

Priority date assessment under EPC: part II



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This is the second of a two-part article on the rather topical issue of priority date assessment under EPC. The first part was published last month at page 379. To assist readers, the content of the two parts is set out below:

PART 1

0. Introduction and Overview
1. 2001: Enlarged Board of Appeal Decision G0002/98
2. 2003 to 2012: Development of a Strict Approach: T1127/00 to T0476/09
3. Mezzanine: The T0665/00 Approach to Split Priority

PART 2

4. Discussion of the Decade of Development 2003 to 2012
5. 2013: The T1222/11 Approach to Split Priority
6. Specific Embodiments as Priority Domains
7. Split Priorities - Practise
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4. Discussion of the decade of development 2003-2012

4.1 The position in terms of EPO appeal decisions as of late 2012, then, is that, viewed overall, EPO Boards of Appeal have looked for real signs of individualisation in the patent/application in question to justify claim splitting; and there is evidence that, in some cases, boards have wanted basis for individualisation in the claim in question. T0665/00, supported by T0680/08, contrary to this strict line, takes a different approach which seems aberrant and unlikely to provide a secure basis for action. Based just on the number of boards that have taken the strict approach, there is likelihood that most cases, in the near future at least, will be determined on this basis. That must inform how risk is assessed by patentees/applicants and their opponents in contexts where patent validity hinges on considerations of multiple priority.

4.2 That having been said, it is not that clear that this overall mood of appeal boards is based on a correct implementation of what was intended in G0002/98:

- i. Reason 6.7 of the G0002/98 states that when a generic expression is used in a claim, the test for awarding multiple priorities is that such use gives rise to the claiming of (a) a *limited number* of (b) *clearly defined* alternative subject-matters. Both these requirements need to be interpreted carefully, particularly the former.
- ii. Referring to the first requirement – the

limited number requirement³⁵ – many generic expressions subsume very substantial numbers of alternatives which they import into the claim in question. It cannot have been intended by the Enlarged Board in G0002/98 that the number of alternatives a generic expression in a claim theoretically covers should be a determinant as to whether priority is or is not to be awarded. Referring to paragraph 3.7 and the adjacent text box, the purpose of reason 6.7 of G0002/98 is to enable the definition of domains of different priority dates. On that basis, a sounder interpretation of reason 6.7 is that the Enlarged Board intended the limited number requirement to be with reference not to the number of theoretical alternatives the generic expression covers as a matter of semantics, but rather to the number of different priority domains it subsumes with reference to the priority documents.

- iii. As a requirement, that then seems a reasonable one as it would deny multiple priority in situations where the number of priority domains was sufficiently large to constitute an undue burden on a public needful of knowledge as to both the boundaries of the relevant patent protection and how those boundaries interact with validity and its dependence on priority date; the *clearly defined* requirement is, of course, similarly motivated. An interesting comment, which is less than supportive of the above, was made on the *limited number*

requirement of Reason 6.7, G0002/98 by the judge in the April/May 2013 case of *HTC Corp v Gemalto*.³⁶

- iv. It may also not make a great deal of sense for the system to produce outcomes such as mentioned in the footnote to paragraph 1.1.6.
- v. If sub-paragraph (ii) is correct as a matter of interpretation, it must follow that claim splitting is not dependent on what the patent/application identifies by way of individualised domains (the position taken in the decisions referred to earlier in paragraph 3) but *per contra* on the disclosure of priority domains in the priority documents which fall within the scope of the claims in the patent/application. The alternative subject-matters to which the *limited number* and *clearly defined* tests of G0002/98 are applied are thus the sum of those that have a claimed priority date and those which do not.
- vi. This proposition is the converse of the overall *semi-consensus* position that has been developed in EPO case law over the circa ten-year period up to the end of 2012 – and indeed supported by the *Nestec* case³⁷ in the UK Patents Court within the few weeks prior to authorship of this paper. However, it is suggested that it is a proposition of merit.

5. 2013: the T1222/11 approach to split priority

5.1 This decision, published in December 2012³⁸, also challenges the development of case law over the ten plus years that preceded it, and provides reasoning which has significantly greater depth – and obviously much greater authority – than the thoughts expressed in paragraph 4.2 above.

5.2 In doing so, the decision goes out of its way to set out a complete alternative (and, by definition, contrarian) approach occupying just over 11 pages of obiter content that is formidably, if somewhat challengingly, reasoned. The decision directly demurs from the opinions set forth in T1127/00, T1443/05, T1877/08 and T0476/09 in reasons 11.4 and 11.5 (pages 23 and 24 of the decision) as regards the proper interpretation of the proviso to reason 6.7 of G0002/98 (“...provided that it [i.e. the use of a generic expression in a claim] gives rise to the claiming of a limited number of clearly defined alternative subject-matters”).

