



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Große
Beschwerdekammer

Enlarged
Board of Appeal

Grande
Chambre de recours

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of the Enlarged Board of Appeal
of 29 November 2016**

Case Number: G 0001/15

Appeal Number: T 0557/13 - 3.3.06

Application Number: 98203458.9

Publication Number: 0921183

IPC: C10L10/04, C10L1/22, C10L1/18,
C10L1/14

Language of the proceedings: EN

Title of invention:
Use of cold flow improvers in fuel oil compositions

Patent Proprietor:
Infineum USA L.P.

Opponent:
Clariant Produkte (Deutschland) GmbH

Relevant legal provisions:
EPC Art. 54, 76, 87, 88, 89, 112(1)(a), 123(2)

Paris Convention:
Art. 4A(1), 4B, 4C, 4F, 4H

Keyword:
"Admissibility of referrals by the boards of appeal - yes"
"Point of law of fundamental importance - yes"
"Priority right - conditions and effects"
"Partial and multiple priorities"
"Legal basis and assessment of partial priority"

Decisions cited:

G 0003/89, G 0003/93, G 0002/98, G 0001/03, G 0002/10,
J 0015/80, T 0301/87, T 0665/00, T 1127/00, T 0135/01,
T 1443/05, T 0184/06, T 1496/11, T 1877/08, T 0476/09,
T 2311/09, T 0571/10, T 1222/11, T 0557/13.

Catchword:

Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR"-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect.



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Große
Beschwerdekammer

Enlarged
Board of Appeal

Grande
Chambre de recours

Case Number: G 0001/15

DECISION
of the Enlarged Board of Appeal
of 29 November 2016

Appellant:
(Patent Proprietor)

Infineum USA L.P.
1900 East Linden Avenue
Linden, New Jersey 07036 (US)

Representative:

Hart, Richard Joseph
Infineum UK Ltd.
Law Department
Milton Hill,
P.O. Box 1
Abingdon, Oxfordshire OX13 6BB (GB)

Respondent:
(Opponent)

Clariant Produkte (Deutschland) GmbH
Group Intellectual Property
Am Unisys-Park 1
65843 Sulzbach (DE)

Representative:

Mikulecky, Klaus
Clariant Produkte (Deutschland) GmbH
Patent & License Management Chemicals
Industriepark Höchst, G 860
65926 Frankfurt am Main (DE)

Referring Decision:

Interlocutory decision of the Technical Board
of Appeal 3.3.06 of the European Patent Office
of 17 July 2015.

Composition of the Board:

Chairman: W. van der Eijk
Members: P. Carlson
I. Beckedorf
C. Vallet
F. Blumer
H. Meinders
W. Sieber

Summary of Facts and Submissions

I. By interlocutory decision T 557/13 dated 17 July 2015, Technical Board 3.3.06 referred the following questions of law to the Enlarged Board of Appeal (further: Enlarged Board) under Article 112(1)(a) EPC:

"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?"

II. In the case underlying the referral, the opposition division revoked European patent No. 0 921 183, which was granted on a divisional application of European patent application No. 95923299.2 (hereinafter "parent application"). The latter was filed on 8 June 1995 and published on 14 December 1995. The patent and the parent application claim priority from national application GB 9411614.2 (hereinafter "D16"), filed on 9 June 1994.

Claims 1 and 7 of the patent read as follows:

"1. The use of a cold flow improver, wherein the cold flow improver is an oil-soluble polar nitrogen compound carrying two or more substituents of the formula $-NR(13)R(14)$, where R(13) and R(14) each represent a hydrocarbyl group containing 8 to 40 carbon atoms provided that R(13) and R(14) may be the same or different, one or more of which substituents may be in the form of a cation derived therefrom, to enhance the lubricity of a fuel oil composition having a sulphur content of at most 0.05% by weight, wherein from 0.001 to 1% by weight of the cold flow improver based on the weight of the fuel is present."

"7. The use of any of claims 1 to 4, wherein the polar nitrogen compound is the N,N-dialkylammonium salt of 2-N',N'-dialkylamidobenzoate product of reacting one mole of phthalic anhydride and two moles of di(hydrogenated tallow)amine."

The patent was opposed on the grounds of Articles 100(a) EPC (lack of novelty and lack of inventive step) and 100(c) EPC (non-compliance with the requirements of Articles 123(2) and 76(1) EPC).

The reasoning of the decision under appeal is in essence the following:

- The claims as granted were not objectionable under Article 123(2) or 76(1) EPC.

- The subject-matter of claim 1, resulting in a generalisation of a more specific disclosure of the nature of the compound to be used as a cold flow improver in the priority document, did not represent the same invention. The priority claimed was thus not valid for the whole scope of claim 1. Moreover, referring to G 2/98 (OJ EPO 2001, 413, Reasons, points 4, 6.6 and 6.7), the opposition division concluded that the "intermediate generalisation in granted claim 1 with respect to the disclosure of priority document D16 does not give rise to the claiming of a limited number of clearly defined alternative subject-matters" and thus that the "subject-matter of claim 1 was only entitled to the filing date".

- Although the patent met the requirements of Article 76(1) EPC, it did not enjoy the priority date

of the parent application, which thus was state of the art under Article 54(3) EPC.

- Consequently, the subject-matter of claim 1 as granted lacked novelty under Article 54(3) EPC in view of the use of the cold flow improver of Example 1, disclosed identically in the parent application and in the priority document. The embodiment described in the parent application was held to be "entitled to the claimed priority date of 09.06.1994", whereas granted claim 1 was held to be "only entitled to the filing date of 08.06.1995".

- III. Following a decision taken on 14 October 2015, the Enlarged Board invited the President of the European Patent Office to comment on the points of law referred to it by the technical board and placed an announcement in the Official Journal of the European Patent Office to give third parties the opportunity to express their views on the points referred.
- IV. The President of the European Patent Office submitted his comments by letter dated 25 February 2016. A large number of amicus curiae briefs were also received.
- V. Oral proceedings took place on 7 June 2016. At the end of the oral proceedings the Chairman announced that the Enlarged Board would give its decision in writing before the end of November 2016.

