be used as an anticipation against the claim in

the subsequent application. The Board has fit the issue into the EPC's legislative framework by saying that there would have been a valid priority claim only for this exact example. In the context of G2/98, the Board reasoned that the ensemble of microspheres  $< 0.1 \text{ g/cm}^3$  is to be seen as a claimed genus, a pool of embodiments out of which only the single point value of the  $0.04 \text{ g/cm}^3$  species would enjoy priority because it was disclosed in (the example of) the priority document. All other microspheres  $< 0.1 \text{ g/cm}^3$  ( $\neq 0.04 \text{ g/cm}^3$ ) would thus be entitled to the filing date. It gave rise for some discussion at that time, but it seemed all was settled. 3/4

Time has shown that little was true. A whole line of case law has been created on this point, and Boards appeared divided on the issue. Some Board of Appeal decisions (such as T1127/00, T1443/05, T1877/08, T0476/09) rather followed a narrow interpretation of the G2/98 test, requiring an explicit disclosure of alternatives in order to successfully claim partial priority (e.g. disclosing 'A-B-C-D' is acceptable for claiming all these embodiments, while 'A to D' would only allow priority for explicit embodiments 'A' and 'D'). Or, if in the case of ranges, a range from the priority document (say 1 to 10) would overlap with the subsequently claimed range (say 5 to 15), it would not be possible to claim priority for the overlapping portion (of 5 to 10), because these ranges would be continuums of values and thus not correspond to distinctive alternative embodiments).



That is, until more recently in T1222/11 a Board of Appeal broke with this line of previous case law decisions. It has taken its own, broader, approach to assess partial priority, allowing for the subject-matter of a claim to be fragmented theoretically into the bits from the priority document and extensions upon filing, without even requiring for an explicit identification of every single embodiment in the priority document (e.g. 'A to D' would now also allow priority for all embodiments 'A-B-C-D'). For establishing whether G2/98's 'limited number of clearly defined subject-matters' is disclosed in the priority document, the Board advocates using the well-known 'directly and unambiguously derivable' test from G3/89, resulting in a more context driven assessment rather than an assessment based on the literal text. Decision T571/10 has then adopted and endorsed this broader approach. So are we going back to taking the 'original' T665/00 perspective which is more in favor of the patentee? One thing is for sure: an inconsistency in the EPO jurisprudence was created.

### **CLARIFY THE LAW REGARDING PARTIAL PRIORITIES: DETOXIFICATION?**

Faced with the same 'toxic issues' in case T557/13, the EPO Technical Board of Appeal 3.3.06 has decided to turn to the EPO's Enlarged Board of Appeal in order to clarify the law regarding partial priorities: when is it available? Will there be any threat of toxic divisionals? These two main queries were broken down into the following questions that were formally referred to the Enlarged Board and were recently published, some of which really address the tests provided in the G2/98 decision. Context is needed to understand what 'limited number of clearly defined subject matters' stands for.

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? 4/4
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?

## **'BONUS QUESTION' 5: ENLIGHTENING THE TENSION BETWEEN THE IDEOLOGY OF THE PATENT SYSTEM AND THE FUNDAMENTALS OF PATENT LAW**

Interestingly, question 5 is not immediately at stake between the parties in the T557/13 case, but was formulated at the own initiative of the referring Board. This may suggest that the EPO realizes that the whole issue touches on the fundamentals of the patent system and that the EPO is willing to go that extra mile for ensuring a more robust legislation.

Question 5 addresses an important area of tension. On one hand there is the 'gut feeling' that it would be unfair for an applicant to get his own priority document backfired at him in such way that he loses his subsequent patent, since patents are in the end a reward for the applicant's inventive effort and this aspect is generally not significantly challenged by a toxic priority. In the case of divisionals the possibility of a toxic attack with a parent feels even more unfair: by definition divisionals may only contain subject-matter disclosed in the parent and they retain the parent's filing date and priority date. As such, a divisional is in essence a (partial) duplication of the parent, especially 'date-wise', so why would it be logic to allow for one to anticipate the other? On the other hand, these philosophies appear not to be directly compatible to fit into the current legal framework, which is set-up in such way that priority of subject-matter is a strict literal issue, prior rights do have a novelty destroying capability and the fate of a divisional is entirely independent of its parent. At least the EPO shows that it is aware of the need among practitioners to clarify this topic and renders the service it claims to in its mission statement: *'(...) commitment to high quality and efficient services delivered under the European Patent Convention.'*

Time will tell whether the EPO's Enlarged Board will choose for a 'detox regime' to the 'toxic' priorities and divisionals in their proceedings. Keep an eye on your NLO news feed, we will keep you posted on any developments.

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