

All change for priority at the EPO?

The EPO's highest instance, the Enlarged Board, has been asked to provide an updated test for assessing priority.

Introduction

A [new referral](#) to the Enlarged Board seeks to end years of uncertainty regarding priority entitlement at the EPO. At present, two different tests for priority have been applied, sometimes giving radically different results. The referral has its origins in the so-called "toxic divisional" attack (a subject of our previous note [here](#)), but the referral could have an impact far beyond this esoteric topic. The five questions referred to the Enlarged Board are given in full at the end of this newsflash.

The "strict" and "generous" tests for partial priority

The divergent case law that led to the referral relates to "partial priority" — the awarding of priority for only part of a claim, where that part appears in the priority document (provisional). The current test from the Enlarged Board was set down in G 2/98 and permits partial priority where "it gives rise to the claiming of a [limited number of clearly defined alternatives](#)". For example, a claim to "compounds A or B" where only compound A appeared in the priority document would be entitled to the earlier date, but in relation to compound A only. The "A or B" scenario is simple and uncontested. The divergence occurs where a claim [generically](#) covers compound A, e.g. by using a generic term or Markush grouping, but does not "clearly define" compound A as an alternative in the text of the claim.

Certain EPO decisions are [generous](#) and assign partial priority by "conceptually" dividing the claim into the "limited number of clearly defined alternatives" required by G 2/98. The conflicting [strict](#) decisions argue that mere "conceptual" division of a claim is not permitted by G 2/98, and that instead the text of the claim must identify those alternatives in order for partial priority to be acknowledged.

The strict test can seemingly never be satisfied by ranges or other generic terms in a claim, as the text of such terms cannot be divided into alternatives, whereas the generous approach allows these generic terms to be divided up and so allowed partial priority. For example, a range of "5 to 6" in a priority document that had been broadened to a range of "5 to 7" in the claims of the application would completely lose priority under the strict approach, but have partial priority in the range "5 to 6" under the generous approach. Clearly, these two different approaches have serious implications for patent validity where there is intervening art.

The first four questions – how to assess partial priority?

The questions referred to the Enlarged Board not only ask the Board to decide between these strict and generous approaches, but also give the Board the option of [totally abandoning the G 2/98 test](#) for partial priority, replacing it with a new test, or providing clarification as to how the test should be applied.

Question 1 asks if it is [ever](#) possible to deny priority for subject-matter first correctly disclosed in the priority document, where that subject-matter falls within a generic claim:

"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?"

Question 1 therefore invites the Enlarged Board to remove G 2/98's "limited number of clearly defined alternatives" test of altogether, at least for "generic" claims. It is unusual for the Enlarged Board to overrule its previous decisions, but this is by no means impossible (e.g. G 1/84 was overruled by G 9/93).

If the Enlarged Board answers "no" to question 1, it would accept that subject-matter first disclosed and enabled in the priority document and encompassed by the claim is entitled to priority regardless of any other considerations. This outcome would end the referral, as the other questions are conditional on an answer of "yes" to question 1.

If the Enlarged Board considers that the mere disclosure of subject-matter in the priority document (as described in question 1) is [not](#) enough to permit partial priority for that part of a generic claim,

it has to answer yes to question 1 and so move on to the second. The second asks whether the “limited number of clearly defined alternatives” test from G 2/98 is the correct test to use for generic claims (see question 2 below). If the G 2/98 test is found to be the correct one, then the Enlarged Board will move on to question 3, which asks how this test is to be interpreted and applied. If the Enlarged Board disagrees with the G 2/98 test, then it is obliged to set out a new test in answer to question 4, which asks how entitlement to partial priority should be assessed for a generic claim.

The first four answers – a hint from the referring Board?

The questions referred are accompanied by around 60 pages of legal background, including a comprehensive review of the EPO’s case law, produced by the referring Board. The referring Board concludes that prior to G 2/98 a more generous approach was accepted. The Board finds no mention of the G 2/98 test in these earlier decisions and states that they were not explicitly overruled in the G 2/98 decision. The Board also notes that one of the reasons underlying the decision in G 2/98 (evidence of the legislative intent from a contemporaneous FICPI Memorandum) may seem to support a generous approach to partial priority.

These observations, coupled with the sweeping nature of question 1 as asked by the referring Board, perhaps suggest that this referring Board favours total abandonment of the G 2/98 test for partial priority. Of course the Enlarged Board will make its own decision, and it is likely that it will be assisted by a significant number of amicus briefs from interested parties.

The fifth question – toxic divisionals

The referring Board was faced with the “[toxic divisional](#)” attack. The fifth and final question ensures that the Enlarged Board must address this attack even if it requires a strict test for partial priority (see question 5 below).

In the “toxic divisional” attack, the strict G 2/98 approach to partial priority is applied by an opponent in order to invalidate a priority claim. The opponent then argues that a family member (a

parent or divisional of the patent in suit) is novelty destroying under the EPO’s novelty-only prior art provisions (Article 54(3) EPC). This attack relies on a more specific disclosure in the priority document (often an example) which is entitled to priority, set against a generic claim which is not entitled to priority (often because the claims were broadened when filing the application claiming priority). As a result, the patent loses priority for the broadened claims, but the more specific disclosure in the family member retains its earlier date and so is citable as novelty-only prior art.

If the Enlarged Board considers that the disclosure of subject-matter in the priority document (as described in question 1) is enough to permit partial priority for that part of a generic claim, then this would provide a permanent antidote to the “toxic divisional” problem. If the Enlarged Board takes this route (by answering “no” to question 1) then all toxic divisional attacks must fail, because the generic claim would be always entitled to partial priority for any disclosure that appeared in the priority document. As a result, no family member (parent or divisional) could contain a novelty-destroying disclosure with an earlier effective date. This would be a simple solution to years of argument on this “toxic divisional” topic, but could potentially cause other complications.

The referring Board clearly appreciates the importance of comprehensively addressing the “toxic divisional” problem, because if the Enlarged Board either confirms and clarifies the G 2/98 test (question 3), or creates a new test (question 4), it must then answer question 5. Question 5 asks whether a family member (parent or divisional) can ever be novelty-only prior art, regardless of partial priority. There are a number of underlying legal and public policy points that have been used by patent proprietors to argue that family members are never citeable for novelty against each other. It will therefore be interesting to see how the Enlarged Board chooses to clarify the law in this area, if such clarification is still required following the answer to question 1.

Conclusion

The answers to the referred questions will rewrite, or at least significantly clarify, the concept of partial priority, with potential effects on pending patents

and applications. No matter how the Enlarged Board answers the first four questions, it will have to address the “toxic divisional” problem head on. In light of the controversy of “toxic divisional” attacks, many will hope that the Enlarged Board both clarifies the law regarding partial priority and conclusively dispels the spectre of “toxic divisionals”.

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The following questions are referred to the Enlarged Board for decision:

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. 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?