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**Datasheet for the interlocutory decision
of 17 July 2015**

Case 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

Headword:

Partial Priority / Infineum

Relevant legal provisions:

Paris Convention Art. 4F, 4G
EPC Art. 54(3), 76(1), 87, 88, 89, 100(a), 100(c), 112(1)(a),
123(2)

Keyword:

Priority - Partial priority
Novelty - Parent/divisionals -
State of the art under Article 54(3) EPC
Referral to the Enlarged Board of Appeal -
Points of law of fundamental importance -
Divergence in case law

Decisions cited:

G 0003/93, G 0002/98, G 0002/02, G 0003/02, G 0001/03,
G 0001/05, G 0002/10, J 0015/80, T 0081/87, T 0085/87,
T 0073/88, T 0441/92, T 0441/93, T 0395/95, T 0077/97,
T 0352/97, T 0665/00, T 1127/00, T 1177/00, T 0015/01,
T 0135/01, T 1443/05, T 0184/06, T 1877/08, T 0476/09,
T 2311/09, T 0571/10, T 2406/10, T 1222/11, T 1496/11,
T 2473/12

Nestec SA & Ors v Dualit Ltd & Ors [2013] EWHC 923 (Pat)

HTC Corporation v Gemalto SA and HTC Corporation v Gemalto NV
[2013] EWHC 1876 (Pat)

Catchword:

The following questions are referred to the Enlarged Board for decision:

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?



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Case Number: T 0557/13 - 3.3.06

**I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal 3.3.06
of 17 July 2015**

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 18 December
2012 revoking European patent No. 0921183
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. Czech
Members: G. Santavicca
 J. Geschwind

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division to revoke European patent No. 0 921 183.
- II. The patent was granted on European patent application No. 98203458.9, which is a divisional application of European patent application No. 95923299.2, hereinafter "parent application". The latter was filed as international application PCT/EP95/02251 on 8 June 1995 and published as WO 95/33805 A1 (hereinafter D1) 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.
- III. 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."

- IV. The patent was opposed on the grounds of Article 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).
- V. In the decision under appeal, the opposition division came to the following conclusions:
- The claims as granted were not objectionable under Article 123(2) or 76(1) EPC.
 - The subject-matter of Claim 1, resulting from a generalisation of a more specific disclosure in D16, regarding the nature of the compound to be used as a cold flow improver, did not represent the same invention as that set out in D16. The priority claimed was thus not valid for the whole scope of Claim 1. Moreover, referring to opinion G 2/98 (OJ EPO 2001, 427, Reasons, 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 of 08.06.1995". This finding was held to be in line with decisions T 665/00 of 13 April 2005, T 1877/08 of 23 February 2010 and T 1496/11 of 12 September 2012.
 - Although the patent met the requirements of Article 76(1) EPC, it did not enjoy the priority date of parent application D1, which thus was state of the art under Article 54(3) EPC. In this respect, reference was made to decision T 1496/11 (Reasons, 2.1 and 3).
 - 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 D16 and D1. The embodiment

described in D1 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".

VI. In its statement setting out the grounds of appeal, the appellant (patent proprietor) maintained that the subject-matter of Claim 1 as granted was novel over D1. It submitted essentially that pursuant to Article 76(1) EPC a divisional application could not have a different priority date from its parent and could thus not be held to lack novelty over the latter under Article 54(3) EPC. The appellant nevertheless filed a set of amended claims as auxiliary request AR1, intended to overcome the novelty objection by the more limited ambit of its amended claim 1. In support of its arguments, it submitted the following documents:

D20: Tobias Bremi, *"Self-collision with your own priority application under Article 54(3)? - T 1443/05 and its possible consequences on filing strategies"*, Mitt., Heft 5/2009, pages 206 - 210;

D21: Legal Expert Opinion by Professor U. Vollrath dated 12 April 2005 submitted in appeal proceedings
T 705/04 (18 pages plus list of publications);
and, annexed thereto:

D21a: U. Joos, *"Identität der Erfindung, Mehrfach- und Teilpriorität im europäischen Patentrecht"*, in Straus, Joseph (Hrsg.), *"Aktuelle Herausforderungen des geistigen Eigentums"* - Festgabe für F.-K. Beier, Heymanns, Köln, 1996, Pages V and 73 - 85;

D22: Internet blog entry "Tufty the Cat: Article 54(3) and EP Divisionals" of 5 February 2011 and comments; two pages printed out from <http://tuftythecat.blogspot.co.uk/2011/02/article-543-and-ep-divisionals.html>; and,

D23: M. Lawrence and M. Wilkinson, "*Poisonous Divisions - thoughts and feedback since original publication of the 'Poisonous Divisionals' concept*", IP Europe Quarterly, February 2012, Pages 1 - 6.

VII. In its reply, the respondent (opponent) rebutted the arguments of the appellant, maintained its novelty objection based on D1 and raised objections regarding the admissibility and allowability of the appellant's auxiliary request AR1. It referred to document

D24: Benkard, Patentgesetz, 10th edition, 2006, Page 923, § 39, Note 38.

VIII. In a further letter the appellant referred to decision T 1222/11 of 4 December 2012, and to Memorandum C of document M/48/I, submitted at the Diplomatic Conference of 1973 by FICPI ("Fédération Internationale des Conseils en Propriété Industrielle") - hereinafter "Memorandum".

It argued that partial priority had to be acknowledged for Claim 1, and that the novelty objection based on D1 thus fell away. It enclosed the following further documents in support:

D25: R. Teschemacher, "*Poisonous Divisionals - ein Gespenst verschwindet?*", Mitt., Heft 1/2014, pages 16 - 18;

D26: R. Teschemacher, "*Poisonous divisional*

applications - is the bogey going to disappear?",
Lexology, print-out of 4 pages, 19 November 2013;

D27: L. Walder-Hartmann, "*Giftige Teilanmeldungen -
Altlast oder Lärm um nichts?*", GRUR Int., 2014,
pages 17 - 27.

IX. In a further written submission, the respondent
rebutted the arguments of the appellant, enclosing
document

D28: Singer-Stauder "*Europäisches Patentübereinkommen -
Kommentar*", 6th Edition, 2012, Article 123 EPC,
Note 43.

It also submitted, as auxiliary requests, the following
questions A, B and/or C to be referred to the Enlarged
Board of Appeal:

A) "Bedeutet für die Inanspruchnahme des
Prioritätsrechts der Begriff '*beschränkte Zahl
eindeutig definierter alternativer Gegenstände*', dass
ein Patentanspruch abzählbare Ausführungsformen
aufweisen muss, die voneinander unabhängig sind, oder
ist der Begriff so auszulegen, dass die lediglich
intellektuell mögliche Unterordnung von
Ausführungsformen, die im Prioritätsdokument gelehrt
sind bereits als beschränkte Zahl eindeutig definierter
alternativer Gegenstände anzusehen ist, auch wenn diese
Gegenstände im Anspruch nicht vereinzelt sind?"

(English translation: "For claiming priority, does the
expression '*limited number of clearly defined
alternative subject-matters*' mean that a claim must
identify countable, mutually independent subject-
matters, or is it to be interpreted such that the
merely conceptual categorisation of embodiments taught

in the priority document is already in itself to be regarded as a limited number of clearly defined alternative subject-matters, even if these subject-matters are not individualised as such in the claim?")

B) "Bedeutet Art. 76(1) EPÜ, dass der Prioritätsanspruch, den eine Teilanmeldung aus ihrer Stammanmeldung erhebt, für das auf die Teilanmeldung erteilte Patent selbst dann erhalten bleibt, wenn die im Teilpatent erteilten Ansprüche nicht mehr die gleiche Erfindung im Sinne des Art. 87(1) EPÜ betreffen, die im Prioritätsdokument offenbart war?"

(English translation: "Does Article 76(1) EPC mean that the priority claim derivable by a divisional application from its parent application is preserved for the patent granted on the divisional application even if its claims as granted no longer relate to the same invention within the meaning of Article 87(1) EPC as that disclosed in the priority document?")

