

Toxic priority: a 2013 epilogue



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0.1 There were important developments relevant to the topic of *Toxic Priority* which achieved high profile in the 12 months to September 2013, and some with a lower profile but perhaps not much less importance in Quarter 4 of 2013. This paper¹ is intended to pull them together to help readers to take an action-oriented view of the implications flowing from this complex topic.

0.2 The developments in question leave *Toxic Priority* as a proven IP risk. However, as seen at the end of 2013, the risk has a different look and feel than it did for much of 2012. The risk now comes with a different and much more hopeful outlook for patent owners than was previously the case. Conversely, opportunities for those considering challenges to patent validity based on *Toxic Priority* seem likely to be less frequent and more challenging.

0.3 **T1222/11**, which deals with partial and multiple priorities under **Article 88 EPC** although not directly with *Toxic Priority* as such, is the most significant development.

0.4 **T1222/11** deserves optimism as a reaction. However, there are two reasons why that optimism should be guarded. The first is the compound uncertainty as to whether **T1222/11** will be subject to an Enlarged Board of Appeal referral, what the EBA will rule if there is and in the meantime the extent to which **T1222/11** will be embraced by appeal boards of the EPO (and national tribunals) in well-argued cases².

0.5 The second is that **T1222/11** may not be a complete detoxification therapy. It leaves intact the dual conditions of **G0002/98**, Reason 6.7 for a claim to be treated as having virtual domains of different priority dates: the domains must be limited in number and, in particular, they must be “clearly defined”³. Accordingly, referring to the text box below, a body of P1-dated subject-matter contained in one member may form a missile whilst no P1-dated domain enveloping the missile subject-matter can lawfully be envisioned in the claim concerned.

1. Poisonous divisions – judicial perspective and incidence

1.1 As of December, 2013, **T1496/11** is the only decision from any European tribunal directly to validate the *Poisonous Division* concept *per se*. However, the now quite generous case law support for the conceptually analogous proposition of *Poisonous Priority Documents*⁴ ought to be seen as substantial indirect validation.

1.2 On the other side of the same coin, although there is no EPO appellate decision which rejects the principle, an Opposition Division decision handed down at oral proceedings in early December 2013⁵ rejected the *Poisonous Divisions* challenge from the Opponent. It appears to have done so plausibly insofar as it was based on a view of **T1222/11** but somewhat implausibly in other respects.

1.3 In terms of the wider stage, the concept appears to be generally “*in play*” before tribunals, although with unsurprising signs of some misunderstanding and an impression that more conventional validity attacks are preferred by parties, and indeed perhaps by tribunals. The writer previously reported *obiter* approval of the concept in a 2005 EPO opposition appeal case where reaction of an appeal board to a challenge on this basis was tested⁶. Patent validity has also been challenged on the basis of a *Poisonous Division* in a number of more recent validity proceedings, none so far resulting in a published decision on the issue⁷:

- In two EP oppositions (where the *Poisonous Divisions* challenge was withdrawn,

Toxic priority – a recap

Under **Article 54(3) EPC**, the content of a European patent application can have a prior art effect as a citation against the claims of another European patent application/patent even if the citation was not *prior* published. All that is required for so-called “*whole contents*” anticipation are that (i) the citation has been published, (ii) it discloses subject-matter falling within a claim of the application/patent against which it is cited and (iii) this subject-matter enjoys an earlier priority date in the citation than in that application/patent.

The doctrine of *Toxic Priority* recognises that the application/patent and the citation may be members of the same priority group (when *Toxic Priority* is referred to more specifically as the doctrine of *Poisonous Priority Documents*) or members of the same divided family (the doctrine of *Poisonous Divisions*).

According to *Toxic Priority* doctrine, a body of P1-dated subject-matter contained in one member (the *missile*) anticipates a P2-dated claim (the *target*) which encompasses the same subject-matter except where the *target* claim can be envisioned under **Article 88 EPC** as enveloping the missile subject-matter in a virtual P1-dated domain of the claim.

apparently for tactical reasons), the written phase of EPO oppositions included a challenge to the validity of a patent whose claims did not enjoy the claimed priority date as they had been narrowed relative to the priority document⁸

- A 2013/Q3 first instance preliminary view on a currently undecided EPO opposition pleading *Poisonous Division* but with no submissions made after **T1496/11**, failed to recognise T1496/11 or the *Toxic Priority* argument made⁹. The case demonstrates how easy it is for this issue to be misunderstood
- In another EPO opposition, a *Poisonous Divisions* challenge was made together with other challenges based on *whole contents* citations relevant due to alleged loss of priority for the claims attacked. A preliminary view pre-dating T1496/11 (and therefore T1222/11) focused on the other challenges and in so doing examined Reason 6.7 of **G0002/98** in considerable detail. The opposition was withdrawn before oral proceedings and following submission of amended claims

