

## A Strategic Remedy for Toxic Priority in Divided Families

### Abstract

*We propose in an amicus curiae brief in Appeal G0001/15 a new purposive interpretation of EPC's Whole Contents anticipation provisions. This interpretation reads into those provisions an Exhaustion Concept and a Survivorship Concept which partially, but substantially, disapply those provisions to divided families. The two concepts operate co-ordinately, are independently effective and are well-grounded in the rules of purposive construction based in part on the contextual background documentation to EPC. Our approach has the strategic result that root applications are natural perennial survivors of Whole Contents conflicts between them and their descendants - which were previously proposed to be fatal. One dimension of Toxic Priority by Division, arguably its most important, is thus removed. Its removal potentially has the collateral benefit of substantially simplifying the management of the second dimension of Toxic Priority by division - Whole Contents anticipation of divisionals by citation of their family's root application. Over and above this, for instances where a root application ceases before official publication, we also propose a Surrogacy Concept under which a hierarchically next member of the divided family, filed with the benefit of content management legally impossible for the root application, takes the hierarchical place of the latter. Whilst timing of its deployment is critical and although such content management is likely to prove challenging, this additional concept should offer opportunities for tactical management of Toxic Priority threats resulting from exposure to root applications of other divided family members. None of our proposals change our current views on other measures to manage Toxic Priority by Division. These include use of domain structures to take advantage of EPC's partial/multiple priority provisions and the exclusion from priority-claiming applications of priority document content likely to fail a strict clarity test. Whilst our propositions introduce a legally reasoned basis to support outcome-oriented commentary elsewhere, they are contrarian and an Opinion from the Enlarged Board of Appeal of the EPO is awaited, hopefully this autumn.*

## A Strategic Remedy for Toxic Priority in Divided Families

### 1. Background and Introduction

- 1.1. A claim in an EPC patent application may encompass embodiments (P) disclosed in a priority document and embodiments (N) newly added at EPC filing. The claim (P, N) as a whole is then entitled to the EPC filing date only. However, it can be treated under the doctrine of “*partial priority*” as having separate virtual domains (P and N) which, in subject-matter and priority date terms, correspond respectively to disclosures originating in the priority document and those which do not. Novelty would be assessed for each domain based on priority date and subject-matter. The same model is applied by EPC to claims encompassing embodiments (P1) disclosed in a first priority document and embodiments (P2) disclosed in a second priority document, the claim then being virtualised as domains P1 and P2 (the doctrine of “*multiple priorities*”).
- 1.2. The rules governing application of the two doctrines are set down in case law but the case law is in conflict. In 2001, the Enlarged Board of Appeal of the EPO (the “*EBA*” - the EPO’s supreme appellate instance) stipulated in Appeal Decision G0002/98 that a claim could only be dismembered virtually when this produces domains which satisfy a double-barrelled test requiring that they constitute a “*limited number*” of “*clearly defined*” alternative subject-matters<sup>1</sup>. Lower appeal boards of appeal from 2001 – 2011 set stringent requirements based on a broadly common interpretation of the EBA’s ruling<sup>2</sup> (making plural priorities for one and the same claim poorly available). Case law in late 2012 adopted an appealing and very different approach<sup>3</sup> (which made plural priorities for one and the same claim much more available). The latter has enjoyed broad informal acceptance amongst EPO appeal boards but without confirming a unified opinion.
- 1.3. In divided families<sup>4</sup>, priority is sometimes asymmetrical - claims in one member can have a date later than that of encompassed subject-matter also disclosed in another. Where this imbalance exists, case law supports the proposition that the so-called “*Whole Contents*” anticipation provisions of EPC<sup>5</sup> permit anticipatory conflict between family members – conflict that could be mutual.

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<sup>1</sup> EBA Decision G0002/98, Reason 6.7: “[...] *The 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*”

<sup>2</sup> The so-called “*T1127/00 cluster*” of appeal Decisions required that a domain entitled to priority can only be visualised in a claim if the subject-matter of the domain is individualised as such in the specification of the patent /patent application (in some case in the claim itself) and also disclosed in the relevant priority document

<sup>3</sup> The approach adopted in Appeal Decision T1222/11 states that a domain can be visualised in a claim if its subject-matter is disclosed in the relevant priority document regardless of whether it is individualised in the specification of the patent /patent application

<sup>4</sup> A “*divided family*” for the purposes of this article is a family whose members are connected by their entitlement to the same date of actual filing by virtue of Article 76 EPC (EPC’s provisions on division)

<sup>5</sup> Under these provisions, a claim of an EPC patent/patent application is anticipated by any content of a later published EPC application falling within its scope if that content enjoys a priority date earlier than that enjoyed by the claim in question

- 1.4. The overall proposition, which has become known as “*Toxic Priority by Division*” or as “*Poisonous Divisions*”, first entered the public domain in a 2005 written submission in an opposition appeal<sup>6</sup> (where the writer represented an opponent respondent), was argued in opposition proceedings a year or two later by another law firm and subsequently was the subject of debate and significant legal writing in law journals<sup>7</sup>. Opinions amongst practitioners have differed and have not always drawn a distinction between arguments with legal force and those which are aspiration-led.

### Toxic Priority

#### **Problem**

In Appeal Decision T1496/11, parent Claim 1 in a divided family was based on the priority document and new matter added to the EPC application - so the claim was entitled only to the EPC filing date. A specific embodiment common to the priority document and the divided family (and thus entitled to priority) fell within parent Claim 1 and its instance in the divisional was held to anticipate the parent claim.

#### **Solution**

Under the “partial priority” doctrine, such a claim might be virtually resolved into (1) a domain entitled to the priority document’s date and encompassing the specific embodiment (assessed separately as novel by virtue of priority date) and (2) one not so entitled and excluding the specific embodiment (novel on a subject-matter basis).

- 1.5. The proposition is now before the EBA, having been referred up by a 64-page lower EPO appeal board decision in July 2015. The EBA will address the strategic question of application of EPC’s Whole Contents anticipation provisions to divided families, together with key issues of partial/multiple priority<sup>8</sup> having more general relevance. At oral proceedings in June 2016, the EBA heard oral submissions from the parties and the EPO President, and stated that it would issue a Decision in November at the latest.
- 1.6. In terms of tactical solutions to Toxic Priority, it is not easy to see that the double-barrelled condition set out in Appeal Decision G0002/98 is likely to be displaced by the idea that this condition is *obiter dictum* and to be disregarded, although that is possible. On the basis that it survives largely intact<sup>9</sup>, its requirement for the virtual domains into which a claim can be notionally fragmented to be clear and limited in number will still apply. These criteria may be applied by the EBA in such a way as to reduce or to increase the frequency and ease of finding and implementing Toxic Priority solutions. In particular, if the EBA decides that the clarity criterion applied to virtual domains of a

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<sup>6</sup> EP0642355

<sup>7</sup> Toxic Priority was made the subject of client-distributed law and practise information by the present writer in 2010, followed *inter alia* by a law journal publication (*Lawrence & Wilkinson, 2011* [1]). There have been numerous publications since that time

<sup>8</sup> EBA Appeal G0001/15; the first appellate instance Decision referring legal questions up is Appeal Decision T0557/13

<sup>9</sup> We opine in our amicus brief that it should

claim is significantly less onerous than application to whole claims of EPC's statutory clarity provisions<sup>10</sup>, the frequency of solutions will increase; the converse is also true.