C) "Kann die Offenbarung, die in einer Stammanmeldung enthalten ist, und der das für die Stammanmeldung in Anspruch genommene Prioritätsrecht zukommt, einem Patent als Stand der Technik unter Art. 54(3) EPÜ entgegen gehalten werden, welches auf eine Teilanmeldung aus dieser Stammanmeldung erteilt wurde, sofern für dieses Patent Prioritätsrecht aus der Stammanmeldung unwirksam ist?"

(English translation: "Can a parent application's disclosure which enjoys the priority right claimed for that application be cited as state of the art under Article 54(3) EPC against a patent granted on a divisional application of that parent application, if

for this patent the priority right claimed in respect of the parent application is not valid?")

- X. In a communication issued in preparation for oral proceedings, the Board indicated that it did not question the opposition division's finding that the granted claims were not objectionable under Article 100(c) EPC.

The Board noted potential differences between relevant disclosure elements in D1 and D16. The Board however observed that a use as defined in Claim 1, of the product according to Example 1 appeared to be disclosed in D1, D16 and the patent. That this use appeared to fall within the terms of Claim 1 was even more evident in view of dependent Claim 7.

The Board also noted that the issue of novelty might hinge on whether the patent could validly claim a right of priority for this use, as embraced by the more generic definition according to Claim 1. It indicated that questions might be referred to the Enlarged Board of Appeal. With respect to the notion of "partial priority" it referred to document

D29: Schricker, Fragen der Unionspriorität im Patentrecht, GRUR Int 1967, Heft 3, pages 85 - 93.

- XI. In a further written communication, the Board drew the parties' attention to decision T 571/10 of 3 June 2014.
- XII. With its further letter of 15 December 2014, the appellant filed a table juxtaposing decisions of the boards of appeal in which partial priority was either accepted or denied, and the following "possible referral questions":

"Where a claim of a European patent or patent application encompasses more specific subject matter disclosed in an earlier application from which priority is claimed, for example because the claim in question contains generic term(s) or generic formula(e) encompassing both the subject matter disclosed in the priority application and alternative(s) thereto:

1. Is the expression 'provided that it gives rise to the claiming of a limited number of clearly-defined alternative subject matters' from Point 6.7 of Enlarged Board opinion G 2/98 to be applied as the legal test for entitlement to partial priority under Article 88(2) and (3) EPC?

2. If the answer to 1 is 'yes', how is the test from Point 6.7 to be applied in this situation, and in particular, how is a claim containing generic term(s) or generic formula(e) to be interpreted as relating to a limited number of clearly-defined alternative subject matters?

3. If the answer to 1 is 'no', what is the legal test for partial priority of a claim containing generic term(s) or generic formula(e), and how is it to be applied to such a claim?

In the situation defined above, where:

(i) the European patent was, or the European patent application is, a divisional application ('Divisional') and the claim in question *fails* the legal test for partial priority as clarified above;

(ii) the parent European patent or patent application ('Parent') claims the same priority as the Divisional and, as published, discloses specific subject matter

also disclosed in the priority application and encompassed by the claim of the Divisional; and (iii) the Parent and Divisional designate the same EPC contracting states:

4. Does Article 76(1) EPC nevertheless prevent different effective dates being attributed to the claim of the Divisional and the priority-entitled specific subject matter in the Parent?

5. If the answer to 4 is 'no', is the term 'European patent applications' in Article 54(3) EPC to be interpreted as extending to the Parent application, thereby rendering the Divisional lacking in novelty over its Parent?"

In a footnote to these questions, the appellant stated: "If the legal test for partial priority universally avoids the situation described in (i) to (iii), there would be no need to answer questions 4 and 5. However, if there were still some prospect of 'poisonous priority', the answers to questions 4 and 5 would still be relevant to this appeal, and generally."

XIII. Oral proceedings were held on 17 December 2014.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, on the basis of the set of claims according to auxiliary request AR1 filed with the statement setting out the grounds of appeal. The respondent (opponent) requested that the appeal be dismissed.

The respondent expressly confirmed that it had no

objections under Article 100(c) EPC with regard to the claims of the patent as granted (main request).

The identity of the use of the compound of Example 1 as disclosed in D1 and D16, respectively, was common ground between the parties.

The appellant also reiterated its request for referral to the Enlarged Board of Appeal of the questions submitted by letter of 15 December 2014, and the respondent declared that it agreed with the request for referral. The parties were heard on the appropriateness of a referral. The Board announced that it would refer one more questions to the Enlarged Board and that the decision would be given in writing.

XIV. The appellant submitted essentially the following:

The opposition division had erred in finding that

- i) Claim 1 did not enjoy partial priority from D16,
- ii) "Article 76(1) did not have the effect of aligning the priority (effective) date of parent and divisional applications", and
- iii) "the content of the parent (Example 1) had an earlier effective date than the divisional claim, and was novelty-destroying under Article 54(3) EPC" ("so-called 'self-collision' effect, in which one member of the European patent family 'poisons' another").

Decision T 1496/11, relied upon by the opposition division, neither considered the possibility of partial priority, nor offered reasoning for the assumptions that priority had to be independently assessed for the parent and the divisional and that a divisional was another European application citable under Article 54(3) EPC.

Partial priority

According to the appellant, the correct approach to the question of partial priority was set out in decision T 1222/11 with reference to G 2/98 and the Memorandum (cf. also commentaries D25 and D26). Applying the approach of T 1222/11 to the facts of the case, partial priority had to be acknowledged for Claim 1 to the extent that it encompassed subject-matter disclosed in the priority document, in particular the use described therein of the compound of Example 1. Therefore, the published parent application D1, although disclosing the same use, was not novelty-destroying. The interpretation of G 2/98 (Reasons, 6.7) given in T 1222/11 and applied in T 571/10 was the correct one and corresponded to the policy intent as expressed in the Memorandum. In contrast to the different approaches adopted in decisions T 1443/05 of 4 July 2008, T 2311/09 of 2 September 2013, T 1127/00 of 16 December 2003, T 1877/08, and T 476/09 of 21 September 2012, that interpretation did not lead to practical problems to the detriment of applicants, in particular with regard to claim drafting. In the appellant's view, a decision of the Enlarged Board on partial priority was of fundamental importance considering the potential impact of such a decision on applicants' filing strategies. In particular, regarding the filing of divisional applications, uniform application of the law needed to be re-established. There were inconsistencies in the case law of the boards of appeal after G 2/98, which arose because it was not clear whether the proviso in the Reasons, 6.7, was actually intended to be a legal test and, if so, how it should be applied.

Article 76(1) EPC

Referring *inter alia* to Articles 4F and 4G of the Paris Convention, Article 8 PCT, Articles 87 to 89 EPC, G 2/98 and decisions J 15/80 of 11 June 1981 (Reasons, 3, 6 and 7) and T 2473/12 of 5 November 2013 (Reasons, 5.3), the appellant submitted that Article 76(1) EPC, the statutory provision referring to the priority date of a divisional application, had to be considered a stand-alone provision and interpreted in its own right. It was clear from its wording ("shall enjoy any right of priority") that the identity of filing and priority dates between divisional and parent applications was mandatory and could not be decoupled, on the basis of an independent, forensic analysis of priority entitlement. Moreover, Article 76(1) EPC was the counterpart of Article 4G of the Paris Convention, the policy purpose of which was to preserve the benefit of priority to an applicant who divided out. Considering also that the patent was granted on a divisional application filed in response to a unity objection raised under the provisions of the PCT, the decision under appeal was reached based on an interpretation of Article 76(1) EPC that contravened the provisions of the Paris Convention. On a proper interpretation of Article 76(1) EPC, the effective date of a European divisional application was deemed to be the same as that of the European parent application. Thereby it was ensured that they could not collide under Article 54(3) EPC.