The early December 2013 rejection of a *Poisonous Divisions* challenge mentioned in Paragraph 1.2 occurred in the case of **EP2157457**. The case is interesting partly because of the Opposition Division's alignment with T1222/11 and partly for other features of the oral proceedings which add to the feeling that there are challenges both in asserting and defending against this argument. First, on the principal point, the Opposition Division had initially issued a preliminary view adverse to the patent based on T1496/11 but it later issued a non-adverse replacement based on T1222/11 shortly before the oral proceedings. It maintained that position in the decision it handed down. Secondly, the tribunal took the position at oral proceedings, understandable but in this writer's view incorrect, that divisionals are special and as such are entitled to special treatment in this context which protects them from the challenge¹⁰.

- Moving away from Munich, the *Poisonous Division* concept was pleaded in a UK High Court patent action scheduled to come to trial at some time in early 2014 but now settled.

1.4 Importantly, it is understood that general EPO Appeal Board sentiment towards the T1222/11 approach to split priority under **Article 88(2),(3) EPC** is now positive^{11,12}. This should be seen as a very encouraging development. However, the circumspection recommended earlier in this paper¹³ nevertheless seems appropriate as the debate on the issue of multiple priorities for one and the same claim probably still has time to run. In this connection, some views against T1222/11 have been expressed in the IP community, one very recently in "Opposing Views on Partial Priority", **David Pearce** and **Renaud Fulconis**, December [2013] *CIPA* 716-720 (see pages 719 and 720)¹⁴.

2. Judicial incidence of poisonous priority documents

2.1 It is not safe to assume that contexts comparable with **T0680/08**¹⁵ and **T1443/05**¹⁶ are going to be experienced only very rarely in practise. A single piece of technology will not uncommonly lead, not just to plural patents, but in some cases inevitably to a family of patents of which one or more is a priority document for others. As if to prove the point, whilst the issue of *Toxic Priority* stood short of the later more public debate, correspondence had been taking place between the EPO Legal Division and concerned practitioners in certain corporate IP departments¹⁷ whose IP strategies they considered could be impacted by this IP risk.

2.2 The UK High Court judgment in *Nestec*¹⁸, supra is, of course, broadly aligned with T0680/08 and T1443/05 and expressly relies on Reason 6.7 of G0002/98¹⁹. The same is true of the judgement in *HTC*^{20,21}. However, there is an earlier case of interest which has had much less visibility despite the fact that it related to a multi-jurisdictional dispute – *Novartis AG and Cibavision AG v Johnson & Johnson Medical*.²²

2.3 In the EPO fragment (T0246/04 – July 2007) of validity challenges made across the geography of that dispute, the board of appeal was not tasked with determining a *Poisonous Priority Documents* challenge. However, such a challenge was made against the same patent in the UK High Court and the *Bundespatentgericht*²³. The challenge was successful in the German proceedings, whilst in the UK the principle if not the whole argument survived the trial intact²⁴.

2.4 In October 2013, oral proceedings of the patentee EPO appeal (Appeal No **T1674/12**) on European Patent No **2 103 236**²⁵, the *Poisonous Priority Document* challenge was on the table, although apparently not discussed²⁶ in deciding the patent should be revoked; the issue was discussed at first instance and considered resolved by an Auxiliary Claim Request.

3. Divisional myths

3.1 A blog post in mid-2013, one amidst a great many in several separate lengthy strands, questioned whether it is reasonable that priority and divisional procedures should combine with "*such lethal effect*". The point being made is that patent applicants should be at liberty to use the device of division unhampered by the IP risk posed to divided families by the *Poisonous Division* concept.

3.2 This can, however, be shown to be a solution which is unfair in itself when one considers the position of a patent applicant who pre-empts division of a root application by creating the family at the outset instead. That pre-emptive family will, of course, be tested against all the requirements of EPC. This will include the full measure of those of Article 54(3) EPC, which provides within its terms that other members of the pre-emptive family are in principle as citable as any other citation falling within the Article's definition of "*state of the art*"²⁷. The proposition that **Article 54(3) EPC** should apply to divided families with greater leniency than to pre-emptive families is a double standard which has no basis in EPC.