- 1.7. On the strategic issue, we are on record with the view that a divided family cannot equitably be treated so that its members experience EPC's Whole Contents anticipation provisions more favourably than if they had been filed at the outset as independent patent applications. Those anticipation provisions have long been accepted as permitting *self-collision* between individual applications in common ownership. We now believe there is a possible legal basis for disregarding divisional applications completely as citations against other members of their divided family; but we have found no equivalent solution to Toxic Priority by Division where it is the root application<sup>11</sup> and not a divisional which is the citation. Our views are contrarian, and whether the EBA agrees on either count remains to be seen.

## 2. The Questions referred to the EBA

- 2.1. The first appellate instance has referred a total of five legal questions to the EBA. In this article, we will focus on Question 5. However, in doing so, it's necessary to touch on Question 1 (quoted below) and to an extent on Question 2 (which we will not quote here) as Question 5 depends upon them. Question 1 reads:

**Question 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?"*

- 2.2. Translated somewhat, Question 1 asks whether the EPO has jurisdiction to refuse priority for embodiments which a claim encompasses by generic expression(s) even if the following criteria - what might be called the orthodox criteria for priority entitlement - are satisfied:
- (a) The embodiment is disclosed in the relevant priority document. [Articles 88(3) and (4) EPC]
  - (b) It is enabled by that priority document. [established by case law]
  - (c) That priority document is the first application meeting criteria (a) and (b). [Article 87(4) EPC]
- 2.3. Our view is that Question 1 is answerable in the affirmative, but that the EPO's jurisdiction is subject to certain conditions.
- 2.4. In this respect, Question 2 appears to make clear that if the EPO has jurisdiction subject to conditions<sup>12</sup>, then Question 1 is answerable in the affirmative for the purposes of Question 5.

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<sup>10</sup> In our amicus brief, we suggest that the clarity provisions of Article 84 EPC represent the most natural approach as clarity of claims and of their component domains should be judged by a common standard

<sup>11</sup> The term "*root application*" refers to the ultimate progenitor of the divided family, to distinguish it from divisionals which are also *parents* because they have themselves been divided

<sup>12</sup> The issue of these "certain conditions" is covered by our amicus brief but we shall not deal with them in this article

2.5. Question 1 is specifically and exclusively directed to “*partial priority*” in its narrow sense<sup>13</sup> and so the question does not expressly subsume “*multiple priorities*”. We believe that the question is answerable in the same way for both “*partial priority*” and “*multiple priorities*” (based on a purposive construction taking into account the background contextual documentation in the so-called *Travaux Préparatoires* for EPC). Hopefully, and likely, the EBA will deal with both in its Decision although it is not impossible that it will not.

2.6. Turning to Question 5, this reads as follows:

**Question 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??”*

**3. Question 5 background and preliminary analysis of Question 5**

3.1. As in all patent systems, it is fundamental to EPC that patent protection should not be granted for subject-matter falling within the state of the art, the latter being constituted by the entirety of information available to the public before the priority date of the claimed subject-matter in question.

3.2. EPC additionally adopts the Whole Contents approach to anticipation (referred to in Paragraph 1.3 above). This is based on the principle that patent protection encompassing subject-matter which is disclosed in a first application (the citation), and which is there entitled to a first priority date, should not be granted separately pursuant to a second application in which that encompassed subject-matter is entitled only to a later priority date<sup>14</sup>. What is essentially a ban on *Duplicate Patent Protection* is achieved by applying the legal fiction that, as long as the citable subject-matter is actually officially published<sup>15</sup>, it is treated as forming part of the state of the art for novelty purposes retrospectively with effect from its priority date.

3.3. The Whole Contents approach to novelty is invoked by citations of third parties and in contexts in which the citation and the application/patent against which it is cited have common legal ownership. In short, the provision permits self-collision (as noted in Paragraph 1.7).

3.4. Toxic Priority is helpfully seen as a family of self-collision issues – one which has elements that are familiar and frequently encountered:

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<sup>13</sup> Paragraph 8.2.1 of the referring Decision states that “*partial priority*” is used in: “[...] *the narrow sense 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*”

<sup>14</sup> This, however, subject to the approach to selection inventions under EPC

<sup>15</sup> Article 93 EPC requires that the “*European Patent Office shall publish the European patent application as soon as possible (a) after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, from the date of priority [ ...]*”. If the putative citation is never officially published, then it never acquires citation status and has no anticipation properties

- (a) *Conventional Self-Collision*: Whole Contents self-collision other than in the context of “Poisonous Division” or “Poisonous Priority Documents”, between an application or patent and an application of the same applicant.
  - (b) *“Poisonous Division” or “Toxic Priority by Division”*: Whole Contents collision between members of a divided family, namely a family whose members are connected by their entitlement to the same date of actual filing by virtue of the Article 76 EPC – the provisions of EPC permitting patent applications to be divided.
  - (c) *“Poisonous Priority Documents”*: Whole Contents collision between members of a priority group, namely a group consisting of a published priority-conferring European patent application<sup>16</sup> and one or more European patent applications or patents which claim its date.
- 3.5. The perception of Toxic Priority in these terms has tended to be overwhelmed in public debate in the European IP community by the attention given to “*Poisonous Division*”. This is unfortunate because, as we outline below, solutions to Toxic Priority lead down a path in which comparisons between the three kinds of Toxic Priority are inevitably important.
- 3.6. Toxic Priority by Division is illustrated in Figure 1 below. It will be noted that this shows bilateral anticipation in which (i) earlier priority date content in a root application anticipates later-dated claims of a divisional application within whose scope that root application content falls and (ii) the converse situation in which, simultaneously, earlier priority date content in a divisional application anticipates later-dated claims of a root application within whose scope that divisional content falls (for which there is case law support in Appeal Decision T1496/11). This can occur in various factual circumstances. As illustrated in Figure 1, the EPC claims (Claims X and Y) in both divided family members have been narrowed to a scope not disclosed in the priority document (and are therefore not entitled to the priority date P1). More specific embodiments (Embodiments A and B), common to the divisional and root application specifications, fall within Claims X and Y, respectively, and are supported by disclosures in the priority document (such more specific embodiments therefore being entitled to priority date P1). Of course, in filing the divisional, Embodiment A might in this illustration have been excluded as not relevant to the subject matter of Claim Y<sup>17</sup>, and ought not to have been included<sup>18</sup>.

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<sup>16</sup> More definitively, the priority document must be (A) an EPC patent application, (B) a national application in an EPC Member State or (C) a PCT application which has entered the national/regional phase in (1) EPC or (2) an EPC Member State; note that EPO jurisdiction excludes conflicts with priority documents (B) and (C)(2). Thus, patentees/applicants outside EPC are in general not normally affected by the IP risk of Paragraph 3.4(c) - a US or Japanese priority document, for example, cannot be a *Poisonous Priority Document*

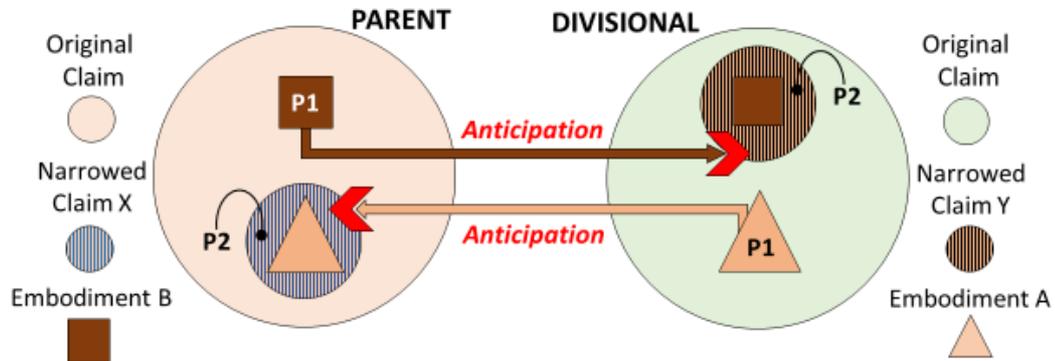
<sup>17</sup> However, this isn't always possible. Method + apparatus inventions, for example, will commonly include enablement-conferring content common to both aspects of the invention (which must be retained in both divided family members but then makes Whole Contents anticipation bilateral)

