

ET0377.95

DECISIONS OF THE BOARDS OF APPEAL

Decision of Technical Board of Appeal 3.3.4 dated 5 August 1998

T 377/95 - 3.3.4*

(Language of the proceedings)

Composition of the board:

Chairman: U. M. Kinkeldey

Members: C. Holtz

D. Harkness

Patent proprietor/Appellant: University Patents, Inc.

Opponent/Respondent: SmithKline Beecham Biologicals SA Patent

Opponent/Appellant: SmithKline Beecham Biologicals SA

Proprietor/Respondent: University Patents, Inc.

Headword: Herpes simplex virus/UNIVERSITY PATENTS, Inc.

Article: 54, 55, 56, 66, 87, 89, 112 EPC

Paris Convention (PC) Art. 4, 19

Vienna Convention (VC) on the Law of Treaties Art. 31, 32

**The European Convention on Human Rights and Fundamental Freedoms
Art. 6(1)**

**Strasbourg Convention on the Unification of Certain Parts of Substantive Law
on Patents for Inventions Art. 4**

Keyword: "Abuse" - "Period of grace" - "Priority date" - "Scope of Article 55(1) EPC" - "Referral to the Enlarged Board of Appeal"

Headnote

The following question is referred to the Enlarged Board of Appeal:

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

Summary of facts and submissions

I. The appeals lie against the interlocutory decision of 7 April 1995 by the Opposition Division whereby the patent-in-suit was maintained in amended form.

II. The present decision is limited to the appellant/patentee's first auxiliary request for a referral to the Enlarged Board of Appeal under Article 112 EPC of the question of the scope of application of Article 55(1) EPC regarding disclosures due to evident abuse.

III. Facts relevant for the Board's decision on this legal issue are the following:

An oral presentation was made by Dr Pereira at the 17th International Congress on Herpes Virus of Man and Animal held 7-9 December 1981 in Lyon, France (hereinafter "the Pereira presentation"). Both parties agree that Dr Pereira at this occasion presented two slides containing data which appeared also in the first priority application and in the European patent application at issue (tables 3 and 4).

The inventors (with whom Dr Pereira had co-operated by providing antibodies from her laboratory) published an article on their results in the Journal of Virology, 43:1099-1104, in March 1982, but without these data. Dr Pereira was included as co-author of the article. The first priority date claimed by the patentee is 18 February 1982 (US patent 350021). The second priority date claimed is 4 February 1983 (US patent 463141). The European patent application at issue was filed on 14 February 1983.

IV. At issue is whether or not a disclosure made within six-months before the priority date of a European patent application falls within the purview of Article 55(1) EPC, so that, if the answer to this question is yes, a disclosure which is found to be due to an evident abuse as required under this provision will be considered non-prejudicial and consequently not belong to the state of the art.

V. On the question of the appropriate interpretation of Article 55 EPC the parties argue essentially as follows:

The appellant/patentee

(a) In order to define the prior art to be considered for a decision under Article 100(a) EPC the Board would first have to decide whether or not the Pereira presentation was due to an evident abuse in relation to the applicant or his predecessors under Article 55(1)(a) EPC, and if answered in the affirmative, whether the relevant date for the calculation of the six-months term stipulated in that Article was the convention priority date or the date of the filing of the European patent application.

(b) The Opposition Division did not answer the first question but denied the applicability of Article 55(1)(a) EPC to the present case on the ground that the Pereira presentation had occurred more than six-months before the actual filing of

the present European patent application. The Opposition Division thereby disregarded an earlier decision of another Opposition Division, *Passoni/Stand Structure*, published in EPOR 1992, 79, in which Article 55 EPC was found to be applicable to the six-month period before the priority date of a European patent application.

(c) Article 89 EPC redefines the date of filing as the priority date in the case of a convention application by the provision that the right of priority has the effect that the date of priority should count as the date of filing of the European patent application. Articles 55 and 56 EPC also relate to prior publications and the state of the art and supplement Article 54 EPC, referring explicitly to it. Therefore the date of "the filing of the European patent application" under Article 55(1) EPC must be the same date as in Article 54(2) EPC and "the state of the art" for the purposes of Articles 54(1) and 56 EPC must be identical.

