

Opposing views on partial priority

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1. Introduction

The recent case involving Nestec S.A.'s European patent EP2103236 for a coffee machine (*Nestec SA & Ors v Dualit Ltd & Ors* [2013] EWHC 923 (Pat)) has brought the issue of partial priority under **Article 88(2) EPC** to the fore in relation to the question of whether a patent can be found to lack novelty over its own published priority application. The same issue arises in relation to the so-called 'poisonous divisionals' hypothesis, according to which a patent can be found to lack novelty over another published divisional (or parent) application of the same patent family if the priority claim is invalid due to some generalization (see case **T 1496/11**). The hypothesis applies where a patent or application having a claim of broader scope than anything in an application to which priority is claimed becomes invalid through lack of novelty as a result of the priority application itself (or of any other application based on the priority application) being published and becoming prior art under **Article 54(3) EPC**. The question is then whether, or to what extent, a patent or application should be immune to anticipation by other applications of the same patent family.

Article 88(2) EPC, second sentence, states, "*Where appropriate, multiple priorities may be claimed for any one claim*". How this should be interpreted was one of the subjects tackled by the EPO Enlarged Board in **G 2/98**, although this was not the main issue in question. The legislative intent underlying the sentence was, in the Enlarged Board's view, expressed by a memorandum from 1973 drawn up by the international organisation FICPI (Fédération Internationale des Conseils en Propriété Industrielle) during preparations leading to establishment of the EPC. This memorandum put forward a case for multiple priorities in a single claim being permissible because this would allow an applicant to obtain a valid broad scope of claim without the need to file multiple independent claims. Three different examples were provided in the memorandum: a) broadening of chemical formulae; b) broadening of a range; and c) broadening of a field of use. In each case, the memorandum argued that a broad claim should be allowed to validly claim partial priority to an earlier narrow disclosure.

In **G 2/98**, after commenting on the memorandum the Enlarged Board held that "*The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters*" (point 6.7 of the reasons, emphasis added).

It is commonly held that the concept of partial priority, *i.e.* the attribution of a priority date to part of a claim only, has to be treated similarly to the concept of multiple priorities, since the situations are strictly symmetric. As a result, if use is made of a generic term or formula in a claim which is broader than the disclosure of a priority document, the claim should be entitled to its priority date for the part of the subject-matter disclosed in the priority document provided that this gives rise to "*the claiming of a limited number of clearly defined alternative subject-matters*".

In the Nestec case, as presented at the High Court, the patent claimed a device in which a specific location of a housing for receiving a capsule was not stated in the claim. The claim, it was argued, covered situations where the housing could be in first or second parts of the device, or in a

combination of the two. In the priority document, the housing was only disclosed as being in the second part, resulting in a question over the validity of the priority claim. Another issue was that the claim covered different possible orientations of the capsule, only one being disclosed in the priority document. Mr Justice Arnold, citing **G 2/98**, rejected the patentee's argument that the claim should be entitled to partial priority, and ruled that the claim was not entitled to priority at all because the third possibility of the housing being divided between the two parts was not a "*clearly defined alternative*" to the first two, and because the capsule arrangements disclosed in the priority document were not "*clearly defined alternatives to the other arrangements*" either. As a result, the content of the published priority document was held to be novelty defeating for the claimed invention.

The same patent has also been the subject of opposition proceedings at the EPO. At first instance, the patent was upheld in amended form: the Opposition division did partly entertain the opponents' objections of anticipation by the priority document, but held that one of the auxiliary requests filed by the patent proprietor remedied the problem. On appeal, the issue of partial priority was discussed again by the parties in the course of the written proceedings. Oral proceedings were held on the matter in October 2013, but the patent was finally held to be invalid due to added subject-matter and was revoked on this ground, without priority coming into question (case **T 1674/12**).

While the question of what the Enlarged Board meant in **G 2/98** regarding multiple priorities/partial priority remains unresolved, the following is an attempt by the authors at presenting their opposing views on the matter of how to interpret **Article 88(2) EPC** in light of **G 2/98**. These can in essence be summarised as arguing for broad or narrow interpretations of **Article 88(2) EPC**, second sentence. According to the broad interpretation, **Article 88(2)** should be interpreted as allowing partial priority in all cases where a broader claim scope encompasses a narrower priority disclosure. According to the narrow interpretation, **Article 88(2)** has only limited applicability to situations where an application with a broad claim scope has clear basis for both the narrow priority claim scope and to the rest of the claim.