<sup>18</sup> But settings where instructions are restrictive and/or very urgent create a dynamic in which it is very easy for divisionals to be filed with material that isn't needed. Equally, such a dynamic may not foster consciousness that narrower claims will be needed and that they will not have the ideal priority date

**Figure 1**

The Bilateral Anticipation Effect of Toxic Priority

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3.7. In our view, there are three real essences contained within referred Question 5 which, when looked at from the starting point of first principles, point in the direction of a radical new vision of the Toxic Priority proposition which has up to now been elusive<sup>19</sup>:

- (a) Can EPC properly be construed in such a way that any member of a divided family interacts with the Whole Contents anticipation provisions of EPC in a manner which isolates it from the full effects of self-collision – either based on (1) a view of that member’s attributes or (2) a view that the Whole Contents anticipation provisions of EPC can be interpreted as having attributes which achieve the same result?
- (b) In answering the enquiry posed in Paragraph 3.7(a), is there (1) an inherent difference between the attributes of root applications on the one hand and divisional applications on the other and/or (2) an inherent aspect of EPC’s Whole Contents anticipation provisions which itself leads to a difference in the way the two application types are respectively treated?
- (c) If the answer to the enquiry posed in Paragraph 3.7(a) is YES, does this produce a double standard in EPC under which outcomes achieved by applicants in self-collision contexts are determined by mere procedural selectivity, and if so, is this an acceptable situation?

**4. A Survivorship Concept and an Exhaustion Concept - Overview**

4.1. Our consideration of the questions posed in Paragraph 3.7 above demonstrates that root applications are inherently different to divisional applications and that the mechanism of EPC’s Whole Contents anticipation provisions treats the two types of application differently.

4.2. Thus, we propose the following concepts to be applied to the interaction of EPC’s Whole Contents provisions with divided families:

**(a) Survivorship Concept**

<sup>19</sup> That radical new vision is one which the present writer was only able to formulate in the course of preparing an amicus curiae brief in the G0001/15 appeal proceedings

*Survivorship of the root application is fundamental to EPC's Whole Contents provisions:* EPC's Whole Contents provisions are intended to resolve a conflict by supplying a survivor to the prejudice of the other participant in the conflict; survivorship is fundamental. In resolving the conflict between a root application and a divisional, there is a logic which points to the root application as the favoured survivor.

**(b) Exhaustion Concept**

*Divisionals are never Whole Contents citations - as a result of 'exhaustion' of the Whole Contents purpose and effect of divided families:* EPC's Whole Contents provisions employ a mechanism by which a citation's "content" is incorporated into the state of the art and treated as having done so on the priority date to which it is entitled. In the case of a divided family, admittance of content to the state of the art would ordinarily<sup>20</sup> be when the root application had itself been published, and is likely to have been a historical event in relation to division. This exhausts the total capacity which the divided family as whole has for providing a citation effect; republishing the same content in a divisional application later fulfils no remaining function and is of no legal effect.

**4.3.** We outline our reasoning, with reference to the rules of statutory interpretation applicable to EPC, in the paragraphs below.

**5. The Vienna Convention on the Law of Treaties (VCLT1969)**

**5.1.** To address the questions in Paragraph 3.7 above, EPC's Whole Contents anticipation provisions require careful interpretation. In this regard, the official practise of the EPO is to apply the principles of VCLT1969 to the interpretation of EPC.

**5.2.** The non-binding nature of VCLT1969 on the EPO accommodates some diversity in the firmness with which this official practise is judicially stated. Appeal Decision G0002/02 states that its principles "[...] may be relied on to provide guidance in matters pertaining to the interpretation of the EPC". However, Appeal Decisions G0002/12 and G0002/13 (March 2015) diligently apply VCLT1969, with a willingness also to entertain "secondary considerations"<sup>21</sup>, and no doubt represent modern official practice.

**5.3.** VCLT1969 does not give primacy to any of the four *general* elements of interpretation of Article 31(1) VCLT1969 (see text Box); it is left to the interpreter to attach weight to each as thought fit (*Mouyal, 2016* [2]). However, a teleological approach can have a high profile in EPC appellate decision-making.<sup>22</sup>

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<sup>20</sup> We deal with non-ordinary situations later in this article, showing that they are not anomalous; however, that part of this text is best read in its proper turn

<sup>21</sup> Both Decisions first form an "intermediate conclusion" based on the interpretative process of VCLT1969 and then move to "secondary considerations": (1) a concept of "dynamic interpretation" (where "[...] considerations have arisen since the Convention was signed which might give reason to believe that a literal interpretation of the wording of the relevant provision would conflict with the legislator's aims") and one of "legal erosion" (where "circumvention" of an exclusion in an artificial way might mean that "[...] the legislator's intentions could be frustrated")

<sup>22</sup> Reason 3.3 of Appeal Decision T2473/12 mentions this quite strikingly: "[...] the construction of a written enactment must be purposive and not literal [...]"

## Vienna Convention on the Law of Treaties (VCLT1969)

### Overview

- A. VCLT1969 (which does not apply to EPC *ex lege*) provides a mixed, but textually-led, two-step approach to the interpretation of treaties. Article 31 VCLT1969 applies primary means of interpretation as the first step, whilst Article 32 VCLT1969 applies secondary means of interpretation if triggered by an inconclusive result from the first step (see Paragraph E below).

### Primary means of interpretation

- B. Article 31(1) VCLT1969 provides that a treaty (or part of one) is to be interpreted (i) in good faith, (ii) in accordance with the ordinary meaning to be given to the terms of the treaty and (ii)(a) in their context and (ii)(b) in the light of the object and purpose of the treaty.
- C. The term “*context*” is defined narrowly in Article 31(2) VCLT1969. As a statement of the obvious, it includes the overall text of the treaty. Less obviously, it excludes preparatory work leading to treaty completion - in the case of EPC, the Travaux Préparatoires<sup>i</sup>. The primary interpretation of an EPC provision must therefore be determined without reference to the Travaux Préparatoires.
- D. But Article 31(3) VCLT1969 states that later agreements and practices are to be taken account, together with context.

### Supplementary means of interpretation

- E. Article 32 VCLT1969 defines supplementary means of interpretation and gives power to invoke them to confirm the interpretation resulting from application of the primary interpretation means of Article 31 VCLT1969 or, as determinative, where that primary interpretation process either leaves meaning ambiguous or obscure or leads to a manifestly absurd or unreasonable result (the use of preparatory material to achieve an understanding of a treaty also being permissible<sup>ii</sup>). The Travaux Préparatoires fall within the class of supplementary means of interpretation which are conditionally available for consideration under Article 32 VCLT1969.

