



Internal distribution code:

- (A) Publication in OJ
- (B) To Chairmen and Members
- (C) To Chairmen

O P I N I O N
of 31 May 2001

Case Number: G 0002/98

Headword:

Requirement for claiming priority of the "same invention"

Relevant legal provisions:

EPC Art. 54(2), (3), 56, 60(2), 83, 84, 87(1), (4), 88(2), (3),
(4), 89, 93, 112(1)(b), 123(2), (3)
Paris Convention Art. 4A(1), 4C(4), 4F, 4H, 19
RPEBA Art. 11b

Keyword:

"Interpretation of the concept of "the same invention" referred
to in Article 87(1) EPC"
"Consistency of the interpretation with the Paris Convention
and the EPC"
"Conformity of the interpretation with principles of equal
treatment and legal certainty and with the requirement of
consistency as regards assessment of novelty and inventive
step"

Decisions cited:

G 0001/93, G 0003/93, T 0116/84, T 0184/84, T 0016/87,
T 0085/87, T 0295/87, T 0301/87, T 0073/88, T 0255/91,
T 0582/91, T 0311/93, T 0669/93, T 1056/93, T 0364/95,
T 0077/97, J 0015/80

Headnote:

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.



Case Number: G 0002/98

O P I N I O N
of the Enlarged Board of Appeal
of 31 May 2001

in relation to a point of law referred by
the President of the European Patent Office
pursuant to Article 112(1)(b) EPC

Composition of the Board:

Chairman: P. Messerli
Members: W. Moser
C. Andries
G. Davies
J.-C. Saisset
R. Teschemacher
E. Turrini

Summary of the Proceedings

I. On 29 July 1998, the President of the EPO, making use of his power under Article 112(1)(b) EPC, referred the following point of law to the Enlarged Board of Appeal:

- "1a) Does the requirement of the "same invention" in Article 87(1) EPC mean that the extent of the right to priority derivable from a priority application for a later application is determined by, and at the same time limited to, what is at least implicitly disclosed in the priority application?
- 1b) Or can a lesser degree of correspondence between the priority application and the subject-matter claimed in the later application be sufficient in this respect and still justify a right to priority?
- 2) If question 1b) is answered in the affirmative, what are the criteria to be applied in assessing whether the claim in the later application is in respect of the same invention as is in the priority application?
- 3) In particular, where features not disclosed, even implicitly, in the priority application have been added in the relevant claim of the later application, or where features defined in broader terms in the priority application have been more specifically or more narrowly defined in the later application, can a right to priority nevertheless be derived from the priority application and, if so, what are the criteria which must be met to justify the priority in such cases?"

II. In the reasons for his referral, the President of the EPO pointed to conflicting decisions of the boards of appeal on the above point of law and in essence put forward the following arguments.

(i) Traditionally, the scope of the right to claim priority from a previous first application had been regarded by the EPO as determined by, and limited to, the extent to which the subject-matter claimed in the later application had been at least implicitly disclosed in the first application (cf. decisions T 116/84 of 28 November 1984 [not published in the OJ EPO], point 2 of the reasons; T 184/84 of 4 April 1986 [not published in the OJ EPO], points 2 and 3 of the reasons; T 85/87 of 21 July 1988 [not published in the OJ EPO], points 3 and 4 of the reasons; T 295/87 "Polyetherketones/ICI" [OJ EPO 1990, 470], points 6.2 and 6.4 of the reasons).

(ii) The above principles had been considered to apply not only where the claims of the later application had been broadened in relation to the disclosure of the previous filing, but also where in terms of scope of the protection the invention was more narrowly defined in the European patent application than in the broader disclosure of the previous application. According to this case law, the criterion of at least implicit disclosure used for the novelty test under Article 54(2) and (3) EPC and the disclosure test under Article 123(2) EPC were considered also to apply to cases where the claims of the European patent application contained one or more additional features over the disclosure of the invention in the priority application, or where features had been defined in a more specific way than the more general

disclosure in the priority application. It was regarded as irrelevant in this context whether the previously undisclosed added features were essential elements of the claimed invention or not, although it had always been clear that priority could not be claimed if essential features of the invention were missing in the priority application, or if they were omitted in the European patent application as compared with the priority application.