VI. Submissions of the appellant

- As to question 1 of the referral

The term generic "OR"-claim can be interpreted in at least two ways: firstly, as relating to a claim broadened beyond the broadest disclosure of the priority document, and, secondly, as relating to a claim which is narrower in scope than the priority disclosure but which contains a generic term. The appellant requests the Enlarged Board to clarify in its decision the interpretation which it adopts.

Concerning the legal context of the present issue, the EPC is a special agreement within the meaning of the Paris Convention (J 15/80, OJ EPO 1981, 213). Thus, interpretations of the EPC which are incompatible with the Paris Convention should not be considered the intention of the legislator.

The referred question focuses on certain aspects of the EPC. However, the EPC must be interpreted as a coherent whole: interpretations of one part that contradict or adversely affect other parts cannot be what the legislator intended.

Under the Vienna Convention on the Law of Treaties, the travaux préparatoires are the primary source of reference for resolving the meaning of the EPC. Primary law dominates secondary law (case law). In the case of conflict, the legislative intent, as evidenced by the travaux préparatoires, should prevail.

Both the political context and the industrial context of the patent system require it to be simple and affordable, and to support the priority right with high legal certainty. The law needs to reflect the realities of research, and not create artificial barriers to priority entitlement or the management and transfer of patent rights.

The issue of poisonous priority and self-collision looks out of place in this context; its complexity brings more cost and legal uncertainty, and creates a further barrier to patent protection. It has no counterpart in the rest of the priority world, which has applied the Paris Convention without creating this difficulty.

With respect to inter partes proceedings under the EPC, adopting a narrow, literal approach to the proviso of G 2/98 (supra, Reasons, point 6.7) "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" comes close to establishing lack of clarity as a substantive ground against granted claims: a lack of clarity per se would be sufficient to fail the literal test of point 6.7, depriving the claim of priority and precipitating self-collision.

The appellant submits that the answer to question 1 should be negative, arguing that the divergence in the case law stems from a strict interpretation of point 6.7 of G 2/98 as the definitive statement setting out the law on partial priority. However, legislation takes precedence over case law, and neither the EPC nor the Paris Convention provides for a restrictive approach

whereby partial (or multiple) priority should be denied on the ground that a claim was not drafted so as to relate to a limited number of clearly defined alternatives. FICPI Memorandum C (hereinafter "the Memorandum", cf. "travaux préparatoires" to the EPC 1973 M/48/I, section C) provides a clear view of the intended approach to partial (or multiple) priority: generic "OR"-claims are a permissible way to refer to alternatives in a claim. The Memorandum provides concrete examples a), b) and c) showing how priority has to be assessed. No distinction is made between the different types of generic expressions and no need is expressed to separate out subject-matter into different priority bundles.

It is thus considered that the correct approach is that adopted in decisions T 1222/11 (of 4 December 2012, not published in the OJ EPO) and T 571/10 (of 3 June 2014, not published in the OJ EPO) and which, by dividing the generic "OR"-claim into conceptual parts inside and outside the scope of each priority disclosure, resolves the problem of poisonous priority and self-collision (as discussed in the commentaries Schulte/Moufang, Patentgesetz mit EPÜ, 9th edition 2014, §41, Rdnr 44 and Breimi in Singer/Stauder, EPÜ, 7th edition 2016, Art.87, Rdnrn 34,35). This approach amounts to re-instating the case law which prevailed before G 2/98.

An unequivocal "no" in answer to question 1 makes it unnecessary to answer questions 2 to 4.

- As to question 5 of the referral

A negative answer to question 1 has the consequence that question 5 too has to be answered in the negative. Adopting the "encompasses" test for partial priority means that the scope of the European claim will have partial priority to the extent that it encompasses priority content. So a conceptual part of the claim will always have the same effective date as the same content in a parent or divisional application, and one can never become prior art to the other under Article 54(3) EPC.

The appellant expressed the view that the Enlarged Board should nevertheless provide an interpretation of Articles 54(3) and 76(1) EPC in this respect, particularly in order to make it clear that, contrary to what has been argued by the respondent, the assessment of priority entitlement for a parent and for a divisional application is not to be performed independently, because the divisional enjoys any right of priority of its parent, provided only that the divisional does not extend beyond the content of the earlier application as filed.

VII. Arguments of the respondent

The respondent requested a positive answer to questions 1, 2 and 5, essentially for the following reasons.

The disclosure test as set out in G 2/98 for acknowledging partial priority does not allow a simple conceptual division of a generic "OR"-claim into two or

more parts, because this standard requires the application documents to disclose directly and unambiguously what the subject-matter of the claimed priority or priorities is. This is the way the disclosure test is understood for the purposes of Article 123(2) EPC. G 2/98 stated that the same standard should apply for the assessment of priority under Article 87(1) EPC in order to define how the notion of the "same invention" should be interpreted. This was later confirmed in G 1/03 (OJ EPO 2004, 413, Reasons, point 2.2.2) and G 2/10 (OJ EPO 2012, 276, Reasons, point 4.6).

The acknowledgement of partial priorities on the basis of subsumptions as in the conceptual approach would lead to contradictions because different standards would be used for novelty, added subject-matter and priority, in particular when two European applications conflicted with one another under Article 54(3) EPC.

Moreover, a negative answer to question 1 would lead to systematically acknowledging priority rights without any individual examination. However, G 2/10 (supra, Reasons, point 4.5.3) made it clear that potential embodiments or intermediate generalisations, although falling within the ambit of the general teaching, cannot be seen as implicitly disclosed on the sole basis of schematic reasoning.

The proviso laid down in G 2/98 (supra, Reasons, point 6.7) must be seen as an expression of the requirement for a direct and unambiguous disclosure in the priority document of the subject-matter of the claim of the subsequent application. This proviso means that in

order for a partial priority to be acknowledged only a limited number of clearly defined alternative embodiments can be distinguished by a skilled person within the ambit of the generic feature. This is the case in example a) of the Memorandum because of the limited number of existing halogens, namely F, Cl, Br, I and At, so that nothing prohibits the acknowledgement of partial priority for Cl. By contrast, examples b) and c) of the Memorandum do not clearly define what all the possible alternatives included in the generic feature are, so that the required direct and unambiguous disclosure is missing.

The Memorandum does not have the force of law. It expresses the view prevailing in 1973, and the only conclusion that may be drawn from it today is that the legislator wished to create the possibility of claiming partial priority. However, the scope of this possibility has become limited due to developments in the case law in the meantime.