<sup>i</sup> Article 32, VCLT1969 defines preparatory work as a supplementary means of interpretation (*Ris, 1991* [3], *Linderfalk, 2016* [4] and *Linderfalk, 2015* [5])

<sup>ii</sup> *Gardiner, 2015* [6]

- 5.4. VCLT1969’s limitation to interpretative use of historical preparatory material only in a supplementary role, not universally respected in other areas of the law, is followed in the above EBA Decisions. Its implied elevation in Reason 16 of G0002/06 to the position of primary means of interpretation is not quite aligned with what appears to be the modern EBA approach and may mislead.

## 6. VCLT1969 and the Survivorship Concept

- 6.1. Following the principles of VCLT1969, the primary means of interpretation of EPC’s Whole Contents anticipation provisions (Step 1 of the VCLT1969 interpretative process: Article 31(1) VCLT 1969 – see Text Box) is textual but subject to context and to the object

and purpose of EPC. The interpretative question wrapped up in Question 5 of Appeal G0001/15 is whether members of divided families are capable of being citations against each other under EPC's Whole Contents provisions. Approached on a purely textual basis, the answer would appear to be that EPC's Whole Contents provisions give them that capability, as the provisions themselves contain no language to suggest otherwise but permit a bilateral conflict in a divided family to destroy both conflict participants (as illustrated in Figure 1).

- 6.2. When introducing context and purposive interpretation to the issue (which former does not formally include the Travaux Préparatoires – see Text Box), it is clear that when two applications are in Whole Contents conflict, EPC intended it to be resolved in favour of the application with the first filing date (or priority date, where one is claimed) to avoid Duplicate Patent Protection. This is set out as a principle in Article 60(2) EPC<sup>23</sup> and the mechanism for achieving it is set out in EPC's Whole Contents provisions, the two having a purposive nexus. However, whilst ruling out the textual interpretation, it is unclear how provisions built upon a first-to-file principle should be applied in the setting of such bilateral conflict in a divided family.
- 6.3. Article 31(3)(b) VCLT1969 requires that consideration to be taken of any practice, after completion of EPC, in its application “[...] which establishes the agreement of the parties regarding its interpretation”. Following the approach in G0002/13 of looking only at practice in the EPO, no such agreement can be established; many years in which divided family members were not cited against each other were interrupted by Appeal Decision T01496/11 in which a parent was held anticipated by its divisional. Article 31(3)(b) VCLT1969 therefore does nothing to provide clarity.
- 6.4. The lack of clarity triggers Article 32 VCLT1969 (Step 2 of the VCLT1969 interpretative process), making it appropriate and necessary to consult (at least) the Travaux Préparatoires. The outcome of that consultation is discussed in the following paragraphs.

## **7. Travaux Préparatoires to EPC1973 and the Survivorship Concept**

- 7.1. The picture of EPC's Whole Contents provisions as a means to avoid Duplicate Patent Protection is consistent with the minuted statement of the Chair in Proceedings of the 10th Meeting of the Patents Working Party (Travaux Préparatoires, Document 9081/IV/63-E-Final<sup>24</sup>), namely that:  
*“The basic idea of patent law was to grant a monopoly to persons making technical knowledge available to the public. It was therefore logical to give that monopoly to the first applicant, as the draft provided”.*
- 7.2. In this regard, overly literal approaches to the interpretation of contextual background documents underlying legislation do not recognise the lack of precision common in contextual background. Accordingly, allowing for a degree of imprecision in his language, the Chair in the above-quoted language can in fact be seen as remarking that

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<sup>23</sup> Article 60(2) EPC: *“If two or more persons have made an invention independently of each other, the right to a European patent therefor shall belong to the person whose European patent application has the earliest date of filing, provided that this first application has been published.”*

<sup>24</sup> See page 72, sixth paragraph

*the basic idea of patent law is to grant a monopoly on patent applications first making the relevant technical knowledge available to the public* (first availability being defined with reference to priority date but subject always to the proviso that the application is ultimately published).<sup>25</sup>

- 7.3.** It is to be noted that the EBA, in opining on the intention and purpose of the Whole Contents anticipation provisions of EPC, aligned itself in G0002/98, Reason 8.1<sup>26</sup> with the above attitude by stating that *“the right to the patent should be associated with the application which did actually disclose the subject-matter first.”* This statement can be regarded as more perceptive because it presents the conflict, accurately, as one between two applications rather than two applicants.
- 7.4.** The purpose of EPC’s Whole Contents anticipation provisions can therefore be characterized as follows:
- (a)** The avoidance of Duplicate Patent Protection
  - (b)** Its achievement using a novelty mechanism:
    - Which resolves the conflict between two patent applications in favour of survival of the “first” application (and thus to the prejudice of the other application).
    - Which, as a novelty mechanism, disregards all questions of whether the cited content in the citation has actually been granted patent protection, or is even capable of inclusion within granted patent protection<sup>27</sup>.
- 7.5.** The Travaux Préparatoires contain no suggestion as to how this purpose should apply in the context of a divided family - it is clear that the legislature did not contemplate the issue of Whole Contents conflicts in this context and left a lacuna.

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<sup>25</sup> The Whole Contents novelty provisions of EPC (Article 54(3) EPC) cannot seriously be construed purposively as limited to prevention of such later dated protection only when applied for by a third party applicant. If it were so-limited, abusive schemes involving surrogate applicants could be created in which third party title to such later dated protection could be achieved by assignment of a patent/patent application from a surrogate “self” applicant - and so circumvention of the provision by a “back door”. Moreover, self-collisions were absolutely intended to be embraced by the provision; self-collision was one of the most hotly and comprehensively debated issues in preparations for EPC but its inclusion in EPC survived the debate (as did much of the originally proposed language) as a result of an important compromise between the participating interests

<sup>26</sup> G0002/98, Reason 8.1 (third paragraph): *“This is perfectly in keeping with the very aim and object of Article 54(3) EPC, a provision which is based on the principle that when two European patent applications relate to the same subject-matter the right to the patent should be associated with the application which did actually disclose the subject-matter first.”*

<sup>27</sup> EPC’s Whole Contents provisions are sister to its conventional novelty provisions. The latter preclude patenting the prior art, whilst the former preclude patenting something which is already the subject of a patent application (already by reference to the priority date of the subject-matter in question). As a novelty mechanism, one would expect it extend to the *whole* content of the first application with the effect, and probably objective, of creating a wide safety margin (also, if the citation’s ability to claim the matter concerned required assessment, the law would suffer operational impairments which legislative history shows the legislature crucially wished to avoid)

- 7.6.** Appeal Decision G0001/97 establishes that ex-VCLT1969 gap-filling to close lacunae in EPC falls within the jurisdiction of the EBA<sup>28</sup>. There are two questions whose answers reveal how the lacuna should most appropriately be filled:
- (a)** In the context of bilateral anticipation as illustrated by Figure 1 above, what is the correct balance between:
- Preserving both the [root application] -> [divisional application] arm of the bilateral anticipation exemplified by Figure 1 and its [divisional application] --> [root application] arm - in subservience to an objective of avoiding (all) Duplicate Patent Protection, and
  - Preserving one only of those two arms of anticipation – in subservience to the objective of ensuring there is a survivor of the conflict?
- (b)** If one only of the two arms is to be preserved and the other ruled out, which is it (ie which application in a divided family is the *first application* in the sense of G0002/98, Reason 8.1)?
- 7.7.** It seems to us that the answer to the Paragraph 7.6(a) question turns on which of the two options can be shown to align most closely with sensible law-making, with the EBA perhaps taking an evolutive approach. If divided families involving bilateral anticipation contexts under EPC's Whole Contents provisions are likely to be rare, then this might tend towards an answer to the question which gives primacy to avoiding all Duplicate Patent Protection and thus accepting that some bilateral anticipation is in principle to be tolerated as the cost. However, divided families are a large constituency, perhaps the largest constituency of applications exposed to self-collision. Divided families are also the constituency most at risk:
- (a)** All members of a divided family are likely to have completely or substantially identical information content:
- Patent applications in divided families are therefore innately exposed to high risk from EPC's Whole Contents anticipation provisions (in the sense of both the probability *and* consequence dimensions of risk) in cases of partial priority and multiple priorities
- (b)** It has long been established that technology the subject of a first filing often continues to undergo development during the 12-month priority interval which follows, with resulting supplementary patent applications in the "home" country being filed during that interval and establishing additional filing dates<sup>29</sup>:

