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**Datasheet for the decision
of 16 January 2020**

Case Number: T 0844/18 - 3.3.08

Application Number: 13818570.7

Publication Number: 2771468

IPC: C12N15/63

Language of the proceedings: EN

Title of invention:

Engineering of systems, methods and optimized guide compositions for sequence manipulation

Patent Proprietors:

The Broad Institute, Inc.
Massachusetts Institute of Technology
President and Fellows of Harvard College

Opponents:

Schlich, George
Grund, Dr., Martin
Regimbeau
CRISPR Therapeutics AG
Storz, Dr. Ulrich
Novozymes A/S
Boxall Intellectual Property Management Limited
Sagittarius Intellectual Property LLP
Adams, Harvey Vaughan John

Headword:

CRISPR-Cas/BROAD INSTITUTE

Relevant legal provisions:

EPC Art. 54(3), 60(3), 87(1), 87(2), 87(3), 88(1), 90(3),
90(5), 112(1)(a)

EPC R. 52, 53

Paris Convention Art. 4A, 4A(1), 4A(2), 4A(3), 4D, 4D(1),
4D(4), 4F, 4G, 19

Fourth session of 9 November 1880 of International Conference
for protection of intellectual property, page 60 - 62,
(Procès-verbaux des séances de la conférence, quatrième séance
9 novembre 1880)

PCT Art. 8(1), 8(2)(a), 8(2)(b)

Vienna Convention on the Law of Treaties (1986) Art. 31(1),
33(4)

European Convention on Human Rights Art. 1 of Protocol No. 1

The Constitution of the United States Art. VI, clause 2

Notice from the President of the EPO dated 26 January 1996
concerning priority conferring effect of the "US provisional
application for a patent"

Keyword:

Priority - main request (no)

Novelty - main request (no)

Decisions cited:

G 0003/92, G 0001/05, G 0001/15, T 0390/90, T 0015/01,

T 1242/04, T 0005/05, T 0788/05, T 0969/14, T 1201/14,

T 0239/16

Accord Healthcare -v- Research Corporation Technologies [2017]

EWHC 2711 (Ch)

KCI Licensing -v- Smith & Nephew [2010] EWHC 1487 (Pat)

Riendeau -v- Zehnder Group International AG, Swiss Federal

Patent Court, 21 March 2018

Catchword:

- i) The board is empowered to and must assess the validity of a priority right claim as required by Article 87(1) EPC,
- ii) the board's interpretation of the expression "any person" in Article 87(1) EPC confirms the long-established "all applicants" or the "same applicants" approach,
- iii) the national law does not govern who is "any person" as per Article 87(1) EPC, the Paris Convention determines who "any person" is.



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Case Number: T 0844/18 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 16 January 2020

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 March 2018
revoking European patent No. 2771468 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. Stolz

Members:
D. Rogers
R. Winkelhofer
P. Julià
M. Montrone

Summary of Facts and Submissions

I. This appeal concerns European patent 2 771 468 having the title "ENGINEERING OF SYSTEMS, METHODS AND OPTIMIZED GUIDE COMPOSITIONS FOR SEQUENCE MANIPULATION" that is based upon European patent application No. 13 818 570.7 and the PCT application, PCT/US2013/074819 filed on 12 December 2013 ("PCT '819"). European patent 2 771 468 and PCT '819 claim priority from twelve US provisional patent applications (referred to as P1 to P12 in the decision of the opposition division).

II. In the present decision, for ease of reading, the phrase "Priority Application" will be used to refer to the plurality of US provisional patent applications (P1, P2, P5 and P11) from which priority is claimed and which were relevant for the opposition division's decision. The phrase "Subsequent Application" will be used to refer to European patent application No 13 818 570.7 and PCT '819. More generally, "priority application" will be used to refer to a patent application from which priority is claimed in a "subsequent application".

III. The document numbering system used in this decision follows that used in the consolidated list of documents, submitted by the appellants (the proprietors of the European patent 2 771 468) on 17 May 2019.

IV. The Paris Convention for the Protection of Industrial Property will be referred to as the "Paris Convention" and the Vienna Convention on the Law of Treaties will be referred to as the "Vienna Convention".

V. The learned monographs on the Paris Convention will be referred to as follows:

"Paris Convention for the Protection of Industrial Property as revised at Stockholm in 1967" by G.H.C. Bodenhausen - document D288, ("Bodenhausen"); "Patents, Trademarks and Related Rights, National and International Protection", by S.P. Ladas, ("Ladas"); "Die Unionspriorität im Patentrecht - Grundfragen des Artikels 4 der Pariser Verbandsübereinkunft", by R. Wieczorek - document D145, ("Wieczorek").

VI. The appellants (the patent proprietors) filed an appeal against the decision of the opposition division revoking the patent.

VII. The opposition division found that priority had not been validly claimed from certain US provisional applications (P1, P2, P5 and P11). As a consequence, the European patent was found not to be novel over the disclosure of documents D3 and D4 and was revoked.

VIII. In order to reach this finding the opposition division applied the established case law of the EPO and the Boards of Appeal as regards assessment of priority claims, the so-called "all applicants" approach (i.e. matching of all applicant names; also called "same applicant" approach). This approach requires that all of the persons listed as applicants for the priority application are also listed as applicants for the subsequent application, allowance being made for successors in title. In this particular case the applicants for the Subsequent Application were not the same as those for the Priority Application, one applicant was missing from the Subsequent Application and no question of successor in title arose.

IX. The core issue to be decided in this case can be stated in the following form:

"A and B are applicants for the priority application. A alone is the applicant for the subsequent application. Is a priority claim valid even without any assignment of priority right from B to A?"

The appellants say that the answer is "yes" and the respondents that the answer is "no".

X. The appellants have set out their arguments in their Grounds of Appeal in the form of three questions that need to be answered. These are:

- 1) Should entitlement to priority be assessed by the EPO?
- 2) How is the expression "any person" in Article 87(1) EPC to be interpreted?
- 3) Does national law (in this case US law) govern the determination of "any person" who has "duly filed" in Article 87(1) EPC?

XI. The parties have structured their written and oral submissions around this scheme of questions. These questions overlap to a certain extent which has led to a degree of overlap in the parties' submissions. Nevertheless, the Board finds this a useful structure to follow. The Board also finds that by following this structure it becomes easier to understand the decision if the arguments of the parties are placed together with the reasons for the decision, rather than the traditional separation of the parties' submissions and the reasons for the decision.

XII. The parties to this case have made extensive submissions running to several thousand pages. In order to aid the readability and to maintain the brevity of this decision,

only the arguments of the appellants will be summarised in the "Reasons" section of this decision. Six respondent-opponents have actively participated in this appeal. The Board will discuss, without precise attribution, the arguments of the respondents in the "Reasons" section of this decision.

XIII. The parties' full requests were annexed to the minutes of the oral proceedings. The requests that are relevant for this decision are as follows:

XIV. The appellants requested that:

1. The decision of the Opposition Division dated 26 March 2018 be set aside.
2. ...
3. Entitlement to priority of the Patent to P1, P2, P5 and P11 is acknowledged as validly claimed.
4. Questions are referred to the Enlarged Board of Appeal if the Board is minded not to decide that entitlement to priority of the Patent to P1, P2, P5 and P11 was validly claimed, as set out at pages 70-72 of the grounds of appeal;
- 5....
6. The case is remitted to the Opposition Division for further prosecution if the Board decides that entitlement to priority of the Patent to P1, P2, P5 and P11 was validly claimed;
7. ...
8. In case the Board decides not to remit the case to the Opposition Division, to reject the oppositions and maintain the Patent as granted or, alternatively, in the form of any of Auxiliary Requests 1-64.

XV. The respondents requested that the appeal be dismissed. Further the respondents requested that the Board confirm the opposition division's decision not to admit Auxiliary

Requests 1-64 and, if the Board were to overturn the opposition division's decision on the right to priority, that various questions be referred to the Enlarged Board of Appeal.

Reasons for the Decision

Admission/consideration of documents

1. On the first day of oral proceedings the Board admitted into the proceedings all documents D1 to D315 that were concerned with the issue of priority. None of the parties objected to this procedural decision. No further issues regarding document admissibility arose during the course of the four day oral hearings in this case.

Question 1: Should entitlement to priority be assessed by the EPO?