2. The Broad Interpretation

The examples set out in the FICPI memorandum establish that a broad claim scope can have a valid partial priority to a narrow priority disclosure. In example a), a broad claim scope to a formula covering halogens is considered to validly claim partial priority to a first earlier priority application disclosing only chlorine and to a second earlier application disclosing also bromine, iodine and fluorine as alternatives. The first priority claim is valid for chlorine, and the second is valid for the other halogens disclosed in the second application. In example b), a first priority document discloses a temperature range of 15-20° and a second priority document a broader temperature range of 10-25°. An application claiming priority to both earlier applications should be allowed to validly claim the range 10-25°, with partial priority to the first application for the 15-20° part of the range and to the second for the 10-15° and 20-25° parts, instead of having to draw up three independent claims. In example c), a first priority document discloses a method of coating the inner wall of a pipe, while a second priority document discloses the same method for coating the inner wall of bottles or other hollow bodies. An application claiming priority to both earlier applications should be allowed to claim a method for coating the inner wall of hollow bodies with a valid partial priority to the first application for coating pipes and to the second for coating the inner walls of hollow bodies not being pipes. It is important to note that there is no mention in the memorandum of any requirement for an application to have basis for amending to separable claims having different priorities that would together have the same scope as a single claim with multiple priorities. In particular, the memorandum does not indicate whether the second application would need to explicitly specify a method of coating the inner walls of hollow bodies that are not pipes.

The examples in the FICPI memorandum provide a clear indication that a broad scope of claim such as that in the Nestec case should have been allowed to validly claim partial priority, not least given the obvious similarities to the third example. The disclosure of the housing being entirely in the second part in the priority application would allow for partial priority for this configuration in the later application, while other configurations where the housing is not entirely in the second part would have a priority claim only to the date of filing of the application. It is clear from reading the memorandum, which was held in **G 2/98** to “*express the legislative intent underlying Article 88(2), second sentence, EPC*” (point 6.4 of the reasons) that such an interpretation would be correct and that Arnold J’s judgment was wrong in this respect. The emphasis on requiring the claim to have “*a limited number of clearly defined alternative subject-matters*”, without referring to what this must mean in light of the memorandum to which **G 2/98** refers, has apparently resulted in an interpretation that would inevitably mean that the specific examples in the memorandum itself would not comply with **Article 88(2)**, second sentence. This cannot be a logical conclusion to arrive at, not least because **G 2/98** expresses no opinion regarding the validity of any of the examples and it must therefore be assumed that all were considered to be valid.

Given the examples provided in the memorandum, the legislative intent behind allowing multiple priorities in one claim can be considered to have broad applicability, in particular in relation to the question of published priority applications becoming **Article 54(3) EPC** prior art (i.e. the ‘poisonous priority’ or ‘poisonous divisionals’ issue). The examples may even be broadened to a general principle, in which an application having a claim with a broad claim scope that encompasses the disclosure of a priority application can be considered in principle to have a valid claim to partial priority for the part of the claim that corresponds to the disclosure in the priority application and to a priority of the date of filing to the rest of the scope of the claim. Whether the particular broadening is in terms of a range, a chemical formula, a field of use or anything else does not matter because the division in terms of priority needs only to be theoretical. The only criteria required would be: i) that the claim scope entirely encompasses the priority disclosure; and ii) that there is no issue regarding public disclosures between the priority date and the date of filing of the application. Provided such criteria are met, and of course all other requirements of the EPC are met for the claim scope (in particular **Article 83 EPC**, as the broader scope would need to be justified by the application as a whole), the validity of a partial priority would defuse any possibility of the priority application, if published, becoming **Article 54(3)** prior art. This is because the published priority application would not be prior art for the portion of the claim scope having a valid claim to priority, while the rest of the scope of the claim would inevitably be novel. It must be emphasised, however, that this is only applicable when there are no intervening public disclosures within the scope of the later broader claim but outside of the scope of the earlier disclosure, since the only solution to this would be to amend the scope of the later claim.