Article 54(3) EPC

By following the correct approach in law on partial priority as set out in T 1222/11, the same subject-matter would always be accorded the same priority date.

A claim which encompassed, as an alternative, subject-matter disclosed in the priority document would also validly enjoy priority to the extent that it encompassed this subject-matter. To the extent that the claim encompassed other alternatives (e.g. through generalisation), it would not enjoy priority. The approach in T 1222/11 ensured that an independent assessment of priority for European parent and divisional applications would mean that the claims in each enjoyed priority to the extent that they read on subject-matter disclosed in the priority document. A claim in one application, to the extent that it read on subject-matter in the priority document, would have the same priority date as that subject-matter in the other application. Thus, there would be no collision under Article 54(3) EPC and the addition of further alternative embodiments would not result in "poisonous" divisionals or parents.

If partial priority were not to be acknowledged, the question would arise whether a European divisional application or patent that satisfied the requirements of Article 76(1) EPC could be held to lack novelty over its parent application under the provisions of Article 54(3) EPC. Referring to D21 and D27, the appellant argued that upon proper construction, the term "European applications" in Article 54(3) EPC did not include applications from the same European parent/divisional family. Otherwise, a European application could, to take it to the extreme, even be held to collide with itself. The controversial views regarding this question, as apparent from D21 to D23, showed the difficulty posed by the wording of Article 54(3) EPC in relation to the question of "self-collision" between European parent and divisional applications. The approach of the opposition division was also in

conflict with the position under German national law, which corresponded to that advanced in D21 with respect to the EPC. Reference was made to the legal commentary Schulte, "Patentgesetz mit EPÜ - Kommentar", 8th edition, 2008, Notes 262, 264, 273 and 276) on the provisions of Section 34 of the German Patent Act, as well as to decision G 1/05 (OJ EPO 2007, 362).

Furthermore, in the light of *inter alia* Article 4G(1) of the Paris Convention and Article 8(2)(a) PCT, the appellant argued that there was an unseverable link between European parent and divisional applications regarding the allocation of effective dates and the rights which flowed from them. Hence, European parent and divisional applications could not be considered stand-alone applications.

The appellant also mentioned "public policy considerations" speaking against a possible "practice of self-collision of parent and divisional applications".

XV. The respondent's arguments can be summarised as follows:

Partial priority

Following G 2/98, priority could only be validly claimed provided Claim 1 could be directly and unambiguously derived from the content of D16 as a whole. This had to be denied due to the broader definitions comprised in Claim 1 as compared to the disclosure of D16. Moreover, the criteria for attributing different priority dates to Claim 1 in accordance with G 2/98 (Reasons, 6.7) were not met, since Claim 1 was not an "OR"-claim embracing a

"limited number of clearly defined", i.e. individualised alternatives, but relied on generic definitions of a continuum of subject-matters. The respondent conceded that regarding the meaning to be given to the expression "limited number of clearly defined alternative subject-matters" the case law of the boards of appeal was not consistent. It contrasted T 1443/05, T 2311/09 and T 1127/00 with T 1222/11. Therefore, if the Board were inclined to consider that Claim 1 enjoyed the priority claimed, based on the rationale of T 1222/11, question A (*supra*) should be referred to the Enlarged Board.

Article 76(1) EPC

Article 76(1) EPC did not preclude the priority deemed to be enjoyed by a divisional application or the patent granted thereon from being challenged and found to be invalid for substantive reasons. For instance, the claim to priority could be invalid if the divisional patent comprised claims not entitled to priority. Priority could even be denied for a claim of the divisional application as filed if there was insufficient correspondence with the disclosure of the priority document.

A priority deemed to be enjoyed by a divisional patent could be refused since European parent and divisional applications were, according to the case law, entirely independent of each other. The divisional itself had to meet the various substantive requirements of the EPC (cf. T 441/92 of 10 March 1995, Reasons, 4.1, and T 1177/00, Reasons, 2.1).

Neither the PCT nor the Paris Convention ruled out that a claim to priority could be held invalid if the "same

invention" criterion was not met. Nor did they contain provisions on how to assess whether the invention was the same. In the case at issue the divisional application upon which the patent was granted had been filed as a European application. Hence, the priority-related provisions of the EPC were applicable, and to be construed in conformity with the PCT and the Paris Convention. Since neither contained provisions relating to this specific issue, there was no lack of conformity.

The appellant's reference to German law was neither appropriate nor conclusive, since the issue at stake was not procedural (Article 125 EPC) but substantive. According to German law, priority could only be preserved for the divisional if its subject-matter was disclosed in the priority document (cf. D24).

If the Board nevertheless considered that a European divisional application or patent and its parent are so linked that the divisional benefits in any case from the priority claimed by the parent, question B (*supra*) should be referred to the Enlarged Board.

Article 54(3) EPC

It was irrelevant whether the application invoked as state of the art under Article 54(3) EPC was the parent (as in the present case), a divisional (as in T 1496/11) or some unrelated European application. What counted was whether the claim under attack was entitled to priority and, if not, whether the European application invoked as state of the art under Article 54(3) EPC contained elements of disclosure of earlier priority date. In the present case, Claim 1 did not enjoy the claimed priority, whereas the subject-matter

of parent application D1 that was already disclosed in priority document D16 did enjoy this priority. Since parent and divisional applications were independent of each other, D1 was state of the art under Article 54(3) EPC. Consequently there was indeed lack of novelty.

Article 54 EPC distinguished between "the European patent application" under examination and "European patent applications" as state of the art. Hence, a European patent application could not collide with itself.

D21 was a legal expert opinion submitted by a party in a different case. It postulated, with reference to Article 76(1) EPC, a special relationship between European parent and divisional applications, in the sense that they were part of a non-separable complex of applications. Since parent and divisional applications were, however, independent of each other, there was no such special relationship which could justify mutually disregarding them in the application of Article 54(3) EPC, as suggested in D21 to D23. If the Board were nevertheless minded to adopt a different view, question C (*supra*) should be referred to the Enlarged Board.

Regarding the appellant's public policy considerations, the respondent argued that any changes made to the text of a European application, compared to the priority application, could always lead to a loss of priority. This could be avoided by filing a new priority application for the amended subject-matter.

Reasons for the Decision

Admissibility of the appeal

1. The appeal is admissible.

Patent in suit not objectionable under Article 100(c) EPC

2. In its communication of 26 November 2014, the Board explained why it did not question the opposition division's finding that the claims of the patent as granted were not objectionable under Article 100(c) EPC. Moreover, during the appeal the respondent raised no such objection. Thus the Board, having duly reconsidered all relevant aspects, concludes that the patent in suit is not objectionable under Article 100(c) EPC.

Novelty: Claim 1 and the disclosure of parent application D1

3. Subject-matter of Claim 1

The features of Claim 1 (Point III, *supra*) can be grouped as follows:

(i) features relating to the use: "*The use of a cold flow improver*" (i.e. the use of a compound as a cold flow improver) "*to enhance the lubricity of a fuel oil composition*";

(ii) features defining the compound used as a cold flow improver: "*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";

(iii) features defining the fuel oil composition to be enhanced in lubricity: *"a fuel oil composition having a sulphur content of at most 0.05% by weight";* and,

(iv) features defining the concentration of the cold flow improver upon use: *"wherein from 0.001 to 1% by weight of the cold flow improver based on the weight of the fuel is present".*

4. Subject-matter of D1 cited against Claim 1

4.1 As indicated in the decision under appeal, D1 discloses at least one specific use falling within the generic terms of Claim 1. This is not in dispute.