2. The statement of grounds of appeal, ("Grounds of Appeal") on pages 19 to 29, in the section, "2. Argument I: Entitlement to priority should not be assessed by the EPO", deals with this question. Under this head the appellants also made arguments concerning the meaning of "any person" and public policy considerations that are better dealt with when question 2 is considered.
3. The appellants argue that entitlement to priority is a property right and that the EPO should no longer assess entitlement to priority, but instead leave any challenge to be decided in entitlement actions before national courts, as for any other property right. The appellants consider that the current "same applicant" approach results in issues of title raised by non-owners of the property right being used to destroy the underlying property itself, something unheard of in the law of

property and not intended by the Paris Convention. Article 60(3) EPC provides that the EPO does not adjudicate on the ownership of a patent, but rather leaves this to national tribunals, as acknowledged by the Enlarged Board of Appeal in the decision G 3/92 (OJ 1994, 607, point 3 *et seq.*). The appellants consider that this principle should apply equally to entitlement to priority, meaning that the EPO has no jurisdiction or competence to determine whether or not an applicant is entitled to claim the priority right. The appellants consider that there is no need for the EPO to assess entitlement to priority, given that Article 88 EPC and Rules 52 and 53 EPC already provide the required "connection" between the applicants of the priority application and the applicants claiming priority. This is because the details of a priority application are not publicly available before a subsequent application is filed (see point 77, Grounds of Appeal). In addition the appellants argue that legal certainty for third parties is upheld through the "same invention" requirement, a requirement that should always be assessed by the EPO and which allows the invalidation of a priority right on technical grounds, grounds for which the EPO has the necessary expertise.

4. The appellants' arguments on this question start with the classification of entitlement to priority as an item of property. The appellants note that the EPC leaves the assessment of entitlement to property rights in patents and applications to national courts, for example under Article 60(3) EPC and the associated Implementing Regulations. It is hence for national courts to decide who is the owner of an application or a patent, as established also by the Enlarged Board of Appeal in the decision G 3/92 (*supra*). From this the appellants argue that the EPO should not assess the title to the priority right, this being one of the property rights associated with a

patent application (see paragraphs 68, 74 and 99, Grounds of Appeal). If the appellants' approach were followed, it would have the consequence that the priority right could only be challenged by someone claiming to be the rightful owner, rather than being raised by an opponent; a question of ownership could not be used to destroy the property itself. This approach is in line with the approach taken by the national courts of EPC member states. An issue of title should not affect the patent's continued existence and the ability of someone to assert it (see paragraph 73, Grounds of Appeal).

5. The appellants further argue that the provisions of the EPC, Articles 87(1) and 88 and Rules 52 and 53 EPC, support such an approach. Article 88 EPC and Rules 52 and 53 EPC provide an exhaustive list of what an applicant for a European patent must do in order to claim priority. These provisions do not require proof of the patent applicant's right to claim priority and do not include an assessment of the ownership of the priority right (see paragraphs 82 and 92, Grounds of Appeal).

6. According to the appellants, a key element of the system of claiming priority is that there is a "connection" between the applicant for the priority application and the applicant claiming priority for the subsequent application. This connection is assured by complying with Article 88 EPC and with the formal requirements of Rules 52 and 53 EPC, since only the applicants for the priority application have knowledge of the priority application and can provide the information required by these Rules (see paragraphs 77 and 88, Grounds of Appeal). Deficiencies in any of these formal requirements result in a loss of the priority right (Article 90(3),(5) EPC). Articles 87(1) and 88(1) EPC do not require the EPO to assess who enjoys the right of priority (see paragraphs 81 and 82, Grounds of

Appeal). The requirements of Article 87(1) EPC are fulfilled by the technical assessment of the "same invention". It is this technical assessment of the "same invention" that third parties require for legal certainty (see paragraph 93, Grounds of Appeal). Third parties know that someone has claimed the right of priority based on the disclosure in the earlier application, but who claimed it, and whether the applicant indeed holds that right or is entitled to it, does not impact their legal certainty (see paragraph 94, Grounds of Appeal).

7. The appellants argue that the EPO must only ensure that the formal requirements of Rules 52 and 53 EPC are fulfilled, and that it is not to introduce an additional formal requirement, namely the "identity of applicants" or the "same applicants", that requires the assessment of title to the priority right (see paragraphs 74, 78 and 81, Grounds of Appeal). Indeed such an assessment lacks all utility as the assessment of the "same applicants" cannot ensure that the applicant for the subsequent application holds the right to claim priority of the earlier application (see paragraphs 71, 72 and 87, Grounds of Appeal). The appellants also note that there is no reasoning or justification given for introducing this assessment in any of the decisions of the Boards of Appeal and in the legal commentaries, beyond the brief explanation given in decision T 0788/05 of 8 May 2007 (see paragraph 84, Grounds of Appeal). Nor is such a justification derivable from the EPC *Travaux Préparatoires* concerning the assessment of the right to claim priority; the "same applicants" approach was not contemplated by the EPC legislator (see paragraphs 102 and 103, Grounds of Appeal).
8. The appellants point to the difficulties of the "same applicants" approach for assessing priority entitlement of

an Article 54(3) EPC document because the documents necessary to assess entitlement are only available if the document belongs to one of the applicants, but not if it belongs to a third party (see paragraph 97, Grounds of Appeal). The appellants also point to an inconsistency in the EPO's approach to Article 87(1) EPC when it is a matter of the original applicant for the priority application being the applicant for the subsequent application compared to when it is a matter of the successor in title to this original applicant being the applicant for the subsequent application. In the first case the EPO carries out a "prima facie" matching of names exercise, and in the second case a substantial legal assessment (see paragraph 100, Grounds of Appeal). Policy considerations and applying Article 60(3) EPC by analogy, the bar on the EPO considering property rights should prevent the EPO from carrying out a substantial legal assessment in the second case.

9. The appellants also refer to the non-binding preliminary opinion of Technical Board of Appeal 3.3.01 in case T 0239/16 (document D207). In this preliminary opinion, board 3.3.01 raised the issue of whether the EPO has the competence or jurisdiction to examine who is entitled to the right of priority. The appellants consider that if board 3.3.01 had not seriously considered the notion that the EPO had no competence, it would not have raised this issue in its communication (see paragraph 105, Grounds of Appeal).
10. The appellants are thus arguing that the EPO should not consider the underlined words, "Any person who has duly filed ... an application for a patent ... shall enjoy, for the purpose of filing a European patent application ... a right of priority ...", in Article 87(1) EPC, as being a requirement whose meaning is to be examined by the EPO.

Text of Article 87(1) EPC and the Board's answer to the first question

11. It is helpful to consider the text of Article 87(1) to
(3) EPC:

"Article 87 Priority right

(1)

Any person who has duly filed, in or for

(a)

any State party to the Paris Convention for the
Protection of Industrial Property or

(b)

any Member of the World Trade Organization,

an application for a patent, a utility model or a
utility certificate, or his successor in title,
shall enjoy, for the purpose of filing a European
patent application in respect of the same
invention, a right of priority during a period of
twelve months from the date of filing of the first
application.

(2)

Every filing that is equivalent to a regular
national filing under the national law of the State
where it was made or under bilateral or
multilateral agreements, including this Convention,
shall be recognised as giving rise to a right of
priority.

(3)

A regular national filing shall mean any filing
that is sufficient to establish the date on which
the application was filed, whatever the outcome of
the application may be."

This wording, other than necessary contextual changes, is identical to the wording found in Article 4A of the Paris Convention.

12. Article 87(1) EPC sets out four requirements which can usefully be set out as questions:

- 1) Who?
- 2) Where?
- 3) What?
- 4) When?

Article 87(2) and (3) EPC provide further details regarding "what".

The "where", "what" and "when" questions are not a matter of contention between the parties.

13. The position of the appellants is that the EPO should not concern itself with the "who" issue when applying Article 87(1) EPC, they are content with the EPO assessing the "where", "what" and "when" issues.

14. The Board disagrees with the appellants' position. The EPC clearly sets out a requirement that the EPO examines the "who" issue of priority entitlement.