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<sup>28</sup> G0001/97, page 24, Paragraph (b) reads: *"In a codified legal system such as the EPC, the judge cannot simply decide, as the need arises, to substitute himself for the legislator, who remains the primary source of law. He may certainly find occasion to fill lacunae in the law, in particular where situations arise for which the legislator has omitted to provide. He may even contribute to the development of the law, beyond the filling of lacunae. In principle, however, statute law should provide him with reference points, even if these are incomplete."*

<sup>29</sup> *Shibata 2016* [7] quotes (amongst other references) the following seminal passage from a 1911 conference statement by the International Bureau: *"It often happens that, after filing a first patent application, an inventor improves his invention while the period of priority is still valid and requests for these improvements either ordinary patents or additional patents or certificates. The problem has arisen of whether the inventor who patents his invention in one or more countries of the Union can combine all of their elements in the same application [.....]"* [redacted; author's translation]

- Partial priority and multiple priorities are commonly experienced priority contexts arising from this reality<sup>30</sup>
- (c) In addition, non-unity of invention - a substantial contributor to division - is a circumstance which suggests basis in plural priority-conferring applications:
  - Plural priorities are therefore going to be especially common in divided families created to deal with non-unity objections<sup>31</sup>
- 7.8. Given an awareness of the above factors, the correct balance would appear to be to preserve only one of the two arms of anticipation as this would satisfy the objective of ensuring there is a survivor, as opposed to no survivors, of the conflict. To permit the law to operate so that there would be no survivors would be damaging to many divided families and would not be the correct balance; it compares unfavourably with tolerating some Duplicate Patent Protection. It would in particular be inconsistent with EPC's fundamental function stated in EPC to be the granting of patents and with the finding in G0001/03 that EPC's Whole Contents provisions should be applied with minimum effect.<sup>32</sup>
- 7.9. With respect to the Paragraph 7.6(b) question, there are a number of points to be made:
  - (a) First, and recapping, it is clear from the parts of the Travaux Préparatoires quoted above that EPC's Whole Contents provisions operate by citing the first application against the second, the first application/citation surviving at the expense of the second.
  - (b) In a divided family, the root application is in principle an ordinary application, with the property of citability as a Whole Contents citation against other applications **generally**, conferred on its official publication; it does not lose its normality on division either before or after that property is conferred. There is nothing in EPC to support the idea that EPC's Whole Contents provisions themselves change shape when applied to the citation of a root application against eg a divisional of the same divided family.
  - (c) A root application becomes citable against divisionals **specifically** as soon as the latter are filed, there being nothing in EPC giving divisionals a dispensation from

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<sup>30</sup> Plural priority date claiming is also increasingly popular. Limited and informal research (*Lawrence 2015* [9]) shows the following indicative figures for slices of 200 consecutively published PCT applications published, respectively, in 2003 and 2014:

- 2003: 14.5% of the applications in the slice claim two or more priority dates
- 2014: 21.5% of the applications in the slice claim two or more priority dates

For applications claiming two or more priority dates at least one of which is that of a US application, the proportions are significantly higher

<sup>31</sup> Limited informal research is reported (*Lawrence 2013* [8]) as indicating that EPC divisionals are about 3.7X more likely to claim multiple priority dates. The figure for divisionals claiming a single date but having subject-matter of two dates is unknown but perhaps even larger

For applications claiming two or more priority dates at least one of which is that of a US application, the proportions are significantly higher

<sup>32</sup> The EBA stated in Appeal Decision G0001/03 (Reason 2.1.1, paragraph 3) that "[...] *the intention was to restrict the effect of the earlier application as far as possible [...]*". The Decision does not refer to application of VCLT1969 but can be argued to have followed its principles

the need to satisfy all the requirements of EPC (as confirmed in several appellate decisions of the EPO<sup>33</sup>).

- (d) At that point, it is the root application which must be judged to be the first “...to actually disclose the subject-matter” of the divided family.
- (e) The judgment should not change with divisional publication. This would be illogical and prevent practical application of the law. In particular:
  - Re-assessing which application is “first” would also lack purpose in terms of EPC’s Whole Contents provisions as divisionals may be identical to, but cannot contain more than, their root application<sup>34</sup>.
  - Conceptually, citability and survivorship must reside as a duality in the same application. As incorporation of root application content into the state of the art is *irreversible*, and so therefore is citability, survivorship once conferred must be permanent.

**7.10.** Of course, the loss of the [*divisional application*] -> [*root application*] arm of the bilateral anticipation illustrated in Figure 1 through the Survivorship Concept should not be ignored. However, divided families experience Toxic Priority as a self-collision which does not usually involve opposing proprietorial interests. Resolving conflict under EPC’s Whole Contents anticipation provisions with survivorship of the root application is therefore free of the considerations which would have to be weighed in the balance in considering conflicts between *differently owned* patent applications. In short, no party is relatively advantaged/disadvantaged by loss of this arm of the bilateral anticipation scheme: the advantage/disadvantage attaches nominally to the relevant member(s) of the divided family rather than to any person<sup>35</sup>. In these circumstances, it appears that survivorship is far more important than preserving both arms of bilateral anticipation.

**7.11.** There is good evidence that the adoption of an interpretation of EPC which affects the operation of an established legal concept must be supported by convincing legal reasoning based on an overriding logic. This standard was in any event applied in the context of self-collision generally when it was deliberated in the preparatory conferences which led to EPC. That is recorded in the Travaux Préparatoires as an

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<sup>33</sup> Appeal Decisions G0004/98, G0001/05 and T0441/92

<sup>34</sup> In our view, any additional subject-matter in a divisional can have no legal effect under the Whole Contents rules of EPC. If present, it must be deleted. Prior to its deletion, the terms of Article 76 EPC - governing the filing and effect of divisional applications and their status - provides that, at least for any such additional subject-matter, a divisional application is not entitled to either the parent filing date or the priority date(s) claimed and cannot form part of the state of the art as defined in the Whole Contents anticipation provisions. This aligns with page 8 of Travaux Préparatoires, M/54/I/II/III, dealing with those provisions (“[...] it would be unjust to allow technical matter, such as new methods of carrying out the invention, examples, diagrams etc which were not contained in the earlier application, to become part of the state of the art.”) [page 9 is absent from the EPO’s online Travaux Préparatoires]

<sup>35</sup> Of course, the members of a divided family may be independently and individually assigned (see the final footnote to Paragraph 7.2), so creating opposing proprietorial interests. However, this constituency of applications/patents is relatively minor. Of course, additionally, the connection between members of divided families is publically notified so that all proprietorial interests can be taken to have notice of the facts as they impact on any assigned properties. Moreover, the rationale for avoiding universal disapplication of self-collision (explained in the Paragraph 7.2 footnote) simply has no applicability to divided families

approach supported by the chairman of a key meeting (10th meeting of the Patents Working Party, held in Brussels over the period 16 to 27 September 1963<sup>36</sup>). It is difficult to see that a lesser standard should apply now, 50 years later. That said, our view is that the arguments set out above meet this standard.

