

# Review of some Enlarged Board of Appeal referrals and opinions

**Lunes de Patentes**

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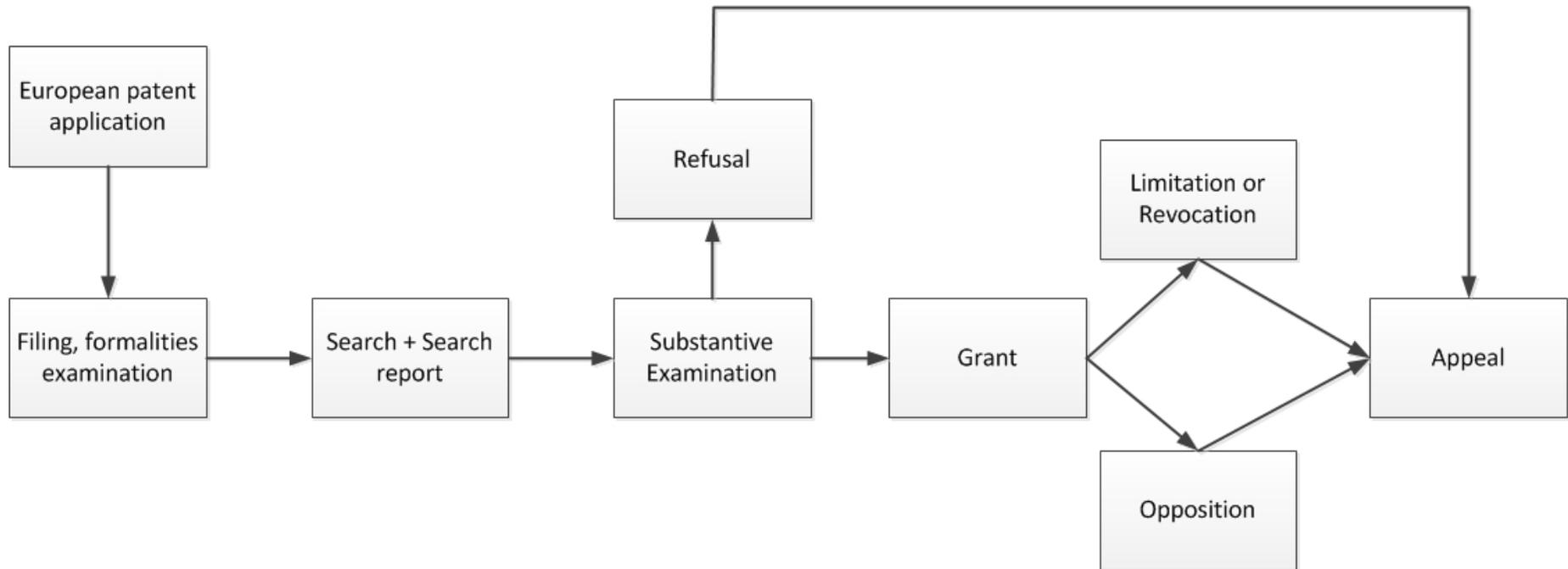
ZBM Patents and Trademarks

# Agenda

- G3/14, clarity in opposition proceedings
- G1/10, request to correct patent
- G1/15, partial priorities



# G3/14 clarity in Opposition



# G3 / 14 legal background (1)

- Art. 84 EPC: The claims shall define the matter for which protection is sought. They shall be **clear** and **concise** and be **supported** by the description.

## G3 / 14 legal background (2)

- Art. 100 EPC: Opposition may **only** be filed on the grounds that:
- (a) the subject-matter of the European patent is **not patentable** under Articles 52 to 57;
- (b) the European patent **does not disclose the invention in a manner sufficiently** clear and complete for it to be carried out by a person skilled in the art;
- (c) the subject-matter of the European patent **extends beyond the content of the application as filed**, or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed.

## G3 / 14 legal background (3)

- Art. 101(2) EPC: If the Opposition Division is of the opinion that at least **one ground for opposition prejudices the maintenance of the European patent**, it shall revoke the patent. Otherwise, it shall reject the opposition.
- Art. 101(3) EPC: If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the European patent during the opposition proceedings, the patent and the invention to which it relates
  - (a) **meet the requirements of this Convention**, it shall decide to maintain the patent as amended, provided that the conditions laid down in the Implementing Regulations are fulfilled;
  - (b) **do not meet the requirements of this Convention**, it shall revoke the patent.

# G3 / 14 legal background (4)

- G 9 / 91 (about extent of opposition):
- In order to avoid any misunderstanding, it should finally be confirmed that **in case of amendments** of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be **fully examined as to their compatibility with the requirements of the EPC** (e.g. with regard to the provisions of Article 123(2) and (3) EPC).

# G3 / 14 referral

- T 373/12 proprietor amends claims 1 by incorporating dependent claim 3. Claim 3 included a lack of clarity “*over substantially all its surface area*”.
- Is this an **amendment** in the sense of G 9/91 that needs to comply with the requirements of the Convention i.e. clarity?
- If so, is the whole claim to be investigated for clarity, or only the portion incorporated into claim 1?
- What are the conditions to be applied in deciding whether an examination of clarity comes into question in a given case?

# G3 / 14 diverging case law (1)

- T 301/87 (and others): only lacks of clarity actually caused by amendments are open for examination
  - Why?
    - Because clarity is not a ground for opposition
    - Because of efficiency of opposition proceedings
    - Because there are other ways to deal with a lack of clarity
- “Conventional approach”

# G3 / 14 diverging case law (2)

–T 1459/05 (also T 459/05 and others): any technically meaningful amendment is to be examined for clarity, also e.g. incorporation of dependent claim in independent claim

- Why? Because not all claims are “completely” examined during Examination
- Because lack of clarity (or lack of support) becomes more important in independent claim
- Because clarity is in the interest of the public

–“Divergent approach”



# G3 / 14 reasoning (1)

- No distinction in EPC, Guidelines between clarity requirements for independent and dependent claims
- But in real world, independent claims will be subject to more scrutiny. Sometimes lack of clarity does not come to light until new prior art is cited in Opposition.
- However, EPC does not appear to give basis for complete re-examination in case of amendments, only gives basis for examination of the amendment
- In the Travaux Préparatoires for EPC 2000 there was no indication that there was any intention to change the (then) established Case Law of the “conventional approach”

## G3 / 14 reasoning (2)

- Opposition proceedings have to be efficient, not “any” amendment should give rise to Art. 84 objections
- Other ways to deal with “unclear” claims: lack of novelty/inventive step or insufficiency of disclosure
  - From EPO Guidelines F-IV 4.6 (relative terms): “*an unclear term cannot be used by the applicant to distinguish his invention from the prior art.*”

# G3 / 14 decision

-In considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then **only to the extent that the amendment introduces non-compliance** with Article 84 EPC.

# EPO Guidelines D-V 5

- A claim amended during opposition proceedings is **not** subject to examination for compliance with Article 84 if it results from
  - (i) inserting **a complete dependent claim as granted** into an independent claim;
  - (ii) combining **one of several alternative embodiments** of the dependent claim as granted with the independent claim as granted;
  - (iii) deleting wording from a granted claim (whether independent or dependent), whereby its scope is narrowed but a **pre-existing lack of compliance with Article 84 is left intact** (as exemplified by T 301/87); or
  - (iv) **deleting optional features** from a granted claim (whether independent or dependent).

# EPO Guidelines D-V 5

–However, an amended claim is to be examined for compliance with Article 84:

–(v) if **features are taken from the description** and inserted into a granted claim by way of amendment; or

–(vi) if a **feature from a dependent claim as granted is introduced into an independent claim as granted and this feature was previously connected with other features** of that dependent claim and an alleged lack of compliance with Article 84 is introduced by the amendment.

# Example (1)

1. A product comprising X
2. A product according to claim 1, further comprising a substantial amount of Y, and preferably also Z

A product comprising X and a substantial amount of Y, and preferably also Z

**NOT EXAMINED FOR COMPLIANCE WITH ART. 84 EPC**

A product comprising X and a substantial amount of Y

**NOT EXAMINED FOR COMPLIANCE WITH ART. 84 EPC**

# Example (2)

1. A product comprising a surface
2. A product according to claim 1, wherein the surface has roughness
3. A product according to claim 1, wherein the surface is substantially curved
4. A product according to claim 1, wherein the surface is elongated having a length of more than Y

A product comprising a surface, wherein the surface is substantially curved

**NOT EXAMINED FOR COMPLIANCE WITH ART. 84 EPC**

A product comprising a surface, wherein the surface is elongated

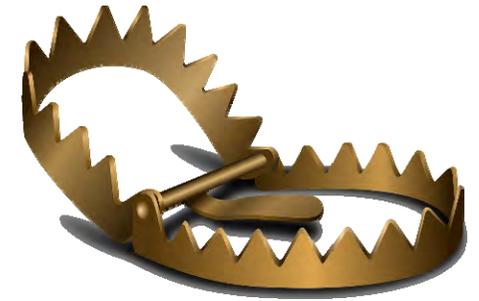
**EXAMINED FOR COMPLIANCE WITH ART. 84 EPC**

# G3/14 practical consequences



- Early Certainty, apparently increasing pressure on Examiners for timeliness.
- Have instructions/guidelines for EPO Examiners changed concerning clarity examination of dependent claims?
- Do EPO Examiners have enough time to check clarity for each dependent claim?
- Do the quality checks in place at the EPO also relate to dependent claims?

# G3/14 practical advice (1)



- Be careful when removing a lack of clarity in claims
  - Avoid Art. 123(2) – Art. 84 trap
- *A method of laser machining a substrate to form a stent*
  - *providing a polymer tube*
  - *laser machining the polymer tube with a pulse width and wavelength that cuts through a wall of the tube to form structural elements having a machined edge surface*
  - *wherein the laser beam modifies the substrate in a surface region adjacent to the machined edge surface to a much lesser extent*
  - *Wherein ....*
- Objection during Examination...take it out?
- Opposition based on added subject-matter....put it back in, clarity problem

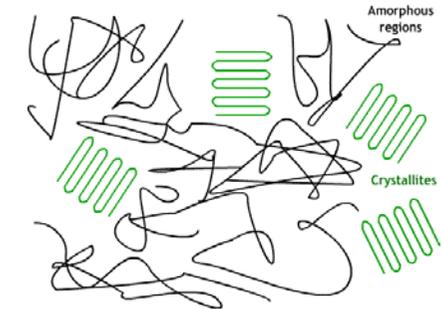
# G3/14 practical advice (2)

- During Examination, add claims (preferably clear ones) to maximum of 15
  - Improves possibility for amendments in Opposition
  - If amendment is incorporation of dependent claim, no examination of Art. 84 EPC
  - If amendment is incorporation of same feature from description, more objections possible
- During Opposition, try to justify amendments in claims starting from combinations of dependent claims to avoid clarity examination of those parts

# G3/14 practical advice (3)

- Distinction between Art. 83 and Art. 84 objection has become even more important
  - Potential Art. 84 problem is less problematic than potential Art. 83 problem
- Based on T 908/04:
  - CLAIM AS GRANTED “*An absorbent article comprising a thin, elastomeric film having improved strength in the cross machine direction, the film comprising at least one low crystallinity polymer, wherein **the crystallinity of said polymer is less than 30%.***”
  - In description: “*As used herein, the term "low crystallinity propylenes" refers to homopolymers and/or copolymers that are less than 30% crystalline, as defined by thermal techniques. **Crystallinity is determined using differential scanning calorimetry (DSC) by taking the heat of fusion of the second DSC scan and dividing it by 185 Joules per gram (the approximate crystallinity of pure polypropylene).***”

# G3/14 practical advice (3)



- Based on T 908/04:
  - MAIN REQUEST *“An absorbent article comprising a thin, elastomeric film having improved strength in the cross machine direction, the film comprising at least one low crystallinity polymer, wherein the crystallinity of said polymer is less than 30%, **said crystallinity is being the heat of fusion of the second DSC scan and dividing it by 185 Joules per gram.**”*
  - Board: Amended claim open to examination under Art. 84 EPC
  - For the second DSC scan, cooling/heating rate is important and will lead to different results
  - No information on those parameters (and skilled person would not necessarily know how to select them)
  - Main Request is unclear

# G3/14 practical advice (3)



– T 908/04:

–AUXILIARY REQUEST “A personal care absorbent article comprising a liquid permeable liner and an outer cover with an absorbent core disposed therebetween, said outer cover including a thin, elastomeric film having improved strength in the cross machine direction, the film comprising at least *one low crystallinity polymer selected from the group consisting of low crystallinity propylene homopolymers, copolymers and blends thereof, and wherein the crystallinity of said polymer is less than 30%.*”

–Board: claim based on a granted claim that already contained the unclear feature of crystallinity of 30%. No Examination of Art. 84 EPC

–But insufficiently disclosed because different methods for determining crystallinity would lead to different values for crystallinity

# G3/14 practical advice (3)

- T 908/04 (cont.):
  - While **some level of uncertainty can be permissible** when it comes to **sufficiency of disclosure**, this would however presuppose that it can be shown that this uncertainty does not jeopardize the validity of the measured parameter for the solution of the technical problem,
  - Patent in suit does not disclose the method for determining the crystallinity of the suitable propylene polymers in a manner which reliably retains the validity of the parameter for the solution of the technical problem. Patent revoked.

## G3/14 practical advice (4)

- So, if my claim relates to a plastic for covering vegetable containers, the plastic being characterised by “stickiness”; and
- Different methods for measuring stickiness exist
- In description we mention which method has to be used for measuring the stickiness, but the description of the method is incomplete
- Is it better to put that method in claim 1?



## G3/14 practical advice (4)

- So, if my claim relates to a plastic for covering vegetable containers, the plastic being characterised by “stickiness”; and
- Different methods for measuring stickiness exist
- In description I mention which method has to be used but the description of the method is incomplete
  
- Is it better to put that method in claim 1?
  
- Considerations:
- In practice, Art. 69 EPC determines that the scope of protection will probably be limited to the method of the description
- Having the method in my granted claim, more “uncertainty” is allowable, because only open to objection under Art. 83 EPC, not Art. 84 EPC

# G3/14 practical advice (4)

- So, if my claim relates to a plastic for covering vegetable containers, the plastic being characterised by “stickiness”; and
- Different methods for measuring stickiness exist
- In description I mention which method has to be used but the description of the method is incomplete
  
- Is it better to put that method in claim 1?
  
- If method only specified in description, then (if incorporated) examined under Art. 84 EPC. Or can we argue that the amendment is a clarification, rather than a new lack of clarity? (T 908/04 appears to suggest differently)
- Unclear feature cannot distinguish over prior art? Some plastics are 100% not “sticky”. So with the method specified in the claim, I am in a better position, may help to distinguish over some prior art documents
- EPO Guidelines F-IV 4-18: The method of and means for measurement of the parameter values need not however be in the claims when the description of the method is so long that its inclusion would make the claim unclear through lack of conciseness or difficult to understand; in that case the claim should include a reference to the description, in accordance with Rule 43(6);

# Art. 83 vs . Art. 84 EPC

- Guidelines F-III 11
- An **ambiguity** in the claims may lead to an **insufficiency** objection. However, **ambiguity** also relates to the scope of the claims, i.e. Art. 84 (see F-IV, 4). Normally, therefore, an ambiguity in a claim will lead to an objection under Art. 83 **only if the whole scope of the claim is affected**, in the sense that it is impossible to carry out at all the invention defined therein. Otherwise an objection under Art. 84 is appropriate (see T 608/07).
- In particular (see T 593/09), where a claim contains an **ill-defined ("unclear", "ambiguous")** parameter (see also F-IV, 4.11) and where, as a consequence, the skilled person **would not know whether he was working within or outside of the scope of the claim**, this, by itself, is not a reason to deny sufficiency of disclosure as required by Art. 83. Nor is such a lack of clear definition necessarily a matter for objection under Art. 84 only. What is decisive for establishing insufficiency within the meaning of Art. 83 is **whether the parameter, in the specific case, is so ill-defined that the skilled person is not able**, on the basis of the disclosure as a whole and using his common general knowledge, **to identify (without undue burden) the technical measures necessary to solve the problem** underlying the application at issue.

# G3/14 conclusions (1)

- Clarity examination in Opposition limited to amendments
- (v) if **features are taken from the description** and inserted into a granted claim by way of amendment; or
- (vi) if a **feature from a dependent claim as granted is introduced into an independent claim as granted and this feature was previously connected with other features** of that dependent claim and an alleged lack of compliance with Article 84 is introduced by the amendment

# G3/14 conclusions (2)

–Proprietor:

– During drafting:

- Provide clear definitions in description for terms
- Provide examples, specific values for these terms (might be able to use them as fall-back position)
- Knowing prior art helps to distinguish in a clear manner over prior art

– Once drafted:

- lack of clarity in claims is preferable to other problems
- If you have a lack of clarity, might as well have it in the (dependent) claims
- parameters: always provide complete information

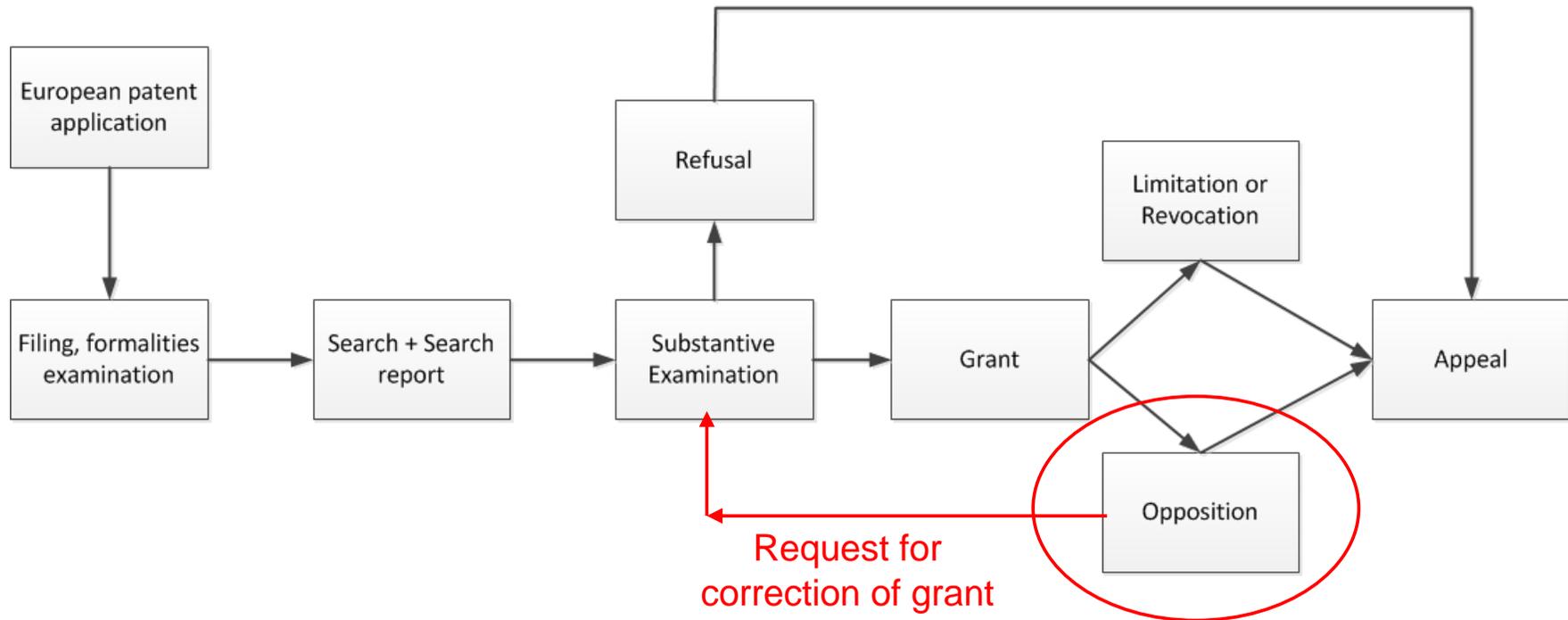
# G3/14 conclusions (3)

- Opponents:
  - do not wait until Opposition, use Third Party Observations for lack of clarity
    - also for dependent claims
  - might also prompt a reaction from proprietor that clarifies or defines unclear features
    - could be useful in litigation/opposition
  - try to exploit lack of clarity to attack under Art. 83, 54 or 56

# Agenda

- G3/14, clarity in opposition proceedings
- G1/10, request to correct patent
- G1/15, partial priorities

# G1/10 situation



- Pre-grant: claim 1 was amended, “a command related to a *position* of the device data”, to “a command related to a *portion* of the device data”
- Opposition under Art. 100(c) EPC, “added subject-matter”
- Request for correction to Examining Division

# G1/10 legal background

- Rule 140 EPC: In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected.
- T 450/97: “*obvious mistakes*” means that the text of a decision does not correspond to the real intention of the deciding instance
- Opposition Division stayed the proceedings and remitted the case to Examining Division. Opponent appealed the decision
- Board of Appeal refers to Enlarged Board of Appeal

# G1/10 referral (1)

- Why? Important point of law
- Sending case to Examining Divisions during Opposition might delay many cases
- If this is possible during Opposition, “parallel” proceedings could take place. One of them “*ex parte*”, another one “*inter partes*”
- Divergent Case Law:
  - T 268/02 allowed such a correction, and thought *inter partes* BoA was competent to review the correction
  - T 79/02 was of the opinion that neither Opposition Division, nor *inter partes* Board of Appeal is competent to question such a correction

# G1/10 decision + reasoning (1)

- Decision **only relates to correction of patent documents** (claims, description, drawings), not e.g. bibliographical data
- From *Travaux Préparatoires* it becomes apparent that legislator was particularly concerned with protecting the public
- Conclusion: correction of the text of the patent approved by the applicant is no longer possible after grant
  - It protects third parties, potential opponents
  - No delay in Opposition proceedings
  - Does not harm patent proprietors, because after all the mistake has to be obvious. “**All concerned should read the patent as if corrected and an actual correction should not be necessary**”

# G1/10 decision + reasoning (2)

- Patent applicants have adequate means at their disposal to ensure patent as granted is in the exact form he/she wants
- Under Rule 71(3), and (6), the applicant is obliged to approve the text to be granted
- Rule 71(3) EPC: Before the Examining Division decides to grant the European patent, **it shall inform the applicant of the text in which it intends to grant** it and of the related bibliographic data. In this communication the Examining Division shall invite the applicant to pay the fee for grant and publishing and to file a translation of the claims...
- Rule 71(6) EPC: If the applicant, within the period under paragraph 3, **requests reasoned amendments or corrections** to the communicated text or keeps to the latest text submitted by him, the Examining Division shall issue a new communication under paragraph 3 if it gives its consent; otherwise it shall resume the examination proceedings.

# G1/10 decision + reasoning (3)

- If patent applicant does not notice the errors and gives approval, that is on the applicant.
- It does not matter whether the mistake originates from the Examining Division or from the applicant.
- Since Rule 140 EPC is not available to correct the text of a patent, a patent proprietor's request for such a correction is inadmissible whenever made, including after the initiation of Opposition proceedings.

# G1/10 decision + reasoning (3)

- What happened to the case? according to OD preliminary opinion claim 1 as granted violated Art. 123(2) EPC; and claim 1 as corrected would violate Art. 123(3) EPC
- Patent proprietor requests revocation of the patent...
  
- Contrast with T 1795/07, both Opposition Division and Board of Appeal pretended “as if” (pending at time of referral of G1/10)

In this regard, it is noted that an error of transcription has occurred during preparation of the B specification. In detail, the English version of claim 1 of the B specification recites at lines 2-3 of page 29 that “the time to achieve a concentration that is 50% of the ultimate concentration of said enzyme is more than 50 seconds” (emphasis added). This claim should however recite “more than 90 seconds” (emphasis added), as evidenced by the claim 1 of the Druckexemplar and page 2 lines 8-9 of the Application as filed. As can be seen the correction is obvious, and therefore I request that this error is corrected, either at the discretion of the EPO, or under R88 EPC if required.

# G1/10 consequences (1)

- There may be a tendency for Examiners to make more amendments to claims, and description in order to issue Rule 71(3) Communication
- Careful checking is required. The ultimate responsibility for any amendment of a patent (application) always remains that of the applicant (or the patentee)
- Electronic Druckexemplar makes checking more complicated.

# G1/10 consequences (2)

- EPO Guidelines H-VI, 4: Exceptionally, and in consideration of all relevant circumstances of the case, formatting/editing errors which were already contained in the text approved by the applicant may be corrected by the EPO of its own motion or at the request of the patent proprietor. Formatting/editing errors are alterations in the patent documents which occur during the preparation of the Druckexemplar and which are indicated neither by standard marks nor in Form 2004C or 2004W.
- Is there an extra danger with the waiver to receive a new Rule 71(3) Communication?
  - Probably not. If text granted/published than text approved by applicant, this could still be corrected. A waiver cannot succeed if Examining Division wants to make amendments. New Rule 71(3) Communication would be required.

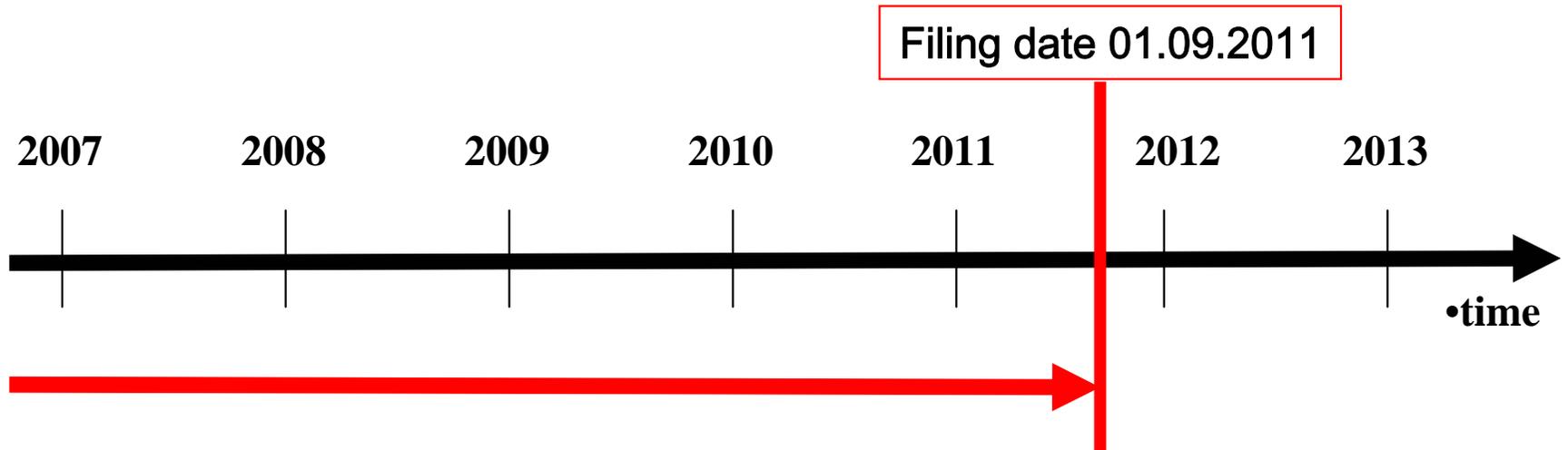
# Agenda

- G3/14, clarity in opposition proceedings
- G1/10, request to correct patent
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# G 1/15 Legal background

- Art. 54(1) EPC: An invention shall be considered to be new if it does not form part of the state of the art.
- Art. 54(2): The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.
- Art. 54(3): Additionally, the content of European patent applications, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.
- Art. 56: (...) If the state of the art also includes documents within the meaning of Article 54(3), these documents shall not be considered in deciding whether there has been an inventive step.

# Art. 54(1) and (2) EPC

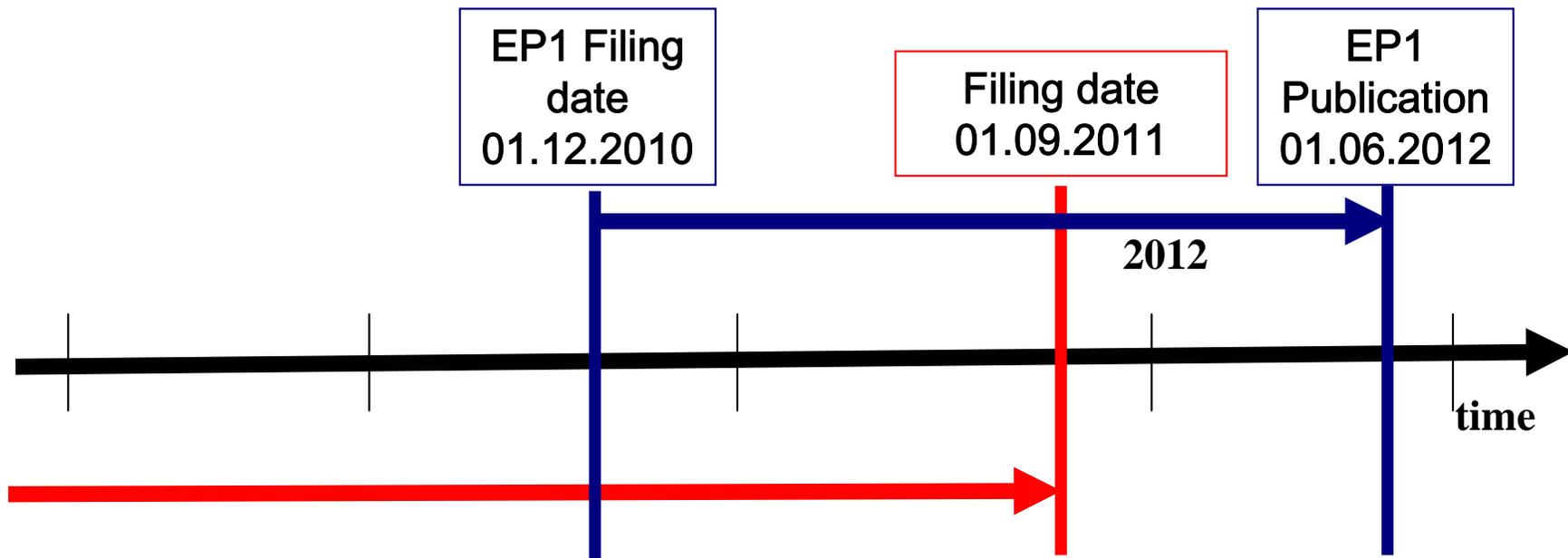


Everything made available to the public  
before the date of filing

Article 54 EPC



# Article 54(3)



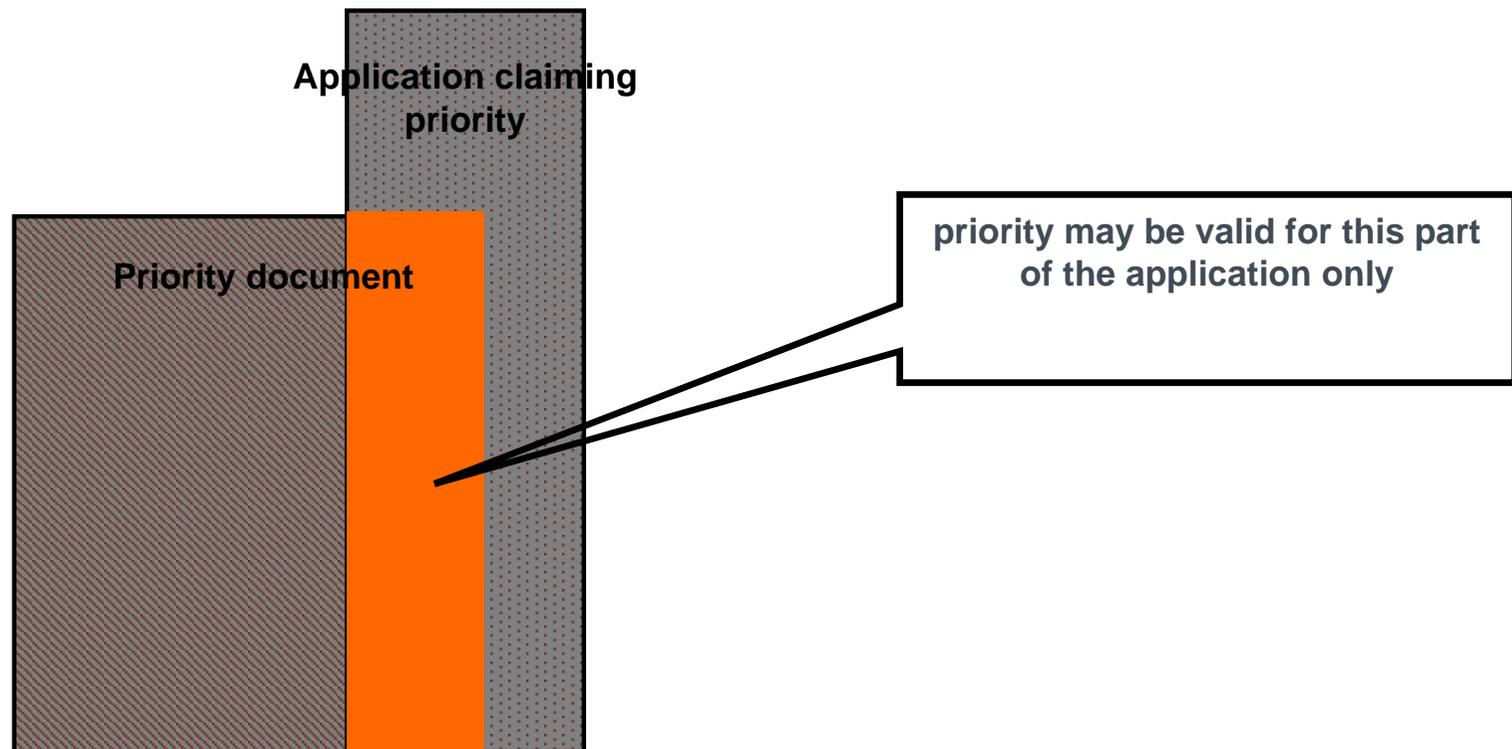
- For assessing novelty, EP1 is part of the state of the art!
  - EP1 must be “regular” publication

# Legal framework priority

- Art. 87(1) EPC: **Any person who has duly filed** (...) an application for a patent (...)
- **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**.
- Art. 88(2) EPC: Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries.
- Art. 88(3) EPC: 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.

# Legal framework priority

- Art. 88(4) EPC: If certain elements of the invention for which priority is claimed **do not appear among the claims formulated in the previous application, priority may nonetheless be granted**, provided that the documents of the previous application as a whole specifically disclose such elements.



# Effect of priority

- Article 89 EPC
- The right of priority shall have the effect that the date of priority shall count as the date of filing of the European patent application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2.

If two or more persons have made an invention independently of each other, the right to a European patent therefor shall belong to the person whose European patent application has the earliest date of filing, provided that this first application has been published.

What is comprised in the state of the art

# Priority and date of filing

- If a first application (first filing) has been filed in a WTO or Paris Convention State;
- a later application can claim priority for the same subject matter disclosed in the first application;
- provided that the date of filing of the latter application is no more than twelve months away from the first application date of filing;
- in this case, for the purposes of Article 54 EPC (novelty), the date of priority is counted as the date of filing.

# Pitfall when claiming priority (1)

- Art. 87(1) EPC: **Any person who has duly filed** (...) an application for a patent (...)
- **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**.
- PITFALL: the subsequent European application (or PCT application entering EP national phase) is not filed in the name of the **same applicant** (or his successor in title)
  - US regular filing or US provisional filing in name of inventors, and subsequent EP filing in name of company

# Pitfall when claiming priority (2)

- Art. 87(1) EPC: **Any person who has duly filed** (...) an application for a patent (...)
- **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**.
- PITFALL: the subsequent European application (or PCT application entering EP national phase) is not filed in respect of **the same** invention
  - EPO applies the same strict standard as with respect to “added subject-matter”
  - “directly and unambiguously derivable” from the (priority) application as filed (G 2 /98).

# Legal framework

- Art. 54(3) EPC: Additionally, the content of **European patent applications**, the dates of filing of which are prior to the date referred to in paragraph 2 **and which were published** on or after that date, shall be considered as comprised in the state of the art.
- Art. 87(1) EPC: **Any person who has duly filed** (...) an application for a patent (...)
- **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**.
- Art. 88(2) EPC: 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**. (...)
- G 2/98 “AND claims” and “OR claims”

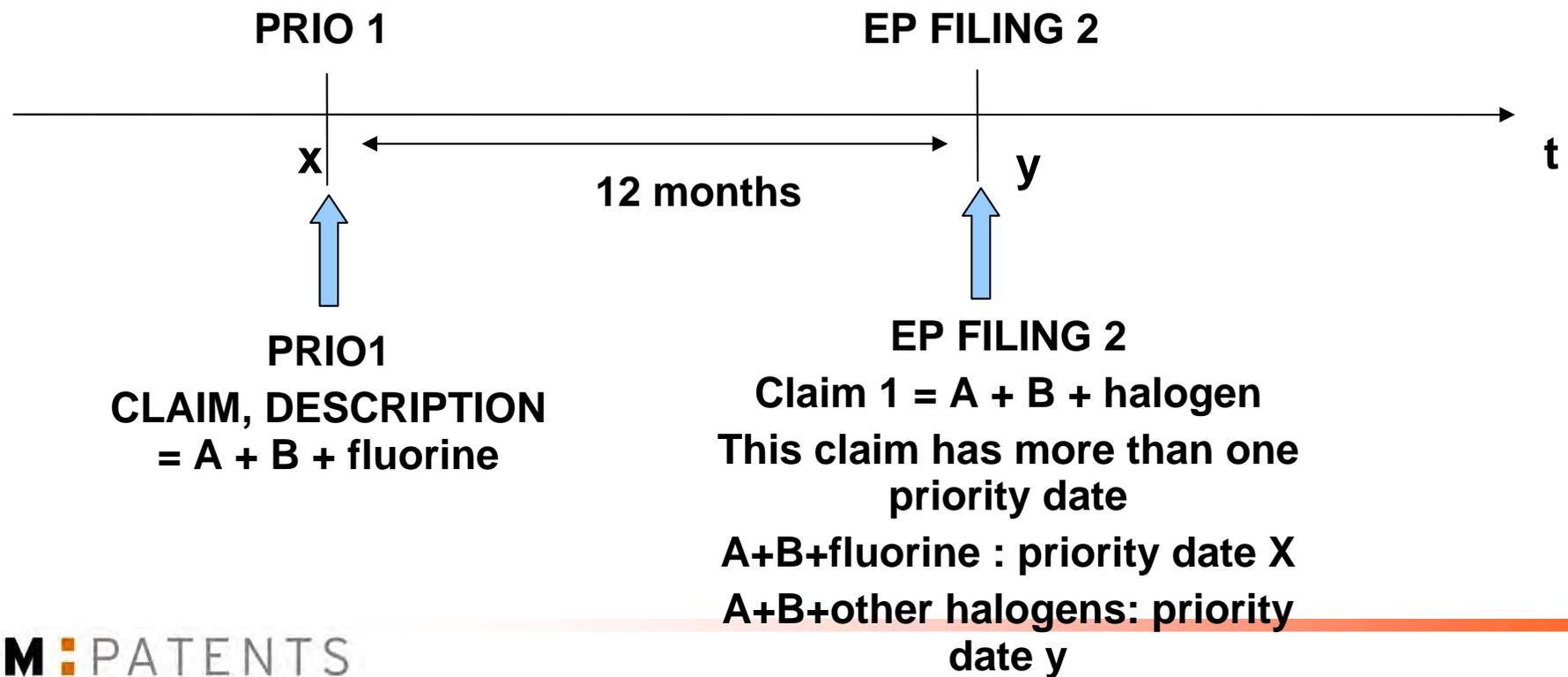


## G 2/98

- ... distinction has to be made between the following situations: (i) "AND"-claim (ii) "OR"-claim
- multiple priorities **can be claimed in an OR claim**, if each alternative has a different priority date
- **multiple priorities cannot be claimed for an "AND"-claim**. Hence, the application of the so-called "umbrella"-theory (according to which the feature A in the claim directed to A+B would enjoy a partial priority from the first priority date, with the result that the feature A could under no circumstances become state of the art in relation to the claimed invention A+B) is to be disregarded.
- **"OR"-claim**: two priorities may also be claimed for a claim directed to C, if the feature C, **either in the form of a generic term or formula, or otherwise, encompasses feature A** [disclosed in Pr1] as well as feature B [disclosed in Pr2 as alternative to A].
- The use of a generic term or formula in a claim for which multiple priorities are claimed (...) is perfectly acceptable (...), provided that it gives rise to the claiming of **a limited number of clearly defined alternative subject-matters**.

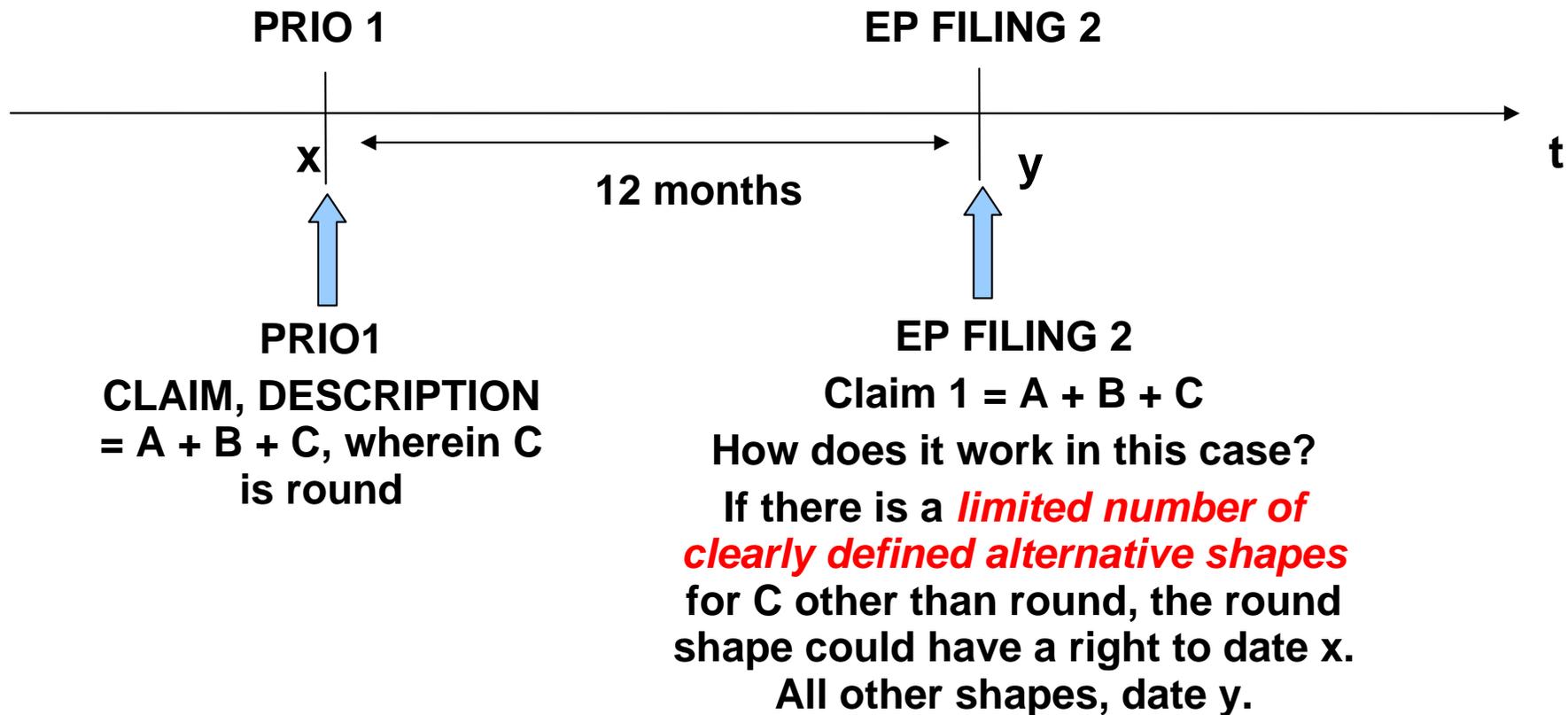
# G 2/98

- For example
- The use of a generic term or formula in a claim for which multiple priorities are claimed (...) is perfectly acceptable (...), provided that it gives rise to the claiming of **a limited number of clearly defined alternative subject-matters**.



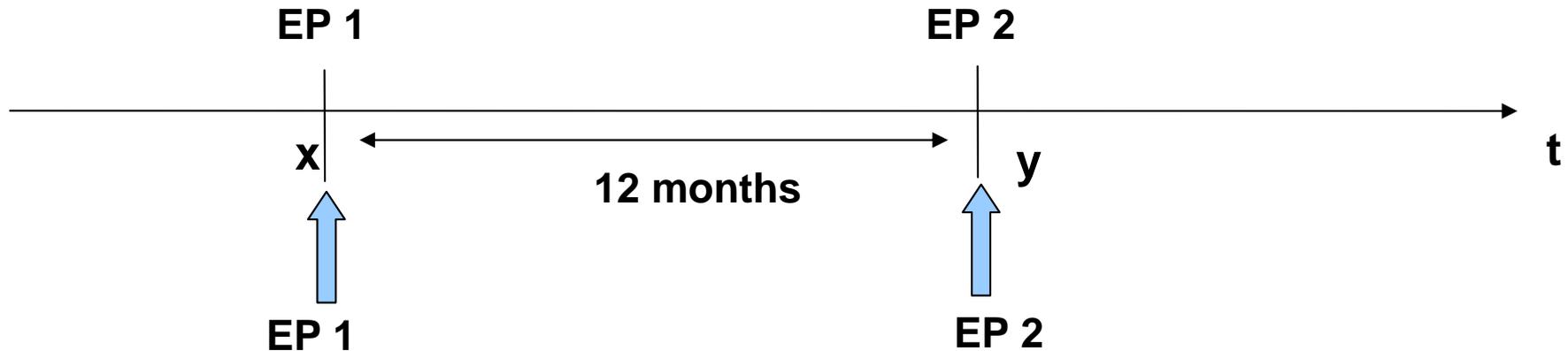
# G 2/98

- But
- The use of a generic term or formula in a claim for which multiple priorities are claimed (...) is perfectly acceptable (...), provided that it gives rise to the claiming of **a limited number of clearly defined alternative subject-matters**.



# Poisonous priority 1

- EP 2 claims priority from EP 1



**CLAIM, DESCRIPTION  
= A + B + C, wherein C  
is round**

**Claim 1 = A + B + C  
This claim only has a right to  
date y?**

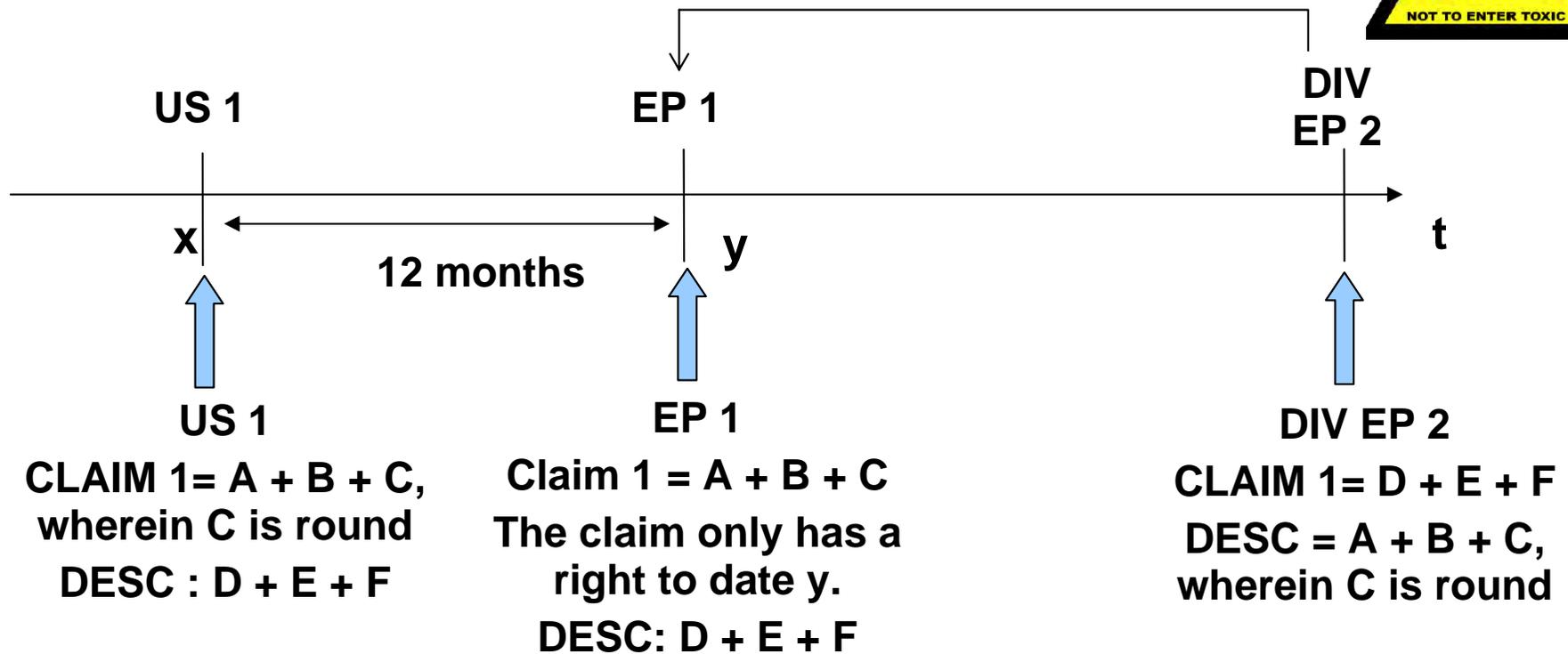
- Effective date for EP 2 is y
- EP 1 has filing date before EP 2. **If EP 1 is published, it destroys the novelty of EP 2.**
- Solutions:
  - **Abandon EP 1** before it is published
  - No priority founding application in Europe / PCT
  - But beware of toxic divisionals!



# Toxic divisionals 1



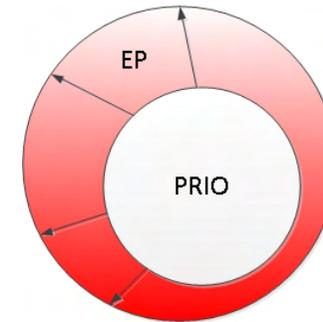
- EP 2 claims priority from US 1



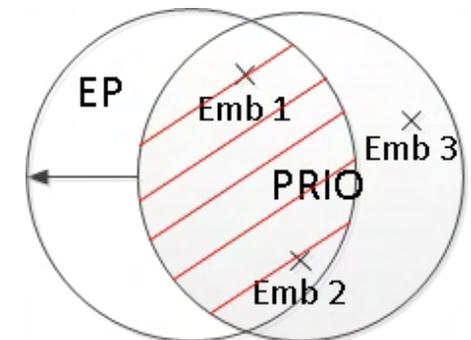
- Applying the “narrow approach” to priority right, effective date for EP 2 is y
- US 1 has filing date before EP 2. DIV EP 2 validly claims filing date of EP 2 and validly claims priority date x for novelty destroying embodiment.
- DIV EP 2 belongs to state of the art according to Art. 54(3) EPC
- DIV EP 2 therefore potentially invalidates EP 2. Are there a limited number of clearly defined alternative subject-matters?

# This problem could occur when:

- A PCT/EP application claiming priority has been broadened with respect to priority application.



- Or if invention has shifted in PCT/EP application claiming priority

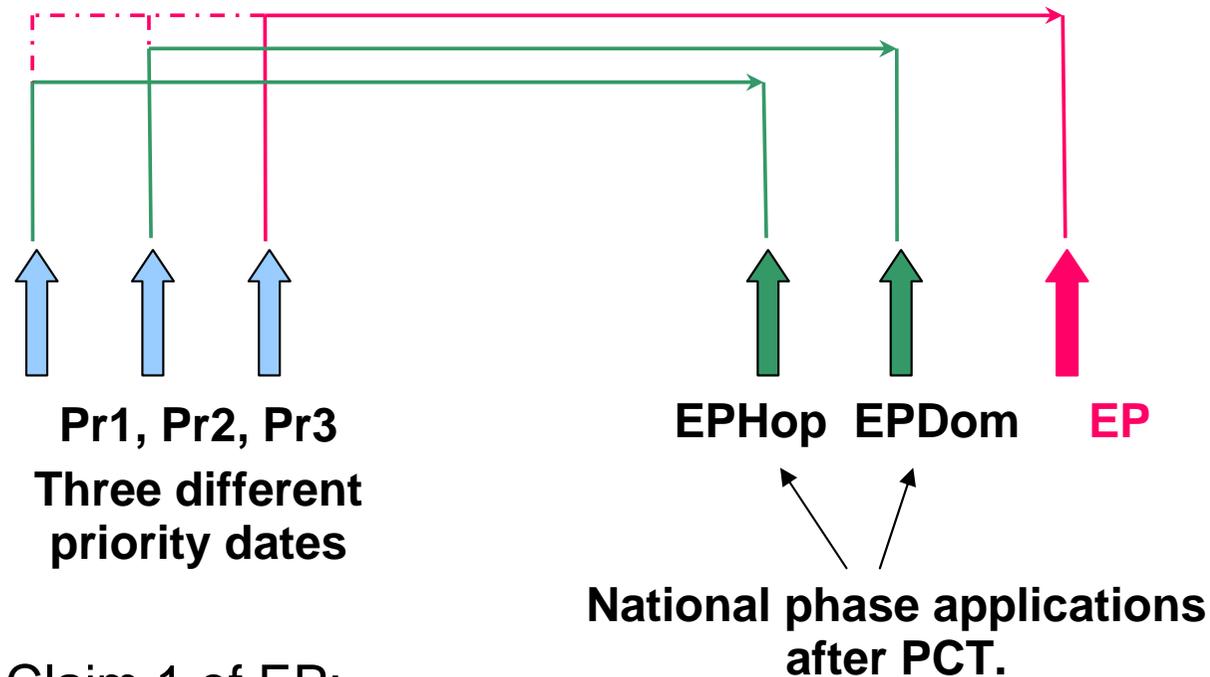


# This problem could occur when:

- But in some cases even if PCT/EP application is more “narrow”
  - Priority: range 0.5 – 13.9
  - Later filed EP: range 0.6 – 13.8
  - EP does not have right to priority
  - And does not have novelty with respect to priority application applying criteria of novelty for sub-ranges of Guidelines

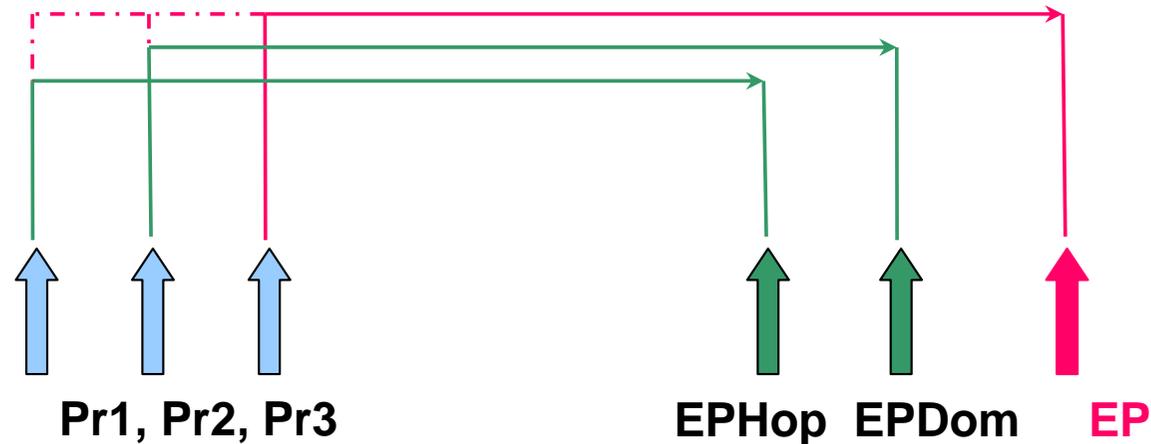
# Other possible self-collision

- Ciba-Geigy & Novartis (Nov), v. Johnson & Johnson (JnJ)



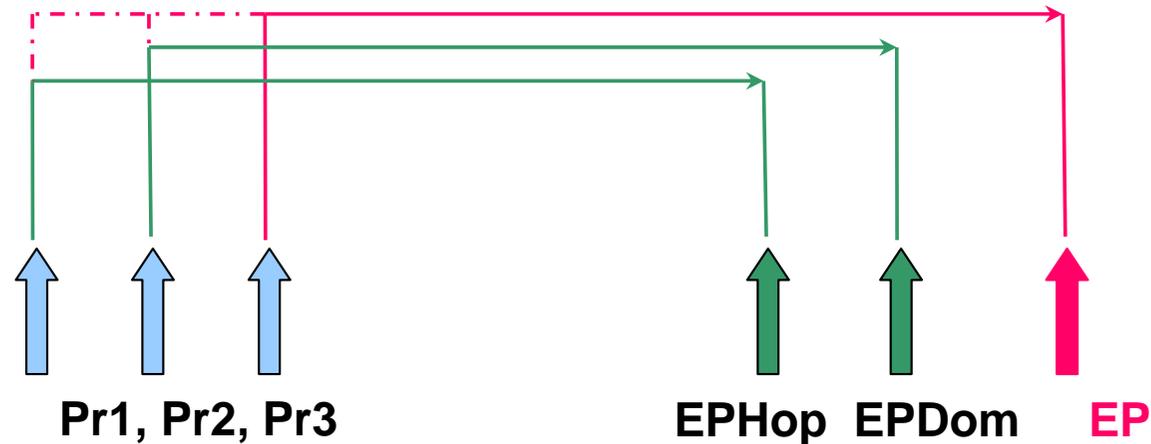
- Simplified Claim 1 of EP:
  - Ophtalmic lens
  - made of a polymer of two polymerizable materials, one of them having oxygen diffusion rate higher than x and the other having a ion or water diffusion rate higher than y

# Novartis v. Johnson & Johnson



- Simplified Claim 1 of EP:
  - Ophthalmic lens
  - made of a polymer of two polymerizable materials, one of them having oxygen diffusion rate higher than  $x$  and the other having a ion or water diffusion rate higher than  $y$
- However, Pr 1 and Pr2 do not mention these parameters, or values  $x$  and  $y$ , or ways to measure these parameters.
- EP can only validly claim priority of Pr3 !?
- EPHop and EPdom therefore could belong to the state of the art according to Art. 54(3) EPC

# Novartis v. Johnson & Johnson



- EPHop and EPDom describe some materials and examples which also belong to invention of EP
- JnJ arguments:
  - claim 1 of EP is “AND” claim
  - Does not have right to priority date
  - Some embodiments of EPHop and EPDom destroy novelty
- Novartis arguments
  - Claim 1 of EP is “OR” claim
  - For the embodiments disclosed in EPHop and EPDom has right to priority
  - For the embodiments not disclosed therein does not have right to priority (but there is no novelty destroying prior art)

# Nestec v. Dualit (UK Patents Court)

- Relates to Nespresso coffee machines and capsules (suitable for these coffee machines)
- Extraction system comprising a device for the extraction of a capsule and a capsule (16) that can be extracted in the device;
- the capsule (16) comprising a guide edge in the form of a flange, the device comprising
  - a first fixed part (2),
  - a second part (3) which is moveable relative to the first part,
  - a housing (4) to receive the capsule and defining, in the closed position of the moveable part against the fixed part, a position for extracting the capsule on an axis (25) in said housing,

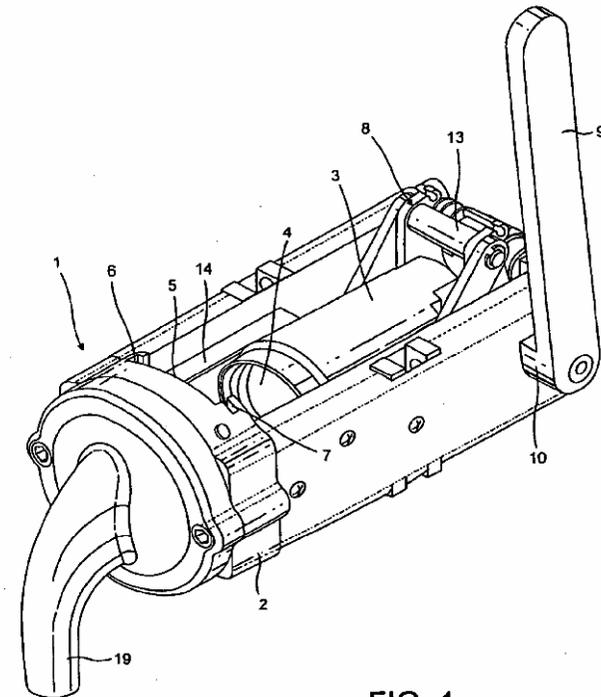


FIG. 1

# Nestec v. Dualit (UK judge Arnold)

It is common ground that claim 1 of the Patent covers arrangements in which the housing to receive the capsule is contained in either

- (i) the movable second part or
- (ii) the fixed first part or
- (iii) divided between the movable part and the fixed part, as disclosed at [0011] of the Patent.

It is also common ground that only the first of these arrangements is disclosed in the Priority Document.

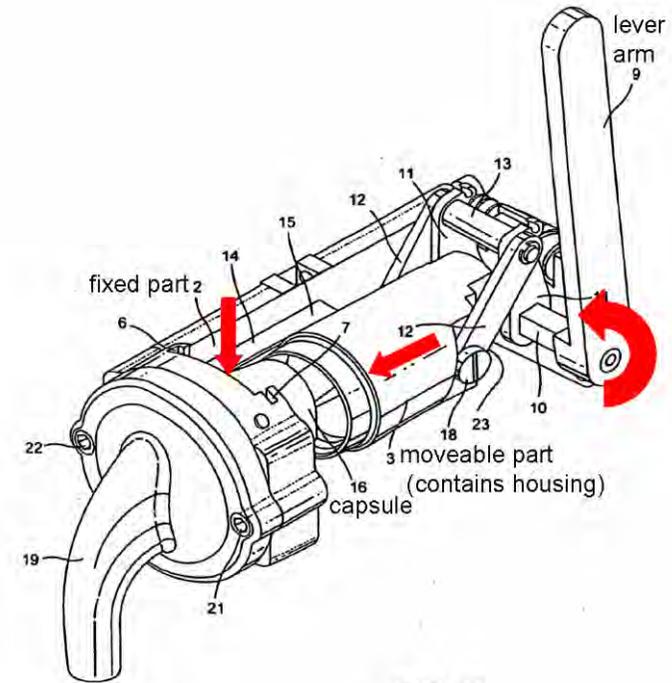


FIG. 2

Dualit contend that it follows that claim 1 is not entitled to priority. Nestec contend that claim 1 is entitled to partial priority: it has priority with regard to option (i), but not options (ii) and (iii). Who is right depends on whether these three arrangements are clearly defined alternatives. In my judgment option (ii) is a clearly defined alternative to option (i), but the same cannot be said of option (iii). Option (iii) is not actually a single arrangement at all. It covers a whole range of different arrangements – everything that is not covered by options (i) or (ii). Furthermore, some of the arrangements covered by option (iii) (housing mainly in the movable part) would be quite similar to option (i) and others (housing mainly in the fixed part) would be quite similar to option (ii). Thus option (iii) is not a clearly defined alternative to options (i) and (ii)

# EPO BoA Interpretation of G 2/98

- T 184/06: relates to a liquid composition comprising
  - a hypohalite bleach, comprising 3 to 8% by weight of an alkyl(alkoxy) $n$  sulphate,
  - wherein  $n$  is from 0.5 to 20, and a stabilizing agent which is a chelating agent.
  - Priority document:  $n$  is from 2 to 4 (and additional specific features)
  - Priority is not valid and priority document is novelty destroying
  - Not an “OR” claim: the invention claimed in the patent in suit relates to a composition of matter, characterized by a combination of features which cannot be regarded in isolation from each other, which subject-matter encompasses everything falling within its scope defined by its essential features and does not relate to specific distinct alternatives having different scope for which different priorities could be claimed.

# EPO BoA Interpretation of G 2/98

- T 1496/11: relates to a security document
  - characterized in that self-verification means of the first portion (5) comprises an optical lens (11) and the security device provided at the second portion (4) comprises **a feature** (10) which can be inspected, enhanced or optically varied by the optical lens when the first and second portions (5,4) are brought into register."
  - Priority document: "**printed or embossed** feature"
  - Priority date not validly claimed, because features made by hot-stamping or lithography are now included
  - **Divisional application destroys novelty!**

# EPO BoA Interpretation of G 2/98

- T 665/00: relates to microspheres
  - Priority document claims < 0.5 grs, has specific embodiments of 0.04 grs
  - Patent claims < 0.1 grs
  - According to BoA, different priorities can be assigned to those embodiments with a mass of 0.04 grs (entitled to priority) and to those embodiments having different mass (not entitled to priority, but no novelty destroying disclosure).

# EPO BoA Interpretation of G 2/98

- T 1222/11: relates to a liquid composition
  - The present Board is of the opinion as explained below that 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 to it by the respective Boards in the above mentioned decisions T 1877/08, T 476/09, T 1443/05 and T 1127/00.
  - As a preliminary remark, this condition cannot be meant to set out the manner in which the subject-matter of the “OR”-claim must be defined.
  - Furthermore, it has to be borne in mind that the assessment required can be achieved only by a comparison of the claimed subject-matter of that “OR”-claim with the disclosure of the multiple priority documents. Therefore, the words “gives rise to the claiming of a limited number of clearly defined alternative subject-matters” refer to the ability to conceptually identify by said comparison a limited number of clearly defined alternative subject-matters to which the multiple rights of priority claimed can be attributed or not.

# EPO BoA Interpretation of G 2/98

- T 1222/11
  - It is therefore concluded that in so far as a subject-matter disclosed in a priority document and encompassed by an “OR”-claim of a European application (i.e. a claim of a European application which compared to the disclosure of the subject-matter in the priority document has been broadened) is concerned, the decision on whether priority can be acknowledged for this subject-matter, i.e. for this embodiment covered by the “OR”-claim, **is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the “OR”-claim of the European application as a separate alternative embodiment (or in the application as a whole).**
  - Basic conclusion appears to be: a broader generic formula can have partial priority because the **clearly defined alternatives are the narrow formula and the rest of the scope of the claim**

# G1/15 decision and reasoning (1)

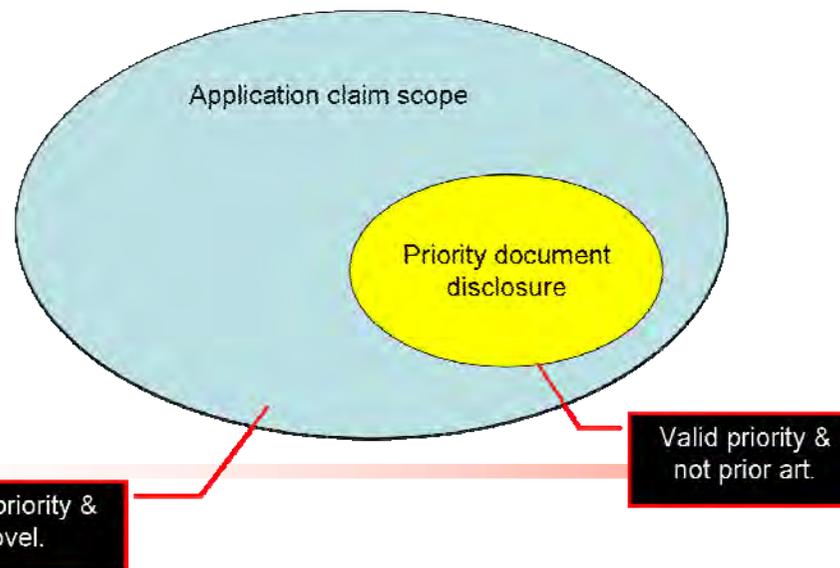
- Priority is a right
- Art. 87 EPC
- Art. 4 PC
- Only limitation: Same invention = Same subject-matter
- Art. 89 explains (priority date = filing date) serves to protect first applicant against third parties
- Art. 4B PC: any subsequent filing shall not be invalidated by **reason of any acts** accomplished in the interval ...
- If a claim in a later application is broader than an element disclosed in the priority application, priority may be claimed for such element but not for all other embodiments falling within the scope of the claims
- FICPI Memorandum (Travaux Préparatoires EPC)

# G1/15 decision and reasoning (2)

- It is thus to be concluded that the **EPC does not contain other requirements for recognising the right of priority** beyond the same invention, whether for simple, multiple or partial priority, the last being regarded as a sub-group of multiple priorities.
- In assessing whether a subject-matter within a generic OR" claim may enjoy partial priority, **the first step is to determine the subject-matter disclosed in the priority document that is relevant**, i.e. relevant in respect of prior art disclosed in the priority interval. This is to be done in accordance with the disclosure test laid down in the conclusion of G 2/98 and on the basis of explanations put forward by the applicant or patent proprietor to support his claim to priority, in order to show what the skilled person would have been able to derive from the priority document.

# G1/15 decision and reasoning (3)

- The next step is to **examine whether this subject-matter is encompassed by the claim** of the application or patent claiming said priority.
- If the answer is yes, the claim is *de facto* conceptually divided into two parts, the first corresponding to the invention disclosed directly and unambiguously in the priority document, **the second being the remaining part of the subsequent generic OR"-claim not enjoying this priority but itself giving rise to a right to priority**, as laid down in Article 88(3) EPC



# G1/15 headnote

-Under the EPC, entitlement to partial priority **may not be refused** for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR"-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, **unambiguously** and in an enabling manner in the priority document.

**No other substantive** conditions or limitations apply in this respect

# G1/15 conclusions (1)

- Own priority document not novelty destroying under Art. 54(3) if published.
  - Also not taken into account for Art. 56 EPC
  - No more poisonous priorities and toxic divisionals
- According to EPO, but according to national courts? Unified Patent Court?
- Abandon priority application still generally appears safer if substantive amendments have been made
- Japan and US explicitly exclude self-collision

# G1/15 conclusions (2)

- If priority document published under Art. 54(2), e.g. Spanish Utility model, then very possible still problem, at least because of inventive step
- Also other disclosures during priority year
- Whether some useful protection can be saved will depend on the original draft. Can the patent be amended without infringing Art. 123(2) and establish inventive step?