15. Article 87(1) EPC does not require that the "any person" who has filed the patent application is actually legally entitled to do so, merely that they have done so. Thus, as regards the "any person" of Article 87(1) EPC, the EPO does not carry out any substantial assessment of the legal entitlement to property rights, it does not go beyond a formal assessment of the person ("any person") who has performed the act of filing the patent application. In addition, whilst the wording of Article 60(3) EPC states that an "applicant shall be deemed to be entitled to

exercise the right to a European patent", there is no corresponding provision in the EPC referring to exercising a right of priority. The absence of a provision in the EPC does not mean that there is a gap in the law that necessarily requires to be filled by analogy from another provision of the EPC. The Board thus cannot follow the appellants' argument based on reasoning by analogy with Article 60(3) EPC. Whilst the findings of the Enlarged Board of Appeal in decision G 3/92 (*supra*) are pertinent for Article 60(3) EPC, they are not however directly applicable to the issue here under consideration.

16. The appellants have argued (see paragraph 3 above) that the EPO's approach to the interpretation of Article 87 EPC means that issues of title raised by a non-owner can be used to destroy the underlying property right. The appellants are correct in this as well as in their assertion that deficiencies in formal requirements may result in the loss of the priority right (Article 90(5) EPC). The failure to comply with a formal requirement of the EPC can destroy a patent or patent application, irrespective of whether it satisfies the substantive requirements for patentability. The Board notes that the EPC sets out many formal requirements for obtaining a patent, relating to such things as payment of fees, time limits for carrying out certain actions etc. The loss of a patent or a patent application due to failure to fulfil such formalities is a feature of the EPC system. In the present case the appellants chose the named applicants in a way that did not comply with the well-established practice of the EPO. It is not for the Board to repair such errors, omissions or deliberate choices of a party.
17. The appellants' arguments that Article 88 EPC, and Rules 52 and 53 EPC are exhaustive as regards the existence of the priority right, and that the "same invention"

requirement of Article 87(1) EPC is enough to establish a "connection" between the applicant for the priority application and the subsequent application, are also unconvincing.

18. The Board can see no basis in Article 88 EPC and Rules 52 and 53 EPC for disregarding the "any person" requirement of Article 87 EPC, none of these provisions relieve the EPO from the obligation to formally assess who has performed the act of filing the patent application as required by Article 87(1) EPC. The Board notes that the word "connection" is not found in any of these provisions. Thus the EPO is not tasked with finding such a "connection", rather it is to apply Articles 87 and 88 EPC as well as Rules 52 and 53 EPC. Likewise, whilst the Board may agree with the appellants' arguments that there is necessarily a "connection" between the applicants for the priority application and the subsequent application because of the non-public nature during a certain period of time of the priority application, this "connection" is not a basis for disregarding the "any person" requirement of Article 87(1) EPC.

19. Turning now to the appellants' arguments (see point 100 Grounds of Appeal) concerning successors in title: the appellants point out that the EPO's approach in these cases is inconsistent. The inconsistency is that the EPO makes a substantive assessment of a successor in title's right to claim priority, but only a *prima facie* check as regards whether the original applicant (the predecessor to the successor) was entitled to the claimed priority rights. Thus, as regards the successor in title, the EPO carries out an assessment of property rights, which, applying Article 60(3) EPC by analogy, the EPO should not do. This "inconsistency" argument is merely a supporting argument for the appellants' view that a substantive legal

assessment of the right to a priority claim should not be carried out.

20. The EPO only assesses, and for this it is the practice of the EPO to require evidence, that a successor in title is in fact the successor in title of the original applicant; an assessment which indeed involves a substantial legal assessment but not an assessment of legal entitlement to a priority right.

21. However, the issue of successorship in title is not an issue in this case and therefore the appellants' arguments on this point are irrelevant for deciding this case.

22. The same approach to the assessment of a right to claim priority is carried out by the EPO as regards a document relevant under Article 54(3) EPC. The EPO does not perform a substantial assessment of the legal entitlement to claim priority, but only a formal assessment of who has performed the act of filing the patent application.

23. Finally, the appellants have put forward the non-binding preliminary opinion of board 3.3.01 in case T 0239/16 (document D207) as support for the proposition that the EPO does not have competence or jurisdiction to examine who is entitled to the right of priority. The Board notes that document D207 is a preliminary, non-binding opinion and that the part of this document referred to by the appellants did not find its way into the final decision of the Board, which was decided on other issues. The Board does not consider that this document is persuasive on this point.

24. Thus the Board concludes that the instances of the EPO are empowered and obliged to assess the validity of a priority right claim as required by Article 87(1) EPC.

Question 2: How is the expression "any person" in Article 87(1) EPC to be interpreted?

25. The appellants' next argument concerns how the expression "any person" in Article 87(1) EPC is to be interpreted.

26. The appellants argue that "any person" in Article 4 Paris Convention (and Article 87 EPC) must be interpreted to mean that any one who duly filed the priority application (or his/her successor in title) can validly claim priority. That is, if there are multiple applicants for the priority application, one, a plurality of these applicants, or all of them, can validly claim priority. Such an interpretation recognises the ordinary meaning of the word "any" as well as the Paris Convention's object and purpose. The EPO's requirement that all persons who duly filed the priority application (or all of their successors in title) must also claim priority together sets an additional requirement that contravenes the Paris Convention. The appellants further argue that, even if the EPO ignores the language of Article 87 EPC (as adapted from Article 4 Paris Convention) in its interpretation of "any person" for European ("internal") priority applications, the EPO must comply with Article 4 of the Paris Convention for "foreign" or "external" priority applications that are governed by Article 8(2)(a) PCT. Lastly the appellants argue that even if it is assumed that the applicants for a priority application form a legal unity - which the appellants dispute - each of them individually must be allowed to exercise the right to priority.

27. The appellants do not contest that the practice of the EPO is, and has been, to require identity between the applicants for the priority application and the applicants

for the subsequent application. This is referred to in the parties' pleadings as the "all applicants", "same applicants" or "identity of applicants" approach. The appellants argue for a change of practice to one where, from a plurality of applicants for the priority application, one, some or all of these can be the applicant(s) for the subsequent application.

28. The appellants argue that the ordinary meaning of "any" in "any person" is not "all". If one regards the EPC, the words "jedermann", "celui qui" and "any person" are open and permissive terms and equally open, permissive language is used in the Paris Convention. This was acknowledged by the opposition division for the English and German versions of the Paris Convention, but not for the French. There is however no basis for the opposition division's restrictive interpretation of "celui qui" at paragraph 66.2 of its decision (see paragraphs 113 and 116, Grounds of Appeal).

29. The appellants argue that looking at the use of "any person" in the context of the other provisions of the Paris Convention confirms its permissive meaning. The appellants point out that the permissive "celui qui" and "quiconque" are used in Articles 4A(1) and 4D respectively, and the restrictive "le déposant" and "le demandeur" are used in Articles 4F and 4G respectively. Neither the Paris Convention nor the EPC specify that "all applicants" of the priority application must also be the applicants for the subsequent application in order for priority to be validly claimed (see paragraphs 118 and 119, Grounds of Appeal).

30. In case of ambiguity, Article 31(1) of the Vienna Convention prescribes that the terms of a treaty must be interpreted in the light of their object and purpose.

Article 33(4) prescribes that in case of a difference in the meaning between two or more equally authentic texts, the treaty must be given the meaning which best reconciles the texts having regard to the object and purpose of the treaty (see paragraphs 122 and 144, Grounds of Appeal). The appellants argue that the object and purpose of the Paris Convention are favourable to their interpretation of "any person". The appellants refer to the statement of the purpose of the priority right in decision T 0015/01 (OJ 2006, 153), paragraphs 32 and 34:

"... safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention ...

...

The international priority provisions contained in the Paris Convention ... assist the applicant in obtaining international protection for his invention ..." (see paragraphs 123 and 125, Grounds of Appeal).

31. The appellants argue that the "identity of applicants" practice of the EPO does not facilitate the above purposes. It creates additional obstacles for applicants and leads to the destruction of a patent because of an issue over the ownership of a property right. For the protection of third parties the most important consideration is not "identical applicants" but that the same invention is being claimed in both the priority and subsequent application (see paragraphs 132 to 135, Grounds of Appeal).

32. The appellants also criticise the opposition division's emphasis on procedural or administrative efficiency as one of the aims of the Paris Convention (see paragraphs 124 and 125, Grounds of Appeal). The opposition division used this as an argument in favour of the "all applicants"

approach. The appellants point out that this could lead to the loss of the priority right, and hence possibly of the patent application, in the situation where one of the applicants is holding the others to ransom by refusing to join in as an applicant for the subsequent application (see paragraph 195, Grounds of Appeal). The EPO's "all applicants" approach restricts a right established by an international treaty, the Paris Convention, by imposing additional requirements. This constitutes a violation of Article 1 of Protocol No. 1 to the European Convention on Human Rights (see paragraphs 138 and 195, Grounds of Appeal).