3.3 The idea of what might be called “*divisional privilege*” is not confined to blog posts. In the opposition to EP2157457, the Opposition Division adopted the T1222/11 interpretation of Reason 6.7 of G0002/98 but gratuitously decided additionally to express some principles in favour of special treatment of divided families – doing so in a brief paper²⁸ which it supplied to the parties only at oral proceedings²⁹. The Opposition Division opined that the *Poisonous Division* effect goes:

beyond the legislative purpose of Article 54(3) EPC”, and that it would be “illogic (sic) to consider a parent application (or a divisional) among the documents mentioned in **Article 54(3) EPC**.

Not only does this challenge the established principle of the independent status of divisionals³⁰, but the tribunal appears not to have considered that this creates two tiers of patent applicants. Those who file applications which are divided in prosecution would experience an attenuated application of Article 54(3) EPC; those who pre-empt division by filing separate applications at the outset would not be given the same privilege. The principle of fairness requires that the two applicant constituencies must be treated in an equivalent way. The proposition in the Opposition Division’s paper is a cure which is worse than the malady.

3.4 An excellent and thoughtful late 2013 paper written by **Rudolf Teschemacher**³¹ also expresses a concern that the *Poisonous Division* risk hampers division. It must be acknowledged that the paper also properly recognises that the central problem is not division, but priority and the narrow interpretation of Reason 6.7 of G0002/98 adopted by most appeal boards. However, the core themes of the paper may leave in the shade the point that patent applicants creating families by division during prosecution and those who pre-empt division should form a homogeneous population in terms of what each constituency has a legal right to expect.

4. Where T1222/11 helps and where it may not

4.1 As noted in Paragraph 0.5, T1222/11 brings to centre stage the dual conditions for a claim to be treated as having domains of different priority dates. In particular, both

G0002/98 and T1222/11 make it a condition that that such domains must be “*clearly defined*”. This condition means that it will not always be possible to virtualise a priority domain within a claim in order to address a *Toxic Priority* scenario. This is a crucial message from the decision. This paper will try to illustrate below contexts where the approach to priority of T1222/11 cures *Toxic Priority* and where it does not.

4.2 As summarised in the Table below, the context in each of Figures 1 to 3 below is composed of a patent claim in a root application (referred to hereinbelow as “parent claim” for simplicity) and a disclosure at one of three levels which is common to the priority document (dated P1) and the description of a divisional divided out of the root application³². Only one of the three may be capable of supporting a (useful) claim split to create a virtual priority domain.

4.3 In Figure 1, the parent claim is not entitled to priority P1 from Disclosure (1) in the priority document because the claim is narrower than Disclosure (1) and so does not relate to the same invention in the sense of G0002/98.

4.4 Applying the split priorities doctrine of G0002/98 (Reason 6.7) as interpreted by T1222/11, no domain can be visualised in the claim which subsumes Disclosure (1) of the priority document; to the contrary, as inferred by Paragraph 4.3, Disclosure (1) is broader and falls in part outside the claim boundaries. Claim has priority date P2.

4.5 However, in this illustration, the claim is novel over Disclosure (1) in the divisional, by virtue of the limitations it contains, despite the P2 date of the claim.

4.6 Taken as a whole, the parent claim in Figure 2 fails to secure priority date P1 based on Disclosure (2) of the priority document; the claim is too broad.

4.7 However, the outcome of applying split priority doctrine is problematic for the parent:

(a) Disclosure (2) is also contained in the divisional, has date P1 and falls within the scope of the parent claim; it is thus a potential P1 *missile* against the claim.

Parent Claim

“Apparatus comprising... and a plurality of elongate secondary members...”

Description of Priority Document and Divisional Specifications

Disclosure (1)