- (iii) This approach had been based on the consideration that, according to the EPC, the right to, and the limits of, patent protection obtainable by an applicant were decisively linked to the disclosure in an application filed at a certain date. Pursuant to Article 60(2) EPC, the right to the European patent belonged to the person whose application had the earliest date of filing, and not to the person having made the invention first. Pursuant to Article 54(3) EPC, such an application was considered state of the art against a later application even if the later applicant had in fact been the first inventor. According to Article 123(2) EPC, the patent protection available to an applicant was determined by, and limited to, the disclosure made in the application as filed, i.e. on the filing date. Therefore, according to the traditional view, the same should apply to the determination of the extent of a right to priority derivable from a previous first filing. This principle was considered to be reflected in Article 88(3) EPC, which provided that, in the case of one or more priorities, the right of priority covered only

those elements which were included in the application or applications whose priority was claimed. It was also seen as being derivable from Article 88(4) EPC.

- (iv) By way of contrast, in decision T 73/88 "Snackfood/HOWARD" (OJ EPO 1992, 557) the priority of a previous first filing for a main claim had been recognised, although the latter contained a technical feature (additional feature) which had not been disclosed in the priority application. It was held that the feature was not related to the function and effect, and hence to the character and nature, of the invention. Thus, its absence from the disclosure of the priority document did not cause loss of priority, provided that the claim was otherwise in substance in respect of the same invention as that disclosed in the priority document. A technical feature which was an essential feature for the purpose of determining the scope of protection conferred (i.e. which limited the claimed protection) was not necessarily an essential feature for the purpose of determining priority. Whether a particular feature was essential for the purpose of priority and, therefore, needed to be specifically disclosed in the priority document depended upon its relationship to the character and nature of the invention. In particular, if a technical feature was a more specific embodiment of a feature which was more generally disclosed in the priority document, there was no loss of priority, provided that the inclusion of such more specific technical feature did not change the character and nature of the claimed invention. Moreover, the precise reason why the feature had been added to the claims of the

European patent application, e.g. to establish the novelty of the claimed subject-matter over the prior art, was in principle irrelevant to the determination of priority. An approach only considering whether or not the claimed feature had specifically (albeit implicitly) been disclosed in the priority application was too narrow and literal for determining a right to priority and did not conform to the requirement of Article 87(1) EPC.

This decision had subsequently been approved and followed by others, for instance in decisions T 16/87 "Catalyseur/PROCATALYSE" (OJ EPO 1992, 212), T 582/91 of 11 November 1992 (not published in the OJ EPO), T 255/91 "Priority/AIR PRODUCTS AND CHEMICALS" (OJ EPO 1993, 318), T 669/93 of 13 February 1995 (not published in the OJ EPO), T 1056/93 of 16 January 1996 (not published in the OJ EPO) and T 364/95 of 20 November 1996 (not published in the OJ EPO). In decision T 16/87, the patentee had acknowledged that the added feature had been included in the claim simply to delimit it better from a prior national right. In decisions T 582/91 and T 364/95, as well as in decision T 73/88, the added feature had simply been treated as a "voluntary" limitation of the scope of the claim which did not represent an essential element of the subject-matter of the claim. The validity of the priority was also made dependent on the examination as to whether a particular effect or function could be attributed to the modified or specified feature.

- (v) In other decisions, the boards of appeal continued to apply the traditional approach: the so-called "novelty test". The term "novelty

test" was a key-word serving to distinguish this approach from the approach in decision T 73/88. However, this method of examining the validity of a claimed priority did not correspond in every respect to the examination as to novelty, if the priority document were state of the art against the claim under consideration. In fact, there could be cases, e.g. where the claim had been broadened in the later application as compared to the more specific disclosure of the priority application, where the claim would not be novel with respect to the more specific disclosure of the priority document, but nonetheless priority could not be validly claimed for the broader claim in the later application (cf. for example decision T 77/97 of 3 July 1997 [not published in the OJ EPO], points 6.4 and 6.5 of the reasons).