33. The appellants also argue that the case law considered by the opposition division does not provide a sufficient basis for upholding the "all applicants" approach (see paragraph 146 *et seq.*, Grounds of Appeal). This issue was briefly treated in decision T 0788/05, where the "all applicants" approach was adopted almost without reasoning. This decision neither considered the object and purpose of the priority right nor even mentioned the Paris Convention. Subsequent national and EPO case law simply adopted the conclusions of T 0788/05 without further reasoning. Thus the "all applicants" approach has never been examined on its merits. The appellants refer (see paragraph 146 *et seq.*, Grounds of Appeal) to the recent cases of *Accord Healthcare -v- Research Corporation Technologies* [2017] EWHC 2711 (Ch), from the UK, and *Riendeau -v- Zehnder Group International AG*, of the Swiss Federal Patent Court, 21 March 2018 (see documents D268 and D269), as supporting the view that the "all applicants" approach is incorrect. These cases also support the appellants' policy argument that a consequence of the "all applicants" approach is to use disputes over ownership of a property right to destroy the property right itself, such an outcome being contrary to the object and purpose

of the Paris Convention. The appellants pointed out that the EPO case law shows a certain flexibility in the handling of priority rights. The appellants gave the examples of the assignment (successor in title) and non-exhaustion of the priority right (it can be validly claimed for more than one European patent application; see decision T 0015/01, *supra*), and multiple partial priority rights that can be transferred (see decision T 0969/14 of 5 June 2018). If it was possible to unbundle the priority right for different subject-matter, Contracting States, etc. there was no reason for not doing the same with the co-owners of this right. It was irrelevant whether a practice was well-established. If it was wrong, it was always possible to change such a practice as shown by the decision G 1/15 (OJ 2017, 82) concerning the entitlement to partial priority.

34. The appellants also point out that all of the EPO case law that supports the "all applicants" approach was concerned with "internal" priority claims: that is both the priority and subsequent applications were European applications. The present case is one of an "external" priority under Article 8(2)(a) PCT, whereby priority rights are determined by the provisions of the Paris Convention alone. The "all applicants" approach that has arisen in the case of internal priorities under Article 8(2)(b) PCT follows from Article 60(3) EPC, where all applicants of the priority application are deemed to own the whole application. Such considerations do not arise in the case of an external priority under Article 8(2)(a) PCT (see paragraphs 166 to 171, Grounds of Appeal).

35. The opposition division's decision dealt with the issue of the rights of co-owners of an intellectual property right in paragraphs 66.7 to 66.8. The appellants are broadly in agreement with the finding of the opposition

division that each of the co-owners of a right may individually act to exploit the right. The act of filing the priority application results in a priority right owned by all applicants (co-owners), this right may therefore be exercised individually by each of the co-owners (see paragraph 172 *et seq.*, Grounds of Appeal). However, according to the appellants, it was not a consideration of the rights of co-owners, but rather policy considerations, in particular that of avoiding the multiplication of proceedings with identical content (which could lead to multiple patenting), that provided the basis for the opposition division to support the "all applicants" approach (see paragraph 187 *et seq.*, Grounds of Appeal). The appellants argue that this policy consideration is not convincing: the priority mechanism does not, and was not intended, to prevent multiple patenting. In this the appellants follow decision T 0015/01, paragraph 39.

The Board's view on the interpretation of "any person" in Article 4A Paris Convention

36.The Vienna Convention sets out the principles upon which the Paris Convention and the EPC are to be interpreted (see paragraph 110, Grounds of Appeal). The EPC is a special agreement within the meaning of Article 19 Paris Convention, thus application of its provisions cannot contradict the basic principles concerning priority laid down in the Paris Convention (see paragraph 130, Grounds of Appeal). Therefore, in order to interpret "any person" in Article 87(1) EPC, it is necessary to interpret the legal concept of "any person" in Article 4A Paris Convention, the interpretation given in both treaties needing to be the same.

37.This raises certain linguistic issues which must be borne in mind: the authentic text of the Paris Convention is

written in French, the EPC is written in German, English and French, all texts being equally authentic. It should be noted that the parties' submissions in this case have been in English.

38. The general rule of interpretation for international treaties is set out in Article 31(1) Vienna Convention, this states:

A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.

39. The first aspect of interpretation is the ordinary meaning of the term "any person".

40. The respondents have argued that the EPC duplicates the language of the Paris Convention and that both of these treaties are to be interpreted in the same way.

41. The respondents stress that the authentic language of the Paris Convention is French, indeed until the 1958 revision, the Paris Convention was only officially available in French. These are not disputed issues between the parties.

42. The respondents argue that the term "celui qui", which is translated into "any person" in the English version, is restrictive in meaning and requires strict identity of the applicants. If a more permissive meaning had been desired, the drafters of the Paris Convention could have used another term. The Board notes that in Article 4A(1) Paris Convention the term "celui qui" is used, whereas in Article 4D(1) Paris Convention the term "quiconque" is used. Both of these terms are translated as "any person"

in the English version. The Board is of the view that the authentic French text of the Paris Convention tends, if anything, to support the "all applicants" approach, given the use of "celui qui" and then "quiconque". The Board, however, does not find this clearly determinative of the issue.

43. The respondents argue that the context in which this term is used in Article 87 EPC is where one person files and one priority right arises. The respondents have further looked at the contractual background that typically accompanies joint applicants for a patent and have seen this as a basis for the "all applicants" approach.

44. The opposition division appears to have been unable to come to a definite view on the meaning of "any person" in the light of considerations of the ordinary meaning. The Board is of the same view; the ordinary meaning of this term in all the language versions is ambiguous. The Board also finds of little assistance the context in which this term is used in the EPC and the Paris Convention.

45. In the light of the above the Board must turn to the object and purpose of the Paris Convention, and more broadly, public policy considerations, in order to interpret "any person". This is also in line with Articles 31(1) and 33(4) of the Vienna Convention referred to by the appellants.

46. The Board agrees with the statements of the object and purpose of the Paris Convention as set out in paragraphs 32 and 34 of decision T 0015/01, also mentioned by the appellants, that is:

"... safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention ...

...

the international priority provisions contained in the Paris Convention ... assist the applicant in obtaining international protection for his invention ..."

47. To the above objects and purposes the appellants at paragraph 132 of their Grounds of Appeal also add, "...to facilitate the filing of patents around the world."
48. The appellants are arguing that the "all applicants" rule is contrary to the above as it requires an extra formality to be fulfilled by applicants, and makes reference to Article 4D(4) of the Paris Convention. The Board notes that whilst this article prohibits the imposition of further formalities, it only refers, however, to the declaration of priority which corresponds to, and is established in, Rules 52 and 53 EPC. Moreover, the difficulty that the Board has with such an argument is that any formal requirement for patenting, including those for claiming priority, such as Rules 52 and 53 EPC, could be considered contrary to the above object and purpose. The Board notes that patent law abounds with formal requirements. Such a general analysis, as suggested by the appellants, provides no clear guidance as to when a formal requirement can be considered contrary to the object and purpose of the Paris Convention, and when not.
49. The Board also finds that the above objects and purposes actually highlight the question of who is the "applicant" whose interests are being safeguarded or facilitated. A feature of a priority right is that it comes into existence with the filing of one patent application but is exercised by the filing of another patent application,

often in another country. So if A and B file the first patent application together, the appellants' interpretation of "any person" would allow A alone to file and own another patent application in another country claiming the same invention without involving B. This could of course result from an agreement between A and B, it could however equally result from more sinister circumstances, such as A trying to deprive B of its rights to a patent in another country. This second scenario can hardly be thought of as one that the law should seek to protect, and neither safeguards the interests of all of the patent applicants, nor assists the applicants in obtaining international protection. It is also to be borne in mind that an applicant can progress a patent application before the EPO without the active participation of the other applicants, which deals with the appellants "ransom" point, (see paragraph 32 above).