5.3 T1222/11 states that the determination of whether subject-matter claimed within an “OR” claim enjoys priority is independent of whether the subject-matter in question is identified in the “OR” claim³⁹. This directly contradicts T1127/00 in particular. The decision justifies this position with detailed argument as to how reason 6.7 G0002/98 is properly to be construed. With a degree of synthesis, the writer’s interpretation of these arguments is as follows:

- i. Article 88 EPC deals with substantive issues of priority right and not just procedural issues⁴⁰. More specifically,

Article 88(3) EPC, when properly interpreted, states that if priority is claimed by an application, the applicant/patentee is *entitled* to priority for the *elements* of the patent application⁴¹ included in the priority document(s). There is no conditionality that the included elements should themselves be identified individually as such in the patent/application. In line with this, the final sentence of reason 6.7 of G0002/98 confirms that a claim in a patent/application claiming priority may subsume the *elements* in question within a generic expression such as a formula. [See reason 11.5.1 of T1222/11 on pages 23 and 24 of the decision.]

- ii. Per G0002/98, the determination as to which elements enjoy priority is to be carried out by comparing the claim under assessment with the priority document(s)⁴². The two tests set out in the proviso to reason 6.7 of G0002/98 (namely, the *limited number* and *clearly defined* tests) refer, according to the board in T1222/11, to (i) the *alternative subject-matters* which are disclosed in the priority documents and are conceptually identifiable in the claim under assessment (as opposed to actually being individualised)⁴³ plus (ii) the alternative subject-matters encompassed by the claim but not disclosed in the priority documents. [See reason 11.5.2 of T1222/11.]
- iii. *The limited number* and *clearly defined* tests serve to enable the public to identify which parts of the claim concerned enjoy the benefits of priority according to Article 89 EPC. [See reason 11.5.3 on pages 24 and 25 of T1222/11.]
- iv. According to G0002/98, the legislative intentions⁴⁴ behind the provisions of Article 88 EPC regarding multiple priorities are as set out in the FICPI memorandum⁴⁵. The FICPI memorandum makes clear by the words (quoted by the board in T1222/11): “It is, of course, immaterial whether the word ‘or’ actually occurs in the claim, or is implied through the use of a generic term, or otherwise” that an embodiment need not be individualised as such in a patent/application to benefit from priority. [Reason 11.5.4 of T1222/11.]
- v. The FICPI memorandum gives three examples of “OR” claims. The first example refers to a context where a narrow formula in the priority document is replaced by a broader encompassing formula in the later priority filing. The example proposes that multiple priorities are enjoyed by doing no more than including a single claim directed to the broader formula; such claim carries the date of the priority document insofar as it *encompasses* the narrower formula. It therefore supports the contention that it is whether an element of an invention disclosed in a priority document *falls within the scope of the claim in question* that is determining of priority entitlement. This first example given by FICPI expressly uses the term “scope” in referring to the relationship between elements of the invention and the claim, adding to the clarity that the element need not be

individualised in the claim. [See reason 11.5.5, page 26 of T1222/11, lines 10, 11, 21 and 22.]

- vi. The second FICPI memorandum example attributes priority entitlement to temperature-defining domains of the claim concerned despite the fact that they are not (all) “explicitly or implicitly disclosed in the claim”. [See reason 11.5.6, page 27 of T1222/11, lines 14 to 18.]
- vii. The third example in the FICPI memorandum presents a context where the claim defines in general terms a substrate to be treated (inner surfaces of a hollow body) but it is stated by FICPI to enjoy priority for domains disclosed in priority documents (inner surfaces of pipes) that fall within those general terms but are not identified as such in the claims. The identifiable alternative subject-matters in the claim are those related to treatment of inner surfaces of (a) pipes and (b) hollow bodies other than pipes. [See reason 11.5.7 of T1222/11.]
- viii. The opinions expressed by the board are not, in the board’s view, inconsistent with the key teaching set out in the conclusion of G0002/98 (that the skilled person must be able to derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole). The EBA’s conclusion (see page 20 of G0002/98) is not, according to the board in T1222/11, applied to “OR” claims as such *in vacuo* but takes account of, and is without prejudice to, both reason 6.7 of the EBA’s decision and to the provisions of Article 88 EPC. Reason 6.7 is to be applied to a claim in a comparative manner with respect to the priority documents so as to identify a domain within the claim scope for which the priority document contains basis entitling that domain to priority⁴⁶. [See reason 11.7 of T1112/11 on page 30.]
- ix. G0002/98 emphasises the need for application to patents/applications of the legal concepts underlying EPC in a consistent and coherent manner. This is important when considering Article 87(4) EPC, which provides for priority rights to be generated only from the first application for protection of an invention. When, for example, a priority document P1 encompasses narrow subject-matter already disclosed in an earlier application *P minus 1* filed before the start of the Paris Convention period applicable to the context, this is a crucial question. By custom and consensus, answering the question does not involve determining whether the narrow subject-matter is actually identified in an individualised manner in the later specification P1. For consistency, the same standard of consideration must apply to the different question of the priority date candidature of a domain within a claim of a P2 patent/patent application validly claiming priority from that P1 priority document – the principle of consistency and coherence with implementation of Article 87(4) EPC means that priority cannot depend on