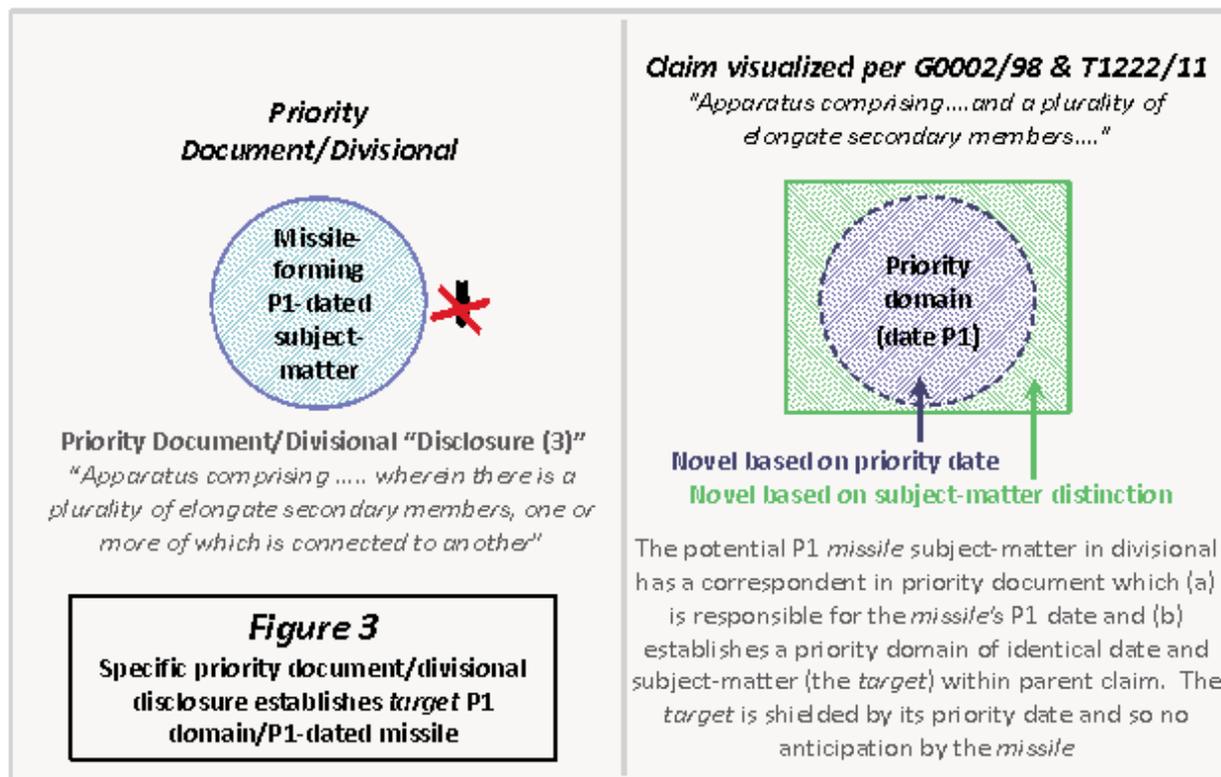
“Apparatus comprising... and at least one secondary member...”

Disclosure (2)

“Apparatus comprising... wherein the secondary member(s) are relatively rigid elongate members pressed from thin sheet to convenient shape”

Disclosure (3)

“Apparatus comprising... wherein there is a plurality of elongate secondary members, one or more of which is connected to another”



- (b) It is tempting to conclude that one can visualise in the parent claim a virtual P1 priority domain corresponding in content and scope to Disclosure (2) in the priority document. However, the candidacy of a disclosure as a *missile* and as a priority domain are not subject to the same tests, the latter calling for compliance with the "clearly defined" test of Reason 6.7 of G0002/98.
- (c) Whilst Disclosure (2) in the divisional qualifies as a *missile*, its language lacks clarity, at least in the sense of Article 84 EPC ("*relatively rigid*", "*thin sheet*" and "*convenient shape*" on the face of it lack clarity in an Article 84 EPC sense). As such, it appears seriously open to question whether Disclosure (2) in the priority document can lead to a virtual priority domain within the parent claim as, lacking clarity, such a domain would not satisfy the "clearly defined" test of Reason 6.7 of G0002/98³³.
- (d) If Disclosure (2) in the priority document does not support split priorities for the parent claim, then the claim can only have its priority date assessed as whole; as a whole, the claim is not entitled to the P1 priority date of the priority document for the reason given in Paragraph 4.6. The claim is therefore anticipated under **Article 54(3) EPC** by the P1-dated *missile* corresponding to Disclosure (2) in the divisional.
- (e) Importantly, Disclosure (2) enjoys an independence from Disclosure (3) and thus e.g. the P1-dated *missile* it forms is not limited to one or more of the secondary members being connected to another. If it were so limited, the missile

- would fall *within* the P1 priority domain virtualised by Disclosure (3) and the claim would be shielded.
 - (f) The set of facts leading to the conclusion in Paragraph 4.7(c) and (d) above has a degree of artificiality but is not without realism – the facts are actually a disguised version of a real situation in which new technical features have been substituted for those in the original. Equally, one can scarcely be certain that the conclusion is legally sound. That said, the prospect that the conclusion is right is not so far-fetched that negligible risk can be assumed; that debate is taken further in Paragraph 5 below.
- 4.8 Taken as a whole, the parent claim in Figure 3 fails to secure priority date P1 based on Disclosure (3) of the priority document; as in the case of Figure 2, the claim is too broad.
- 4.9 Applying split priority doctrine, the outcome differs from that in Figure 2:
- (a) Disclosure (3) in the divisional has date P1 and is a potential missile against the later-dated parent claim (i.e. that block of subject-matter makes the divisional potentially poisonous)
 - (b) As noted already, Disclosure (3) of the priority document is narrower than the parent claim (falling entirely within its boundaries). As such, applying T1222/11, the parent claim can be seen as subsuming a virtual priority domain having the same content/boundaries as Disclosure (3) of the priority

document. That domain (the *target*) is therefore entitled to priority date P1.

