



## Partial Priority and Dealing with “Toxic Divisionals” under the European Patent Convention

### *A New Referral to the EPO Enlarged Board of Appeal: Beyond G 2/98*

A new referral to the Enlarged Board of Appeal (“EBA”) of the European Patent Office (“EPO”) seeks clarification on the assessment of partial priority entitlement as well as a statement on the controversy surrounding the so-called “toxic divisional” attack. The referred questions have been published in Board of Appeal Decision T 557/13. At the center of the discussion leading to the referral is decision G 2/98 and the principles laid down by this decision for priority assessment.

#### Background

The appeal resulted from the opposition division’s decision to revoke European patent EP 0921183, based on the fact that the claims were not fully entitled to their priority. The granted claim 1 was a generalization of a specific disclosure in the priority document, and according to the opposition division, claim 1 did not have the priority date of the parent application. Consequently, the published parent application constituted prior art only for the purposes of novelty (Article 54(3) EPC). Hence, the patent under attack lacked novelty over its own parent application. In the present decision, the Technical

Board of Appeal recognized that the most important issue to be resolved was whether partial priority could be claimed for a generic claim.

A core requirement for validly claiming priority is that it has to be with respect to “the same invention.” This concept has been the subject of extensive analysis and discussion to determine how similar the disclosure of a later application has to be in order to be considered “the same invention” as the earlier application. According to G 2/98, the requirement for claiming priority of “the same invention” is acknowledged if the skilled person can derive the subject matter of the claims *directly and unambiguously* from the previous application as a whole.

The principle of “the same invention” also applies to applications claiming multiple priorities. According to Article 88(2) EPC, second sentence, it is allowed to have “multiple priorities ... for any one claim.” Thus, when evaluating multiple priorities for the same claim, a distinction has to be made between the so-called “AND” claims and “OR” claims.

For example, if an application claims feature A combined with feature B (A+B), but the priority document discloses only feature A, then the priority is not valid for the entire claim. If, on the other hand, the application claims two distinct alternatives, namely feature A or feature B (A/B), then the claim has two priority dates—one for feature A (reaching back to the priority date) and one for feature B (filing date of the subsequent application). The question is, if the application claims feature C in a generic term that encompasses feature A (the so-called “generic “OR” claim” in the referral), does such claim enjoy partial priority with respect to the subject matter of feature A, and is the remaining subject matter entitled only to the filing date of the subsequent application? For a generic “OR” claim, the Enlarged Board of Appeal in G 2/98 provided guidance on how Article 88(2) EPC is to be interpreted, permitting partial priority where “it gives rise to the claiming of a limited number of clearly defined alternatives.”

However, the criteria established by G 2/98 do not seem to provide consistent guidance for priority assessment for generic “OR” claims, and the case law has been developed divergently in interpretation and application of the criteria. Some Boards took a “strict” or “literal” approach, which could lead to denying partial priority, given that the generic term encompasses a practically unlimited number of alternatives that are not expressly spelled out. On the other hand, some Boards took a “generous” or “conceptual” interpretation, which does not require the “clearly defined alternatives” to be spelled out in the claim. Rather, it suffices to be able to conceptually identify a limited number of such alternatives by comparing the generic “OR” claim with the priority document. In this way, partial priority may be acknowledged.

The “strict” approach to partial priority has been used by some opponents to raise so-called “toxic divisional” attacks to invalidate a priority claim, whereby an opponent argues that a family member (a parent or a divisional of the patent at stake) is novelty destroying under Article 54(3) EPC. The attack relies on family members with a more specific disclosure according to the priority document (thus with a valid priority), as compared to a family member with a generic claim, which is not entitled to priority. The latter family member loses priority because of the broader claim, but the more specific disclosure in the former family member retains priority and so

it is, in principle, citable as prior art under Article 54(3) EPC against the latter family member. This “toxic divisional” attack has raised much controversy in recent years.

Not limited to the parent-divisional relationship, similar objections could also arise where the “colliding” application is the priority application itself, if the priority application is a European application that matures to publication, known as the “toxic priority.”

## The Referral

In decision T 557/13, published on August 12, 2015, the Technical Board of Appeal referred five questions to the Enlarged Board of Appeal, in order to settle the diverging case law on partial priority assessment. The questions as published are:

- 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?

The first four questions relate to partial priority, and in particular how entitlement to partial priority should be assessed for generic “OR” claims. The questions are intended to clarify the criteria for priority assessment in cases where the earlier application discloses a species, and the later application claims the genus in which that species belongs. For example, can an application claiming “metal” in general validly claim priority from an earlier application where only copper has been disclosed?

If the first question is answered in the negative, i.e., that partial priority cannot be refused, it would end the referral. If the answer to the first question is positive, it moves to the remaining four questions. Should the criteria “it gives rise to the claiming of a limited number of clearly defined alternatives” be used for the test (question 2)? 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 (question 3)? If the answer to question 2 is no, and the G 2/98 criteria are not applied, then the Enlarged Board should provide new criteria (question 4).

The fifth question relates to the “toxic divisional” attack, requesting clarification on the criteria to be applied. In essence, question 5 asks whether a family member (parent or divisional) can ever be prior art (novelty-only) according to Article 54(3) EPC.

## Comments

The Enlarged Board is not expected to give its answers until late 2016, but when issued, they should clarify the concept of partial priority in Europe and provide some clarification regarding the relationship between family members with different effective dates.

However, until the Enlarged Board of Appeal provides its answers, disclosure of the priority application and the claims of all family members should be carefully examined before filing a European divisional application, in order to ensure that no collision among family member occurs.

## Lawyer Contacts

For further information, please contact your principal Firm representative or one of the lawyers listed below. General email messages may be sent using our “Contact Us” form, which can be found at [www.jonesday.com/contactus/](http://www.jonesday.com/contactus/).

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