

# EPO Enlarged Board of Appeal Significantly Relaxes Formal Requirements for Making a Valid Priority Claim

The EPO's Enlarged Board of Appeal has recently made a key ruling on the issue of priority entitlement in decision [G1/22](#) and [G2/22](#). The decision represents a significant relaxation of the formal requirements that were previously imposed on applicants and patentees to demonstrate the validity of a priority claim. It will be welcome news to rights holders.

## Previous EPO position on the right to claim priority

The right to claim priority at the EPO is governed by Article 87(1) EPC, which provides that the right to claim priority from an earlier patent application belongs to the person who filed the earlier application or to their "successor in title".

In cases where the priority application and the later application were filed by different parties, the EPO previously imposed a high burden on applicants and patentees to demonstrate that the applicant named on the later application was the true successor in title to the applicant named the priority application. The jurisprudence of the boards of appeal on this topic, before the new decision in [G1/22](#) and [G2/22](#), can be summarised as follows.

- The right to claim priority from an earlier patent application is a separate right to the property right in the priority application itself. It was therefore necessary to adduce evidence to show that the right to claim priority had been properly transferred: it was not sufficient merely to show that the property right in the priority application had been transferred (see, for example, [T205/14](#)).
- This assignment of the priority right had to occur before the filing date of the later application: no retroactive assignment was possible. Further, a high burden of proof ("up to the hilt") could be imposed on the applicant/patentee to demonstrate that the priority right had been properly transferred (see, for example, [T1201/14](#)).
- The provisions of the EPC did not lend themselves to an autonomous determination of the requirements for transfer of the priority right and the validity of such a transfer therefore had to be determined under national law (see for example [T1008/96](#)). This caused difficulties, because EPO tribunals are not well suited to considering issues of private international law to determine which national law should apply in any given situation.

The jurisprudence summarised above led to a situation whereby a priority claim in a European patent or application could often be successfully attacked by opponents in opposition proceedings. The Enlarged Board noted in [G1/22](#) and [G2/22](#) that there was a "dramatic increase" in formal challenges to priority entitlement from 2015 onwards. Some high-profile European patents

ultimately ended up being revoked following a loss of priority on formal grounds, one famous example being decision [T844/18](#), revoking the Broad Institute's patent to CRISPR technology (which was the subject of the 2020 Nobel Prize in Chemistry).

These outcomes were perceived by many to be unduly harsh for patentees. For example, the England & Wales High Court considered the operation of the jurisprudence governing the transfer of the right to claim priority, and noted that there was no public benefit in striking down patents merely because those responsible for filing the priority application and the later European application could not properly evidence a transfer of the right to claim priority<sup>1</sup>.

## Changes in the law following [G1/22](#) and [G2/22](#)

The Enlarged Board confirmed that EPO tribunals are fully entitled to assess whether or not an applicant or a patentee is entitled to claim priority as a "successor in title". It then went on to overturn a long line of previous caselaw, to hold that when making that assessment, national law should not be applied. Rather, the EPO should apply only the "autonomous law of the EPC" when assessing whether or not a valid transfer of the right to claim priority has been made<sup>2</sup>.

The Enlarged Board then went on to explain how the autonomous law of the EPC should be applied when assessing the requirements for a valid transfer of the right to claim priority. The key finding was that the EPO should proceed on the basis that there is a strong rebuttable presumption that the priority applicant has transferred the right to claim priority, noting that such transfer need not be effected in writing and can be done informally<sup>3</sup>.

The rebuttable presumption can only be challenged by specific facts which support serious doubts about the transfer of the priority right<sup>4</sup>, which must relate to the situation at the date on which the priority right is claimed: later developments after priority is claimed cannot affect the rebuttable presumption<sup>5</sup>.

The reasoning of the Enlarged Board in reaching this conclusion is summarised below.

- The EPC does not impose any formal requirements for the transfer of the priority right by agreement. Moreover, the EPC should not establish higher formal requirements than any national laws in EPC states, many of which allow the informal transfer of a priority right between parties. Thus, the Enlarged Board notes that the transfer need not be effected in writing, and can be done informally. The Enlarged Board even left open the possibility that a retroactive transfer of the priority right may be acceptable<sup>6</sup>.
- When the priority application and a later European application

are filed by different parties, it must be assumed that the priority applicant A accepts, or at least tolerates, the use of the priority right by the subsequent applicant B. That is because it is typically not possible for party B to make a valid priority claim without the consent of party A. For example, it is necessary when making a priority claim at the EPO to file a copy of the priority application with the EPO within sixteen months of the priority date, which is usually prior to publication of the application. The cooperation of party A is therefore typically required in order for party B to meet this requirement.

