

## Priority in Europe

*(everything<sup>1</sup> you wanted to know but didn't want to ask)*

### 1. Introduction

1.1 Both granted patents and applications in the examination phase can, and often do, fail on the basis of the invalidity of the priority claim combined with a prejudicial disclosure made available to the public in between the priority and filing dates.

1.2 Notwithstanding the often critical reliance placed on the priority claim, it is surprisingly common to find that European-specific aspects of substantive and procedural priority requirements are overlooked.

1.3 What follows is intended to provide a wide-reaching discussion of priority requirements in Europe, whilst recognising that nuances and variations inherent in specific cases may fall outside of the scope of this general overview.

### 2. Substantive Requirements

#### 2.1 Disclosure - the “same invention”

2.1.1 The Enlarged Board of Appeal of the EPO has laid down<sup>2</sup> a strict test for assessing whether the subject-matter of a particular claim is disclosed in an earlier application.

2.1.2 The legal test to be applied is that both the earlier application and any subsequent claim should define the “same invention”. The Enlarged Board equated the “same invention” with the “same subject-matter”. Priority should therefore be acknowledged if the person skilled in the art can derive the specific combination of features, in the context required by and recited in the claim, directly and unambiguously using common general knowledge, from the earlier application as a whole.

<sup>1</sup> (Almost)

<sup>2</sup> [G2/98](#)

2.1.3 Importantly, when analysing whether all features of a claim are disclosed in the earlier application, such analysis should even consider technical features which are not related to the function and effect of the claimed invention<sup>3</sup>. In other words, each and every feature should be directly and unambiguously disclosed (in the appropriate context) in the priority document, notwithstanding that one or more of those features may not influence the overall technical effect achieved by the combination of remaining features<sup>4</sup>.

2.1.4 The UK Court of Appeal made clear<sup>5</sup> that the leading authority on priority in the UK (the House of Lords decision in *Biogen v Medeva*<sup>6</sup>) was consistent with the Enlarged Board of Appeal opinion in *G2/98*. As such, at least in principle, there should be little or no divergence between the approaches of the EPO and UK tribunals when assessing the validity of a claim to priority.

#### 2.2 Enabling character of the priority disclosure

2.2.1 Case law of the EPO Technical Boards of Appeal has long recognised that for a claim to priority to be acknowledged as valid the earlier application should be disclosed in a manner sufficiently clear and complete for the skilled person to implement the invention<sup>7</sup>. The skilled person should, without undue burden, be able to implement from the disclosure of the priority document substantially all embodiments falling within the ambit of the subsequent claim(s)<sup>8</sup>. This approach has been fully endorsed by the House of Lords and is thus similarly applied under UK case law<sup>9</sup>.

<sup>3</sup> [G2/98](#) at paragraph 9 of the Reasons for the Decision

<sup>4</sup> In contrast, in the case of a feature added by amendment after filing and which does not provide a technical contribution to the subject-matter claimed, such a feature can be ignored when assessing allowability of the amendment ([G1/93](#)).

<sup>5</sup> in [Unilin Beheer v Berry Floor \[2005\] FSR 6](#)

<sup>6</sup> [Biogen v Medeva \[1997\] RPC 1](#)

<sup>7</sup> [T81/87](#), [T193/95](#), [T843/03](#)

<sup>8</sup> [T843/03](#) at paragraph 3 of the Reasons

<sup>9</sup> [Biogen v Medeva \[1997\] RPC 1](#)

2.2.2 Where biological material is to be relied upon for the purposes of enablement, such material should be deposited with a recognised depositary institution in accordance with the terms of the Budapest Treaty. Any deposit must be made no later than the date of filing of the application whose priority is to be claimed, and the relevant formalities must be complied with<sup>10</sup>. Failure to comply with any of these requirements could render the priority application insufficient, and lead to invalidity of any subsequent priority claim.

### 2.3 Support

2.3.1 Under both the European Patent Convention and the British domestic patent statute, the claims should be “supported by the description”<sup>11</sup>. These provisions give effect to the general legal principle that the monopoly under the patent should be coterminous with the technical contribution to the art. The question of “support” is distinct from the question of whether the language of the claims finds basis in the application as originally filed.

2.3.2 In the UK House of Lords decision in *Biogen*<sup>6</sup>, it was held that the disclosure of the earlier application whose priority was claimed did not support the breadth of the claim in the subsequent patent. Lord Hoffman explained that whilst a requirement for a valid application is that the claims should be supported by the description, the issue of support is not a formal ground for revocation of a subsequently-granted patent, in contrast to the issue of enablement. Nevertheless, it was explained<sup>12</sup> that the substantive effect of the pre-grant support provision, i.e. that the description should, together with the rest of the specification, constitute an enabling disclosure, is given effect by the provision of lack of enablement as a ground for revocation. The UK priority provisions require the claims in suit to be supported by subject-matter disclosed in the earlier application.

<sup>10</sup> See, for example, [Rule 31 EPC](#)

<sup>11</sup> [Article 84 EPC](#) and [Section 14\(5\)\(c\) PA1977](#)

<sup>12</sup> [Biogen v Medeva \[1997\] RPC 1](#) at paragraph 60

Consequently, Lord Hoffmann explained, there is a need for an enabling disclosure to satisfy the requirements of support for a valid priority claim.<sup>13</sup>

### 2.4 Plausibility

2.4.1 Recent developments in European patent law have established a principle that at the time of filing the patent application it should at least be plausible that the invention actually solves a technical problem, and not merely puts one forward. Where there are limited or no data in the application to prove that a claimed invention actually solves the stated problem, the EPO may refuse to allow the filing of subsequent evidence if, on the basis of the application as filed, the plausibility of the solution is not established.

2.4.2 A recent Board of Appeal case<sup>14</sup> has determined that the assessment of the plausibility requirement, at least as far as inventive step is concerned, applies only in respect of the subsequent application as filed, and not the earlier application whose priority is claimed. The basic requirements for a subsequent claim to enjoy priority are merely that the subject-matter of the claim should be clearly and unambiguously disclosed in the earlier application, and that the earlier application provides an enabling disclosure (see above). In other words, there is (perhaps paradoxically) no current requirement that the earlier application itself must necessarily involve an inventive step over the prior art, although an objection may nevertheless arise in the form of lack of enablement or support.

### 2.5 The “first application” & regenerating the priority date

<sup>13</sup> This reasoning was subsequently explained to relate to situations where the claim in suit was drawn to a product “*defined by a class of processes of manufacture*”, and thus the *Biogen* reasoning may have limited applicability in practice (see [H Lundbeck A/S v Generics \(UK\) Ltd & Ors \[2008\] EWCA Civ 311](#), paragraphs 30-35)

<sup>14</sup> [T903/05](#) at paragraph 12 of the Reasons

2.5.1 To validly claim priority from an earlier application, the earlier application must be the first application disclosing that subject-matter. Thus, any subject-matter disclosed in an application whose priority is claimed will not be entitled to that priority if the same subject-matter is disclosed in an application which pre-dates the application whose priority is claimed, unless very strict criteria are fulfilled (see below).

2.5.2 For example, where a first application is filed disclosing subject-matter “X”, a second (subsequent) application is filed separately disclosing subject-matter “Y” but also disclosing X a second time (for example a US Continuation-in-part application) and then a PCT application is to be filed within 12 months of the first filing, priority should be claimed from both applications. A priority claim only to the second application would be considered invalid having regard to a claim only to subject-matter “X” since it would not be the “first application” for that particular subject-matter.

2.5.3 A subsequent application covering the same invention can be considered to be the “first” application, if (before filing the subsequent application) an initial application for that invention is withdrawn before publication and in such a way that no rights are left outstanding. Since the right of priority is itself a right arising separately from the application (and can be independently assigned), the requirement to leave no rights outstanding in connection with the initial application means that the right of priority itself must specifically be withdrawn for that application before the subsequent application is filed<sup>15</sup>. If such withdrawal is correctly effected, the subsequently-filed application can be considered to be the “first” application, and the 12 month priority period begins to run once more from the date of filing of the subsequent application<sup>16</sup>.

2.5.4 This can create difficulties in a number of ways, and detailed examples are beyond

<sup>15</sup> [See UKIPO notice](#)

<sup>16</sup> [See Haberman v Comptroller-General \[2004\] RPC 21](#)

the intended scope of this publication. However, an important point to note is that the mere fact that a previous application has been withdrawn does not necessarily save a subsequent priority claim. This is particularly pertinent where the application whose priority is claimed is a US Continuation or Continuation-in-part application. Thus, a sole priority claim to such an application in respect of subject-matter that was disclosed for the first time in a “parent” application, the parent having been previously withdrawn, may still fail. This is because a right from the parent has been left “outstanding” by the very fact that the application whose priority is claimed derives from the parent.

2.5.5 Great care should therefore be taken to ensure that all claims to priority are made within 12 months of the filing of the first application and that priority is claimed from all relevant applications.

## 2.6 The same applicant or successor in title

2.6.1 According to the Paris Convention<sup>17</sup>, the right of priority arises in respect of the “person” who has duly filed the earlier application, or his “successor in title”. Recent TBA and UK High Court decisions have taken a restrictive interpretation of the meaning of this language of the Convention with important practical consequences for filing, particularly in the case of filings in the names of joint applicants.

2.6.2 In [T788/05](#) two co-applicants (“A” & “B”) had filed a first patent application for the relevant invention. Applicant A subsequently filed, as a sole applicant, a European patent application covering the same invention and claimed the priority of the earlier application. The Board held that the priority claim was invalid, and concluded that (emphasis added):

<sup>17</sup> [Article 4A\(1\) PC](#). Note that very similar language is used in [Article 87\(1\) EPC](#), and [Section 5](#) of the Patents Act 1977 is in accordance with the [Paris Convention](#).

*“...this means that the priority right belongs simultaneously and jointly to the two applicants, who thus constitute a legal unity unless one of them decides to transfer his right to the other applicant, who then becomes his successor in title and this before the filing of the later application. Since no evidence for such a transfer was submitted to the Board, D1, independently of the question of the same invention, could only serve as a basis for claiming a priority right for the filing of a later application designating both applicants.”*

2.6.3 In other words, in the case at issue, in order to effect a valid claim to priority, the priority right should have been transferred from A & B (as the unified assignor) to A only (as the sole assignee) prior to the filing of the subsequent European patent application in the name of A only. In this respect, A & B represent, as a legal unity, the “person” and A represents the “successor in title” within the meaning of the Convention. Alternatively, the subsequent European patent application should have been filed in the name of A & B and an assignment of the application subsequently executed from A & B in favor of A only.

2.6.4 The general principle of joint applicants forming a “legal unity” in this way was recently endorsed in the UK High Court<sup>18</sup>. Here, a US application had been filed in the joint names of individuals “A”, “B” & “C” and the subsequent PCT application had been filed in the name of company “X”. At the time of filing the earlier US application, only person A had been employed by X. The interest in the invention belonging to persons B & C had only been assigned to X after the PCT application had been filed.

2.6.5 In this case it was held firstly that the interests from all Applicants for the earlier US case should have been acquired by company X before the PCT was filed. Retroactive assignments of priority rights will therefore fail. Secondly, and in consequence, since

company X had not acquired the right of priority from B & C prior to the PCT filing, then company X was not properly the “successor in title” of the unified legal “person” consisting of A, B & C who had filed the earlier US case. The priority claim was therefore found invalid.

2.6.6 On a practical level, great care should consequently be taken in ensuring that the “person” filing a subsequent application and desiring to enjoy a valid right of priority from an earlier application should properly acquire that right before filing the subsequent application. The most obvious difficulties arise, as in the case above, as a consequence of the constitutional right of US inventors to file US applications (which often serve as first filings for subsequent European cases) in their own names, and where the subsequent filing is made in the name of the relevant company. For instance, where at least one of the original inventors was not employed by the company (e.g. an outside consultant) or his rights in the invention do not (or cannot subsequently be proven to) automatically vest with the company via operation of a legal instrument (e.g. employment or consultancy contract). In such cases, assignments should be executed (preferably signed by all parties) prior to the subsequent filing.

### 3. Procedural Requirements

#### 3.1 Formalities

3.1.1 Most national offices, including the EPO and the UKIPO require that the applicant complies with certain formalities to ensure that the validity of the priority claim is established. Thus, where the number of the application whose priority is claimed was not known at the time that the declaration of priority was made, this number must be subsequently provided. A certified copy of the earlier application must also be provided within certain time limits. Recent changes to the EPC and UK domestic legislation leave the request for a certified translation (where necessary) of the earlier application up to the discretion of the office. Usually, a translation

<sup>18</sup> [Edwards Lifesciences AG and Cook Biotech Inc. \[2009\] EW/HC 1304](#) at para 82

will not be requested unless the examiner has good reason to investigate the content of the earlier application.

3.1.2 A certified copy of the priority document is requested in the international phase of the PCT. However, if the certified copy is not provided, designated Offices cannot disregard the priority claim without giving the applicant an opportunity to provide the copy directly to that office within a reasonable time limit<sup>19</sup>.

### 3.2 Claiming priority from US provisional applications

3.2.1 Claiming priority from US provisional applications is a practice so routine and widespread that rarely, if ever, is consideration given to whether it is legally legitimate.

3.2.2 The Paris Convention and the EPC both provide<sup>20</sup> that a right of priority arises in respect of any person who has duly filed “...an application for a patent...”. A US provisional application, however, cannot itself mature into a granted US patent and therefore, *prima facie*, might not be seen to be “an application for a patent” within the meaning of the relevant priority provisions.

3.2.3 Shortly after the introduction of the provisions relating to US provisional applications, the EPO issued a legal advice document<sup>21</sup> which stated that the EPO would recognise a US provisional application as giving rise to a right of priority for a subsequently-filed European patent application. However, this advice was issued with the caveat that the independent decision making competence of the EPO Boards of Appeal and the Courts of the contracting states was acknowledged. Notably, the Boards of Appeal are, strictly speaking, not bound by these instructions and are

<sup>19</sup> [Rule 17.1\(c\) PCT](#)

<sup>20</sup> [Article 4A\(1\) PC](#), [Article 87\(1\) EPC](#)

<sup>21</sup> Notice from the President of the European Patent Office dated 26 January 1996 ([OJEP 1996](#), 81)

mandated only to comply with the provisions of the EPC<sup>22</sup>.

3.2.4 To the best of our knowledge, the legitimacy of the legal advice given by the EPO has neither been challenged before a Technical Board of Appeal nor pleaded before a UK court.

3.2.5 Subsequently, US patent law was altered via the American Inventor’s Protection Act (1999) to allow for the conversion of a US provisional application to a US utility application. This is seen by some as a remedy to the potential problem outlined above. Nevertheless, it remains the case that a provisional application cannot of itself give rise directly to a granted patent.

3.2.6 Consequently, in US first filing cases where the right of priority is subsequently to be critically relied upon, prudence would favour that the first filing should be in respect of a utility application rather than a provisional.

### 3.3 Restoration of the 12 month priority deadline & late declaration

3.3.1 Recent changes to the EPC and UK domestic Statute now provide, in certain circumstances, for a subsequent application for the same invention to be filed outside of the usual 12 month priority period and for the applicant still to retain the benefit of the earlier application in terms of a valid right to priority. In addition, it is also now possible to file a late declaration of priority, after the 12 month period, where a subsequent application was filed within this period<sup>23</sup>.

3.3.2 Where an applicant misses the 12 month deadline for filing a subsequent application claiming the priority of an earlier filing, a subsequent application can nevertheless be filed, within a specified time

<sup>22</sup> [Article 23\(3\) EPC](#)

<sup>23</sup> See our previous publications:

[http://www.hlbbslaw.com/uploads/files/pagestop\\_20061124180912.pdf](http://www.hlbbslaw.com/uploads/files/pagestop_20061124180912.pdf)

[http://www.hlbbslaw.com/docs/pagestop/pagestop\\_20060818135743.pdf](http://www.hlbbslaw.com/docs/pagestop/pagestop_20060818135743.pdf)

limit, together with a request for restoration of the 12 month deadline. Importantly, however, the standard against which an application for priority restoration is judged is applied differently throughout the various granting offices of Europe.

3.3.3 The European Patent Office applies an “all due care” standard. This is the same standard which applies to the restoration of lapsed European patent applications. As such, the case law which has been developed over many years in relation to restoration of lapsed applications is directly relevant and is applied in cases of missed priority deadlines. The applicant is required to show that the deadline was missed notwithstanding that all due care had been taken to meet the deadline.

3.3.4 In contrast, the UK Intellectual Property Office (UKIPO) applies an “unintentional” standard. Although on the face of it such a standard is less onerous, care should nevertheless be exercised in requesting restoration of the priority deadline before national offices, particularly the UKIPO.

3.3.5 A number of cases have been reported involving applications for priority restoration made directly to the UKIPO<sup>24</sup>. In short, such a request will fail if the applicant had intended to file either a PCT application designating GB or EP(UK), or a direct European patent application designating UK, but where the applicant had missed the deadline for filing the PCT/EP and instead filed an application for a British patent late (together with an application for priority restoration) directly with the UKIPO. Such an application fails since the direct filing with the UKIPO had never been the true intention of the applicant. Thus, where the true intention of the applicant had been to file a PCT (GB/EP(UK)), the applicant should file the late application and the request for priority restoration with WIPO under the PCT rules<sup>25</sup>. The application for

priority restoration will then be considered by the UKIPO in due course. Alternatively<sup>26</sup>, the applicant can (subject to certain time constraints) file a PCT application late, request UK national phase entry and file the request for priority restoration directly with the UKIPO.

3.3.6 Whilst, as described, it is now possible to file an application outside of the traditional 12 month Paris Convention period and have the priority deadline restored, or file a declaration of priority late, the question of ownership of the right of priority is an issue which should be considered in such situations.

3.3.7 Thus, the person filing the late application and making the request for priority restoration, or making a late declaration of priority after the normal 12 month period, should be the owner of the right to claim priority (as explained at section 2.6). In other words, he should be the same person (or the successor in title) as applied for the earlier application whose priority is claimed.

3.3.8 Importantly, however, and in the absence of case law to the contrary, the right to claim priority should have been owned by the subsequent applicant at the latest by the expiry of the period of 12 months from the date of filing of the earlier application, notwithstanding that the priority declaration is made after this deadline by way of restoration or late request. An assignment of the right of priority after the 12 month period to a third party, followed by subsequent late filing of the application and request for restoration of the priority deadline by the assignee, may not be sufficient to establish the validity of the late priority claim.

<sup>24</sup> [Sirna Therapeutics' Application \[2006\] RPC 351; Abaco Machines \(Australasia\) Pty Ltd's Application \[2007\] Bus. L. R. 897 Ch. Div. Pat. Ct.](#)

<sup>25</sup> [Rule 49ter.2 PCT](#)

<sup>26</sup> [See our previous publication](#)

#### 4. Practice points

Whilst not intended to be an exhaustive check list, applicants may wish to consider the following general points during the course of drafting applications which are intended to act as first filings, when claiming priority from such applications, and when drafting and filing subsequent applications.

1. Wherever possible, ensure minimal structural differences exist between the first and subsequent applications. Ideally, the “complete case” should be included in the first filing, including literal basis for any amendments which may need to be relied on during prosecution of subsequent applications. This helps to maintain identity of subject-matter between applications such that they both relate to the “same invention” in disclosure terms.
2. Similar to the above, technical information relating to the earlier application(s) should be provided in full, such that the invention can be implemented without undue burden and can be seen to be supported across the full scope intended to be claimed in any subsequent application. All relevant biological material should be deposited prior to the filing of the first application, and all relevant deposit formalities complied with.
3. Any subsequent application (e.g. PCT) should be filed within 12 months of the filing of the first application describing the relevant subject-matter.
4. Where a first filing is to be withdrawn in order to regenerate the priority date, the first application should be withdrawn at least the day before filing the subsequent application. Withdrawal of the first application must also be accompanied by a statement withdrawing all outstanding rights, or a specific statement withdrawing the right to claim priority.

5. The right to claim priority from any and all earlier applications must be owned by the applicant of the subsequent priority-claiming application prior to filing the subsequent application. All necessary assignments should therefore be executed before the subsequent case is filed.

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