

G 1/15 EPO'S Enlarged Board of Appeal Prescribes an Antidote to Poisonous Divisionals

Background to the Decision

The legal issue explored in G 1/15 is the extent to which a narrow disclosure in a priority document may give rise to a right to partial priority, in the priority-claiming application, for a broader claim that encompasses that narrow disclosure. Divergent case law on this point had developed from the EPO's Technical Boards of Appeal. Furthermore, in some cases where priority entitlement was denied, this had led to findings that claims in a European filing lacked novelty based on the disclosure in another European family member sharing a priority claim with the case under attack. In at least one decision, T 1496/11², an objection of lack of novelty was upheld when the other European family member in question was a European divisional application and the claim under attack was in the European parent patent.

In more detail, Boards of Appeal refusing to acknowledge partial priority³ had often cited an earlier Enlarged Board decision, G 2/98⁴, as legal basis. In G 2/98, the Enlarged Board confirmed that a generally worded claim can be entitled to multiple priority dates, provided that it “gives rise to the claiming of a limited number of clearly defined alternative subject-matters”. Some Appeal Boards had concluded that this condition is not met when the number of embodiments encompassed by a generally worded claim was large (as is common, for example, in a claim to a general chemical formula) or even infinite (as, for example, in a continuous numerical range). Thus, even if the priority application disclosed one or more of the encompassed embodiments – either individually or in a generally worded form – then no partial priority was to be acknowledged.

Such a finding can have negative consequences for the validity of the claim at issue. Most obviously, full loss of priority renders such a claim vulnerable to a disclosure, between the priority date and the filing date of the case at issue, of any subject-matter within the scope of the claim. Such a disclosure might originate from a third party, but it could also correspond, for example, to a non-patent publication from the applicant after the priority date or to another of its own European filings having a common priority claim with that of the case at issue (including the priority filing itself). Such filings may typically contain a disclosure of one or more embodiments falling within the scope of the generally worded claim of the case at issue, but with the disclosed embodiment, unlike the generally worded claim, being deemed to be entitled to priority. In a still more extreme example, the case at issue and the other European filing would have a parent application-divisional application relationship or vice versa, giving rise to a so-called “poisonous divisional” attack of lack of novelty⁵.

In contrast, the Boards of Appeal in decisions T 1222/11⁶ and T

571/10⁷ considered that the reference in G 2/98 to “the claiming of a limited number of clearly defined alternative subject-matters” did not refer to the total number of embodiments within the generally worded claim, but rather to the ability conceptually to distinguish (a limited number of) sub-groups within the generally worded claim to which priority would or would not apply. For example, in a claim to a general chemical formula wherein the priority document discloses a single chemical compound, there would be two sub-groups: one corresponding to the single chemical compound, which enjoys priority; and the other corresponding to all other compounds embraced by the claim, which does not enjoy priority. In a further example, in a claim reciting a continuous numerical range of 1 to 10, wherein the priority document discloses the narrower range 3 to 6, there would be three sub-groups: one corresponding to the range 3 to 6, which enjoys priority; and two others corresponding to the ranges (i) 1 to less than 3 and (ii) more than 6 to 10, respectively, which do not enjoy priority.

In view of the divergent case law in this area the Board of Appeal in T 557/13⁸ referred questions to the Enlarged Board of Appeal to resolve the issue.

The Enlarged Board's Analysis and its Consequences

The Enlarged Board analysed the priority provisions of the European Patent Convention (EPC) and the Paris Convention to assess whether imposing any “additional conditions and/or limitations”, such as those sometimes considered to arise from G 2/98, would be in line with the fundamental principles concerning the right of priority.

The Board concluded that the priority provisions contain no requirements for recognising a right of partial priority except that the “same invention” as that disclosed in the priority document is encompassed by the claim of the priority-claiming application. The Board further indicated that this meant that the reference in G 2/98 to “the claiming of a limited number of clearly defined alternative subject-matters” could not be construed as implying a further limitation of the right of priority.

Finally, the Enlarged Board outlined a two-step process for assessing whether partial priority can be enjoyed. The first step involves determining the relevant disclosure in the priority document. The second step involves determining whether this disclosure is encompassed by the claim in the priority-claiming case. If yes, then the claim is de facto conceptually divided into a part enjoying priority and a part not enjoying priority.