✘ Only if applicant/patentee could prove there had been a valid transfer of the priority right from A to B (or C, as the case may be) before the filing date of the later application ✓ unless opponent can prove otherwise

The Enlarged Board accepted that the presumption of validity must be rebuttable, as there may be instances where the right to claim priority was not in fact properly transferred (e.g. when the later application was made in bad faith). However, the bar for any challenge to the validity of a transfer of the priority right is deliberately set high. This approach is therefore likely in practice to make it very difficult to attack the validity of a priority claim at the EPO on the basis that the right to claim priority was not properly transferred.

✘ Only if applicant/patentee could prove there had been a valid transfer of the priority right from B to A before the filing date of the later application (this is essentially the scenario under which the Broad's CRISPR patent was revoked in T844/18) ✓ unless opponent can prove otherwise

**Contrast between the situations before and after G1/22 and G2/22**

We set out below a summary of common situations which may apply when priority is claimed, and compare the situation at the EPO now with the situation which applied under the previous jurisprudence:

Applicant for priority application	Applicant for later application	Valid priority claim under previous jurisprudence?	Valid priority claim following G1/22 and G2/22?
A	A or A+B	✓ unless opponent can prove otherwise	✓ unless opponent can prove otherwise
A+B	A+B or A+B+C	✓ unless opponent can prove otherwise	✓ unless opponent can prove otherwise
A	Where later application is PCT: A (US only) + B (all other States)	✓ Contentious: this is the scenario that gave rise to the present referral to the Enlarged Board	✓ unless opponent can prove otherwise

A B or B+C

A+B A

**Remaining traps for the unwary**

Despite the welcome liberalisation in the approach to be taken by EPO tribunals in assessing the validity of a transfer of the right to claim priority, some traps for the unwary may still remain. These are considered below.

- The Enlarged Board notes that “*The EPO’s competence to assess priority entitlement does of course not imply that national courts are bound by the EPO’s assessments*”<sup>7</sup>. Arguably, this leaves open the possibility that a national court in an EPC member state, or indeed the new Unitary Patent Court, may still require a patentee to adduce evidence to support a transfer of the right to claim priority if validity of a European patent is challenged in any such forum. It therefore remains best practice to execute a document explicitly transferring the right to claim priority before any European application (or PCT application designating the EPO) is filed.
- If any documentary evidence comes to light which derives from the patentee and which suggests that a transfer of the right to claim priority did not in fact occur before the filing date of the later application, this information could be used by a third party to rebut the presumption of validity, as an admission against interest. Patentees should therefore be careful about creating any paper trail which suggests that rights were not properly transferred, bearing in mind the possibility that relevant documents may be uncovered in disclosure during national litigation<sup>8</sup>.

## Conclusions

The Enlarged Board's decision in G 1/22 and G 2/22 decisively shifts the burden of proof regarding valid transfer of a priority right away from the patentee towards any opponent. It is a clear, well-reasoned decision that ought to lead to a uniform application of the principles discussed by the various EPO tribunals.

The decision is likely in practice to make it very difficult to attack the validity of a priority claim at the EPO on the basis that the right to claim priority was not properly transferred. This will therefore be welcome news to patentees and applicants.

## Footnotes

1. See *Accord Healthcare Limited v Research Corporation Technologies, Inc.* [2017] EWHC 2711 (Ch): paragraph 77 notes that there was “*no obvious public interest in striking down patents on this ground, unlike all the other grounds of*

*invalidity*”.

2. Reason 86
3. See headnote I, reasons 105-108 and reasons 99-100.
4. Reason 110
5. Reason 109
6. Reason 100
7. Reason 115
8. Examples where a patentee has themselves placed information into the public domain suggesting that a valid transfer of the priority right was not made include (a) attempts to *correct* the identity of the applicant on the PCT request form and (b) assignment documents placed onto the EPO file which are inconsistent with the claim to priority (see T725/14 and T924/15 for an example of the latter situation).

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