**7.12.** To summarise, the following is a respectable line of argument which can be advanced to the effect that, in a Whole Contents conflict between divided family members, the root application can be cited against other members but not the converse:

- (a)** It is fundamental to EPC's Whole Contents provisions that resolution of the conflict must leave a survivor.
- (b)** This fundamental feature extends to Whole Contents conflicts in divided families.
- (c)** In that setting:
  - The root application survives to the prejudice of its divisional.
  - Accordingly, this preserves the *[root application] -> [divisional application]* arm of the bilateral anticipation exemplified by Figure 1 but rules out its *[divisional application] -> [root application]* arm.
  - For there to be no survivor at all would be inconsistent with the fundamental objective of EPC's Whole Contents provisions and undermine its purpose.
  - In a divided family, precedence of root application survival over the objective of preserving both arms of the illustrated bilateral anticipation represents the appropriate balance.

## **8. The Exhaustion Concept**

**8.1.** According to the Survivorship Concept, EPC's Whole Contents provisions elect root applications as survivors of a Whole Contents collisions. Contrastingly, according to the Exhaustion Concept, it defines divisional applications as devoid of citation function and effect. The two concepts thus enmesh as the idea of a non-functioning divisional, explained in conceptual terms (see below) supports root application survivorship.

**8.2.** It is the "*content*" of an application that is added to the state of the art by EPC's Whole Contents provisions - not the application itself, which in effect is its wrapper. The distinction between the published application and its "*content*" as published is a crucial one: the wrapper defines each divisional as a new entity whereas the "*content*" of divisionals is never new – the "*content*" of every divisional is always present in the "*content*" of the root application (even though the latter may include content not reproduced elsewhere in the divided family)<sup>37</sup>.

**8.3.** The purpose of EPC's Whole Contents provisions is fully satisfied once that content is incorporated into the state of the art. A divisional application in the same family will be officially published later. With the content of both members of the divided family already pre-incorporated into the state of the art through root application publication, official publication of the divisional content has no effect on the state of the art – it

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<sup>36</sup> Travaux Préparatoires, 9081/IV/63-E-Final, page 72, Chairman: "[...] *important for the Convention to adopt a system corresponding to an overriding logical concept [...]*"

<sup>37</sup> EPC's Whole Contents provisions (Article 54(3) EPC) state (emphasis added):

"[.....] the content of European patent applications as filed... and which were published [.....]." is to be "...considered as comprised in the state of the art."

merely republishes subject-matter which the root application has already incorporated into the state of the art. The official publication of the divisional content thus fulfils no purpose under EPC's Whole Contents provisions - no purpose under those provisions remains unfulfilled at the time the divisional's content is officially published. If it has no purpose to fulfil, it follows that it has no effect under those provisions. In short, the divisional cannot itself serve as a Whole Contents citation – as the Whole Contents function of the divided family as a whole has been “*exhausted*” by publication of the root application's content.

- 8.4. The idea that the Whole Contents function of a divided family as a whole has been “*exhausted*” by publication of the root application's content is supported by a very basic purposive construction of EPC (although without assistance from the Travaux Préparatoires): the purpose of a legal provision informs purposive construction but the latter should not be informed by regard to any appendance to purpose (such as the *second instance* publication of content occurring when a divisional application is officially published) which looks needlessly beyond its fulfilment.
- 8.5. The Exhaustion Concept gives mechanistic support for the Survivorship Concept as it is the legal device which removes the threat which otherwise impacts on root applications, and because it explains root application survivorship in terms of the properties of other members of divided families. Looked at in reverse perspective, the Exhaustion Concept is also supported by the Survivorship Concept in the sense that the latter provides a rationale for the existence of the former. The mechanistic logic of the Exhaustion Concept is, we suggest, not easy to resist.
- 8.6. In summary, we believe that the Exhaustion Concept is well-grounded in a purposive construction of EPC's Whole Contents anticipation provisions and disqualifies a published divisional application as a Whole Contents citation.

## **9. Round-up of the Survivorship and Exhaustion Concepts, a Challenge and some Pointers forward**

- 9.1. As noted, the propositions we present argue that EPC's Whole Contents anticipation provisions have (1) a survivorship purpose which preserves root applications and (2) a coordinating mechanistic purpose in which addition of its contents to the state of the art leaves other divided family members with no Whole Contents function or effect.
- 9.2. The published root application then serves as the only potential prior art against later dated claims - both extrinsically *and* within the divided family. We can find no basis for an interpretation of EPC which removes this latter vestige of Toxic Priority by Division. However, the problem this leaves is unidirectional as opposed to the omni-directional problem which exists if a root application and its divisionals are mutually exposed to Whole Contents attack from each other. Our propositions would thus bring substantial relief to the divisional filing strategies which form part of many EPC patent protection programmes.
- 9.3. Nevertheless, the remaining impact on division is significant and division isn't always entirely a matter of choice. In division of root applications to address a non-unity objection in partial/multiple priority contexts, divisional Claims in some cases will encompass earlier dated embodiments of their root application; non-unity could be planned for with care but its shape is sometimes not recognisable until all the art has

come forward. It is worth at least wondering if the Opinion of the EBA in Appeal Decision G0001/91 contains a way forward in cases where Toxic Priority makes division to restore unity is so unviable as to fall within the framework of its Reason 5.1 part-quoted below (emphasis added):

*"[...] even though Article 102(3) and Rule 61a EPC may leave some doubts as to the importance of unity at the opposition stage, the lack of the legal institution of division shows that unity can no longer have any importance for the opposition or in opposition proceedings."*

- 9.4.** In some cases, divided families would benefit from careful distribution of claimed subject-matter so that susceptible claims are maintained and prosecuted in the safer harbour setting of the root application, although there are other tactical nuances discussed later in this article.
- 9.5.** It is appropriate, however, to challenge our propositions with the following question: *"Would the outcome of applying our propositions constitute an unresolvable anomaly as compared to that in the Conventional Self-Collision setting of two identical European applications, unrelated by membership of a divided family, otherwise having the attributes they would if they were as well involving subject-matter of two or more priority dates"*:
- (a)** In such a setting, each application would seem to be citable against the other, neither application surviving without remedial action - and perhaps neither surviving in any event. If this is an outcome permitted by EPC in the above context, it can be argued that EPC must also permit it in a divided family setting as both contexts ought to experience EPC's Whole Contents anticipation provisions in the same way.
  - (b)** However, the two contexts are very different. In the non-divided family context, an applicant has complete control, at the point the two applications are created, over the content of each which will be incorporated into the state of the art for Whole Contents anticipation purposes. To the contrary, at the point division creates plural applications, the applicant would have no control over root application content entering that state of the art<sup>38</sup> and control over divisional content which is limited to the right to omit from divisionals some root application content. In short, the applicant in the non-divided family context has the opportunity to constitute his applications in a way which preserves the rights he most values whereas the applicant in the divided context, if the root application is not an automatic survivor as we propose, may well not have that same opportunity. It is important that this disadvantage be ameliorated as far as the law can provide – eg as would transpire if our propositions are applied.
  - (c)** Referring to the non-divided family context in our challenge question: -
    - o A Conventional Self-Collision setting such as set forth in our challenge question would be rare.