This clarification means that, when the claims of the priority-claiming European filing involve only broadening amendments

compared with the disclosure in the priority filing, a right to partial priority will arise owing to the “encompassed” nature of the earlier disclosure. Under these circumstances, so-called “poisonous divisional” attacks are no longer possible, and nor is self-collision between the priority-claiming European filing and the priority application (or another European filing also claiming priority from the same priority filing). This is because the enjoyment of partial priority by the claim at issue immunizes it from any identical disclosure in the hypothetically conflicting application. This will be welcome news for patent applicants.

Nonetheless, it should be emphasised that the Enlarged Board in G 1/15 also considered and endorsed the strict approach taken under European practice to the concept of “the same invention” when determining whether a disclosure in a priority filing gives rise to any right of priority in the priority-claiming European application.

The strict “same invention” assessment requires that subject-matter for which priority entitlement is sought is directly and unambiguously derivable from the priority document. Consequently, the position with regard to partial priority remains uncertain when the claimed subject-matter in the later-filed application does not correspond only to a broadening of the disclosure in the priority application, but additionally involves the narrowing of one or more elements of the claim. Following the two-step analysis outlined by the Enlarged Board in G 1/15, such a disclosure in the priority document is no longer (fully) encompassed by the claim in the priority-claiming case and as such it is possible that no priority will be enjoyed by the claim.

In many cases, even if the claim at issue is denied priority, the relevant disclosure in any intervening publication will not be fatal, given that it necessarily discloses (broader) subject-matter that is different from the (narrower) subject-matter being claimed. However, there may be exceptions, notably in cases where the narrowed claim does not meet “selection invention” criteria with respect to the broader disclosure in the priority document. By way of example, in the case where a priority filing discloses an invention featuring a range of 1 to 10 and this range is narrowed to 2 to 9 in the claim of the later application, then: (a) the two-step assessment of G 1/15 may lead to the conclusion that there is no right to priority for the claim; and (b) the claimed range of 2 to 9 may, depending on the facts, be considered not to give rise to novelty under European provisions over a disclosure in the priority period of the range 1 to 10. It seems at least possible that self-collision objections may continue to be raised under such circumstances.

Summary and Practical Tips

G 1/15 provides authoritative confirmation that exclusively broadened claims in a European patent application will enjoy partial priority entitlement from a priority document disclosing

For more information, please contact:

Andrew Clark – aclark@jakemp.com

Mark Roberts – mroberts@jakemp.com

subject-matter encompassed by the broadened claim. For such cases currently in pre-grant examination or post-grant opposition proceedings before the EPO where self-collision or even “poisonous divisional” attacks have been raised, it is now clear that these objections should fail.

When a priority-claiming application is being prepared, the principles outlined in G 1/15 should now provide more freedom to broaden out claim features without significant risk of loss of priority for the disclosure in the priority filing. However, it remains good practice to retain all of the priority document disclosure in the later filing. For example, this would allow for claim amendments to be made later to reinstate full priority entitlement in the event of potentially problematic prior art being cited that was published between the priority and filing dates.

Similarly, it remains important carefully to consider the correlation between the disclosure in the priority filing and that in the priority-claiming application. This is particularly true when, during preparation of the priority-claiming application, it is intended to narrow down one or more features compared with the disclosure in the priority filing (perhaps while broadening out one or more other features). Care is needed to establish the extent to which partial priority entitlement could still be asserted, for example, with respect to any preferred embodiments already disclosed in the priority application. There may still be circumstances where it would be desirable to take proactive steps to mitigate the risk of self-collision objections, such as by preventing the publication of the priority application.

Finally, still earlier in the process, careful drafting of the priority filing, including the provision of extensive fall-back positions, remains desirable. Ideally, the priority filing should itself provide adequate scope for narrowing amendments, so that these do not need to be added for the first time when the priority-claiming application is being drafted. In this case, the prospects for preserving priority entitlement will be maximised.

Footnotes

1. Full decision available [here](#)
2. Full decision available [here](#)
3. See, for example, [T 1127/00](#), [T 2311/09](#), [T 0184/06](#), [T 1877/08](#), [T 0476/09](#) and [T 1496/11](#)
4. Full decision available [here](#)
5. See [T 1496/11](#) discussed above
6. Full decision available [here](#)
7. Full decision available [here](#)
8. Full decision available [here](#); the questions can be found in the Order on page 60 of this document

Chris Milton – cmilton@jakemp.com

Ravi Srinivasan – rsrinivasan@jakemp.com