

The Principles of Priority in EPO Proceedings

Christopher Rennie-Smith

Consultant, Collyer Bristow, former Chairman of an EPO Board of Appeal

Basic Principles - Articles 87-89 EPC

- A European patent applicant or his successor in title can claim priority (the earlier filing date)
- of an application (for patent, utility model or utility certificate – the priority document) in respect of the same invention
- filed during the previous 12 months in a Paris Convention or WTO member state

Basic Principles - Articles 87-89 EPC

- equivalent to a regular national filing - sufficient to establish the filing date of the application
- any yet previous application for the same subject-matter being at the priority date withdrawn, abandoned or refused without public inspection, without leaving outstanding rights and not having based a priority claim
- priority date counts as the filing date (for novelty and ownership as between two or more independent applicants)

Multiple Priorities

- Multiple priorities, originating in different countries, possible, where appropriate for any one claim. Time limits which run from the date of priority run from the earliest priority date. (Art 88(2) EPC)
- Based on FICPI Memorandum C which distinguished between “AND”-claims and “OR”-claims

Partial Priorities

- “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.” (Art 88(3) EPC)

Partial Priorities

- Also mentioned in FICPI Memorandum C by reference to “AND”-claims and “OR”-claims
- “If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may none the less be granted, provided that **the documents of the previous application as a whole specifically disclose such elements.**” (Art 88(4) EPC)

G2/98 – The Question

- Question to the EBA:
 - Does “same invention” in Art 87(1) EPC mean that the extent of the right to priority derivable from a priority application is determined by, and at the same time limited to, what is at least implicitly disclosed in the priority application?”
- The background to G2/98:
 - Could an additional feature not disclosed in the priority document and not related to the function and effect of the invention affect a priority claim? (T73/98).
 - Or is priority to be assessed strictly (a novelty test)? (T77/97)

G2/98 – The Answer

- “The requirement for claiming priority of “the same invention”, referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim **directly and unambiguously, using common general knowledge, from the previous application as a whole.**”

G2/98 – The Answer

- “The same invention” in Art 87(1) equates to “the same subject-matter” in Art 87(4)
- This is consistent with Art 88(2) to (4) - multiple and partial priorities
- FICPI Memorandum C cited in support (see 6.4 to 6.8 of G2/98)

G2/98 on “OR”-claims and multiple/partial priorities

- As regards “OR”-claims, it is **held** in Memorandum C that where a first priority document discloses a feature A, and a second priority document discloses an alternative feature B, then a claim directed to A or B can enjoy the first priority for part A of the claim and the second priority for part B of the claim.

G2/98 on “OR”-claims and multiple/partial priorities

- It is further suggested that these two priorities may also be claimed for a claim directed to a feature C if, in the form of a generic term or formula or otherwise, feature C encompasses feature A as well as feature B.
- The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC 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, 6.7)

Traces of Poison?

In several post-G2/98 decisions (T1127/00, T1877/08, 476/09 and T1443/05) the condition

“provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters”
characterised how “OR”-claims were defined.

T1127/00

- Claim directed to a generic formula broader than the generic formula in the priority document.
- Covered a great number of alternative compounds which were not, as such, spelled out in the claim and which did not represent a limited number of clearly defined alternative subject-matters in the form of an "OR"-claim, which could be split up into groups of different priorities.

T1127/00

- The fact that these compounds might be intellectually envisaged to fall within the scope of the claim was not considered to make up for a clear and unambiguous presence of these alternatives, individualized as such.
- Claim could not enjoy partial priority but only entitled to the priority date of the document where this generic formula was for the first time disclosed.

T1222/11

- The condition
“provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters”
should be given, when read in its proper context, a different meaning than that attributed in T1127/00 (and other decisions).
- How that happened will be explained by Alexander Esslinger
- We have not heard the last of Memorandum C....