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Partial Priority: Report on EPO Decision G1/15

On 1 February 2017 the Enlarged Board of Appeal of the EPO published the detailed reasoning supporting its decision in case G1/15, which related to the manner in which partial priority applied to generic “OR”-claims.

A generic “OR”-claim is a claim encompassing alternative subject-matters by virtue of one or more generic expressions or otherwise. Such generic “OR”-claims can be found, for example, in a patent application claiming priority from an earlier “priority” application where there has been some generalisation of the particular subject-matter contained in that earlier priority application.

The expression “generic “OR”-claim” was introduced by a Memorandum drafted by FICPI in 1973, as part of the *Travaux préparatoires* for the European Patent Convention (Memorandum C (M/48/I) – hereafter “the FICPI Memorandum”). The FICPI Memorandum is of particular importance in decision G1/15, as the FICPI Memorandum is recognised as setting out the legislative intent underlying Articles 88(2) and 88(3) EPC, which govern multiple and partial priorities. The FICPI Memorandum contains several examples illustrating different types of generic “OR”-claims (simply referred to as “generic claims” in what follows).

The decision G1/15 now clarifies a situation where diverging case law had emerged before the Boards of Appeal of the EPO on how partial priority should be assessed for a generic claim. The decision should also bring an end to so-called “poisonous” priorities and “poisonous” divisional applications in Europe.

It is worthwhile noting that this decision is fully in line with the position promoted by FICPI since 1973. The FICPI Memorandum is indeed confirmed (see reasoning 5.2; pages 36 ff.) by the decision as authoritative for assessing multiple and partial priorities, in particular for generic claims. The decision is also in full agreement with the amicus brief filed by FICPI on 29 February 2016 in this matter.

In referral G1/15, five questions were referred to the Enlarged Board of Appeal. Question 1 was critical, as the four other questions needed to be answered only if answer to question 1 was to be positive.

Question 1 read:

“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?”

In essence, this question asked whether it could be possible, considering a generic claim, to refuse entitlement to partial priority for some subject-matter covered by the generic claim, in spite of the fact that such subject-matter was disclosed in an enabling manner for the first time, directly, or at least



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implicitly, and unambiguously, in the priority document – i.e. such subject-matter would satisfy the “Gold standard” used at the EPO for entitlement to priority.

In other words the question asked implicitly whether in such situation, in addition to the Gold standard, there should be additional conditions for entitlement to partial priority.

Some decisions at the EPO had indeed considered that in such situation, in order for particular (“alternative”) subject-matter covered by the generic claim to be entitled to partial priority, the condition based on proviso 6.7 of an earlier decision (G2/98) should also be fulfilled. This interpretation of the proviso 6.7 required that in order to be entitled to partial priority, the generic claim should “give rise to the claiming of a limited number of clearly defined alternative subject-matters”.

Such interpretation (sometimes improperly referred to as a “strict” approach) would not allow entitlement to partial priority for subject-matter covered by a generic claim if the generic claim did not fulfill this additional condition.

On the other hand, in a more “open” approach, many other EPO decisions did not follow this interpretation and did not consider proviso 6.7 of G2/98 as a legal requirement for entitlement to partial priority. Diverging case law had thus emerged and clarification was indeed necessary, particularly in view of the importance of priority in Europe’s first-to-file system.

Clarification was all the more necessary since the “strict” approach on partial priority gave rise to “poisonous” priorities and “poisonous” divisionals which created concern amongst users of the patent system.

A large number of amicus briefs have been filed at the Enlarged Board of Appeals, including a brief from [FICPI](#).

In this amicus brief FICPI expressed its support for the open approach. FICPI exposed to the Enlarged Board of Appeal that the FICPI Memorandum should be recognised as expressing the legislative intent behind Articles 88(2) and 88(3) EPC, and that the FICPI Memorandum made it clear that all generic claims should be entitled to partial (as well as multiple) priorities and therefore no further conditions should apply. FICPI also pointed out that the interpretation of proviso 6.7 of G2/98, which followed in the “strict” approach, was in contradiction with the FICPI Memorandum.

The reasoned decision G1/15, now available, is fully aligned with said FICPI position.

In its detailed reasoning the Enlarged Board of Appeal emphasises that priority is a right and that, “as a matter of principle, where a right is established by an international treaty or convention, or by national law, it cannot be restricted by imposing supplementary conditions in administrative rules or guidelines or even in jurisprudence”. It also confirms that partial priority is a concept that is present in the EPC - as recited in Article 88(3) EPC, and in the spirit of Articles 4F to 4H of the Paris Convention. The decision also makes it clear that “If a claim in the later application is broader than an element disclosed in the priority document, then priority may be claimed for such element but not for all other embodiments



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encompassed by the claim or claims. This principle applies for each individual element disclosed in any priority document.”, and “It is (...) of no relevance whether one claim for which partial priority is claimed encompasses only one element disclosed in a priority document or a plurality of elements disclosed in one or more priority documents.” (reason 5.1.3).

Importantly, the Enlarged Board of Appeal very explicitly states that the FICPI Memorandum was an essential element in forging Article 88 EPC (initially, Article 86 EPC) : “The Minutes of the Munich Diplomatic Conference of 1973, M/PR/I, “Article 86 (88) Claiming Priority”, points 308 to 317, indicate that the Memorandum was an essential element in the process of drafting the EPC provision finally adopted”. The decision also explicitly confirms that its reasoning is “consistent with the Memorandum”.

Fully in line with the FICPI Memorandum and the amicus brief filed by FICPI, the Enlarged Board of Appeal further states that “the EPC does not contain other requirements for recognising the right of priority beyond the same invention, whether for simple, multiple or partial priority, the last being regarded as a sub-group of multiple priorities. As a consequence, the proviso laid down in G 2/98, (supra, Reasons point 6.7, last sentence), cannot be construed as implying a further limitation of the right of priority”. And the decision also confirms that the “Gold standard” for assessing entitlement to priority is consistent with its interpretation of Articles 88(2) and 88(3) EPC.

Reason 6.4 of the decision recites how entitlement of a generic claim to partial priority is to be assessed:

“In assessing whether a subject-matter within a generic “OR” claim may enjoy partial priority, the first step is to determine the subject-matter disclosed in the priority document that is relevant, i.e. relevant in respect of prior art disclosed in the priority interval. This is to be done in accordance with the disclosure test laid down in the conclusion of G 2/98 and on the basis of explanations put forward by the applicant or patent proprietor to support his claim to priority, in order to show what the skilled person would have been able to derive from the priority document. The next step is to examine whether this subject-matter is encompassed by the claim of the application or patent claiming said priority. If the answer is yes, the claim is de facto conceptually divided into two parts, the first corresponding to the invention disclosed directly and unambiguously in the priority document, the second being the remaining part of the subsequent generic “OR”-claim not enjoying this priority but itself giving rise to a right to priority, as laid down in Article 88(3) EPC.”

The Enlarged Board of Appeal confirms that “This also corresponds, logically and exactly, to the scheme described in the Memorandum”. The Enlarged Board of Appeals concludes that the answer to question 1 of the referral is to be answered in the negative and, as a consequence, questions 2 to 5 need not be dealt with.

This important decision thus clarifies how partial priority should be assessed, and reinforces legal certainty of the EPO practice. It will also very likely bring an end to the poisonous priorities, and poisonous divisionals which had generated concern amongst users of the patent system.



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FICPI contribution has been decisive in this clarification, from which all users of the patent system will benefit.

Jérôme Collin

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Regimbeau: Creative IP

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