

Priority date assessment under EPC: part I



By **Malcolm Lawrence**
(Fellow)

Nearly ten years ago, an eminent member of an Appeal Board in the EPO opened a particular issue at oral proceedings with the words “The problem the EPO has with priority...”. It was certainly a taxing issue then, and it is still a taxing issue now.

One of the two tests for attribution of priority in G0002/98 is the same as that which controls added matter, and as time has passed it has grown closer to those legal origins in its implementation. The other test, less well-formed, has been implemented differently by different EPO tribunals – but creating a *semi-consensus* amongst the majority of appeal boards; that is now challenged by an alternative approach which, if adopted, will change many future outcomes, and probably for the better, but only after a period of uncertainty.

And priority in Europe is not just taxing, but also *very relevant* to commercial outcomes. There is one context which makes it especially so: a large proportion of EPC patent applications originate in the PCT environment and, created by practitioners outside Europe whose grasp of the above picture is necessarily limited, follow strategies which can lock in attributes which fit poorly with the EPC priority system. That’s an issue made worse, although by no means created, by recently emerging IP risks such as *Poisonous Divisions* and *Poisonous Priority Documents*. Hopefully, this paper will catalyse debate and aid communication in a way that ameliorates that issue.

0. Introduction and overview

0.1 Priority entitlement is at the core of best patent practise, capable of determining “life and death” decisions in private patent validity disputes as well as in the more extreme of patent prosecution contexts¹. Whilst there is literature highlighting individual EPO Appeal Board decisions within this overall theatre, less than might be expected has been written on priority date assessment in the round using Enlarged Board of Appeal Decision G0002/98 as the starting point².

0.2 Priority is seldom a straightforward matter for patent proprietors where the technology concerned, or perhaps the proprietor’s understanding of it, grows within the priority year after first filing and leads to specification changes which threaten the originally established priority date.

0.3 Priority is equally a tough issue for tribunals and, as this paper will show, appellate decisions of the EPO have been an imperfect source of guidance for patent applicants and patentees. Indeed, a definitive position on multiple priorities is still lacking 15 years after the presidential referral that led to the landmark Enlarged Board of Appeal Decision G0002/98. As one of a handful of concepts that are absolutely fundamental to the patent system, it is remarkable that any significant aspect of priority should still await

final resolution after such a lengthy gestation period.

0.4 The developing landscape of jurisprudence on priority, and the current implications for practise, can conveniently be reviewed as the following chapters:

Claim splitting

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.
4. Discussion of the decade of developmental 2003 to 2012.
5. 2013: the T1222/11 approach to split priority.
6. Specific embodiments as priority domains
7. Split priorities – practise.

Subject-matter test

8. Applying the G0002/98 *Conclusion* test to priority documents.

1. 2001: Enlarged Board of Appeal decision G0002/98

1.1 The decision

1.1.1 G0002/98 (May 2001)³ decided two things. First, what amounts to the key teaching, at least in the consciousness of most practitioners, sets the disclosure standard needed in a priority

document to support a priority claim. Secondly, the decision sets out the circumstances in which a claim can be partitioned to recognise multiple priorities under Article 88(2)(3) EPC. The latter tends to be the harder question, and of the two teachings it is the one least well understood.

1.1.2 The key teaching in G0002/98 (as set out in the conclusion), requires 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 board commented extensively on the fact that its decision represented a narrow approach achieving necessary alignment and consistency in implementation of a number of different legal concepts underlying EPC, and those comments have been reprised in other decisions.

1.1.3 The seminal test that this key teaching sets out is an Article 123(2) EPC test, which examines whether there is basis in that sense in the priority document for the claim concerned. Article 123(2) EPC is a “daily” challenge, quite outside of questions of priority date assessment, for most IP practitioners; it is perhaps this which explains why this part of the overall teaching of G0002/98 takes the higher position it does in practitioner consciousness.

1.1.4 Reason 6.7 of G0002/98 also gives the Enlarged Board of Appeal’s view on legislative intentions driving the multiple priority provisions of Article 88(2)(3) EPC. Reason 6.7 deals with priority date assessment for so-called “AND claims” and “OR claims”. The first arm of this is easy enough and will not here be discussed. The second arm of reason 6.7 deals with situations where a claim covers features expressed in the alternative – “feature A” or “feature B” – where those features may be contained in a group of priority documents whose dates are claimed but not all of those features are contained in any single priority document.