Article 4F of the Paris Convention entitles an applicant to claim priority for a patent claim of a subsequent application even if it contains additional features or subject-matter as compared to the priority application and excludes the application to be refused on that ground. However, it does not give an applicant the possibility to claim priority for a patent claim of a subsequent application whose subject-matter was not disclosed in the priority application. Hence, Article 88(3) EPC is consistent with Article 4F of the Paris Convention.

A negative answer to question 1, as many amicus curiae briefs advocate, would mean that partial priority should be acknowledged without any conditions or test. Moreover, there was no explanation why the priority right should be derived from the scope of protection of the priority document, when the EPC and the case law provide that the disclosure of the priority document is the determining factor.

Consequently, the respondent took the view that the answer to question 2 should also be positive and, with regard to question 3, that the proviso of a "limited number of clearly defined alternative subject matters" has to be interpreted to mean that partial priority should not be acknowledged if it places an undue burden on the skilled person to be able to distinguish the possible alternatives within a generic "OR"-claim, or if more than one generic feature is encompassed in the claim, or if the generic feature is represented by ranges of values or domains of use.

On question 5, the respondent argued in substance that a consistent body of case law has developed which considers that, once a divisional application has been validly filed, it becomes separate from and independent of the parent application. Parent and divisional thus have no particular relationship to each other which could justify not applying Article 54(3) EPC. In this respect, some amicus curiae briefs expressed the view that in the case of a parent and a divisional application with the same disclosure and having the same priority right, no collision could ever occur. The respondent emphasised that such collision is not ruled out and results from amendments made during the

priority interval, with the consequence that some parts of the description enjoy the priority date while other parts only enjoy the filing date. In other words, such collision can only occur as a consequence of an invalid priority claim. However, this situation is solely the responsibility of the applicant who made the amendments leading to it, even though other options were open to him.

VIII. Comments of the President of the European Patent Office

Focusing on the historical background to Article 88(2) and (3) EPC, the President of the European Patent Office concluded that these provisions are based on Article 4F of the Paris Convention and that partial priority is a variant of multiple priorities for which no additional requirements apply. The Paris Convention does not cover the situation of multiple priorities for a single claim. However, the Memorandum suggests that entitlement to priority for generic "OR"-claims should be facilitated as much as possible. In particular, no requirement to spell out alternative subject-matters as such in a claim can be derived from the travaux préparatoires. A thorough analysis of board of appeal decisions concerning the way in which priority rights are to be assessed, in particular where partial priority is claimed for a generic "OR"-claim, showed a persistent divergence in the case law, although the Enlarged Board has repeatedly stated that the fundamental test for determining whether subject-matter enjoys priority is the "gold standard" disclosure test. Hence, the same test applies consistently to Articles 54, 76(1), 87 to 89 and 123(2) EPC.

With regard to the impact of the present referral, the President of the Office stressed that the priority right is a core element of the European patent system and that legal certainty is of paramount importance for all stakeholders in all fields of technology, but especially so in chemistry and pharmaceuticals, where the definition of (bio-)chemical subject-matter poses particular difficulties (Markush-type claims or continuous ranges of numerical values). The need to clarify whether the examples of the Memorandum continue to be authoritative for the interpretation of Article 88(2), second sentence, and (3) EPC and what the exact meaning and application are of the phrase "a limited number of clearly defined alternative subject-matters" in G 2/98 is especially great in these fields. A further aspect is the burden of substantiation in identifying alternative subject-matters within a generic "OR"-claim, which seems to lie with the applicant, who is claiming the benefit of the right of priority. Having considered decisions issued by courts of EPC contracting states, the President of the Office observed that the case law is still evolving with regard to the requirements for ascertaining "the same subject-matter" under the provisions of Articles 87 to 89 EPC, with some courts adopting a broad approach and others appearing to be sceptical of a generic "OR"-claim's entitlement to partial priority for alternatives not spelt out as such in the claim. Moreover, some courts favour the application of the same disclosure standard for the assessment of novelty, added subject-matter and priority, whereas others seem to apply the test for novelty and added subject-matter only to a limited extent to priority. The same divergence appears in the literature.

The President of the Office concludes that acknowledging a generic "OR"-claim to be capable of enjoying partial priority for subject-matter that it encompasses "either in the form of a generic term or formula, or otherwise" does not appear to be compatible with the requirement to spell out alternative subject-matters, and that therefore the strict approach adopted by some boards of appeal seems to be at odds with the Enlarged Board's jurisprudence. At the same time, the broader approach may be too abstract in the light of the requirement of "the claiming of a limited number of clearly defined alternatives" and thus the burden on the public to identify a large number of alternatives should be taken into account.

With respect to question 5, the President's view was that it should be answered in the negative. To do otherwise would go against the purpose and function of divisional applications in the patent system.

IX. Arguments in the amicus curiae briefs in favour of a positive answer to question 1

The main arguments put forward in the amicus curiae briefs in favour of a positive answer to question 1 are the following:

- Partial priority is a concept not mentioned expressly in either the Paris Convention or the EPC. Therefore the notion of "the same invention" has to be interpreted narrowly, taking into account the proviso of unity of invention laid down in Article 4F of the

Paris Convention and the strict approach adopted in G 2/98 (supra, Reasons, point 6.7).

- With regard to the "conceptual" approach taken in decision T 1222/11, giving up a "literal" reading of the proviso of "claiming a limited number of clearly defined alternative subject-matters", which is understood to mean claiming such subject-matters in express terms, would lead to legal uncertainty for the users of the European patent system. In the case law of the Enlarged Board it has been emphasised that the basic idea of Article 123(2) EPC is that an applicant cannot be allowed to improve its position by adding subject-matter not disclosed in the application as filed (G 1/03; G 3/89, OJ EPO 1993, 117). In the same way, G 2/98 explained that a narrow or strict interpretation of the concept of the "same invention" is necessary to ensure a proper use of priority rights in full conformity inter alia with the principles of equal treatment of the applicant and third parties, legal certainty and consistency in the assessment of novelty and inventive step (Reasons, point 9). These principles of equal treatment and legal certainty thus also apply to Articles 87 and 88 EPC, so that in assessing partial priority it has to be investigated whether no unwarranted advantage is given to the applicant or patentee that could diminish certainty for third parties. This aspect was not given sufficient attention in decision T 1222/11. If the claims of the subsequent application are directed to broadened ranges of components A, B and C as compared to the priority document, without containing a description of the composition disclosed in the previous application, the public cannot be aware that this specific composition

is a crucial embodiment according to the invention described in the subsequent application claiming priority. In the same way, the applicant could also claim priority for a different selection of components A and B, where the priority document disclosed A, B and D, the last component D being omitted. The conceptual approach could lead to allowing an arbitrary division of the claimed subject-matter that did not need to have a basis in the application as originally filed. The finding of the case law that a priority application is not a reservoir for amending the claims would be disregarded, as would the principles laid down with respect to selection inventions.

