

Decision of Technical Board of Appeal 3.3.2 dated 15 September 2003

T 998/99

(Translation)

Composition of the board:

Chairman: U. Oswald

Members: J. Riolo

P. Mühlens

Patent proprietor/Respondent: L'OREAL

Opponent/Appellant: Organogenesis, Inc.

Headword: Skin equivalent/L'OREAL

Article: 111(1), 87(1), 88(4) and (5), 89, 76(1), 54(3) and (4) EPC

Rule: 88 EPC

Keyword: "Validity of priority - no: Article 87(1) does not permit the same priority to be claimed over the priority period in respect of the filing in one and the same country of several applications concerning the same invention" - "Correction of error - no: the filing date of a divisional application cannot be replaced by that of the original application under Rule 88 EPC" - "Referral to the Enlarged Board of Appeal - no: the non-existence of case law is not a reason in itself"

Headnote

I. Article 87(1) EPC does not provide for the possibility of filing several applications in respect of the same subject-matter and therefore of the same invention in one and the same country over the priority period on the basis of a single priority document.

As provisions governing exceptions are subject to strict interpretation, only the first filing may enjoy a right of priority.

II Neither Article 4G(1) of the Paris Convention nor the corresponding provision in the European Patent Convention (Article 76(1), second sentence) provide for a situation where a divisional filing can generate a priority right dating back to the filing date of the original application.

Summary of facts and submissions

I. European patent No. 285 474 was granted on the basis of European application No. 88 400 502.6, which claimed the priorities of French applications FR8704205 and FR8708604 filed on 26 March 1987 and 19 June 1987 respectively. The sole claim of the patent as granted was worded as follows:

"Skin equivalent (27) composed of a dermis equivalent (24) covered with an epidermis equivalent (26), the dermis equivalent being a film formed from a type I collagen gel containing fibroblasts (14) arranged three-dimensionally in the said film, characterised by the fact that the epidermis equivalent (26) comprises:

- a) a basal membrane equivalent (5a) formed from a layer of laminin, fibronectin, type IV collagen and the bullous pemphigus antigen;
- b) cells (10a) of basal layer (6a) in a palisade arrangement, attached to the membrane equivalent (5a) according to a) by hemidesmosomes (39);
- c) cells (11a; 12a) of suprabasal layers (7a; 8a) which, beginning with the first suprabasal layer (7a), contain basic keratin of 67 kDa, and acidic keratin of 56.5 kDa;
- d) granular cells containing grains of keratohyalin, involucrine, transglutaminase and filaggrine;
- e) flattened and keratinised cells arranged near the free surface, giving, after extraction using dodecyl sodium sulphate and 2-mercaptoethanol, corneous envelopes characteristic of corneocytes, the cells of the different layers being attached to one another by desmosomes."

II. The appellant (opponent) filed notice of opposition against the grant of this European patent, requesting that it be revoked under Article 100(a) EPC for lack of novelty and inventive step.

The following documents were cited during the appeal procedure:

(55) FR-A-2 612 938

(56) FR-A-2 612 939

(57a) EP-A-285 471.

III. At the oral proceedings on 8 July 1999, the opposition division decided that, bearing in mind the amendments made by the patent proprietor during the opposition procedure, European patent No. 285 474 met the conditions set out in the EPC.

It considered that the "globally homogeneous" feature introduced in the claim established novelty vis-à-vis the state of the art.

Furthermore, it did not think there was anything in the state of the art that rendered the claimed subject-matter obvious because the documents cited in relation to inventive step referred to processes concerning different cell sources and/or substrates.

IV. The appellant lodged an appeal against this decision.

V. Oral proceedings were held before the board of appeal on 15 September 2003.

At the oral proceedings, the respondent (patent proprietor) asked the board to dismiss the appellant's challenge concerning the priority right on the grounds that it had not been made in due time. If, however, the board decided to admit the issue of priority right validity into the proceedings, it requested in turn remittal of the case to the department of first instance at the appellant's expense, referral to the Enlarged Board of Appeal and correction of the priority date under Rule 88 EPC.

The point of law to be put to the Enlarged Board of Appeal was: "Is it possible under the EPC to claim the same priority during the priority period in respect of two applications with claims of different categories, for example process and product per se?"