Thus, what was meant in reality by the term "novelty test" was a "disclosure test", i.e. for the examination of the validity of the claimed priority the explicit and implicit disclosure of the priority application had to be determined.

- (vi) From opinion G 3/93 "Priority Interval" of the Enlarged Board of Appeal (OJ EPO 1995, 18), it could be deduced that the Enlarged Board of Appeal regarded a claimed combination consisting of the features A+B+C as being an invention different from a combination only containing the elements A+B, irrespective of the nature of the added element.
- (vii) In decision T 77/97, it had been stated that the term "same invention" in Article 87(1) EPC had to be interpreted in conformity with Article 88(2) to (4) EPC, and in particular with

the requirement of Article 88(4) EPC that the elements for which priority was claimed had to be specifically disclosed in the priority application (as a whole). Therefore, in the case of a dependent claim characterised by additional elements which were not present in the respective independent claim, these additional elements had also to be specifically disclosed. It was not sufficient that the claim was supported by the disclosure in the priority document within the meaning of Article 83 EPC. It was even less sufficient that the specific dependent claim was embraced by the more general disclosure in the priority document. Rather, the relevant criterion to be applied in determining the validity of a claimed priority was the criterion of at least implicit disclosure in the priority document. The rules to establish such implicit disclosure were the same in all cases in which implicit disclosure had to be determined, and the result had to be the same irrespective of the nature of the document concerned.

III. In order to emphasise the importance of the point of law referred to the Enlarged Board of Appeal, the President of the EPO essentially put forward the following arguments.

- (i) The answer to the point of law referred to the Enlarged Board of Appeal would have an enormous impact not only on the applicant wishing to avail himself of the priority of one or more previous applications, but also on third parties affected by the priority date accorded to the European patent application. This applied in particular to the applicants of possibly conflicting applications.

- (ii) The reason given in decision T 73/88 that a patentee should not forfeit his claim to priority as a result of a mere reduction in the scope of protection, as compared to the disclosure in the priority document (cf. point 2.4 of the reasons), was plausible. However, the application of that approach could also turn out to be to the detriment of an applicant who, in relation to two previous national filings, uses the priority period as of the later national filing containing exactly the specific disclosure which he then claims in his European filing. This was because the definition of the concept of the same invention was also of importance for the examination as to which one of two or more previous applications constituted the first application for the same invention within the meaning of Article 87(1) EPC.

- (iii) Article 54(3) EPC was based on the principle that, when two applications concerned the same subject-matter, the right to the patent should belong to the application which had first disclosed such subject-matter. Whether a European patent application constituted state of the art, detrimental to the patentability of another application under Article 54(3) EPC, was therefore to be decided exclusively under novelty criteria. Consequently, if Article 89 EPC provided that, also as regarded Article 54(3) EPC, a validly claimed priority had to be taken into account, this evidently only fitted in with Article 54(3) EPC because, and to the extent that, the subject-matter had actually already been disclosed in the priority application.

- (iv) In determining which of two European patent applications had the earlier relevant date, it was in many cases of decisive importance whether or not the priority claimed had been validly claimed from the substantive point of view. The approach in decision T 73/88 made this dependent on the essentiality of the added feature. However, an extensive or broad interpretation of the concept of "the same invention" in accordance with that approach could lead to an unwarranted result. A European patent could be granted on the basis of a European patent application A, and a later-filed European patent application B claiming the same subject-matter could be refused. This could occur in spite of the fact that the previous patent application whose priority was claimed by the later-filed European patent application B had actually been the first application disclosing the claimed subject-matter.
- (v) According to the problem-solution approach, the problem solved by the invention under consideration was to be defined on an objective basis by determining the contribution the invention makes to the state of the art. Hence, the problem objectively solved by the invention could not be determined once and for all at any given point in time. On the contrary, it was possible that it had to be considerably redefined in the course of the prosecution of the application and even later, with every new piece of prior art later discovered having to be taken into account. Therefore, what appeared to be a negligible "side"-effect of the claimed invention at a certain point in time, could turn out later to be the (real) contribution which the invention makes to the state of the art. But

even in the absence of any new prior art, the definition of the problem objectively solved and of the essential nature of features could drastically change in the course of proceedings. Thus, like novelty and inventive step, the validity of the claimed priority could also be challenged over the whole lifetime of the patent, in particular on the basis of new prior art, as long as procedures so allowed.