- If acknowledgement of partial or multiple priorities is seen as a remedy against "self-collision" between a priority document claiming a species and a subsequent application claiming a genus, in such circumstances the priority should be recognised only in combination with measures designed to avoid double patenting and allow for proper delimitation, within the generic claim of the subsequent application, of the subject-matters disclosed in the respective priority documents in order to be able to distinguish between different embodiments claiming different priority dates.

It was suggested that, in order to avoid double (or multiple) patenting, a disclaimer should be introduced into the claims of the subsequent application excluding the species disclosed in the priority document, on the basis of either G 1/03 or G 2/10, depending on whether or not the subsequent application disclosed the specific subject-matter filed earlier.

In cases in which partial priority was to be acknowledged it was suggested that

- the self-collision problem would be solved by excluding the more specific subject-matter from the state of the art pursuant to Article 54(3) EPC
- the subject-matter of the priority document should be disclosed in the subsequent application.

X. Arguments in the amicus curiae briefs in favour of a negative answer to question 1

Most amicus curiae letters argued in favour of a negative answer to question 1. Given the outcome of the referral, it does not appear necessary to set out the arguments developed in these briefs.

Reasons for the Decision

1. Admissibility of the referral

The jurisprudence of the boards of appeal clearly takes two different lines on a point of law of fundamental importance, namely the issue of partial priority.

The requirements laid down in Article 112(1)(a) EPC are thus complied with, in that a decision of the Enlarged Board is necessary to ensure a uniform application of the EPC. This is common ground between the parties.

2. Context of the referral

2.1 A new line denying partial priority has emerged on the basis of the Enlarged Board's statement in G 2/98, supra, Reasons, point 6.7, which reads as follows:

"As regards the "OR"-claim (...) it is held in the memorandum that where a first priority document discloses a feature A, and a second priority document discloses a feature B for use as an alternative to feature A, then a claim directed to A or B can enjoy the first priority for part A of the claim and the second priority for part B of the claim. It is further suggested that these two priorities may also be claimed for a claim directed to C, if the feature C, either in the form of a generic term or formula, or otherwise, encompasses feature A as well as feature B. The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2) EPC, second sentence, 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**" (our emphasis).

2.2 In a number of decisions of the boards of appeal, the last part of the third sentence, quoted above in bold, has been taken as a ground for refusing partial priority for a generic "OR"-claim. It is convenient to reproduce here the summaries of these decisions which were set out in the Reasons for decision T 557/13 of the referring board.

Broadening of generic chemical formulae

In case T 1127/00, claim 1 was directed to a generic formula covering a great number of alternative compounds. The board noted that the alternative compounds were not, as such, spelt out in the claim, and held that the fact that they might be intellectually envisaged to fall within the scope of the claim did not make up for a clear and unambiguous presence of these alternatives, individualised as such, in the claim. Claim 1 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. Thus, claim 1 could not enjoy partial priority from a priority document, but could only be entitled to the priority date of the document where the generic formula was disclosed for the first time. This was not the first priority document, as it disclosed only more specific synthetic ribozymes. Although these were covered by the general formula of claim 1, there was no direct and unambiguous disclosure in the priority document of the broad generic group as represented by that formula. Thus, claim 1 did not enjoy the first priority date (Reasons, points 5 to 7).

In case T 2311/09 (Reasons, points 2 to 4), claim 1 was directed to eotaxin proteins comprising an amino acid sequence having "at least 40% identity" with a given sequence and encompassing variants which were not disclosed in either priority document. Hence, priority was not acknowledged for the whole claim. Nor was partial priority acknowledged to the extent that the claim encompassed proteins having 100% sequence

identity, although this sequence appeared to be disclosed in a priority document. In this respect, the board held that claim 1 did "not comprise a limited number of clearly defined alternative subject-matters (cf. G 2/98, Reasons, point 6.7)".

Broadening of chemical compositions

In case T 184/06, (Reasons, point 6), partial priority was not acknowledged although the claim encompassed compositions disclosed in the priority document in narrower terms (narrower alkoxylation range of a component; additional component). The board found that the combination of features of claim 1 could not be derived directly and unambiguously from the priority document (Article 87(1) EPC and G 2/98, Headnote and Reasons, point 9). Moreover, claim 1 related to a composition of matter characterised by a combination of features which could not be regarded in isolation from each other. This subject-matter encompassed "everything falling within its scope defined by its essential features" and did "not relate to specific distinct alternatives having different scope for which different priorities could be claimed" (Article 88(2) and (3) EPC).

In case T 1443/05, claim 1 was directed to a composition comprising two components, the presence of a specific third component considered disadvantageous being excluded by a disclaimer. Priority was claimed from an earlier European application which exemplified compositions comprising the first two components and not comprising the third, but which also mentioned the possibility of incorporating the third. The board

concluded that the subject-matter of claim 1 did not concern the same invention (Article 87(1) EPC) as that disclosed in the priority document. Hence, the claimed priority date was denied for the claim as a whole (Reasons, point 4.1.11). Moreover, with reference to G 2/98 (Reasons, point 6.7), it was held that, although the examples of the priority document were encompassed by claim 1, the claim's generic wording did not permit any unambiguous alternative covering the examples to be identified (Reasons, point 4.2.6). The compositions exemplified in the European application whose priority was claimed, which did not contain the third component, were thus held to be novelty destroying under Article 54(3) EPC.

Broadening of ranges of values

In case T 1877/08, claim 1 was directed to a blend of three components present, respectively, in the relative amounts of 30 to 65 / 1 to 10 / 33 to 69 weight-%. The patent claimed priority from a US application disclosing a blend containing the same three components in more narrowly defined amounts, namely 30 to **55** / **2** to 10 / **35** to **65** weight-%, respectively (emphasis by the referring board). The board found that the combination of features of claim 1 could not be derived directly and unambiguously from the priority document (Article 87(1) EPC and G 2/98). The claimed amounts represented a continuum of a numerical range of values which did not correspond to distinctive alternative embodiments (Article 88(2) and (3) EPC). Consequently, no separable alternative embodiments, i.e. elements in the sense of Article 88(3) EPC, which could enjoy the priority date could be identified within that

continuum, and for these reasons priority was denied for claim 1 as a whole.

In case T 476/09, claim 1 was directed to a toner composition characterised inter alia by an average "circularity" (a physical characteristic) of the toner particles that was defined in terms of a continuous range "of 0.930 to 0.990" (emphasis by the referring board). Although the first priority document disclosed a toner with all the features of claim 1 at issue, but with a narrower circularity range "of 0.94 to 0.99", the board did not acknowledge even partial priority. The board found that the claimed range represented a continuum of a numerical range of values which did not correspond to distinctive alternative embodiments (G 2/98, Reasons, point 6.7, and T 1877/08). Thus, no separable alternative embodiments could be identified within this continuum which could enjoy the priority date.

Other generalisations

In case T 1496/11, claim 1 of the (parent) patent was directed to a security document including a security device which comprised a functionally defined "feature (10) which can be inspected, enhanced or optically varied by the optical lens when ...". The priority document disclosed only a "printed or embossed" feature for this purpose. The board concluded (Reasons, point 2.1) that the claimed subject-matter had been generalised by omitting the more specific indication and thus encompassed security devices including features produced by other means. Hence, it did not constitute the same invention as that set out in the

priority document (Article 87(1) EPC). Consequently, the subject-matter of claim 1 was found to be only entitled to the filing date of the parent application upon which the patent had been granted. The board went on to conclude that the subject-matter of claim 1 lacked novelty under Article 54(3) EPC over an embodiment disclosed in its published European divisional application. This embodiment was identically disclosed in the priority document and was hence entitled to the priority date claimed. Therefore, it anticipated the subject-matter of claim 1 of the parent patent, which was not entitled to priority.

2.3 As can be seen from the above summaries, the broadening of a chemical formula, of a range of values, of chemical compositions, or the presence of other generalisations compared to the invention disclosed in an enabling manner in the priority document has led to partial priority being denied because the claim of the subsequent application did not spell out a limited number of clearly defined alternatives, even though the requirement of identity of invention was met for at least some alternative embodiments disclosed in the priority document and encompassed by the generic "OR"-claim.

2.4 A number of decisions issued since G 2/98 which, on the other hand, acknowledged partial priority in comparable circumstances were also summarised in the referring decision T 557/13.

In case T 135/01, claim 1 was directed to a method for driving an electric motor involving first and second current switching steps, whereby the switching interval

was defined as being in the range $\frac{1}{4} < \delta < \frac{3}{4}$. The board found (Reasons, point 5) that "for purposes of assigning priority, claim 1 ... was to be regarded as being split into a first notional part claim specifying a range for the switching interval of 'approximately = $\delta/2$ ', which was entitled to the priority date of the GB application ... [priority document], and a second notional part claim to the complementary range of $\frac{1}{4} < \delta < \frac{3}{4}$ punctured by the range of 'approximately $\delta/2$ ', which second part claim was entitled only to the priority of the actual filing date and for which therefore the intermediate publication D13 [conference proceedings] was prior art", since it also disclosed the range of "approximately = $\delta/2$ ". The board, without expressly referring to G 2/98 or addressing the criteria of point 6.7 of the Reasons, thus acknowledged partial priority for the narrower range disclosed in the priority document and encompassed, without being spelt out, in the broadened range of claim 1.

In case T 665/00, claim 10 was directed to a cosmetic powder containing hollow microspheres characterised inter alia by a "specific mass below 0.1 g/cm³", said range not being disclosed in the priority document. A novelty objection had been raised based on an alleged public prior use within the priority interval. Referring to Article 88(3) EPC and G 2/98 (supra, Reasons, point 6.7), the board held that different elements of a patent application could enjoy different priority dates and this was also applicable to a single claim encompassing alternatives and being, thus, separable into a plurality of subject-matters (Reasons, point 3.5). The board further held (Reasons, point 3.5.1) that the generic expression "specific mass

below 0.1 g/cm^3 " permitted defining a set of hollow microspheres, i.e. alternative possibilities of realising the invention, to which a priority date could, respectively, be attributed. The priority document exemplified powders comprising hollow microspheres "Expancel DE" having a specific mass value falling within the range defined in the claims. Among the alternatives encompassed by claim 10, those involving the powders comprising the microspheres "Expancel DE" thus enjoyed the priority date claimed. The invoked prior use, which involved a powder containing the same "Expancel DE" microspheres, could therefore not be novelty-destroying.

In this decision, partial priority was thus acknowledged for a generic "OR"-claim comprising as a generic expression a specific mass range which was not disclosed as such in the priority document and which represented a generalisation of the more specific disclosure in the examples of the priority document, more particularly of the implicitly disclosed specific mass value of the "Expancel DE" microspheres used. The finding that the claim was entitled to partial priority to the extent that the claim encompassed specific alternatives disclosed in the priority document was based on a mere comparison of the ambit of the claim with the content of the priority document. The decision contains no further specific comments in respect of the criteria "limited number" and "clearly defined" of G 2/98 (supra, Reasons, point 6.7).

In case T 1222/11 (Reasons, point 11), the board advocated, in an obiter dictum, the following

interpretation of the proviso in G 2/98, Reasons, point 6.7:

- This condition set out in G 2/98 could not be meant, as held in the cited decisions, to require that the subject-matter had to be defined in an "OR"-claim in a certain manner, such as to give "rise to the claiming of a limited number of clearly defined alternative subject-matters", as this would, at least in relation to generic terms, be at variance with the disclosure test based on the principle of an unambiguous and direct disclosure (G 3/89).

This conclusion was reached in view of the following:

- Point 6.7 of the Reasons concerned exclusively the question of claiming multiple priorities for one and the same "OR"-claim. The reference to Article 88(3) EPC thus meant that the Enlarged Board was indicating under what conditions the assessment required by Article 88(3) EPC could be made when the "OR"-claim was drafted using a generic term or formula.

- This assessment could be achieved only by a comparison of the claimed subject-matter of the "OR"-claim with the disclosure of the multiple priority documents.

- Therefore, in the context of this assessment, the wording "gives rise to the claiming of a limited number of clearly defined alternative subject-matters" referred to the ability to conceptually identify, by this comparison, such alternative subject-matters, to which the multiple rights of priority claimed could be

attributed or not. This was necessary in order to make it possible to identify which parts of the claim benefited from the effect of the priority right defined in Article 89 EPC.

Moreover, the last sentence of point 6.7 of the Reasons for G 2/98 complied with the Memorandum, which according to the Enlarged Board reflected the intent of the legislator concerning multiple priorities. Going through the examples illustrated in the Memorandum, the board indicated how the respective priorities could be acknowledged in each case, in compliance with G 2/98 (Reasons, 6.7). In particular, example c) of the Memorandum illustrated that attributing different priority dates was "not reserved only to claims which define on their own a limited number of clearly defined subject-matters" (Reasons, point 11.5.7). Furthermore, there was no reason why the condition of G 2/98 should be different when assessing entitlement to partial priority in relation to a single priority document (Reasons, point 11.6).

It was therefore concluded that the decision on whether priority could be acknowledged for subject-matter disclosed in the priority document and encompassed by an "OR"-claim did not depend on whether this subject-matter was expressly identified as a separate alternative in the claim.

Case T 571/10 expressly applied the approach developed in T 1222/11. Two alternative groups of subject-matters were identified (Reasons, point 4.5.14) as being encompassed by the claim, although not spelt out as such therein: alternative (a), concerning the use of a

specific composition (calcium salt of the active ingredient and tribasic phosphate salt in which the cation was multivalent), and alternative (b), concerning the use of a composition defined in more generic terms (acid form or acceptable salt thereof as the active, inorganic salt in which the cation was multivalent, wherein active ingredient and inorganic salt were other than calcium salt of the acid and tribasic phosphate salt in combination).

Alternative (a) was subject-matter disclosed in the priority document, not defined as such in the claim but encompassed by it. Alternative (b) was the remaining subject-matter of the claim, which was not disclosed in the priority document. The board found that the subject-matter of alternative (a) enjoyed priority whereas that of alternative (b) did not. Consequently, parallel European application D9, claiming priority from the same earlier application as the patent in suit and disclosing the same two alternatives (a) and (b), was found not to be state of the art under Article 54(3) EPC for alternative (a), because it did not have an earlier effective date. For alternative (b) D9 was prior art pursuant to Article 54(3) EPC, but not novelty-destroying, since alternatives (a) and (b) did not overlap.

3. Scope of the referral

It is clear from the referring decision that the divergence that has emerged in the case law has been caused by the proviso in point 6.7 of the Reasons of G 2/98. In particular, in a number of decisions the words "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-

matters" have been understood as a further test to be complied with for a claim to partial priority to be accepted. The Enlarged Board will analyse the relevant provisions of the EPC and corresponding provisions of the Paris Convention in order to assess whether the introduction of additional conditions and/or limitations is in line with the fundamental principles governing the right of priority. Accordingly, the Enlarged Board will consider first the nature, conditions and effects of the right of priority in general (see point 4 below) and then issues relating specifically to partial and multiple priorities (see point 5 below). Lastly, it will discuss whether additional conditions of a substantive kind apply and how the right of priority is to be assessed (point 6).

4. Legal framework of the priority right

4.1 Priority is a **right**

Article 87(1) EPC states:

"Any person who has duly filed, in or for

(a) any State party to the Paris Convention for the Protection of the Industrial Property or

(b) any Member of the World Trade Organization,

an application for a patent ... **shall enjoy**, for the purpose of filing a European patent application in respect of the same invention, **a right of priority** during a period of twelve months from the date of filing of the first application."

This wording corresponds to Article 4 of the Paris Convention, which states in its paragraph A(1):

"Any person who has duly filed an application for a patent ... in one of the countries of the Union ..., **shall enjoy**, for the purpose of the filing in the other countries, **a right of priority** during the periods hereinafter fixed."

4.2 Substantive condition of "the same invention"

Apart from formal requirements (such as filing of a declaration, identity of applicant, twelve-month period), the sole substantive condition laid down by the EPC (and the Paris Convention) for the right of priority to be validly claimed is that the priority document and the subsequent filing are directed to the same invention, Article 87(1) EPC. Article 4C(4) of the Paris Convention mentions "the same subject". However, the meaning is undoubtedly identical.

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.

4.3 Effects of the priority right

- 4.3.1 Article 89 EPC provides: "The right of priority shall have the effect that the date of priority shall count as the date of filing of the European patent

application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2."

- 4.3.2 This provision makes it clear that the right of priority is intended to protect the applicant against third parties filing a patent application in respect of the same invention during the twelve-month period after the first filing. It has to be read in conjunction with Article 60(1) and (2) EPC, which define entitlement to the grant of a European patent: this right belongs to the inventor and, in the case of conflict, to the person who filed first.
- 4.3.3 Provided that the application claims the same invention as that disclosed in the priority document, the subject-matter which enjoys the priority right cannot be considered state of the art under Article 54(2) or (3) EPC against that application. The relevant provisions (Articles 89 and 54 EPC) are thus consistent with one another. The fiction that the subsequent application is deemed to have been filed on the date of the first filing - to the extent that it relates to the same subject-matter as the first filing - provides a sort of barrier designed to prevent third parties from interfering with the applicant's right to obtain protection for the claimed subject-matter which it first disclosed in the previous application. As a consequence, what is true for third parties is equally true for the applicant itself.
- 4.3.4 Consequently, the only circumstance in which a novelty objection can succeed is where priority cannot be recognised.

