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Case Number: G 3/93

O P I N I O N
of 16 August 1994

Headword:
Priority interval

Relevant legal norms:
EPC Art. 54(2), 87 to 89

Keyword:
"Priority - document published during the priority interval"
"State of the art - document published during the priority interval"
"Invalid priority - different invention"
"Obiter dictum - admissibility of the referral"

Headnote/Catchword:

I. A document published during the priority interval, the technical contents of which correspond to that of the priority document, constitutes prior art citable under Article 54(2) EPC against a European patent application claiming that priority, to the extent such priority is not validly claimed.

II. This also applies if a claim to priority is invalid due to the fact that the priority document and the subsequent European application do not concern the same invention because the European application claims subject-matter not disclosed in the priority document.



Case Number: G 0003/93

O P I N I O N
of the Enlarged Board of Appeal
of 16 August 1994

on points of law referred by
the President of the European Patent Office
by virtue of Article 112(1)(b) EPC

Composition of the Board:

Chairman: P. Gori
Members: J. Brinkhof
F. Antony
W. Moser
C. Payraudeau
R. Schulte
P. van den Berg

Summary of the Procedure

I. On 23 April 1993, the President of the EPO, making use of his power under Article 112(1)(b) EPC, referred the following question to the Enlarged Board of Appeal:¹

"Does a document published during the priority interval and whose technical contents correspond to that of the priority document constitute prior art citable under Article 54(2) against a European patent application where the claim to priority is not valid because said application comprises subject-matter not disclosed in the priority document?"

II. In the reasons for his referral, the President referred in particular to conflicting decisions on the above point of law given by Board of Appeal 3.3.2 in case T 301/87 (OJ EPO 1990, 335) on the one hand, and by Board of Appeal 3.4.1 in case T 441/91 (OJ EPO 1993, Special edition, 45), on the other. In the President's view, this divergence has given rise to considerable legal uncertainty.

III. Decision T 301/87 concerned an applicant claiming multiple priorities for various elements of its European patent. In respect of these elements, Board of Appeal 3.3.2 held that the various elements in the patent could only derive priority from documents disclosing the very

¹ The original version of this question reads as follows:

"Kann einer europäischen Patentanmeldung eine Veröffentlichung im Prioritätsintervall, deren technischer Inhalt mit dem des Prioritätsdokuments übereinstimmt, als Stand der Technik gemäß Artikel 54 (2) entgegengehalten werden, wenn die Inanspruchnahme der Priorität nicht wirksam ist, weil die europäische Anmeldung Gegenstände umfaßt, die nicht in der Erstanmeldung offenbart waren?"

same elements. In that case, the consequence was that two claims were found not to be entitled to the priority of the first priority document because the content of the said claims had not been disclosed in that priority document. The said two claims could only derive priority from the second priority document which had disclosed the content of the claims for the first time.

The Board of Appeal further held that the publication of the content of the first priority document in the interval between the filing of the first priority document and the filing of the (final) European patent application could not be used as state of the art against any claim in the latter application, including the said two claims which were not entitled to the priority of the first priority document. The Board of Appeal based its decision on Article 4B of the Convention for the Protection of Industrial Property - the Paris Convention. According to this provision "any subsequent filing" during the priority year "shall not be invalidated" by, *inter alia*, the publication of the invention as covered by the first filing in the priority interval. The Board of Appeal stated: "This means, particularly, that such a publication will neither destroy the novelty of the invention, for which priority is claimed in the subsequent filing, nor diminish the inventive step embodied in it, **as considered at the date of the first application on which the right of priority is based.**"

- IV. In its Decision T 441/91, Board of Appeal 3.4.1 decided that Claim 1 of the patent under consideration could not derive priority from a certain priority document because an essential feature of the claim had not been disclosed therein in such a way that the invention defined in Claim 1 could be regarded as the same invention as that disclosed in the priority document. On this basis, the

Board of Appeal concluded that another document the technical content of which was identical to the priority document and which had been published in the interval between the date of the priority document and the date of filing the European application, formed part of the state of the art in respect of the European application.

- V. In the reasons for his referral, the President noted, on the one hand, that it frequently occurs that in subsequent filings new elements and information are added in respect of prior applications of the same applicant and, on the other hand, that inventors are often eager to publish the results of their research as soon as possible. According to Decision T 301/87, the publication of the invention after the filing of the first application does not endanger the protection eventually obtainable for added subject-matter included in a later European application filed by the same applicant. However, according to Decision T 441/91, the publication of the content of the first filing might be harmful in respect of a subsequent filing containing added subject-matter vis-à-vis the first filing.

The President also noted that the practice of allowing claims to priority in the Contracting States might deviate from the approach to the determination of the right to priority adopted in Decision T 301/87. This could lead to the revocation of many European patents by the national courts in the Contracting States.

Opinion

1. The point of law referred to the Enlarged Board of Appeal by the President of the EPO relates to the application of Articles 87 to 89 EPC concerning priority.
2. The referral is admissible, although the decisions cited by the President conflict only insofar as one decision contains an "**obiter dictum**" (see T 301/87, OJ EPO 1990, 335, point 7.4). It is in fact the function of the Enlarged Board of Appeal to ensure uniform application of the law. Even an "**obiter dictum**" may give rise to legal uncertainty.
3. It may be helpful to give an example in order to illustrate the different consequences of Decisions T 301/87 and Decision T 441/91.

Example

The following facts are assumed:

- On 1 January 1990, an applicant files an application P1 containing the elements A + B;
- On 1 February 1990, a document D is published containing the elements A + B;
- On 1 March 1990, the same applicant files an application P2 containing the elements A + B + C;
- On 1 June 1990, the same applicant files a European patent application with Claim 1 containing the elements A + B, and Claim 2 containing the elements A + B + C; priority is claimed from P1 and P2;

- Claim 1 contains the same invention as disclosed in P1; Claim 2 contains the same invention as disclosed in P2; the invention disclosed in P1 is not the same as the one disclosed in P2 (although there is unity of invention within the meaning of Article 82 EPC).

01.01.90	01.02.90	01.03.90	01.06.90
P1 A + B	Publication D A + B	P2 A + B + C	European Application Claim 1: A + B Claim 2: A + B + C
not the same invention			

Does document D form part of the state of the art in respect of Claim 2?

According to Decision T 301/87 the answer must be no, although Claim 2 cannot derive priority from application P1; according to Decision T 441/91 the answer must be yes, because Claim 2 cannot derive priority from application P1. This means that, according to Decision T 301/87, document D is not citable against Claim 2, whereas, according to Decision T 441/91, document D is citable against Claim 2.

4. Articles 87 to 89 EPC provide a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application (cf. Decision J 15/80, OJ EPO 1981, 213).

The Paris Convention also contains rules of law concerning priority. The Paris Convention is not formally binding upon the EPO. However, since the EPC - according to its Preamble - constitutes a special agreement within the meaning of Article 19 of the Paris

Convention, the EPC is clearly intended not to contravene the basic principles concerning priority laid down in the Paris Convention (cf. Decision T 301/87, OJ EPO 1990, 335, Reasons point 7.5).

5. Article 87(1) EPC lays down who shall enjoy a right of priority for the purpose of filing a European patent application namely: "a person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent . . . , or his successors in title". Furthermore, the provision contains two requirements which are to be met. The European application must concern "the same invention", and must be filed within a period of twelve months from the date of filing of the first application.

The corresponding Article 4, Section A(1), Paris Convention, makes no mention of the subject-matter of the subsequent application. It is generally held that the subsequent filing must concern the same subject-matter as the first filing on which the right of priority is based [cf. R. Wieczorek, Die Unionspriorität im Patentrecht, Köln, Berlin, Bonn, München 1975, p. 149; G.H.C. Bodenhausen, Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967, Geneva 1968, at Article 4, Section A(1), sub (i)].

6. Article 88 EPC is mainly concerned with the procedural and formal aspects of claiming priority. Substantive aspects are dealt with in conformity with the basic principles laid down in Article 87(1) EPC. Article 88(1) corresponds to Article 4 section D, Paris Convention, Article 88(2) and (3) EPC to Article 4 section F, Paris Convention, and Article 88(4) to Article 4 section H, Paris Convention.

7. With regard to the effect of a right of priority, Article 89 EPC provides: "The right of priority shall have the effect that the date of priority shall count as the date of filing of the European patent application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2".

Article 4, Section B Paris Convention, corresponds to Article 89 EPC.

8. Pursuant to Article 87 EPC, the coming into existence of a right of priority depends on the fulfilment of certain requirements, one of these being that the European patent application claiming the right of priority from an earlier application in a State party to the Paris Convention must be "in respect of the same invention" disclosed in the said earlier application. Article 89 deals with the effect of possessing a right to priority on the premise that the conditions precedent to having that right have been satisfied, including the requirement that the inventions be the same. If these preconditions are not met, no right to priority exists, consequently, in such case a claim to priority from a previous application has no effect, either under Article 87 EPC or under the Paris Convention.

9. Where priority is claimed but cannot be allowed because the essential condition precedent, that the inventions are the same, is not met, there is no right to priority. In consequence, any publication of the contents of the priority document in the interval between the filing thereof as a patent application, and the filing of the European application claiming priority therefrom, constitutes prior art citable against elements of the European application which are not entitled to priority.

The United States Court of Appeals for the Federal Circuit decided likewise (In re Gosteli, 10 USPQ 2d 1614 (1989); GRUR Int. 1990, p. 994).

10. As to the example given in point 2, it follows from the above that document D forms part of the state of the art in respect of Claim 2 and is citable against Claim 2.

Conclusion

For these reasons

the question of law referred to the Enlarged Board by the President of the EPO is to be answered as follows:

1. A document published during the priority interval, the technical contents of which correspond to that of the priority document, constitutes prior art citable under Article 54(2) EPC against a European patent application claiming that priority, to the extent such priority is not validly claimed.
2. This also applies if a claim to priority is invalid due to the fact that the priority document, and the subsequent European application, do not concern the same invention because the European application claims subject-matter not disclosed in the priority document.

The Registrar:


J. Rückerl

The Chairman:


P. Gori