1.1.5 Commonly, the alternative features referred to are expressed in the claim as a generic term. Reason 6.7, second sentence gives as an example the situation where the claim is directed to feature C, a generic term encompassing features A and B; here, the claim is split for priority date assessment purposes, with the claim so far as it covers feature A having one date (P1) and so far as it covers feature B having a different date (P2) – reflecting two priority documents having features A and B as respective disclosures. However, the final sentence of reason 6.7 contains the crucial message, namely, that Article 88(2)(3) EPC permits a patent claim to claim multiple priority dates using a generic term subject to satisfaction of the important compound legal pre-requisite that use of the generic term gives rise to the claiming of alternatives which (i) are clearly defined and (ii) are limited in number⁴. This test makes the “OR claims” arm of G0002/98, reason 6.7 more difficult to apply – first because it is inherently more difficult to comprehend and secondly because EPO Boards of Appeal have adopted different approaches to its implementation.

1.1.6 In applying the above test, most lower boards, perhaps led principally by T1127/00, have looked for real signs in the specification of the patent/application in suit⁵ of individualisation of the features in question which the generic term subsumes, as well as clarity in expression of, and limitations in the number of, such individualisations. This consideration is applied narrowly and strictly (although the test is not an Article 123(2) EPC test).

1.17 In a closely reasoned but obiter opinion on the interpretation of G0002/98, T1222/11, published at the end of last year, takes the entirely different approach that reason 6.7 of that EBA decision permits multiple priorities in any one claim assignable to domains that can be conceptually envisaged in the patent/application under priority date assessment, but they do not need to be individualised.

1.1.8 It should not be forgotten, but commonly is, that the primary embodiment of legislative intention behind reason 6.7 of G0002/98 is derived from the so-called “FICPI memorandum”⁶ forming a crucial part (as far as priority is concerned) of the *Préparatoires Travaux* to EPC 1973. That background text is referred to in G0002/98 as an important authority but in comparatively few other places in terms of either lower board decisions or expert papers on the subject of multiple priorities⁷.

1.1.9 Reason 6.7 of G0002/98 has an obvious focus on situations where technology grows after first filing to engender claim *broadening*, as distinct from *narrowing*. That is the focus in the FICPI memorandum (and indeed the two contexts are treated differently in T0680/08, although in applying the test for identity of invention rather than in claim splitting⁸). However, it is nevertheless argued that it also embraces narrowing in that feature A and feature B may be alternative narrowing features (with different priority dates). For example, the first filing may disclose a broad range (abandoned in a second filing in favour of the new narrow range referred to below) and a more specific parameter (the latter being feature A), and the second filing may disclose the narrow range (feature B) encompassing the more specific parameter (the latter being, as already noted, feature A).

1.2 Various priority contexts

1.2.1 For the purposes of conceptual understanding, it is perhaps helpful at an early point to look at the three model priority contexts illustrated below, and how they sit in the context of a possible prior art attack (based on a disclosure of specific embodiment subject-matter⁹). As there is more than one type of broadening, there are three illustrations to illustrate narrowing and broadening amendments after P1 filing. Illustration 3 is the reciprocal of illustration 2.

1.2.2 Illustration 1:

- P1 filing was limited to W (and duly exemplified).
- At P2 filing, a new disclosure was filed directed to an alternative X (together with its own exemplification).

- P3, the cognate of P1 and P2, was subsequently filed and produced **broadening** relative to the P1 filing as its claims are to {W or X}. The main claim *overall* enjoys date P3 as it does not overall claim the same invention as the P1 or the P2 filing. However, the claim is notionally divided into separate priority domains, domain W (P1) and domain X (P2), in line with G0002/98, reason 6.7.
- Domain W is invulnerable by virtue of its P1 priority date to a novelty challenge based on e.g. a *whole contents* disclosure of P1 subject-matter and P1 date (or later).¹⁰
- Domain X has the same invulnerability despite its later priority date P2 as it is limited to subject-matter X and does not include any subject-matter W.
- But for the claim splitting, the whole claim would be invalid.

1.2.3 Illustration 2:

- As shown in Table 1 below, a P1 filing has a claim A limited to a parameter range 1 to 8 and this is exemplified by an example (parameter 3.5).
- At P2 filing, claim B replaces claim A and relies instead on parameter range 2 to 5 not disclosed at the P1 stage.
- P2 with the latter definition – a **narrowing** relative to the P1 filing – is proceeded with¹¹ to examination. As a result of the narrower parameter definition, the invention claimed in P2 is not the same as in P1, and claim B *overall* is entitled only to priority date P2.
- Claim B is vulnerable to a novelty challenge based on e.g. a *whole contents* disclosure of the example in the P1 filing as this would fall within the scope of claim B. Final outcome would depend on basis for splitting claim B to define a P1 domain encompassing the cited example and one or more domains representing the balance of claim B (i.e. the subject-matter: {claim B minus the P1 domain}).