VI. The appellant was contesting *inter alia* the validity of the priority of the patent in suit because, it claimed, the same priority had already been sought for a first application. It therefore called into question the novelty of the patent under Article 54(3) and (4) EPC in view of prejudicial document (57a).

VII. The respondent refuted the appellant's assertions.

It held that the priority of patent (55) remained valid because the subject-matter of the two applications was different. It further asserted that the application also enjoyed the priority of document (56) which, while filed later than document (55), actually shared the same filing date by virtue of being a divisional application.

It concluded that document (57a) was not anticipatory under Article 54(3) and (4) EPC.

A new claim was filed by fax as an auxiliary request on 3 September 2003.

VIII. The appellant requested the cancellation of the contested decision and revocation of the patent.

The respondent's main request was that the appeal be rejected and its auxiliary request was that the patent be maintained on the basis of the claim faxed on 3 September 2003. If necessary, it requested that a point of law be referred to the Enlarged Board of Appeal.

Reasons for the decision

1. The appeal is admissible.

2. Admissibility of the challenge concerning the priority right

The respondent observed that the arguments regarding the priority right had not been made before the opposition division. It had therefore come as a surprise that the appellant was contesting the validity of the priority for the first time before the board of appeal and had concluded that the patent in suit was null and void for lack of novelty vis-à-vis European patent application (57a) under Article 54(3) and (4) EPC.

For this reason, the respondent requested that the question of validity not be admitted into the proceedings.

The board observes that this is a question of law, not of fact. This means that Article 114(2) EPC and the case law concerning late documents do not apply. Nonetheless, the requirements of Article 113 EPC in this regard have to be taken into account.

The board is in no doubt as regards this point given that the respondent was aware that the priority was being contested from the time the statement of grounds of appeal was filed, which meant it had ample time to prepare its defence.

3. Main request

3.1 Priority

European application (57a) was filed on 2 March 1988 under French priority (55) of 26 March 1987. The two documents, both descriptions and claims, are absolutely identical. The two claims of the set of claims relate to a process for obtaining a skin equivalent and to a product per se, ie the skin equivalent obtainable by this process.

The patent application in suit was filed on 3 March 1988, or one day later, under two priorities: French priority (55) dated 26 March 1987 and French priority (56) dated 19 June 1987.

The description of the patent application in suit is absolutely identical to the description in documents (55) and (57a) but makes only one claim relating to a skin equivalent as opposed to a set of two claims relating to a process for obtaining a skin equivalent and to a skin equivalent obtainable by this process respectively.

Thus document (57a) and the contested patent describe the same subject-matter and consequently the same invention.

Article 87(1) EPC states that "A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate, or his successors in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application."

Article 89 EPC stipulates that "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".

So the priority right is the right conferred on the person who applies for the first time for industrial property protection in one of the Union countries to request, within a given period of time referred to as the "priority period", a corresponding protective right in other Union countries without such a request being prejudiced by disclosures made during this period or conflicting applications.

The Convention is silent on whether it is possible to make several filings in respect of the same invention in one and the same country during the priority period and to claim separate priority for each of these applications.

The board is of the view that this is not possible, however.

While the Convention provides for multiple and partial priorities (Article 88(2) and (3) respectively), it does not provide for claiming the same priority several times in respect of applications filed in one and the same country of the Union and relating to the same invention.

The board is certain that the provisions of the Paris Convention that feature in the European Convention have to be interpreted strictly because they are provisions governing an exception.

Application (55) on the basis of which priority was validly claimed for European application (57a) could not therefore form the basis for a second priority claim within the priority period in respect of a different application concerning the same invention for the same countries of the Union.

For this reason, the patent in suit does not enjoy the priority right of filing (55) of 26 March 1987.

The board does not follow the respondent's argument that application (57a) and the patent in suit concern different inventions because the claims are different.

The product claim of application (57a), while referring to the process for obtainment, does comprise a product claim *per se* like the product claim of the contested patent.

Furthermore, as the product claimed in the contested patent is obtained by the same process as the product claimed in application (57a), given that the descriptions of the applications are identical and only disclose one and the same process for preparing the product, the board has no alternative but to conclude that both inventions are identical.

