

# The Doctrine of Partial and Multiple Priorities, especially from the standpoint of Toxic Priority

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*"It's never as simple as it seems at the beginning, or as hopeless as it seems in the middle...or as finished as it seems at the end."*

## 0. Introduction & Overview

0.1 Priority is a fundamental issue for IP practitioners. Its importance is marked by case law of the Enlarged Board of Appeal (EBA) in mid-1994 (G0003/93) and mid-2001 (G0002/98) and by a greater number of lower board decisions spanning longer. But this doesn't stand priority out much from the crowd: it might be seen as normal background noise, with one or two louder highlights, to be expected following the reforms of the 1970's.

0.2 Self-publication has always been the most dangerous form of anticipation risk – who else is more likely to be in a position to disclose the precise subject-matter on which an innovator is working than the innovator himself. The good news is it can be controlled – policy and process can anticipate what can go wrong and ensure it doesn't happen unacceptably often. Toxic Priority<sup>1</sup> is self-publication without the good news. Its existence was unrealised and so beyond control. Once realised, implementation of its management required a lot of thought and much delay. There was also historic toxicity requiring consideration. Toxic Priority therefore received a lot of concerned "*public*" attention, which explains why, in a paper about the wider topic of partial/multiple priorities, centre stage is occupied by that sub-topic and solutions for it.

0.3 A recap and overview may be helpful, particularly with readers outside EPC in mind:–

- So-called *whole contents* anticipation occurs in EPO proceedings if a claim in patent/application A encompasses subject-matter disclosed in patent/application B and the priority date of the claimed matter in A falls between the publication and priority dates of the cited matter in B.
- The citation has no effect unless published but the effect is as of the cited subject-matter's priority date.

- The two patents/applications may be members of a divided family or priority group, in which case priority is said to be "*toxic*".
- Toxicity may occur eg when a claim is broadened on parent filing relative to the priority document and the parent later divided; the broadening results in the parent claim losing priority whilst the division produces a specification some content of which retains priority and falls within the parent claim as an anticipation (T1496/11). The toxicity may be worse when a claim is narrowed by inclusion of features not disclosed in the priority document.
- In the case of a divided family, the citation is any published family member, as in the example just given. In the case of a priority group, it is a published priority document.
- The root of the problem resides in the priority system on which EPC relies. The solution is in the same place<sup>2</sup>.
- Priority-based solutions rely on a less than wholly clear set of precedents on assessment of partial/multiple priority date entitlement. However, recent case law sets out a convincing new approach. If adopted as the rule, this provides a helpful framework for addressing Toxic Priority although, as explained in this paper, it is not a solution for every instance.

Radical changes in legal landscape – new legislation or EBA opinion – have been suggested. These offer no speedy assistance, are unlikely to be retroactive, depending on reach are arguably unnecessary<sup>3</sup> and could be retrograde (eg special treatment of divided families/priority groups, creating tiers of proprietor and risk of abuse).

## 1. FICPI Memorandum to T1222/11

### 1.1 FICPI Memorandum

1.1.1 The FICPI Memorandum<sup>4</sup> summarizes the 1973 position of the contracting states. It sets out the strategic proposition that "OR" claims should conditionally be entitled to enjoy<sup>5</sup> plural priority dates reflecting different subject-matters<sup>6</sup>. The individual *domains* would fall to be tested against prior art individually based on their priority dates and subject-matter content.

2 Disclaimers (not covered here) may also prove useful

3 The front line question of how partial and multiple priority date entitlement should be assessed is, to the contrary, highly desirable

4 *Memorandum M/48/II, Section C, Préparatoires Travaux EPC1973* (<http://tinyurl.com/oaey9ry>)

5 The FICPI Memorandum is the antecedent of Article 88 (2) EPC and both are about *claiming* priority. Article 88 (3) EPC is about what subject-matter will *enjoy* the priority right claimed. As the FICPI Memorandum continues, its direction changes towards *enjoyment* of priority rights

6 FICPI Memorandum, Section I, page 1 (opening paragraph in particular) and page 2 (central part dealing with "OR" claims)

1 Submitted October 2014, re-submitted February 2015

See the following 2010 and 2011 papers and EPO Appeal Decision T1496/11 :-

(1) "*Poisonous EPC Divisionals (Just as you thought it was safe ...)*", Malcolm Lawrence, *Inventive Steps*, Issue No 2, HLBBSHAW, December 2010 [<http://tinyurl.com/krlgwt5>]

(2) "*Poisonous EPC Divisionals – Implications for Risk Management and Opportunistic Advantage*", Malcolm Lawrence & Marc Wilkinson, *Journal of the European Patent Institute (EPI Information)*, Volume 2/11, June 2011, 54–61 [<http://tinyurl.com/luan2s4>]

1.1.2 The rationale for the proposition<sup>7</sup> is that proper enjoyment of priority rights requires statutory permission for plural priorities for a single claim to avoid to the less desirable use by patentees of claim multiplicities to maximize priority opportunities.<sup>8,9</sup>

1.1.3 The memorandum gives separate visibility to “*partial priority*” (where a domain of the claim is disclosed in a priority document but the remainder of the claim scope is not) and “*multiple priorities*” (where basis for different domains is supplied by respective priority documents). However, the memorandum<sup>10</sup> seems clear they should receive the same treatment<sup>11</sup>.

1.1.4 In addition to introducing the broad idea of partitioning claims into domains, the FICPI Memorandum makes specifically clear that some claims should be partitioned into *virtual* domains across broadly defined integers.<sup>12</sup>

1.1.5 Examples (a), (b) and (c) of the memorandum contain useful illustrations. They are properly referred to by others (eg T1222/11). But it isn’t necessary to drill through the memorandum’s strategic sweep into this supporting detail to discern the strategic legislative intent of Article 88(2) EPC. There’s a tendency to attach too much weight to the FICPI Examples (eg see both the opposed positions in Pearce & Fulconis<sup>13</sup>).

## 1.2 Article 88 (2) EPC

1.2.1 The FICPI Memorandum concludes by proposing language providing for multiple priorities in EPC. This language was adopted largely unchanged in EPC:

**FICPI proposal:** “... *Where appropriate, multiple priorities can be claimed for one and the same claim of the European patent*”

**Article 88(2) EPC:** “... *Where appropriate, multiple priorities may be claimed for any one claim. Where ...*”

1.2.2 The FICPI Memorandum makes a separate proposal for “*partial priority*”, not taken up in EPC. In the context, the EP filing itself supplies the priority date for

subject-matter not disclosed in a priority document. EPO appeal board opinion is that partial priority needs no legislative platform beyond Article 88(2),(3) EPC<sup>14</sup>.

1.2.3 Making assignment of priority dates to parts of claims subject to the qualifying phrase: “*Where appropriate ...*” was motivated by perception that multiple priorities for “*AND*” claims needed to be excluded<sup>15</sup>. However, the wording agreed by member states is self-evidently more general; it’s clear that the wider scope was intended by the contracting states, precise implementation to be left to EPO tribunals.

## 1.3 Interaction of EPC with the Paris Convention (“PC”)

1.3.1 EPC is a “*special agreement*” under Article 19 PC. The latter provides that such agreements are subject to the proviso that they “*do not contravene the provisions of*” PC. The position of EPO appeal boards has always been that EPC complies with this proviso.