(d) The argument that Article 55 EPC could only be interpreted to refer to the actual filing of the European patent application since it is not mentioned in Article 89 EPC missed the point that Article 56 EPC also is not mentioned there. No one would conclude from this that a priority should be ignored when considering the inventive step of an application. The same rationale must therefore apply to Article 55 EPC which deals with special instances of the application of Article 54 EPC. If "the filing of the European patent application" in Article 54(2) EPC were effectively replaced by the priority date in view of Article 89 EPC, this must necessarily also apply to "the filing of the European patent application" in Article 55(1) EPC.

(e) It would be grossly unjust if the applicant, having filed the first application within six-months from the disclosure, were to be punished for not having also filed the European application within that period. More than 90% of all European patent applications claim an earlier convention priority date. If EPO practice were to restrict the application of Article 55 EPC, the protection provided by the provision on priority

rights would become illusory. The patentee only learned about the Pereira disclosure in 1992.

(f) The following question should therefore be referred to the Enlarged Board of Appeal:

When applying Articles 54 and 55 EPC to a disclosure of the invention which was due to, or in consequence of, an evident abuse in relation to the applicant or his legal predecessors, does the six-month period of grace permitted under Article 55(1)(a) EPC end on the priority date or the later European filing date?

The appellant/opponent

(g) Claims 1 and 2 of the patent as maintained by the Opposition Division lack novelty in view of the Pereira presentation. Article 55 EPC is not applicable to this disclosure, since it occurred more than 12 months before the filing of the EP application. The EPC is quite clear in this respect in that Article 89 EPC allows for the replacement of the filing date by the priority date only with respect to Articles 54(2), 54(3) and 60(2) EPC, not Article 55 EPC. The purpose of Article 55 EPC is to strike a balance between the legitimate interests of a potential patentee who has been wronged and the public at large. To enable a patentee to benefit from the exception provided by Article 55 EPC he must for his part act quickly and file his European patent. If this were not done within six-months of the disclosure, the requirement of Article 55 EPC would not be met and the public would then be free to make use of the disclosure.

(h) Decision T 173/83 notes, albeit obiter dictum, that the travaux préparatoires of the Munich Diplomatic Conference showed that the wording of Article 55 EPC was expressly chosen to ensure that this period would not be understood as relating to the date of priority, but to the actual date when the European patent application was

filed. Accordingly, the Pereira disclosure does not fall within the provision of Article 55 EPC and thus belongs to the state of the art.

(i) There is no need to refer a question on this point to the Enlarged Board of Appeal as the Board of Appeal is perfectly competent to take a decision on this question of law, on which it should be guided by the comments in decision T 173/83 of the previous Board of Appeal. Further, the question is not determinative for the outcome of the patent, since the patent is in any case anticipated by another document (Madras thesis, document A 1). It is not even determinative for the Article 55 EPC point as the patentee has failed to show evident abuse.

Reasons for the decision

Admissibility

1. Both appeals are admissible.

The scope of application of Article 55(1)(a) EPC - EPO practice

2. There is to date no decision by any Board of Appeal which has resolved the question at issue here. The scope of application of Article 55(1)(a) EPC has been discussed in a number of cases, but left undecided, on the ground that the Board had come to the conclusion that the disclosure in question had not been due to an evident abuse as required under that Article (see e.g. decisions T 173/83, OJ EPO 1987, 465; T 830/90, OJ EPO 1994, 713; T 436/92 of 20 March 1995 and T 585/92 of 9 February 1995).

It may be noted here that whichever scope is found to be the justified one, it will apply equally to cases under Article 55(1)(b) EPC, which concerns disclosures at certain international exhibitions.

3. However, no legal provision can be applied to a factual incident unless it is previously established that it is legally applicable to this same incident. Hence, contrary to the patentee's assumption that the first question to be resolved is whether or not the Pereira presentation was due to an evident abuse, the Board has to start by examining the question of the scope of application of Article 55(1)(a) EPC. From this follows further that the opponent's argument that an answer to the question of the scope of application is not determinative as long as evident abuse has not been proven also fails. If it is found that this provision only applies to the six-month period preceding the actual filing of the European patent application, the question of a non-prejudicial disclosure never arises and the Pereira presentation is part of the state of the art.

4. The only decision by an organ of the EPO dealing with this question is the Opposition Division decision of 8 July 1991 on application 82 107 958.9, the so-called Passoni case, in which it was found that - on balance - there were overriding reasons in favour of the applicability of Article 55(1)(a) EPC to the six-month period preceding the priority date of a European patent application. The main argument of the Opposition Division seems to have been the safeguarding of the right to priority rights guaranteed by the Paris Convention, the PC. It was noted that a vast majority of applications filed at the EPO claimed priority. As the EPC was a regional agreement under Article 19 of the PC, the Opposition Division argued that the EPC necessarily must be interpreted such as to conform to the PC. This meant that the EPO would be wrong to tell an applicant that because he had filed his application first with a national office he must lose his patent, whereas if he had filed directly with the EPO, his right to the patent would have been upheld. In this context the Opposition Division also referred to Article 66 EPC, which guaranteed that a European patent application which had been accorded a date of filing should be equivalent to a regular national filing, where appropriate with the priority claimed for the European patent application.

5. Decision T 173/83 (*loc. cit.*), cited by the opponent, did not resolve this question. In this decision the Board noted that there seemed to be a limitation of Article 55(1)(a) EPC to the six-month period preceding the effective date of filing, although there was no unanimity of doctrine, but concluded that a reply to this question was not necessary as in the Board's opinion the disclosure did not arise from an evident abuse (point 5 of the reasons).

6. Decision T 830/90 (*loc. cit.*) took the same approach, concluding that, as the evidence of prior public use was incomplete, it was superfluous to discuss the question of the non-prejudicial disclosure pursuant to Article 55(1)(a) EPC (point 4 of the reasons).

7. In decision T 436/92 (*loc. cit.*), the Board found that the applicability of Article 55 EPC rightly should be the first question to be decided, but nevertheless concluded that it could forgo a discussion on this point, presuming the Article to apply to the six-month period preceding the priority date, on account of the fact that it did not find any evident abuse (point 5.1 of the reasons).

8. Decision T 585/92 (*loc. cit.*) referred to the finding of T 173/83 (*loc. cit.*) that where a disclosure was not found to have been caused by evident abuse, a decision on the scope of application of Article 55(1)(a) EPC was not necessary.

Articles 55(1)(a) and 89 EPC

9. Article 55(1)(a) EPC reads, heading included:

"Non-prejudicial disclosures

(1) For the application of Article 54 a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six-months preceding the filing of the European patent application and if it was due to, or in consequence of:

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

10. Article 89 EPC reads, heading included:

"Effect of priority right

The right of priority shall have the effect that the date of priority shall count as the date of filing of the European patent application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2."

11. Starting with the wording of these provisions, there is a difference in that Article 55 EPC speaks of "*the filing of the European patent application*", whereas Article 89 EPC refers to "*the date of filing of the European patent application*" (corresponding differences are to be found in the German and French versions of the EPC). This may indicate that the difference is not coincidental, that the legislators did intend to differentiate between the two and that this may have been done with the aim of restricting the scope of application of Article 55(1) EPC.

12. Such an intended restriction of the scope of application might be inferred from the travaux préparatoires to Article 55(1) EPC. According to document M/PR/I, page 30, paragraph 61 of the German version from the Munich Diplomatic Conference on the EPC, on a question from the Dutch delegation, the chairman explained that "Anmeldetag" (i.e. date of filing, as in Article 54(2) EPC) should be taken to mean "Tag der Einreichung" (English: "the filing of", as in Article 55 EPC in its final version). Later, the wording was also amended accordingly.

13. It should be noted in this context that during the negotiations preceding the diplomatic conference some delegations had been opposed to a period of grace - adhering in their national patent laws to the concept of absolute novelty - and therefore may have had an interest in limiting the exception as far as possible (see e.g. doc. IV/2767/61/Brussels, first meeting of the working party "Patents", 17-28 April 1961 and doc 6551/IV/62/Brussels, sixth meeting of the working party "Patents", 13-23 June 1962). There was also a concern among various delegations that the provision be harmonised with a corresponding provision in a proposed convention on substantive patent law which was being discussed within the Council of Europe (adopted in 1963 as the Strasbourg Convention on the unification of certain parts of substantive law on patents for inventions, Article 4(4)(a)). At the Munich Diplomatic Conference, a number of proposals for amendments of Article 55 EPC were discussed, see M/PR/I, page 30, as was the question from the Dutch delegation.

Interpretation of international treaties

14. In the case law of the Boards of Appeal of the EPO the 1974 Vienna Convention on the Law of Treaties, the VC, is recognised as applicable to the EPC, see G 1/83, OJ EPO 1985, 60. Articles 31 and 32 VC provide useful guidelines for the proper interpretation of international conventions.

15. The basic method of interpretation is found in Article 31.1 VC, which provides that a treaty shall be interpreted in good faith in accordance with the ordinary meaning given to its terms in their context and in the light of its object and purpose. This corresponds closely to the so-called teleological method, i.e. the one by which the judge tries to adhere as closely as possible to the intentions of the legislator, while reading and understanding the words of the treaty in their normal sense, given the context in which they were written. This principle is recognised by the Boards of

Appeal, see for example decisions G 1/88, OJ EPO 1989, 189, J 4/91, OJ EPO 1992, 402 and T 356/93, OJ EPO 1995, 545.

16. Article 31.2 VC defines the context of a treaty as its text including the preamble and annexes, any agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty, and any instrument which was made in connection with the conclusion of the treaty by one or more of the parties and accepted by the other parties as an instrument related to that treaty.

17. Given the detailed way in which the term "context" is defined in Article 31.2 VC, this provision should probably be seen as exhaustive. This would mean that any understanding between only some of the delegations present or agreements entered into at a later stage are not considered as belonging to the "context" of a treaty, unless confirmed by all other parties to the treaty.

18. This understanding of the term "context" has a bearing also on the understanding of Article 31.3 VC, which provides that subsequent agreements between the parties and subsequent practices establishing such an agreement also may be taken into account. Again the definition of the term "context" in Article 31.2 VC would require all parties to the treaty to have entered into the agreement for it to be considered as part of the "context".

19. Finally, Article 32 VC mentions preparatory work and the circumstances at the conclusion of the treaty as a supplementary means of interpretation "in order to confirm the meaning of a provision resulting from the application of article 31 or to determine the meaning *when the interpretation according to article 31: a) leaves the meaning ambiguous or obscure; or b) leads to a result which is manifestly absurd or unreasonable.*" (emphasis added)

20. Article 32 VC seems ancillary to Article 31 VC and restricted to the situations mentioned, i.e. where a provision would appear ambiguous or obscure or lead to unreasonable results when applying the method given in Article 31 VC.

21. In applying these principles to the relevant provisions of the EPC, i.e. Articles 55 and 89, it may be concluded that the choice of terminology is consistent, namely if the legislator meant to differentiate between the conditions for priority rights under Article 89 EPC as opposed to the conditions for invoking abuse under Article 55(1)(a) EPC.

22. In the national patent laws of a number of the member states to the EPC the defence of abuse is also restricted in its application, for example Germany, France, the Netherlands, Italy and Sweden, as established in decision T 436/92, point VI.

23. On the other hand, according to the judgment of the Schweizerisches Bundesgericht of 19 August 1991 in the case of S. GmbH v. B. AG, see GRUR Int. 1992, page 293 ff, Swiss patent law seems to have accepted the broader scope of application.

24. It may therefore be concluded that there is a broad agreement among member states to the EPC, if not consensus, that the legislator's intention at the time of the adoption of the EPC was to restrict the right to invoke abuse to the six-month period preceding the date when the EP application was actually filed.

25. However, the present Board finds it necessary to examine this question further, since the result of such an interpretation of Article 55(1)(a) EPC could lead to an unreasonable result as discussed below.

Other aspects in the interpretation of an international treaty

26. Utilising another method of interpretation, the **dynamic** or evolutive method, organs competent to apply a given legal text may over time adapt the originally intended meaning of a provision when circumstances and/or attitudes have changed to the extent that the original intention no longer seems acceptable. This may happen when for example aspects should be taken into account which the original legislator either had not been in a position to consider because they were not yet in existence or had at the time assessed as not important enough to influence the provision in question. This method of interpretation is accepted by the European Commission and the European Court of Human Rights, see *Matscher*, Methods of Interpretation of the Convention, in Macdonald et al., The European System for the Protection of Human Rights, Kluwer Academic Publishers, 1993, page 63 ff.

27. One aspect to be taken into account when choosing a method of interpretation is the frequency with which priorities are claimed for European patent applications, which according to *Loth* (Artikel 55, Europäisches Patentübereinkommen, Münchner Gemeinschaftskommentar, 13. Lieferung, January 1990, page 31) hovered around 94% in the 1980's.

28. Another aspect is the time factor, i.e. the length of time for the prosecution of patent applications. It may have been a concern from the 1950's to the 1970's, when a European patent system was being discussed in the Council of Europe as well as within the EEC, that prolonged litigation over a patent application could result from the patentee relying on the defence of abuse. However, since the EPC adopted the approach of opposition after grant of the patent, the procedure before the patent granting authority was itself prolonged. Therefore the time argument does not seem to have the same weight with regard to the EPC as it might have in respect of national patent systems which still adhered to the laying open for public scrutiny and objections to the application before grant.

29. A separate argument against a broad scope of application could be that litigation in opposition cases would extend unduly because of the need for presenting evidence, including testimonies from witnesses. This argument, although valid at a time when applications could be examined and patents granted after only a year or two, seems less valid in an international system such as the European patent system, where half of the patent term may have already elapsed before a final decision is taken by an organ of the EPO.

30. To assess evidence a long time after the fact may be difficult, which is yet another aspect of the time factor which may have influenced the legislator when drafting Article 55 EPC. However, it can be seen from the discussion at the Munich Diplomatic Conference (ut supra) that the abuse that delegations had in mind related to patent applications filed by a third party who had no right to the invention in question. Establishing the facts as to the legal ownership of an invention should normally not become more difficult with time, whereas the time factor might adversely affect the chances of finding sufficient sound evidence supporting the circumstances surrounding a prior use.

31. Whether or not, in interpreting an international treaty like the EPC, a dynamic method should be adopted may be influenced by further factors as well. Among them, fundamental principles of procedure such as parties' equal rights before the law may prove decisive.

32. Whether the provision in question should be interpreted **narrowly** or not because of the fact that it represents a deviation from the basic concept of absolute novelty laid down in the EPC is another issue that needs to be considered. Such an approach has to be balanced against the legitimate interests of applicants to be awarded patents for innovative contributions to the art, at least where the availability to the public was beyond their control.

*The 1950 European Convention on Human Rights and Fundamental Freedoms,
ECHR*

33. This convention, which has been recognised in the case law of the Boards of Appeal as relevant for the purposes of the EPC (see e.g. decisions T 261/88, OJ EPO 1992, 627, and T 27/92, OJ EPO 1994, 853), lays down fundamental principles of procedure guaranteeing the parties the right to a fair and public trial.

34. Article 6(1) ECHR reads in its relevant parts:

"In the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law."

The concept of 'fair hearing' entails that all parties to a case must be treated equally, which in turn requires that their ability to defend themselves may not be unduly impaired.

35. In the case law of the European Commission and the European Court on Human Rights it has been established that a party's right to refer to evidence or to invoke events in order to refute a claim from the opposing party is essential for the fulfilment of the requirement of equal treatment, see *Sutter v. Switzerland*, Application No. 8209/78, Decisions and Reports 16, Council of Europe, 1979. In this case the European Commission established the principle that a party has the right to try and refute allegations made by the opposing party. This right includes the right to refer to evidence. Applied by analogy to a case of disclosure relating to a patent application, this would be tantamount to having the right to refer to abuse where the opposing party has alleged that the patent lacks novelty or inventive step because of a particular disclosure, occurring (as required in patent law) before the priority date, i.e. to invoke the special provision of Article 55(1)(a) EPC. Or, in other words, as the

European Commission held in an early case, Appl. No. 434/58, X. v. Sweden, Council of Europe Yearbook II, page 354, a party "shall have a reasonable opportunity of presenting his case to the Court under conditions which do not place him under a substantial disadvantage vis-à-vis his opponent."

36. The overall acceptance of the ECHR as guidance is shown by the fact that all member states to the EPC adhere to the ECHR.

Patent literature

37. Opinions vary on the scope of application of Article 55(1)(a) EPC in the literature on patents. Here, reference can be made to *Singer/Singer*, Europäisches Patentübereinkommen, C. Heymanns Verlag 1989, Artikel 55, Rdnr. 2; *Paterson*, The European Patent System, The Law and Practice of the European Patent Convention, Sweet & Maxwell, London 1992, page 382, 9-23, *van Empel*, The Granting of European Patents; Sijthoff-Leyden, 1975, page 45 and note 75; *Benkard G.*, Patentgesetz, 9. Ed. Verlag C.H. Beck Munich 1993, Patgesetz § 3, Rdnr. 96, C.I.P.A, Guide to the Patents Act, 4th Ed., Sweet & Maxwell, para. 2.30, page 57. Although these all agree that the scope of application should be restricted to the time period immediately preceding the actual filing of the European patent application, there are few reasons given.

Holding the opposite view are *Loth* (see above paragraph 27) and *Eisenführ* (Die Schonfrist-Falle des Art. 55 (1) a) EPÜ, Mitteilungen der deutschen Patentanwälte, 1997, page 268 ff). The Committee on National Institutes of Patent Agents (CNIPA), commenting as early as in 1962 on a proposal from the Council of Europe, found it "a curious anomaly" that a patent filed under the convention which was based on a "home" application could be refused, whereas the home application itself would be safeguarded (see document EXP/Brev. (62)6, Council of Europe).

38. One objection in the literature to a more extensive scope of application of Article 55 EPC is that this could lead to a "cumulation" of the six-month period with the one year period of priority, thereby extending the latter to exceed the 12 month priority term given under Article 4C of the Paris Convention.

This understanding seems however to be based on a misconception of the effect of a successful invocation of the defence of abuse. If the authority deciding this issue finds for the patentee, i.e. that the disclosure was indeed due to evident abuse, the result is only that the claimed disclosure is disregarded or in other words considered as not belonging to the state of the art. The date of priority remains the same and all other disclosures predating it still form part of the state of the art. It should also be noted that the heading to Article 55 EPC reads "non-prejudicial disclosures" and does not speak of cumulation. For this reason, an "extended" scope of application of Article 55(1)(a) EPC should not lead to any unacceptable results from the point of view of international law and obligations arising under another treaty.

39. The proponents of the broader scope of application point to the logic of the EPC, viz. that Article 54, paragraphs 2 and 3, EPC which are specifically mentioned in Article 89 EPC are again referred to in Article 55 EPC, and to the weakening of the right to priority resulting from a narrow interpretation.

The travaux préparatoires to the EPC

40. As it would take this decision beyond its confines to try and locate all relevant documents in which the concept of novelty and a period of grace may have been discussed, only a short summary of a few of them is given below.

41. The six-month period of grace under Article 55 EPC represents a deviation from a strict absolute novelty concept which dates all the way back to the discussions in the Council of Europe of a European patent system in the 1950's and 1960's. In doc.

CM/WP IV (51) a comparative study of the legal situation in European countries at the time was made. It can be noted from it that most countries adhered to the obligation under the PC to protect inventions having been exhibited at international exhibitions and the like, and that some countries allowed for a period of grace in cases of disclosures which had taken place without the inventor's consent (eg. UK and Scandinavian countries). German law even had a six-month period of grace which was valid generally for all disclosures made by the inventor himself, see doc. EXP/Brev (53) 1, page 7. The Secretariat of the Council concluded that there was an overall requirement of absolute novelty, but found a need for harmonisation of exceptions to this concept. There is no particular discussion of the start of the period of grace in this document, but the language consistently refers to the filing of the application. A Scandinavian proposal to this effect was discussed in doc. EXP/Brev (60) 1, page 15 ff. A disclosure made within a six-month period prior to the filing of the patent application was considered equitable and was already provided for in Scandinavian patent laws. A corresponding wording was later adopted in the 1963 Strasbourg Convention, Article 4.

42. As negotiations started in the EEC and later continued among an extended group of European countries, the Scandinavian proposal was again referred to, leading to the discussions and results mentioned above (paragraphs 12-13).

The relationship between Articles 54, 55, 56, 87, and 89 EPC

43. In the patent literature cited above (paragraph 37) another argument in favour of a restricted scope of application is that Article 89 EPC does not refer to Article 55 when providing that the priority date shall count as the date of filing, "for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2.", and that the language in the relevant Articles differs. This may merit a study of how the various provisions on novelty and the state of the art are related to one another.

44. Novelty is the first patentability criterion defined in the EPC, Article 54. The period of grace under Article 55 EPC refers to Article 54 EPC in its entirety, i.e. not only to its paragraphs 2 and 3. This would in ordinary language mean that novelty as defined in Article 54 EPC is qualified by Article 55 EPC. In fact, in some countries these two provisions are included in the same Article (cf. the UK Patents Act, Section 2, paragraph 4).

45. Article 56 EPC requires that inventive step be examined in relation to the "state of the art", a term which in turn is defined in Article 54(2) EPC, i.e. **including** the qualifying provision of Article 55 EPC. This seems to give the following result: if a disclosure is excluded from the state of the art under Article 54 EPC as a consequence of abuse under Article 55 EPC, it is also disregarded for the purposes of establishing inventive step under Article 56 EPC. Logically, this must mean that the reference in Article 89 to Article 54(2) EPC also includes any qualification of the latter by way of Article 55 EPC, i.e. that Article 89 EPC implicitly refers also to Article 55 EPC. In other words, the reference in Article 89 EPC should be read as saying: "..... for the purposes of Article 54, paragraphs 2 and 3, *as modified by Article 55 EPC, as the case may be....*". Such an implicit reading could explain why Article 89 EPC does not expressly refer to Article 55 EPC.

While opinions vary as to the reason why Article 89 EPC does not expressly refer also to Article 56 EPC (see the literature cited in paragraph 37 above), the Board would here only offer the comment that this may simply be due to the fact that inventive step (Article 56 EPC) is a separate patentability requirement which is only examined once novelty under Article 54 EPC has already been established.

46. However, the above does not explain why Article 89 EPC uses different language from Article 55 EPC (the "date of filing" as compared to the "filing of" in the latter).

47. Article 87 EPC uses the term "date of filing of the first application", the first application being an application filed in any state party to the PC, and provides for the right of priority during twelve months from that date. If, because of a restrictive interpretation of Article 55 EPC, this provision cannot be followed, as the priority right emanating from the "first" application cannot be guaranteed, it seems that this restrictive interpretation in itself contravenes not only the PC but also the EPC. In such a legal conflict it would be justified to interpret the law with the interest of the applicant and the obligation ensuing from the PC being of first importance. This would result in accepting the broader scope of application of Article 55(1) EPC.

Balancing opposite interests

48. As already pointed out by the Opposition Division in the Passoni case, it hardly seems reasonable that the fate of a patent application should be totally dependent on whether the application was originally filed with a national office or an international institution like the EPO. The result is that a person who has filed his application with a national office, even if in a member state to the EPC, when later filing with the EPO and claiming priority from the national application, may not invoke abuse in respect of a disclosure which occurred within six-months from the filing of the national (priority) application.

49. An opponent who wants to destroy a patent for which a priority has been claimed and also recognised by the competent authority (i.e. the EPO) must necessarily refer to disclosures which occurred before that priority date, otherwise they are not part of the state of the art. As an overwhelming majority of applications with the EPO claim priorities, the result is that in a corresponding number of opposition cases documents will be cited which date before the respective priority date.

50. However, the opponent in the present case objects to the conclusion drawn in the Passoni case, claiming that the restricted possibility of invoking abuse strikes a fair balance between the interests of the public at large and those of the inventor. When abuse has occurred the latter must - it is contended - be diligent and file his application within six-months.

51. The Board cannot agree with this argument as any diligence on the part of the inventor or owner of the invention presupposes that he immediately becomes aware of the disclosure. In the present case, the patentee states that the inventors were not made aware of the content of the Pereira presentation until 1992, i.e. eleven years after its occurrence.

52. The Board of Appeal would therefore conclude that a narrow interpretation of Article 55(1) EPC based on a requirement of diligence on the part of the inventor seems unreasonable.

Obligations under the Paris Convention (PC)

53. Article 4A(1) PC guarantees that any person who files an application in any of the countries of the Union shall enjoy the right of priority for the purpose of filing in the other countries. Under international law adhering states are obliged to adopt such legislation as is necessary in order to uphold the provisions of the treaty in question, in this particular case to guarantee the right to priority.

54. The EPC falls under Article 19 PC as a special agreement for the protection of industrial property. However, such agreements are only allowed in so far as they do not contravene the provisions of the PC. The possibility of regional conventions is also foreseen in Article 4A(2) PC, which refers to filings equivalent to national filings or filings under bilateral or multilateral treaties concluded between countries of the Union, i.e. in the present case EP applications. If it were to be concluded that

Article 55(1) EPC was intended to be restricted in scope as stated by the opponent, the result as shown above (point 4) may be considered as contravening the PC.

Decisions at the national level

55. Finally, the Board finds it appropriate to refer to decisions on the question of the scope of application of Article 55(1) EPC already taken at the national level, based on corresponding national legislation. In addition to the Swiss decision mentioned above (paragraph 23) two such decisions, one Dutch and the other German, have recently been published in volume 5 of the OJ EPO 1998, pages 278 and 263, respectively.

56. The Swiss decision

In this decision, the Swiss Federal Court came to the conclusion that Swiss law, which allowed for the calculation of the period of grace of six-months from the date of priority of an application, did not correspond to the intentions behind Article 55(1) EPC. The Federal Court consequently denied the patentee the right to invoke abuse related to a disclosure which had taken place more than six-months before the actual filing of the application in question. In arriving at this decision, the Federal Court referred mainly to the wording of the EPC and to the patent literature and *travaux préparatoires* which indicated that the scope of application of Article 55(1) EPC was meant to be restricted.

57. The Dutch decision

This decision of 23 June 1995 was taken by the Supreme Court (Hoge Raad) of the Netherlands in the case *Organon International BV et al v. Applied Research Systems ARS Holding BV*. The Supreme Court found that the calculation of the six-month limit under Article 55(1) EPC was based on the date of priority and not the date of filing. It arrived at this finding based on the following reasoning (see point 3.3.2 of the decision in the English version published in the OJ EPO):

"It follows from Article 89 EPC that the right of priority has the effect that, inter alia for Article 54(2) EPC - a provision which lays down the relevant state of the art in terms of time and hence is closely linked to Article 55(1) EPC - to be applied, the date of priority must be taken as being the date of filing of the European patent application. Article 55(1) EPC would not serve its purpose - to protect the applicant - if this provision were to be interpreted literally in cases of a pre-existing priority right. The system underlying the Convention thus justifies an interpretation according to which the date of priority also takes the place of the date of filing when calculating the time limit under Article 55(1) EPC."

58. The German decision

The German Federal Court (Bundesgerichtshof) handed down this decision on 5 December 1995 in case X ZB 1/94, "*Corioliskraft*". The patent had been revoked by the German Patent Office on the ground that an earlier patent application of 20 May 1978, claiming a priority date of 7 June 1977 (hereinafter "the citation"), anticipated the patent-in-suit, the application for which had been filed on 25 July 1978, claiming a priority date of 25 July 1977. The appeal court had dismissed the patentee's appeal on the ground that the period of grace under German patent law was to be calculated from the date on which the application for the patent in suit was filed. This interpretation of the German patent law was upheld by the Federal Court. Since, in the latter Court's view, the date of disclosure of the citation was considered to be its priority date, i.e. 7 June 1977, the result was that this disclosure had taken

place more than six-months before the date on which the application at issue had been filed, i.e. 25 July 1978, which excluded the right to invoke abuse. The Federal Court quoted the wording of the law and the prevailing view among German patent law scholars as well as decision T 173/83 (paragraph 5 above), but referred also to the opposite view held by others and to the Dutch decision (paragraph 57 above).

59. The fact that these decisions arrived at different interpretations is in this Board's view another reason why this question must be resolved at the European level, in order to further the harmonisation of national patent laws in Europe.

Referral to the Enlarged Board of Appeal under Article 112 EPC

60. The above survey of questions and problems relating to Article 55 EPC shows the complexity of the matter. In view of its significance, in particular with regard to the right of priority as required under the Paris Convention, the Board is of the opinion that it raises an important point of law, meriting the referral of a question to the Enlarged Board of Appeal.

61. The opponent, in addition to the objection raised in relation to the question of abuse, has however objected to a referral on the further grounds that (a) the Board of Appeal is competent to answer this point of law itself and (b) that it does not need to be decided as the patent is anticipated by another document cited by the opponent.

62. On the first ground, the Board disagrees with the opponent for the reasons firstly that this is a very fundamental question which may have far-reaching consequences and secondly because there is no consensus as to which interpretation of Article 55 EPC is justified. As all opinions expressed by previous Boards of Appeal on this issue have been *obiter dicta*, they are strictly speaking not part of their case law and therefore do not serve as guiding principles for subsequent boards, albeit that such

opinions may be noted in other decisions (notably the Enlarged Board of Appeal in decision G 3/93, in which decision T 301/87 was quoted on the issue of priority, although the latter was recognised as only containing an *obiter dictum* statement on the subject in question, see point 2 of the reasons in G 3/93).

63. On the second ground, the Board notes that it cannot predict, until an examination has taken place, the significance of any document cited against the patent. If the Board were finally to disagree with the opponent on the document cited, a need to discuss the Pereira presentation would arise.

64. Accordingly, the Board finds a referral to the Enlarged Board of Appeal necessary.

Order

For these reasons it is decided that:

The following question is referred to the Enlarged Board of Appeal:

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

* Case pending under G 3/98 (see OJ EPO 1998, 567).