4.2 As regards the nature of the flow improver (group 3(ii) *supra*), D1 (page 19) discloses several examples of "additives used", "Example 1" reading as follows: "A polar nitrogen compound, an N,N-dialkylammonium salt of 2-N'N'-dialkylamidobenzoate, the product of reacting one mole of phthalic anhydride and two moles of di(hydrogenated tallow)amine." The alkyl substituents of this compound, which comprises a dialkylammonium cation, originate from tallow, a natural fat consisting almost entirely of a mixture of glyceryl esters of C₁₄, C₁₆ and C₁₈ fatty acids. The alkyl substituents are thus *"hydrocarbyl groups containing 8 to 40 carbon atoms"* within the meaning of Claim 1. The compound disclosed in Example 1 of D1 is thus a mixture of compounds representing one of many conceivable alternative flow improvers falling within the generic definition according to Claim 1. This is also reflected by the fact that dependent Claim 7 (point III, *supra*) refers

specifically to this compound defined as a reaction product.

- 4.3 The use to which this cold flow improver compound is put (group 3(i) *supra*) according to D1 (see claims 1, 14 and 15, page 1, penultimate paragraph) is the same as that according to Claim 1. This is apparent from the following parts of D1 in particular:
- page 17: "various additives were tested in Fuels I, II and III";
 - page 18, last paragraph: "various additives were used in the numbered examples, the results and the treat rates in ppm by weight of active ingredient based on the weight of the fuel, being given in the Tables"; and
 - page 21: "Results (Fuel I)", Example 1 and "... all flow improvers enhance lubricity".
- 4.4 As regards group 3(iii) *supra*, D1 (page 17) discloses the use of the oil-soluble polar nitrogen compound of Example 1 for enhancing the lubricity of "Fuel I", which is "a Class 1 diesel fuel commercially available in Sweden" having a sulphur content of 0.001% by weight, i.e. within the range of "at most 0.05% by weight" prescribed by Claim 1.
- 4.5 As regards group 3(iv) *supra*, according to page 21 of D1 (first data row in the table, Example 1) the compound of Example 1 was tested using a "treat rate" of 1334 ppm (weight of active ingredient based on the weight of the fuel; see D1, page 18, last paragraph). This treat rate value (0.1334% by weight) falls within the concentration range of "*from 0.001 to 1%*" defined in Claim 1 at issue. Still according to page 21 of D1 (paragraph between the two tables), the measured wear reduction was an indication of an enhanced lubricity.

- 4.6 Summing up, D1 discloses the use of an oil-soluble polar nitrogen cold flow improver compound which is covered by the generic chemical definition according to Claim 1, for enhancing the lubricity of a fuel with a sulphur content as defined in Claim 1, at a concentration within the range prescribed by Claim 1.

Novelty objection based on D1

5. D1 as potential state of the art under Article 54(3) EPC

European parent application D1 was published after the (deemed) filing date of the divisional application on which the patent was granted. It is not in dispute that for the parent application, published under the PCT as D1, the requirements of Articles 54(4) and 158(2) EPC 1973 are met.

6. Further conditions to be met

For D1 to be novelty-destroying under Article 54(3) EPC, the following three conditions would also have to met:

- (a) the relevant subject-matter disclosed in D1 (4.6, *supra*) enjoys the priority date of D16;
- (b) the subject-matter of Claim 1 alleged to lack novelty over D1 does not enjoy the priority date of D16; and
- (c) D1 can indeed be considered to be a (colliding) European application within the meaning of Article 54(3) EPC, even though it is the parent application of the divisional application on which the patent in suit was granted.

7. Priority date of use disclosed in D1 -
condition (a) under 6, *supra*
- 7.1 Both the patent and parent application D1 claim the
priority of earlier national application D16. The
opposition division held (decision, point 3.2, second
paragraph, first sentence) that D16 (page 20)
identically disclosed not only the use of the additive
compound of Example 1 of D1 for the same purpose, but
also the characteristics of the fuel in terms of its
sulphur content (page 19) and the test results in terms
of treat rate and enhanced lubricity (page 22). Hence,
the use of the polar nitrogen compound of Example 1 as
disclosed in D1 was entitled to priority from D16.
- 7.2 In its communication of 26 November 2014 (points 4.1.1
to 4.1.3), the Board questioned the identity of the
uses disclosed in D16 and D1, respectively, especially
regarding the sulphur content of the fuel treated and
the treat rate in ppm. At the oral proceedings the
appellant overcame the Board's concerns by indicating
the following:
 - 7.2.1 The sulphur content of "0.01 wt%" mentioned on page 19,
line 15, of D16 was an evident error. The additive of
Example 1 was tested in a "Class 1 diesel fuel
commercially available in Sweden" (page 19, lines
10 - 11). According to D16 itself (page 2, first full
paragraph), such a fuel had a sulphur level below
0.001 wt%. This was also generally known, as evidenced
by e.g. document
D4: A.M. Kulinowski et al., "Diesel Fuel Additives to
Meet Worldwide Performance and Emissions
Requirements", SAE Technical Paper 932737, 1993,
in particular page 1, right column, second full
paragraph and table I on page 2.

7.2.2 Furthermore, there was no difference between the treat rates reported in D16 and D1, respectively. Given that the treat rates in D16 referred to the concentrations of the additive composition in the fuel, whereas in D1 the treat rates referred to the concentrations of only the active ingredient of the additive composition, the latter concentrations were smaller in value. The identity of the treat rates was apparent from the identical wear value of 254 μm reported in D1 and D16. Hence, D16 and D1 differed only in terms of how the same concentration of active additive was expressed.

7.2.3 At the oral proceedings, the respondent expressly confirmed the correctness of these indications and of the conclusion that the uses of the compound according to Example 1 as described in D16 and D1 were the same.

7.3 Hence, the Board has no doubt that the use of the compound according to Example 1 as described in D16 and in D1 is indeed one and the same, also in respect of the sulphur content of the fuel and the additive concentration (treat rate), and that, consequently, this use enjoys priority from D16.

Condition (a) under 6, *supra* is thus met.

8. Entitlement of Claim 1 to (partial) priority from D16 - condition (b) under 6, *supra*

8.1 Scope of Claim 1 broader than relevant disclosure in D16

8.1.1 It is common ground between the parties that Claim 1 generically encompasses, *inter alia*, alternative subject-matters which are not disclosed in priority document D16 but result from generalisations of

subject-matter which is disclosed in D16.

8.1.2 According to the parties, Claim 1 contains two such generalisations:

- i) Regarding the oil-soluble polar nitrogen compounds to be used as a cold flow improver, D16 (see e.g. paragraph bridging pages 10 and 11) discloses the substituents $-NR^{13}R^{14}$ as defined in Claim 1, but exclusively as substituents of amine salts or amides made from specific starting materials (see D16, claim 15). The broader definition of the compounds to be used according to Claim 1 amounts to a generalisation of the more specific disclosure of such compounds in D16.
- ii) Whereas priority document D16 (see e.g. claim 20) discloses a range of 0.01 to 1% by weight of the cold flow improver concentration based on the weight of the fuel, Claim 1 defines the **broadened** range of 0.001 to 1% by weight. This broadened range represents a further generalisation of the more specific disclosure of D16.

The Board observes that, in this analysis, the parties appear to have referred to the information contained in claims 2, 14, 15 and 20 of D16.

8.1.3 If, however, reference is made to the specific use of the compound of Example 1 invoked as being novelty-destroying for the subject-matter of Claim 1, the following three generalisations are contained in Claim 1, compared to the priority document:

- i) The specific oil-soluble polar nitrogen compound of Example 1 of D16, namely the N,N-dialkylammonium salt of 2-N'N'-dialkylamido-benzoate, the product of reacting one mole of phthalic acid anhydride and two moles of di(hydrogenated tallow)amine, has been generalised to 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 represents a hydrocarbonyl 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";

ii) the specific treat rate (concentration of polar nitrogen compound) illustrated in the use of the priority document, namely, if expressed as an active ingredient, 1334 ppm (0.1334% by weight), has been generalised to "wherein from 0.001 to 1% by weight of the cold flow improver based on the weight of the fuel is present"; and

iii) the specific Fuel I, which is a Class 1 diesel fuel commercially available in Sweden and having a sulphur content of 0.001% by weight, has been generalised to "a fuel oil composition having a sulphur content of at most 0.05% by weight".

