



## Partial priority – G 1/15

A new decision from the EPO's Enlarged Board of Appeal marks a radical change in the EPO's approach to assessing priority entitlement.

The [decision](#) resets the EPO's approach to assessing priority in the situation where only some parts of the claim are entitled to priority – a concept known as “partial priority” – making it much easier for a claim to benefit from partial priority.

### The previous “strict” and “generous” approaches to partial priority

The Enlarged Board was asked to rationalise two diverging lines of case law. The previous test was set down by the Enlarged Board in G 2/98, which permitted 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 in relation to compound A only. The “A or B” scenario is simple and uncontested. The divergence in case law occurred where a claim generically covered a specific embodiment from the priority document (such as compound A in this example), e.g. by using a generic term or Markush grouping, but did not “clearly define” the specific embodiment as an alternative in the text of the claim.

Certain EPO decisions were generous and assigned partial priority by “conceptually” dividing the claim into the “limited number of clearly defined alternatives” required by G 2/98. The conflicting strict decisions argued that mere “conceptual” division of a claim was not permitted by G 2/98, and that instead the text of the claim must itself identify those alternatives for partial priority to be acknowledged.

The strict test was not satisfied where a specific example in a priority document had been extended to become a range or other generic term in the later application, whereas the generous approach allowed these generic terms to be divided up for the purposes of partial priority. For instance, an example value of “6” in a priority document that had been broadened to a range of “5 to 7” in the claims of the application completely lost priority under the strict approach, but had partial priority for the value of “6” under the generous approach. Clearly, these two different approaches had serious implications for patent validity where there is intervening art (e.g. prior art published between priority and filing dates).

### The questions referred

The questions referred to the Enlarged Board not only asked the Board to decide between these strict and generous approaches, but also gave 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 asked if it is ever possible to deny priority for subject matter first 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?”*





## The Enlarged Board's answer

The Enlarged Board answered “no” to this first question and clarified that “[n]o other substantive conditions or limitations apply” when considering the question. The Board has therefore overruled G 2/98’s “limited number of clearly defined alternatives” test altogether.

The decision also seems to set out a simple, two-step test for assessing whether a “generic” claim enjoys partial priority:

1. determine the subject matter disclosed in the priority document relevant for overcoming prior art (under the EPO’s “direct and unambiguous” standard, as usual); and
2. examine whether this subject matter is encompassed by the claim of the application or patent claiming priority.

If in the second step, the subject matter disclosed in the priority document is found to be encompassed, this subject matter enjoys partial priority, regardless of any other “substantive” considerations, e.g. whether the alternatives are laid out in the claim in question. This test is a clear endorsement of the more generous line of case law discussed above.

The Board recognised that assessing partial priority in this way can be a “demanding intellectual exercise”. However, the decision provides welcome certainty in an area of law where EPO practice has previously been inconsistent.

It remains to be seen how G 1/15 will be applied by the Boards in more complex scenarios, for example, where the “first filing” requirement of Article 4C of the Paris Convention needs to be assessed in a “cascading priority” situation.

## An antidote to toxic divisionals

The Enlarged Board was asked to consider the issue of partial priority in the context of a “toxic divisional” attack.

In the usual form of this 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 the family member (with the same priority claim) is novelty destroying under the EPO’s novelty-only prior art provisions (Article 54(3) EPC). The decision does not directly address the core question of whether a family member (a parent or divisional of the patent-in-suit) can form part of the prior art base, but the new approach to partial priority should extinguish many such attacks.

## Conclusion

Partial priority has always been recognised at the EPO, but the earlier Enlarged Board decision G 2/98 limited its availability by requiring the claims to relate to “a limited number of clearly defined alternatives”. This new Enlarged Board decision, G 1/15, sweeps away the limits introduced by G 2/98 and so makes it easier for a claim to benefit from partial priority. However, there remains some uncertainty as to how broadly this principle will be applied, given that it is a considerable departure from the “strict” line of case law on partial priority that had built up over the past 15 years.

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