1.3.2 But it may be wondered how Article 88 (2) EPC complies with Article 4B PC, which provides priority-claiming applications with what at a glance is general immunity from acts during the priority interval:–

“... *any subsequent filing ... before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention ...*”

1.3.3 The generally stated objective in Article 4B PC must be interpreted having regard to other provisions of PC, which make clear that there are circumstances where priority may be prejudiced:

- Article 4H PC qualifies Article 4B PC and provides, according to G0002/98, Reason 4, that priority for a claim can be refused “... *if the subject-matter of the claim ... “is not” ... specifically disclosed ... in the application documents relating to the disclosure ... of the application whose priority is claimed*” – for example, by the claim encompassing an embodiment not disclosed in the priority document.
- Article 88 EPC (construed per G0002/98) disapplies priority only in more restricted circumstances than permitted by Article 4H PC (ie only when the situation is, to paraphrase Article 88 (2) EPC, not one “*Where (it is) appropriate*”). This makes Article 88 (2) EPC compliant with Article 4H PC and thus, indirectly, with Article 4B PC.

1.3.5 Seen at the highest level, of course, treaties on the scale of EPC tend to have lives of their own and function with a degree of prepossession; appeal boards have always been firm that EPC contains “*a complete self-contained code of rules of law on the subject of claiming priority*” (G0002/098; J0015/80; T02473/12).

7 The memorandum builds the proposition in the series of paragraphs commencing with that bridging pages 1 and 2

8 Plural priorities for a single claim and claim multiplicities are doubtfully perfect equivalents: it would be a rather idealised claim multiplicity which achieved entirely what the flexibility of permitting plural priority dates for one and the same claim can achieve, even taking account of restrictions imposed on the latter by the “*limited number*” test of G0002/98, Reason 6.7. Depending on when such a claim multiplicity is added to a specification, one might also expect sizeable challenges in terms of new subject-matter objections (Article 123(2) EPC)

9 The key paragraph bridges pages 3 and 4; claim multiplicities are described as “*frivolous*”

10 FICPI Memorandum, page 6, second sentence

11 Reason 11.6 of T1222/11 also makes clear that “*partial priority*” and “*multiple priorities*” are to be treated in principle in the same way. The EPO Guidelines for Examination (in both the September 2013 and November 2014 versions) are curiously silent on the concept of “*partial priority*”, but this is no doubt because no procedural matter turns on it and because the interaction of priority and the state of the art can be exemplified without reference to it

12 FICPI Memorandum, page 2, second paragraph following central panel, expressly stating that “*it is, of course, immaterial whether the word ‘or’ actually occurs in the claim*”

13 “*Opposing Views on Partial Priority*”, David Pearce and Renaud Fulconis, Journal of the UK Chartered Institute of Patent Attorneys (CIPA Journal), Volume 42, No 12 (December 2013), 716–720

14 According to Reason 11.6 of T1222/11, assessment of priority is no different whether there is a single or multiple priority dates claimed

15 FICPI Memorandum, page 5, second paragraph and central panel

## 1.4 G0002/98 and T1127/00 vs T1222/11

1.4.1 G0002/98 interprets the imprecise language of Article 88(2) EPC, stating that generic terms may be used to encompass domains of different priority date only if the “*limited number*” and “*clearly defined*” tests of Reason 6.7 are satisfied:

**Reason 6.7 of G0002/98 (partial, emphasis and [ ] added):** “... these two priorities may also be claimed for a claim directed to C, if the feature C, either in the form of a generic term or formula, or otherwise, encompasses feature A as well as feature B. The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters [ie domains].”

1.4.2 Where the limited number of clearly defined alternative subject-matters are to be found is not specified. There are two alternatives:

**T1222/11:** the domains of a claim are clearly defined bodies of subject-matter which, in the case of domains which enjoy priority, are disclosed in a priority document as seen through the lens of the G0002/98 Conclusion test<sup>16</sup>, <sup>17</sup>; as contained in the priority document, the latter may conveniently be termed “*pre-domains*”.

**T1127/00:** G0002/98 intended the domains *inter alia* to be “*clearly defined*” in the specification whose claims are under priority date assessment<sup>18</sup> – as well as disclosed in the priority document.

1.4.3 At the general level, Reason 11.5 of T1222/11 accepts the principle of the “*limited number*” and “*clearly defined*” tests; the tests are expressly accepted at Reason 11.5.3 as “*obviously necessary*”.

## 1.5 Support for, and views against, the T1222/11 approach

1.5.1 The approach set out in T1222/11, advocated elsewhere<sup>19</sup> by this writer as the preferred approach, has now been approved by another appeal board in T0571/10 (November 2014). The decision is in line with what is understood<sup>20</sup> to be *general* EPO Technical Boards of Appeal sentiment towards the T1222/11 approach to

split priority. It appears to be the only appellate EPO decision in support of T1222/111 so far. However, T1222/11 was decisively applied by an opposition division in December 2013 in the case of EP2157457, the opposition division having issued a preliminary view in favour of the patentee after having issued an unfavourable view before becoming aware of T1222/11<sup>21</sup>.

1.5.2 Moreover, there seems to be good intellectual and practical support for the T1222/11 approach, which makes much more sense than T1127/00 *et al*:–

- The language in Reason 6.7<sup>22</sup> refers to claimed “*features*” A and B as entitled to the priority dates of priority documents respectively disclosing them, even when a generic expression C encompassing them is used in the claim. The EBA is referring to the “*elements*” of the claim, in the sense of *embodiments*, mentioned in Article 88 (3) EPC<sup>23</sup> and uses the term “*features*” with this intent. In this context, the proviso that the expression C must “*give rise to*” only a “*limited number of clearly defined alternative subject-matters*” logically refers to the domains of the claim, and the *embodiments* they define, visualised with reference to (the pre-domains of) the priority documents according to Article 88 (3) EPC, without the additional qualification of T1127/00.
- The “*alternative subject-matters*” referred to in G0002/98 cannot sensibly refer to members of the theoretical mass of features a generic expression comprehends. Although finite in number, their numerousness in many cases would make compliance with the “*limited number*” test unrealistic, and it could not have been intended<sup>24</sup> by the legislature or G0002/98 that claims using broad generic terminology should not benefit from Article 88 (2), (3) EPC. According to T1222/11, the number of domains is limited by the number of pre-domains chosen<sup>25</sup> in the priority document(s).
- G0002/98 expressly states that a claim may be split across the scope of a generic expression for priority date assessment purposes. It would be a contradiction in terms to construe the decision as requiring the *claim* concerned then to identify – ie “*clearly define*” – the

16 T1222/11, Reason 11.5.2, second sentence: “... the words ‘gives rise to the claiming of a limited number of clearly defined alternative subject-matters’ refer to the ability to conceptually identify by said comparison [of the claimed subject-matter of that „OR“-claim with the disclosure of the multiple priority documents] a limited number of clearly defined alternative subject-matters to which the multiple rights of priority claimed can be attributed or not.” Note that resolution of the claim into domains includes those not entitled to priority

17 G0002/98’s Conclusion stipulates that the test for whether subject-matter is disclosed in a priority document is the same as the test applied when assessing whether an amendment to a patent/application adds subject-matter

18 T1127/00, Reason 6

19 “A Review of priority Date Assessment under EPC”, Malcolm Lawrence, Journal of the European Patent Institute (EPI Information), Issue 3/13, September 2013, 89–102

20 Personal communication

21 T1222/11 was applied to address a Toxic Priority attack

22 To understand the proviso to Reason 6.7 of G0002/98, it’s essential to read the whole Reason to gather context

23 G0002/98, Reason 4, second paragraph establishes correspondence of meaning between “*element*” and “*embodiment*”. It is suggested by this writer that both are also equivalent to “*subject-matter*” – Reason 11.8 of T1222/11, for example, refers to “*subject-matter*” (in the sense of “*alternative subject-matters*” as used in Reason 6.7 of G0002/98) and reads in part: “It is therefore concluded that ... the decision on whether priority can be acknowledged for this **subject-matter**, i.e. for this **embodiment** covered by the „OR“-claim, is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the „OR“-claim of the European application as a separate alternative embodiment.”. In short, *element* = *embodiment* = (*alternative*) *subject-matter* = *pre-domain* = *domain*