The main argument raised against this interpretation is that, for multiple priorities to be validly claimed, it must be possible to at least notionally divide the claim up into distinct independent claims having different priority claims without contravening **Article 123(2) EPC**. This argument is based on the requirement in **G 2/98** for “*a limited number of clearly defined alternative subject-matters*”, and has been applied in several EPO Board of Appeal decisions such as **T 1877/08**, **T 476/09**, **T 1443/05** and **T 1127/00**.

In **T 1877/08**, the Board rejected a range of numerical values as not corresponding to distinctive alternative embodiments (point 2.4 of the reasons). The same point was made in **T 476/09** (point 5.6 of the reasons). This is in direct contradiction to example b) of the memorandum, which specifically refers to numerical ranges being a possibility for multiple priorities in one claim. Both of these decisions were therefore wrongly decided on this point.

In **T 1127/00**, the Board rejected a claim to partial priority for a generic formula encompassing an earlier narrow range in the priority application because the claim did not embrace a limited number of clearly defined alternative subject-matters in the form of an “OR” claim which could be split up into groups of different priorities (point 6 of the reasons). This is, however, clearly contradictory in terms of both examples a) and b) of the memorandum.

In **T 1443/05**, the issue was complicated by the fact that the application as filed contained a disclaimer, so the above criteria for validly claiming partial priority would not apply.

The above mentioned decisions supposedly following **G 2/98** and which reject the idea of the broad applicability of **Article 88(2)** to claiming multiple priorities in a single claim can be shown to either have been decided wrongly on this point or to be not relevant to the issue in question.

A more recent decision, **T 1222/11**, has cast doubt on the earlier aforementioned decisions by disagreeing with their interpretation of **G 2/98**, concluding that *“in so far as a subject-matter disclosed in a priority document and encompassed by an “OR”-claim of a European application (i.e. a claim of a European application which compared to the disclosure of the subject-matter in the priority document has been broadened) is concerned, the decision on whether priority can be acknowledged for this subject-matter, i.e. for this embodiment covered by the “OR”-claim, is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the “OR”-claim of the European application as a separate alternative embodiment. The above conclusion, however, also implies in view of the necessary coherence of rules of law on the subject of claiming priority defined in the EPC, that when an application on the basis of which a priority date is claimed encompasses a narrower subject-matter already disclosed by the same applicant in an earlier application, the decision on whether the claim to priority on the basis of the later application is valid does not depend on whether the narrower subject-matter disclosed in the earlier application is identified in said later application”* (point 11.8 of the reasons, emphasis added). The requirement to have specific basis for the *“limited number of clearly defined alternative subject-matters”* in the application is therefore explicitly rejected in **T 1222/11**. Instead, it is sufficient for a claim to be theoretically divided up into a first part having a valid earlier priority and a second part having a different priority (being typically the date of filing of the application).

The concept of imaginary claim splitting, as established by **T 1222/11**, allows for a complete solution to the supposed problem of ‘poisonous priority’ or ‘poisonous divisionals’. It should therefore never be the case that an application claiming a broader scope than an earlier priority application discloses can be held to lack novelty over the content of the priority application once published. To establish this as a general rule, however, will require **T 1222/11** to be followed in preference to the other cases where a different narrow view on partial priority has been taken.

3. The Narrow Interpretation

According to the opposing view, there are good reasons to consider that the approach of imaginary claim splitting set out in **T 1222/11** is not in agreement with the case law of the Enlarged Board of Appeal.

First of all, it seems that the concept of imaginary claim splitting leads to the conclusion that a claim broader than the disclosure of a priority document will always benefit from partial priority. Indeed, it is always possible to split a claim in a theoretical manner (however artificially) into subject-matter disclosed in the priority document (A) and subject-matter not disclosed in the priority document (non-A). This correlatively implies that the proviso in point 6.7 of **G 2/98** – *“provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters”* – is in fact a silent condition, which is necessarily met and can therefore be

ignored in practice. Such a conclusion is unsatisfactory, as it was apparently the Enlarged Board's intention to limit the application of multiple priorities (and therefore partial priority) to some circumstances.