8.1.4 The use of the compound according to Example 1 as disclosed in D1 is identically described in the divisional application as filed and in the patent. This use represents one alternative embodiment having all the cumulative features (see point 4.6 *supra*) of the use defined in broader terms in generic Claim 1, This is also evident from dependent Claim 7, which is expressly directed to the use of the specific compound according to Example 1.

8.2 Partial priority - generic "OR"-claims - terminology

8.2.1 For the purposes of the present decision, the expression "partial priority" is used by the Board in a narrow sense (cf. Schricker (D29), point II.1, second paragraph; Memorandum, paragraph 38), to refer to the situation in which part of the subject-matter of a claim is entitled to the priority date of a single

earlier application, whereas the remaining subject-matter is entitled only to the filing date of the subsequent European patent application.

8.2.2 For the purposes of the present decision, a "generic 'OR'-claim" is a claim directed to subject-matter defined by one or more generic expressions, such as a chemical formula, a continuous range of numerical values or a functional definition, or otherwise. Such a generic "OR"-claim encompasses, without spelling them out, alternative subject-matters having all the features of the claim.

8.2.3 Acknowledging entitlement to partial priority for such a generic "OR"-claim to the extent that it encompasses alternative subject-matter disclosed directly, or at least implicitly, and unambiguously, in the priority document means that this alternative subject-matter enjoys the claimed priority date as its effective filing date.

8.3 Opposing views of the parties on partial priority

The parties disagreed as regards the priority date(s) attributable to the subject-matter(s) of Claim 1.

8.3.1 The appellant took the view that partial priority had to be acknowledged for Claim 1 to the extent that it encompassed, as one of a plurality of alternatives, the use of the compound of Example 1 as described in both D1 and the patent, i.e. precisely the use considered by the respondent to be novelty-destroying. More particularly, it argued that applying the approach set out in T 1222/11, the criteria indicated in G 2/98 (Reasons, 6.7) were met.

8.3.2 By contrast, the respondent argued that Claim 1 was not entitled to priority since, due to the generalised wording of Claim 1, the claimed invention was not the same as that disclosed in priority document D16. Not even partial priority could be acknowledged because Claim 1 did not spell out any alternatives. As regards the applicability of the criteria indicated in G 2/98 (Reasons, 6.7), it was true that the case law was divergent.

8.4 Decision on novelty potentially dependent on approach to assessing entitlement to partial priority

Regarding condition (b) under 6, *supra*, the Board thus takes the view that the decision on novelty of the subject-matter of Claim 1 may depend on what approach is adopted in assessing entitlement to partial priority for a generic "OR"-claim. The concrete question to be resolved here is whether Claim 1 enjoys partial priority to the extent that the use of the product of Example 1 as disclosed in D16 is encompassed by the more generic definition of Claim 1, rather than being spelt out in it. The matter of the proper approach to be adopted for this purpose will be considered in depth in the further course of these Reasons.

9. Parent application D1 as potential colliding application under Article 54(3) EPC - condition (c), *supra*

The Board merely notes at this point that should the respondent's view on partial priority turn out to be correct, the parties' arguments as to Articles 76(1) and/or 54(3) EPC regarding the possibility of a collision between the patent and its parent application D1 would also have to be assessed before a final

decision on novelty can be taken with respect to Claim 1.

Partial priority - legal framework

10. Paris Convention

10.1 The Paris Convention established rules concerning the right of priority (Articles 4, Sections A to I). Article 4F addresses the possibility of multiple and partial priorities. In this respect, see Bodenhausen, "Guide to the application of the Paris Convention for the Protection of Industrial Property", BIRPI, WIPO Publication, reprinted 2007, page 53, paragraphs (a) and (d), with further reference to Schricker (D29). Attention is also drawn to D21b:Beier & Moufang, GRUR Int., 1989, 869 (English version in IIC, 1990, 593), which reflects the willingness of the international industrial property system to recognise multiple and partial priorities, considering that inventing is an innovative process which seldom comes to a halt after a patent application has been filed (see also T 15/01, OJ EPO 2006, 153, Reasons, 33).

Article 4G concerns the division of patent applications and provides that the applicant may preserve "the benefit of the right of priority, if any".

11. *Travaux préparatoires* to the EPC 1973 - Memorandum

11.1 In section I, "Multiple Priorities", of the Memorandum (*supra*), it is pointed out that, considering the differing or unclear approaches in the claiming of priority in various countries, it was essential that under the EPC the position be made clear by an express

provision, so that applicants would know how to draw up their patent claims in such cases.

- 11.2 Concerning the claiming of multiple priorities for one and the same claim, the Memorandum distinguishes between:
- 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).
- 11.3 Concerning "OR"-claim situations, 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" (this corresponds to a generic "OR"-claim in the terminology of the Board).
- 11.4 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.

11.5 In section II, "Partial priority", it is pointed out

- that "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
- that "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".

11.6 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.

11.7 It would appear from the Minutes of the Munich Diplomatic Conference of 1973, M/PR/I, "Article 86 (88) Claiming Priority", points 308 to 317, that the Memorandum was an essential element in the process of drafting the EPC provision allowing the claiming of multiple priorities for one and the same claim which was finally adopted.

12. The European Patent Convention

12.1 The EPC constitutes, according to its preamble, a "special agreement within the meaning of Article 19 of the Paris Convention". Hence, it shall not contravene

the basic principles concerning priority laid down in the Paris Convention (cf. G 2/98, Reasons, 3; also J 15/80, Reasons, 7; T 2473/12, Reasons, 5.3).

- 12.2 Article 88(2), second sentence, EPC, provides that: "Where appropriate, multiple priorities may be claimed for any one claim."
- 12.3 Article 88(3) EPC lays down 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."
- 12.4 Article 76(1), second sentence, EPC 1973 (applicable here), lays down that a European divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision [EPC 2000: "requirement"] is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of [EPC 2000: "enjoy"] any right of priority."

Case law concerning partial priority

13. Case law prior to G 2/98
- 13.1 Preliminary remark on the "same invention" requirement

The Board observes that prior to G 2/98 two different approaches were adopted by the boards with regard to the requirement of the "same invention" under Article 87(1) EPC: a broad approach (T 73/88 (Snackfood/

Howard), OJ EPO 1992, 557) and a strict approach based on the disclosure test. According to the latter, all the features of the claimed subject-matter must be directly, or at least implicitly, and unambiguously disclosed in the priority document in the claimed combination (e.g. T 81/87, OJ EPO 1990, 250, Reasons, 12; T 77/97 of 3 July 1997, Reasons 6.4 and 6.5). This divergence in the case law triggered the referral case G 2/98 and was resolved in favour of the strict approach.

13.2 Board of appeal decisions on partial priority

The Board is not aware of any decision concerning partial priority and applying the broad approach. There are, however, decisions applying the strict approach in dealing with partial priority. These decisions all acknowledge partial priority for generic "OR"-claims.

Broadening of generic chemical formulae

- 13.2.1 In case T 85/87 of 21 July 1998, claim 1 was directed to compounds defined by a generic chemical formula which was broader than the generic formula disclosed in the priority document, due to amendments to the definitions of some substituents. For the deciding board (Reasons, 3 and 4), it followed from Article 88(3) EPC that a claim in a European patent application might contain subject-matter going beyond what was disclosed in the priority document. In other words, such a claim might only be partially entitled to priority, i.e. only for those elements disclosed in the priority document. Thus, the whole claim 1 did not need to be entitled to the claimed priority date. Therefore, priority was acknowledged for part of claim 1, to the extent that there was full agreement between the

generic formula in the priority document and the generic formula in claim 1 as regards the meaning of the substituents (Reasons, 4). Consequently, another European application disclosing a specific compound falling within said part of claim 1, but with an effective date after the priority date claimed by the application at issue, was not considered as state of the art under Article 54(3) EPC. However, the board denied priority for a dependent claim directed to this specific compound, which, relying on the principles developed by the boards of appeal to determine novelty of specific (individual) chemical compounds over a generic disclosure of a group of compounds, was not disclosed in the priority document. Therefore, the specific compound disclosed in the other European patent application anticipated the subject-matter of the dependent claim.

