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D E C I S I O N
of 12 July 2000

Case Number: G 0003/98
Appeal Number: T 0377/95 - 3.3.4
Application Number: 83901021.2
Publication Number: 0101506
IPC: A61K 39/245

Language of the proceedings: EN

Title of invention:
Materials and methods for herpes simplex virus vaccination

Patentee:
University Patents, Inc.

Opponent:
SmithKline Beecham Biologicals SA

Headword:
Six-month period/UNIVERSITY PATENTS

Relevant legal provisions:
EPC Art. 54(2)(3), 55(1)(a), 56, 89, 112(1)(a)
EPC R. 23
RPBA Art. 17(2)
Paris Convention Art. 2, 4
SPC Art. 4
EHRC Art. 6

Keyword:
Admissibility of referral - significance of the point of law
in the appeal proceedings (yes)"
"Calculation of the six-month period under Art. 55 EPC -
relevant date - date of actual filing of the application"

Decisions cited:

Federal Court of Justice (DE) 5 December 1995 (Coriolis force)
Federal Court (CH) 19 August 1991 (Stacker)
Hoge Raad (NL) 23 June 1995 (Follicle stimulation hormone II)
Opposition Division (EPO) 8 July 1991 (PASSONI/Stand
structure)

Headnote:

For the calculation of the six-month period referred to in Article 55(1) EPC, the relevant date is the date of the actual filing of the European patent application; the date of priority is not to be taken account of in calculating this period.



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Case Number: G 0003/98

D E C I S I O N
of the Enlarged Board of Appeal
of 12 July 2000

Appellant: University Patents, Inc.
(Proprietor of the patent) 537 Newton Avenue
Norwalk
Connecticut 06851 (US)

Representative: Uexküll & Stolberg
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D-22607 Hamburg (DE)

Respondent: SmithKline Beecham Biologicals SA
(Opponent) 89 rue de l'Institut
B-1330 Rixensart (BE)

Representative: Dalton, Marcus Jonathan William
SmithKline Beecham plc
Corporate Intellectual Property
Two New Horizons Court
Brentford, Middlesex TW8 9EP (GB)

Referring decision: Decision of the Technical Board of Appeal 3.3.4
of 5 August 1998 in the appeal proceedings
T 0377/95 - 3.3.4.

Composition of the Board:

Chairman: P. Messerli
Members: R. Teschemacher
G. Davies
J.-C. Saisset
C. Andries
W. Moser
P. van den Berg

Summary of Facts and Submissions

I. Technical Boards of Appeal 3.2.4 and 3.3.4 have referred similar points of law to the Enlarged Board of Appeal under Article 112(1)(a) EPC.

II. In interlocutory decision T 377/95 (OJ EPO 1999, 11 - Herpes simplex virus/University Patents, Inc.) of 5 August 1998, Technical Board of Appeal 3.3.4 referred the following point of law to the Enlarged Board of Appeal (language of proceedings: English, case number G 3/98):

For the purposes of Article 55(1) EPC, in the case where a priority is recognised for a European patent application, is the time period of six months "preceding the filing of the European patent application" to be calculated from the date of filing of the priority application (the priority date) or from the date of the actual filing of the European patent application?

III. In an interlocutory decision, the Opposition Division had ruled that the patent in the form of the last auxiliary request complied with the requirements of the Convention. It held the preceding requests to be unpatentable for lack of novelty, ruling that the subject-matter claimed in them had been made available to the public at a presentation given before the priority date. In its view, the patent proprietor could not claim non-prejudicial disclosure under Article 55(1)(a) EPC because the presentation had in any case been given more than six months before the filing of the European application. The priority date was not relevant for purposes of calculating the six-month period, so the question of whether the oral

disclosure in the presentation could be viewed as an evident abuse in relation to the applicant was also irrelevant. Both parties appealed against this decision.

IV. In the case before Board 3.3.4, the opponent had requested that the patent be revoked in full, arguing that the oral disclosure prejudiced the novelty of the patent even in the form of the last auxiliary request. Furthermore, that request also lacked novelty in view of a document first named in the appeal proceedings, a thesis dating from 1981. In any case, there had been no inventive step relative to the presentation and the thesis in conjunction with other prior art.

V. The proprietor had primarily requested that the patent be maintained as granted. In its view, the presentation was an abusive disclosure within the meaning of Article 55(1)(a) EPC. The 1981 thesis had not been made available to the public in the university library until after the priority date. Even if the presentation counted as prior art, the subject-matter of the last auxiliary request was in any case new and inventive. The proprietor submitted an auxiliary request that the Enlarged Board of Appeal be asked to rule on whether the six-month period under Article 55(1)(a) EPC was to be calculated from the priority date or from the subsequent date of filing of the European patent application. The opponent objected to this request for referral, on the ground that the patent was anticipated by the thesis anyway.

VI. The referring Board 3.3.4 considered the referral was required. Calculation of the six-month period was an issue of fundamental importance which had hitherto been left unresolved by board of appeal case law. The

national courts of last instance in Switzerland, the Netherlands and Germany held divergent views. The question of evident abuse at issue between the parties could be examined only if the provision were applicable to the case in hand. The significance of the newly-cited document could not be assessed without prior examination. If the Board were ultimately to disagree with the opponent on the new document, a need to discuss the presentation would arise (Reasons point 63).

- VII. In an interlocutory decision of 12 April 1999 (T 535/95, unpublished), Board 3.2.4 referred the following point of law to the Enlarged Board (language of proceedings: German, case number G 2/99):

Wenn einer europäischen Patentanmeldung eine Priorität zuerkannt wird, ist dann für die Zwecke des Artikels 55(1) EPÜ die Frist von sechs Monaten "vor Einreichung der europäischen Patentanmeldung" vom Tag der Einreichung der prioritätsbegründenden Anmeldung (Prioritätstag) oder vom tatsächlichen Einreichungstag der europäischen Patentanmeldung an zu berechnen?

- VIII. The Opposition Division had revoked the patent in suit for lack of novelty on grounds of public prior use, ruling that a device corresponding to its subject-matter had been handed over to a customer. In the appeal proceedings, this prior use and its subject-matter were no longer contested. The proprietor however claimed that the prior use was due to an evident abuse in relation to the original applicant, arguing that the sales manager of a company belonging to the original applicant's wife had handed over the device contrary to the applicant's express instructions. The opponent confirmed this account and thereupon withdrew its opposition. The sales manager subsequently also confirmed the facts in an affidavit.

IX. Board 3.2.4 found that the other prior art was not an obstacle to maintaining the patent. On the other hand, the subject-matter of the specified prior use was identical to the subject-matter of claim 1 of the patent in suit, that prior use being the result of an evident abuse in relation to the earlier applicant. The earlier applicant had been the *de facto* head of his wife's company. By handing over the device contrary to instructions, the sales manager had acted in breach of contract and trust. As the prior use had taken place more than six months before the filing of the application itself, but less than six months before the filing of the priority application, the decision on the case depended on how the six-month period under Article 55(1) EPC should be calculated, an issue which was already pending before the Enlarged Board in case G 3/98. To give the proprietor an opportunity to address the issue before the Enlarged Board, Board 3.2.4 decided at the proprietor's request to refer the point of law again.

X. Board 3.2.4 did not voice any opinion on the referred question, whereas Board 3.3.4 put forward *inter alia* the following observations:

In view of the wording of the relevant provisions, a distinction could be made in the English text of the Convention between "the filing of the European patent application" in Article 55 EPC and "the date of filing of the European patent application" in Article 89 EPC; corresponding differences were to be found in the German and French versions. The conclusion could be drawn that the wording had been chosen with a view to restricting the scope of application of Article 55(1) EPC, an intention which might also be inferred from the *travaux préparatoires* relating to Article 55(1) EPC. There was broad agreement on this issue among the Contracting States.

The referring Board 3.3.4 nonetheless found it necessary to examine this question further, because calculating the period from the date of the subsequent application might produce unsatisfactory results. Subsequent developments had to be taken into account, such as the frequency with which priorities are claimed for European patent applications or the duration of grant and opposition proceedings. Another significant factor was the right of the parties to a case to be treated equally, as recognised in the practice relating to Article 6(1) of the European Convention on Human Rights (ECHR). That included the right to defend oneself by presenting facts and evidence in order to contest the opposing party's claims. In patent literature, opinions on calculating the six-month period were divided. Proponents of the priority date as reference point could rely on the argument that Article 89 EPC implicitly referred to Article 55 EPC by way of Article 54(2) and (3) EPC. Moreover, the narrower interpretation of Article 55(1) EPC did not guarantee the right of priority arising from the first application. That contravened not only Article 4A(1) of the Paris Convention for the Protection of Industrial Property (PC) but also Article 87 EPC. Nor was it reasonable that the fate of a patent application should depend on whether it was filed with a national office or with an international authority like the EPO. With regard to balancing the interests of the applicant against those of the public, the facts of the case showed that applicants were not in a position to prepare for an abusive disclosure and file a subsequent application in time, ie within six months after the disclosure, because as a rule they did not find out about abusive disclosures until later.

- XI. In proceedings before the Enlarged Board, the opponent in case G 3/98 took the view that the six-month period in Article 55(1) EPC was to be calculated from the time

of actual filing of the European patent application, and submitted two legal opinions to that effect. This was based on the wording of the provision, which referred to the filing of the application, not to the priority date. With regard to the effects of a priority right, Article 89 EPC deliberately made no reference to Article 55 EPC. The formulations in question had been intentionally chosen by the legislator in order to prevent any cumulation of the priority period and the six-month period. This effect was also in keeping with the PC, which did not concern itself with events preceding the priority date. Interpreting the wording of the provision in its context, pursuant to Article 31 of the Vienna Convention on the Law of Treaties (VC), produced a clear result. This result could not be viewed as manifestly absurd or unreasonable within the meaning of Article 32(b) VC, not least because the EPC's legislator had deliberately chosen that solution and because practice in a number of Contracting States on the interpretation of comparable national provisions and also on Article 55 EPC had produced the same result. Besides, inventors could not be said to have no protection against abusive disclosures, being able to press claims under national civil law. Thus, there were no grounds for applying supplementary means of interpretation under Article 32 VC in addition to the general rule of interpretation in Article 31 VC.

XII. On the other hand, the proprietors in both cases argued that the six-month period was to be calculated from the priority date. The wording of Article 55(1) EPC did not contradict that, if only because it did not concern itself with the effects of a priority right. No intention to the contrary on the part of the Contracting States could be inferred from the *travaux préparatoires* relating to the EPC. Lastly, Article 89 EPC was no different in that respect, referring as it did to Article 54 EPC, which governed the state of the

art. Article 55 EPC was likewise a provision which governed the state of the art, excluding certain disclosures from it and referring to Article 54 EPC. Thus, in the reference in Article 89 EPC to Article 54(2) and (3) EPC there was also an implied reference to Article 55 EPC. That was the only interpretation that produced a meaningful result and adequate protection, as otherwise the priority right would be seriously undermined. That was particularly important in view of the high proportion of European patent applications in which priority was claimed. A narrow interpretation of Article 55 EPC denied applicants, particularly those outside the Contracting States, the opportunity to file a subsequent European patent application on the basis of a convention priority, and it also constituted a breach of the right to national treatment under Article 2 PC.

The opponent in the case giving rise to the referral in G 2/99 withdrew its opposition after the proprietor had claimed abusive disclosure.

XIII. By a decision of 27 May 1999, the two cases were consolidated in accordance with Article 8 RPEBA. Oral proceedings were held on 12 July 2000 at the end of which the answer to the referred question contained in the order of the decision was announced.

Reasons for the Decision

1. Admissibility of the referrals

1.1 As regards the criteria set out in Article 112(1)(a) EPC, it is evident that an important point of law is involved the clarification of which would ensure uniform application of the law. This need is underlined

by the fact that the question of the reference point for the six-month period under Article 55(1) EPC has been left open in a series of decisions (references in T 377/95, Reasons point 2, and Case Law of the Boards of Appeal of the EPO, 3rd ed. 1998, I.C.7.2).

1.2 The questions referred also originate in the context of the cases which led to the referrals.

1.2.1 In referral T 535/95, the Board explained in detail why its decision would differ depending on the answer to the referred question. Hence the context in which the referred question originates is completely clear.

1.2.2 In referral T 377/95, on the other hand, no such explanation is given.

The Board did not examine whether there had been abuse under the terms of Article 55(1)(a) EPC. What it said was that no provision could be applied to the facts of a case unless it had previously been established that it was applicable thereto (Reasons point 3). This can be construed as meaning that the abstract scope of application of a provision has to be clarified before the provision can be applied to the facts of a specific case. The Enlarged Board disagrees. There is no binding principle governing the order in which the conditions for applying a legal provision must be examined. The order in fact depends on what is useful and appropriate in the given circumstances. In finding that a provision is not applicable, the deciding body may select one unfulfilled criterion, leaving aside consideration of other criteria. For reasons of procedural economy, the criterion may be chosen which is the easiest to examine. Thus in a specific case the scope of application of a provision may be highly debatable, but it may not be at all difficult to establish that an actual condition is not fulfilled.

Furthermore, Board 3.3.4 in its referral left open the question of whether the new citation was an obstacle to maintaining the patent. In response to the objection of the opponent in this case that this citation's anticipation of the patent made a referral unnecessary, the Board simply noted that it could not predict the significance of the new document until an examination had taken place (Reasons point 63).

1.2.3 Board 3.3.4, thus, did not demonstrate how different answers to the referred question would influence subsequent proceedings. Pursuant to Article 112(1)(a) EPC, a board of appeal, during proceedings on a case, may refer a question of law to the Enlarged Board of Appeal if it considers that a decision is required. Whereas it is the view of the referring Board which is decisive for assessing whether a referral is required, such assessment should be made on objective criteria and should be plausible. This being so, under Article 17(2), second sentence, RPBA the referral decision must also state the context in which the referred point originated. This is intended to indicate that the referred question does not have a merely theoretical significance for the original proceedings (cf in this respect also Article 112(3) EPC), as would be the case if the referring board were to reach the same decision on the basis of the file regardless of the answer to the referred question.

1.2.4 In the present case, it is clear from their submissions to the proceedings before Board 3.3.4 that the parties seriously disagree over the circumstances which purportedly constitute an evident abuse. Further evidence may have to be taken before a decision can be reached, but it remains to be seen whether this would produce a clear outcome. It would not be surprising to find that the researchers working on the claimed invention had entertained different notions of their

obligations. If the outcome of the evidence is not clear enough, the burden of proof may be the determining factor in the decision. In this situation, it seems reasonable to start by clarifying whether application of Article 55(1)(a) EPC is ruled out purely on legal grounds, given that in the undisputed sequence of events the disclosure took place outside the six months preceding the actual filing of the application.

As regards the allegedly anticipatory document, it is clear from the submissions of the parties to the proceedings before the Board of Appeal that this is not an instance where reference to the state of the art presently on file alone provides sufficient grounds for a final decision. The new citation was named in the statement of grounds for the appeal. Enquiries made by both parties indicate that apparently the thesis was not publicly available in a library until after the first priority date. The patent proprietor requested that the document not be admitted into the proceedings because it was late-filed. The opponent considers the document relevant because four of the five independent claims of the patent were not eligible for the first priority. Thus the new document raises a number of questions which have nothing to do with the matter in dispute before the department of first instance (admission of the document, remittal as a fresh case, sufficient disclosure in the first priority application, novelty and inventive step relative to the document). Ultimately, in the light of the parties' submissions in the appeal proceedings giving rise to G 3/98, it cannot simply be assumed that the referred question will prove irrelevant to the final decision on maintaining the patent. Indeed, the issues that would allow a final decision to be taken without waiting for an answer to the referred question are seriously

disputed both as to the facts and as to their legal significance. In these circumstances, it also seems justified in the interests of procedural economy to address the referred question first.

2. Interpretation of Article 55 EPC

2.1 The wording of the provision

According to Article 55 EPC, the starting point for calculating the period for non-prejudicial disclosures is the filing of the European patent application. Hence the reference point for the provision is the filing of the application which is to be examined, not the filing of an application from which priority is claimed. According to Article 89 EPC, which governs the effects of the right of priority, the date of priority counts as the date of filing of the European patent application for the purposes of Article 54(2) and (3) EPC and Article 60(2) EPC; there is no reference to Article 55 EPC. Thus neither the wording of Article 55 EPC nor that of Article 89 EPC provides for the period for non-prejudicial disclosures to be calculated from the priority date.

2.2 The wording in the context of the provision

The proprietor in case G 2/99 found this literal interpretation only superficially unambiguous. In its view, given the system underlying the Convention, Article 55 EPC could not be expected to mention both the filing of the European application and the filing of a priority application, because the provision governed the conditions for patentability, not the effects of the priority right. However, this overlooks the fact that the Convention, in a number of places dealing with time limits outside the chapter on priority, explicitly specifies the date of priority as

an alternative to the filing of the application or the date of filing (see for example Article 77(3) and (5) EPC and Article 93(1), first sentence, EPC). That is necessary because, simply for reasons of legal certainty, a decision as to the appropriate starting point for a period cannot be left to the discretion of the person interpreting the Convention.

Referral T 377/95 takes up the argument that Article 89 EPC contains an indirect reference to Article 55 EPC (Reasons point 45), said to be implied by the fact that Article 89 EPC refers to Article 54(2) and (3) EPC, where the state of the art is fully defined. It seemed arbitrary to exclude Article 55 EPC *in toto* from the state of the art, especially as the paragraphs 2 and 3 named in Article 89 EPC were the very paragraphs of Article 54 EPC to which Article 55 EPC referred (a point already made in *Loth*, "Neuheitsbegriff und Neuheitsschonfrist im Patentrecht", Cologne 1988, p. 304). The objection to that is that Article 89 EPC associates the effect of the priority right not with the state of the art but with three specifically named provisions, which do not include Article 55 EPC. That is where it differs from Article 56 EPC, which refers generically to the notion of the state of the art for the purpose of deciding whether there has been an inventive step.

Another objection to the assumption that there is an implicit reference to Article 55 EPC in Article 89 EPC is the use of different terminology in the two provisions. "Filing" within the meaning of Article 55 EPC is to be viewed as an act performed by the applicant, as evidenced not only by the term itself but by the provisions governing the filing of the European patent application in Article 75 and Article 76(1), first sentence, EPC or by the exemption from the requirement for representation in Article 133(2) EPC.

On the other hand, the "Tag der Anmeldung" in the German wording of Article 89 EPC is synonymous with the "Anmeldetag" (in the English and French wordings the same term is used in each case: "date of filing" and "date du dépôt"). The date of filing is a date accorded to the application following the examination on filing (Article 90(1) EPC). The date of filing is not necessarily identical with the day on which application documents are filed: it may be re-dated if drawings are filed late (Article 91(6) in conjunction with Rule 43 EPC). The legal implications of the date of filing (eg the term in Article 63 EPC) differ from those of the filing of the European patent application (eg the time limit for payment of the first fees in Article 78(2) EPC). That precludes treating the two terms as synonymous. The Enlarged Board thus draws the same conclusion as the Swiss Federal Supreme Court in its judgment dated 19 August 1991 (OJ EPO 1993, 170 - Stapelvorrichtung [Stacker]) and that of the German Federal Court of Justice in its judgment dated 5 December 1995 (OJ EPO 1998, 263 - Corioliskraft [Coriolis force]): it cannot be inferred from the wording of Article 89 EPC and Article 55 EPC that the priority date should take the place of the filing of the application.

2.3 The intention of the legislator

It cannot be assumed either that the reference point in Article 55 EPC was chosen by mistake, with consequences which run counter to the intentions of the legislator. Apart from anything else, the legislator, as shown above, makes a deliberate distinction elsewhere in the Convention between priority date, date of filing and filing of the application as three different possible reference points. Specifically in the context of non-prejudicial disclosures, the legislator was well aware what date was meant when referring to the filing of the

application, having also used that date as the reference point for fulfilment of the formal requirements for claiming protection for inventions displayed at exhibitions. Article 55(2) EPC stipulates that when filing the application the applicant must state that the invention has been displayed at an exhibition. Under Rule 23, first sentence, EPC the certificate of exhibition likewise prescribed in Article 55(2) EPC must be filed within four months of the filing of the application. The legislator cannot simply be assumed to have used the same term in the same context in two paragraphs of the same provision to refer to two different dates. Another possibility which can be ruled out is that the legislator meant to refer to the priority date in Article 55(1) EPC as well as in Article 55(2) EPC and in Rule 23, first sentence, EPC. That would mean that the acts required by Article 55(2) EPC in conjunction with Rule 23, first sentence, EPC have to be completed before the application is filed. However, the EPC does not envisage formal requirements which have to be fulfilled before the filing of the application.

2.4 The *travaux préparatoires*

No indication of a legislative oversight is to be found in the legislative history either. In the Preparatory Documents for the Munich Diplomatic Conference, the reference point for the period for non-prejudicial disclosures was "... within six months preceding the date of filing ..." (doc. M/1, Article 53 of the draft). The Netherlands delegation wanted to have it made clear that the "date of filing" within the meaning of the provision was to be understood as the actual date on which the patent application was filed. The text of the provision was amended accordingly, "the date of filing" being replaced with "the filing" (Minutes of the Munich Diplomatic Conference, Minutes

of the Proceedings of Main Committee I, doc. M/PR/I, point 61). On the same occasion, a further amendment was made on the proposal of the UK delegation, "... not more than six months ..." being substituted for "... within six months ..." to ensure that the scope of Article 55(1)(a) EPC included conflicting applications not published beforehand but with an earlier priority (doc. M/PR/I, loc. cit., point 62 ff). Main Committee I rejected attempts to extend the scope of Article 55(1)(b) EPC on the grounds that, among other things, such an amendment would diverge from the Strasbourg Patent Convention (SPC) (Minutes of the Munich Diplomatic Conference, Annex I, Report on the results of Main Committee I's proceedings, section C.II.2).

Article 4 SPC, in paragraphs 2 and 4, governs the implications of abusive disclosures in the following terms:

(2) Subject to the provisions of paragraph 4 of this Article, the state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of the patent application or of a foreign application, the priority of which is validly claimed.

(4) A patent shall not be refused or held invalid by virtue only of the fact that the invention was made public, within six months preceding the filing of the application, if the disclosure was due to, or in consequence of:

(a) an evident abuse in relation to the applicant or his legal predecessor, or

The differing formulations in the two paragraphs make it clear that in relation to the state of the art (paragraph 2) the priority date has to be taken into consideration, whereas in relation to evident abuse (paragraph 4) it is only the filing of the application that counts. Thus, the SPC drafters agreed that what mattered was the actual filing in the given State, not the filing of an application from which priority is claimed (Committee of Experts on Patents, Memorandum by the Secretariat on the meeting held at Strasbourg from 7th to 10th November 1961, doc. EXP/Brev (61) 8, point 7). During parallel work on the EPC, the relevant working party held that only at the level of the Paris Convention could a more far-reaching grace period guarantee the legal position of inventors. An isolated provision in the EPC would give them a false sense of security, which would be found to be illusory if they went on to file applications outside the EPC Contracting States (Proceedings of the 5th meeting of the Patents Working Party held at Brussels from 2 to 18 April 1962, doc. (EEC) 3076/IV/62, p. 142, re Article 15; likewise Minutes of the Munich Diplomatic Conference, Annex I, Report on the results of Main Committee I's proceedings, section C.II.2).

This has two implications:

First, the EPC legislator was aware that Article 4(4) SPC associated the time limit with the filing of the application being examined. Second, it was intended that Article 55 EPC be in keeping with the SPC. That undermines any supposition that the legislator did not realise the scope of the provision set out in Article 55(1)(a) EPC, an assumption made still less likely by the fact that the issue of cumulating the period of priority with the period of protection for non-prejudicial disclosures had also been debated as part of attempts to broaden the provision in Article 11

PC and has remained contentious (*Ladas, Patents, Trademarks, and Related Rights, Cambridge, Mass. 1975, Vol. 1, § 341*). Similarly, statements made after the Munich Diplomatic Conference show that the legislator deliberately avoided having the six-month period calculated from the priority date (Report of the German delegation (*Singer*), GRUR Int. 1974, 47, 63; *van Empel, The Granting of European Patents, Leyden 1975, point 88*). Thus, the legislative history of the EPC does not provide any indication that the wording of Articles 55 and 89 EPC does not correspond to the intended meaning of the provisions (Swiss Federal Supreme Court, *loc. cit.*, Reasons point 2(b)(aa)). As the aim was evidently to create a provision with a narrowly restricted time frame, the reference to the restricted effects of the provision (*Loth, loc. cit.*, p. 306) is hardly surprising either.

2.5 Dynamic interpretation

Referral T 377/95, basing its interpretation on the wording and context of the Convention, likewise construes Article 55(1)(a) EPC as meaning that the six-month period is to be calculated from the filing of the application being examined and finds that this interpretation reflects the legislator's intention when drafting the Convention (Reasons points 21 and 24). However, Board 3.3.4 considers that there are other aspects not known to the legislator that need to be taken into account in applying the provision (Reasons point 26). Having weighed up the various interests, it concludes that a narrow interpretation based on a requirement of diligence on the part of the inventor does not produce reasonable results (Reasons point 52). The Board identifies the following considerations which it claims have arisen since the signing of the EPC:

2.5.1 The frequency with which priorities are claimed for European patent applications

The referral T 377/95 (Reasons point 27) cites *Loth* (Münchener Gemeinschaftskommentar, Article 55 EPC, point 65), who, referring to the high percentage of European applications claiming priority, takes the view that the non-cumulation of the six-month period with the priority year would make Article 55 EPC more or less meaningless and undermine the right of priority.

It may be true that the legislator did not foresee the scale on which European applications would claim priorities. It was certainly to be expected, however, that at least applicants from non-member States would generally claim priority from their own country. Thus, abusive disclosure arising before the priority date was not a possibility that the legislator would have seen as being in any way exceptional. Moreover, in assessing the conflict of interests between the applicant affected by the abusive disclosure and the public, especially competitors, the frequency with which this conflict arises is not a crucial factor: the interests to be balanced, in particular individual justice and legal certainty, are always the same. Changing this balance in the applicant's favour on account of a large number of cases necessarily means changing it just as frequently to the public's disadvantage.

As for the alleged undermining of the right of priority, it should be pointed out that this right is independent of the existence of rules governing non-prejudicial disclosures. The priority right protects a filing against being invalidated by acts accomplished in the priority interval (Article 4B PC). It does not however affect the issue of the effects that acts accomplished before the priority date have on the subsequent application. Admittedly, Article 11(1) PC

obliges the countries of the Union to grant temporary protection to inventions exhibited at official or officially recognised exhibitions, an issue that the EPC deals with in Article 55(1)(b). However, as regards the form such protection should take, the provision refers to domestic legislation (for possible forms see *Bodenhausen*, Paris Convention for the Protection of Industrial Property, Geneva 1968, Article 11, note (c)). Regarding the relation between temporary protection and priority right, Article 11(2) PC says in its first sentence that temporary protection shall not extend the priority period, while its second sentence gives domestic legislation the option of calculating the period from the date of introduction of the goods into the exhibition. Thus, the Paris Convention does not oblige the countries of the Union to cumulate the period for protection against non-prejudicial disclosures with the priority period. That also means that there is no contravention of the principle of national treatment. A first applicant is in a different situation to the person filing a subsequent application. This conclusion is independent of the fact whether there is a situation involving another country as in the case of a priority under the Paris Convention or a situation within one and the same country as in the case of an internal priority. Article 2 PC does not preclude different solutions for different circumstances. The granting of a priority right under Article 4 PC is intended to compensate, albeit to a limited extent, for the negative consequences affecting a subsequent application in another country. Yet the Paris Convention does not oblige any State to treat the subsequent applicant in all respects as if it had filed the application on the priority date itself.

2.5.2 The time factor

On this subject, the referral T 377/95 says (Reasons points 28 to 30) that prolonged litigation before the patent granting authority (ie, to take account of abusive disclosures) may have been a cause for concern before the introduction of opposition after grant.

Since the EPC approach of opposition after grant of the patent had in any case prolonged the procedure before the patent granting authority, this concern no longer seemed to have the same weight. Similarly, Board 3.3.4 in its referral considered that there is now less significance in objections to delays in opposition proceedings because of the need to take evidence, and particularly to examine witnesses, since in proceedings before the EPO half of the patent's term may well have elapsed anyway before a final decision is taken.

The referral provides no evidence that the legislator was actually influenced by any such considerations. Nor is it evident that grant or opposition proceedings used on the whole to be considerably shorter in the Contracting States. On the contrary, it should be borne in mind that, at the time of the preparatory work on the EPC, deferred examination was introduced in the Netherlands and Germany in order to reduce the backlog of pending applications and thereby cut the excessive processing times before these countries' authorities. Lastly, it is difficult to see why further prolonging a procedure which is already too long should not give rise to objections.

2.5.3 Article 6 of the European Convention on Human Rights
(ECHR)

Article 6(1) ECHR reads in part: "In the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law". Citing case law relating to the ECHR, the referral T 377/95 states (Reasons points 33 to 35) that this provision concerning the fulfilment of the requirement of equal treatment implies a party's right to refer to evidence and facts in order to defend itself against a claim.

The referral T 377/95 concludes, for the present situation, that the proprietor must be able to claim abuse under Article 55(1)(a) EPC where the opposing party has alleged that the patent lacks novelty or inventive step because of a disclosure (Reasons point 35). This overlooks the fact that the right to a fair hearing within the meaning of Article 6(1) ECHR is a procedural right designed to guarantee equal opportunities for both parties. Each party should have the opportunity to refute the other party's evidence with suitable evidence of its own (*Grottrian*, Article 6 of the European Convention on Human Rights - The right to a fair trial, Strasbourg 1996, point 91, with references to case law). In the present case, however, it is not a matter of a patent proprietor being denied the opportunity to defend itself on procedural grounds against claims it considers to be incorrect. What is actually at stake is the substantive law issue of which facts have to be taken into account when assessing novelty and inventive step. However, Article 6(1) ECHR does not govern the content of substantive law; it is only a guarantee of a fair procedure in which decisions are made in relation to claims on the basis of the substantive rights the State in its discretion provides

(Harris/O'Boyle/Warbrick, Law of the European Convention on Human Rights, London 1995, p. 186 ff, with references to case law). Thus, in the present context, there is no need to examine the other requirements of the provision in more detail.

2.5.4 Consequences of a literal interpretation

Referring to the decision of an Opposition Division dated 8 July 1991 (EPOR 1992, 79 - PASSONI/Stand structure), Board 3.3.4 found it unreasonable that the fate of an application should be conditional on whether it was originally filed with a national office or with the EPO. However, that condition is beside the point as far as calculating the six-month period in connection with an abusive disclosure is concerned. In fact, on the assumption that a provision in line with Article 55 EPC applies to the national office, all that matters is whether the application being assessed is a first filing or a subsequent application filed more than six months after the disclosure. Only the first filing enjoys protection against abusive disclosure, not the subsequent application, regardless of whether it is filed with the EPO or with a national office.

Board 3.3.4 also considers it unreasonable to expect the inventor or his successor in title to file a subsequent application within six months following an abusive disclosure which he did not find out about until later. This argument can of course be cited against any time limit within which an application must be filed in order to obtain protection against abusive disclosure. In any case, breach of an obligation to maintain secrecy by disclosure relates more to the domain of the inventor and subsequent applicant than to that of the public in general and competitors in particular. Only the applicant can take suitable action to prevent unauthorised disclosure. Thus, it is not

inherently unreasonable or inappropriate to resolve the prevailing conflict of interests to the applicant's disadvantage in the interests of legal certainty rather than to the public's disadvantage in the interests of individual justice.

Furthermore, it is not evident that the legislator was unaware of the above considerations; in fact, these arguments are inherent in any debate on a grace period. In this respect, any forum responsible for the application of legislation is debarred from substituting its own assessment for the judgment of the legislator.

No other conclusion can be drawn from the patent proprietors' reference to subsequent legislative developments, particularly in Germany where the legislator, so far as the law on utility models and designs is concerned, has associated the grace period with the date relevant for the state of the art relating to the application, which may also be the priority date (see Sec. 3, third sentence, German Utility Model Law and Sec. 7a German Designs Law). This was to be seen as a sign that the lack of an adequate grace period was increasingly being found unsatisfactory. However, this very legislative development in Germany shows that the legal policy decision to extend the scope of application of the grace period has been treated as a matter for the legislator. The German legislator has also made a distinction, deliberately maintaining the difference in terms of grace period between utility model and patent. This was based on the consideration that proposals to revise the rigorous limitation of the grace period in patent law are best dealt with as part of a

comprehensive international agreement (see "Begründung zum Entwurf eines Gesetzes zur Änderung des Gebrauchsmustergesetzes", Part B, re No. 2, point 2, in Bl. f. PMZ, 1986, 320, 324).

Overall it is not possible to identify any considerations that have arisen since the Convention was signed which might give grounds for assuming that a literal interpretation of the wording of Article 55(1)(a) EPC conflicts with the legislator's aims. Thus, there is no need for further discussion of the question at issue between the parties as to the conditions under which a dynamic interpretation might lead to a result which diverges from the wording of the law.

- 2.6 The result of the above interpretation is in keeping with the decisions of the national courts of last instance in Switzerland and Germany (see point 2.2 above). The thoroughly reasoned Swiss decision is particularly worthy of mention because the Swiss legislator chose a different solution for national law, explicitly taking the priority date as reference point. The court denied that the differently formulated provisions of national and European law were the same in substance, even though Swiss documentation suggested that the national legislator had considered the provisions synonymous (*loc. cit.*, Reasons points 2(a) and 2(b)(dd), last paragraph).

The supreme court in the Netherlands came to a different conclusion. The Hoge Raad decision of 23 June 1995 (OJ EPO 1998, 278 - Follicle stimulation hormone II), issued as a temporary injunction, based its succinct reasoning on the protective purpose of Article 55 EPC. It did not identify any considerations liable to challenge the conclusion reached here.

Order

For these reasons it is decided that:

The question of law referred to the Enlarged Board of Appeal is answered as follows:

For the calculation of the six-month period referred to in Article 55(1) EPC, the relevant date is the date of the actual filing of the European patent application; the date of priority is not to be taken account of in calculating this period.

The Registrar:

A handwritten signature in black ink, appearing to be 'W. Roepstorff', with a stylized, somewhat abstract flourish at the end.

W. Roepstorff

The Chairman:

A handwritten signature in black ink, appearing to be 'P. Messerli', written in a cursive style.

P. Messerli