24 See “A Review of priority Date Assessment under EPC”, *supra*, Paragraph 4.2 (ii)

25 See Paragraph 2.3

“alternative subject-matters” (per T1127/00 *et al*) which would result.<sup>26, 27</sup>

- Whether (i) subject-matter claimed in a priority application is entitled to priority and (ii) an application (P1) from which it claims priority is, as between it and an even earlier application (P0), the first application for the purpose of Article 87 (1) EPC, must be tested in consistent manner – see G0002/98, Reason 8.4 *et seq*<sup>28</sup>. The test in (ii) is a novelty test on P1 and does not depend on whether the relevant subject-matter disclosed in application P0 is *identified* in the P1 application. The T1222/11 approach is consistent with G0002/98, Reason 8.4 *et seq*<sup>29</sup> – those in T1127/00 *et al* are not.

1.5.3 The T1222/11 approach seems supported by Kitchen J in *Novartis AG v Johnson & Johnson Medical Limited* [2009] EWHC 1671 (Pat) in the UK Patents Court. Paragraph 122 of the judgement includes the following passage which, though falling short of saying that that a domain does not have to be identified as such in the patent under assessment, is so framed as to leave not much doubt that it was intended to express *all* the conditions for a virtual domain to benefit from the multiple priority provisions of Article 88 EPC:–

*“I discern from this passage that the EPO considers it is permissible to afford different priority dates to different parts of a patent claim where those parts represent a limited number of clearly defined alternative subject-matters and those alternative subject-matters have been disclosed (and are enabled) by different priority documents. Further, this principle applies even if the claim has adopted a generic term to describe and encompass those alternatives. I do not detect anything in the decisions of the Court of Appeal in *Pharmacia and Unilin Beheer* which is inconsistent with this approach and in my judgment is one which this court should adopt.”*

1.5.4 On the negative side, the deciding board in T2311/09 (September 2013) did not follow T1222/11, denying partial priority in Reason 4 based on the approach in the T1127/00 decision cluster. Lessening the authority of T2311/09, T1222/11 appears not to have been asserted and the board did not have the benefit of hearing oral argument as there were no oral proceedings.

1.5.5 In addition, in terms of professional community debate, *Pearce & Fulconis* (“*Narrow Interpretation*”) *supra*<sup>30</sup>, argues against T1222/11:–

26 This particular criticism of T1127/00 evaporates if the view taken is that this case law calls for the “alternative subject-matters” to be identified elsewhere in the specification than the claim in question

27 See „*European Patent Office (Technical Board of Appeal 3.3.07): Poisonous divisional applications – is the bogey going to disappear? (Decision of December 4, 2012 – Case T 1222/11 – Hair cosmetic composition/KAO)*”, Rudolf Teschemacher, IP Report 2013/IV, Autumn 2013, Bardehle Pagenberg

28 See also T0477/06, Reason 4 and T0454/01, Reason 2.4.4 and the subsequent discussion of selection novelty in the context of applying Article 87(1),(4) EPC

29 See T1222/11, Reason 11.8

30 *Pearce & Fulconis* appears intended by its authors to be provocative in the interests of further debate

- The concept of “*imaginary claim splitting*” is argued to be irreconcilable with the “*disclosure test*” as particularly set out as the so-called “*golden standard*” in G0002/10<sup>31</sup>. This is incorrect:

- The combination of the FICPI Memorandum, Article 88 (2) EPC and Reason 6.7 of G0002/98 make it clear that parts of a claim are to be recognised as different “*subject-matters*” enjoying different priority dates – even if they fall within a generic expression the claim uses to encompass them as opposed to being specifically disclosed in it. This powerful trio takes outside the disclosure test the question of visualizing virtual domains in a claim.

- G0002/10 (eg Reason 4.5.3, partially quoted in *Pearce & Fulconis*), concerns subject-matter changes arising from either transiting a specification from original to amended form or from priority document to priority-claiming application. Contrastingly, virtualisation of a domain within a claim does not occasion any such tangible action and does not even involve exercise of linguistic expression – it’s merely an intellectual exercise.

- The “*limited number*” and “*clearly defined*” tests of G0002/98 are asserted to be a “*silent condition, which is necessarily met and can therefore be ignored in practice*”.<sup>32</sup> This is also incorrect:

- There is a real risk one or both tests may be failed, as explained later in this paper<sup>33</sup>.

## 1.6 Looking Forward

1.6.1 The conflict between T1222/11 and the T1127/00 cluster of decided cases has now been referred to the EBA by the responsible board in T00557/13, with both parties to the opposition appeal consensual<sup>34</sup>. The conflicting decisions had been debated in some depth in writing and at oral proceedings. The context is a fuel containing 0.001 % to 1 % to of a cold flow improver defined by reference to a formula. The priority document recites a narrower 0.01 % to 1 % range for the content of flow improver and defines the flow improver itself in several ways, the formula in the claim of the opposed patent having been held by the opposition division to be an intermediate limitation. The patentee seeks to resolve the claim virtually into a priority-entitled domain which recites the flow improver chemically and quantitatively as submitted to be disclosed in the priority document, and a non-priority domain for the remainder of the claim.

1.6.2 Things are looking hopeful. But prophecy is never easy, and notwithstanding the merits of T1222/11 and the latest appellate support for it in T0571/10 *supra*, too

31 *Pearce & Fulconis* (“*Narrow Interpretation*”), page 719, Column 1, penultimate paragraph and the next paragraph bridging onto Column 2

32 *Pearce & Fulconis* (“*Narrow Interpretation*”), page 719, Column 1, fourth paragraph

33 It follows that the *contra* argument of *Pearce & Fulconis* (“*Broad Interpretation*”) that T1222/11 provides a complete solution for Toxic Priority is also not correct

34 See <http://tinyurl.com/pyr4uwv>. Strictly speaking, at the time of writing, the relevant board had merely made the decision (at December 17, 2014 oral proceedings) that questions of law be referred to the Enlarged Board – the content for the referral had not at that time been drafted and it appears that the referral might involve one or more other issues

much presumption is, for two reasons, a temptation to be resisted.

1.6.3 The first is the uncertainty as to what the EBA will rule and in the meantime the extent to which T1222/11 will be embraced by EPO and national tribunals, in well-argued cases. Secondly, there remains more to learn about how Article 88 (2) EPC should be implemented and the extent to which the “*limited number*” and “*clearly defined*” tests challenge success in virtualising alternative subject-matters. In this connection, for example, T1222/11 almost certainly is not a complete solution to Toxic Priority<sup>35</sup>, as explained later in this paper.

1.6.4 Avoidance of T1127/00’s restriction that a domain in a claim must have basis in individualized form in the specification containing that claim substantially magnifies the pool of priority document content which can be used to construct a domain – see later paragraphs of this paper. Assuming T1222/11 is adopted as the correct approach, it’s therefore outcome-changing in ways which should be very meaningful in crowded technology areas where multiple priorities are common, commercial significance high and much depends on parties succeeding with priority assertions in dealing with cited art.

1.6.5 It’s worth taking stock at this point, however, by asking two questions:–

- Is Toxic Priority a valid issue worth worrying about?
- Is it a material or an orphan issue?

### Validity of Toxic Priority as an IP Risk

1.6.6 The most common challenge to Toxic Priority as a valid IP risk has been that it was never intended that members of a divided family should come into *whole contents* conflict under Article 54 (3) EPC<sup>36</sup> (*Poisonous Divisions*), with analogous challenge to member-to-member conflict in priority groups (*Poisonous Priority Documents*). The absence of carve out provisions<sup>37</sup> weakens both propositions. However, the most formidable argument against the first is that treating divided families in a privileged way would create two tiers of patent applicants<sup>38</sup>. Those who file applications divided in prosecution would experience an attenuated application of Article 54 (3) EPC; those who pre-empt division by

35 See in particular “*Review of Toxic Priority: The Poisonous Divisions Concept (et al) following EPO Appeal Decisions T1496/11 and T1222/11 and Nestec v Dualit*”, Malcolm Lawrence, Journal of the Chartered Institute of Patent Attorneys (CIPA Journal), Volume 42, No 9, September 2013, 518 – 527

36 The idea of what might be called “*divisional privilege*,” arose in the opposition to EP2157457 referred to earlier (Paragraph 1.5.1). The Opposition Division adopted the T1222/11 interpretation of Reason 6.7 of G0002/98 but gratuitously decided additionally to express some principles in favour of special treatment of divided families – doing so in a brief paper which it supplied to the parties at oral proceedings. The Opposition Division opined that the Poisonous Division effect goes “*beyond the legislative purpose of Article 54(3) EPC*”, and that it would be “*illogic (sic) to consider a parent application (or a divisional) among the documents mentioned in Article 54(3) EPC*”.

37 Article 55 EPC (Non-Prejudicial Disclosures) provides a statutory site for such a carve out, together with the carve outs already stated there

38 This is effectively the end-game of the often articulated contention that a divisional is not “*another*” application in the sense of Article 54(3) EPC (it being generally accepted that the word “*another*” is there implicit). This tends to be justified by reference to avoidance of double patenting as the legislative intention of Article 54(3) EPC. But, again, this leaves one asking the unavoidable question as to why an applicant who has divided should be better off than one who filed separate applications at the outset

filing separate applications at the outset would face its full force. The principle of fairness requires the two applicant constituencies to be treated in an equivalent way. If this argument is correct, it’s hard to take a different position on treatment of priority groups.

### Materiality of Toxic Priority

1.6.7 How many patent applications claim partial or multiple priorities? There are no statistics obviously available from WIPO on the latter subject and one might speculate on the former, on which there are none at all, that incidence might be about the same.

1.6.8 Limited and informal research to determine the proportion of PCT applications claiming plural priority dates shows the following indicative figures for slices of 200 consecutively published PCT applications published, respectively, in 2003 and 2014:

- 2003: 14.5 % of the applications in the slice claim two or more priority dates
- 2014: 21.5 % of the applications in the slice claim two or more priority dates

A repeat of 2014 for a different slice of the same size gave a figure of 17.5 % for applications claiming two or more priority dates.

1.6.9 Applying a filter to limit to slices of 200 consecutively published applications each of which claims the date of a US patent application, produced the following indicative result:

- 2003: 25 % of the applications in the slice claim two or more priority dates.
- 2014: 30 % of the applications in the slice claim two or more priority dates.

A repeat of 2014 for a different slice of the same size gave a figure of 39 % for applications claiming two or more priority dates at least one of which is a US application.

1.6.10 Whilst the above falls short of statistically conclusive evidence, it’s a clear indicator that events calling for assertion of Article 88 (2) EPC are very unlikely to be orphan events.

## 2. Domain Structure

### 2.1 Rationale

2.1.1 T1222/11, if it is generally adopted as setting out the right approach, appears to provide basis for a general *domain-based* strategy for addressing Toxic Priority, as well as having broader relevance.

2.1.2 It’s worth questioning how wide a framework it provides. The answer is that it’s quite broad but with limitations. This Paragraph 2, and much of what follows it, looks at domain structure to try to suggest what might and might not work – to some extent in an experimental way.

## 2.2 A starting point

2.2.1 Neither Article 88 (2), (3) EPC nor G0002/98 provides structural information on how a claim may be envisaged in domain terms. However, T1222/11, Reasons 11.5.5–11.5.7 discuss this in the settings of the FICPI Examples.

2.2.2 The working hypothesis emerging from that discussion is that one takes the broadest *relevant* priority document disclosure and, treating it as a pre-domain<sup>39</sup>, envisages it as a priority domain within the claim concerned. A balancing domain consists of the rest of the claim. There are therefore just two domains (“*alternative subject-matters*”) and they are mutually exclusive (abutting)<sup>40</sup>.

2.2.3 Arrowsmith & Faulkner<sup>41</sup> suggests a solution which involves *expressing* domains rather than virtualising them (at the same time doubting the legal validity of Toxic Priority as an IP concept). T0571/10<sup>42</sup> *supra*, in a slightly more complex situation, applies the principles of T1222/11. This involved a claim to a coated tablet composition of an active pharmaceutical ingredient (API) in acid or pharmaceutically-acceptable salt form together with an inorganic salt stabilizer. The board resolved the claim into (i) a priority domain in which the API is in zinc salt form and the stabilizer is in triphosphate salt form and (ii) a further (non-priority) domain representing the rest of the claim.

### NOTE 1

Taking the T0571/10 model, there will be many straightforward cases where Toxic Priority is remediable by unproblematic assertion of a domain structure. This has been facilitated by T1222/11. Contrastingly, adopting the approach of the T1127/00 stable of cases, there are significant additional obstacles to asserting such domain structure, as illustrated by those cases.

## 2.3 Patentee choice in determining Domain Structure

2.3.1 On balance, nothing in T1222/11 or Article 88 (2) EPC gives an overall impression that the approach summarised in Paragraph 2.2.2 is prescriptive as opposed to illustrative. In fact, T1222/11, Reason 11.5.3 supports the notion that domain generation will normally be citation-driven in patentee hands<sup>43</sup> having at least some freedom of choice. This is consistent with the broadly defined benefits of Article 88 (2) EPC<sup>44</sup> and is aligned with the rationale at the heart of the FICPI Memorandum – that multiple priorities are a preferred option to claim multiplicities, over which a patentee would enjoy wide freedom of choice on claim content<sup>45</sup>.

2.3.2 Figure 1 and Table 1 illustrate how freedom of choice might be used in a somewhat more complex situation than those discussed in Paragraph 2.2. In the illustration, the patent and priority document claim/disclose chemical subject-matter, an integer of which recites an alkyl group by reference to carbon atom content:–

- The claim (C1–C20 alkyl) may be resolved into:
  - abutting Domains I and II or
  - (i) Domains I, III, IV and (ii) a domain (not shown as such) representing the rest of the claim
- Domain I at E (C5–C20 alkyl) corresponds to the priority document subject-matter at B but the priority document subject-matter at C (C9–C21 alkyl) falls partly outside the claim (C1–C20 alkyl) and thus is not a pre-domain.
- Domain I should be entitled to priority. Domains III and IV correspond to the narrow pre-domains (C3 and C2 alkyl) at D in the priority document and so are also entitled to priority. Domain II (C1 to C4 alkyl) is not so-entitled as there is no corresponding pre-domain in the priority document<sup>46</sup>.
- The latter shows that, despite having only slight narrowness at one end relative to the priority document, the claim must seek pre-domains in the lower levels of the descriptive hierarchy of the priority document if it is to maximise priority opportunities.

39 The topic and its analysis is advantaged by having its own language; the expression “*pre-domain*”, as noted in Paragraph 1.4.2, seems apposite to refer to the precursor in a priority document of the “*domain*” in the claim

40 T1222/11 makes clear that in partitioning a claim into domains for the purposes of Article 88 (2) EPC, the domains in aggregate, counting both priority and non-priority domains, represent the whole of the claim (Reason 11.5.5, final sentence). See also Teschemacher *supra*, “Remarks” section

41 “*An antidote to poisonous division(al)s*”, Peter Arrowsmith and Tom Faulkner, Journal of the Chartered Institute of Patent Attorneys (CIPA Journal), March 2012

42 The decision has been reported as one in which a divisional claim was challenged by subject-matter of earlier priority date in a parent. This is inaccurate as the claim, although in a divisional application, was in fact challenged by matter in a Euro-PCT application of common priority date claim, common filing date and almost identical content but which fell outside the divided family

43 T1222/11, Reason 11.5.3: “... it is not the task of the European Patent Office to determine *ex officio* to which parts of an “OR”-claim can be attributed the right(s) of priority claimed ...”

44 But the subject is sufficiently challenging that it’s foreseeable that eg the EPO will exercise some kind of limited discretionary jurisdiction

45 As noted earlier (Paragraph 1.1.2, Footnote 8), it would be a rather idealised claim multiplicity to achieve what permitting plural priority dates for one and the same claim can achieve. But the argument that a migration of the law from one regime to the next should not materially lessen the fundamentals of patentee freedom of choice on claiming seems persuasive

46 Put alternatively, priority is not enjoyed for *either* of two reasons: first, some of the subject-matter of Domain II falls outside the scope of the priority document and secondly the Domain II subject-matter which falls within its scope, which is a combination of Domains III and IV and what lies to the right hand side of them (C4), is not as *such* disclosed in the priority document

Figure 1 – Domain (Grafik)

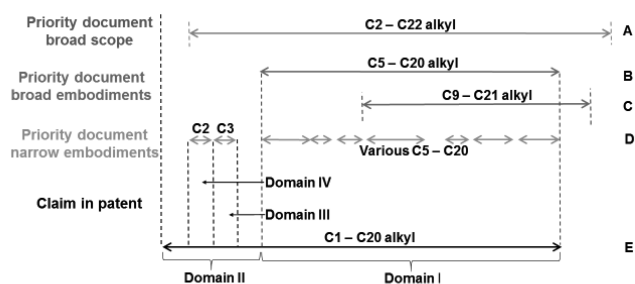


Table 1

<b>A</b>	C2–C22 alkyl	Priority Document	Scope mismatch with Claim
<b>B</b>	C5–C20 alkyl	Priority Document	Pre-domain
<b>C</b>	C9–C21 alkyl	Priority Document	Not pre-domain: straddles Claim boundary
<b>D</b>	C2, Cs alkyl/ various C5–C20 alkyl	Priority Document	Pre-domain
<b>E</b>	C1–C20 alkyl	Main Patent Claim	Non-priority: straddles priority document boundary
<b>Domain I</b>	C5–C20 alkyl	Claim domain	Priority
<b>Domain II</b>	C1–C4	Claim domain	Non-priority: straddles priority document boundary
<b>Domain III</b>	C3 alkyl	Claim domain	Priority
<b>Domain IV</b>	C2 alkyl	Claim domain	Priority

2.3.3 If the reasoning set out above in this Paragraph 2.3 is sound, it follows that if a patentee faces prior art relevant only to the subject-matter of say Domain IV, his freedom of choice may be even wider: he can virtualise a domain structure consisting of Domain IV and a domain consisting of the rest of the claim which abuts Domain IV on all sides – the patentee thus going no further than asserting a priority domain broad enough to ring-fence the citation. In the context of Toxic Priority, such prior art may be created through division specifically to protect the matter of Domain IV in a divisional, the latter then being citable as a *whole contents* citation against the parent.

**NOTE 2**

In asserting split priority, a minimalist approach to resolving the claim into domains appears allowable, and seems likely always to be wisest – taking a position on domain structure more than this would be unnecessary and might conceivably conflict with a position that might need to be taken in some later context.

**2.4 Estoppel**

2.4.1 It is uncertain, once a domain structure choice is made by a patentee, whether there may be circum-

stances where he is estopped from taking a different position in a different prior art context.

2.4.2 Where a patentee has asserted a domain to have a particular priority date to avoid a citation, it seems appropriate that there should be estoppel (extending beyond tribunals of coordinate jurisdiction) from later asserting it to have a different one. However, for estoppel to go further, the benefits of Article 88(2), (3) EPC would to some material extent be withheld, without the justification of a public interest need not already addressed by Reason 6.7 of G0002/98.

**3. What do the terms “limited number” and “clearly defined” really mean?**

**3.1. General**

3.1.1. Reason 6.7 of G0002/98 is central to the issue of partial and multiple priorities, and the “*limited number*” and “*clearly defined*” tests in its proviso have given practitioners trouble.

3.1.2. Despite T1222/11, it is still not entirely clear how these tests should be implemented in practise. There is little sign that these areas of the topic will be officially much illuminated in the immediate future.

**3.2. The „limited number” test**

3.2.1. The driving force for the “*limited number*” test is no doubt a legislative desire to avoid the interested public being faced with too complex a task when assessing priority for the purposes of the validity dimension of an FTO exercise<sup>47</sup>.

3.2.2. In practise, there will be few contexts where the “*limited number*” test will be hard to satisfy. In most cases of Toxic Priority, it should be possible to assert a limited number of priority domains which neutralise cited art, whilst in others it will either not be possible or not be necessary to assert any domain structure that helps; this is illustrated in Paragraph 4. However, asserting many domains will presumably not normally be acceptable implementation of Article 88 (2) EPC.

3.2.3. In particular, it’s probably not accurate to say that plural claimed dates *necessarily* means complexity in the sense of the “*limited number*” test. The extent to which resolving a claim into domains reflecting priority dates of many claimed will depend on exercise of patentee choice as informed by needs arising from citations facing him<sup>48</sup> – plural claimed dates give capacity for many domains but, generally, not all priorities need to be asserted. However, there may be a clarity issue – see Paragraph 3.3.2.

47 T1222/11, Reason 11.5.3: “... a limited number of clearly defined alternative subject-matters is obviously necessary in order to identify which parts of the claims benefit from the effect of the priority right ...” The decision is not as direct as the opinionated comment in Paragraph 3.2.1, but it’s a good approximation

48 This is a more developed view than the view by this author in Paragraph 6.2 of „*Toxic Priority – A 2013 Epilogue*”, Malcolm Lawrence, Journal of the UK Chartered Institute of Patent Attorneys (CIPA Journal), Volume 43, No 3 (March 2014), 142-149

3.2.4. The judge in the 2013 *HTC v Gemalto*<sup>49</sup> UK case was less than supportive of the “limited number” test of G0002/98. The judge commented in Paragraph 160 of his judgement:

“In **G2/98** the EPO Enlarged Board held that multiple priorities in a single claim were possible as long as the claim related to a limited number of clearly defined alternative subject-matters<sup>50</sup>. Although one can sympathise with the desire for a limited number, I doubt there is any principled basis for such a requirement ...”

3.2.5. It would be wrong to attach excessive importance to the comment as the point has not been debated at any length in case law and, in the trial in question, the judge did not need to decide the point. But it’s worth keeping in mind; perhaps it alludes to the point made in Paragraph 3.2.2.

### 3.3. The “clearly defined” test

3.3.1. Lack of clarity in a priority domain presented as neutralizing a citation is, of course, fatal to an entire split priority strategy as it would leave the claim anticipated by the citation concerned. However, as the “clearly defined” test is expressed as a requirement of the overall claim splitting, presumably the “clearly defined” test is not satisfied if resolving generic terminology into the necessary domains “gives rise to the claiming of” any subject-matter domain which is not clearly defined.

3.3.2. The risk in this respect is illustrated in *Nestec*<sup>51</sup> where the court held that domains beyond those which had basis for priority purposes in the priority document were not clear alternative subject-matters<sup>52</sup>. The consequence was that no part of any claim was attributed the claimed priority date. If it is correct that this view of the court goes to clarity as opposed to some other relevant issue, the point may be that the boundaries of a priority domain are rendered uncertain if the domains which border it are not themselves clearly defined. As case law stands, this points to a clear risk of adverse outcomes, at least in the UK Patents Court. Importantly, although not taken into account in *Nestec*, it does not appear that T1222/11 would have changed the court’s view on clarity as T1222/11 adds nothing to that facet of split priority doctrine.

49 *HTC Corp v Gemalto* [2013] EWHC 1876 (Pat)

50 This wording is somewhat general: G0002/98 applies the “clearly defined,” and “limited number,” tests only in the context of claim splitting across generic expressions. Presumably, when the claim recites specific alternatives as opposed to covering them within a generic expression, the specific alternatives will have been tested earlier as meet the “clearly defined” test anyway

51 *Nestec SA & Others v Dualit Ltd & Others* [2013] EWHC 923 (Pat)

52 In *Nestec*, the judge concluded in Paragraph 96 of the judgement that “Option (iii)” (in which the “housing” in the extraction system was distributed between the “movable part” and the “fixed part” of the system) covered a “whole range of different arrangements”, those at the extremes being “quite similar” to the respective other options (“Option (i)” and “Option (ii)”) – so that it was not a clearly defined alternative to the other options. On another feature, the judge took a similar view that “inclined” orientations of the capsule were not clearly defined alternatives to non-inclined orientations (Paragraphs 97 *et seq.*, in particular Paragraph 103)

3.3.3. Whilst the standard to be adopted for the “clearly defined” test is a debating point, it is suggested that logically it ought perhaps to be applied as an Article 84 EPC clarity test. Just as different claims do, different domains of a claim interact differently with validity considerations according to their priority dates, and interact differently with potentially infringing commercial proposals according to their included subject-matter. It should follow therefore that the same public interest issues arise in terms of where boundaries are regardless of whether the boundaries are those of a claim or of a domain of a claim.

3.3.4. It can alternatively be argued that there is a distinction, albeit a fine one, between the words “clearly defined” used in G0002/98 and the language “... sufficiently clear and complete ...” which is used in Article 84 EPC, and that there is no sufficient difficulty in construing what the test means to require any recourse to Article 84 EPC<sup>53</sup>. Although appealing on the language, this approach to a clarity standard could lead unsatisfactorily to application of different standards of clarity as between claims on the one hand and domains defined within claims on the other. The legislative intention *per* the FICPI Memorandum appears to have been to provide split priority as an alternative to claim multiplicities; it would be surprising if this broad aim were considered *appropriately* met if accompanied by relaxation for domains of the clarity standard which would apply to a claim multiplicity. The *Nestec* approach (Paragraph 3.3.2) seems most aligned with the stricter standard.

3.3.5. Consider a prosecuted priority document claim to a chemical composition comprising (i) component A and (ii) additional component X *not* clearly defined. This might be objected to under Article 84 EPC in official examination. Consider then a claim in an application claiming the date of that priority document and reciting a more broadly defined composition comprising (i) a genus consisting of A or B plus (ii) component X *clearly defined*. The latter claim could be resolved into domains including one corresponding to the priority document’s claim. It cannot be right for this to satisfy the clarity test of G0002/98 even though a corresponding claim fails under Article 84 EPC.

## 4. Paragraphs 2 and 3’s Ideas in Action

4.1 Consider the following alternative scenarios. In each, a patent of filing date F is a member of a priority-claiming divided family, claims a range 1–20, seen as a whole is disentitled to priority and faces challenge from three citations:

### Alternative scenarios

- 1: priority document P1 discloses “5–10” + specific values in range 5–10
- 2: priority document P1 discloses “not more than 10” + those specific values

53 This is a valid alternative not recognised in this writer’s earlier thinking – see Paragraph 5 of “*Toxic Priority – A 2013 Epilogue*”, *supra*



**Citations**

- 1: conventional intermediate date<sup>54</sup> citation disclosing the above specific values
- 2: *whole contents* matter of the priority document
- 3: *whole contents* matter of an identical other member of the divided family

4.2 In Scenario 1, novelty in Toxic Priority and other contexts can be rescued by using split priority tools to virtualise the domain “5–10” and an abutting domain representing the rest of the claim. None of the Citations prevails as an anticipation<sup>55</sup> and it isn’t necessary to virtualize any further domains:

- The split priority tools create a “5–10” domain having a priority date earlier than that of Citation 1 and a balance domain distinguished in subject-matter terms.
- That date of the “5–10” domain is the same as that of the potentially anticipatory matter in Citation 2 (range “5–10” and specific values).
- The disclosure of range “1–20” as disclosed in Citation 3 on the one hand and the overall claim on the other have the same date and so do not come into conflict.

**NOTE 3**

It’s perhaps obvious but worth underlining that the first step in novelty assessment having regard to a particular disclosure in a citation, prior to implementation of the split priority tools of Article 88 (2) EPC, is to ask of the claim whether the citation anticipates it. If the answer is YES, the split priority tools are then applied and each domain individually assessed for novelty.

- The priority date of Domain “5–10” is also the same as that of the specific values in Citation 3 (if disclosed there); it would not be necessary to assert narrower domains reflecting the disclosure of specific values in the priority document.

4.3 In Scenario 2:

- Citation 1 anticipates the patent by virtue of its specific value disclosures.
- Citation 2 anticipates the patent by virtue of its disclosures of the range “not more than 10” and its specific value disclosures.
- As illustrated, there isn’t a domain which can be virtualized using split priority tools to neutralize both Citations 1 and 2. The priority document disclosure “not more than 10” falls partly outside the parent claim and is thus not a pre-domain. Even if to do so would be otherwise viable, resolving the claim into a discontinuous plurality of specific value domains and a domain consisting of the rest of the claim would leave the latter (and in particular the matter in the interstices between specific value domains) exposed to anticipation by Citation 2’s general disclosure.
- In case of Citation 3, the F-dated broad range has the same subject-matter content and priority date as the

broad range claimed in the challenged claim and would not be citable against it. The citation is relevant only for the specific values it discloses.

- Although successfully resolving the claim into plural specific value domains would theoretically address the vestigial *Poisonous Divisions* problem of specific value disclosures in Citation 3, the “limited number” test of G0002/98, Reason 6.7 would need to be considered. This might resist solution if the tribunal considered the number of domains to be an undue burden; there may also be a clarity issue depending on the context in which the specific values sit.

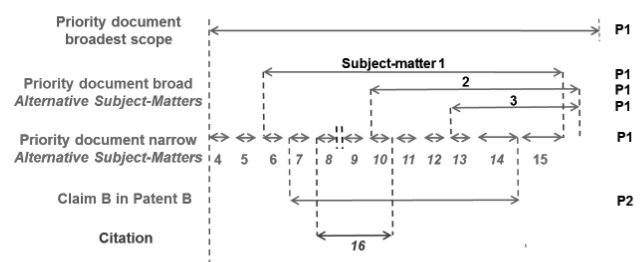
**5. Ineffective domain structures**

5.1 Narrowing relative to Priority Document

5.1.1 Claims are commonly broadened in the priority interval. Various drivers for this include new information and/or simply the opportunity for reconsidering the approach to protection taken in the first instance, often under time pressures limiting preparation time<sup>56</sup>. It is also, however, not uncommon for claims to be limited during that interval, or subject-matter basis for doing so added then and deployed later, with similar drivers.

5.1.2 Although G0002/98, in common with the FICPI Memorandum, focuses on broadening to the exclusion of narrowing (as far as Article 88 (2) EPC is concerned), both have subject-matter change at their core and should benefit from the provisions of Article 88 (2) EPC in the same way. Beyond this generality, however, there are differences between the way claim broadening and narrowing experience the implementation of those provisions, as can be seen from the illustration in Figure 2 below.

**Figure 2**  
Domain (un)availability in case of Narrowed Claims



5.1.3 As Figure 2 shows, Claim B is not only narrower than the broadest claim scope in the originally filed specification but, as can happen, is also narrower than Subject-Matter 1 and straddles a boundary of each of Subject-Matters 2 and 3. In the result, none of these P1-dated subject-matter blocks is a pre-domain serving to generate priority domains within Claim B; the claim must look to lower levels in the priority document scope

54 ie Citation 1 published immediately before F and after P1  
 55 Although *whole contents* citations are not citable under an inventive stop head (Citations 2 and 3), Citation 1 remains prior art under this head so far as subject-matter claimed beyond the domain [5–10] is concerned

56 The point that much can change between a first and second commonfamily filing is made well in “Self-collision of European patent filings: an accident waiting to happen?”, Jane Wainwright (Potter Clarkson LLP), Life Sciences Intellectual Property Review (LSIPR), May 31, 2013

hierarchy to identify viable pre-domains. There are two problems which can arise from this.

5.1.4 As illustrated by Figure 2, one of these problems is that a patentee may be forced to assert a discontinuous fragmentary domain structure which may well make the split priority tools of G0002/98 in many cases ineffective in dealing with citations. For example:–

- Consider Citation 16 against Claim B, assumed for the purposes of this illustration to have an (effective) publication date earlier than Claim B's P2 date but later than P1. The citation is broader than the sum of the domains generated by P1-dated Pre-domains 8, 9 and 10 (as it also encompasses the interstices). It thus cannot be captured by the fragmentary domains which those pre-domains may virtualise in Claim B. Citation 16 may be an early publication by the inventor team, perhaps a poster.
- The problem can also be found in Toxic Priority contexts. Publication of the priority document would place in the state of the art, as of the relevant priority date, various specific and more general P1-dated subject-matter encompassed by Claim B. This is anticipatory as the claim is only entitled to date P2. No domain structure can be asserted which satisfies the three-fold test that it must capture this matter, be disclosed in the priority document and fall wholly within Claim B.

5.1.5 Secondly, the less rigorous language which can sometimes be used at the lower levels of a priority document's descriptive hierarchy could make it challenging to satisfy the "clearly defined" test. In the case of a rather limited claim, there may be no other relevant priority document disclosures on which to rely.

#### NOTE 4

Claims which have been narrowed relative to a priority document produce potentially more dangerous scenarios than claims that have not. As claims become narrower, they "push" the search for pre-domains towards the bottom of the descriptive hierarchy of the priority document where the ration of possible pre-domains is leaner, pre-domains may be too fragmented to match citations and language may lack the rigour to satisfy the "clearly defined" test.

## 5.2 Non-Specific Embodiment Domains which challenge the "clearly defined" test

5.2.1 Using Figure 2 and the following facts, the point made in Paragraph 5.1.5 can be illustrated in a *Poisonous Divisionals* context (ignoring issues arising from other facets of the fact pattern). Patent B is a member of a divided family and the specifications of the members are assumed to have the same content. Subject-Matters 7–14 in another member have date P1, fall within the scope of Claim B and anticipate it unless Article 88 (2), (3) EPC provides a solution. These bodies of subject-matter may not have been drafted with the rigour no doubt reflected in claims and key consistory clauses. If they not satisfy the clarity test of G0002/98, Reason 6.7, the

corresponding content in the priority document will not provide pre-domains useful in implementing Article 88 (2) EPC, leaving Claim B anticipated.

5.2.2 Chemical and life sciences subject-matters are by their nature more likely to experience Toxic Priority risks. However, so can subject-matter in other areas. In a mechanical case, for example<sup>57</sup>, an assembly of members was claimed as an "array" but no array was disclosed as such in the priority documents except in an informal diagram in the setting of loosely drafted description, the overall combination being unclear but its counterpart in a divisional anticipatory of the parent claim.

5.2.3 Case Study 1 below provides a further illustration, again in a mechanical context. Passages such as the disclosure "... and elongate secondary member(s) which are relatively rigid and pressed from thin sheet to convenient shape" are all too easily included in patent specifications, especially those necessarily filed with urgency and with less than complete information. This is drafting practice worth revisiting, especially if (as may be the case) it serves little purpose in terms of conferring enablement or opportunities for later amendment.

#### NOTE 5

Suggested drafting rule: No content should be included in both a priority document and an application claiming its priority date which could form basis for an anticipation attack against another member of a divided family unless, were it a claimed feature, it would comply with Article 84 EPC. Only in that case would the content in question be capable of giving rise to a protective virtual domain in the claim with prospect of success.

### CASE STUDY 1 – A's Patent

#### Context

A's Patent was the parent in a divided family whose members claimed a common priority date. Both parent and divisional main claims originally corresponded to the broadest priority document claim but were limited in prosecution based on substantial additions on filing the priority-claiming application. The resulting main claim in each application thus did not as a whole enjoy priority. A preferred embodiment: "Apparatus comprising ... and elongate secondary member(s) which are relatively rigid and pressed from thin sheet to convenient shape" was common to all family members and within the claim scope. In the parent and divisional, it was linked to the invention in both its original and limited scopes, and was generally linked to other features in the priority document.

#### Analysis

The above preferred embodiment (the "missile") was entitled to the priority date and thus reciprocally citable under the "whole contents" rules – each of the parent and divisional was a "target" for the "missile" in the

57 Personal communication

other. But, as a pre-domain, it was sufficiently vague that it probably failed the G0002/98 “clearly defined” test. Therefore, it could not safely be used to envisage a priority domain to neutralise the citation and avoid Toxic Priority.

### Solutions

To protect the parent from attack by the divisional in the above specific scenario, the preferred embodiment could have been omitted from the divisional specification. However, as the main divisional claim was not entitled to priority and embraced the same priority-entitled “missile” in the parent, the divisional would be left exposed so that this approach needed to be combined with other action.

The parent and divisional but not the priority document disclosed the generally applicable preferred presence of 2 to 10 elongate members. Limiting the divisional claim to this feature would distinguish the divisional claim from the parent “missile”. The combination of the parent “missile” with the 2 to 10 elongate member count feature would not destroy the divisional claim’s novelty; not being disclosed in the priority document, it lacked the priority date necessary for citability.

Fortunately, this also applied to the specific embodiment described with reference to the drawings, which had been revised on parent filing.

### 5.3 “Specific Examples” as priority domains

5.3.1 Much has been written about the damaging role of priority-entitled Examples (and other specific embodiment material) as prior art in Toxic Priority contexts. This is valid although there has been a certain amount of over-reaction.

5.3.2 The suitability of the language of an Example for inclusion in a claim is normally poor and it is suggested that, in most cases, it will not satisfy the “clearly defined” test when used to define a priority domain. However, to keep perspective, the need to visualise a domain corresponding to, as opposed to subsuming, an Example is not likely to be very common. Where the subject-matter of an Example has been added to the state of the art before the priority date of the claim it challenges (eg in a Toxic Priority context), domain selection should result in visualization of the broadest, appropriately early dated, priority domain enveloping that subject-matter. In most cases of reasonably well drafted specifications, this will not mean relying on the Example in the priority document as a pre-domain itself; usually, although not always, the priority document will disclose tiers of intermediate limitations at least some of which can serve instead of the Example as broader pre-domains and so define suitably early priority domains in the challenged claim<sup>58</sup>.

5.3.3 Nestec illustrates the exception, and in doing so again demonstrates that mechanical subject-matter is

not immune to difficulties in implementing Article 88 (2) EPC:–

- The court held the claims had been broadened to cover three alternatives for housing configuration and three for capsule disposition. The priority document disclosed only one of the three alternatives in each case.
- The claims had also been limited to recite a capsule flange to guide it within the extraction system claimed. This feature was disclosed in the description of the priority document with reference to the drawings but not in any broader setting<sup>59</sup>.
- To produce a priority domain in the claims concerned, a pre-domain would need to be identified in the priority document which was limited to:
  - Embodiments in which the capsule has a flange (otherwise the domain it gives rise to would not fall wholly within the claim concerned)
  - The single housing configuration and the single capsule disposition disclosed in the priority document.
- No such pre-domain was disclosed in the priority document other than the specific embodiment described with reference to the drawings.

5.3.4 Case Study 2 below, further illustrates the risks posed by anticipatory specific embodiment subject-matter when there is no supply of suitable intermediate limitation in the priority document.

5.3.5 In his late 2013 paper, *supra*, Rudolf Teschemacher appears to demur from the idea that an Example is likely to be unsuitable as a domain former. The paper states in its “Remarks” section that “... Within the meaning of G0002/98, the specific example is one clearly defined alternative subject-matter; the other alternative is the generic rest of the claim ...” However, this may be referring to specific embodiments in a more general sense than specific Examples or description referring to drawings. A similar situation arises in the context of T0571/10 *supra* which refers to “specific embodiments” as domain-forming (Headnote, Paragraph 2; Reason 4.5.12), but Reason 4.5.3 makes clear specific Examples and description with reference to drawings are not intended.

### CASE STUDY 2 – B’s Patent

#### Context

The claimed laminate product had a pre-formed film adhered upon a non-planar surface having two surface levels connected at a bevel. The priority document, a UK application which had published prior to being abandoned in favour of a UK designation in an EPC application claiming its date, gave no general information on bevel radius, although specific embodiments described with reference to drawings recited specific radii. More general bevel angle information comprehending the specific embodiments (Examples) was added at the

58 See Paragraph 9 of “Toxic Priority – A 2013 Epilogue”, *supra*

59 The capsule flange point is not really featured in the judge’s reasoning per the judgement

time of filing the EPC application. Some of this found its way into the EP's independent claims during prosecution, with loss of overall priority.

### Analysis

The published UK priority document contained specific embodiment disclosures falling within the scope of the granted EP claims. The specific embodiments in the priority document and the patent were identified as engendering in the claims corresponding priority domains. Arguably, these were too numerous to satisfy the "limited number" test. With less reservation, they lacked the clarity expected by the "clearly defined" test as they referred to various proprietary materials by means of trade designations and the protocols set out relied on interpretation and adaptive implementation by the skilled man.

### Outcome

The EP was therefore (probably) invalid (for anticipation in a *whole contents* sense by the priority document) so far as the UK was concerned, leaving no valid protection in the patentee's single significant market. Interestingly (and of significant practical value in any commercial setting), an easy alternative to bringing a formal action for revocation existed in the UK by which a third party had the right to draw to the attention of the UK Intellectual Property Office (IPO) possible invalidity of a UK patent (eg an EP(UK) patent) based on a *whole contents* citation and to request revocation of the patent on that basis.

Case Study 2 illustrates the danger of allowing priority documents to publish, and to become state of the art for the purposes of *whole contents* anticipation, motivated in this case by desire to maintain the UK application until the EPC application appeared likely to succeed. Different motivations apply in the more damaging context of EPC applications claiming priority from an earlier EPC application.

## 6 Changing the law?

6.1 Comments have been made on whether the law should be changed. Although none is preferred by this writer, they add value to the debate. Two recent opinions are briefly referred to below.

6.2 Bobzien & Drope<sup>60</sup> is correct in stating that conventional belief has been that claim broadening on filing a priority-claiming application would not give rise to *whole contents* conflicts between family members. This, however, was based on a perception that the tests for priority entitlement would result in symmetrical priority across eg a divided family. This isn't so. Bobzien & Drope also states that there are no comparable decisions to T1496/11 *supra* in jurisdictions outside EPC. In fact, apart

from UK Court decisions mentioned in the present paper, Toxic Priority has been addressed by the Australian Federal Court in a case involving the same patentee as in T0571/10 and patents equivalent to the family that decision features<sup>61</sup>. Bobzien & Drope suggest that the law should be changed by means of an EBA Decision to excuse anticipation pursuant to Toxic Priority – in essence, a carve-out. However, no basis for the EBA so deciding is given. The EBA referral from T0557/13 may or may not go that far.

6.3 Wohlmuth<sup>62</sup> looks at national law change for solutions in relation to Unified Patents, requiring agreement across the participating states. But this is a long term suggestion which, in any event, offers no remedy for the more likely encountered aggregate challenge to an EPC patent application which could come from another EPC member of the same family. Wohlmuth's analysis of T1222/11 adopts the same views in principle as those which are used to support T1222/11 in Pearce & Falconissupra, in this writer's view erroneously. With existing toxicity in mind, Wohlmuth suggests reformulation of claims as "OR" claims and deployment of disclaimers, an approach that will depend on the merits in each particular circumstance but which, on the face of it, might be less attractive than an approach based on the T1222/11-centred ideas in the present paper.

## 7 Round-Up

7.1 The concepts of partial and multiple priorities have lacked the operational clarity needed to make them workable in the manner business users of the European (EPC) IP system expect. Some commentators argue that parties have not brought the issue before tribunals with sufficient frequency or depth. This in turn can be argued to be because the issue does not arise often (and when it does, that cases are necessarily fact-specific and decisions necessarily case-specific). There is some truth in these arguments but it can also be argued that G0002/98 missed an opportunity of examining the issue of partial and multiple priorities in depth, setting out instead an interpretation of Article 88 (2) EPC which took lower appeal boards down a 10 years long uncorrected wrong road which masked the fundamental concepts needing debate.

7.2 Abandoning the notion that a specification whose claims are under priority date assessment must exhibit content rendering a domain of the claim recognisable as such, massively expands the effective scope of Article 88 (2) EPC as a useful apparatus. That in turn gives rise to a need for protocols on how the resulting freedoms are exercised and questions on what their effects will be. Apart from anything else, G0002/98's tests look different in the new milieu hopefully created post-T1222/11. This is not easy territory. But the challengingly algebraic

60 "Divisionals Reloaded: T 1443/05 and Poisonous Divisionals", C Bobzien and R Drope, Journal of the European Patent Institute (EPI Information), Issue 3/14, September 2014, 110-111

61 "Poisonous Priority Arrives in Australia and New Zealand", Michael Caine, Davis & Collison, November 2014 (<http://tinyurl.com/lhoodjw>)

62 "Potential Solutions for prior art under Art. 54 (3) EPC of the same patent family", J Wohlmuth, Journal of the European Patent Institute (EPI Information), Issue 3/14, September 2014, 112-114

thinking needed for the document comparisons involved in implementing Article 88 (2), (3) EPC will inevitably be so; the alternatives are less attractive. The recent referral to the EBA is a welcome event which may move the situation towards the end of the quotation at the head of this paper.

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*The views in this paper are those of its author and no-one else*