- (c) As the *missile* and its *target* have the same priority date, the missile is ineffective; the target is shielded by its priority date.

4.10 There cannot be much doubt that outcomes as depicted in Figure 3 are significantly more likely to be experienced in practice than those depicted in Figure 2.

5. T1222/11 and the “clearly defined” test of G0002/98, Reason 6.7

5.1 Nevertheless, distilled from the above is that, in a divided family, a block of subject-matter in a priority document may support the priority date of the same block (*missile*) in a Family Member A without supporting the virtualisation of a priority domain of the same date and subject-matter in a claim (*target*) of a Family Member B. This is simply because Reason 6.7, G0002/98 imposes (*inter alia*) a “clearly defined” test in the latter of the two settings. It is this which (mainly) gives rise to the risks associated with *Toxic Priority*.

5.2 The question which must be asked is whether this is what G0002/98 intended to happen, and specifically whether clarity in an Article 84 EPC sense is what was intended. It is submitted that the answer is probably yes on both counts.

5.3 The largely logic-driven case is as follows:

- The second sentence of Article 88(2) EPC, especially as seen against the background of the FICPI Memorandum, makes clear that multiple priorities for one and the same claim is conditional – and uses very general language in doing so.
- Self-evidently, the Enlarged Board of Appeal intended in G0002/98 to impose real limits on what priority domains were permitted to be virtualised within a claim and what were not (the imposition of limits constitutes an interpretation of the qualifier “where appropriate” in Article 88(2) EPC³⁴).
- It did so by purposefully inaugurating (*inter alia*) the “clearly defined” test³⁵
- That test can also be justified in more general terms than relying on G0002/98 and Article 88(2) EPC:

- Clarity in claims is required so that the public can (i) determine scope with reasonable legal certainty for infringement assessment purposes and (ii) have the same legal certainty in assessing scope for validity purposes.
- A logical expansion of (ii) above is that clarity should be required as to where the frontiers are between a priority domain and the rest of the claim even though the priority domain is virtual and not represented by language actually appearing in the claim where it sits. Different domains interact differently with validity considerations according to their priority dates, and the public needs

clarity as to where the boundaries of these domains are for the purposes of freedom-to-operate decisions based on validity/invalidity.

- Article 84 EPC states that claims should be clear (and concise). This may not automatically read across to an identical clarity requirement for domains which are virtualised for the purposes of asserting multiple priorities for one and the same claim. However, the purpose of Article 88(2),(3) EPC was to permit a simpler manner of claiming matter having more than one priority date but with the same effect as if a claim was expressly split into the required number of separate claims³⁶. Article 84 EPC would apply to such separate claims and logically and equitably it ought to apply to corresponding virtual priority domains conceived with the scope of a claim.
- The test in any event should logically be an Article 84 EPC clarity test as the context of the test is a patent claim and no other form of clarity test could have been intended.

5.4 Even so reasoned, the test seems at first glance quite a harsh requirement and it’s therefore worth reflecting back to the basic statutory construction question of whether, by reference to outcomes, it is reasonable and appropriate³⁷. That said, it is submitted that the answer is in the affirmative. The “clearly defined” test is no worse, and in almost all cases a lot better, than having to split a claim (even pre-filing) into a fan of separate Article 84 EPC-compliant claims engineered to capture all the priority dates available for all the subject-matter to which each relates.

5.5 There will (in both scenarios) be instances of priority dated subject-matter which cannot be presented as a virtual priority domain (or a claim). But it will matter only in limited instances where there is no clear domain which encompasses the subject-matter in question to shield it from a *missile*. Paragraph 4.7(e) above illustrates where it may matter as well as where it may not.

5.6 A specific embodiment (in the sense of a specific Example or description with reference to drawings) is an example of a body of subject-matter which may on clarity grounds not enable virtualisation of a corresponding priority domain in a claim. That said, it will not matter as long there is a domain encompassing it which can be visualised.

5.7 A quick poll will no doubt reveal that cases which were broadened at the end of the Paris Convention year³⁸ will generate far less problems than cases which were narrowed using added matter (which is the situation in the illustrations in Paragraph 4); in such cases, it is more likely that priority issues will turn on hierarchically lower level disclosures, noting that here less stringent clarity may sometimes be a more common commodity.