The board also observes that contrary to the assertions of the respondent, neither Article 87 nor Article 88 EPC concerning the priority right refers to the "claimed" invention or subject-matter.

This is understandable because the claimed subject-matter or the invention as claimed may be changed over the lifetime of a patent making it impossible to determine with any degree of certainty the scope of priority.

Finally, the board notes that the possibility of splitting a first filing and claiming priority separately for each part of this filing (divided priority), thus bringing about a situation which, as seen above, differs from the present case, has also not been provided for in the Convention.

As divided priority was not at issue in the present case, the board felt no need to express an opinion on this point.

3.2 Novelty

Since the descriptions in document (57a) and the contested patent are identical, and the designated contracting states are also identical, the board concludes that document (57a) constituted total anticipation of the patent in suit under Article 54(3) and (4) EPC.

4. Auxiliary request

The conclusions of point 3.2 also apply to the claim of the auxiliary request for the same reasons.

5. Correction under Rule 88 EPC

The respondent referred to point 4 of opinion G 3/93 of the Enlarged Board of Appeal (OJ EPO 1995, 18) which stipulates that "Articles 87 to 89 EPC provide a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application (cf. decision J 15/80, OJ EPO 1981, 213). The Paris Convention also contains rules of law concerning priority. The Paris Convention is not formally binding upon the EPO. However, since the EPC - according to its Preamble - constitutes a special agreement within the meaning of Article 19 of the Paris Convention, the EPC is clearly intended not to contravene the basic principles concerning priority laid down in the Paris Convention (cf. decision T 301/87, OJ EPO 1990, 335, reasons point 7.5)."

It then referred to Article 4G(1) of the Paris Convention which states that "if the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain

number of divisional applications **and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.**"

On this basis, it requested that the filing date of the second priority to which the patent in suit related, ie French application (56) filed on 19 June 1987, be replaced by the filing date of French application (55), ie 26 March 1987.

It thought that Article 4G(1) of the Paris Convention, which the EPO could not contravene according to G 3/93, made it clear that a divisional application retained the **benefit of the right of priority**, and as French application (56) filed on 19 June 1987 was actually a divisional application of French parent application (55) filed on 26 March 1987, it could take advantage of the date of 26 March 1987.

It therefore requested that the filing date of the second priority, ie 19 June 1987, be replaced by the filing date of the parent application, ie 26 March 1987.

The board observes that the provisions of Article 4G(1) of the Paris Convention concerning divisional applications were taken over in the European Convention in Article 76(1), second sentence, which stipulates that a 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 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 any right to priority.**"

Of course, these two wordings are not identical but the intention of both is the same and the only possible interpretation - taking the legal fiction that a divisional application is considered to have the same filing date as the original application - is that where the original filing has validly claimed priority, the divisional application also enjoys this priority even if the original application is divided and the divisional application is filed over a year after the filing of the priority of the original application.

This basically means that if initial French application (55) had claimed a priority right on the basis of a previous filing, divisional application (56) derived from the initial application would have benefited from this previous priority when prejudicial state of the art was being assessed.

There is therefore no reason to change the filing date of document (56) under Rule 88 EPC since there is nothing wrong with the filing date of divisional application (56).

Furthermore, the board notes that it seems *a priori* very doubtful that a divisional application could generate any such priority right because by definition such an application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed" and it could therefore not be a first application within the meaning of Article 87(4) EPC.

6. Referral to the Enlarged Board of Appeal

At the oral proceedings, the respondent maintained that the question of whether it was possible under the EPC to claim the same priority within the priority period for two applications with claims in different categories, for example process and product *per se*, should be referred to the Enlarged Board of Appeal on the grounds that it had never been put to it before and that to its knowledge there was no case law on the subject.

However, the board is of the opinion that the non-existence of case law on a particular point is not reason enough in itself to put a case and a related question to the Enlarged Board of Appeal.

Under the circumstances, it is first and foremost for the boards of appeal to decide on this question.

The request for referral to the Enlarged Board of Appeal is thus refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for referral to the Enlarged Board of Appeal is refused.