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<sup>38</sup> Once it is filed, the future Whole Contents anticipation effect of a root application on publication is locked in; the entire content as filed is published unless, due to timely abandonment, there is no publication at all. (Per Appeal Decision J0005/81, an application has Whole Contents prior art effect only if still in existence at the time of publication, suggesting that abandonment will disable its usefulness as a citation even if abandonment is too late to prevent publication)

- Its rarity makes it aberrant, and it is acceptable in a pragmatic IP system such as EPC that rare aberrations should remain unremedied by the law.
  - An applicant electing to adopt the filing strategy referred to in our challenge question can reasonably be assumed to be aware of the resulting IP risk and to have exercised a fully informed choice.
- (d) To seek a blanket resolution to the apparent anomaly would effectively result in a review of self-collision in general, which would not be appropriate given the nature of the debate recorded in the *Préparatoires Travaux*<sup>39</sup>.

## 10. Strategic v tactical solutions

10.1. Tactical tools for managing Toxic Priority appear to be available within the split priority rules of EPC<sup>40</sup>. Invoking these rules involves dismembering, in a purely virtual exercise, each claim challenged by Toxic Priority attack from another member of the same divided family into virtual domains respectively entitled to an early priority date on the one hand and a later date on the other. Novelty is assessed for each domain as if it were a claim. The split priority discussion in *Lawrence, 2015 supra* [9] illustrates how this can be done; it also demonstrates the inherent (but perhaps avoidable/curable – see Paragraph 14) limitations of this approach - in particular, how a body of early priority date content in one member of a divided family may have the properties necessary to enjoy priority and anticipate a later dated Claim in another member, whilst its instance in the priority document is not clear enough under current legal tests for a virtual domain in that Claim to be legally recognised<sup>41</sup>. Questions relevant to use of these tools have been posed to the EBA in Appeal G0001/15 and the EBA will hopefully hand down a Decision which makes it clear how these tools are to be applied; we are hopeful that the Decision will take a position which reflects the flexibility illustrated in *Lawrence, 2015 supra* [9] whilst at the same time applying a clarity requirement for domains of claims which is consistent with the rules on clarity applied to claims as whole.

10.2. Our proposed Survivorship and Exhaustion Concepts, if followed by the EBA, would provide a more strategic solution to threats currently posed by divisionals to their root application. However, as discussed in Paragraphs 11 to 14 below, our broad proposals come with a penumbra of additional tactical opportunities which could make it easier to manage the citation of a root application against a divisional application, although largely in the mode of emergency repair.

## 11. Tactics influencing Whole Contents anticipation effects in divided families

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<sup>39</sup> See the final footnote to Paragraph 7.2 above

<sup>40</sup> See Article 88(2) EPC

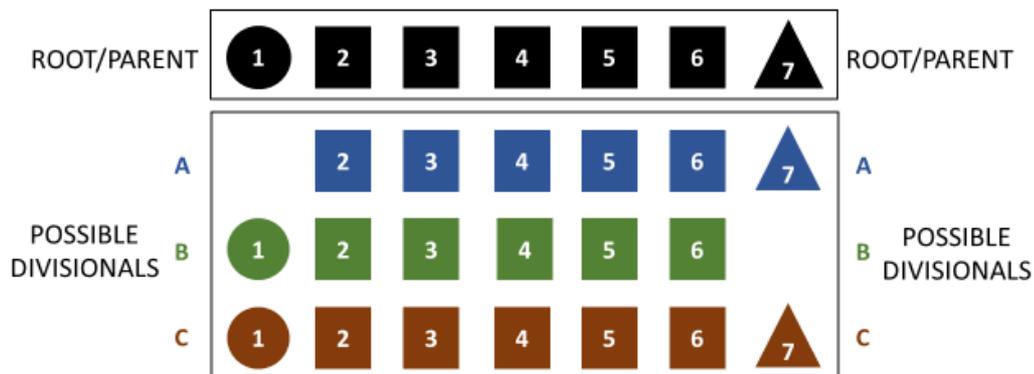
<sup>41</sup> It should be remembered that:

- (1) A body of subject-matter in a priority document *de facto* supports entitlement to priority date of an instance of that same body in an EPC application (assuming the context is also the same).
- (2) At the same time, however, it can fail to support the envisioning in a claim of the EPC application of a domain having that date.
- (3) The test for the former is, put simply, a subject-matter basis test whereas the test for domain recognition is whether the claim is virtually fragmented into domains which represent “[...] a limited number of clearly defined alternative subject-matters” (Appeal Decision G0002/98)

- 11.1.** As a necessary preamble to Paragraph 12 to 14, we refer to Figure 2 below. The symbols refer to blocks of subject-matter contained in the specification of a root application and in those of each of three possible divisional applications emanating from it. It is assumed that priority is asymmetric across the divided family – in other words, some claims are entitled to a later or plural possible priority dates and each member of the divided family discloses subject-matter which is there entitled to an earlier priority date and which falls within those claims. Figure 2 demonstrates a number of different contexts.
- 11.2.** Divisional C has the same content (signified in Figure 2 as “Content 1-7”) as the root application (whereas Divisionals A and B have lesser Contents 2-7 and 1-6, respectively,

**Figure 2**

Whole Contents Effects in Different Divided families  
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notably being different to one another although over-lapping)<sup>42</sup>:

- (a) Assuming we are right in reading into EPC’s Whole Contents anticipation provisions the Survivorship Concept and Exhaustion Concept, Divisional C cannot have the Whole Contents prior art effect it would otherwise have: it has no role under those provisions as the purpose of the provisions was fulfilled by the publication of the root application content which would already have taken place.
- (b) Divisionals A and B contain less content than Divisional C. For the same reason, they too have no role under EPC’s Whole Contents anticipation provisions and the root application survives them.
- (c) Further than this, none of the three divisionals has an effect on any other divisional (or any other application); the objectives of EPC’s Whole Contents anticipation provisions having been met by official publication of the root application’s content, none has any Whole Contents prior art function to fulfil.
- (d) The root application, having been published, has potential full-complement Whole Contents prior art effect against all the divisionals. The effect of this is that earlier priority date content it contains which falls within the scope of divisional

<sup>42</sup> None of them could contain more than the root application – as discussed previously in Paragraph 7.9(e) and its footnote

claims in any of Divisionals A, B and C anticipates those Claims – subject to tactical remedies based on EPC’s split priority tools.

- 11.3.** Figure 2, however, also illustrates the situation if the root application is abandoned and not published and divisionals are filed which contain either all or, alternatively, some but not all, of the root subject-matter - as discussed in Paragraphs 12 to 14.

## **12. Surrogate ‘Parent’ Applications**

- 12.1.** In an EPC-direct filing, the root application in Figure 2 could be abandoned without publication but divided whilst still pending. Let us assume that this produces, as a first divisional, Divisional C. The latter would then take the place, on publication, of the abandoned root; in doing so, it will fulfil the purposes of EPC’s Whole Contents anticipation provisions in relation to any divisionals divided from Divisional C, and any other divisionals, published after Divisional C. In this sense, Divisional C amounts to a *surrogate ‘parent’* identical to the *natural ‘parent’*.