More generally, the **T 1222/11** approach hardly seems reconcilable with the doctrine of the 'disclosure test' as a whole, which was developed by the Enlarged Board over the years, notably in its decisions **G 3/89**, **G 11/91**, **G 2/98**, **G 1/03** and **G 2/10**. This doctrine, which is referred to as a "golden standard" in **G 2/10**, concerns a common appraisal of the distinct issues of validity of a priority claim (**Article 87 EPC**), extension of subject-matter (**Articles 123(2)** and **76(1) EPC**) and novelty (**Article 54 EPC**). As the Enlarged Board puts it in **G 1/03**, "*the European patent system must be consistent and the concept of disclosure must be the same for the purposes of Articles 54, 87 and 123 EPC*".

The central pillar of this consistent approach is the criterion of direct and unambiguous disclosure for the skilled person. Any notion of conceptual or abstract delimitation of subject-matter in a claim, as suggested in **T 1222/11**, would be at odds with the above consistent approach. Indeed, such a notion would be tantamount to applying a rule of logic, according to which partial priority / multiple priorities are necessarily acknowledged. And the recourse to rules of logic of this kind has already been rejected by the Enlarged Board in an analogous context, namely that of the assessment of 'undisclosed disclaimers'. The Enlarged Board made it clear that only a case by case assessment can be performed in relation with the 'direct and unambiguous disclosure' criterion: "*it was also submitted that the disclosure of an embodiment or smaller region (B) within a broader region (A), likewise disclosed, would thereby logically and inevitably disclose the subject-matter of the broader region minus the embodiment (A-B) and that a claim containing such a disclaimer would for that reason not contain subject-matter offending against Article 123(2) EPC. [...] The question can nevertheless not be decided schematically. In particular, no principle can be acknowledged, which would be applicable a priori, to the effect that disclaiming disclosed specific embodiments, groups thereof or areas from a broader claim can never infringe Article 123(2) EPC. Also, no so-called rule of logic applies, in the sense that where an application discloses a general teaching and specific embodiments, groups thereof or areas, all other potential embodiments or intermediate generalisations falling within the ambit of the general teaching (but not as such disclosed in the application as filed) would thereby, by implication, inevitably also be disclosed*" (**G 2/10**, point 4.5.3 of the reasons).

Turning back to the FICPI memorandum, the three examples contained therein admittedly reflect a very liberal appraisal of partial priority, arguably in keeping with the 'imaginary claim splitting' set out in **T 1222/11**. But it should be considered that not all of these examples comply with the Enlarged Board's doctrine – and that these examples therefore have no legal authority.

As a preliminary remark, the Enlarged Board in **G 2/98** did state that "*the memorandum can be said to express the legislative intent underlying Article 88(2)*", but this should not be construed as an endorsement of the totality of the memorandum, including its various examples (contrary to the first view expressed in this article). What the Enlarged Board explicitly approved in the memo is:

- the distinction made between so called AND-claims and OR-claims (reasons, 6.5);
- the principle that AND-claims (*i.e.* claims directed to A+B wherein only A is disclosed in a first priority document) cannot benefit from multiple priorities (reasons, 6.6);
- the principle that OR-claims (*i.e.* claims directed to A or B wherein A is disclosed in a first priority document and B in a second priority document) can benefit from multiple priorities (reasons, 6.7) – although the examples of the FICPI memorandum in this respect are neither commented upon nor even mentioned.

It is in relation with this latter point that the Enlarged Board added its proviso with respect to the “*claiming of a limited number of clearly defined alternative subject-matters*”. This proviso is nowhere to be found in the FICPI memorandum itself. It was introduced by the Enlarged Board, and it qualifies the general principle that multiple priorities can be valid for OR-claims.

If we get a closer look at the three examples of the FICPI memo, the first example (the one relating to halogens) seems to be formally correct since it does relate to a limited number of clearly defined alternatives subject-matters, namely the various halogens; but the same cannot necessarily be said of the other two, which relate to subject-matters corresponding to a continuum of not clearly defined alternatives.

In particular, the reasoning underlying the third example clearly seems to be flawed.