In G 3/93 (OJ EPO 1995, 18), the Enlarged Board already stated that: "Article 89 EPC deals with the effect of possessing a right to priority on the premise that the conditions precedent to having that right have been satisfied, including the requirement that the inventions be the same... Where priority is claimed but cannot be allowed because the essential condition precedent, that the inventions are the same, is not met, there is no right to priority. In consequence, any publication of the contents of the priority document in the interval between the filing thereof as a patent application, and the filing of the European patent application claiming priority therefrom, constitutes prior art citable against elements of the European patent application which are not entitled to priority" (Reasons, points 8 and 9).

4.3.5 Article 4B of the Paris Convention establishes the effects of the right of priority as follows:

"Consequently, any subsequent filing ... **shall not be invalidated by reason of any acts accomplished in the interval**, in particular, another filing, the publication or exploitation of the invention, ... and such acts cannot give rise to any third-party right or any right of personal possession ...".

In his Guide to the Application of the Paris Convention (edition 1967), pages 41 and 42, Bodenhausen commented in connection with this provision that "the effect of the subsequent filing must not be less than it would have been had that filing been effected at the time of the first filing ... on which the right of priority is based", and further explained that neither another

filing nor a publication or exploitation of the invention, "whether by the person who filed the first application or by third parties during the period of the priority right [will] invalidate or prejudice the subsequent filing for which the right of priority is claimed; particularly, it will neither destroy the novelty of the invention nor diminish the inventive step embodied in it, as considered at the date of the first application on which the right of priority is based."

The same understanding was expressed by Mathély as follows in "Le Nouveau Droit Français des Brevets d'Invention", 1992, at pages 596 and 597, in the chapter dedicated to Union law: "La priorité accorde au brevet correspondant une **immunité** contre les faits de divulgation et d'usurpation qui peuvent s'être produits depuis la première demande prioritaire". Furthermore, "la priorité met l'inventeur à l'abri, non seulement des antériorités des tiers, mais encore de sa propre divulgation".

These authors have chosen clear and strong terms to define the ambit of the right of priority.

- 4.4 It can thus be concluded both from the wording of the law and from the logic of the underlying concept that the right of priority as established in the EPC (and the Paris Convention) operates to exclude the collision of subject-matter disclosed during the priority period with identical subject-matter disclosed in a priority document, in so far as priority has been validly claimed.

5. Partial and multiple priorities

5.1 The EPC provisions

5.1.1 The relevant provisions for both partial and multiple priorities are to be found in Article 88(2) and (3) EPC.

Article 88(2) first and second sentences, EPC provide: "Multiple priorities may be claimed in respect of a European patent application, notwithstanding that they originate in different countries. Where appropriate, multiple priorities may be claimed for any one claim."

Article 88(3) EPC lays down: "If **one or more** priorities are claimed in respect of a European patent application, the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed."

In fact, paragraphs 2 to 4 of Article 88 EPC correspond to Articles 4F and 4H of the Paris Convention, though with the express provision that multiple priorities may be claimed for any one claim (Article 88(2), second sentence, EPC).

5.1.2 Article 88(3) EPC is to be interpreted in such a way that the right of priority embraces situations where only part of the subsequent application (e.g. part of the subject-matter encompassed by a claim) can enjoy priority from the one or more priority applications. The elements which can be directly and unambiguously derived from the one or more priority applications constitute what may benefit from partial priority, the

rest of the elements disclosed in the subsequent application establishing, by themselves, a priority for a further subsequent application.

The term "elements" used in Article 88(3) EPC (see also Articles 4F and 4H of the Paris Convention) is not to be understood as a single feature but as subject-matter such as that defined in a claim or disclosed in the form of an embodiment or example specified in the description (see G 2/98, supra, Reasons, points 4 and 6.2).

Article 88(3) EPC refers to a plurality of elements which may have been "included" (disclosed) in one or more priority documents. Each of the disclosed "elements" may benefit from the priority of the priority document in which it has been disclosed. Under Article 88(3) EPC, it does not matter whether all elements encompassed by a claim are disclosed in the same priority document or in a plurality of priority documents, the latter situation being referred to as "multiple priorities" in Article 88(2), first sentence, EPC.

- 5.1.3 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 encompassed by the claim or claims. This principle applies for each individual element disclosed in any priority document. It does not matter whether partial priority is claimed for one element in one priority document only, for a plurality of elements disclosed in one priority document (first situation addressed in Article 88(3) EPC), for a

plurality of elements disclosed in more than one priority document (second situation addressed in Article 88(3) EPC) or for a plurality of elements disclosed in a plurality of priority documents (situation addressed in Article 88(2), second sentence, EPC). It is also 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. The situation where one claim encompasses elements disclosed in a plurality of priority documents is specifically addressed in Article 88(2), second sentence, EPC.

In view of the wording of Article 88(2) and (3) EPC alone, the argument that partial priority is a concept not present in the European patent system cannot hold.

5.2 The historical documentation relating to the EPC, including the Memorandum, which can be said to express its intent (G 2/98, Reasons, point 6.4), allows for a confirmation of the present interpretation.

5.2.1 Travaux préparatoires to the EPC 1973 - FICPI
Memorandum C (M/48/I)

With respect to multiple priorities for one and the same claim, the Memorandum draws an important distinction between two different types of claim:

- Type A+B claim ("AND"-claim, claim too narrow to be supported by the disclosure of the first priority document); and

- Type A or B claim ("OR"-claim, claim too broad to be supported by the disclosure of the first priority document).

Concerning "AND-claims", the Memorandum explains that such a situation occurs when "a first priority document discloses a feature A and a second priority document discloses a feature B to be used together with A, then a claim directed to A+B cannot enjoy a partial priority from the first priority date, because the invention A+B was disclosed only at the date of the second priority document."

Concerning "OR"-claim situations, which form the context of the present referral, the Memorandum states that "if a first priority document discloses a feature A, and a second priority document discloses a feature B for use as an alternative to A, then a claim of the application directed to A or B will in fact consist of two distinct parts A and B respectively, each complete in itself, and there seems to be no reason why it should not be possible to claim the first priority for part A of the claim and the second priority for part B of the claim". In this connection, the Memorandum also points out that "it is of course immaterial whether the word 'or' actually occurs in the claim, or is implied through the use of a generic term or otherwise".