## **13. Effects of Surrogacy**

- 13.1.** Surrogacy may have various other effects. By way of illustration, Divisionals A, B and C may first be divided from the root application in time-spaced succession and the applicants later abandon that root application in time to prevent its official publication. Divisional publication would normally be in the sequence A, B, C. In that case, things are not as simple as in Paragraph 12.1:

- (a)** The root application is not published and so its content is never added to the state of the art for the purposes of EPC’s Whole Contents anticipation provisions.
- (b)** Published Divisional A and published Divisional B collectively add all root application Content 1-7 to that state of the art:
  - Divisional A fulfils the purpose of EPC’s Whole Contents anticipation provisions, on its publication *first*, so far as Content 2-7 is concerned.
  - Divisional B fulfils the purpose of EPC’s Whole Contents anticipation provisions, on its publication *next*, so far as Content 1 is concerned (the purpose of those novelty provisions having already been satisfied as far as Content 2-7 is concerned).
- (c)** Through surrogacy, Divisionals A and B are potential Whole Contents citations against later Divisional C.
- (d)** But what is the relationship between Divisionals A and B? Overlap infers conflict and Divisional A (as “*first*”) should be the survivor at the expense of Divisional B. The oddity is that it seems that to fulfil the function of EPC’s Whole Contents provisions, Divisional B’s *de novo* publication should incorporate Content 1 in the state of the art, as this will be the first instance of publication of that content.

## **14. Tactical use of Surrogacy – A Solution for Toxic Priority in Divided Families?**

- 14.1.** The problem in the context noted in the text box at Paragraph 1.4 is that a specific embodiment of early priority date in a divisional fell within a parent claim of later date. But let us instead consider two changes to that context:

- (a) First, let's reverse the citation line to one where the cited material is in a parent rather than a divisional, because the premise in this article is that parents can anticipate divisionals but not the other way round
  - (b) Secondly, let's recognise that the Toxic Priority source may not be a specific embodiment at all – a passage in the earlier part of the specification could easily have the same effect.
- 14.2** In the scenario illustrated in Paragraph 13, Divisionals A and B have taken the place of the root application by *surrogacy* and in principle they exclusively carry in aggregate its entire Whole Contents relevance:
- (a) Contrasting with the restriction imposed on *ex post facto* amendment of parents at division point in the family, Divisional A (= surrogate parent), for example, could be filed with whatever part of the root application content is considered appropriate to manage its subsequent Whole Contents effect.
  - (b) Surrogate 'parenthood' might therefore be used for tactical surgical removal, from the non-specific description<sup>43</sup> of the basic mother specification, of bodies of early-dated "*chimeric*" material (ie material which, in its divided family instance, qualifies for priority entitlement and as an anticipation but which, in its priority document instance, fails to satisfy current legal tests for domain formation) whose *removal* could be tolerated but whose *presence* would found a Whole Contents anticipation attack.
  - (c) An example of such a body of material and how it might impact Claims in a divided family is illustrated in *Lawrence 2015* [9] (see Paragraph 5.2.3 and Case Study 1)<sup>44</sup>. This is also described for convenience below with reference to Figure 3 of this article.
  - (d) Figure 3 maps priority document, root and divisional application contents to a single figure. The figure shows a body of P1-dated chimeric matter (labelled "3") common to all three documents, its priority-entitled instance in one member of the divided family falling within, and anticipating, the P2 claim (labelled "4") of another.
  - (e) The anticipation is not relieved by envisioning the instance of matter "3" in the priority document as forming a priority domain within the Claim "4". Matter "3" is, we would argue, not clear enough in its priority document instance to satisfy the "*clearly defined*" legal test, despite this disclosure being clear enough in its divided family instances to qualify for priority entitlement and as an anticipation.
  - (f) Matter "3" could be excluded from a divisional which serves as a surrogate 'parent' in order to reduce the anticipatory potential of the latter and lead to better outcomes<sup>45</sup>.

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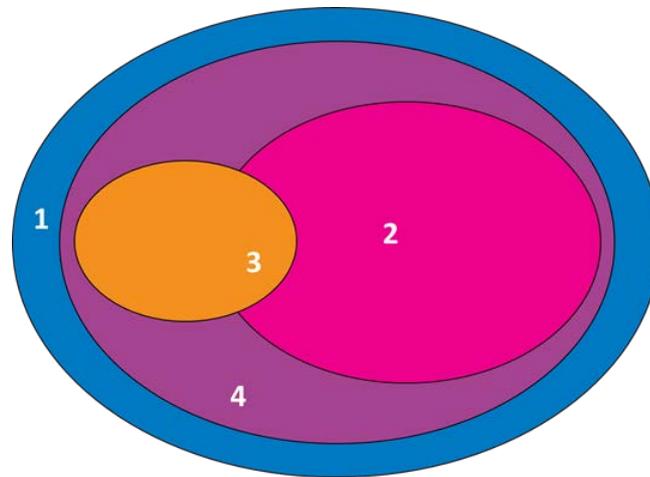
<sup>43</sup> Removal of relevant *specific* description such as an Example may be less easily tolerated

<sup>44</sup> Cited in Appeal Decision T0557/13 *supra*

<sup>45</sup> Such bodies of subject-matter do occur in patent specifications and in many instances their presence serves no essential purpose such as enablement, basis for novelty-conferring limitation, inventive step argument or priority conferring limitation

**Figure 3**

Chimeric Bodies of Content  
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**Priority Document**

**1. Broadest statement:** *In its broadest sense, the invention is an apparatus comprising [...] and at least one secondary member [...]* **P1**

**Priority Document & EP applications in question**

**2. Embodiment:** *In a preferred embodiment, the invention is an apparatus comprising [...] wherein there is a plurality of elongate secondary members, one or more of which is connected to another”* **P1**

**EP applications in question**

**4. Broadest statement + Claim:** *In its broadest sense, the invention is an apparatus comprising [...] and a plurality of elongate secondary members [...]* **P2**

**3. Embodiment:** *A particular embodiment of the apparatus of the invention comprises [...] and from 2 to 4 elongate secondary members which are relatively rigid and pressed from thin sheet to convenient shape”* **P1**

- (g) Of course, had the instance of Matter “3” contained in the priority document been encompassed by Matter “2”, then envisioning the latter as a priority domain In Claim “4” would have been protective against citation of Matter 3 by virtue of priority date. In that circumstance:
- o Matter “2” satisfies the “clearly defined” test.
  - o Matter “2” has priority date P1, and
  - o Matter “2” would encompass matter “3” so as to exclude it from the novelty battlefield.

**15. Asymmetry of Effect across the three forms of Toxic Priority**

**15.1.** The proposed Survivorship and Exhaustion Concepts result in asymmetry across a divided family in terms of the effects of EPC’s Whole Contents anticipation provisions. They also lead to a wider asymmetry across all types of Toxic Priority:

- (a) The two concepts offer no relief to situations where Conventional Whole Contents anticipation prevails. Accordingly, an applicant filing separate applications at the outset would (continue to) experience Whole Contents self-collision as in the past where one/both applications have claims of later priority date encompassing subject-matter having instances of disclosure of earlier priority date in the other. The self-collision risk would emphatically remain mutual between the two applications as compared with the unidirectional self-collision which would be experienced in a divided family in which the divisional(s) have no Whole Contents effect on root applications.
  - (b) Additionally, our propositions would provide no relief for situations where anticipation by a Poisonous Priority Document prevails. An applicant in such a case would therefore (continue to) experience self-collision, but subject to such relief as may be obtained from application of the split priority tools of G0002/98.
- 15.2** This asymmetry may be a price worth paying in return for the strategic solution to the risk posed by mutual anticipation between members of divided families offered by our proposed Survivorship and Exhaustion Concepts. It is, of course, open to an applicant to avoid Poisonous Priority Document issues, albeit with inconvenience but hopefully nothing more substantive, by adopting a filing strategy which does not permit the priority document to be published.

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