whether the subject-matter of the domain is actually identified in an individualised manner in the P2 case. [see Reason 11.8, bridging pages 30 and 31 of T1222/11]

5.4 As noted already, T1222/11 demurs from the T1127/00 position that, for a domain of a claim to enjoy a claimed priority date, that domain must be individualised in the claim concerned. It appears, however, that T1222/11 may go further and establish that the domain need not be individualised in the application/patent **as a whole**.

5.5 The board’s elaborate and independent reasoning, which leads off from G0002/98 along an entirely different road to T1127/00, means that the board’s conclusion has no inherent pre-requisite that a domain disclosed in a priority document and encompassed by the claim in question, if not identified as such in the claim, must nevertheless be flagged in the body of the patent specification.

5.6 In addition, simple logic would suggest that, in terms of this issue, there is no distinction to be made between a condition under which subject-matters are identified in the claims which encompass them and a condition under which such encompassed subject-matters are identified in the patent/application in question as a whole – if the former is not a requirement, then nor can the latter be. Moreover, there is no part of G0002/98 or the FICPI memorandum which suggests that any part of a patent specification must itself, as a pre-condition for priority entitlement, identify a domain for which priority-generating basis can be found in a priority document. It is perhaps notable that the (somewhat difficult language) of reason 11.8 refers at its very end (page 31) in a specific context to the lack of any need for identification of a priority domain (anywhere) in the later application there referred to.

5.7 Although T1222/11 does not mention T0910/06 (December 2008) *supra*, it is possible that the latter-mentioned decision provides support for the position taken by the board in T1222/11.

5.8 In T0910/06, priority date entitlement for a claim in a patent under opposition needed to be established to distinguish the invention over a self-disclosure – a scientific paper published by the inventor before the filing date. Relying on Article 88(4) EPC and reason 6.2 of G0002/98, the board took the approach of seeking an answer to the query as to what subject-matter in the citation which fell *within the scope* of the claim under challenge could also be found in PD2 – the board expressing the view that, in such case, the citation did not form part of the state of the art as the claim would enjoy the date of PD2. The board found this to be the case on a fact pattern in which it assessed PD2 as disclosing, in its overlap area with the claims, the same mix of reactants and initiator as did the citation. The board did not cite reason 6.7 of G0002/98 but from reason 6.7 (sic) of T0910/06 it seems clear the board was articulating the idea of a claim split to define a domain entitled to the date

of PD2. The board appeared not to be looking for any individualization of the relevant priority domain in the patent, merely stating (again in reason 6.7 of T0910/06) that the subject-matter of the domain fell *within the scope* of the claim under consideration (as in T1222/11). It may have been possible to find basis for such individualisation⁴⁷ but the board in T0910/06 did not seem to make it a pre-requisite⁴⁸.

5.9 It is interesting that in the *Nestec* case *supra* before the UK Patents Court in April this year, the judge appears not to have considered T1222/11 even though that decision was published several months before his judgment.⁴⁹ T1222/11 also appears not to have been considered by the (different) judge in the event more recent *HTC* case *supra*, which came to trial in the weeks bridging April and May 2013. In *Netstec*, an appeal to the UK Court of Appeal was filed in June 2013, a trial date in late 2013 or early 2014 being expected. Additionally, an appeal is pending before an EPO board of appeal (Appeal T1674/12) on the same European patent⁵⁰ and is expected to be heard later this year.⁵¹ It therefore seems likely that a view on T1222/11 may be forthcoming from both appellate instances in the relatively near future.

6. Specific embodiments as priority domains

6.1 In cases where priority date really matters, it is commonly because of an interim publication which (as noted in the footnotes to paragraph 1.2.1) experience shows is not only rather specific but which also emanates from persons associated with the patent in question (e.g. the inventors or the patentee).⁵² Typically, in such cases, the publication is of a commercial form of the invention or a *whole contents* citation which discloses a specific embodiment of the invention. Where such a disclosure is cited against a claim established to be disintitiled to a claimed priority date that would have neutralised the citation, it is relevant to pose the question:

Could the claim be partitioned under reason 6.7 of G0002/98 to define as one priority domain the subject-matter of the specific embodiment (that domain then enjoying the date of the priority document)?

6.2 Two cases where the fact pattern appears to have presented an opportunity for the board to do just that are (i) T1443/05 and (ii) T0665/00 *supra*. T1443/05 is a case where whole contents conflict arose between generationally separated family members, the patent in suit having claims that did not enjoy the priority date of the cited matter as a result of a disclaimer introduced after first filing. The cited matter was specific examples of earlier priority date in the published priority document, the latter cited as a whole contents citation.⁵³ T0665/00 *supra*, whilst not quite the same scenario, was similar in that the citation was of a prior use of an example in the patent in suit, which prior use took place between the claimed priority date and the filing date.⁵⁴

6.3 In T0665/00, in which decision the deciding appeal board ultimately decided in favour of the proprietor, it seems that the fundamental motivation of the board emanated from a view that justice would be served by neutralising the anticipatory prior use conflict. The special approach of splitting the claim to provide a domain whose subject-matter is the offending example could theoretically have cured the problem and that would have aligned with the board's apparent motivation. However, the deciding board chose not to take the approach of splitting the claim to create a domain whose subject-matter is the offending specific embodiment. In T1443/05, the board decided against the patentee but the above special approach was available to it. However, the deciding board in that case too chose not to take the approach of splitting the claim to create a domain whose subject-matter is the offending specific embodiment. In the limited sense that such domains are usually unlikely to satisfy the clearly defined test set out in the proviso of reason 6.7 of G0002/98⁵⁵, this seems sensible in both cases. In the case of T1443/05, the plurality of the specific embodiments would perhaps also mean that the *limited number* test of G0002/98 would not be met. But perhaps the point is that in neither case do the decisions suggest that the above special approach has been contemplated.

6.4 Specifically at the UK level, *Hospira*⁵⁶ is a case where example 5 in the patent reported a phase 2 clinical trial and where the same report appears as example 5 in PD2 (the only priority document at issue) – therefore, on the face of it, example 5 of the patent was subject-matter carrying the PD2 priority date. The primary (novelty) citation, relevant only for subject-matter disintitiled to the date of PD2, also reported the same phase 2 trial. The citation, however, used different language and, to some extent, different terms (e.g. with reference to the definition of the patient volunteer group receiving treatment). This underlines the difficulty in deploying examples in this way as the question of whether the cited subject-matter falls wholly within the defined domain (which would mean a neutralised citation) or whether it straddles the walls of the domain (which would not clearly have the neutralising effect) is not easy. Of course, one could instead define the priority domain as consisting of the report of the clinical trial in the citation, and the question then requiring an answer would be whether that subject-matter satisfied the identity of invention test laid down in the conclusion to G0002/98 so as to have the date of the priority document.

6.5 On the basis of most case law experience to date, it is reasonable to venture the instinctive prediction that the idea of splitting a claim to provide a domain whose subject-matter is the offending example of a citation is unlikely to be a popular one with many EPO appellate instances and other tribunals in the foreseeable future. Indeed, it is hard to resist the feeling that it is debatable whether in principle an example would be capable of the individualisation contemplated by G0002/98⁵⁷ as interpreted e.g. by the

appeal board in T1127/00. It remains to be seen whether T1222/11 will change this.

7. Split priorities – practise

7.1 The concept of priority is exceedingly difficult and collective EPO appellate case law, whilst helpful, is disappointingly so. The notion that a priority domain must be seen as individualised in the patent/application under assessment enjoys a degree of establishment, whilst at the same time being poorly understood by a significant audience and not always easy to implement. T1222/11 seems, although this is an early stage, a sensible decision with practical benefits in terms of priority date assessment generally – and in terms of dealing with *Poisonous Division* and *Poisonous Priority Documents*⁵⁸ more specifically.

7.2 It is tempting to conclude that the decision in T1222/11 will result in a referral to the Enlarged Board of Appeal; indeed, the decision manifests all the hallmarks of a device created to lead to just that result.

7.3 In the interim, prudent practitioner policy – remembering that even practitioners whose practice is wholly patent procurement have to stand in the two opposing corners of securing priority for their clients' claims and obstructing priority for cited matter under Article 54(3) EPC – should recognise that, as matters stand, outcome will depend on whether it is the T1127/00 or T1222/11 approach to multiple priority that prevails in any particular instance.⁵⁹

7.4 Best drafting practise in preparing patent applications at the stage of filing priority-claiming applications will no doubt, pending an Enlarged Board of Appeal decision, be to ensure that all originally disclosed features falling hierarchically below the broadest scope of claim going forward are clearly retained in the priority-claiming filing⁶⁰. As noted earlier, it is common for anticipatory material to be self-published (e.g. as whole contents matter), and here the necessary strategy is to ensure the presence of a disclosure which individualises an embodiment which (a) is entitled to priority and (b) encompasses the self-published matter. Experience seems to show that this does not always happen. Under G0002/98 and T1127/00, this would enable a claim which has been broadened to be partitioned into a domain distinguished by virtue of priority date and a domain which is novel by virtue of subject-matter differentiation.

7.5 It should be appreciated that in principle the same rationale applies where the case going forward has been *narrowed* by incorporation of a new narrowing feature; a domain reflecting even greater narrowing and entitled to priority may well be distinguished over such a self-disclosure as mentioned above and, in the same fashion as in broadening contexts, serve through the claim-splitting process of G0002/98 to save the claim from what would otherwise be an anticipation.

8. Applying the G0002/98 conclusion to priority documents

8.1 The more case law that is read on this subject, the clearer it is that the philosophical and practical need for consistency between the various principles underlying the EPC has driven home a firm policy that the standard to be applied when considering a priority document for basis for a priority claim is the same as under Article 123(2) EPC. Voices can be heard in IP corridors which (still) suggest that the EPO will sometimes adopt a softer approach for priority date assessment. Although this is not without some grounds,⁶¹ the case law overall makes it clear that no safe presumption can be drawn from this: it is evident from G0002/98 that a narrow and strict interpretation of the concept of “the same invention” should be applied, equated to the concept of “the same subject-matter” referred to in Article 87(4) EPC, and that this is being applied faithfully by at least the more experienced lower appeal boards – and indeed the stated reasoning set out in the conclusion of G0002/98 is reiterated in terms with ubiquity in appellate decisions.

8.2 In T0070/05 (February 2006), the above was illustrated by a very experienced board in holding the claims in question as entitled to the claimed (first or second) priority dates and then applying G0002/98 to the whole contents citation alleged nevertheless to anticipate them. The board noted that a small percentage of the amino acid residues of which the receptor molecules disclosed in the citation and its priority document consisted were different as between the priority document the citation, holding that this deprived the citation of the right to priority (see reason 13). The board suggested that this would be the right decision regardless of the reasons for the different amino acid in the two documents, even if this was due e.g. to a typing error.⁶²

8.3 Somewhat analogous fact patterns arose in T0351/01 (July 2003), T0030/02 (October 2006), T0902/07 (December 2010) and, in particular, T1213/05 (September 2007). In T1213/05, the patent claimed a nucleic acid the definition of which relied on a coding sequence which enjoyed more than 99.5% homology (see reason 28, third paragraph) with a coding sequence disclosed in a priority document. It was argued by the patentee that, if parameters used to define a substance in a claim are known to vary within margins of commonly encountered experimental errors, variation in such a parameter between a priority document disclosure and a claim being assessed for priority date purposes did not necessarily abrogate entitlement to the claimed priority date. However, the board disagreed (reason 29), referring to G0002/98 and T0070/05 *supra* in particular, as well as, comprehensively, to various other appellate decisions.^{63,64}

8.4 The decisions referred to in paragraphs 8.2 and 8.3 relate to cases in the biotechnology field and it is in this field, and in the chemical and pharmaceutical fields, that most cases, and the most argued cases, can be found. However, it hardly need be stated that this is a circumstantial reality rather than a limit on applicability of G0002/98.

Notes and references

- * The pseudonymity of this peer reviewer is a result of the internal rules of the relevant corporation.
35. The “clearly defined” requirement is submitted to be an Article 84 EPC test – the latter safeguards public interest, and public interest should demand clarity, not just on what a claim covers per se, but on what parts of that coverage grounds for invalidity impinge differently; that said, Article 84 EPC inherently calls for a determination which balances private and public interest although with the latter naturally of greater weight.
36. See *HTC Corp v Gemalto* [2013] EWHC 1876 (Pat) - where the UK Patents Court also followed the T1127/00 approach followed in *Nestec* by a different judge. The judge’s comment, in Paragraph 160 of the HTC judgement, reads (emphasis added) “*Although one can sympathise with the desire for a limited number, I doubt there is any principled basis for such a requirement but I accept the need for clearly defined alternative subject-matters if a single claim is to be given multiple or partial priorities*”. As noted later in this paper (see Paragraph 5.9), neither the judge in *Nestec* nor the judge in *HTC* appears to have considered T1222/11.
37. See paragraph 2.6 above.
38. T1222/11 is a helpful decision which points a way forward to a (perhaps) more hospitable approach to priority date assessment in multiple priority contexts. However, of the four options on intra-EPO distribution available to the board when issuing a decision, the deciding board opted for distribution to chairmen only, with the result that dissipation of the case may be slower than it might otherwise have been.
39. Reason 11.8 on page 30 of the decision states: “... so far as a subject-matter disclosed in a priority document and encompassed by an “OR” claim of a European application... is concerned, the decision on whether priority can be acknowledged for this subject-matter... is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the “OR” claim... as a separate alternative embodiment” (emphasis added).
40. Reason 6 of G0002/98.
41. Reason 6.2 of G0002/98 states that this term is synonymous with elements of the invention.
42. Reason 4 of G0002/98 and Article 4H of the Paris Convention.
43. *Kitchin J* may have got close to this in *Novartis AG v Johnson & Johnson Medical Ltd* [2009] EWHC 1671 (Pat), where, at paragraph 122, he stated: “I discern from this passage [reason 6.7 of G0002/98] 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 judgement is one which this court should adopt.”
44. Reason 6.3 of G0002/98.
45. Memorandum M/48/I, Section C in the *Préparatoires Travaux*.
46. This suggests the T1222/11 approach will mean more opportunities for award of multiple priorities where the subject-matter of the claim as a whole does not pass the test set out in the conclusion of G0002/98.
47. In terms of individualisation, first impression suggests that the reaction mixture features of T0910/06 mentioned in the body of paragraph 5.8 above are constituents severed from examples. It is submitted that by reference to the patent specification, this is not so; rather, the constituents are mentioned in passages which, although *organisationally* positioned as if part of the body of examples, are not intellectually fixed in that setting. As such, the features are individualised and would in the context not unreasonably have been combined as a priority domain of the claim under assessment following the T1127/00 approach to G0002/98.
48. T0352/97 (October 2000) may be earlier appeal board thinking somewhat in alignment with T1222/11. The board assigned the date of PD1 to subject-matter which subsumed the intermediate prior art and which corresponded to a subset of substituent definitions disclosed as such in PD1 and encompassed within the overall scope of the claim concerned; there was no apparent search for a disclosure of the subset identified as such in the case under consideration.
49. The *Nestec* trial was in Q1 of 2012 and, whilst the parties would not have had an opportunity of being heard on the matter of T1222/11 at trial, it is possible (indeed not uncommon) for parties to send newly issued decisions to the judge, with a short note, after trial and before judgment is handed down.
50. The litigation of the patent in suit forms part of a portfolio of proceedings in various jurisdictions.
51. It is understood that T1222/11 has been cited in the EPO appeal.
52. See paragraph 1.2.1 and its footnotes, July [2013] *CIPA* 379.
53. T1443/05 is similar to T0680/08 in terms of the legal principles applied and the fact that both are in the chemical field. In T1443/05, the priority document (a European patent application which had been published and which was citable as a *whole contents* citation as of the priority date), embraced the presence of a particular biocide in a biocide composition. The claims of the eventual patent disclaimed the presence of this component. The patent and priority document were held in opposition proceedings relating to the former not to relate to the same invention and the claims in the patent were thus held disentitled to the claimed priority date. Examples in the priority document in which the relevant biocide was absent (a) did not support the priority claim and (b) were held to anticipate the patent as it fell within the scope of its claims. An interesting paper analysing T1443/05 appears in EPI Information 2/29 (“Study of Priority Right under EPC: Same Invention/Disclaimers”, F Portal, EPI Information 2/09, pages 56-59. The Portal paper states (page 58, column 1) that all of the examples of the priority document in T1443/05 which disclose compositions from which the particular biocide concerned was absent, appear in the application which matured into the opposed patent (and would be entitled to the date of the priority document). A quick review by the non-German-speaking writer of the present paper could not fault this.
54. It will be recalled that, in T0665/00, this was established as fact that example 1 of the patent and example 1 of the *priority document* were the same, the former simply giving more details of what the branded microsphere component actually was (reason 3.2).
55. As to clarity, example 1 of the patent in T0665/00, not untypically of many patent specifications, defines the microspheres in part by reference to a trade mark, and there is a run of case law holding that use of a trade mark in a claim contravenes Article 84 EPC (see T0762/90, T0932/92 and T0480/98).
56. *Hospira and another v Novartis* [2013] EWHC 516 (Pat) *supra*. One of the Novartis patents involved is subject to EPO opposition also citing the principle novelty citation deployed in the UK Patents Court proceedings.
57. The message in reason 6.7 of G0002/98 is that it is intended to deal with situations where development of the invention in the first year after first filing gives rise to a second filing which introduces feature B as an alternative to feature A disclosed in the first filing. Assuming the specification drafting supports it, one can imagine fitting into this scheme a narrowing scenario –

8.5 As to other technologies:

- In T0184/06 (March 2007), the conclusion of G0002/98 is applied in reason 6.1.1 to disallow priority for a claim broadened to include additional possibilities for a component of a chemical composition and for the absence of another component required in the priority document. It is perhaps the firmness with which the decision (a feature it has in common with others) refers to the “established jurisprudence of the boards of appeal” (reason 6.1.1) which makes the decision compelling, together with the specific referral to reason 9 of G0002/98 (which latter concludes that the so-called “narrow” interpretation of the expression “same invention” is to be applied in priority date assessment).
- T0273/04 (March 2006) is a relatively rare example of seriously challenged priority date assessment in a mechanical case, the decision made being in favour of the patentee. It is not immediately clear from reason 2 of the decision how the differences between the terms in

which the subject-matter was claimed and those of the second priority document were not fatal to that priority claim under the G0002/98 test. Both the description and the claims of the (second) priority document call for a configuration including members having side walls and concave-shaped and convex-shaped further walls having apices which, in at least one case, is substantially flat (arguably, on the basis of the description in the priority document, only a preferred feature). Claim 1 of the Main Request does not recite this configuration but was nevertheless held entitled to the date of the priority document. Further, that claim also recites the presence of longitudinal struts and this can be compared with the disclosed *preferred* feature in the priority document of longitudinal struts – but there these connect the apices whereas the claim in the patent merely states that the struts connect rows of the members. As a mechanical case, T0273/04 may simply reflect the tendency for cases in certain technologies by habit to experience **Article 123(2) EPC** with less injury,⁶⁵ as well as less frequency, than say biotechnology cases.

Notes and references (*continued*)

- splitting out of embodiments characterised respectively by a narrow feature B (priority P2) and an originally disclosed preferred form of feature A (priority P1) which is even narrower. However, that seems to be an adventure in itself and it could be that a split to define a domain consisting of an entire specific embodiment is simply not permissible as a matter of principle.
58. As to both, see:
- (1) “Poisonous EPC Divisionals (Just as you thought it was safe....)”, **Malcolm Lawrence**, *Inventive Steps – Ideas in IP Management*, December 2010.
 - (2) “Poisonous EPC Divisionals – Implications for Risk Management & Opportunistic Advantage”, **Malcolm Lawrence** and **Marc Wilkinson**, *EPI Information*, No 2/2011, pages 54-61, European Patents Institute, June 2011.
 - (3) “Thoughts and Feedback since Original Publication of the ‘Poisonous Divisionals’ Concept”, **Malcolm Lawrence** and **Marc Wilkinson**.
59. It is not totally unrealistic to assume that, pending an Enlarged Board of Appeal decision, there is a prospect that boards in the pharmaceutical and life sciences fields may follow T1127/00 (which was a biotechnology decision) whilst boards dealing with other matter may follow T1222/11 (where the patent was not in these areas).
60. There is in principle quite a lot of potential practitioner control at this point, although obviously falling short of an omniscient awareness of all prior art that may produce a call for multiple priorities.
61. See the examples in paragraph 8.5, second bullet point and paragraph 8.6.
62. This point in T0070/05 is made with reference to that decision, but with perhaps even greater force and clarity, in T1213/05, reason 33, second paragraph.
63. Oral proceedings were heard in both T0070/05 and T1213/05 by very experienced boards, in T1213/05 a five-member board. Both T1213/05 and T0070/05, in surveying a great deal of case law on the subject of priority date assessment, are each a memorable tableau on the topic not limited to the specific points made here. Reason 29 of T1213/05 is perhaps the most powerful development of the key teaching of G0002/98.
64. In this respect, as already noted above, the point in T0070/05 about small discrepancies between patent and priority document (e.g. caused by experimental errors) is made with reference to that decision, but with perhaps even greater force and clarity, in T1213/05, reason 33, second paragraph. Reason 40 of T1213/05 expresses the board’s firm rejection of the notion that the narrow interpretation of the requirement for identity of invention should be replaced in specific cases by a different approach taking account of “possibly unintended errors resulting from specific physical characterization methods”, adding the further point that the Enlarged Board of Appeal in G0002/98 state that a distinction between technical features related to function and effect of an invention and features not having this significance must be avoided.
65. Although there are exceptions, of course –
- see, for example, T0030/01 (June 2004) concerning an imaging apparatus and T0832/04 (September 2006) concerning a bale shredding apparatus, these perhaps were not cases where the board was faced with especially contentious situations.
66. In T1213/05, the board held in reason 31 that for justice to await a decision on whether deviations between a priority document and a patent claim had any effect on the function of the subject-matter in question would be incompatible with G0002/98. The decision refers with approval to T0351/01 in which polynucleotide sequence deviations were sufficient to deny priority even though the deviations were in non-coding regions of the polynucleotide and could not have any functional effect on the polynucleotide or the protein it encoded.
67. There is an analogy here with early Article 123(2) EPC case law drawing a distinction between information originally disclosed and information which was not but which falls within the scope of the original disclosure. Information is either new or not, and a flag in both documents concerned in T0065/92 indicating that the data constituting it is approximate does not, through the notion that approximation naturally infers scope, do anything to change that.
68. Example 1 of the patent in T0665/00 stipulated presence of a branded microsphere product of density 0.04 g/cm³. In the expert testimony referred to, a figure of 0.036 g/cm³ was given for that branded product used in example 1 of the priority document.
69. See paragraph 1.1.9 footnote.

8.6 There are cases in the biotechnology field which contrast with T0070/05 and 1213/05, although these can be explained and do not detract from the substantial establishment enjoyed by the strict application of the “narrow” interpretation of the expression “same invention”. In T0065/92 (June 1993), the board held that a glycosylated polypeptide of molecular weight 61-68kD was entitled to priority from a priority document disclosing one of molecular weight 61-65kD. However, importantly that decision predates G0002/98 by nearly ten years and it is suggested that it would be decided differently now for several reasons. First, reason 3.2 (final paragraph) of T0065/92 suggests that the board was influenced by an understanding that the difference was “qualitatively irrelevant” in terms of function, a factor which would not per se find favour with a modern board, and did not find it with the board in the run of decisions led by T1213/05⁶⁶. Secondly, notwithstanding that both the patent and priority document made it expressly clear that the reader was being informed of approximate figures, the patentee made a choice in presenting the skilled man with different information in the patent.⁶⁷

8.7 As an aside, it is suggested that the same is not quite true in the case of the branded microsphere component density in T0665/00 *supra*, whose priority document recited no density at all in its example 1. The question was whether example 1 of the patent, *which did*, was the same, in particular with respect to density. In what must have been a

difficultly balanced decision for the board, patentee submissions – supported by expert evidence – that the microsphere density in both was *virtually* the same⁶⁸ were accepted as establishing as fact that this was indeed the case. The approximation took place outside the documents being compared and was attributed to the evidence rather than those documents.

8.8 In this respect, as mentioned earlier⁶⁹, the board in T0680/08 drew a clear distinction between claims *broadened* and claims *narrowed* at P2 filing relative to the relevant priority document, and in reason 1.3, second paragraph the board stated that it found nothing in G0002/98 to suggest that the Enlarged Board of Appeal had “explicitly” considered situations where a claim had been “marginally” narrowed (in the case before it, the range “0.325 – 0.415 kWh/kg” had been changed to “0.330 – 0.415 kWh/kg”). In the light of the emphasis the Enlarged Board put on the need for a “narrow and strict approach” to the expression “same invention” and to the clear ruling in the conclusion of G0002/98, the approach in T0680/08 seems highly adventurous and out of alignment.

Please feel free to offer feedback to the author at malfiblu@yahoo.co.uk. Peer reviewed: Ursula Kinkeldey, former Chair, EPO Board of Appeal 3.3.4 and former Member, Enlarged Board of Appeal; Peercat*, a senior Fellow of the UK in-house profession.

The domestic context to Chinese overseas patent applications



By Tom Duke, Senior Intellectual Property Liaison Officer, British Embassy Beijing*

Although small in comparison to domestic applications, Chinese companies are already filing a significant number of overseas patent applications. The domestic intellectual property landscape needs to be understood in order to explain trends in overseas applications by Chinese residents. This article examines the main government policies driving patent filing behaviour in China and the geographical distribution of major patentees. It concludes by considering Chinese overseas patent applications and looks forward to changes in the coming years.

China is changing the global intellectual property (IP) landscape. In 2012, the State Intellectual Property Office (SIPO) received 653,000 invention patent applications, 80% of these were from Mainland Chinese applicants.¹ Chinese applicants now constitute the single largest group of patent filers in the world.²

This is despite the relative youth of the Chinese IP system. The first modern Chinese patent law was enacted in 1985. Subsequent years have seen frequent amendments to legislation, regulations and practice as the Chinese IP system converged with the rest of the world. The fourth set of major revisions to the patent law was launched last year, with the views of domestic stakeholders playing an increasingly important role in driving reforms.

Government policy

One of the primary drivers of patent filing in China is government IP policy, which is part of a broader innovation policy framework. High-level Party and government officials have stressed the need for China to move up the global value chain and build a more innovative economy.³

Recent innovation policy in China can be traced to the publication of the *Medium- to Long-Term Plan for Scientific and Technological Development* (MLP), which covers the period 2006-2020.⁴ Policy makers have set broad and ambitious targets to increase domestic innovative capacity and global technological competitiveness. A number of strategic policy documents followed the MLP⁵ and by 2011 a set of national-level quantitative targets had