13.2.2 The approach of T 85/87 was followed in T 352/97 of 24 October 2000 (Reasons, 3.4.2 and 3.4.3, second paragraph) in the assessment of the extent to which a claim directed to compounds defined by a generic formula may be entitled to partial priority.

Broadening of compositional ranges

13.2.3 In case T 395/95 of 4 September 1997, claim 1 concerned the use as a tackifier of a composition comprising a "resin having a softening point from **10°C to 120°C** being a copolymer containing from **10 to 60 wt%** of the monovinyl aromatic compounds" (emphasis by the Board). The board (Reasons, 2.1.1) referring to Article 88(3) EPC, held that a right of priority covered only those elements of the European patent application (and, consequently, of the European patent) which were included in the application from which priority was

claimed. Hence, priority could not be recognised for those parts of the claims which involved a resin having a softening point from above 80°C to 120°C and/or containing from above 30 to 60 wt.% of the monovinyl aromatic compounds, as such subject-matters were not disclosed in the priority document. Consequently, a European patent application published in the priority interval was state of the art under Article 54(2) EPC for the subject-matter covered by the claims but not disclosed in the priority document, and under Article 54(3) EPC for the subject-matter covered by the claims and disclosed in the priority document.

Broadening of process

13.2.4 In case T 441/93 of 27 March 1996 (Reasons, 19 and 20), partial priority was acknowledged for part of the claimed subject-matter to the extent that it was disclosed in the priority document (process for the transformation of protoplasts), whilst the process for transformation of whole cells also encompassed by claim 1 was held to enjoy only the filing date of the European patent application. Consequently, a scientific article published in the priority interval was held to be prior art only as regards the parts of the claimed subject-matter not disclosed in the priority document.

14. G 2/98 - principles regarding priority

14.1 Opinion G 2/98 concerns the interpretation of the requirement of the "same invention" in Article 87(1) EPC. The Enlarged Board set out the following principles:

14.1.1 With reference to Articles 4F and 4H of the Paris Convention, it was acknowledged (Reasons, 4, in

particular second paragraph) that:

- Priority may not be refused on the ground that an application claiming one or more priorities contained one or more elements that were not included in the application whose priority is claimed, provided that there is unity of invention.
- With respect to said one or more elements not included in the priority document, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.
- 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, an "element" within the meaning of Article 4F of the Paris Convention represents subject-matter specifically disclosed, explicitly or implicitly, in the application documents relating to the disclosure, in particular, in the form of a claim, or of an embodiment, or of an example.
- 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 addition. This makes it clear that "element" was not understood as a feature but as an embodiment.

14.1.2 In point 5 of the Reasons, the Enlarged Board found that a 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" in Article 87(4) EPC, was perfectly consistent with Articles 4F, and 4H, and also 4A(1) of the Paris Convention. It was, however, generally considered that the subsequent filing had to concern the same subject-matter as the first filing on which the right of priority was based. This followed 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. Such a strict interpretation was also consistent with Article 4C(4) of the Paris Convention, which provided that a subsequent application concerning the same subject as a previous first application could be considered as the first application if certain requirements were met.

14.1.3 In point 6 of the Reasons, the Enlarged Board indicated that although Article 88 EPC was mainly concerned with procedural and formal aspects of claiming priority, it also concerned substantive aspects which must be dealt with in conformity with the basic principles laid down in Article 87(1) EPC. Points 6.1 to 6.8 of the Reasons specifically address the possibility of claiming multiple priorities for a single claim:

- Article 88(2) EPC, first sentence, EPC and Article 88(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.
- Since 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" in Article 88(4) EPC and the term "elements of the European patent application" in Article 88(3) EPC are to be considered synonymous. Both an "element of the invention" and an "element of the European patent application" constitute subject-matter as defined in a claim of the European patent application.
- Article 88(2), second sentence, EPC 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, including the Memorandum (*supra*), which can be said to express this intent. According to the Memorandum, in evaluating whether there is any justification for claiming multiple priorities for one and the same claim, a distinction has to be made between "AND"-claim and "OR"-claim situations.

14.1.4 Point 6.7 of the Reasons 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."

14.1.5 The Enlarged Board concluded (Reasons, point 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, 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."

14.2 The Conclusion of G 2/98 reads:

"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."

15. Case law after G 2/98

15.1 Board of appeal decisions denying partial priority

Broadening of generic chemical formulae

15.1.1 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 for the first time disclosed. 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, 5 to 7).

- 15.1.2 In case T 2311/09 (Reasons, 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. decision G 2/98, Reasons 6.7)".

Broadening of chemical compositions

- 15.1.3 In case T 184/06 of 21 March 2007 (Reasons, 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, 9). Moreover, claim 1 related to a composition of matter characterised by a combination of features which could not be regarded isolatedly 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 88(3) EPC).

15.1.4 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, 4.1.11). Moreover, with reference to G 2/98 (Reasons, 6.6), 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, 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

15.1.5 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 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 88(3) EPC). Consequently, no separable alternative embodiments, i.e. elements in the sense of Article 88(3) EPC, could be identified within that continuum, which could enjoy the priority date, and for these reasons priority was denied for claim 1 as a whole.

15.1.6 In case T 476/09 claim 1 was directed to a toner composition characterised *inter alia* by an average "circularity" of the toner particles (a physical characteristics thereof), being defined in terms of a continuous range "of 0.930 to 0990" (emphasis by the Board). Although a 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, 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

15.1.7 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, 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.

15.2 Two judgments of the High Court of Justice (Patents Court) of England and Wales referring to G 2/98 and denying partial priority

15.2.1 In the case of *Nestec SA & Ors v Dualit Ltd & Ors* [2013] EWHC 923 (Pat) of 22 April 2013, claim 1 of European Patent (UK) 2 103 326 was directed to an extraction system comprising a device for the extraction of a capsule. It was common ground that the claim covered subject-matter disclosed in the priority document. Considering *inter alia* the criteria of the proviso in G 2/98 (Reasons, 6.7), the court held that the claim also encompassed subject-matter which could not be considered as "clearly defined alternatives" (paragraphs 96 and 103) and concerned "a whole range of different arrangements" (paragraph 96). Hence, not even

partial priority was acknowledged. Consequently, claim 1 was found to lack novelty over said subject-matter disclosed in the priority document, which was prior art pursuant to section 2(3) of the Patents Act 1977, corresponding to Article 54(3) EPC (paragraph 111).

- 15.2.2 In *HTC Corporation v Gemalto SA and HTC Corporation v Gemalto NV* [2013] EWHC 1876 (Pat) of 10 July 2013, concerning European Patent (UK) 0 932 865, the judge noted with reference to G 2/98 (Reasons, 6.7), that "although one can sympathise with the desire for a limited number", it was questionable whether there was "any principled basis for such a requirement". The "need for clearly defined alternative subject-matters" was expressly accepted "if a single claim is to be given partial or multiple priorities" (paragraph 160).

In effect (paragraph 195), claim 1 comprising features defined with respect to a "high level language", was not found to be (even partially) entitled to priority, since "Java" was the only programming language disclosed in the priority document. However, claim 3, dependent on claim 1 and limited by reference to "Java", was found to enjoy priority.

- 15.3 Board of appeal decisions acknowledging partial priority

Broadening of continuous ranges of numerical values

- 15.3.1 In T 135/01 of 21 January 2004 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, 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 = $\hat{\omega}/2$ ', which was entitled to the priority date of the GB application ... [priority document], and a second notional part claim to the complementary range of $\frac{1}{4} < \hat{\omega} < \frac{3}{4}$ punctured by the range of 'approximately = $\hat{\omega}/2$ ', 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 = $\hat{\omega}/2$ ". 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.

