In a new twist in the CRISPR/Cas9 saga, European patent EP 2 771 468 was revoked in appeal on 16 January 2020 (T 0844/18). This patent covers an important aspect of the technology and its use in eukaryotes.

The question at stake was whether priority is validly claimed when one of the applicants of the priority application is not an applicant of the PCT application on which the patent was later granted. The patent claimed the priority of 12 US provisional applications. However, the rights of the two earliest had not been assigned from one of the inventors/applicants to the co-applicants of the PCT application.

Three lines of arguments were put forward by the patentees to support their argument that priority was validly claimed:

- The EPO is not competent to assess priority entitlement because it was not meant to deal with entitlement to priority; in an audacious argument, the patentees argued that the EPO’s approach was in contravention of a patentee’s human right to property;
- The expression “any person” in Article 87 EPC / Article 4 of the Paris Convention is not correctly construed by the EPO; hence when the priority application is filed by a group of applicants, any one or any sub-group of them should be able to claim the priority of this application;
• Determination of who is entitled to priority should be based on the law of the country where the priority application was filed (in the present case, the US law) and not on the EPC.

After the first day of the oral hearings, the Board indicated that they were considering referring a question to the Enlarged Board of Appeal, based on the three strands of the Patentee’s argument. This would have been a shock, since there seems to be uniform application of the law of priority across the Boards of Appeal. However, in the afternoon of the fourth day, the Board came to the conclusion that they could decide the question by themselves. The priority claim was declared invalid, following established case law of the Boards of Appeal, meaning that the claimed composition lacked novelty in view of an intermediary publication from the patentees’ own laboratory.

This case emphasises how important it is that priority is validly claimed. In particular, extreme care must be taken in ensuring that applicants have the right to claim priority before filing the PCT application.

The reasons for the Board’s decision will be issued at a later time. In addition, although the dismissal of the appeal could be expected, the considerable amount of work and money spent by the patentees to fight their case, as well as the imaginative arguments they developed, suggests that this might not be the end of the story. It remains now to be seen whether the patentees will file a petition to review the Board’s decision pursuant to Article 112bis EPC, maybe in relation with the Board’s refusal to refer the case to the Enlarged Board of Appeal. Stay tuned!

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