5.8 On a positive note, Article 84 EPC can be flexible in its application and, moreover, at least at appellate levels, can be administered effectively as a balance between the private interest of patent applicants and public interest. It’s not far-

fetched to think this is how Article 84 EPC would be applied in the context of Reason 6.7 of G0002/98.

5.9 It is worth flagging that the *Teschemacher* paper *supra* takes the view that specific embodiments are clear enough to be used to virtualise priority domains within a claim. The author of that paper states towards the end of its “Remarks” section that:

... Within the meaning of G0002/98, the specific example is one clearly defined alternative subject-matter; the other alternative is the generic rest of the claim...

However, this may be referring to specific embodiments in a more general sense than specific Examples or description with reference to drawings.

6. T1222/11 and the “limited number” test of G0002/98, Reason 6.7

6.1 Less has been said about this test than the “clearly defined” test. It was broadly accepted in T1222/11³⁹. Although its purpose (and perhaps, by implication, its validity) was softly questioned by the judge in *HTC Corp v Gemalto*⁴⁰ in the UK Patents Court, it remains a condition and has not been conclusively elucidated.

6.2 However, Reason 11.5.3 of T1222/11 contains a clue: the comparison between the priority document and the relevant claim “...should give rise to a limited number of clearly defined alternative subject matters” and this

... is obviously necessary in order to identify which parts of the claims benefit from the effect of the priority right defined in Article 89 EPC.

This gives an impression that plentiful priority dates (and thus plentiful numbers of “*subject-matters*”) are going to be regarded at some limit as placing an unreasonable burden on the interested public. It will call for careful judgement by patent applicants which it won’t always be practical to make soon enough, but most problem cases are likely to stick out by the outset of an EPC-included filing programme.

7. Looking forward

Drafting practice

7.1 Passages such as Disclosure (2), referred to in Paragraphs 4.6 and 4.7⁴¹, are all too easily included in patent specifications, especially those which are necessarily filed with urgency and with less than complete information. But probably they shouldn’t if they serve little purpose, either in terms of conferring enablement or building in scope for later amendment.

7.2 The drafting rule should be that no content should be included which could form a *missile* unless it is also clear enough that, were it a claimed feature, it would comply with Article 84 EPC. It is submitted that only in that case would the content in question have the capability to give rise to a target virtual domain protectively having the same date as the missile.

The state of the law

7.3 There is no doubt that a referral to the Enlarged Board of Appeal of the **conflict between T1222/11 and T1127/00** (*et al*) should be made. None was evidenced in the list of pending referrals at December 31, 2013, and that remained the case when checked more recently⁴².

7.4 It is worth reflecting on the often asked question of whether the law should be changed to give divisionals special status to protect them from *Toxic Priority* damage.

References

1. The present paper is further to the present author’s paper on this topic published in 2013 by the UK Chartered Institute of Patent Attorneys, parts of whose content will be referred to here for the purposes of context - see “*Review of Toxic Priority: The Poisonous Divisions Concept (et al) following EPO Appeal Decisions T1496/11 and T1222/11 and Nestec v Dualit*”, Malcolm Lawrence, *Journal of the Chartered Institute of Patent Attorneys*, September 2013, pages 518 – 527 (peer reviewed by **Ursula Kinkeldey**, former Chair of EPO Appeal Board 3.3.4 and former Permanent Member, EPO Enlarged Board of Appeal)
2. In this respect see Paragraph 1.4 below
3. 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*”
4. (1) *Nestec SA & Others v Dualit Ltd & Others* [2013] EWHC 923 (Pat) (2) **T0680/08**; (3) **T1443/05**
5. This decision is referred to in more detail in the penultimate bullet point of Paragraph 1.3 below
6. The case is referred to in “*Review of Toxic Priority: The Poisonous Divisions Concept (et al) following*

- EPO Appeal Decisions T1496/11 and T1222/11 and *Nestec v Dualit*”, *supra*. In that early case, the Patentee amended the claims to confer priority but failed on inventive step; the obiter remarks on the *Poisonous Division* argument were not reported in the decision
7. Personal communications or (limited) private research by the writer. The writer is not the representative on any of the matters mentioned
 8. In contrast to what is perhaps the more common situation of the claims having been broadened relative to the priority document, *narrowing* may be more challenging in the context of multiple priority date assessment. See later comment in Paragraph 5.7 of this paper
 9. When issuing T1222/11, the Board concerned opted for “*No Distribution*” (as in the case of T1443/05 and T0680/08, *infra*), which couldn’t have helped.
 10. The rights of divisionals to special treatment are very limited and clearly prescribed. It is suggested by the writer that the case for a divisional having any other entitlement to special treatment, whilst perhaps not negligible, is almost so. See further comment on this general issue in Paragraph 3 below, in particular Paragraphs 3.2 and 3.4
 11. Personal communication
 12. Obviously excluding the Enlarged Board of Appeal at present
 13. See Paragraphs 0.4 and 0.5

14. The paper in fact presents the opposing views of authors who respectively support so-called broad (pro-T1222/11) and narrow (anti-T1222/11) interpretations of Article 88(2) EPC. The narrow interpretation argues that T1222/11 should not be followed *inter alia* because its condition that a claim must be split for priority purposes is always satisfied, making it a “silent condition”, and because it is not aligned with the so-called “Golden standard” of eg **G0002/10**
15. In **T0680/08**, *whole contents* conflict arose between an EP priority document (P1), which had been published and thus qualified as an **Article 54(3) EPC** citation as of the priority date¹⁵, and an EP second filing (P2) claiming priority from it. The chemical process claims of the P2 filing had been narrowed by changing the recited range of values for a process condition (to 0.330 – 0.415 kWh/kg) relative to the P1 filing (which specified the broader range 0.325 – 0.415 kWh/kg). In the result, priority entitlement was lost and the requested claims suffered *whole contents* anticipation by the P1 filing (specifically, a set of preferred features in the priority document) under Article 54(3) EPC.
16. In T1443/05, the priority document (a European patent application which had been published and was citable as a whole contents citation as of the priority date), embraced the presence of a particular biocide in a biocide composition. The claims of the patent disclaimed the presence of this component. The patent and priority document were held in opposition proceedings

7.4.1 There are several specific reasons which can be deduced from this paper why this would be wrong:

- It would relatively favour divisional applicants over applicants who pre-empt division by plural filings at the outset.
- It could lead to the abuse of applicants routinely filing more applications which combine plural inventions, instead of recognising the need for separate applications in the first instance
- It would not address *Poisonous Priority Document* damage
- It would not target the root cause of the problem, which is the implementation of the concepts of multiple and partial priorities

7.4.2 Perhaps most importantly, however, there is an issue of proportionality; assuming the T1222/11 approach to Article 88(2),(3) EPC prevails, the problem of Toxic Priority is largely manageable through management of priority per Paragraph 7.2 above and, as such, a change in the law would be a disproportionate remedy – and therefore wrong even without taking account of the disadvantages likely to flow from it.

The author (Malcolm.lawrence@avidity-ip.com) is indebted to **Thierry Senninger**, who peer-reviewed this paper in draft, and to the several other practitioners who provided information or feedback on the more difficult parts of the paper. The views expressed in this paper are the personal views of the author, and not necessarily the views of anyone else.

relating to the former not to relate to the same invention and the claims in the patent were thus held disentitled to the claimed priority date. Examples in the priority document in which the relevant biocide was absent (a) were not held to support the priority claim and (b) were held to anticipate the patent as falling within its claims. An interesting analysis of T1443/05 appears in "Study of Priority Right under EPC: Same Invention/Disclaimers", **F Portal**, *EPI Information* 2/09, 2009, 56-59

17. Personal communication
18. Relying on Reason 6.7 of G0002/98 (Paragraph 91 of the court's judgement), the UK court held that Claim 1 was not entitled to the claimed priority date (Paragraphs 103 and 104) but only to the filing date of the application on which the patent was granted. Having lost its claimed priority date, inter alia Claim 1 was held anticipated by the published priority document under Section 2(3) of the UK Patents Act 1977 (corresponding to Article 54(3) EPC)
19. 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" The judge appears not to have considered T1222/11 even though that decision was published several months before his judgement. The trial was in Q1 of 2012 and, whilst the parties would not have had an opportunity of being heard on the matter of T1222/11 at trial, it is possible (indeed not uncommon) for parties to send newly issued decisions to the judge, with a short note, after trial and before judgment is handed down.
20. *HTC Corp v Gemalto* [2013] EWHC 1876 (Pat)
21. T1222/11 also appears not to have been considered by the (different) judge in *HTC Corp v Gemalto* [2013] EWHC 1876 (Pat) which came to trial in the weeks bridging April and May 2013. But these are not in themselves reasons to believe that national courts will not follow T1222/11
22. *Novartis AG and Cibavision AG v. Johnson & Johnson Medical* [2009] EWHC 1671 (Pat) – UK decision at first instance
23. The patent in suit in *Novartis AG and Cibavision AG v Johnson & Johnson Medical* claimed priority from priority documents P1 and P2, whose dates were also claimed, respectively, one in parallel application "Hop" and one in parallel application "Dom". The challenge to validity was that the claims under review did not enjoy the claimed priority dates and were thus anticipated in a whole contents sense by Examples in "Hop" and "Dom" which fell within their scope and which

enjoyed dates P1 and P2, respectively. The Examples could not in the view of the UK High Court (the *Bundespatentgericht* taking the contrary view on lesser facts) be shown to fall within the scope of the claims and thus the challenge, although not the principle, failed in the UK (whereas the challenge succeeded in Germany). The most informative narrative on the UK proceedings appears at Paragraphs 114 to 125 of the UK High Court decision

24. The principle also survived appeal of the UK High Court decision to the Court of Appeal (see *Novartis AG & Cibavision AG v. Johnson & Johnson* [2010] EWCA Civ 1039)
25. Parallel proceedings to *Nestec SA & Others v Dualit Ltd & Others* in the UK Patents Court, supra
26. "Nespresso European Patent Revoked", 11 October 2013 (Updates October 19, 2013 and 22 November 2013), Tufty the Cat blog
27. The definition in Article 54(3) EPC has always seemed to many practitioners to be somewhat jumbled in its language but the jumble provides no fuel to support the idea that *whole contents* applies differently to divisional applications
28. The paper is on the public file but is unfortunately well-hidden
29. Presentation of a paper on the subject by the Opposition Division at oral proceedings seems at first glance to score poorly on any fairness scale. But EPO tribunals have habitually, albeit not a common habit, introduced new case law at oral proceedings and given the parties a small ration of time to consider it and take a position. It's tough on parties but better than leaving it to an appeal stage
30. This has twice been endorsed by the Enlarged Board of Appeal - Decisions G0004/98 (November 2000) and **G0001/05** (June 2007) as well as by the Technical Board of Appeal in **T0441/92** (March 1995)
31. "European Patent Office (Technical Board of Appeal 3.3.07): Poisonous divisional applications – is the bogey going to disappear? (Decision of December 4, 2012 – Case T 1222/11 – Hair cosmetic composition/KAO)", **Rudolf Teschemacher**, *IP Report* 2013/IV, Autumn 2013, Bardehle Pagenberg [Dr Teschemacher is a former permanent member of the EPO Enlarged Board of Appeal]
32. The same disclosures would incidentally no doubt be present in the parent specification but the illustration here goes to the effect on parent claims of priority matter contained in a divisional description
33. 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"

34. **Article 88(2) EPC**: "Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries. **Where appropriate**, multiple priorities may be claimed for any one claim. **Where multiple priorities are claimed**, time limits which run from the date of priority shall run from the earliest date of priority."
35. In this respect, T1222/11 does not imply that the "clearly defined" test (or the "limited number" test) of G0002/98, Reason 6.7 is (are) "a silent condition, which is necessarily met and can therefore be ignored in practice", as opined in "Opposing Views on Partial Priority", supra. T1222/11 supports both tests and unequivocally invokes them to limit the circumstances in which a claim may benefit from multiple priority dates
36. The FICPI Memorandum is clear in its overall tenor that permitting plural priority dates for one and the same claim is the (preferred) equivalent to the default circumstance of patent applicants filing claim multiplicities to capture all the priority dates available for all the subject-matter to which each priority document relates. The key paragraph is perhaps the paragraph which bridges page 3 and 4 of the memorandum, where claim multiplicities are described as "frivolous". As an aside, it would be a rather idealised claim multiplicity to achieve what permitting plural priority dates for one and the same claim achieves, even taking account of the restrictions imposed by the "limited number" test of Reason 6.7 of G0002/98; depending on the point in time when such a claim multiplicity were added to a specification, one could also expect sizeable challenges in terms of avoiding a new subject-matter objection (**Article 123(2) EPC**)
37. Of course, the general rule is that an interpretation of a statutory provision, in this case the expression "where appropriate" in Article 88(2) EPC, is inappropriate if it leads to absurd results
38. This refers to partial priority contexts; obviously, the situation is analogous in multiple priority claim contexts
39. See T1222/11, Reason 11.5.3
40. *HTC Corp v Gemalto* [2013] EWHC 1876 (Pat), supra, Paragraph 160: "Although one can sympathise with the desire for a limited number, I doubt there is any principled basis for such a requirement"
41. Disclosure (2): "Apparatus comprising wherein the secondary member(s) are relatively rigid elongate members pressed from thin sheet to convenient shape"
42. Enquiries just prior to publication of this paper through personal contacts have also drawn a blank.