50. In the Board's view, the object and purpose of the Paris Convention cannot form the basis for favouring one or some persons to the detriment of all other persons who originally formed part of the group of persons that filed a patent application. Neither can they form a basis for exempting this person or persons from fulfilling any formal requirements. Indeed, this person or persons are defined by means of the action which they originally carried out, i.e. filing an application. Hence, if a group of persons decides together to carry out this act of filing, then they have decided to act as a unity for this purpose, thus implying that the "any person" is this group as such. As argued by the respondents, it is this action which the Paris Convention seeks to facilitate, namely, using the legal concept of priority, applicants can be treated as if they had simultaneously filed the same patent application in a multiplicity of member states of the Paris Union. In 1883, when the Paris Convention was

originally adopted, (and even today), actually to file the same patent application simultaneously around the world would have presented very considerable, if not insuperable, difficulties. The provisions of the Paris Convention thus certainly assist patent applicants and facilitate the filing of patents around the world, i.e. the object and purpose of the Paris Convention as acknowledged by all parties. The legal fiction of simultaneous filing establishes both substantive (same invention), and formal (same applicants) requirements for a priority right to be acknowledged.

51. The appellants' submissions on the violation of the European Convention on Human Rights (see paragraph 138, Grounds of Appeal) are made under the heading of "argument I" (Question 1 in this decision), although the appellant refers to arguments made in document D197 (Declaration of Professor Paul Torremans, 13 November 2017), point 52, which is concerned with "national law" dealt with under the heading of "argument III" (Question 3 in this decision). Nevertheless, the Board will deal with this argument here. The appellants' arguments state that, by applying the "same applicant" requirement, the EPO bars, without proper justification, nationals of Union countries from enforcing their right of priority that is granted under the Paris Convention, and thus interferes with the owners' right of peaceful enjoyment of their possessions. Moreover, it can even result in the loss of another property right, namely the patent, due to novelty destroying intervening prior art. The Board considers this argument to be circular: it assumes that the established EPO interpretation of the Paris Convention is wrong, without bringing any supplementary arguments as to why this is the case, and then concludes that, being wrong, the European Convention on Human Rights is violated.

52. The Board thus finds that considerations of the object and purpose of the Paris Convention do not provide a decisive push in one direction or another that enables the Board to adopt either the appellants' or the respondents' diverging interpretations of "any person". The Board, however, sees more force in the respondents' position due to the fact that if a plurality of persons has carried out together the same act of filing, then this implies that the group is to be considered as a unity for this purpose.

53. It is undisputed that there is no case law, either of the EPO or of national tribunals, that clearly and unambiguously adopts the interpretation of "any person" proposed by the appellants. In addition, as the above discussion demonstrates, the current practice can be considered to have a rational foundation that derives from a conventional approach to interpreting legal texts. Users of the international patent system are thus faced with an established practice, the continued application of which can be seen as an aspect of legal certainty. In general, the bar for overturning long established case law and practice should be a high one because of the disruptive effects a change may have. The Board notes that as the priority provisions of the Paris Convention have remained essentially unchanged since 1883, the appellants are faced with over 100 years of consistent case law and practice adopting the "all applicants" approach that they need to show as incorrect. This is a considerable burden.

54. From the case law that the parties have referred to in these proceedings the Board has noted the following: very few cases appear to have addressed this issue, and these cases are very old, from the first thirty years of the twentieth century, or very recent, from the last fifteen years or so. There appears to have been a period of over seventy years when no court was called upon to address

this issue, which supports the viewpoint that the "all applicants" approach in general does not seem to be an unjustified formal burden for applicants. Another striking feature of this case law is that it contains very little, or no reasoning, as to why the court in question always adopted the "all applicants" approach. An example of this limited reasoning is found in the second paragraph of point 2 of decision T 0788/05, which states that:

"The term "a person" in Article 87(1) EPC... implies that the applicant be the same for "the first application"...and for the later application for which a priority right is claimed. The required identity for the applicants originates in that the priority right is part of the applicants right."

55.This lack of in-depth reasoning on this point is also found in the standard learned treatises on the Paris Convention (Wieczorek, Bodenhausen, Ladas etc.) which deal with remarkable brevity with the "all applicants" approach. This is even the case for Ladas, which is the only one of these works to support the appellants' interpretation of "any person".

56.The appellants have attacked this case law as providing an insufficient basis for the "all applicants" approach.

57.The Board agrees with the appellants to the extent that neither the case law nor the learned treatises cited provide a reasoned basis for the "all applicants" approach that the Board can simply adopt as its own.

58.The appellants have also referred to recent English and Swiss cases that, in their view, support a relaxation or "softening" of the "all applicants" approach. The first of these is *Accord Healthcare v Research Corporation*

Technologies [2017] EWHC 2711 (Ch), an English Patent Court decision by Birss, J (document D201). The appellants refer in particular to paragraph 77 of this judgment where Birss, J observed in respect of the consequences of a loss of priority right:

"There is no obvious public interest in striking down patents on this ground, unlike all the other grounds of invalidity".

59. Although the *Accord* case turned on the distinction in English law between equitable and legal ownership of a right, the appellants adopt Birss, J's statement as being one of policy that should be applied to the present case: a mistake in the formality of correctly naming the applicants should not lead to the revocation of the patent.

60. The Board notes that in the present case it does not appear to have been a mistake of inadvertence that one of the applicants for the Priority Application was excluded from the Subsequent Application, but rather a deliberate choice of the appellants. Moreover, a formal requirement cannot be merely disregarded or ignored if, as the consequence of its non-compliance, it results in the revocation of the patent. It is not appropriate to "soften" any requirement - be it formal or substantive - for patenting on the sole basis that its non-compliance may result in the revocation of a patent.

61. In addition, in paragraph 148 of their Grounds of Appeal, the appellants refer to paragraph 67 of *Accord*, which in turn refers to *KCI Licensing v Smith & Nephew* [2010] EWHC 1487 (Pat). The appellants take Birss J's statement made in paragraph 67, that the court in *KCI*:

"...accepted a significant softening to what otherwise might have been the rigour of the rule that the title must be secured by the time the international application is made, by accepting an analysis based on common law principles distinguishing the equitable and legal title to property."

62.The appellants state that these decisions have:

"...softened the rigour of the EPO rule..."

By this the appellants mean that these English decisions provide a basis for softening the EPO's "all applicants" approach. The Board cannot follow this: as stated above, and as confirmed in the quotation from paragraph 67 of *Accord*, these cases were concerned with the question of successorship in title and do not concern the question at hand in the present case, as acknowledged by the appellants themselves in the penultimate sentence of paragraph 147 of their Grounds of Appeal, where they state, "Also Lord Hoffmann notes that these cases merely concerned the question of successorship in title and do not concern the question at hand in the present case".

63.The Board concurs with Lord Hoffmann, and the appellants, that the *Accord* case concerns rather different facts than the present case. *Accord* is a generics manufacturer and sought to revoke RCT's patent. It was acknowledged by both parties that a loss of the priority right would render the patent not novel. In the *Accord* case, Professor Kohn, the applicant for the US priority application, assigned his rights in the patent application to RCT. Professor Kohn was also an employee of the University of Houston and under his contract of employment he was obliged to assign any rights in patents to Houston. Houston had a long

standing contractual relationship with RCT, who sought to exploit, for the mutual profit of itself and Houston, inventions made by Houston's employees. The case turns upon the distinction in English law (and US law) between legal and equitable ownership. According to English law it is the equitable owner who should be the applicant for the subsequent international patent application and not the bare legal owner. Applying this analysis, Professor Kohn was owner of the bare legal title, and Houston was the owner of the equitable title. Thus, in the absence of any assignment from Houston to RCT of the equitable title prior to the date on which RCT applied for the subsequent application, RCT had only received an assignment of the bare legal title from Professor Kohn. This is the issue addressed in *Accord*, and without a "softening" of the rule, would have led to a loss of priority as RCT was not the equitable owner on the day it filed the subsequent application. The English court was able to save the priority right for RCT in this case by the application of another part of the English doctrine of equity by treating RCT as a *bona fide* purchaser without notice ("equity's darling").

64. The *Accord* case thus treats issues that are somewhat distant from those that have arisen in the present case.

65. Thus Birss, J's remark on public policy concerns in *Accord* refers to an entirely different situation than that of the present case, namely to an issue of successor in title that was resolved by reference to English equitable principles.

66. The second of the cases referred to by the appellants is a decision of the Swiss Federal Patent Court of 21 March 2018, *Riendeau v Zehnder Group International AG*. The original German language judgment is document D268, and

the English translation provided by the appellants is document D269.

67. The *Riendeau* judgment concerned a dispute between the parties as to the ownership of a number of patents. In what follows the Board uses the appellants' translation of this judgment, document D269. Section 8 of this decision concerns "The consequences for the priority claim for national registrations". The Swiss Federal Patent Court appears to have been faced with a situation where the defendant was the applicant for European patent applications "EP 2" and "EP 3", and was also applicant for patent applications "WO 2" and "WO 3", which claimed priority from EP 2 and EP 3 respectively. The plaintiff requested that the defendant remove its references to the priority dates of EP 2 and EP 3 in its applications WO 2 and WO 3.

68. When considering this issue the Swiss Federal Patent Court applied the standard approach of the EPO and approved its case law, in particular decisions T 1201/14 of 9 February 2017, T 0005/05 of 9 November 2005 and T 0788/05. The material parts of the judgment state at paragraph 8.2, page 1 of document D269:

"With regard to the validity of a priority claim in relation to the question as to whether a priority registration and a subsequent registration were filed by the same person or by his/her legal successor, the decisive criterion is the situation at the moment the subsequent patent registration was filed. When the patent registrations WO 2 and WO 3 were filed, the defendant was the patent applicant of EP 2 and EP 3 and the patent applicant of WO 2 and WO 3. This means that under art. 87(1) EPC the defendant was entitled to claim the

priority of EP applications EP 2 and EP 3 (the applicant filing the priority claim and the subsequent patent registration is the same person).

The assertion made in this respect that the plaintiff was entitled to EP 2 and EP 3 together with the defendant does not change the fact that when the applications for WO 2 and WO 3 were filed the defendant was the applicant of EP 2 and EP 3, since the validity of a priority claim with regard to the question of legal successors is based on the formal applicant status of the priority application and not on who is substantively entitled to file the priority application."

The decision then continues with the following paragraph, which the appellants rely upon:

"Contrary to the case law generated by the Board of Appeal of the EPC a sufficient condition for the validity of a priority claim is deemed to exist if at least one of the applicants during the prior application and one of the applicants during the subsequent application are the same person. If several persons file a priority application, the conclusion that the priority may only be claimed by one person or by a sub-group of applicants during the prior application cannot be drawn either from the Paris Convention for the Protection of Industrial Property...or from the EPC. If during the subsequent application the persons named as the applicants no longer wish to assert material claims in respect of the patent, they may do this by filing a claim for assignment. The creation of such formal requirements leads to a restriction of the right to claim a priority right and runs contrary

to the spirit of the Paris Convention for the Protection of Industrial Property of enabling and simplifying international patent protection."

69. The paragraph cited above appears to be an *obiter dictum* as regards the actual decision, which is set out above it. This paragraph is without relevance to the court's decision or its reasoning, which applied the established EPO approach. In addition, this *obiter dictum* makes no reference to any earlier Swiss law, legal authority or European case law. As regards the content of this *obiter dictum*, it is merely another statement of the appellants' arguments on the object and purpose of the Paris Convention that have been dealt with above.

70. Thus the Board is not persuaded that these cases provide a basis for the change in practice that the appellants are seeking.

External and internal priority argument

71. The appellants argue in paragraphs 166 to 170 of the Grounds of Appeal that all of the cases where the boards have found in favour of the "all applicants" approach have concerned "internal" (European) priorities under Article 8(2)(b) PCT. The present case concerns an "external" (non-European) priority under Article 8(2)(a) PCT. Thus the Board should only apply the Paris Convention, without being influenced by the possible considerations flowing from the wording of Article 60(3) EPC that led the Boards in the past to adopt the "all applicants" approach in internal priority cases.

72. The Board does not find that this argument assists the appellants as it does not amount to a positive case as to

what "any person" in Article 4A Paris Convention actually means.

73. Article 8 PCT has the title "Claiming priority" and contains Articles 8(1) and 8(2)(a), (b) PCT. Article 8(1) requires the international application to contain a declaration claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention. Article 8(2)(a) refers to Article 4 of the Stockholm Act of the Paris Convention and Article 8(2)(b) provides that an international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

74. The Board observes that none of the EPO case law dealing with the "all applicants" approach - and referred to by the appellants - appears to have been decided upon the basis of the board making a distinction between Article 8(2)(a) PCT and Article 8(2)(b) PCT cases. Nor does the Board see any reason to make such a distinction for the purpose of establishing the meaning of "any person" on the sole basis of the wording of these articles and of appellants' arguments thereupon.

75. The Board considers that the EPO is obliged to apply Article 4A of the Paris Convention in the same way regardless of whether it is faced with an "internal" priority under Article 8(2)(b) PCT or an "external"

priority under Article 8(2)(a) PCT. This follows from the fact that the EPC is a special agreement under Article 19 Paris Convention and that Article 87(1) to (3) EPC is basically identical to Article 4A of the Paris Convention.

The opposition division's discussion of co-ownership

76. The opposition division was prepared to accept, (see paragraphs 66.7 and 66.8 of its decision), that the filing of an application claiming priority could be classified as an act of exploitation of a right held in common and could thus be exercised individually by each of the joint owners. It was found, that when this approach was applied to priority rights, it would allow each joint applicant, alone or in different combinations with the other co-applicants, to file a patent application claiming priority from the first application. The opposition division considered this could lead to a multiplication of proceedings with identical content and thus to potential double patenting (see paragraph 66.9 of its decision). The opposition division found this to be undesirable from a public policy view point and it was hence not prepared to deviate from the established practice.

77. The appellants agree with the opposition division's classification of the right to claim priority as being an exploitation of the underlying right rather than a disposal of it (see opposition division decision paragraph 66.8 and Grounds of Appeal paragraphs 172 to 186). The conclusion that the opposition division drew from this classification, and which is also supported by the appellants, is that one of a group of joint owners can act alone, in other words, can file an application claiming a priority right without the other owners. The opposition division found, however, that policy considerations relating to the prevention of multiple patenting were of

sufficient weight to prevent the application of this conclusion. The appellants argue that such policy considerations are not substantial enough to stop the application of the conclusion that one of a group of joint owners can act alone in filing an application claiming a priority right without the other owners (see Grounds of Appeal paragraphs 187 to 198).

78. The appellants' argument is thus that if the right to file an application claiming priority is classified as a right of exploitation, then this can be exercised individually by any of the joint owners and hence "any person" should be interpreted as one or more of a plurality of persons. Policy considerations that would counter such a conclusion are said to be unconvincing.
79. The Board first notes that neither the Paris Convention, nor the EPC, take a clear position on the exact nature of either joint ownership or on the precise legal classification of the right to file a priority application, indeed these issues were ones of controversy between the parties. A further issue that arises from the individual exercise of a joint right is whether this right is exhausted by its first exercise. This was touched on in decision T 0015/01 at points 28 and 41, where the board found that there was no doctrine of exhaustion of the priority right.
80. The Board also takes issue with the opposition division's classification of the filing of an application claiming priority from an earlier application as being an act of exploitation of this earlier application. Distinctions between exploitation and disposal of a property right derive from considerations of real property. Whether it is possible to shoe-horn an entirely synthetic right such as the right to claim priority into such a framework appears

to the Board to be questionable. The Board also notes that such distinctions have developed differently in civil and common law jurisdictions.

81. Although the Board agrees with the appellants that the priority mechanism was not meant to, and in certain circumstances is unable to prevent multiple applications, it finds the possibility of a multiplication of proceedings and double patenting identified by the opposition division to be plausible and to be avoided. The Board also finds the potential "hostage" situation proposed by the appellants (see paragraph 195, Grounds of Appeal and paragraph 32 above) an unconvincing policy consideration. An applicant can progress a patent application before the EPO without the active participation of the other applicants even though they are named in the application. There is also the further policy justification for the current practice: it protects applicants from being "left out" and being forced to resort to international litigation in order to protect their rights.

82. The Board thus finds that, even accepting the opposition division's classification of the right to claim priority as a "right of exploitation", there are sufficiently strong countervailing policy concerns to prevent the full application of the consequences of such a classification. The Board has not been able to identify a policy reason advanced by the appellants that gives a convincing case for overturning the well-established practice of the EPO.

*Conclusion on interpretation of "any person" in Article 87(1)
EPC*

83. The ordinary meaning of the term "any person" in Article 87(1) EPC is ambiguous. The term "celui qui" in

the authentic French text of Article 4A of the Paris Convention is perhaps less ambiguous and more likely to support the "all applicants" approach. The "all applicants" approach is certainly a plausible interpretation of this term from the ordinary meaning perspective and appears to be the one consistently applied by several member states of the EPC, over the last hundred years.