As set forth above, this third example assumes a first priority document to a method of coating a pipe and a second priority document to the same method for coating bottles or any other hollow bodies. It is noted in the memorandum that, should multiple priorities not be allowed, “*the applicant [would] have to draft parallel claims, one [A] directed to the method coating inner walls of a pipe, which will benefit from the first priority, and the other one [B] directed to the method of coating the inner walls of hollow bodies other than pipes, which will benefit from the second priority*”. The flaw in this statement is that, based on the Enlarged Board’s views on the “*same invention*” criterion for the assessment of priority, the second putative claim B can in fact not benefit from the second priority – unless of course the second priority document directly and unambiguously discloses a method of coating the inner walls “*of hollow bodies other than pipes*”.

In other terms, the FICPI memorandum’s line of reasoning is contrary to the “*golden standard*”. This is not surprising, since the memorandum dates back to 1973, long before the Enlarged Board developed its doctrine revolving around the disclosure test.

Against this backdrop, the restrictive approach taken by the majority of the Boards of appeal as of today with respect to OR-claims (namely Board 3.2.5 in **T 1496/11**, Board 3.3.1 in **T 1443/05**, Board 3.3.8 in **T 1127/00** and **T 70/05**, Board 3.3.9 in **T 476/09** and Board 3.3.10 in **T 1877/08**) seems to in better agreement with the Enlarged Board’s doctrine than the more liberal approach taken by Board 3.3.7 in **T 1222/11** – which for the time being remains a rather isolated decision.

As a side note, contrary to first view expressed in this article, it can be argued that **T 1443/05** was no particular case even though the claim at stake contained a disclaimer. The core issue was still that the claimed subject-matter (including the disclaimer) had been generalized with respect to the specific embodiments (examples) disclosed in the priority document, just like in the other cases referred to above.

The ‘restrictive approach’ is also the path that Mr. Justice Arnold chose to take, and that the German Federal Patent Court also took on at least one occasion, in a *Johnson & Johnson Vision Care & Ors. v Novartis AG* ruling (2009, docket number 3 Ni 23/08).

One of the arguments often heard against this approach to partial priority is that it would lead to unfair and/or absurd results; the possibility for a patent to be invalidated based on its own priority document or based on another application of the same family is viewed by many practitioners as an aberration.

But is this situation actually more unfair than the case of a patent invalidated due to the inventor disclosing a claimed invention to a third party just before the filing? Or the case of a patent invalidated due to a conflicting application under **Article 54(3) EPC** containing an anticipatory

disclosure in its description, albeit entirely different claims? Or the case of a patent containing a genuine mistake, which cannot be corrected due to **Article 123(2) EPC**? Or the case of a patentee caught in an inescapable trap between **Article 123(2)** and **123(3) EPC**? European patent law is replete with potential pitfalls which might seem somewhat unfair or absurd to the affected parties.

However, each of these pitfalls does in fact make sense in view of the required overall consistency of the system, and in view of the fundamental principle of legal certainty for third parties. What would actually be unfair, should **T 1222/11** be followed, would be to allow a claim, generalized relative to a priority document, to have partial immunity derived from the priority document whatever the nature of the generalization is, bearing in mind that such partial immunity would be effective against all disclosures, as there is no legal basis in the EPC for a distinction between disclosures resulting from the patentee's own applications and disclosures made by third parties.

The general message of **G 2/98** is that in order for a claim to benefit from a priority date, the claimed subject-matter must be directly and unambiguously disclosed as such in the priority document. It is certainly acceptable for the applicant to add to the claim another, clearly alternative, subject-matter not benefiting from the priority date. But it is not acceptable to alter the claim by way of a generalization actually leading to a different invention – an *aliud* – and still partly keep the benefit of the priority date.

4. Conclusions

Given the fundamental disagreement over how to interpret “*a limited number of clearly defined alternative subject-matters*” in decisions of the EPO Boards of Appeal (and among practitioners), it appears that the only realistic way forward to resolve the issue would be a referral to the Enlarged Board. The issue will inevitably arise in other appeal cases, so the most likely route would appear to be a referral from a Technical Board of Appeal, although a referral from the President could be a possibility.