15.3.2 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/m^3 ", said range not being disclosed in the priority document. A novelty objection had been raised based on an allegation of public prior use within the priority interval. Referring to Article 88(3) EPC and G 2/98 (Reasons 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, 3.5). According to the board (Reasons, 3.5.1) the generic expression "specific mass below 0.1 g/m^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 T 665/00, 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 (Reasons, 6.7).

15.3.3 In T 1222/11 (Reasons, 11), the board advocated, in an *obiter dictum*, an interpretation of the proviso in G 2/98, Reasons 6.7, which differs from that adopted in decisions T 1127/00, T 1443/05, T 1877/08 and T 476/09, as follows:

- The condition set out in G 2/98 (Reasons, 6.7) could not be meant, as held in the cited decisions, to require a certain manner in which the subject-matter had to be defined in an "OR"-claim, 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, OJ EPO 1993, 117).

This conclusion was reached considering 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 indicated 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 G 2/98 (Reasons, 6.7) 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 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, 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.

15.3.4 T 571/10 expressly applied the approach developed in T 1222/11. Two alternative groups of subject-matters were identified (Reasons, 4.5.14) as being encompassed by the claim, although not spelt as such therein: alternative (a), concerning the use of a specific composition (calcium salt of the active 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 54(3) EPC, but not novelty-destroying, since alternatives (a) and (b) did not overlap.

Referral to the Enlarged Board of Appeal

16. Article 112(1)(a) EPC

Pursuant to Article 112(1)(a) EPC, "in order to ensure uniform application of the law, or if a point of law of fundamental importance arises ... the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes".

The Board is of the opinion that the conditions laid down in Article 112(1)(a) EPC for a referral of questions concerning, on the one hand, partial priority, and, on the other, the applicability of Article 54(3) EPC to members of the same European parent/divisional family are met, for the following reasons.

17. Questions concerning partial priority

17.1 Preliminary remark - determination of priority dates

Generally speaking, in proceedings before the EPO, the

validity of a claim to priority is only assessed if state of the art made available to the public on or after the priority date claimed is potentially novelty-destroying or relevant to inventive step for at least some of the subject-matter claimed. Then, the priority dates attributable respectively to the claimed subject-matter under attack and, if necessary, to the cited state of the art, need to be established.

17.2 Requirements of Article 112(1) (a) EPC

17.2.1 Requests of the parties

Both parties stated that they considered it expedient to refer questions concerning partial priority in cases of generic "OR"-claims, invoking *inter alia* the fundamental importance of priority-related issues and divergences in the case law. Among the questions submitted by the parties, those relating to partial priority were ranked first.

17.2.2 Point of law of fundamental importance

The right of priority being one of the cornerstones of the patenting system, the Board considers that clarification of issues arising in the present connection is of fundamental importance. As argued by the appellant, the way in which entitlement to priority is assessed in cases of generic "OR"-claims is of great practical importance for claim drafting and filing strategies.

The Board has also become aware of another pending appeal case (T 624/14-3402, concerning European patent No. 2 157 457) in which a request for referral of questions regarding priority of a generic "OR"-claim

has been made (cf. submission of the respondent dated 30 October 2014). As in the present case, subject-matter disclosed in the parent application has been invoked as novelty-destroying under Article 54(3) EPC for the subject-matter of a claim of the patent granted on a divisional application.

Attention is also drawn to the following further publications which reflect the importance of the issue of partial priority for the interested circles and the controversial nature of the debate:

D30: D. Pearce et al., "*Opposing views on partial priority*"; CIPA, December 2013, pages 716 to 720;

D31: M. Lawrence, "*The Doctrine of Partial and Multiple Priorities, especially from the standpoint of Toxic Priority*"; epi information, 1/2015, pages 23 to 35.

17.2.3 Divergences in the jurisprudence

As apparent from the analysis (*supra*) of the jurisprudence before and after G 2/98, the law has not been applied uniformly in the assessment of entitlement to partial priority for generic "OR"-claims. In particular, after G 2/98 two divergent approaches have developed, both of which differ from that before G 2/98. These latter two approaches have relied upon different interpretations of the proviso in the last sentence of G 2/98 (Reasons, 6.7).

i) Pre-G2/98

Partial priority was acknowledged for a generic "OR"-claim to the extent that it encompassed subject-matter(s) directly, or at least implicitly, and

unambiguously disclosed in the priority document (see T 85/87, T 352/97 and T 395/95, *supra*). The effective date of the subject-matter encompassed as an alternative by the claim and targeted by the cited state of the art was established based on a comparison of the claim with the content of the priority document. Consequently, the same European patent application could, for instance, be cited as state of the art under Article 54(3) EPC against subject-matter generically encompassed by the claim and disclosed in the priority document, and under Article 54(2) EPC against other parts of the claim (T 395/95). The Board observes that these decisions did not rely on an analysis of a generic "OR"-claim in terms of the number and the clarity of the alternative subject-matters it encompassed, including those not disclosed in the priority document.

ii) G 2/98

The Enlarged Board did not take issue in G 2/98 with the aforementioned approach of the earlier decisions acknowledging partial priority. In point 6.7 of the Reasons, with reference to the Memorandum, it considered that "[t]he use of a generic term or formula in a claim for which **multiple** priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters". However, neither in the Reasons, 6.7, nor elsewhere in G 2/98 is there an express reference to a generic "OR"-claim for which **partial** priority is claimed. According to the appellant, the applicability of the proviso "provided it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" (hereinafter "the proviso in G 2/98")

as a legal test for entitlement to partial priority for a generic "OR"-claim appears to be questionable. Moreover, as also pointed out by the parties, G 2/98 does not contain any further explanation of the meaning to be given to the criteria "limited number" and "clearly defined alternative subject-matters". It does not appear to be expressly indicated in G 2/98 whether all or only some of the different types of generic "OR"-claims analysed the Memorandum with respect to examples a), b) and c) would actually meet these criteria and therefore be entitled to **partial** priority (emphasis by the Board).

iii) Post-G 2/98

- The pre-G 2/98 approach appears still to have been used, in some instances without even a reference to G 2/98 (cf. T 135/01, *supra*), or without express consideration of whether the claim, to the extent that it also encompasses subject-matter(s) not disclosed in the priority document and/or not under attack, complies with the proviso in G 2/98.

- According to a first post-G 2/98 approach (cf. T 1127/00, T 1877/08 and T 476/09, *supra*), the boards have refused partial priority with reference to the criteria of the proviso in G 2/98, without however expressly considering the comparable examples of the Memorandum, i.e. examples a), concerning broadening of chemical formulae, and b), concerning broadening of a concentration range. In *Nestec SA v Dualit Ltd*, *supra*, the proviso in G 2/98 was also applied as a precondition to be met in order to accord partial priority. Even partial priority was denied because the further alternatives encompassed by the claim but not disclosed in the priority document could not be distinguished clearly enough.

- In the second post-G 2/98 approach (cf. T 1222/11 and

T 571/10), the proviso in G 2/98 also appears to have been considered as a test for entitlement to partial priority, but to have been interpreted differently from the first approach (T 1127/00, T 1877/08 and T 476/09). This second approach does not require the "clearly defined alternative subject-matters" to be spelt out in the claim. Rather, it suffices to be able to conceptually identify a limited number of such alternative subject-matters by comparing the generic "OR"-claim with the priority document. In this way partial priority may be acknowledged for the alternative subject-matter(s) disclosed in the priority document. The remaining subject-matter(s) of the generic "OR"-claim are treated, *in toto*, as forming one alternative.

The board has also become aware of decision T 2406/10 of 13 January 2015, which did not acknowledge partial priority, with reference to the proviso in G 2/98 and emphasis put on the "limited number" criterion (Reasons, 3.2.2). The second post-G 2/98 approach of the recent decisions T 1222/11 and T 571/10 was not followed. Thus there continues to be a lack of convergence in the jurisprudence which underlines the expediency of referring the matter to the Enlarged Board.

