

Partial priority referred to the EPO's Enlarged Board – an antidote to “toxic divisionals”?

The EPO's Enlarged Board of Appeal is to consider how to assess partial priority, in a decision that could signal the end of the controversial “toxic divisional” novelty attack.

The EPO's Technical Board of Appeal 3.3.06 recently announced its intention to refer one or more questions regarding partial priority to the Enlarged Board of Appeal. The Board concluded that the referral was necessary to address a so-called “toxic divisional” attack, in which the opponent argued that a divisional was anticipated by its own parent under Article 54(3) EPC. There are diverging lines of case law regarding partial priority at the EPO, one of which is inconsistent with a “toxic divisional” attack. Therefore, in addition to clarifying the law regarding partial priority, the new referral could halt the rise of the “toxic divisional” attack.

The Opposition Division held that EP 0921183 ('83) lacked novelty under Article 54(3) EPC over its own parent. The claims of '83 related to the use of a cold flow improver with one or more amine groups. In the priority document the cold flow improver had to be present as a salt or an amide, a requirement not present in the claims of '83. Therefore, the Opposition Division held that the claims in '83 were not entitled to the priority date because they were broader than the disclosure of the priority document. Example 1 of '83 appeared in the priority document and so was entitled to the priority date, unlike the generic claims. Example 1 also appeared in the parent application from which '83 was derived. As example 1 of the parent fell within the scope of the claims of the '83 divisional, the Opposition Division held '83 was not novel under Article 54(3) EPC.

The patentee argued that the claims of the '83 patent were entitled to partial priority, thus overcoming the novelty attack. The Opposition Division decided that partial priority was not available because the genus of compounds disclosed in the priority document was not “a limited number of clearly defined subject matters” – the test for establishing partial priority set down in G 2/98. On appeal, the patentee argued that the Opposition Division had been unduly strict when assessing partial priority. In response, Board 3.3.06 noted that there were diverging approaches to assessing partial priority, as recently summarised in T 1222/11 and T 571/10. The Board explained that as a result of these divergent approaches “the Board will refer one or more questions to the Enlarged Board of Appeal” (see the recently published minutes of the appeal hearing T 557/13 regarding the '83 patent).

The divergent approaches to assessing partial priority were highlighted by T 1222/11, in which another Board expressly disagreed with a line of earlier case law (T 1877/08, T 0476/09, T 1443/05 and T 1127/00) and instead suggested its own approach to assessing partial priority. This approach was expressly endorsed in the more recent decision T 571/10. Unusually, a copy of T 571/10 was sent to the parties by Board 3.3.06 in the run up to the hearing for the '83 patent.

The need to rationalise the approach to partial priority at the EPO has been highlighted by the “toxic divisional” attack. This controversial attack has gained popularity since it appeared to be endorsed in decision T 1496/11. It is hoped that this new referral will explain when partial priority is available, which will allow a better understanding of the threat (if any) posed by toxic divisionals. The first step will be the publication of the question(s) to be referred to the Enlarged Board, which is likely to occur in the next few months.

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