The problem had to be regarded as particularly acute in fast-advancing technical fields such as biotechnology, where often many were directing their research at the same objectives and any improvement was immediately the subject of a patent application.

- (vi) For the interpretation of the Paris Convention for the Protection of Industrial Property (Paris Convention), in particular Article 4A(1) thereof, it was generally held that the subsequent filing had to concern the same subject-matter as the first filing on which the right of priority was based.

IV. Several statements by third parties pursuant to Article 11b of the Rules of Procedure of the Enlarged Board of Appeal were filed. As regards the requirement of "the same invention" referred to in Article 87(1) EPC, two distinct views follow from these statements. On the one hand, it is suggested that, in spite of the fact that a claim of a European patent application contains a feature which has not been disclosed in the priority application, a right of priority can be acknowledged in respect of the claim, if that feature is not related to the function and effect of the claimed invention and does not provide an additional technical contribution to the invention. On the other

hand, it is argued that, based on Article 4F of the Paris Convention, a right of priority can be acknowledged in respect of such a claim, if there exists unity of invention between the invention as defined in that claim and subject-matter disclosed in the priority application.

Reasons for the Opinion

1. In decision T 73/88 (cf. point II.(iv) supra), the priority of a previous first filing for a claim was recognised, although the claim contained an additional feature which was not disclosed in the priority application. However, in some decisions handed down after decision T 73/88 had been issued and after its subsequent publication in the Official Journal of the EPO, in particular, in decisions T 311/93 of 16 January 1997 (not published in the OJ EPO) and T 77/97 (cf. point II.(v) supra), the boards of appeal in examining the validity of a claimed priority continued to apply the criterion of at least implicit disclosure used for the disclosure test under Article 123(2) EPC. It follows that, as required by Article 112(1)(b) EPC, there are different decisions on the point of law referred to the Enlarged Board of Appeal by the President of the EPO. The referral is thus admissible.

2. In order to answer question 1a) of the referral as to whether the concept of "the same invention" referred to in Article 87(1) EPC means that the extent of the right of priority derivable from a priority application for a later application is determined by, and at the same time limited to, what is at least implicitly disclosed in the priority application, it has to be examined in the first place whether a narrow or strict interpretation of this concept, equating it with the

concept of "the same subject-matter" referred to in Article 87(4) EPC, is consistent with the relevant provisions of both the Paris Convention and the EPC. Such a narrow or strict interpretation gives rise to the requirement that the subject-matter of a claim defining the invention in the European patent application, i.e. the specific combination of features present in the claim, must at least implicitly be disclosed in the application whose priority is claimed.

3. The EPC constitutes, according to its preamble, a special agreement within the meaning of Article 19 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. decision J 15/80; OJ EPO 1981, 213), are thus clearly intended not to contravene the basic principles concerning priority laid down in the Paris Convention (cf. decision T 301/87 "Alpha-interferons/BIOGEN"; OJ EPO 1990, 335; point 7.5 of the reasons).

4. Pursuant to Article 4H of the Paris Convention, 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 whose priority is claimed, provided that the application as a whole specifically discloses such elements. It follows that priority for a claim, ie. an "element of the invention" within the meaning of Article 4H of the Paris Convention, is to be acknowledged, if the subject-matter of the claim is specifically disclosed be it explicitly or implicitly in the application documents relating to the disclosure, in particular, in the form of a claim or in the form of an embodiment or example specified in the

description of the application whose priority is claimed, and that priority for the claim can be refused, if there is no such disclosure.

Article 4F of the Paris Convention, first paragraph, provides *inter alia* that priority may not be refused 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 there is unity of invention within the meaning of the law of the country. From the second paragraph of this provision it follows that, with respect to these elements, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions. These elements would then be contained in the application whose priority is claimed in respect of a further application. Since, according to Article 4H of the Paris Convention, an invention for which priority is claimed need not be defined in a claim of the application whose priority is claimed (cf. *supra*), an "element" within the meaning of Article 4F of the Paris Convention represents subject-matter specifically disclosed be it explicitly or implicitly in the application documents relating to the disclosure, in particular, in the form of a claim or in the form of an embodiment or example specified in the description of the application claiming one or more priorities. This is in line with the purpose of Article 4F of the Paris Convention. The possibility of claiming multiple priorities was introduced into the Paris Convention in order to avoid improvements of the original invention having to be prosecuted in applications for patents of additions. This makes it clear that "element" was not understood as a feature but as an embodiment (*Actes de la Conférence de Washington de 1911, Bern 1911, p. 45 f.*).

Furthermore, since priority for a claim can be refused under Article 4H of the Paris Convention, if the subject-matter of the claim is not disclosed in the application whose priority is claimed (cf. supra), unity of invention as required under Article 4F of the Paris Convention, first paragraph, must exist between two or more inventions disclosed in the application claiming one or more priorities, and not, as submitted in some statements by third parties pursuant to Article 11b of the Rules of Procedure of the Enlarged Board of Appeal (cf. point IV supra), between an invention disclosed in the application claiming one or more priorities and an invention disclosed in an application whose priority is claimed.

5. In fact, a narrow or strict interpretation of the concept of "the same invention" referred to in Article 87(1) EPC, equating it with the concept of "the same subject-matter" referred to in Article 87(4) EPC (cf. point 2 supra), is perfectly consistent with Articles 4F and 4H of the Paris Convention, which are provisions representing substantive law. Furthermore, the requirement of "the same subject-matter" does not contravene Article 4A(1) of the Paris Convention although this provision makes no mention of the subject-matter of the subsequent application. It is, however, generally held that the subsequent filing must concern the same subject-matter as the first filing on which the right of priority is based (cf. Wieczorek, *Die Unionspriorität im Patentrecht*, Köln, Berlin, Bonn, München, 1975, p. 149). This follows from the very aim and object of the right of priority: the protection from novelty destroying disclosures during a period of twelve months from the date of filing of the first application is necessary only in case of the filing of a subsequent application relating to the same invention. Finally, such a narrow or strict interpretation is also consistent with Article 4C(4) of

the Paris Convention, which provides that a subsequent application concerning the **same subject** as a previous first application shall be considered the first application if, at the time of filing the subsequent application, the previous first application satisfies certain requirements; there is no reason why in this particular situation the concept of "the same invention" should be interpreted differently.

6. Paragraphs 2 to 4 of Article 88 EPC are concerned with substantive aspects of claiming priority. This finding is not at variance with opinion G 3/93 (cf. point II. (vi) supra), point 6 of the reasons, from which it can be deduced that, although Article 88 EPC is mainly concerned with procedural and formal aspects of claiming priority, it is also concerned with substantive aspects of claiming priority which must be dealt with in conformity with the basic principles laid down in Article 87(1) EPC.
- 6.1 In substance, Article 88(2), first sentence, and (3) EPC correspond to Article 4F of the Paris Convention, and Article 88(4) EPC corresponds almost literally to Article 4H of the Paris Convention.
- 6.2 Pursuant to Article 88(4) EPC, priority may be granted, even if certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, provided that the documents of the previous application as a whole specifically disclose such elements. Article 88(3) EPC provides that, 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. Since, pursuant to Article 84 EPC, the claims of the

European patent application define the matter for which protection is sought and, hence, determine the matter for which priority may be claimed, the term "elements of the invention", referred to in Article 88(4) EPC, and the term "elements of the European patent application", referred to in Article 88(3) EPC, are to be considered synonymous. Both an "element of the invention" and an "element of the European patent application" actually constitute subject-matter as defined in a claim of the European patent application.

- 6.3 Article 88(2) EPC, second sentence, provides that, where appropriate, "multiple priorities may be claimed for any one claim". In order to understand the legislative intent underlying this provision, it is necessary to consult the historical documentation related to the EPC, in particular, documents M/19, M/22, M/23, M 48/I and M/PR/I.
- 6.4 This provision goes back to proposals made by three non-governmental organisations: UNICE (cf. M/19, point 8), CIFE (cf. M/22, point 4) and FEMIP (cf. M/23, point 23). These proposals were subsequently analyzed in a memorandum drawn up by FICPI, i.e. another non-governmental organisation (cf. M 48/I, Section C). Based on this memorandum, the provision that multiple priorities may be claimed for any one claim (Art. 88(2) EPC, second sentence) was finally adopted after the delegation of the Federal Republic of Germany had withdrawn its reservation regarding such an amendment (cf. M/PR/I, point 317). Thus, the memorandum can be said to express the legislative intent underlying Article 88(2) EPC, second sentence.
- 6.5 According to the memorandum, in evaluating whether there is any justification for claiming multiple priorities for one and the same claim of an

application, a distinction has to be made between the following situations:

- (i) "AND"-claim
- (ii) "OR"-claim

6.6 As regards the "AND"-claim (point 6.5(i) supra), 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 together with feature 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". From this it clearly follows that, according to the legislator, multiple priorities cannot be claimed for an "AND"-claim. Hence, the application of the so-called "umbrella"-theory (according to which the feature A in the claim directed to A+B would enjoy a partial priority from the first priority date, with the result that the feature A could under no circumstances become state of the art in relation to the claimed invention A+B) is to be disregarded. Besides, the application of the "umbrella"-theory would manifestly be at variance with Article 88(4) EPC.

6.7 As regards the "OR"-claim (point 6.5(ii) supra), 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.

6.8 It seems, therefore, that a narrow or strict interpretation of the concept of "the same invention" referred to in Article 87(1) EPC, equating it with the concept of "the same subject-matter" referred to in Article 87(4) EPC (cf. point 2 supra), is perfectly consistent with paragraphs 2 to 4 of Article 88 EPC. Such a narrow or strict interpretation is also consistent with Article 87(4) EPC, which corresponds to Article 4C(4) of the Paris Convention and which provides that a subsequent application for the **same subject-matter** as a previous first application shall be considered the first application for the purposes of determining priority, provided that, at the date of filing the subsequent application, the previous first application satisfies certain requirements; there is no reason why in this particular situation the concept of "the same invention" should be interpreted differently (cf. point 5 supra).

7. As regards the Contracting States of the EPC, the concept of "the same invention" as a substantive requirement for claiming priority is expressly mentioned in the Patents Acts of a few Contracting States and is moreover considered to be implicitly derivable from the Patents Acts of some other Contracting States. The interpretation of this concept in these Contracting States varies between a narrow or strict interpretation (cf. point 2 supra) and an extensive or broad interpretation, more or less along the lines as set out in decision T 73/88 (cf. point II.(iv) supra). Thus, no unequivocal conclusions regarding the point at issue, namely the

question to what extent the subject-matter of an invention must be disclosed in the priority document in order to justify a right of priority, can be drawn from the substantive requirements for claiming priority as set out in the various Patents Acts of the Contracting States and their interpretation by the respective national deciding bodies.

8. With a view to establishing the criteria to be applied in assessing whether a claim in a later European patent application is in respect of the same invention as the priority application pursuant to Article 87(1) EPC, the following aspects of the problem have to be considered, in particular.

8.1 According to Article 89 EPC, the right of priority has 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(2) and (3) EPC. When determining which of two possibly conflicting European patent applications (or European patents), in respect of which priorities are claimed, has the earlier relevant date for the purposes of Article 54(3) EPC, the criteria to be applied in assessing the concept of "the same invention" pursuant to Article 87(1) EPC must be, in conformity with the principle of equal treatment of the applicant and third parties, strictly the same with respect to the two applications. In this context, the following examples mentioned in the referral of the President of the EPO and representing two possible situations are to be considered:

	1.10.1998	1.12.1998	30.9.1999	30.11.1999
	GB1	GB2	EP1, prio. GB1	EP2, prio. GB2
	applicant X	applicant Y	applicant X	applicant Y
Ex. 1	A+B	A+B'	A+B'	A+B'
Ex. 2	A+B	A+B+C	A+B+C	A+B+C

If the priority of the British patent application GB1 is acknowledged for the European patent application EP1 because B' is an inessential modification of B (Ex. 1) or because the addition of C to the combination A+B added an inessential feature (Ex. 2), EP1 is accorded the earlier relevant date and constitutes state of the art against the European patent application EP2 under Article 54(3) EPC. From this it clearly follows that an extensive or broad interpretation of the concept of "the same invention", for example along the lines as set out in decision T 73/88 (cf. point II.(iv) supra), can be to the detriment of an applicant for a European patent application who, like the above-mentioned applicant Y, avails himself of the priority of a first application within the meaning of Article 87(1) EPC, actually disclosing the claimed subject-matter first. Corresponding problems arise when novelty under Article 54(2) EPC is considered.

Furthermore, Article 54(3) EPC, in conjunction with Article 89 EPC, provides that the content of a European patent application EP1 as filed, of which the date of filing is prior to the date of priority of a European patent application EP2 and which is published under Article 93 EPC on or after the date of priority of EP2, shall be considered to be comprised in the state of the art relevant to EP2. From Article 56 EPC, second sentence, it follows that the content of EP1 as filed is to be considered only when assessing novelty of the subject-matter of EP2. This is perfectly in keeping with the very aim and object of Article 54(3) EPC, a provision which is based on the principle that when two European patent applications relate to the same subject-matter the right to the patent should be associated with the application which did actually disclose the subject-matter first. When looking at examples 1 and 2 (cf. supra), it becomes, however,

evident that an extensive or broad interpretation of the concept of "the same invention" (cf. supra) could be at variance with that principle.

8.2 Moreover, the problems with an extensive or broad interpretation of the concept of "the same invention" (cf. point 8.1 supra) may be illustrated as follows: an applicant files a national application relating to A+B and, two months later, a national application relating to A+B+C. Subsequently, the applicant files a European patent application relating to A+B+C eleven months after the filing date of the national application relating to A+B+C and takes advantage of the priority of that national application. If, for example, the feature "C" were then to be considered inessential, the priority of the national application relating to A+B+C could not be acknowledged when applying an extensive or broad interpretation of the concept of "the same invention" (cf. point 8.1 supra) because, in that case, the national application relating to A+B+C would not constitute a first application within the meaning of Article 87 EPC.

In this situation, in order to avoid any inconsistency, the criteria to be applied in assessing (i) whether an application is to be regarded as the first application for the purposes of determining priority and (ii) whether a claim in a later European patent application is in respect of the same invention as the priority application pursuant to Article 87(1) EPC must be the same. Therefore, if the priority of a national application relating to A+B is acknowledged in respect of a European patent application relating to A+B' or A+B+C by reason of an extensive or broad interpretation of the concept of "the same invention" (cf. point 8.1 supra), that European patent application may not at the same time be regarded as the first application for the purposes of determining priority by reason of a narrow

or strict interpretation of said concept, equating it with the concept of "the same subject-matter" referred to in Article 87(4) EPC (cf. point 2 supra). From this provision it clearly follows that the criteria to be applied in assessing whether an application is to be considered the first application should rather be strict as regards the interpretation of the concept of "the same invention". Hence, for the reasons given above, the same criteria must apply in assessing whether a claim in a later European patent application is in respect of the same invention as in the priority application (Art. 87(1) EPC).

- 8.3 In order to assess whether a claim in a later European patent application is in respect of the same invention as the priority application pursuant to Article 87(1) EPC, a distinction is made in decision T 73/88 (cf. point II.(iv) supra), and in a statement by third parties pursuant to Article 11b of the Rules of Procedure of the Enlarged Board of Appeal (cf. point IV supra), between technical features which are related to the function and effect of the invention and technical features which are not. This approach is problematic because there are no suitable and clear, objective criteria for making such a distinction; it could thus give rise to arbitrariness. In fact, the features of a claim defining the invention in the form A+B+C do not represent a mere aggregation, but are normally inherently connected with each other. Therefore, if the above-mentioned distinction is to be made, the answer to the question whether the claimed invention remains the same, if one of these features is modified or deleted, or if a further feature D is added, depends very much on the actual assessment of the facts and circumstances of the case by each individual deciding body. Different deciding bodies may thus arrive at different results when assessing these facts and circumstances. Furthermore, as pointed out in the

referral of the President of the EPO (cf. point III. (v) supra), it has to be borne in mind that the assessment by these different deciding bodies of whether or not certain technical features are related to the function and effect of the claimed invention may completely change in the course of proceedings. This is the case, in particular, if new prior art is to be considered, with the possible consequence that the validity of a hitherto acknowledged right of priority could be put in jeopardy. Such dependence would, however, be at variance with the requirement of legal certainty.

8.4 If the invention claimed in a later European patent application constitutes a so-called selection invention - i.e. typically, the choice of individual entities from larger groups or of sub-ranges from broader ranges of numerical values - in respect of the subject-matter disclosed in a first application whose priority is claimed, the criteria applied by the EPO with a view to assessing novelty of selection inventions over the prior art must also be considered carefully when assessing whether the claim in the European patent application is in respect of the same invention as the priority application within the meaning of Article 87(1) EPC. Otherwise, patent protection for selection inventions, in particular in the field of chemistry, could be seriously prejudiced if these criteria were not thoroughly complied with when assessing priority claims in respect of selection inventions. Hence, such priority claims should not be acknowledged if the selection inventions in question are considered "novel" according to these criteria.

9. From the analysis under point 8 supra, it follows that an extensive or broad interpretation of the concept of "the same invention" referred to in Article 87(1) EPC, making a distinction between technical features which

are related to the function and effect of the invention and technical features which are not, with the possible consequence that a claimed invention is considered to remain the same even though a feature is modified or deleted, or a further feature is added (cf. point 8.3 supra), is inappropriate and prejudicial to a proper exercise of priority rights. Rather, according to that analysis, a narrow or strict interpretation of the concept of "the same invention", equating it to the concept of "the same subject-matter" referred to in Article 87(4) EPC (cf. point 2 supra), is necessary to ensure a proper exercise of priority rights in full conformity *inter alia* with the principles of equal treatment of the applicant and third parties (cf. point 8.1 supra) and legal certainty (cf. point 8.3 supra) and with the requirement of consistency with regard to the assessment of novelty and inventive step (cf. point 8.1 supra). Such interpretation is solidly supported by the provisions of the Paris Convention (cf. point 5 supra) and the provisions of the EPC (cf. point 6.8 supra), and is perfectly in keeping with opinion G 3/93 (cf. point II.(vi) supra). It 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 person skilled in the art can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole.

10. In decision G 1/93 "Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS" (OJ EPO 1994, 541), relating to the conflicting requirements of Article 123(2) and (3) EPC, a distinction is made between features providing a technical contribution to the subject-matter of the claimed invention and features which, without providing such contribution, merely exclude protection for part of the subject-matter of the claimed invention as

covered by the application as filed. Hence, decision G 1/93 deals with a completely different legal situation.

11. Since question 1a) is answered in the affirmative (cf. point 9 supra), the questions 1b), 2) and 3) need not be dealt with.

Conclusion

For these reasons

the point of law referred to the Enlarged Board of Appeal by the President of the EPO is answered 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 Registrar:


W. Roepstorff

The Chairman:


P. Messerli