The Memorandum includes examples illustrating "OR"-type situations in which it would be desirable to be able to claim multiple priorities for one and the same claim:

a) broadening of chemical formulae;

- b) broadening of a numerical range of values (temperature, pressure, concentration, etc.); and
- c) broadening of a field of use.

Such an "OR"-claim would then enjoy priority

- from the first priority date to the extent that it encompasses the narrowly defined subject-matter disclosed in the first priority document, and
- from the second priority date for the rest of its scope.

As regards **partial priority**, the Memorandum points out:

- "the claiming of partial priority should of course be governed by the same principles as those explained above for the claiming of multiple priorities", and
- "it would be appropriate to claim a partial priority in situations corresponding to the "OR"-situation dealt with under 'Multiple Priorities', the European patent application itself taking the place of the second priority document".

The Memorandum also indicates advantages of allowing multiple and partial priorities, including the avoidance of claim proliferation and possible disadvantages in national post-grant procedures.

On its last page, the Memorandum makes it clear that accepting multiple and partial priorities is not the same as allowing amended claims in such a manner that,

after amendment, only one priority is claimed for each individual claim. The issue of partial priority would not arise if only one priority was claimed for each individual claim. However, amending a claim set in such a way that an originally filed claim is split up in order to address partial priorities may in many situations be unallowable under Article 123(2) EPC.

- 5.2.2 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, allowing the claiming of multiple priorities for one and the same claim.

As a consequence, the interpretation given in points 5.1.1 to 5.1.3 above is consistent with the Memorandum.

- 5.2.3 This interpretation is also confirmed by the Paris Convention.

It is well established case law that the EPC constitutes, according to its preamble, a special agreement within the meaning of the Paris Convention. Articles 87 to 89 EPC, which provide a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application (cf. J 15/80, supra), are thus clearly intended not to contravene the basic principles concerning priority laid down in the Paris Convention (cf. T 301/87, OJ EPO 1990, 335, Reasons, point 7.5).

Under Article 4F of the Paris Convention, priority **may not be refused** on the ground that the applicant claims multiple priorities, or on the ground that an application claiming one or more priorities contains one or more **elements that were not included** in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country. With respect to elements not included in the priority application(s), "the filing of the subsequent application shall give rise to a right of priority under ordinary conditions" (Article 4F, second paragraph, Paris Convention).

The second ground contained in this provision concerns in particular the possibility of partial priority and was added in 1958 in order to address the frequent situation that the invention is developed further after the first filing and during the twelve-month period for claiming priority (cf. Bodenhausen, *supra*, page 54, point e)).

5.3 It is thus to be concluded 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.

6. Assessment of the same invention

- 6.1 The basis for acknowledging priority is to be found in Article 88(4) EPC, which provides: "If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the documents of the previous application as a whole specifically disclose such elements."

Article 4H of the Paris Convention uses substantially the same wording: "Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements."

- 6.2 In G 2/98, the Enlarged Board defined at a general level how the concept of "the same invention" is to be understood. The Enlarged Board's conclusion reads as follows:

"The requirement for claiming priority of the "same invention", referred to in Article 87(1) EPC, means that priority of a previous application in respect of a **claim** in a European patent application in accordance with Article 88 EPC is to be acknowledged **only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole.**"

The Enlarged Board thereby adopted a strict approach to the definition of the concept of "the same invention"

in order to unify the case law in this respect (Reasons, point 5) and to maintain consistency between the different fundamental elements of patent law by bringing the way in which priority is assessed into line with the approach used to assess whether the requirements of Article 123(2) EPC and the requirements for novelty are fulfilled.

The Enlarged Board's conclusion accords with its later expression of the need for a consistent approach in G 1/03, where it stated in point 4 of the Reasons that "... the extent of the right to priority is determined by, and at the same time limited to, what is disclosed in the priority application. In order to avoid any inconsistencies, the disclosure as the basis for the right to priority under Article 87(1) EPC and as the basis for amendments in an application under Article 123(2) EPC has to be interpreted in the same way." The Enlarged Board took the same approach more recently in G 2/10 (supra, Reasons, point 4.6). In this way it has consolidated the case law in order to create a consistent system.

6.3 The statement of the Enlarged Board in G 2/98 (supra, Reasons, point 6.7) was made in the context of multiple priorities claimed for one and the same claim. The present referral concerns the situation of partial priority, the expression "partial priority" being understood to refer to the situation in which only a part of the subject-matter encompassed by a generic "OR"-claim is entitled to the priority date of an earlier application.

6.4 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.

6.5 This also corresponds, logically and exactly, to the scheme described in the Memorandum (see point 5.2 above): "If a first priority document discloses a feature A, and a second priority document discloses a feature B for use as an alternative to feature A, then a claim of the application directed to A or B will in fact consist of two distinct parts A and B respectively, each complete in itself...", and further: "... it would be appropriate to claim a partial priority in situations corresponding to the "OR"-situation under "Multiple Priorities", the European patent application

itself taking the place of the second priority document".

6.6 The task of determining what is the relevant disclosure of the priority document taken as a whole, and whether that subject-matter is encompassed by the claim in the subsequent application, is common practice in the EPO and among practitioners of the European patent system and as such should not pose any additional difficulty. Nor does it create uncertainty for third parties, as argued by the respondent and in some amicus curiae briefs. Although it can be a demanding intellectual exercise, the decisions reached in cases T 665/00, T 135/01, T 571/10 and T 1222/11 all show that it can be carried out without any need for additional tests or steps.

6.7 From this analysis it follows that the **assessment** of entitlement to partial priority right does not show that any additional requirements are needed.

7. Conclusion

It follows from the above that question 1 is to be answered in the negative.

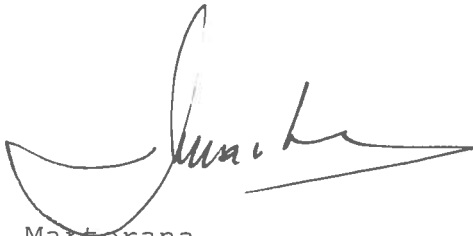
As a consequence, questions 2, 3, 4 and 5 need not be dealt with.

Order

For these reasons, it is decided that the questions of law which were referred to the Enlarged Board of Appeal are to be answered as follows:

Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR"-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect.

The Registrar:



P. Martorana

The Chairman:



W. van der Eijk



B₂
10950.D
FB