84.As regards the object and purpose of the Paris Convention, a reasonable interpretation of this appears to be that of assisting the applicant(s) by facilitating the filing of patent applications around the world for a limited period. To this end, the Paris Convention establishes a system whereby applicants are treated as if they had simultaneously filed the same application in a multiplicity of member states. This fictitious simultaneity supports the "all applicants" approach. When the priority right is exercised it gives birth to an entirely new property right, the subsequent application. The current "all applicants" approach is not an obstacle to the exercise of the priority right to this end. It is an obstacle to one of a multiplicity of original applicants applying on their own for such a subsequent application. There is no evidence that the object and purpose of the Paris Convention is to facilitate such behaviour.

85.The Board is also faced with many decades of EPO and national practice supporting the "all applicants" approach. This approach has been consistently applied under both the EPC 1973 and the EPC 2000. There is no evidence on file that any states that are currently member states of the EPC have ever adopted anything but the "all applicants" approach when applying Article 4A of the Paris Convention. The Board notes that the Paris Convention has

undergone seven revisions since the original 1883 version and the EPC one revision since 1973. There is no evidence on file that during the course of these revisions any doubt was cast on the correctness of the "all applicants" approach.

86. Thus, although arguments can be made for the appellants' "one or more applicant" approach, stronger arguments for the "all applicants" approach can be made and the "all applicants" approach has been applied, as far as the Board can determine, without exception since at least the early twentieth century by states that are currently member states of the EPC, and by the EPO since its inception. The Board has also found that such a practice can be considered to have a rational basis, in the sense that it is based on a reasonable interpretation of the legal texts in question. The bar to overturning long established case law and practice should be very high because of the disruptive effects a change may have. The continuation of such long standing and rationally based practices can be considered as an aspect of legal certainty. In the light of these considerations the Board finds that the words "any person" in Article 87(1) EPC require that all applicants for the priority application, or their successors in title, are applicants for the subsequent application.

Question 3: National law governs who is "any person" as per Article 87(1) EPC

87. The appellants argue (see paragraphs 203 to 303, Grounds of Appeal) that the national law of the country where the priority application was filed is the law that should be used to determine the meaning of "any person" under Article 87 EPC. In this respect the appellants consider that "any person" requires a separate assessment as

compared to "duly filed". The priority right arises and vests in "any person" who duly filed the priority application even before the subsequent application is filed. It can thus only be national law that is applicable to the determination of "any person" in Article 87 EPC, just as with the successor in title case law; any other interpretation would contravene the Paris Convention. Thus, in the present case it is US law that is applicable to the determination of "any person", given that the Priority Application was filed in the United States. The issue of who is the inventor of what is claimed, a very important issue under US law, should thus be taken into account. Therefore recourse must be had to the determination, as made by the US prosecuting attorney, of the applicants' contribution as inventor(s) to the invention(s) disclosed in the Priority Application in order to define who is "any person". The appellants therefore consider that all persons who under US law filed the Priority Application in respect of the invention claimed in PCT '819 were applicants for PCT '819 and priority was therefore validly claimed. The person whose name was missing from the Subsequent Application was not an inventor of what was claimed therein.

88. The appellants argue that it is the national law of the place of filing of the priority application that determines who qualifies as "any person" who has "duly filed" the priority application within the meaning of Article 87(1) EPC, as well as Article 4A Paris Convention. Article 87(1) EPC requires reference to national law, in this case US law, in order to determine not just the "duly filed" and "successor in title", but also to determine "any person". Under US law the applicant status is tied with inventorship (see paragraphs 203 to 208, Grounds of Appeal).

89. The appellants point out that Article 87 EPC is the legal basis for the assessment of priority claims at the EPO. For the interpretation of certain terms this requires reference to another system of law. It is expressly provided in Article 87(2) EPC that there should be recourse to national law to determine whether a filing is a regular filing. The appellants argue that once it has been established that an application was duly filed the question "who" has filed the application and hence who can rely on the priority date for subsequent filings to protect his invention needs to be answered. This should also be determined by national law, the word "duly" in "any person who has duly filed" denoting compliance with rules that, in this context, can only mean the rules of the country in which the first application was filed (see paragraphs 214 to 223 and 236 to 238, Grounds of Appeal).

90. As further support for this view, the appellants argue that in the period between the filing of the priority application and the subsequent application, it should be possible to tell who "any person" is, and this can only be determined at that moment in time by the national law applicable to the priority application. The relevant system of law cannot be changed later depending on where any subsequent application is filed (see paragraphs 210 to 213 and 224, Grounds of Appeal). This situation is analogous to the period between the filing of an EP (parent) application and of a subsequent EP (divisional) application for which only the EPC applies (see G 1/05, OJ 2008, 271, points 3.1 and 6).

91. The appellants note that the EPO has accepted the applicability of national law in the case of determining the successor in title, and, by extension, national law should also be applied to the determination of "any person" in whom the priority right vests. It is

nonsensical that the question of who is a "successor in title" of "any person" who has duly filed is to be determined by national law whilst the determination of who is the predecessor of that successor in title is not (see paragraphs 225 and 226, Grounds of Appeal).

92.The appellants argue that, in addition to being illogical, such a practice contravenes the Paris Convention: it would have the consequence that the validity of a claim to priority would depend on the formalities imposed by the country in which the subsequent application is filed. The Paris Convention does not aim at harmonising national patent laws, it leaves national patent laws untouched, but it is specifically aimed at sparing applicants from having to comply with many different national laws at the time of filing the priority application in order to subsequently claim priority from it (see paragraph 227, Grounds of Appeal).

93.The appellants are not asking the EPO to assess entitlement to the invention, but rather to appreciate that "any person" must be determined under the relevant law, in this case US law, in conformity with the Paris Convention. The EPO should merely assess whether under US law a person qualifies as an applicant of a priority application (see paragraph 249, Grounds of Appeal).

94.The appellants argue that the EPC and the Paris Convention do not in principle prevent a consideration of an applicant's status as an inventor nor its concrete contribution to the specific subject matter of the application: under the national treatment rule the EPO must give foreign nationals access to the EPO patent system on an equal footing as nationals of EPC member states. The EPO must accept the system of naming applicants in the country where the priority application

was filed. If the country where the priority application was filed happens to look at inventorship for determining who the applicant is, the EPO must accept this (see paragraph 251, Grounds of Appeal).

95. The appellants note that it is a fundamental principle of the Paris Convention that the applicants for a priority application should be assisted in obtaining international protection. Since the Paris Convention left the concept of "any person" open, this is only achieved by accepting the determination of "any person" who has "duly filed" under the national law of the country of first filing. This issue cannot be by-passed by mere reference to the register. The content of the register is determined by US law. Anyone consulting the public register of a US application must take into account that the naming of applicants in a US patent application is based on their contribution to any invention disclosed in the application. The EPO has to rely on this and does not have the power to question it (see paragraphs 252 to 259, Grounds of Appeal).

96. The appellants note that the EPO is required to accept US provisional applications by the Notice from the President of the EPO dated 26 January 1996 concerning the priority conferring effect of the "US provisional application for patent" (OJ 1996, 81) (see paragraph 275, Grounds of Appeal).

97. The appellants further note that US provisional applications have special characteristics: they do not need claims; they are never examined; they never proceed to grant; their sole purpose is to obtain a filing date; they may contain multiple inventions; they need not name (an) inventor(s) or applicant(s). This last characteristic must mean that the EPO's approach of simply comparing

listed persons is not applicable. The EPO must logically look at national law to see who qualifies as applicants. The opposition division in the decision under appeal failed to address the issue that US provisional applications can be filed without naming any applicants and still be accorded a filing date (see paragraphs 273 and 274, Grounds of Appeal).

98.If the EPO decides it must assess whether a claim to priority is validly made by looking at whether it was filed by the same applicants as those of the priority application, it must still assess which persons qualify as applicants - "any persons" - for the invention claimed. The consequence of the US approach is that an inventor is an applicant, or "any person", only for the subject-matter of inventions to which they contributed. Unlike under the EPC, a person's applicant status does not depend on being named in the application. The priority right that arises therefore vests in those inventors that contributed to the invention disclosed in the provisional application and claimed in PCT '819, and not in those that only contributed to inventions disclosed in the US provisional application (the Priority Application) but not claimed in PCT '819 (see paragraphs 276 to 278, Grounds of Appeal).

99.The appellants point out that a US provisional application can contain several inventions and a list of inventors who have contributed to certain of these inventions and not others. In the US, in the normal course of events, the inventors are subsequently associated with their inventions and a regular US application is made for each invention (see paragraphs 282 to 292, Grounds of Appeal).

100.According to the appellants, current EPO practice effectively requires that in the case of a priority

application that is a multi-invention, multi-inventor US provisional application, a US inventor-applicant will either have to be an applicant before the EPO for an invention they didn't make, or they will have to assign their non-existent rights in an invention made by someone else to a successor in title. Without such artificial manoeuvres the priority right would be lost. This would result in a discriminating effect. In the case of US provisional applications, the EPO's approach is a clear violation of the national treatment rule (see paragraphs 273, 274 and 279, Grounds of Appeal).

101. The appellants further argue that in the present case the Subsequent Application was filed by all those persons who, as a matter of US law, had filed the Priority Application(s) in respect of the invention that was claimed in the Subsequent Application, hence these persons are the "any person" required under Article 87(1) EPC (see paragraphs 293 to 297, Grounds of Appeal).

102. The opposition division in the decision under appeal fails to explain why the Paris Convention would treat all applicants of the priority application as a legal unity that can only act jointly. Moreover, the opposition division fails to address how - and thus under which law - the qualification as applicants must be made (see paragraph 280, Grounds of Appeal).

103. The present approach of the EPO that all inventors named on the priority application are considered applicants thereof would effectively force the USA to change its patent laws to ensure that its nationals are not unfairly discriminated against.

The Board's answer to the third question

104. As a first point the Board notes that the US is a party to the Paris Convention. Article VI, clause 2 of the US Constitution states:

"This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding."

From this the Board concludes that the Paris Convention is part of the "supreme Law of the Land" in the US.

105. The relevant wording of the Paris Convention is found in Article 4A(1), (2) and (3) and is worth repeating:

(1) Any person who has duly filed an application for a patent ..., or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority ...

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

106. Article 4A(2) Paris Convention provides that it is national law that determines what is a duly filed application under Article 4A(1) Paris Convention, and Article 4A(3) Paris Convention provides that it is national law that determines whether a filing is one that establishes a filing date.

107. The above points were not disputed by the parties. The appellants' argument is that the Paris Convention also foresees a national law assessment of who is the "any person" of Article 4A(1) Paris Convention, and under US law this must be the inventors, or their successors in title, who are the applicants for the patent application of the invention claimed.

108. Article 4A(1) and (2) Paris Convention (and the basically identical Article 87(1) and (2) EPC) do not refer to the "inventor" or the "applicant" for a patent application: they refer to a person who has carried out an act, that of filing a patent application. This is immediately determinable upon the date of the filing - it is the person or persons who carried out the act of filing. Whether these persons are the inventors of what is claimed or whether they are actually entitled to be the applicants for this patent are not issues requiring investigation under the Paris Convention. This is particularly clear from the authentic French text of Article 4A(1) Paris Convention:

"Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention..."

109. It is also apparent that this was the intention of the drafters of the Paris Convention, contrary to what is argued by the appellants' expert, Professor Torremans, in point 35 of document D197, where he refers to his study of

the *Travaux préparatoires* of the Paris Convention. This is made clear by the discussions at the Fourth Session on 9 November 1880 of the International Conference for the protection of industrial property, as to whether the words "celui qui", (the "any person" of the English versions) should read "l'auteur de l'invention" (the author of the invention) - see pages 60 to 62 of the Procès-verbaux des séances de la conférence, quatrième séance 9 novembre 1880. As regards the formulation "celui qui aura régulièrement effectué le dépôt", that the President of the Conference had proposed, the Belgian delegate, M. Demeur, raised the issue if,

"...Par cette formule entend-on que celui qui aura fait le dépôt doit avoir eu le droit de le faire?..."

This was answered by the Swedish delegate, M. Lagerheim, who considered that it would be:

"...dangereux de faire porter le mot sur la question de fond. Il s'agit de la priorité du dépôt, mais non pas du droit définitif de propriété ... il propose donc d'adopter la rédaction de M. Demeur, en enlevant le mot auteur pour le remplacer par la phrase ("celui qui" - Note of the Board) proposée par M. Le President ..."

110. It is thus clear that the Paris Convention, being an integral part of US law, determines who "any person" is, and that this determination is a purely formal one. It does not require that the "any person" is actually legally entitled to make the filing, but merely that they did so. Thus the Paris Convention and the EPC provide self-contained definitions of the person who claims priority,

both treaties define this person by means of the action that this person has performed.

111.The appellants point out that US provisional applications have certain special characteristics, one of them being that no inventors or other applicants need to be named, and yet they are able to establish a filing date. The appellants argue that this must mean, given that the EPO accepts US provisional applications as founding a priority right (Notice from the President of the EPO dated 26 January 1996), that the EPO's approach of comparing lists of names cannot be correct.

112.The respondents have put forward uncontested evidence that a US provisional application that does not name any inventors/applicants will not establish a filing date unless the inventors/applicants are named within a certain time limit (see point 4.4.3 of opponent 4's reply and Declaration of D.J. Kappos, D282, item 14). Thus the appellants' argument is without force on this point.

113.The appellants refer to further special characteristics of US provisional applications, that is they can contain several different inventions and several named inventors who have made different contributions to different inventions. A subsequent filing using such a US provisional application as its priority application would most likely fail the EPO's "identity of applicants" test for assessing "any person". For the appellants this is tantamount to compelling a change in US practice and failing to follow the instructions of the President of the EPO. The appellants consider that this is contrary to the principle of national treatment.

114.As regards changing US practice, it is clear that applicants wishing to use US provisional applications

should be aware of the difficulties they may face if they use these applications to claim priority for a European patent application. This is simply a consequence of the US's adhesion to the Paris Convention. The Notice from the President of the EPO cannot exempt the EPO from applying the Paris Convention and there is no evidence that this was its intention.

115.The principle of "national treatment" is that a nation treats foreigners in the same way as it treats its own nationals. In the context of the EPC this means that applicants and patentees from non-member states are treated in the same way as applicants and patentees from member states. The appellants are mistaken when they consider this principle requires the EPO to treat applicants and patentees from non-member states in the same way as they would have been treated in their home country.

116.The Board thus finds that the "national law" that determines who "any person" is, is in this case, the Paris Convention. The Board has already set out its interpretation of this term in the preceding parts of this decision.

Conclusion on the three arguments of the appellants

117.For the reasons given above, the decision of the opposition division on the interpretation of the term "any person" in Article 87(1) EPC is to be confirmed. The interpretation is that of the so-called "all applicants" approach. The Board agrees with the EPO's long established practice on this issue.

118.A consequence of this is that priority has not been validly claimed from P1, P2, P5 and P11 and hence

documents D3 and D4 become relevant prior art. The appellants have not provided any arguments, either before the opposition division or before the Board, as to why the claims of the patent in suit are novel over documents D3 and D4. The Board thus adopts the reasoning and decision set out in paragraphs 78 to 80 of the opposition division's decision.

Submission of questions to the Enlarged Board of Appeal

119. Under Article 112(1) (a) EPC a board of appeal shall refer a question to the Enlarged Board of Appeal if it considers that a decision is required, in order to ensure uniform application of the law, or because a point of law of fundamental importance arises.

120. The appellants have requested the submission of certain questions to the Enlarged Board of Appeal. Their reasons for wishing to submit these questions are a mixture of uniform application of the law and points of law of fundamental importance.

121. The "uniform application of the law" point does not apply in this case as the instances of the EPO have without exception adopted a consistent interpretation of Article 87(1) EPC since the inception of the European patent system.

122. The Board has a discretion whether to refer questions, even if a point of law of fundamental importance is concerned (see decision T 0390/90, OJ 1994, 808, point 2). One of the applicable criteria is whether the question can be answered beyond doubt by the Board itself (see decision T 1242/04, OJ 2007, 421 point 10.3). In this case the Board has been able to answer the questions raised beyond doubt, hence no referral is necessary.

Admission of Auxiliary Requests 1 to 64 into the proceedings

123. The appellants withdrew their request (Request No. 5) regarding the admission of these Auxiliary Requests into the proceedings. This necessarily means that the reference to these requests in the appellants Request No. 8 is also no longer to be considered.

Conclusion

124. In the light of the above considerations and findings the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated