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**Datasheet for the decision
of 28 January 2022**

Case Number: T 2719/19 - 3.3.04
(consolidated with Case Number:
T 1513/17 - 3.3.04)

Application Number: 16160321.2

Publication Number: 3056218

IPC: A61K39/395, C07K16/18

Language of the proceedings: EN

Title of invention:

Prolongation of survival of an allograft by inhibiting
complement activity

Applicant:

Alexion Pharmaceuticals, Inc.

Headword:

Prolongation of survival of an allograft/ALEXION

Relevant legal provisions:

EPC Art. 87(1), 112(1) (a), 118, 153(2)

EPC R. 99(2), 139

PCT Art. 11(3)

RPBA Art. 12(4)

Paris Convention Art. 4

Keyword:

Priority

Correction of error

Referral to the Enlarged Board of Appeal

Decisions cited:

G 0001/12, T 1933/12, T 0205/14, T 1201/14, J 0011/95,

T 0239/16, T 0419/16, T 0844/18, T 2749/18, T 2842/18,

T 0845/19, T 1837/19

Gerechtshof Den Haag 30 July 2019, ECLI:NL:GHDHA:2019:1962

BGH 16 April 2013 case X ZR 49/12 (Fahrzeugscheibe)

KCI Licensing Inc and others v. Smith & Nephew PLC and others,
case HC09C02624 of 23 June 2010

Catchword:

The following questions are referred to the Enlarged Board of Appeal:

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1) (b) EPC?

II. If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC

in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?



Beschwerdekammern

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Case Numbers: T 1513/17 and T 2719/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 28 January 2022

**Appellant in cases T 1513/17
and T 2719/19:** Alexion Pharmaceuticals, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 30 May 2017
revoking European patent No. 1755674 pursuant to
Article 101(3) (b) EPC.**

**Decision of the Examining Division of the
European Patent Office posted on 11 April 2019
refusing European patent application No.
16160321.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair G. Alt
Members: P. de Heij
 A. Chakravarty

Summary of Facts and Submissions

Relating to case T 1513/17

- I. The appeal of the patent proprietor lies from the interlocutory decision of the opposition division revoking European patent No. 1 755 674 (the patent). The application on which the patent was granted had originally been filed as an international application under the Patent Cooperation Treaty (PCT) with number PCT/US2005/017048 and published as WO 2005/110481 (the PCT application). It claims priority on the basis of the US provisional patent application No. 60/571,444, filed on 14 May 2004 (the priority application).

- II. The priority application was filed in the name of R.P. Rother, H. Wang and Z. Zhong, the inventors. The PCT application names R.P. Rother, H. Wang and Z. Zhong as inventors and as applicants with designation for the United States of America (US) only. It also names as applicants Alexion Pharmaceuticals, Inc. and the University of Western Ontario as applicants for all designated States except the US. The patent in suit names Alexion Pharmaceuticals, Inc. as patent proprietor and R.P. Rother, H. Wang and Z. Zhong as inventors.

- III. The patent was opposed on the grounds referred to in Article 100(a) EPC (novelty and inventive step) and Article 100(b) and (c) EPC.

The validity of the priority claim was contested, *inter alia* because the applicants, Alexion Pharmaceuticals, Inc. and the University of Western Ontario were alleged not to be the applicants or the successors in title of

the applicants of the priority application. As a consequence, the subject-matter of the claims of the patent lacked novelty over the disclosure in documents D10, D20 and D21, all published prior to the filing date of the patent application.

IV. The opposition division held, as far as presently relevant, the following.

The request of the appellant for correction under Rule 139 EPC of EPO Form 1200, such that the appellant and H. Wang and Z. Zhong were indicated as applicants, was to be interpreted as a request to correct Form PCT/RO/101. The request was not allowable, *inter alia* because Rule 139 EPC did not provide for corrections of mistakes based on assumptions. Other than in case J 10/87, this mistake could not be considered an excusable oversight.

The priority claim was invalid because only the priority right of the inventor Rother had been assigned to the appellant prior to the filing of the PCT application. An assignment of the priority rights of the inventors Wang and Zhong to the appellant or the University of Western Ontario had not taken place prior to the filing of the PCT application.

The subject-matter of claim 1 (thus) lacked novelty over the disclosure in documents D20 and D21.

Considering document D21 as representing the closest prior art, the subject-matter of claim 1 of auxiliary request 1 lacked an inventive step.

The subject-matter of claim 1 of auxiliary request 2 lacked novelty over the disclosure in document D21 as well.

- V. The opposition division referred to documents D1 to D46 as listed in the annex to its decision. The three declarations and the other documents mentioned in paragraph 11 of the decision are numbered, respectively, D47 to D57 for ease of reference in this appeal proceedings as follows:

- D47 Declaration of Y. Wang dated 17 March 2016
- D48 Supplemental declaration of Y. Wang dated 27 February 2017
- D49 Declaration of H. Regele dated 16 January 2017
- D50 Assignment by the inventors to Alexion Pharmaceuticals Inc. dated 28.03.2007, 02.04.2007 and 11.09.2007 respectively
- D51 Document supporting the name change from "UDEC Pharmaceuticals, Inc. to "Alexion Pharmaceuticals Inc"
- D52 Declaration of S. Jarrett dated 2 November 2016
- D53 Material Transfer Agreement
- D54 Declaration of S.A. Saxe dated 21 October 2016
- D55 Employment agreement between UDEC Pharmaceuticals Inc. and R.Rother
- D56 Quitclaim Assignment dated 31 July 2007

D57 President's comments on G 1/12 filed by
respondent I with letter of 8 March 2017

VI. Respondent I (opponent 1) and respondent II
(opponent 2) replied to the appeal.

VII. The appellant filed additional submissions dated
28 January 2021 and 5 October 2021. Respondent I filed
an additional submission dated 15 September 2021.
Respondent II filed additional submissions dated
20 December 2019 and 8 October 2021.

VIII. The documents filed by the parties in the appeal
proceedings are numbered as follows:

A1 Decision Edwards Lifesciences AG v. Cook Biotech
Incorporated dated 12 June 2009

A2 Decision of the Opposition Division in
EP 10 774 475.7

A3 Decision of the Opposition Division in
EP 08 798 550.3

A4 Decision of the Opposition Division in
EP 15 165 133.8

A5 Decision of the Opposition Division in
EP 05 777 317.8

A6 Decision of the Opposition Division in
EP 09 701 993.9

A7 Decision of the Opposition Division in
EP 06 837 634.2

A8 Decision of the Dutch Court of Appeal in case
200.234.115/01

IX. The arguments of the appellant, in so far as relevant to the present decision, may be summarised as follows.

Admissibility of the appeal

The appeal was admissible for the reasons set out in the board's preliminary opinion (see section XXII, below).

The request for correction of an error

The request for correction was allowable. The opposition division had incorrectly contrasted the situation dealt with in decision J 10/87 with the present situation. As in case J 10/87, the appellant had relied on information which they believed to be true, namely that the inventors had assigned the invention to their employer. This had been mistakenly assumed however. Thus, there had been an error and not a change of mind. The case law in this field distinguished the two situations.

It had been the intention to file the application in the name of the correctly entitled party. The statement in the amicus curiae submissions of the President of the EPO made in connection with decision G 1/12 in which it was alleged that the Boards of Appeal had developed a line of case law in which "*(a) request to substitute the applicant by a person who at the date of filing of the patent application was never intended to be named as applicant, even if the applicant's intention was based on false assumptions at the time of filing (e.g. a wrong assessment of the factual*

situation), does not fall within the scope of Rule 139 EPC", was made with "[no] support" and "it plainly does not mean what the opponents and the Board proposed it to mean." Reference was made to decisions J 7/80, J 18/93, J 17/96. Thus, the correction of the error had to be allowed.

Allowing the correction would not affect legal certainty in any way as the public never had any reason to doubt the entitlement to priority.

Priority entitlement

Where the applicants for a European patent application or proprietors of a European patent were not the same for all designated Contracting States, they were regarded as joint applicants for the purposes of proceedings before the European Patent Office (EPO) according to Article 118 EPC. Thus, the applicants of the priority application introduced the right to claim priority into the later patent application. A transfer of the priority right to any additional applicants of that later patent application was not necessary, even if the applicants were designated for different Contracting States.

In the absence of any prevailing PCT provision, the same applied to an international (PCT) application with respect to the designation for the European (EP) territory since, as of the date of the filing, the international application had the effect of a regular national application (Article 11(3) PCT and Article 153(2) EPC).

The priority claim of the international application was correctly made under the Paris Convention for the

Protection of Industrial Property (the Paris Convention). There was no provision in the Paris Convention or the PCT providing for splitting the priority right between different Contracting States.

Thus, under the PCT and the EPC, in a Euro-PCT application, if one applicant was entitled to priority, the entire application was so entitled, to the benefit of all applicants.

The patent therefore validly claimed priority because the applicants for the priority application were among the applicants of the PCT application.

The validity of the joint applicants approach was a point of law of fundamental importance. Referral of questions to the Enlarged Board of Appeal (EBA) was appropriate. Such questions also had to address the duty and jurisdiction of the EPO to assess the formal entitlement to priority of a PCT application. This latter issue had in particular been raised in the communication of the board in case T 845/19.

For questions formulated by the appellant, see point 20, below.

- X. The arguments of respondent I, in so far as relevant to the present decision, may be summarised as follows.

The request for correction of an error

The opposition division was right not to allow the appellant's request for correction. Decision G 1/12 set out that for a request for correction to be allowable, the correction had to introduce what was originally intended. In the present case it was not relevant that

the appellant had intended to file the PCT application in the name of the correct parties, but whether it had intended to file it in their own name and that of Wang and Zhong. This was not the case: document D54 confirmed that the appellant's in-house patent counsel had instructed the outside counsel to file in their own name and that of the University of Western Ontario. The application had thus been filed as intended. The correction request would therefore not introduce what was originally intended and was not allowable.

Priority entitlement

The joint applicants approach was valid. Under the PCT, the priority right had a unitary character. As a result, the act of filing an international application together was sufficient to entitle the applicants of a European patent to validly rely on the priority claim of the PCT application, even if not all applicants of the PCT application were applicants for the European patent.

A referral to the EBA was appropriate because the joint applicants approach concerned a point of law of fundamental importance in the sense of Article 112(1)(a) EPC and was decisive for the outcome of the present case. The referral had to also address whether the EPO had the power to decide on the transfer or introduction of priority rights at all. This was a contested concept as emerged from decision J 11/95 and communications of the boards in cases T 239/16, T 1786/15 and T 419/16.

For questions formulated by respondent I, see point 21 below.

XI. The arguments of respondent II, in so far as relevant to the present decision, may be summarised as follows.

Admissibility of the appeal

The appeal was not admissible. The decision of the opposition division was based on novelty and inventive step. However, the submissions of the appellant only addressed the validity of the priority right. Lack of priority was not a ground of opposition. Thus, comments focusing exclusively on priority could not overcome the decision to revoke the patent. The failure to address lack of novelty and inventive step made the appeal incomplete, insufficiently reasoned and therefore inadmissible.

Admission of a new request and facts into the appeal proceedings

The appellant's position that the priority right had to be recognised as valid even without the requested correction had not been advanced in the proceedings before the opposition division and was therefore not subject of the decision under appeal. Only in the appeal proceedings the appellant introduced the new request that the priority right should be held valid even without correction. This could at the same time be considered as a new submission of fact. The request and new facts were to be held inadmissible under Article 12(4) RPBA 2007. The same applied to the new auxiliary requests 1, 3 and 4.

The request for correction of an error

The requested correction was not allowable. The question was not, as the opposition division had incorrectly reasoned, whether it had been the true intention to file in the name of the "right person", but whether it had been the intention to file in the name of the specific person whose name was to be substituted. At the filing date it was believed that the appellant and the University of Western Ontario were the correct applicants. This was apparently not the case. However, the appellant's filing in these names had been entirely deliberate at the time. The requested correction constituted a change of mind. Allowing the request for correction would introduce something different than what had been originally intended and thus did not fall within the scope of Rule 139 EPC. Allowing the request was incompatible with the principle of legal certainty.

Priority entitlement

The priority claim was not valid absent the requested correction.

The appellant had conceded that there had been no transfer of rights in the priority year from the inventors Wang and Zhong and therefore neither the appellant nor the University of Western Ontario were successors in title to the inventors.

The inventors, the appellant, and the University of Western Ontario could not be considered as joint applicants for the PCT application as a whole or for the EP designation thereof. There was no suitable legal basis for this approach. Article 118 EPC dealt only

with the situation where there were different applicants for different designated Contracting States under the EPC and was only concerned with proceedings before the EPO. Article 118 EPC could not be applied analogously to an international application with the designation EP in proceedings before the EPO as the designated Office.

The joint applicants approach for Euro-PCT applications was a point of law of fundamental importance and required the referral of questions to the EBA, including the question of whether the EPO had the competence to decide on the formal entitlement to the right of priority.

For questions formulated by respondent II, see point 22 below.

Relating to case T 2719/19

XII. The appeal in this case lies from the interlocutory decision of the examining division refusing European patent application No. 16 160 321.2 ("the patent application"). This patent application is a divisional application of the earlier application EP 14 177 646.8, which in turn is a divisional application of the parent application EP 05 779 924.9, filed as international application PCT/US2005/017048, referred to above in section I in relation to the appeal case T 1513/17 as the "PCT application".

XIII. Also the patent application No. 16 160 321.2 claims priority on the basis of the US provisional patent application No. 60/571,444, referred to above in section I in relation to the appeal case T 1513/17 as the "priority application".

- XIV. As in case T 1513/17, the appellant requested that EPO Form 1200 be corrected to indicate that the applicants for the application were the appellant and H. Wang and Z. Zhong.
- XV. Third party observations pursuant to Article 115 EPC were filed with a letter dated 28 March 2017. Attention was drawn to the decision of the opposition division at the oral proceedings relating to the patent deriving from the parent application (i.e. the patent being the subject of the appeal proceedings T 1513/17, see above), namely to refuse the requested correction of the applicants' names and to revoke the patent.
- XVI. In its communication of 12 June 2017, the examining division preliminarily agreed with the decision of the opposition division in the parent case to refuse the requested correction and concluded that also in the present case the claimed priority was thus invalid. Consequently, documents D20 and D21 were prior art and the subject-matter of claim 1 of the patent application was not novel in the light of the disclosure in these documents.
- XVII. In their letter dated 1 May 2018, the appellant argued that the entitlement to priority was not dependent on the requested correction for the same reasons as set out above in section IX in relation to appeal case T 1513/17.
- XVIII. In its communication of 20 July 2018, the examining division reiterated its agreement with the decision of the opposition division in the parent case to refuse the requested correction. It furthermore did not acknowledge the validity of the priority claim. As the board understands, this was because the appellant was

the sole applicant of the patent application, but was not applicant of the priority application. The examining division referred to the Guidelines for examination in the EPO, edition November 2016, A-III, 6.1 reading: "*However, in the case of joint applicants filing the later European patent application, it is sufficient if one of the applicants is the applicant or successor in title to the applicant of the previous application. There is no need for a special transfer of the priority right to the other applicant(s), since the later European application has been filed jointly. The same applies to the case where the previous application itself was filed by joint applicants, provided that all these applicants, or their successor(s) in title, are amongst the joint applicants of the later European patent application*" (emphasis added by board).

- XIX. The priority claim being invalid, the examining division reiterated its view that the subject-matter of claim 1 of the present application was anticipated by the disclosure of documents D20 and D21.
- XX. The appellant was summoned to oral proceedings, but informed the examining division that they would not attend. They requested a decision based on their written submissions. The subsequent decision of the examining division refers to the communication of 20 July 2018 for the grounds.
- XXI. In the appeal proceedings the appellant put forward essentially the same line of reasoning with regard to the validity of the priority claim as in case T 1513/17. The decision of the examining division to refuse the requested correction was - unlike in case

T 1513/17 - not disputed. In the present case the validity of the priority right is therefore the only issue.

Relating to both cases

- XXII. The board appointed oral proceedings for 8 December 2021 and with the summons, issued a communication pursuant to Article 15(1) RPBA informing the parties of its preliminary opinion concerning matters relevant for the decision to be taken. The board *inter alia* was of the preliminary opinion that the appeal in case T 1513/17 was admissible as the statement of grounds of appeal enabled the respondents and the board to understand why, in the appellant's view, the appealed decision should be set aside.
- XXIII. Oral proceedings took place as scheduled. Appeal case T 1513/17 and the appeal case T 2719/19 were heard in parallel. At the hearing the board decided to deal with both appeal cases in consolidated proceedings pursuant to Article 10(2) RPBA. At the end of the hearing the chair announced that the board was seriously contemplating referring questions to the Enlarged Board of Appeal concerning issues related to the entitlement to priority.
- XXIV. Third party observations pursuant to Article 115 EPC were received on 14 January 2022 and 25 January 2022 in both case T 1513/17 and T 2719/19.
- XXV. The appellant requested in case T 1513/17 that:
- the decision under appeal be set aside and the patent be maintained on the basis of the set of claims of a main request, or alternatively on the basis of a set of

claims of one of four auxiliary requests, all re-filed with the statement of grounds of appeal;

- in case validity of the priority claim was not acknowledged, the PCT form PCT/RO/101 be corrected to indicate as applicants Alexion Pharmaceuticals, Inc., H. Wang and Z. Zhong;

- question(s) be referred to the EBA.

XXVI. The appellant requested in case T 2719/19 that:

- the decision under appeal be set aside and the patent application be remitted to the examining division with an order to grant a patent on the basis of the current claims (the main request filed on 8 November 2016);

- the case be remitted to the examining division in case any other issue than the validity of the priority right would be considered pertinent;

- question(s) be referred to the EBA.

XXVII. Respondent I requested in case T 1513/17 that question(s) be referred to the EBA and that the appeal be dismissed.

XXVIII. Respondent II requested in case T 1513/17 that:

- the appeal be held inadmissible;

- the new request and related submissions of fact, that the priority right should be recognised as valid even without correction, be held inadmissible in accordance with Article 12(4) RPBA 2007;

- auxiliary requests 1, 3 and 4 be held inadmissible in accordance with Article 12(4) RPBA 2007;
- the opposition division's decision to refuse the correction under Rule 139 EPC of the applicant names on the PCT request form be upheld;
- question(s) be referred to the EBA;
- the appeal be dismissed;
- the case be remitted to the opposition division, should the decision be set aside.

Reasons for the Decision

Admissibility of the appeal in case T 1513/17

1. The request by respondent II to hold the appeal in case T 1513/17 inadmissible is based on the argument that the appellant did not address the grounds on which the decision under appeal was based, in this case lack of novelty and inventive step, but that the appellant's submissions were only concerned with the validity of the priority right. Therefore, they could not overcome the decision to revoke the patent.
2. This reasoning is not persuasive. The statement of grounds of appeal should enable the respondents and the board to understand why, in the appellant's view, the appealed decision should be set aside. This is the case here. In the proceedings before the opposition division, respondent II argued that documents D20 and D21 were available as prior art for assessing novelty

and inventive step because the patent was not entitled to priority. The opposition division in the decision under appeal denied the right to priority and consequently considered documents D20 and D21 to be novelty destroying. There can therefore be no misunderstanding that the appellant requests the decision on the entitlement to priority be reconsidered and as a consequence of this also the decision on the novelty of the subject-matter of claim 1 of the main request and of auxiliary request 2.

3. The appeal in case T 1513/17 therefore complies with Articles 106 to 108 and Rule 99 EPC and is admissible. The appeal in case T 2719/19 is admissible for the same reasons.

The request for correction pursuant to Rule 139 EPC in case T 1513/17

4. The request for correction is conditional on the validity of the priority claim being not acknowledged. However, since a decision on the validity of the priority claim requires guidance of the Enlarged Board of Appeal (EBA) as explained below, the board already at this stage has to assess whether the requested correction is allowable. If this were the case, no referral in case T 1513/17 would be needed to decide on the appeal.
5. The board understands that the requested correction concerns the designation of the applicants for all Designated States except the United States of America, in form PCT/RO/101 which should be corrected to be the appellant, Alexion Pharmaceuticals, Inc., H. Wang and Z. Zhong.

6. In decision G 1/12 it is explained that Rule 139, first sentence, EPC deals with cases in which an error of expression in a declaration occurred (reasons 34). The EBA endorses case law requiring that the correction must introduce what was originally intended. It cannot be used to enable a person to give effect to a change of mind or development of plans. It is the party's actual intention which must be considered (reasons 37).
7. In the present case, this requirement is not fulfilled. The board agrees with the respondents that the form correctly expresses what was actually intended at the time of filing of the PCT application, namely that the applicants for all Designated States other than the United States of America were the appellant and the University of Western Ontario. The appellant's in-house counsel has confirmed this intention in his declaration (document D54). This intention was indeed based on the incorrect impression that Mr Wang and Mr Zhong had assigned their rights in the invention to the university under their employment contract.
8. The in-house counsel has also stated in his declaration that he intended to name the correct parties. This latter statement is not referring to an error of expression in form PCT/RO/101 but rather to the underlying motives for this expression. However, these motives are not relevant for the application of Rule 139 EPC. Respondent I correctly argued that if a party's intention to take the correct action would be relevant, this would open the door to unlimited possibilities for correction, to the detriment of legal certainty. Such an approach would certainly also be at odds with the principles expressed in decision G 1/12.

9. The decisions cited by the appellant (J 7/80, J 18/93 and J 19/96) need not to be discussed in detail. They either do not support the appellant's view that Rule 139 EPC does not exclude the correction of the designation of the applicant to a person/legal entity who/which at the date of filing of the patent application was not intended to be designated as applicant or, if they do, these decisions have been superseded by the later decision of the EBA. In view of the foregoing conclusion, it is also not necessary to address the question of whether form PCT/RO/101 can be corrected at all.

Admittance of the alleged new request and related submissions of fact in case T 1513/17

10. In the present case, the statement of grounds of appeal was filed before 1 January 2020 and the replies thereto were filed in due time. Thus, in view of Article 25(2) RPBA 2020, Article 12(4) to (6) RPBA 2020 does not apply, but instead Article 12(4) RPBA 2007 applies to both the grounds of appeal and the replies.
11. The appellant has argued for the first time in appeal proceedings that the priority is validly claimed, even if the requested correction would not be allowed. The appellant takes the view that in a case like this it is sufficient that all the inventors, named as applicants of the priority application, are among the applicants of the later PCT application, even if for the designation US only. The priority right-owning applicants thus introduced the priority right into the PCT application with full effect for that application as a whole. As the board understands it, the appellant bases this "joint applicants approach" in particular on Article 11(3) PCT and Articles 118 and 153(2) EPC.

12. This line of argument is not based on any new facts or evidence, but represents a fresh legal view. Neither does this line of argument, as was argued by respondent II, involve a new request to recognise the priority right as valid even without the correction. It is merely another argument why the claimed priority is valid and the claimed subject-matter is novel. The board therefore sees no reason nor power on the basis of Article 12(4) RPBA 2007 to hold the line of argument inadmissible.

Third party observations received on 14 January 2022 and 25 January 2022 for both cases

13. These observations concerning the priority issue were received after the debate had been closed at the conclusion of the oral proceedings in the consolidated cases. The board decided not to take their contents into account in the present proceedings.

The joint applicants approach in both cases

14. In view of the foregoing the assessment of the so-called "joint applicants approach" is decisive for the decision in both cases.
15. The "joint applicants approach" concerns, in the most simple case, the situation where a party A is applicant for the priority application and parties A and B are applicants for the subsequent application in which the priority right is invoked. Party B can now benefit from the priority right to which their co-applicant party A is entitled. A separate transfer of the priority right to party B is not needed.

16. The joint applicants approach has been developed in the case law of the Boards of Appeal, see decision T 1933/12, reasons 2.4. See also the Guidelines for Examination in the European Patent Office A-III 6.1. As far as the board is aware, this approach to European patent applications has never been contested by any interested party.
17. The appellant essentially argues that the joint applicants approach, which is applicable to European patent applications, should also apply to PCT patent applications. To distinguish the factual situation from the one that concerns a European patent application, the present situation could be referred to as the "PCT joint applicants approach".
18. A further distinction is noted here to avoid confusion about terminology concerning the factual situation underlying for example the CRISPR-Cas case, T 844/18. As apparent from the written reasons for the decision in this case priority was denied based on an extensive analysis of the relevant facts and law. It was decisive that the priority claim failed to meet the requirement that all applicants of the priority application must also be applicants of the subsequent PCT application for which the priority is claimed (the "all applicants approach").
19. As to the merits of the appellant's line of argument in the present case, the board is aware of several appeal cases in which the PCT joint applicants approach is (or has been) a disputed concept. The board refers for example to communications issued by the boards in cases T 2749/18, T 2842/18, T 1837/19 and T 845/19. The board is further aware that the approach has been followed in a number of cases before opposition divisions, whether

or not referring to the *Notice from the European Patent Office concerning the requirements to be observed when filing an international application with the EPO as a PCT receiving Office*, OJ 2014, A33, III, 9 (see for example documents A2 to A7, filed by the appellant). The issue therefore concerns a point of law of fundamental importance relevant to a number of cases at present pending before opposition divisions and boards of appeal. Although legal requirements for patent applications in the US have changed, thus leading to a reduction in the number of cases in which the facts are similar to those in the present case in the future, the issue will remain of major importance for many years to come. In addition, the answer to the question of whether the PCT joint applicants approach can be accepted as suggested by the appellant is not clear cut. The board therefore finds it appropriate to refer a question concerning the PCT joint applicants approach to the EBA, as requested by all parties.

Questions to be referred as formulated by the parties

20. The appellant has requested that the following questions be referred to the EBA:

i) When acting as a designated or elected office under Art 153 EPC, does the EPO have the jurisdiction to examine the entitlement to and/or the formal validity of a priority claim, as opposed to substantive issues of priority? If no, what is the appropriate legal forum in which a priority claim can be challenged on formal grounds? If yes:

ii) When acting as a designated or elected office under Art 153 EPC and assessing the entitlement to priority of a Euro-PCT application which claims priority from a

first application filed in a member state of the Paris Convention, under which legal framework should the EPO assess priority entitlement (a) if said member state of the Paris Convention is not an EPC contracting state, and (b) if it is?

iii) Provided all of the applicants for a priority application are applicants for a PCT application, can priority rights be established by the naming of a joint applicant for the PCT application who is not a joint applicant for the PCT application's EPO designation (the "joint applicants approach")?

21. Respondent I requested that the following questions be referred to the EBA:

iv) When acting as a designated or elected office under Art. 153 EPC in respect of a PCT application, is the EPO competent to determine who is "successor in title" under Art. 87(1) EPC when a first (priority) application was filed in the name(s) of the inventor(s)? If, yes;

v) Provided all of the applicants for a priority application are applicants for a PCT application, can priority rights under Art. 87(1) EPC be established by the naming of a joint applicant for the PCT application who is not a joint applicant for the PCT application's EPO designation (the "joint applicants approach")?

vi) Can a person with no substantiated ownership interest in the priority right derived from a priority application challenge a patentee's status as successor in title to the priority rights derived from that application?

22. Respondent II requested that the following questions be referred to the EBA:

vii) In the case a first application was filed by a plurality of applicants and a subsequent PCT application was filed by the same applicants or successors in title, is a transfer of the right to priority required for the Euro-PCT application in order to be entitled to the priority of the first application, if not all of the applicants of the PCT application are applicants for EP?

viii) In the case a first application was filed by an applicant and a subsequent PCT application was filed by a plurality of applicants or successors in title including the applicant of the priority application, is a transfer of the right to priority required for the Euro-PCT application in order to be entitled to the priority of the first application, if the applicant of the first application is not applicant for EP?

ix) If the answer to question (1) or (2) is no, are there any requirements to be fulfilled other than that the applications were effectively and timely filed and the requirements of Rules 52 and 53 EPC are met?

x) If the answer to question (1) or (2) is yes, are there any possibilities for substituting the formal proof of transfer of the right to priority within the priority year?

23. Respondent II supported the requests of the appellant and respondent I that the questions to the EBA should include a question regarding the jurisdiction of the EPO to decide on the entitlement to the priority right,

but did not formulate a particular question in this respect.

24. The jurisdiction of the EPO to decide on the entitlement to the priority right has been addressed extensively in the CRISPR-Cas case, T 844/18. The core of the decision on this point can be found in point 18 where it is reasoned that there is no legal basis to relieve the EPO from the obligation to assess who has performed the act of filing the patent application as required by Article 87(1) EPC. The board in the present composition is inclined to agree with this conclusion. It is also rightly pointed out in decision T 844/18 that "*The bar to overturning long established case law and practice should be very high because of the disruptive effects a change may have*" (see point 86). Although this remark concerned the application of the "all applicants approach", the same applies to the standing practise of the boards of appeal to decide on the priority rights in general, including the entitlement to the priority right.
25. In the present case, the jurisdiction of the boards to decide on the entitlement to the priority right had not been explicitly questioned during the written proceedings. Indeed, none of the parties presented arguments in their written submissions why the present standing practise is incorrect or why the reasoning in, for example decision T 844/18, is incorrect other than a reference to decision J 11/95 made by respondent I. This latter decision mentions the issue only in obiter and provides no reasons for the approach taken. It also seems to focus on the ownership of the priority invention rather than on the assessment of the priority claim. The board therefore does not find the position

taken in J 11/95 a convincing argument in favour of the view that the EPO has no jurisdiction.

26. However, the jurisdiction of the EPO to decide on the entitlement to the priority right has been questioned, *ex officio*, in communications of the respective boards in several cases like T 239/16, T 419/16 and T 845/19 and also in commentaries (see Bremi, in Singer/Stauder/Luginbühl, EPÜ, 8. Auflage, Art. 87, Rdn 61). For example in cases T 239/16 and T 419/16 a parallel was drawn with reference to the *Travaux Préparatoires* between the power to determine whether a party is entitled to a particular patent application, which the EPO does not have, and the power to decide on the entitlement to the priority right. In view of the above, the issue will therefore, in spite of the decision in case T 844/18, most likely be raised again in other cases. The board is also receptive to the argument of the parties that, if questions regarding priority are to be referred to the EBA on a related matter, this is a convenient opportunity to have a final decision on the "jurisdiction issue" as well. The board therefore decides to include a question addressing the jurisdiction of the EPO to decide on the entitlement to the priority right.

27. As the further aspects of the PCT joint applicants approach are concerned (such as the status of the party that challenges the priority right or different approaches for a priority right application filed in a EPC Contracting State and for one filed in an non-EPC Contracting State), the board notes that it is appropriate to only refer questions that are relevant for the decision in a given case. These should also be specific enough to allow a clear answer that can be applied directly to the case. Questions ii, vi, ix and

x as formulated by the parties (see above) are not relevant in the legal and factual framework of the present cases or need no separate answer beyond that required by the further question as formulated in the Order. Question iii, v, viii and viii address the same aspects as the question formulated by the board, be it in somewhat different wording.

Legal basis for the PCT joint applicant approach?

28. The following sets out the further considerations of the board regarding the issues raised.
29. During the oral proceedings, three possible legal bases for the PCT joint applicant approach were discussed.
30. Firstly, the appellant has argued that the joint applicants approach can be applied to the present situation, relying in particular on Article 11(3) PCT and Articles 118 and 153(2) EPC. This was because Article 11(3) PCT provides (*inter alia*) that the international application shall have the effect of a regular national application in each designated State. This provision is mirrored in Article 153(2) EPC. Article 118 EPC reads: "*Where the applicants for or proprietors of a European patent are not the same in respect of different designated Contracting States, they shall be regarded as joint applicants or proprietors for the purposes of proceedings before the European Patent Office. The unity of the application or patent in these proceedings shall not be affected; (...)*". (The board notes that in the present case Article 118 EPC 1973 applies. This provision however is identical to that in the EPC 2000.)

31. This line of reasoning does not convince the board. The present situation, where not all of the applicants for the PCT application are applicants for a European patent, is materially different from that of a regular European application. Assuming that Article 118 EPC provides a legal basis for the joint applicants approach, then its effects are limited to the applicants of a European patent, in the present case the appellant and the University of Western Ontario. Neither Article 11(3) PCT nor Article 153(2) EPC provide that PCT applicants for a different territory - in the present case the inventors as applicants for the United States - shall be regarded as applicants for all other designated territories as well. On the contrary, the possibility of designating different applicants for different designated States (see PCT Regulation Article 4.5(d)) must necessarily mean that the status as an applicant is limited to the designated territories. Article 118 EPC can therefore in the opinion of the board not be applied to the present situation.
32. Secondly, respondent I argued that a PCT joint applicants approach can be based on the unitary character of the priority right in the PCT and thus on the operation of the PCT alone.
33. The board cannot see merit in this argument either. The PCT does not create rules of its own regarding the effect of a priority claim but refers to Article 4 of the Paris Convention (Article 8(2)(a) PCT). The validity of the PCT joint applicants approach should therefore, in the view of the board, be assessed in the light of the Paris Convention, in particular the meaning of term "successor in title", rather than the PCT.

34. The appellant furthermore submitted the judgement of the Court of Appeal (CoA) of The Hague in the case *Biogen/Genentech v. Celltrion* (Gerechtshof Den Haag 30 July 2019 , ECLI:NL:GHDHA:2019:1962). This decision offers a third viewpoint that could possibly lead to the conclusion that the PCT joint applicants approach should be acknowledged.

35. The case concerned the validity of a priority claim invoked by Biogen in a PCT application on the basis of a priority application filed by two other parties. It was argued that the right to priority had been assigned to Biogen. It was undisputed between the parties that the validity of the assignment had to be assessed according the law of Massachusetts.

36. The CoA disagreed. It reasoned in essence that the *lex loci protectionis* was applicable to the right to priority because according to Article 2(1) of the Paris Convention, the requirements for granting and nullification of patents in a particular country were determined in accordance with the national law and the right to priority was part of such requirements. In case of a European patent which was granted on a PCT application the *lex loci protectionis* was the EPC. The EPC did not require particular formalities for assignment of the right to priority. Proof of an agreement of assignment of the right to priority sufficed. In the case before the Dutch court, such an agreement was part of an "*Employee Proprietary Information and Inventions and Dispute Resolution Agreement*".

37. This approach seems appealing as it provides for a harmonised and well founded assessment of an alleged transfer of the priority right. However, an issue with

this approach lies in the uncertainty regarding the legal system that is applicable to the assessment of the transfer of the priority right: in several decisions of the boards of appeal, the legal requirements for the transfer of the priority right by agreement have been assessed applying national law. In spite of this, it is far from clear that this is correct, as the EPC does not contain any conflict of laws-rules and this issue has so far not been addressed by the EBA. A separate question relating to conflict of laws-rules to be applied to a transfer of the priority right is nonetheless not necessary because it is inherently contained in the questions posed and it will be addressed in the considerations of the EBA, as needed.

38. Were the EBA to share the view of the CoA that the legal system to be applied to assess the priority right is solely the EPC, then it seems that the EPC does not, in Article 87 EPC or elsewhere, impose any formal requirements for the transfer of the priority right by agreement (see also decisions T 1201/14, reasons 3.2.1 and T 205/14, reasons 3.6.2 and 3.6.3, dealing with the same issue). In that case it could be argued that the mutual filing of a PCT application by parties A and B, wherein party B is named as the applicant for the EPC territory and party A (who is entitled to the priority right) is named as the applicant for the US, demonstrates - absent indications to the contrary - the existence of an implicit agreement between party A and party B, conferring on party B the right to benefit from the priority for the EPC territory. This implicit agreement could possibly be sufficient to bring about the transfer of the priority right to party B for the EPC territory.

39. On the other hand, in case a particular national legal system were applicable, then a priority right could still be considered validly transferred to party B if the applicable system does not require any formalities either.
40. Respondent II referred the board to the judgment of the Bundesgerichtshof (BGH) of 16 April 2013 in case X ZR 49/12 (Fahrzeugscheibe) which reflects a similar line of thinking as far as the implicit agreement to transfer the priority right is concerned. The case concerned the validity of the German part of a European patent that claimed priority of a national German patent application, filed by a company within the same group of companies as the patent proprietor. The patent proprietor argued that the priority had been properly transferred as a result of a research and development agreement between the companies. The BGH held (1) that the transfer of the priority right is a matter of the applicable German conflict of laws-rule, in this case, at the time of transfer, Article 33 (2) EGBGB (Einführungsgesetz zum Bürgerlichen Gesetzbuch; translation: Introductory Act to the Civil Code) (until 17 December 2009; later: Article 14(2) Rome I Regulation). It then held (2) that in accordance with the applicable conflict of laws-rule German national law applied to the transfer of the priority right as the law applicable to the priority application and (3) that German law did not require any particular formalities for the transfer. After having further established that Article 87 EPC does not require such formalities either, the court then assessed the facts of the case that led it to the conclusion that there was an implied agreement ("konkludente Einigung") between the parties to transfer the priority right to the applicant, which was

sufficient to acknowledge priority for the European patent.

41. Less illustrative for this approach, but supporting the view that the PCT application could be regarded as proof of an agreement to transfer the priority right is the UK judgment *KCI Licensing Inc and others v. Smith & Nephew PLC and others* (case HC09C02624) of 23 June 2010, which respondent I has referred to in their submissions. In this case, two European patents claimed priority from a US patent application, filed by the inventor. The subsequent PCT application designated the inventor as the applicant for the US, the proprietor of the subsequent European patents KC Inc as applicant for all designated States except the US and a subsidiary of said proprietor of the patents, Mediscus, as applicant for "GB only". It was concluded that KC Inc had the right to claim priority and that Mediscus was not a co-applicant in respect of the PCT application in so far as it related to the European patents. However, even if Mediscus had to be considered a co-applicant, this would not adversely affect the claim to priority, although there was no evidence of any assignment of the priority right from KC Inc to Mediscus. The reason for this was the implied agreement which could be inferred from the PCT application. The judgment at paragraph 98 states: *"Counsel for KCI accepted that he could not point to any written assignment, or even an oral agreement, but argued that the correct inference to be drawn from the circumstances surrounding the filing of the PCT Application was that KC Inc had agreed by conduct to transfer part of its interest in the invention to its subsidiary Mediscus. He submitted that this was sufficient to make Mediscus a successor in title for the purposes of claiming priority, and that no greater degree of formality was required. I accept*

that submission." Although this reasoning is an *obiter dictum*, it does indeed, as respondent I argued, support the qualification, in certain circumstances, of the PCT application as an instrument of transfer of the priority right.

42. In view of all the foregoing, guidance on the priority issue is needed to come to a decision in the present cases.
43. In the following questions reference to "party A" and "party B" is done for ease of understanding and is not intended to as limiting the considerations to scenarios involving only two parties.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal:

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1) (b) EPC?

II. If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC

in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

The Registrar:

The Chair:



I. Aperribay

G. Alt

Decision electronically authenticated