17.2.4 Necessity for a decision by the Enlarged Board

In the present case, different results in terms of partial priority and, hence, novelty, will be arrived at depending on which of the different approaches mentioned above is applied:

i) Applying the pre-G 2/98 approach (of e.g. T 85/87; T135/01) could result in accepting partial priority for

Claim 1 to the extent that it covers the specific use disclosed in priority document D16. According to this approach, there would be no need to assess how clearly the alternative subject-matters not disclosed in the priority document can be distinguished and counted.

ii) If, instead, either of the post-G 2/98 approaches were taken, the finding on partial priority would appear to depend on how the criteria according to the proviso in G 2/98 are applied:

- The first, and literal, approach could lead to denying partial priority for Claim 1, given that it encompasses a practically unlimited number of alternative compounds, which are not spelt out in it. The two broadenings in the form of continua of numerical values could further complicate the identification of clearly distinguishable alternatives within Claim 1.

- The second, conceptual or notional, approach could, however, like the pre-G 2/98 approach, result in acknowledging partial priority for Claim 1 to the extent that it encompasses the use of the compound of Example 1 as disclosed in priority document D16.

Clarification as to the proper approach to be adopted is therefore needed for the present case.

17.3 Formulation of the questions

Referral questions 1 to 4 have been framed in terms which reflect the fundamental importance of issues of partial priority, which can arise whenever there is state of the art potentially relevant under either Article 54(3) or 54(2) EPC, and not only in situations falling under what has come to be referred to as "toxic priority", or "poisonous divisionals" (present case).

The questions also address the issues of

- whether the proviso in G 2/98 is actually applicable at all to the assessment of entitlement to partial priority for generic "OR"-claims, as opposed to claims involving multiple priorities (cf. also T 1222/11, Reasons, 11.5.1; D25, page 17, left column, lines 22 - 35), and
- if it is applicable, whether all conceivable alternatives encompassed by the generic "OR"-claim which are not disclosed in the priority document can be considered *in toto* as one alternative, as was the approach in T 1222/11, Reasons, 11.5.5, and T 571/10, Reasons, 4.5.9 and 4.9.14 (cf. also D25, page 18, right column, penultimate sentence, lines 15-19).

18. Question concerning Article 54(3) EPC

18.1 Requirements of Article 112(1) (a) EPC

18.1.1 Requests of the parties

In accordance with the parties' requests, the Board accepts that, if the Enlarged Board of Appeal were to conclude that partial priority may be refused in respect of subject-matter encompassed as an alternative by a generic OR-claim and disclosed in the priority document (cf. question 1 *infra*), it could become decisive for the present case to know whether parent application D1 could be opposed as state of the art under 54(3) EPC to Claim 1 of the divisional patent in suit.

18.1.2 Point of law of fundamental importance

This question of the applicability of Article 54(3) EPC in situations of potentially colliding European parent

and divisional applications is closely linked to the preceding ones, as it also involves priority issues. Indeed, two European applications of a same parent/divisional family could only collide where priority is claimed from an earlier application. Otherwise, parent and divisional applications will necessarily share, as their effective date, the date of filing of the parent application (Article 76(1) EPC). Hence, the Board considers the applicability of Article 54(3) EPC also to be a point of law of fundamental importance, which has far-reaching practical consequences, for instance in cases where a divisional is filed in response to a lack of unity objection.

18.1.3 Conflicting standpoints

The Board is only aware of decision T 1496/11, *supra*, relied upon by the opposition division in the decision under appeal, which applied Article 54(3) EPC in a situation of this type (divisional application cited against parent patent). This decision has attracted considerable attention from the interested circles and the controversial nature of the debate on this question is evident from the recent spate of publications, including D20 (last four paragraphs), D21 (points 3.8 to 3.10), D22, D23, D27 (points II.1, II.2 and IV), and D31 (point 1.6.6 and footnote 37).

The following arguments in particular have been invoked by the parties and in the literature as regards the applicability of Article 54(3) EPC in this context:

i) Arguments in favour

- Neither the wording of Article 54(3) EPC itself, nor that of Article 55 EPC concerning non-prejudicial disclosures, rules out that members of a European

parent/divisional family may be considered as state of the art under Article 54(3) EPC in respect of each other.

- Such an exclusion would provide an unjustified advantage to applicants choosing to file a divisional application from a parent application claiming a priority from an earlier application, compared to those filing parallel European applications claiming priority from the same earlier application.

- A European divisional application benefiting from the priority of an earlier application is a European application citable under Article 54(3) EPC, since according to the case law of the boards of appeal, parent and divisional applications are independent of each other (cf. G 1/05, T 441/92, T 1177/00).

ii) Arguments against

- The legislator did not foresee that the filing of a divisional application could create, retroactively, (fictional) state of the art pursuant to Article 54(3) EPC which would have an earlier priority than, and therefore be citable against, its parent application.

- The position that European applications belonging to a parent/divisional family cannot collide under Article 54(3) EPC also appears to be reflected in

"Europäisches Patentübereinkommen", Münchner Gemeinschaftskommentar, 8th edition, January 1986, Article 76(1) / Bossung, Notes 131 to 134.

- Moreover, it is perceived to be counter to the provisions of the Paris Convention (see also e.g. D25, page 16, bridging paragraph).

- A European divisional application is not citable under Article 54(3) EPC against the parent, in view of their special relationship: the root subject-matter is the same, the divisional may not comprise added matter compared to its parent and it is deemed to have been

filed on the same day as the parent application and shall enjoy any right of priority (Article 76(1) EPC).

18.1.4 Observations of the Board

i) The same special relationship does not exist in other situations of potential collision between two related European applications, namely between parallel European applications claiming priority from one and the same earlier application (as in T 571/10), or between a European application and its European priority application (as in T 1443/05), the latter situation sometimes being referred to as "toxic" or "poisonous priority".

ii) Although issues of priority, divisional applications and/or the purpose of Article 54(3) EPC were addressed by the Enlarged Board of Appeal in G 3/93 (OJ EPO, 1995, 18), G 2/98 (Reasons, 8.1, last paragraph), G 1/03 (OJ EPO, 2005, Reasons, 2.1 to 2.1.3), and G 1/05 (Reasons, 4.3), these decisions/opinions are silent on the specific question whether a parent and any divisional stemming from it may be considered as state of the art under Article 54(3) EPC in respect of each other.

18.2 Formulation of the question

The Board has formulated the question in broader terms than suggested by the parties, considering that potential collisions under Article 54(3) EPC could occur between any two members of a European parent/divisional family.

19. No referral question concerning Article 76(1) EPC
- 19.1 For the following reasons, the Board does not regard it as expedient to refer a question focusing on the effect of Article 76(1) EPC.
- 19.2 The Board considers that the Paris Convention and the EPC foresee that a first filing in a Convention country which discloses a specific subject-matter gives rise to a right of priority for this subject-matter, and that the priority date enjoyed by it is not to be lost if it becomes part of an application divided out from an application (the parent) claiming priority from said first filing.

Nevertheless, as confirmed for example in G 2/98 (Reasons, 4, third paragraph), priority can be refused for a **claim** if its subject-matter is not disclosed in the application from which priority is claimed, i.e. for substantive reasons. It appears that the same should be true even in the case of a claim of a divisional application, or the patent granted thereon, which meets the requirements of Article 76(1) EPC (rule against added matter over the parent application as filed).

- 19.3 In the present case, it would appear that if the answer to referral question 1 were to be in the negative, there would be no need for a question on Article 76(1) EPC of the type suggested the parties. However, if the answer to question 1 were to be in the affirmative, lines of reasoning developed by the Enlarged Board in relation to the five questions referred could likewise render a separate question on Article 76(1) EPC unnecessary.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board for decision:

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?

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated