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# A Review of Priority Date Assessment under EPC

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## Peer Reviewed:

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*Nearly 10 years ago, an eminent member of an Appeal Board in the EPO opened a particular issue at oral proceedings with the words "The problem the EPO has with priority ...". It was certainly a taxing issue then, and it's still a taxing issue now.*

*One of the two tests for attribution of priority in G0002/98 is the same as that which controls added matter, and as time has passed it has grown closer to those legal origins in its implementation. The other test, less well-formed, has been implemented differently by different EPO tribunals – but creating a semi-consensus amongst the majority of appeal boards; that is now challenged by an alternative approach which, if adopted, will change many future outcomes, and probably for the better, but only after a period of uncertainty.*

*And priority in Europe isn't just taxing, but also very relevant to commercial outcomes. There is one context which makes it especially so: a large proportion of EPC patent applications originate in the PCT environment and, created by practitioners outside Europe whose grasp of the above picture is necessarily limited, follow strategies which can lock in attributes which fit poorly with the EPC priority system. That's an issue made worse, although by no means created, by recently emerging IP risks such as Poisonous Divisions and Poisonous Priority Documents. Hopefully, this paper will catalyse debate and aid communication in a way that ameliorates that issue.*

## 0. Introduction and Overview

0.1 Priority entitlement is at the core of best patent practise, capable of determining "life and death" decisions in private patent validity disputes as well as in the more extreme of patent prosecution contexts<sup>2</sup>. Whilst there is literature highlighting individual EPO Appeal Board decisions within this overall theatre, less than might be expected has been written on priority date assessment in the round using Enlarged Board of Appeal Decision G0002/98 as the starting point<sup>3</sup>.

<sup>1</sup> The pseudonymity of this peer reviewer is a result of the internal rules of the relevant corporation

<sup>2</sup> Notably, although specific to the UK jurisdiction, three patents were held invalid earlier this year through having disallowed priority claims: *Samsung v Apple*, [2013] EWHC 468 (Pat) [March 7, 2013]; *Samsung v Apple*, [2013] EWHC 467 (Pat) [March 7, 2013]; and *Hospira and another v Novartis*, [2013] EWHC 516 (Pat) [March 15, 2013]

<sup>3</sup> This is against a real life background in which there is some evidence that priority challenges are becoming more common in *inter partes* proceedings, especially in crowded technology areas

0.2 Priority is seldom a straightforward matter for patent proprietors where the technology concerned, or perhaps the proprietor's understanding of it, grows within the priority year after first filing and leads to specification changes which threaten the originally established priority date.

0.3 Priority is equally a tough issue for tribunals and, as this paper will show, appellate decisions of the EPO have been an imperfect source of guidance for patent applicants and patentees. Indeed, a definitive position on multiple priorities is still lacking 15 years after the presidential referral which led to the landmark Enlarged Board of Appeal Decision G0002/98. As one of a handful of concepts which are absolutely fundamental to the patent system, it is remarkable that any significant aspect of priority should still await final resolution after such a lengthy gestation period.

0.4 The developing landscape of jurisprudence on priority, and the current implications for practise, can conveniently be reviewed as the following chapters:

## Claim Splitting:

- 2001: Enlarged Board of Appeal Decision G0002/98
- 2003 to 2012: Development of a Strict Approach: T1127/00 to T0476/09
- Mezzanine: The T0665/00 Approach to Split Priority
- Discussion of the Decade of Developmental 2003 to 2012
- 2013: The T1222/11 Approach to Split Priority
- Specific Embodiments as Priority Domains
- Split Priorities – Practise

## The Subject-Matter Test:

- Applying the G0002/98 *Conclusion* Test to Priority Documents

## 1. 2001: Enlarged Board of Appeal Decision G0002/98

### 1.1 The Decision

1.1.1 G0002/98 (May 2001)<sup>4</sup> decided two things. First, what amounts to the key teaching, at least in the consciousness of most practitioners, sets the disclosure standard needed in a priority document to support a priority claim. Secondly, the decision sets out the circumstances in which a claim can be partitioned to recognise

<sup>4</sup> G0002/98 is, of course, approved in the key UK court decisions in (1) *Biogen v Medeva* [1997] RPC 1 and (2) *Unilin Beheer v Berry Floor* [2005] FSR 6

multiple priorities under Article 88(2)(3) EPC. The latter tends to be the harder question, and of the two teachings it is the one least well understood.

1.1.2 The key teaching in G0002/98 (as set out in the Conclusion) requires that the skilled person must be able to derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. The board commented extensively on the fact that its decision represented a narrow approach achieving necessary alignment and consistency in implementation of a number of different legal concepts underlying EPC, and those comments have been reprised in other decisions.

1.1.3 The seminal test which this key teaching sets out is an Article 123(2) EPC test which examines whether there is basis in that sense in the priority document for the claim concerned. Article 123(2) EPC is a “daily” challenge, quite outside of questions of priority date assessment, for most IP practitioners; it is perhaps this which explains why this part of the overall teaching of G0002/98 takes the higher position it does in practitioner consciousness.

1.1.4 Reason 6.7 of G0002/98 also gives the Enlarged Board of Appeal’s view on legislative intentions driving the multiple priority provisions of Article 88(2)(3) EPC. Reason 6.7 deals with priority date assessment for so-called “AND claims” and “OR claims”. The first arm of this is easy enough and will not here be discussed. The second arm of Reason 6.7 deals with situations where a claim covers features expressed in the alternative – “Feature A” or “Feature B” – where those features may be contained in a group of priority documents whose dates are claimed but not all of those features are contained in any *single* priority document.

1.1.5 Commonly, the alternative features referred to are expressed in the claim as a generic term. Reason 6.7, second sentence gives as an example the situation where the claim is directed to Feature C, a generic term encompassing Features A and B; here, the claim is split for priority date assessment purposes, with the claim so far as it covers Feature A having one date (P1) and so far as it covers Feature B having a different date (P2) – reflecting two priority documents having Features A and B as respective disclosures. However, the final sentence of Reason 6.7 contains the crucial message, namely that Article 88(2)(3) EPC permits a patent claim to claim multiple priority dates using a generic term subject to satisfaction of the important compound legal pre-requisite that use of the generic term gives rise to the claiming of alternatives which (i) are clearly defined and (ii) are limited in number<sup>5</sup>. This test makes the “OR claims” arm of G0002/98, Reason 6.7 more difficult to apply – first

because it is inherently more difficult to comprehend and secondly because EPO Boards of Appeal have adopted different approaches to its implementation.

1.1.6 In applying the above test, most lower boards, perhaps led principally by T1127/00, have looked for real signs in the specification of the patent/application in suit<sup>6</sup> of individualisation of the features in question which the generic term subsumes, as well as clarity in expression of, and limitations in the number of, such individualisations. This consideration is applied narrowly and strictly (although the test is not an Article 123(2) EPC test).

1.1.7 In a closely reasoned but *obiter* opinion on the interpretation of G0002/98, T1222/11, published at the end of last year, takes the entirely different approach that Reason 6.7 of that EBA decision permits multiple priorities in any one claim assignable to domains which can be conceptually envisaged in the patent/application under priority date assessment, but they do not need to be individualised.

1.1.8 It should not be forgotten, but commonly is, that the primary embodiment of legislative intention behind Reason 6.7 of G0002/98 is derived from the so-called “FICPI Memorandum”<sup>7</sup> forming a crucial part (as far as priority is concerned) of the *Préparatoires Travaux* to EPC 1973. That background text is referred to in G0002/98 as an important authority but in comparatively few other places in terms of either lower board decisions or expert papers on the subject of multiple priorities<sup>8</sup>.

1.1.9 Reason 6.7 of G0002/98 has an obvious focus on situations where technology grows after first filing to engender claim *broadening*, as distinct from *narrowing*. That is the focus in the FICPI Memorandum (and indeed the two contexts are treated differently in T0680/08, although in applying the test for identity of invention rather than in claim splitting<sup>9</sup>). However, it is nevertheless argued that it also embraces *narrowing* in that Feature A and Feature B may be alternative narrowing features (with different priority dates). For example, the first filing may disclose a broad range (abandoned in a

5 The exact language in G0002/98, Reason 6.7 is: „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” (emphasis added)

6 An interesting consideration is whether basis for claim splitting must be in the patent, if priority is challenged for the claims as granted, as opposed to *having been* historically present in the application filed, a question presumably to be answered in the affirmative (Article 88(2) EPC is framed about patent *applications*, but it is suggested that this is not significant beyond the fact that it is there that the priority claim is made). To this conjectured extent, it is clearly, although inconveniently, possible for priority entitlement to change, through disapplication of claim splitting, in the amendment process which may be experienced by a patent application in prosecution. Amending a specification always moves the goal posts but an outcome such as this seems a technical consequence too far and is perhaps an early sign that the *semi-consensus* state of case law, at least prior to T1222/11, has not entirely ended up in the right place

7 Denoted „Memorandum M148II, Section C” in the *Préparatoires Travaux*

8 It would be (theoretically) interesting to learn how many people who practise IP have read the FICPI Memorandum, or even had it in their possession, until recently

9 In T0680/08, it is stated by the board in Reason 1.3, second paragraph that it found nothing in G0002/98 to suggest that the Enlarged Board of Appeal had „explicitly” considered situations where a claim had been „marginally” narrowed; however, it is suggested (see Paragraph 8.8 below) that the deciding board may have erred in concluding that this gave it the freedom it decided it had

second filing in favour of the new narrow range referred to below) and a more specific parameter (the latter being Feature A), and the second filing may disclose the narrow range (Feature B) encompassing the more specific parameter (the latter being, as already noted, Feature A).

1.2 Various Priority Contexts

1.2.1 For the purposes of conceptual understanding, it is perhaps helpful at an early point to look at the three model priority contexts illustrated below, and how they sit in the context of a possible prior art attack (based on a disclosure of specific embodiment subject-matter<sup>10</sup>). As there is more than one type of broadening, there are three illustrations to illustrate narrowing and broadening amendments after P1 filing. Illustration 3 is the reciprocal of Illustration 2.

1.2.2 Illustration 1:

- P1 filing was limited to W (and duly exemplified)
- At P2 filing, a new disclosure was filed directed to an alternative X (together with its own exemplification)
- P3, the cognate of P1 and P2, was subsequently filed and produced **broadening** relative to the P1 filing as its claims are to {W or X}. The main claim *overall* enjoys date P3 as it does not *overall* claim the same invention as the P1 or the P2 filing. However, the claim is notionally divided into separate priority domains, Domain W (P1) and Domain X (P2), in line with G0002/98, Reason 6.7
- Domain W is invulnerable by virtue of its P1 priority date to a novelty challenge based on eg a *whole contents* disclosure of P1 subject-matter and P1 date (or later)<sup>11</sup>
- Domain X has the same invulnerability despite its later priority date P2 as it is limited to subject-matter X and does not include any subject-matter W
- But for the claim splitting, the whole claim would be invalid

1.2.3 Illustration 2:

- As shown in Table 1 below, a P1 filing has a Claim A limited to a parameter range 1 to 8 and this is exemplified by an Example (parameter 3.5)
- At P2 filing, Claim B replaces Claim A and relies instead on parameter range 2 to 5 not disclosed at the P1 stage
- P2 with the latter definition – a **narrowing** relative to the P1 filing – is proceeded with<sup>12</sup> to examination. As a result of the narrower parameter definition, the invention claimed in P2 is not the same as in P1, and Claim B *overall* is entitled only to priority date P2
- Claim B is vulnerable to a novelty challenge based on eg a *whole contents* disclosure of the Example in the

P1 filing as this would fall within the scope of Claim B. Final outcome would depend on basis for splitting Claim B to define a P1 domain encompassing the cited Example and one or more domains representing the balance of Claim B (ie the subject-matter: {Claim B minus the P1 domain})

Table 1

	Range 1 – 8	Range 2 – 5	Example (parameter 3.5)
P1 filing (Claim A)	x		x
P2 filing (Claim B)		x	x

1.2.4 Illustration 3:

- As shown in Table 2 below, a P1 filing has a Claim C limited to a parameter range 2 to 5 and this is exemplified by an Example (parameter 3.5)
- At P2 filing, Claim D replaces Claim C and relies instead on a parameter range 1 to 8.<sup>13</sup>
- P2 with the latter definition – a **broadening** relative to the P1 filing – is proceeded with to examination. As a result of the broader parameter definition, the invention claimed in P2 is not the same as in P1, and Claim D *overall* is entitled only to priority date P2
- Claim D is vulnerable to a novelty challenge based on eg a *whole contents* disclosure of the Example in the P1 filing as this would fall within the scope of Claim D. Final outcome would depend on basis for splitting Claim D to define a P1 domain encompassing the cited Example and one or more domains representing the balance of Claim D (ie the subject-matter: {Claim D minus the P1 domain})

Table 2

	Range 1 – 8	Range 2 – 5	Example (parameter 3.5)
P1 filing (Claim C)		x	x
P2 filing (Claim D)	x		x

2. 2003 to 2012: Development of a Strict Approach: T1127/00 to T0476/09

2.1 There are a number of EPO appeal board decisions, involving key boards of appeal associated with widely recognised sound decision making, which have taken quite strict approaches (and, in particular, approaches which are less lenient than in T0665/00 and T0680/08 – see Paragraph 3 below); they have as a common theme that claim splitting under Article 88(2)(3) EPC can only be allowed when there is a solid rationale for the split in

10 Where priority date is at issue, it is common for alleged anticipatory disclosures to be self-disclosures and for those self-disclosures to be disclosures of specific information. For a recent example, see the UK case of *Hospira and another v Novartis*, [2013] EWHC 516 (Pat) (and IPKat March 19, 2013) and, more generally, T1213/05 and T0331/07 (scientific paper publication), T0665/00 (product disclosure), T0680/08 (publication in priority document) and T1496/11 (publication in divisional)

11 This could be the result of a competitor's patent procurement actions or, as in the case of T0680/08 and T1443/05, those of the proprietor

12 Of course, commonly, an EPC P3 will be filed cognating the P1 and P2 filings

13 Unlike Illustration 1, the broadening is the result of a redefinition of a parameter rather than the provision of an entirely different alternative feature

terms of what the patent/application discloses – some disclosure which supports the selectivity associated with any individualisation.

2.2 Decision *T1127/00* (December 2003) (so far as it deals with the Main Request) provides perhaps one of the more useful outlines of how *G0002/98* should be applied. As noted earlier, in the case of “OR” claims having a feature expressed in generic language, *G0002/98* stipulates in Reason 6.7 the over-arching proviso that this must only give “...rise to the claiming of a limited number of clearly defined alternative subject-matters”. In *T1127/00*, the board applied Reason 6.7 of *G0002/98* and determined whether the claim could be split into different domains for priority date assessment purposes (see Reasons 5 to 7). The board pointed out that a notional domain in the claim under assessment, in particular such as one disclosed in the priority document, might be intellectually envisaged to fall within the scope of the claim being assessed but this did not in the board’s view make up for the lack of a clear and unambiguous individualized presence *in the claim* justifying award of multiple priorities (see Reason 7). The board thus found that Claim 1 of the case before it did not embrace “...a limited number of clearly defined alternative subject-matters in the form of an “OR”-claim which could be split up into groups of different priorities”; a single later priority date was assigned to the claim.

2.3 In an Auxiliary Request, AR2, made by the patentee in *T1127/00*, a claim to a ribozyme was, however, split into separate domains. The ribozyme was defined in AR2 by Features A, B, C and D. Feature C in turn was defined by parameters  $m$  and  $m'$  1 and  $b$  2<sup>14</sup>. In splitting the claim across the definition of Feature C, the board felt able to individualise a first priority domain {C:  $m = 1$ ,  $m' = 1$ ,  $b = 2$ } entitled to the date of PD1 and a second priority domain comprising the rest of the claim – a *limited number of clearly defined subject matters*<sup>15</sup>. The granted claims had specified an embodiment corresponding to AR2 which, of course, specified the values  $m = 1$ ,  $m' = 1$  and  $b = 2$  in that these were the lower limits of the open-ended ranges  $m$  and  $m'$  1 and  $b$  2; and the board was no doubt assisted in its individualisation task by the flagging of these limits as of significance in the description of the patent eg the schematic model ribozyme of Figure 3<sup>16</sup>.

2.4 *T0070/05* (February 2006)<sup>17</sup> examined the right to priority of a citation. The board pointed out at an early stage of the decision (Reason 4) the requirement emanating from *G0002/98* that consistency calls for the same criteria to be applied to priority date assessment of a citation as applied to a patent/application under

challenge. In the citation, similar extracellular receptor fragments DDCR (30-215) and DR3-V1 (26-212)<sup>18</sup> defined, respectively, in the citation and its priority document could be seen as having a common polypeptide chain or sub-group. In Reasons 17 and 18 of the decision, the board applied Reason 6.7 of *G0002/98* to the citation in the following way: –

- Reason 17: the common sub-group was “*not singled out as such*” in the citation and the use of approximate terminology in its definition<sup>19</sup> created an open-endedness which meant that (echoing the *limited number* requirement of the proviso to Reason 6.7 of *G0002/98*) the number of sequences covered by the sub-group definition was not limited
- Reason 18: referring to the rationale expressed by the board in *T1127/00*, the common polypeptide chain could not be individualised *inter alia* in the citation as one alternative subject-matter domain – the board holding that the fact that the domain might be intellectually envisaged as falling within the disclosure of the citation was not sufficient. The board decided that the claim could not be so split as the common chain was not as such identified *in the claim* (as opposed to capable of being intellectually envisaged) and not clearly defined<sup>20</sup>.

2.5 In *T0184/06* (March 2007), the board took a tough line in the case of a bleaching composition and nearly, but not quite, stated (in Reason 6.1.2) that its interpretation of Article 88(2) and (3) EPC was that multiple priorities could be claimed only in the case of specific distinct alternatives. The board contrasted this with how it saw the claims before it (Ninth Auxiliary Request) as characterized by a combination of features which “*cannot be regarded isolately (sic) from each other*”. The patentee’s argument on individualization was that priority should be assigned to at least the included compositions comprising a hypohalite bleach and the specific alkyl ether sulphate disclosed in the Examples. Whether better ammunition to deal with the board’s somewhat refractory posture existed is beyond the scope of this paper but the above argument has little obvious strength. In any event, multiple priorities were not permitted.

2.6 As noted in Paragraph 2.2 above, *T1127/00* (Main Request) states that basis for individualisation of an embodiment is required to be “*in the claim*”<sup>21</sup>. However, as plain as this is stated in the decision, it is suggested that it would be going too far to treat this as a general

14 The decision may be found difficult to follow as Reason 21 incorrectly refers to  $n$  and  $n'$  whereas  $m$  and  $m'$  were intended

15 See Reason 21 (in which, however, Reason 6.7 of *G0002/98* was not expressly mentioned)

16 The decision can be distinguished over *T0665/00* because Feature C was individualised in the patent with a force greater than was the relevant microsphere density in *T0665/00*

17 Oral proceedings were heard before a five-member board

18 With a general audience in mind, the style of nomenclature shown has been used as a convenience in distilling into assimilable abstract form the reasonably complex technical fact pattern in *T0070/05*

19 The board noted that the DDCR (30-215) and DR3-V1 (26-212) fragments could be in slightly shortened or extended form so that there were a number of alternative possibilities for the composition of the common polypeptide chain

20 The board in *T0070/05* also decided (Reason 18) that the common polypeptide chain could not be derived clearly and unambiguously from the priority document so that, even if the claim could have been split, it seems that the claimed priority date would not have been assigned to the domain defined in the split

21 A position also taken by the board in *T1443/05*

principle. As noted in Paragraph 2.3 above, T1127/00 itself appears to accord with this in the approach taken to the Auxiliary Request<sup>22</sup>. Moreover, observing the requirement for a solid rationale for a claim split to be contained in the patent/application in question, if basis for individualisation of a priority domain were flagged in *the body of patent specification*, it is not easy to explain why this should be treated as inferior to basis in a *claim* – at least, not without recourse to artificial arguments which are more technical than equitable.

2.7 Reason 6.7 of *G0002/98* derives principally from Article 88(3) EPC, which refers to “*elements*” of the invention. In *T1877/08* (February 2010), the board, in highlighting this terminology, makes the point that it must be understood as referring to “*separable alternative embodiments*”. In that case, the board dealt with a chemical composition comprising three components in proportions defined by numerical ranges (30-65, 33-69 and 1-10) not disclosed in the priority document (which disclosed ranges of 30-55, 35-65 and 2-10). These were argued unsuccessfully to be entitled to priority so far as there was overlap between the ranges claimed and those in the priority document. The board did not agree and held that no “*separable alternative embodiments*” could be identified in the patent, citing Reason 6.7 of *G0002/98*. The decision, usefully reiterating the language of Article 88(3), underlines the perceived need for *individualisation* of domains within the patent whose claims are subject to priority date assessment. A later decision, *T0476/09* (September 2012), supports the position taken by the board in *T1877/08*, the facts being somewhat similar (a range of 0.93 to 0.99 was recited in the claims in question for the circularity of toner particles in a toner composition whereas the priority document disclosed a marginally narrower range of 0.94 to 0.99 for the same parameter).

2.8 A very recent, and well-publicized, judgement (April 22, 2013) of the UK Patents Court in the case of *Nestec SA & Others v Dualit Ltd & Others [2013] EWHC 923 (Pat)* is broadly aligned with the above EPO appeal decisions, and in particular with *T1127/00* (Main Request). In *Nestec*, the relevant claim was to an extraction system in a Nespresso coffee maker, the system being defined in terms which encompassed arrangements in which a beverage capsule had an inclined or non-inclined attitude whereas the priority document did not disclose arrangements in which the capsule had the former attitude (Paragraphs 99 and 102). Relying on *G0002/98* (Paragraph 91) the court held that, *inter alia* on this ground, 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. Counsel for *Nestec* did not argue that the claim was entitled to multiple priority dates for the respective subject-matters it encompassed (Paragraph 103), but in any event the judge stated in Paragraph 103 that he did not consider the “*inclined*” embodiments to be “...

*clearly defined alternatives to the other arrangements covered by ...*” the claim (also see Paragraph 96 for a similar view on other features). It is worth mentioning that not only did the UK Patents Court follow the *T1127/00* approach in *Nestec* but that this is also true of the even more recent *HTC* case<sup>23</sup>. In *HTC*, before a different judge, multiple priorities were not argued, nor permitted, for Claim 1 (which would be notionally split into a *Java language* domain and an *other language* domain – the claim having specified *language* generally) and a split priority argument in relation to a sub-claim was rejected by the judge (see Paragraphs 172, 193 and 195 of the *HTC* judgement). As noted later in this paper (see Paragraph 5.9), neither judge appears to have considered *T1222/11*.

2.9 Pithy rules of thumb are dangerous in the practise of IP law. However, there’s a general flavour in most of the case law that claim splitting across the scope of a generic expression<sup>24</sup> must be straightforward or it’s not going to be allowed as a tool in priority date assessment, at least not under the widely supported “*strict approach*” laid down in *T1127/00*. It wasn’t straightforward in *T1127/00* (Main Request) or *T0070/05*, and nor, it is suggested, was it in *T0665/00* or *T0680/08* (see Paragraph 3).

2.10 There are cases where *it was straightforward* that are worth mentioning to illustrate the point; in these cases, the need to apply split priorities was occasioned by claim broadening at subsequent filing relative to the first filing and the board looked for, and easily found, basis for the necessary individualisation in the patent concerned. In *T0135/01* (January 2004), a domain of Claim 1 whose subject-matter was entitled to the earliest priority date claimed was explicitly defined in Claim 2 and in the description of the original PCT application, so that the situation easily sat within the framework of allowability the board saw as set out by Reason 6.7 of *G0002/98*; things were straightforward and splitting of Claim 1 was permitted so as to attribute multiple priority dates. In *T0441/93* (decided before *G0002/98*, in March 1996), the claim challenged was also partitioned in a similar manner into (A) transformation processes applied to yeast cell protoplasts (for which priority was allowed) and (B) transformation processes applied more broadly to include whole yeast cells (for which priority was not allowed). As the decision predates *G0002/98*, no reference is made in the decision to application of the principles set down by the Enlarged Board of Appeal although express disclosure of (A) was contained in the sub-claims of the patent and presumably relied on by the board. *T0395/95* (also decided before *G0002/98*, in September 1997) also allowed split priority, the split-off domain again being clearly disclosed and identified as such in the patent (see Claim 2 of the patent and Reasons 2.1.1 and 2.1.2 of the decision).

23 *HTC Corp v Gemalto [2013] EWHC 1876 (Pat)* (April and May 2013)

24 Of course, situations where the claim scope is defined by expressly stated alternatives are an easy matter; see, for example, *T0676/01* (May 2005) and *T0108/98* (March 2003)

22 ..... and see *T0135/01* (Paragraph 2.10 below)

2.11 In both cases, the splitting, quite apart from the subject-matter to which it was directed being flagged in the specification of the patent concerned, gave rise to a limited number of alternative subject-matters. Perhaps importantly, they were cases where the later filing broadened the claim scope; had it instead narrowed the claim scope, there might have been a greater challenge to individualisation of eg a domain of early priority date encompassing an anticipatory specific embodiment, at least not one likely to have appealed to the deciding board.

### 3. Mezzanine: The T0665/00 Approach to Claim Splitting

3.1 The *T0665/00* (April 2005) approach, which has featured in a number of blog posts, is best demonstrated with reference to Illustration 2 (Paragraph 1.2.3 above). There are two possible approaches in Illustration 2, each with a different outcome:-

- (i) Claim B is not split at all and therefore has the priority date P2. The P1-dated specific Example (parameter 3.5) is anticipatory of Claim B; or
- (ii) Claim B is split to provide the following priority domains:
  - A priority domain characterised by parameter 3.5 (entitled, following the reasoning in *T0665/00*, to date P1), and
  - Following the claim splitting approach adopted in *T0665/00*, plural priority domains, respectively representing the rest of Claim B, each of which is specific separately to all other parameters within the claimed limits 2 to 5 recited in Illustration 2. The first-mentioned domain has priority date P1 and is therefore invulnerable to any citation of the Example with an effective date later than P1. The remaining domains of Claim B are distinguished from the Example (on a novelty basis) by virtue of different subject-matter.

3.2 The analysis in 3.1(i) seems right on the basis of *G0002/98*. The approach to claim splitting adopted in *T0665/00* is entirely different and, whilst it cannot be ignored, it seems questionable.

3.3 Referring now to the detailed circumstances in *T0665/00*: –

- In *T0665/00*, the board was tasked with assessing priority entitlement of a composition claim reciting a density limit of  $<0.1 \text{ g/cm}^3$  for a microsphere component where the priority document recited instead a density limit of  $<0.5 \text{ g/cm}^3$  and mentioned no additional densities. Example 1 of both patent and priority document stipulated the presence in the composition of a branded microsphere product (*Expancel DE*) in combination with identical other components
- The Example in the *patent* provided a greater amount of information on the branded microsphere component, in particular express disclosure of a density of  $0.04 \text{ g/cm}^3$ . Submissions by the patentee, supported by expert testimony and not challenged by the oppo-

nent, were accepted by the board to establish a figure of  $0.036 \text{ g/cm}^3$  for that branded product as used in Example 1 of the *priority document* (see Reason 3.2 of *T0665/00*)

- This composition exemplified in Example 1 of the priority document had allegedly been disclosed through prior use between the claimed priority date and the EP filing date<sup>25</sup>
- As to legal setting, *T0665/00* refers in Reason 3.5 expressly to Reason 6.7 of *G0002/98*.

3.4 Although Reason 6.7 of *G0002/98* was duly applied, the board approached matters in an unusual way: it decided in Reason 3.5.1 of *T0665/00* that the density of  $<0.1 \text{ g/cm}^3$  in the claims as granted “.....permits the definition of.....” a group of microspheres, each characterised by a given density falling within the generic limitation  $<0.1 \text{ g/cm}^3$  and each element of the group representing an alternative to which its own priority date can be assigned. In short, the board ruled that all densities within the spectrum covered by the terms of the granted claim could be individualised to generate plural respective priority domains. Adopting this approach, the priority domain defined by density  $0.04 \text{ g/cm}^3$  was entitled to the claimed priority date and was held not anticipated by the use which had taken place between the priority date and filing date. The remaining domains would be entitled to the filing date.<sup>26</sup>

3.5 This rather artificial approach appears to take *T0665/00* well beyond the boundaries of *G0002/98*, Reason 6.7 and therefore to treat the patentee with an unexpected leniency<sup>27</sup> which it is submitted is unlikely to be generally available: –

- There is no clear basis, and certainly not one expressed in Reason 3.5.1 of *T0665/00*, for taking the claims in question and individualising each of plural microsphere densities falling within the claimed  $<0.1 \text{ g/cm}^3$  limit, as the Appeal board did:
  - Following case law available to the board (*T1127/00 supra*), the board would have been expected to require a solid rationale for the split – some disclosure in the patent which supports the selectivity associated with individualisation. However, the patent in *T0665/00* specifically discloses only one density, namely the density of  $0.04 \text{ g/cm}^3$  mentioned in Example 1, and is silent as to any other density within the spectrum concerned

<sup>25</sup> Reason 2.3 makes it clear that the board did not actually accept that there had been prior publication; the consideration the board gave to priority date issues in the decision was to that extent *gratis dictum*

<sup>26</sup> The board did not find the claims lacked inventive step, although there is a case that the approach taken left inventive step issues intact and unaddressed. For example, a composition comprising a microsphere component density of (say)  $0.045 \text{ g/cm}^3$  would presumably not be entitled to the claimed priority date (as no domain so defined had not been disclosed in the priority document) and would presumably be open to challenge under Article 56 EPC for lack of inventive step. Parenthetically, it should be said that the expert evidence in the case suggests that composition properties are density-dependant and that might suggest such a challenge could be met – but the *general* point remains valid that the approach of the board in *T0665/00* is, for reasons beyond novelty, likely to provide non-holistic and therefore imperfect solutions in many instances

<sup>27</sup> From the decision, it's difficult to resist the feeling that this is not the only area in which the board demonstrated leniency

- As to the specific density mentioned in Example 1, the figure is not flagged in the patent in the individualised sense apparently required by the then existing case law. It is merely disclosed as one only of a number of microsphere characteristics (the copolymer composition and particle size for the microspheres are, for example, also recited in Example 1), and indeed the microspheres are one integer only of the overall budget of features in the Example (which also mentions, for example, pigments and other components representing the bulk of the composition disclosed)<sup>28</sup>. In short, the density integer is presented as part of a marriage with other features, the whole constituting an overall setting from which density alone cannot be individualised<sup>29</sup>
- In terms of “OR” claims, the proviso to Reason 6.7 of G0002/98 (per T1127/00 and T0070/05) requires that splitting a claim across a generic term or formula into alternative features in priority date assessment is limited to situations where those features can be individualised to give rise to a limited number of clearly defined alternative subject-matters.<sup>30</sup> The approach of the board in T0665/00 to individualization does not create a *limited* number of alternatives, but many alternatives; in essence, the board divided a range, with considerable granularity, into its component parts using a denominator which seems tailored to the desired outcome.

3.6 Unlike T0665/00, the reasoning in T0680/08 (April 2010) does not cite Reason 6.7 of G0002/98 but it did adopt an approach which has more than mere shades in it of that earlier T decision<sup>31</sup>: –

- In T0680/08, the claims of the opposed patent recited a numeric range of 0.330 – 0.415 kWh/kg for a parameter, total drive specific energy, in a chemical process. The range was held not disclosed in the priority document, which recited a different range of 0.325 – 0.415 kWh/kg; the range definition had been narrowed between P1 and P2 filings
- The board held in T0680/08<sup>32</sup> that “... *the subject-matter of claim 1 according to the main request –*

*insofar as a method carried out at the lower bound value of 0.330 kWh/kg is concerned – is not entitled to the priority ...*”<sup>33</sup> (emphasis added)

- However, the board went further, and surprisingly assigned the claimed priority date to a claim amended to exclude, by use of a disclaimer, processes carried out in accordance with the specific parameter of 0.330 kWh/kg on the basis that this limit was in the board’s view responsible for loss of priority<sup>34</sup>; the board commented<sup>35</sup> that “... *methods carried out at claimed SEC values other than 0.330 kWh/kg, i. e. the subject-matter of claim 1 according to the first auxiliary request, concern the same invention as is disclosed in document D0*”
- It can be argued that the board split the claim in depicting it as having one domain specific to 0.330 kWh/kg and a domain representing the balance of the claim (namely, 0.330 – 0.415 kWh/kg truncated at its bottom end by loss of the specific 0.330 kWh/kg figure)
- The latter domain would, however, still be narrower than the priority document because it would exclude the parameter range 0.325 to <0.330 kWh/kg at the bottom end of the range recited in the priority document; it would thus not be the same invention and as a consequence would not enjoy the claimed priority date.

3.7 In summary, it is submitted that the amendment with which the patentee succeeded in T0680/08<sup>36</sup> does not result in a residual claim entitled to the P1 priority date – the residue of the claim following the disclaimer has date P2 and remains anticipated by the description in the priority document cited by the opponents. Additionally, viewed as a process of claim splitting, the two domains formed by the split have the same priority date. As a split must, it is suggested, produce domains of different priority dates (Reason 6.7 of G0002/98 and Article 88(3) EPC are concerned with *multiple* priorities) for it to be a *valid* split under, and fulfilling the purpose behind, Reason 6.7 of G0002/98, there was no basis for a claim split in T0680/08 in the first place.

## An Important Philosophical Test

*The fundamental purpose of recognising “OR” claims is to enable definition of individual priority domains which have different priority dates – Reason 6.7 in G0002/98 is about “multiple” priorities (see also T01127/00, Reason 6). Taking T0665/00 as an example, the density integer used to define the split in T0665/00 per Paragraph 9.3.3*

28 On the latter point, the description in the patent specification beyond the Examples singles out the *class* of branded microsphere product (*Expancel*) of which one form (*Expancel DE*) was used in Example 1. Whilst this seems a move towards the necessary basis for individualisation, it seems to fall short of permitting individualization of density divorced from other microsphere attributes, such as composition and particle size. Perhaps the board thought the same as it did not propound this approach but ventured more deeply to decide on the basis it did

29 As demonstrated by the patent and the priority document, the patentee did not seem to know enough about microsphere density at either filing date. Accordingly, a reflection on the fundamentality that priority is awarded for knowledge which is appropriately demonstrated at both junctures, non-entitlement to priority is a consequence which objectively might well be seen as just

30 As noted previously, the exact language in Reason 6.7 of G0002/98 is: “*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*”

31 The boards in the two cases were not the same

32 Blog posts on this decision contained notable surprise, even taking into account that blogs are commonly a medium for anonymous expressions of astonishment by the blog’s followers

33 The board thus was perhaps at least *courting* with the rationale of Reason 6.7 of G0002/98 – see Reason 2.1 of T0680/08 (“... *the subject-matter of claim 1 according to the main request – insofar as a method carried out at the lower bound value of 0.330 kWh/kg is concerned – is not entitled to the priority...*”)

34 It is submitted that it is not the “bookends” per se that determine priority but the subject-matter between them – in this case, subject-matter which is not the same as that between the 0.325 and 0.415 kWh/kg “bookends” of the priority document

35 Reason 3.2 of T0680/08

36 The amendment was instigated by the board during oral proceedings

of the decision is exported from a specific setting much narrower than the general setting of the claim into which it is imported. The import seems unlikely to be priority-conferring.

If that is right, the split would not achieve its purpose of defining plural priority domains which collectively have at least two priority dates. The split, on this basis, is not a valid one in the first place, and in principle should be impermissible.

3.8 It is valid to consider a modification of the approach in T0665/00 – on that fact pattern, dividing the claim into just two domains, Domain I characterised by microspheres of density 0.04 g/cm<sup>3</sup> and Domain II representing the balance of the claim. This has a sense of the right scale to it (*vis-à-vis* the proviso to Reason 6.7 of G0002/98) and so may deal with the issue flagged in the second (main) bullet point of Paragraph 3.5.

3.9 However, it does not deal with the issue flagged in the first bullet point of Paragraph 3.5 (see its second sub-bullet point) if Domain I is comprised of the subject-matter of the claim expressed in unchanged *general* terms save only for the *specific* density limitation applied to the microsphere component.

#### 4. Discussion of the Decade of Development 2003 to 2012

4.1 The position in terms of EPO appeal decisions as of late 2012, then, is that, viewed overall, EPO Boards of Appeal have looked for real signs of individualisation in the patent/application in question to justify claim splitting; and there is evidence that, in some cases, boards have wanted basis for individualisation in the claim in question. T0665/00, supported by T0680/08, contrary to this strict line, takes a different approach which seems aberrant and unlikely to provide a secure basis for action. Based just on the number of boards that have taken the strict approach, there is likelihood that most cases, in the near future at least, will be determined on this basis. That must inform how risk is assessed by patentees/applicants and their opponents in contexts where patent validity hinges on considerations of multiple priority.

4.2 That having been said, it isn't that clear that this overall mood of appeal boards is based on a correct implementation of what was intended in G0002/98:

- (i) Reason 6.7 of the G0002/98 states that when a generic expression is used in a claim, the test for awarding multiple priorities is that such use gives rise to the claiming of (a) a *limited number* of (b) *clearly defined* alternative subject-matters. Both these requirements need to be interpreted carefully, particularly the former.
- (ii) Referring to the first requirement – the *limited number* requirement<sup>37</sup> – many generic expressions

subsume very substantial numbers of alternatives which they import into the claim in question. It cannot have been intended by the Enlarged Board in G0002/98 that the number of alternatives a generic expression in a claim theoretically covers should be a determinant as to whether priority is or is not to be awarded. Referring to Paragraph 3.7 and the adjacent text box, the purpose of Reason 6.7 of G0002/98 is to enable the definition of domains of different priority dates. On that basis, a sounder interpretation of Reason 6.7 is that the Enlarged Board intended the *limited number* requirement to be with reference *not* to the number of theoretical alternatives the generic expression covers as a matter of semantics, *but rather* to the number of different *priority domains* it subsumes with reference to the priority documents.

- (iii) As a requirement, that then seems a reasonable one as it would deny multiple priority in situations where the number of priority domains was sufficiently large to constitute an undue burden on a public needful of knowledge as to both the boundaries of the relevant patent protection and how those boundaries interact with validity and its dependence on priority date; the *clearly defined* requirement is, of course, similarly motivated. An interesting comment, which is less than supportive of the above, was made on the *limited number* requirement of Reason 6.7, G0002/98 by the judge in the HTC case *supra*<sup>38</sup>.
- (iv) It may also not make a great deal of sense for the system to produce outcomes such as mentioned in the footnote to Paragraph 1.1.6.
- (v) If sub-Paragraph (ii) is correct as a matter of interpretation, it must follow that claim splitting is not dependent on what the patent/application identifies by way of individualised domains (the position taken in the decisions referred to earlier in Paragraph 3) but *per contra* on the disclosure of priority domains in the priority documents which fall within the scope of the claims in the patent/application. The alternative subject-matters to which the *limited number* and *clearly defined* tests of G0002/98 are applied are thus the sum of those which have a claimed priority date and those which do not.
- (vi) This proposition is the converse of the overall *semi-consensus* position which has been developed in EPO case law over the *circa* 10 year period up to the end of 2012 – and indeed supported by the Nestec case<sup>39</sup> in the UK Patents Court within the few weeks prior to authorship of this paper. However, it is suggested that it is a proposition of merit.

inherently calls for a determination which balances private and public interest although with the latter naturally of greater weight

38 The judge's comment, in Paragraph 160 of the judgement, reads (emphasis added) „Although one can sympathise with the desire for a limited number, I doubt there is any principled basis for such a requirement but I accept the need for clearly defined alternative subject-matters if a single claim is to be given multiple or partial priorities“

39 See Paragraph 2.6 above

37 The „clearly defined“ requirement is submitted to be an Article 84 EPC test – the latter safeguards public interest, and public interest should demand clarity, not just on what a claim covers *per se*, but on what parts of that coverage grounds for invalidity impinge differently; that said, Article 84 EPC

## 5. 2013: The T1222/11 Approach to Split Priority

5.1 This decision, published in December 2012<sup>40</sup>, also challenges the development of case law over the 10+ years which preceded it, and provides reasoning which has significantly greater depth – and obviously much greater authority – than the thoughts expressed in Paragraph 4.2 above.

5.2 In doing so, the decision goes out of its way to set out a complete alternative (and, by definition, contrarian) approach occupying just over 11 pages of *obiter* content which is formidably, if somewhat challengingly, reasoned. The decision directly demurs from the opinions set forth in T1127/00, T1443/05, T1877/08 and T0476/09 in Reasons 11.4 and 11.5 (pages 23 and 24 of the decision) as regards the proper interpretation of the proviso to Reason 6.7 of G0002/98 (“... *provided that it* [ie the use of a generic expression in a claim] *gives rise to the claiming of a limited number of clearly defined alternative subject-matters*”).

5.3 T1222/11 states that the determination of whether subject-matter claimed within an “OR” claim enjoys priority is independent of whether the subject-matter in question is identified in the “OR” claim<sup>41</sup>. This directly contradicts T1127/00 in particular. The decision justifies this position with detailed argument as to how Reason 6.7 G0002/98 is properly to be construed. With a degree of synthesis, the writer’s interpretation of these arguments is as follows:

- (i) Article 88 EPC deals with substantive issues of priority right and not just procedural issues<sup>42</sup>. More specifically, Article 88(3) EPC, when properly interpreted, states that if priority is claimed by an application, the applicant/patentee is *entitled* to priority for the *elements* of the patent application<sup>43</sup> included in the priority document(s). There is no conditionality that the included elements should themselves be identified individually as such in the patent/application. In line with this, the final sentence of Reason 6.7 of G0002/98 confirms that a claim in a patent/application claiming priority may subsume the *elements* in question within a generic expression such as a formula. [See Reason 11.5.1 of T1222/11 on pages 23 and 24 of the decision]
- (ii) Per G0002/98, the determination as to which *elements* enjoy priority is to be carried out by comparing the claim under assessment with the priority

document(s)<sup>44</sup>. The two tests set out in the proviso to Reason 6.7 of G0002/98 (namely, the *limited number* and *clearly defined* tests) refer, according to the board in T1222/11, to (i) the *alternative subject-matters* which are disclosed in the priority documents and are conceptually identifiable in the claim under assessment (as opposed to actually being individualised)<sup>45</sup> plus (ii) the *alternative subject-matters* encompassed by the claim but not disclosed in the priority documents. [See Reason 11.5.2 of T1222/11]

- (iii) The *limited number* and *clearly defined* tests serve to enable the public to identify which parts of the claim concerned enjoy the benefits of priority according to Article 89 EPC. [See Reason 11.5.3 on pages 24 and 25 of T1222/11]
- (iv) According to G0002/98, the legislative intentions<sup>46</sup> behind the provisions of Article 88 EPC regarding multiple priorities are as set out in the FICPI Memorandum<sup>47</sup>. The FICPI Memorandum makes clear by the words (quoted by the board in T1222/11): “*It is, of course, immaterial whether the word “or” actually occurs in the claim, or is implied through the use of a generic term, or otherwise*” that an embodiment need not be individualised as such in a patent/application to benefit from priority. [Reason 11.5.4 of T1222/11]
- (v) The FICPI Memorandum gives three examples of “OR” claims. The first example refers to a context where a narrow formula in the priority document is replaced by a broader encompassing formula in the later priority filing. The example proposes that multiple priorities are enjoyed by doing no more than including a single claim directed to the broader formula; such claim carries the date of the priority document insofar as it *encompasses* the narrower formula. It therefore supports the contention that it is whether an element of an invention disclosed in a priority document *falls within the scope of the claim in question* that is determining of priority entitlement. This first example given by FICPI expressly uses the term “*scope*” in referring to the relationship between elements of the invention and the claim, adding to the clarity that the element need not be *individualised* in the claim. [See Reason 11.5.5, page 26 of T1222/11, lines 10, 11, 21 and 22].
- (vi) The second FICPI Memorandum example attributes priority entitlement to temperature-defining domains of the claim concerned despite the fact

40 T1222/11 is a helpful decision which points a way forward to a (perhaps) more hospitable approach to priority date assessment in multiple priority contexts. However, of the four options on intra-EPO distribution available to the board when issuing a decision, the deciding board opted for distribution to chairmen only, with the result that dissipation of the case may be slower than it might otherwise have been

41 Reason 11.8 on page 30 of the decision states: “... so far as a subject-matter disclosed in a priority document and encompassed by an „OR“ claim of a European application ... is concerned, the decision on whether priority can be acknowledged for this subject-matter ... is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the „OR“ claim ... as a separate alternative embodiment” (emphasis added)

42 Reason 6 of G0002/98

43 Reason 6.2 of G0002/98 states that this term is synonymous with *elements of the invention*

44 Reason 4 of G0002/98 and Article 4H of the Paris Convention

45 Kitchin J may have got close to this in *Novartis AG v Johnson & Johnson Medical Ltd* [2009] EWHC 1671 (Pat), where, at Paragraph 122, he stated: “I discern from this passage [Reason 6.7 of G0002/98] that the EPO considers it is permissible to afford different priority dates to different parts of a patent claim where those parts represent a limited number of clearly defined alternative subject-matters and those alternative subject-matters have been disclosed (and are enabled) by different priority documents. Further, this principle applies even if the claim has adopted a generic term to describe and encompass those alternatives. I do not detect anything in the decisions of the Court of Appeal in *Pharmacia* and *Unilin Beheer* which is inconsistent with this approach and in my judgment is one which this court should adopt.”

46 Reason 6.3 of G0002/98

47 Memorandum M148II, Section C in the *Préparatoires Travaux*

that they are not (all) “*explicitly or implicitly disclosed in the claim*”. [See Reason 11.5.6, page 27 of T1222/11, lines 14 to 18].

- (vii) The third example in the FICPI Memorandum presents a context where the claim defines in general terms a substrate to be treated (inner surfaces of a hollow body) but it is stated by FICPI to enjoy priority for domains disclosed in priority documents (inner surfaces of pipes) which fall within those general terms but are not identified as such in the claims. The identifiable alternative subject-matters in the claim are those related to treatment of inner surfaces of (a) pipes and (b) hollow bodies other than pipes. [See Reason 11.5.7 of T1222/11]
- (viii) The opinions expressed by the board are not, in the board’s view, inconsistent with the key teaching set out in the Conclusion of G0002/98 (that the skilled person must be able to derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole). The EBA’s Conclusion (see page 20 of G0002/98) is not, according to the board in T1222/11, applied to “OR” claims as such *in vacuo* but takes account of, and is without prejudice to, both Reason 6.7 of the EBA’s decision and to the provisions of Article 88 EPC. Reason 6.7 is to be applied to a claim in a comparative manner with respect to the priority documents so as to identify a domain within the claim scope for which the priority document contains basis entitling that domain to priority<sup>48</sup>. [See Reason 11.7 of T1112/11 on page 30]
- (ix) G0002/98 emphasises the need for application to patents/applications of the legal concepts underlying EPC in a consistent and coherent manner. This is important when considering Article 87(4) EPC, which provides for priority rights to be generated only from the *first* application for protection of an invention. When, for example, a priority document P1 encompasses narrow subject-matter already disclosed in an earlier application *P minus 1* filed before the start of the Paris Convention period applicable to the context, this is a crucial question. By custom and consensus, answering the question does not involve determining whether the narrow subject-matter is actually identified in an individualised manner in the later specification P1. For consistency, the same standard of consideration must apply to the different question of the priority date candidature under Article 88(2)(3) EPC of a domain within a claim of a P2 patent/patent application validly claiming priority from that P1 priority document – the principle of consistency and coherence between implementation of Article 87(4) EPC and Article 88(2)(3) EPC means that priority cannot depend on whether the subject-matter of the domain is actually identified in

an individualised manner in the P2 case. [see Reason 11.8, bridging pages 30 and 31 of T1222/11]

5.4 As noted already, T1222/11 demurs from the T1127/00 position that, for a domain of a claim to enjoy a claimed priority date, that domain must be individualised in the claim concerned. It appears, however, that T1222/11 may go further and establish that the domain need not be individualised in the application/patent **as a whole**.

5.5 The board’s elaborate and independent reasoning, which leads off from G0002/98 along an entirely different road to T1127/00, means that the board’s conclusion has no inherent pre-requisite that a domain disclosed in a priority document and encompassed by the claim in question, if not identified as such in the claim, must nevertheless be flagged in the body of the patent specification.

5.6 In addition, simple logic would suggest that, in terms of this issue, there is no distinction to be made between a condition under which subject-matters are identified in the claims which encompass them and a condition under which such encompassed subject-matters are identified in the patent/application in question as a whole – if the former is not a requirement, then nor can the latter be. Moreover, there is no part of G0002/98 or the FICPI Memorandum which suggests that **any part** of a patent specification must itself, as a pre-condition for priority entitlement, identify a domain for which priority-generating basis can be found in a priority document. It is perhaps notable that the (somewhat difficult language) of Reason 11.8 refers at its very end (page 31) in a specific context to the lack of any need for identification of a priority domain (anywhere) in the later application there referred to.

5.7 Although T1222/11 does not mention T0910/06 (December 2008) *supra*, it is possible that the latter-mentioned decision provides support for the position taken by the board in T1222/11.

5.8 In T0910/06, priority date entitlement for a claim in a patent under opposition needed to be established to distinguish the invention over a self-disclosure – a scientific paper published by the inventor before the filing date. Relying on Article 88(4) EPC and Reason 6.2 of G0002/98, the board took the approach of seeking an answer to the query as to what subject-matter in the citation which fell *within the scope* of the claim under challenge could also be found in PD2 – the board expressing the view that, in such case, the citation did not form part of the state of the art as the claim would enjoy the date of PD2. The board found this to be the case on a fact pattern in which it assessed PD2 as disclosing, in its overlap area with the claims, the same mix of reactants and initiator as did the citation. The board did not cite Reason 6.7 of G0002/98 but from Reason 6.7 (sic) of T0910/06 it seems clear the board was articulating the idea of a claim split to define a domain entitled to the date of PD2. The board appeared not to

<sup>48</sup> This suggests the T1222/11 approach will mean more opportunities for award of multiple priorities where the subject-matter of the claim as a whole does not pass the test set out in the Conclusion of G0002/98

be looking for any individualization of the relevant priority domain in the patent, merely stating (again in Reason 6.7 of T0910/06) that the subject-matter of the domain fell *within the scope* of the claim under consideration (as in T1222/11). It may have been possible to find basis for such individualisation<sup>49</sup> but the board in T0910/06 did not seem to make it a pre-requisite<sup>50</sup>.

5.9 It is interesting that in the Nestec case *supra* before the UK Patents Court in April this year, the judge appears not to have considered T1222/11 even though that decision was published several months before his judgement<sup>51</sup>. T1222/11 also appears not to have been considered by the (different) judge in the event more recent HTC case *supra*, which came to trial in the weeks bridging April and May 2013. In Netstec, an appeal to the UK Court of Appeal was filed in June 2013, a trial date in late 2013 or early 2014 being expected. Additionally, an appeal is pending before an EPO board of appeal (Appeal T1674/12) on the same European patent<sup>52</sup> and is expected to be heard later this year<sup>53</sup>. It therefore seems likely that a view on T1222/11 may be forthcoming from both appellate instances in the relatively near future.

## 6. Specific Embodiments as Priority Domains

6.1 In cases where priority date really matters, it is commonly because of an interim publication which (as noted in the footnotes to Paragraph 1.2.1) experience shows is not only rather specific but which also emanates from persons associated with the patent in question (eg the inventors or the patentee)<sup>54</sup>. Typically, in such cases, the publication is of a commercial form of the invention or a *whole contents* citation which discloses a specific embodiment of the invention. Where such a disclosure is cited against a claim established to be disentitled to a claimed priority date that would have neutralised the citation, it is relevant to pose the question:

*Could the claim be partitioned under Reason 6.7 of G0002/98 to define as one priority domain the subject-*

49 In terms of individualisation, first impression suggests that the reaction mixture features of T0910/06 mentioned in the body of Paragraph 5.8 above are constituents severed from Examples. It is submitted that by reference to the patent specification, this is not so; rather, the constituents are mentioned in passages which, although *organisationally* positioned as if part of the body of Examples, are not *intellectually* fixed in that setting. As such, the features are individualised and would in the context not unreasonably have been combined as a priority domain of the claim under assessment following the T1127/00 approach to G0002/98

50 T0352/97 (October 2000) may be earlier appeal board thinking somewhat in alignment with T1222/11. The board assigned the date of PD1 to subject-matter which subsumed the intermediate prior art and which corresponded to a subset of substituent definitions disclosed as such in PD1 and encompassed within the overall scope of the claim concerned; there was no apparent search for a disclosure of the subset identified as such in the case under consideration

51 The Nestec 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

52 The litigation of the patent in suit forms part of a portfolio of proceedings in various jurisdictions

53 It is understood that T1222/11 has been cited in the EPO appeal

54 See Paragraph 1.2.1 and its footnotes, above

*matter of the specific embodiment (that domain then enjoying the date of the priority document)?*

6.2 Two cases where the fact pattern appears to have presented an opportunity for the board to do just that are (i) T1443/05 and (ii) T0665/00 *supra*. T1443/05 is a case where *whole contents* conflict arose between generationally separated family members, the patent in suit having claims which did not enjoy the priority date of the cited matter as a result of a disclaimer introduced after first filing. The cited matter was specific Examples of earlier priority date in the published priority document, the latter cited as a *whole contents* citation<sup>55</sup>. T0665/00 *supra*, whilst not quite the same scenario, was similar in that the citation was of a prior use of an Example in the patent in suit, which prior use took place between the claimed priority date and the filing date<sup>56</sup>.

6.3 In T0665/00, in which decision the deciding appeal board ultimately decided in favour of the proprietor, it seems that the fundamental motivation of the board emanated from a view that justice would be served by neutralising the anticipatory prior use conflict. The special approach of splitting the claim to provide a domain whose subject-matter is the offending Example could theoretically have cured the problem and that would have aligned with the board's apparent motivation. However, the deciding board chose *not* to take the approach of splitting the claim to create a domain whose subject-matter is the offending specific embodiment. In T1443/05, the board decided against the patentee but the above special approach was available to it. However, the deciding board in that case too chose *not* to take the approach of splitting the claim to create a domain whose subject-matter is the offending specific embodiment. In the limited sense that such domains are usually unlikely to satisfy the *clearly defined* test set out in the proviso of Reason 6.7 of G0002/98<sup>57</sup>, this seems sensible in both cases. In the case of T1443/05, the plurality of the specific embodiments would perhaps also

55 T1443/05 is similar to T0680/08 in terms of the legal principles applied and the fact that both are in the chemical field. In T1443/05, the priority document (a European patent application which had been published and which 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 eventual patent disclaimed the presence of this component. The patent and priority document were held in opposition proceedings 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) did not support the priority claim and (b) were held to anticipate the patent as it fell within the scope of its claims. An interesting paper analysing T1443/05 appears in *EPI Information 2/29* („Study of Priority Right under EPC: Same Invention/Disclaimers“, *F Portal*, EPI Information 2/09, pages 56-59. The Portal paper states (page 58, column 1) that all of the Examples of the priority document in T1443/05 which disclose compositions from which the particular biocide concerned was absent, appear in the application which matured into the opposed patent (and would be entitled to the date of the priority document). A quick review by the non-German-speaking writer of the present paper could not fault this

56 It will be recalled that, in T0665/00, it was established as fact that Example 1 of *the patent* and Example 1 of *the priority document* were the same, the former simply giving more details of what the branded microsphere component actually was (Reason 3.2).

57 As to clarity, Example 1 of the patent in T0665/00, not untypically of many patent specifications, defines the microspheres in part by reference to a trade mark, and there is a run of case law holding that use of a trade mark in a claim contravenes Article 84 EPC (see T0762/90, T0932/92 and T0480/98)

mean that the *limited number* test of G0002/98 would not be met. But perhaps the point is that in neither case do the decisions suggest that the above special approach has been contemplated.

6.4 Specifically at the UK level, Hospira<sup>58</sup> is a case where Example 5 in the patent reported a Phase 2 clinical trial and where the same report appears as Example 5 in PD2 (the only priority document at issue) – therefore, on the face of it, Example 5 of the patent was subject-matter carrying the PD2 priority date. The primary (novelty) citation, relevant only for subject-matter disentitled to the date of PD2, also reported the same Phase 2 trial. The citation, however, used different language and, to some extent, different terms (eg with reference to the definition of the patient volunteer group receiving treatment). This underlines the difficulty in deploying Examples in this way as the question of whether the cited subject-matter falls wholly within the defined domain (which would mean a neutralised citation) or whether it straddles the walls of the domain (which would not clearly have the neutralising effect) is not easy. Of course, one could instead define the priority domain as consisting of the report of the clinical trial in the citation, and the question then requiring an answer would be whether that subject-matter satisfied the identity of invention test laid down in the Conclusion to G0002/98 so as to have the date of the priority document.

6.5 On the basis of most case law experience to date, it is reasonable to venture the instinctive prediction that the idea of splitting a claim to provide a domain whose subject-matter is the offending Example of a citation is unlikely to be a popular one with many EPO appellate instances and other tribunals in the foreseeable future. Indeed, it's hard to resist the feeling that it is debatable whether *in principle* an Example would be capable of the individualisation contemplated by G0002/98<sup>59</sup> as interpreted eg by the appeal board in T1127/00. It remains to be seen whether T1222/11 will change this.

## 7. Split Priorities – Practise

7.1 The concept of priority is exceedingly difficult and collective EPO appellate case law, whilst helpful, is disappointingly so. The notion that a priority domain must be seen as individualised in the patent/application under assessment enjoys a degree of establishment, whilst at the same time being poorly understood by a significant audience and not always easy to implement. T1222/11

seems, although this is an early stage, a sensible decision with practical benefits in terms of priority date assessment generally – and in terms of dealing with *Poisonous Division and Poisonous Priority Documents*<sup>60</sup> more specifically.

7.2 It is tempting to conclude that the decision in T1222/11 will result in a referral to the Enlarged Board of Appeal; indeed, the decision manifests all the hallmarks of a device created to lead to just that result.

7.3 In the interim, prudent practitioner policy – remembering that even practitioners whose practice is wholly patent procurement have to stand in the two opposing corners of securing priority for their client's claims and obstructing priority for cited matter under Article 54(3) EPC – should recognise that, as matters stand, outcome will depend on whether it is the T1127/00 or T1222/11 approach to multiple priority that prevails in any particular instance<sup>61</sup>.

7.4 Best drafting practise in preparing patent applications at the stage of filing priority-claiming applications will no doubt, pending an Enlarged Board of Appeal decision, be to ensure that all originally disclosed features falling hierarchically below the broadest scope of claim going forward are clearly retained in the priority-claiming filing<sup>62</sup>. As noted earlier, it is common for anticipatory material to be self-published (eg as *whole contents* matter), and here the necessary strategy is to ensure the presence of a disclosure which individualises an embodiment which (a) is entitled to priority and (b) encompasses the self-published matter. Experience seems to show that this does not always happen. Under G0002/98 and T1127/00, this would enable a claim which has been broadened to be partitioned into a domain distinguished by virtue of priority date and a domain which is novel by virtue of subject-matter differentiation.

7.5 It should be appreciated that in principle the same rationale applies where the case going forward has been *narrowed* by incorporation of a new narrowing feature; a domain reflecting even greater narrowing and entitled to priority may well be distinguished over such a self-disclosure as mentioned above and, in the same fashion as in broadening contexts, serve through the claim-splitting process of G0002/98 to save the claim from what would otherwise be an anticipation.

58 Hospira and another v Novartis, [2013] EWHC 516 (Pat) *supra*. One of the Novartis patents involved is subject to EPO opposition also citing the principle novelty citation deployed in the UK Patents Court proceedings

59 The message in Reason 6.7 of G0002/98 is that it is intended to deal with situations where development of the invention in the first year after first filing gives rise to a second filing which introduces Feature B as an alternative to Feature A disclosed in the first filing. Assuming the specification drafting supports it, one can imagine fitting into this scheme a narrowing scenario – splitting out of embodiments characterised respectively by a narrow Feature B (Priority P2) and an originally disclosed preferred form of Feature A (Priority P1) which is even narrower. However, that seems to be an adventure in itself and it could be that a split to define a domain consisting of an entire specific embodiment is simply not permissible as a matter of principle

60 As to both, see:

(1) „*Poisonous EPC Divisionals (Just as you thought it was safe....)*”, Malcolm Lawrence, *Inventive Steps – Ideas in IP Management*, December 2010

(2) „*Poisonous EPC Divisionals – Implications for Risk Management & Opportunistic Advantage*”, Malcolm Lawrence & Marc Wilkinson, *EPI Information*, No 2/2011, pages 54-61, European Patents Institute, June 2011

(3) „*Thoughts and Feedback since Original Publication of the 'Poisonous Divisionals' Concept*”, Malcolm Lawrence & Marc Wilkinson, *Journal of the UK Chartered Institute of Patent Attorneys*, February 2012, pages 74-78

61 It is not totally unrealistic to assume that, pending an Enlarged Board of Appeal decision, there is a prospect that boards in the pharmaceutical and life sciences fields may follow T1127/00 (which was a biotechnology decision) whilst boards dealing with other matter may follow T1222/11 (where the patent was not in these areas)

62 There is in principle quite a lot of potential practitioner control at this point, although obviously falling short of an omniscient awareness of all prior art that may produce a call for a multiple priorities

## 8. Applying the G0002/98 Conclusion to Priority Documents

8.1 The more case law that is read on this subject, the clearer it is that the philosophical and practical need for consistency between the various principles underlying the EPC has driven home a firm policy that the standard to be applied when considering a priority document for basis for a priority claim is the same as under Article 123(2) EPC. Voices can be heard in IP corridors which (still) suggest that the EPO will sometimes adopt a softer approach for priority date assessment. Although this is not without some grounds<sup>63</sup>, the case law overall makes it clear that no safe presumption can be drawn from this: it is evident from G0002/98 that a narrow and strict interpretation of the concept of “*the same invention*” should be applied, equated to the concept of “*the same subject-matter*” referred to in Article 87(4) EPC, and that this is being applied faithfully by at least the more experienced lower appeal boards – and indeed the stated reasoning set out in the Conclusion of G0002/98 is reiterated *in terms* with ubiquity in appellate decisions.

8.2 In T0070/05 (February 2006), the above was illustrated by a very experienced board in holding the claims in question as entitled to the claimed (first or second) priority dates and then applying G0002/98 to the whole contents citation alleged nevertheless to anticipate them. The board noted that a small percentage of the amino acid residues of which the receptor molecules disclosed in the citation and its priority document consisted were different as between the priority document the citation, holding that this deprived the citation of the right to priority (see Reason 13). The board suggested that this would be the right decision regardless of the reasons for the different amino acid in the two documents, even if this was due eg to a typing error.<sup>64</sup>

8.3 Somewhat analogous fact patterns arose in T0351/01 (July 2003), T0030/02 (October 2006), T0902/07 (December 2010) and, in particular, T1213/05 (September 2007). In T1213/05, the patent claimed a nucleic acid the definition of which relied on a coding sequence which enjoyed more than 99.5 % homology (see Reason 28, third paragraph) with a coding sequence disclosed in a priority document. It was argued by the patentee that, if parameters used to define a substance in a claim are known to vary within margins of commonly encountered experimental errors, variation in such a parameter between a priority document disclosure and a claim being assessed for priority date purposes did not necessarily abrogate entitlement to the claimed priority date. However, the board disagreed (Reason 29), referring to G0002/98 and T0070/05 *supra* in particular, as well as, comprehensively, to various other appellate decisions<sup>65,66</sup>.

63 See the examples in Paragraph 8.5, second bullet point and Paragraph 8.6, below

64 This point in T0070/05 is made with reference to that decision, but with perhaps even greater force and clarity, in T1213/05, Reason 33, second paragraph

65 Oral proceedings were heard in both T0070/05 and T1213/05 by very experienced boards, in T1213/05 a five-member board. Both T1213/05

8.4 The decisions referred to in Paragraphs 8.2 and 8.3 relate to cases in the biotechnology field and it is in this field, and in the chemical and pharmaceutical fields, that most cases, and the most argued cases, can be found. However, it hardly need be stated that this is a circumstantial reality rather than a limit on applicability of G0002/98.

8.5 As to other technologies: –

- In T0184/06 (March 2007), the Conclusion of G0002/98 is applied in Reason 6.1.1 to disallow priority for a claim broadened to include additional possibilities for a component of a chemical composition and for the absence of another component required in the priority document. It is perhaps the firmness with which the decision (a feature it has in common with others) refers to the “*established jurisprudence of the boards of appeal*” (Reason 6.1.1) which makes the decision compelling, together with the specific referral to Reason 9 of G0002/98 (which latter concludes that the so-called “*narrow*” interpretation of the expression “*same invention*” is to be applied in priority date assessment)
- T0273/04 (March 2006) is a relatively rare example of seriously challenged priority date assessment in a mechanical case, the decision made being in favour of the patentee. It is not immediately clear from Reason 2 of the decision how the differences between the terms in which the subject-matter was claimed and those of the second priority document were not fatal to that priority claim under the G0002/98 test. Both the description and the claims of the (second) priority document call for a configuration including members having side walls and concave-shaped and convex-shaped further walls having apices which, in at least one case, is substantially flat (arguably, on the basis of the description in the priority document, only a preferred feature). Claim 1 of the Main Request does not recite this configuration but was nevertheless held entitled to the date of the priority document. Further, that claim also recites the presence of longitudinal struts and this can be compared with the disclosed *preferred* feature in the priority document of longitudinal struts – but there these connect the apices whereas the claim in the patent merely states that the struts connect rows of the members. As a mechanical case, T0273/04 may simply reflect the tendency for cases in certain technologies by habit to experience

and T0070/05, in surveying a great deal of case law on the subject of priority date assessment, are each a memorable tableau on the topic not limited to the specific points made here. Reason 29 of T1213/05 is perhaps the most powerful development of the key teaching of G0002/98

66 In this respect, as already noted above, the point in T0070/05 about small discrepancies between patent and priority document (eg caused by experimental errors) is made with reference to that decision, but with perhaps even greater force and clarity, in T1213/05, Reason 33, second paragraph. Reason 40 of T1213/05 expresses the board’s firm rejection of the notion that the narrow interpretation of the requirement for identity of invention should be replaced in specific cases by a different approach taking account of “*possibly unintended errors resulting from specific physical characterization methods*”, adding the further point that the Enlarged Board of Appeal in G0002/98 state that a distinction between technical features related to function and effect of an invention and features not having this significance must be avoided

Article 123(2) EPC with less injury<sup>67</sup>, as well as less frequency, than say biotechnology cases.

8.6 There are cases in the biotechnology field which contrast with *T0070/05* and *1213/05*, although these can be explained and don't detract from the substantial establishment enjoyed by the strict application of the "narrow" interpretation of the expression "same invention". In *T0065/92* (June 1993), the board held that a glycosylated polypeptide of molecular weight 61-68kD was entitled to priority from a priority document disclosing one of molecular weight 61-65kD. However, importantly that decision predates G0002/98 by nearly 10 years and it is suggested that it would be decided differently now for several reasons. First, Reason 3.2 (final paragraph) of *T0065/92* suggests that the board was influenced by an understanding that the difference was "qualitatively irrelevant" in terms of function, a factor which would not *per se* find favour with a modern board, and did not find it with the board in the run of decisions led by *T1213/05*<sup>68</sup>. Secondly, notwithstanding that both the patent and priority document made it expressly clear that the reader was being informed of approximate figures, the patentee made a choice in presenting the skilled man with different information in the patent<sup>69</sup>.

8.7 As an aside, it is suggested that the same is not quite true in the case of the branded microsphere component density in *T0665/00 supra*, whose priority document recited no density at all in its Example 1. The question

was whether Example 1 of the patent, *which did*, was the same, in particular with respect to density. In what must have been a difficultly balanced decision for the board, patentee submissions – supported by expert evidence – that the microsphere density in both was *virtually* the same<sup>70</sup> were accepted as establishing as fact that this was indeed the case. The approximation took place outside the documents being compared and was attributed to the evidence rather than those documents.

8.8 In this respect, as mentioned earlier<sup>71</sup>, the board in *T0680/08* drew a clear distinction between claims *broadened* and claims *narrowed* at P2 filing relative to the relevant priority document, and in Reason 1.3, second paragraph the board stated that it found nothing in G0002/98 to suggest that the Enlarged Board of Appeal had "explicitly" considered situations where a claim had been "marginally" narrowed (in the case before it, the range "0.325 – 0.415 kWh/kg" had been changed to "0.330 – 0.415 kWh/kg"). In the light of the emphasis the Enlarged Board put on the need for a "narrow and strict approach" to the expression "same invention" and to the clear ruling in the Conclusion of G0002/98, the approach in *T0680/08* seems highly adventurous and out of alignment.

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67 Although there are exceptions, of course – see, for example, *T0030/01* (June 2004) concerning an imaging apparatus and *T0832/04* (September 2006) concerning a bale shredding apparatus, although these perhaps were not cases where the board was faced with especially contentious situations

68 In *T1213/05*, the board held in Reason 31 that for justice to await a decision on whether deviations between a priority document and a patent claim had any effect on the function of the subject-matter in question would be incompatible with G0002/98. The decision refers with approval to *T0351/01* in which polynucleotide sequence deviations were sufficient to deny priority even though the deviations were in non-coding regions of the polynucleotide and could not have any functional effect on the polynucleotide or the protein it encoded

69 There is an analogy here with early Article 123(2) EPC case law drawing a distinction between information originally disclosed and information which was not but which falls within the scope of the original disclosure. Information is either new or not, and a flag in both documents concerned in *T0065/92* indicating that the data constituting it is approximate does not, through the notion that approximation naturally infers scope, do anything to change that

70 Example 1 of the patent in *T0665/00* stipulated presence of a branded microsphere product of density 0.04 g/cm<sup>3</sup>. In the expert testimony referred to, a figure of 0.036 g/cm<sup>3</sup> was given for that branded product used in Example 1 of the priority document

71 See Paragraph 1.1.9 footnote