Table 1:	Range 1-8	Range 2-5	Example (parameter 3.5)
P1 filing (claim A)	x		x
P2 filing (claim B)		x	x

1.2.4 Illustration 3:

- As shown in Table 2 below, a P1 filing has a claim C limited to a parameter range 2 to 5 and this is exemplified by an example (parameter 3.5).
- At P2 filing, claim D replaces claim C and relies instead on a parameter range 1 to 8.¹²
- P2 with the latter definition – a **broadening** relative to the P1 filing – is proceeded with to examination. As a result of the broader parameter definition, the invention claimed in P2 is not the same as in P1, and claim D *overall* is entitled only to priority date P2.
- Claim D is vulnerable to a novelty challenge based on e.g. a *whole contents* disclosure of the example in the P1

filing as this would fall within the scope of claim D. Final outcome would depend on basis for splitting claim D to define a P1 domain encompassing the cited example and one or more domains representing the balance of claim D (i.e. the subject-matter: {claim D minus the P1 domain}).

Table 2:	Range 1-8	Range 2-5	Example (parameter 3.5)
P1 filing (claim A)		x	x
P2 filing (claim B)	x		x

2. 2003 to 2012: Development of a strict approach – T1127/00 to T0476/09

2.1 There are a number of EPO appeal board decisions, involving key boards of appeal associated with widely recognised sound decision making, which have taken quite strict approaches (and, in particular, approaches that are less lenient than in T0665/00 and T0680/08 – see paragraph 3 below); they have as a common theme that claim splitting under Article 88(2)(3) EPC can only be allowed when there is a solid rationale for the split in terms of what the patent/application discloses – some disclosure which supports the selectivity associated with any individualisation.

2.2 Decision T1127/00 (December 2003) (so far as it deals with the main request) provides perhaps one of the more useful outlines of how G0002/98 should be applied. As noted earlier, in the case of “OR” claims having a feature expressed in generic language, G0002/98 stipulates in reason 6.7 the over-arching proviso that this must only give: “... rise to the claiming of a limited number of clearly defined alternative subject-matters”. In T1127/00, the board applied reason 6.7 of G0002/98 and determined whether the claim could be split into different domains for priority date assessment purposes (see reasons 5 to 7). The board pointed out that a notional domain in the claim under assessment, in particular such as one disclosed in the priority document, might be intellectually envisaged to fall within the scope of the claim being assessed but this did not in the board’s view make up for the lack of a clear and unambiguous individualized presence in the claim justifying award of multiple priorities (see reason 7). The board thus found that claim 1 of the case before it did not embrace: “...a limited number of clearly defined alternative subject-matters in the form of an ‘OR’-claim which could be split up into groups of different priorities”; a single later priority date was assigned to the claim.

2.3 In an auxiliary request, AR2, made by the patentee in T1127/00, a claim to a ribozyme was, however, split into separate domains. The ribozyme was defined in AR2 by features A, B, C and D. feature C in turn was defined by parameters m and $m^1 \geq 1$ and $b \geq 2$ ¹³. In splitting the claim

across the definition of feature C, the board felt able to individualise a first priority domain {C: $m = 1, m^1 = 1, b = 2$ } entitled to the date of PD1 and a second priority domain comprising the rest of the claim – a *limited number of clearly defined subject-matters*¹⁴. The granted claims had specified an embodiment corresponding to AR2 which, of course, specified the values $m = 1, m^1 = 1$ and $b = 2$ in that these were the lower limits of the open-ended ranges m and $m^1 \geq 1$ and $b \geq 2$; and the board was no doubt assisted in its individualisation task by the flagging of these limits as of significance in the description of the patent, e.g. the schematic model ribozyme of figure 3¹⁵.

2.4 T0070/05 (February 2006)¹⁶ examined the right to priority of a citation. The board pointed out at an early stage of the decision (reason 4) the requirement emanating from G0002/98 that consistency calls for the same criteria to be applied to priority date assessment of a citation as applied to a patent/application under challenge. In the citation, similar extracellular receptor fragments DDCR (30-215) and DR3-V1 (26-212)¹⁷ defined, respectively, in the citation and its priority document could be seen as having a common polypeptide chain or sub-group. In reasons 17 and 18 of the decision, the board applied reason 6.7 of G0002/98 to the citation in the following way:

- Reason 17: the common sub-group was “not singled out as such” in the citation and the use of approximate terminology in its definition¹⁸ created an open-endedness which meant that (echoing the *limited number* requirement of the proviso to reason 6.7 of G0002/98) the number of sequences covered by the sub-group definition was not limited.
- Reason 18: referring to the rationale expressed by the board in T1127/00, the common polypeptide chain could not be individualised *inter alia* in the citation as one alternative subject-matter domain – the board holding that the fact that the domain might be intellectually envisaged as falling within the disclosure of the citation was not sufficient. The board decided that the claim could not be so split as the common chain was not as such identified *in the claim* (as opposed to capable of being intellectually envisaged) and not clearly defined¹⁹.

2.5 In T0184/06 (March 2007), the board took a tough line in the case of a bleaching composition and nearly, but not quite, stated (in reason 6.1.2) that its interpretation of Article 88(2) and (3) EPC was that multiple priorities could be claimed only in the case of specific distinct alternatives. The board contrasted this with how it saw the claims before it (Ninth Auxiliary Request) as characterized by a combination of features which “cannot be regarded isolately (sic) from each other”. The patentee’s argument on individualization was that priority should be assigned to at least the included compositions comprising a hypohalite bleach and the specific alkyl ether sulphate disclosed in the examples. Whether better ammunition to deal with the board’s somewhat

refractory posture existed is beyond the scope of this paper but the above argument has little obvious strength. In any event, multiple priorities were not permitted.

2.6 As noted in paragraph 2.2 above, T1127/00 (Main Request) states that basis for individualisation of an embodiment is required to be “in the claim”²⁰. However, as plain as this is stated in the decision, it is suggested that it would be going too far to treat this as a general principle. As noted in paragraph 2.3 above, T1127/00 itself appears to accord with this in the approach taken to the auxiliary request²¹. Moreover, observing the requirement for a solid rationale for a claim split to be contained in the patent/application in question, if basis for individualisation of a priority domain were flagged in *the body of patent specification*, it is not easy to explain why this should be treated as inferior to basis in a claim – at least, not without recourse to artificial arguments that are more technical than equitable.

2.7 Reason 6.7 of G0002/98 derives principally from Article 88(3) EPC, which refers to “elements” of the invention. In T1877/08 (February 2010), the board, in highlighting this terminology, makes the point that it must be understood as referring to “separable alternative embodiments”. In that case, the board dealt with a chemical composition comprising three components in proportions defined by numerical ranges (30-65, 33-69 and 1-10) not disclosed in the priority document (which disclosed ranges of 30-55, 35-65 and 2-10). These were argued unsuccessfully to be entitled to priority so far as there was overlap between the ranges claimed and those in the priority document. The board did not agree and held that no “separable alternative embodiments” could be identified in the patent, citing reason 6.7 of G0002/98. The decision, usefully reiterating the language of Article 88(3), underlines the perceived need for *individualisation* of domains within the patent whose claims are subject to priority date assessment. A later decision, T0476/09 (September 2012), supports the position taken by the board in T1877/08, the facts being somewhat similar (a range of 0.93 to 0.99 was recited in the claims in question for the circularity of toner particles in a toner composition whereas the priority document disclosed a marginally narrower range of 0.94 to 0.99 for the same parameter).

2.8 A very recent, and well-publicized, judgment (22 April 2013) of the UK Patents Court in the case of *Nestec SA & Others v Dualit Ltd & Others* [2013] EWHC 923 (Pat) is broadly aligned with the above EPO appeal decisions, and in particular with T1127/00 (Main Request). In *Nestec*, the relevant claim was to an extraction system in a Nespresso coffee maker, the system being defined in terms that encompassed arrangements in which a beverage capsule had an inclined or non-inclined attitude whereas the priority document did not disclose arrangements in which the capsule had the former attitude (paragraphs 99 and 102). Relying on G0002/98 (paragraph 91), the court held that, *inter alia* on this ground, claim 1 was not entitled to the claimed priority date (paragraphs 103 and 104) but only to the filling

date of the application on which the patent was granted. Counsel for Nestec did not argue that the claim was entitled to multiple priority dates for the respective subject-matters it encompassed (paragraph 103), but in any event the judge stated in paragraph 103 that he did not consider the “inclined” embodiments to be “... clearly defined alternatives to the other arrangements covered by...” the claim (also see paragraph 96 for a similar view on other features).

2.9 Pithy rules of thumb are dangerous in the practise of IP law. However, there’s a general flavour in most of the case law that claim splitting across the scope of a generic expression²² must be straightforward or it is not going to be allowed as a tool in priority date assessment, at least not under the widely supported “strict approach” laid down in T1127/00. It was not straightforward in T1127/00 (main request) or T0070/05, and nor, it is suggested, was it in T0665/00 or T0680/08 (see paragraph 3).

2.10 There are cases where it was straightforward that are worth mentioning to illustrate the point; in these cases, the need to apply split priorities was occasioned by claim broadening at subsequent filing relative to the first filing and the board looked for, and easily found, basis for the necessary individualisation in the patent concerned. In T0135/01 (January 2004), a domain of claim 1 whose subject-matter was entitled to the earliest priority date claimed was explicitly defined in claim 2 and in the description of the original PCT application, so that the situation easily sat within the framework of allowability the board saw as set out by reason 6.7 of G0002/98; things were straightforward and splitting of claim 1 was permitted so as to attribute multiple priority dates. In T0441/93 (decided before G0002/98, in March 1996), the claim challenged was also partitioned in a similar manner into (A) transformation processes applied to yeast cell protoplasts (for which priority was allowed) and (B) transformation processes applied more broadly to include whole yeast cells (for which priority was not allowed). As the decision predates G0002/98, no reference is made in the decision to application of the principles set down by the Enlarged Board of Appeal although express disclosure of (A) was contained in the sub-claims of the patent and presumably relied on by the board. T0395/95 (also decided before G0002/98, in September 1997) also allowed split priority, the split-off domain again being clearly disclosed and identified as such in the patent (see claim 2 of the patent and reasons 2.1.1 and 2.1.2 of the decision).

2.11 In both cases, the splitting, quite apart from the subject-matter to which it was directed being flagged in the specification of the patent concerned, gave rise to a limited number of alternative subject-matters. Perhaps importantly, they were cases where the later filing broadened the claim scope; had it instead narrowed the claim scope, there might have been a greater challenge to individualisation of e.g. a domain of early priority date encompassing an anticipatory specific embodiment, at least not one likely to have appealed to the deciding board.

3. Mezzanine: the T0665/00 approach to claim splitting

3.1 The T0665/00 (April 2005) approach, which has featured in a number of blog posts, is best demonstrated with reference to illustration 2 (paragraph 1.2.3 above). There are two possible approaches in illustration 2, each with a different outcome:

- i. Claim B is not split at all and therefore has the priority date P2. The P1-dated specific example (parameter 3.5) is anticipatory of claim B; or
- ii. Claim B is split to provide the following priority domains:
 - A priority domain characterised by parameter 3.5 (entitled, following the reasoning in T0665/00, to date P1).
 - Following the claim splitting approach adopted in T0665/00, plural priority domains, respectively representing the rest of claim B, each of which is specific separately to all other parameters within the claimed limits 2 to 5 recited in illustration 2. The first-mentioned domain has priority date P1 and is therefore invulnerable to any citation of the example with an effective date later than P1. The remaining domains of claim B are distinguished from the example (on a novelty basis) by virtue of different subject-matter.

3.2 The analysis in 3.1(i) seems right on the basis of G0002/98. The approach to claim splitting adopted in T0665/00 is entirely different and, whilst it cannot be ignored, it seems questionable.

3.3 Referring now to the detailed circumstances in T0665/00:

- In T0665/00, the board was tasked with assessing priority entitlement of a composition claim reciting a density limit of $<0.1 \text{ g/cm}^3$ for a microsphere component where the priority document recited instead a density limit of $<0.5 \text{ g/cm}^3$ and mentioned no additional densities. Example 1 of both patent and priority document stipulated the presence in the composition of a branded microsphere product (*Expancel DE*) in combination with identical other components.
- The example in the *patent* provided a greater amount of information on the branded microsphere component, in particular express disclosure of a density of 0.04 g/cm^3 . Submissions by the patentee, supported by expert testimony and not challenged by the opponent, were accepted by the board to establish a figure of 0.036 g/cm^3 for that branded product as used in example 1 of the priority document (see reason 3.2 of T0665/00).
- This composition exemplified in example 1 of the priority document had allegedly been disclosed through prior use between the claimed priority date and the EP filing date.²³
- As to legal setting, T0665/00 refers in reason 3.5 expressly to reason 6.7 of G0002/98.

3.4 Although reason 6.7 of G0002/98 was duly applied, the board approached matters in an unusual way: it decided in reason 3.5.1 of T0665/00 that the density of $<0.1 \text{ g/cm}^3$ in the claims as granted "... permits the definition of..." a group of microspheres, each characterised by a given density falling within the generic limitation $<0.1 \text{ g/cm}^3$ and each element of the group representing an alternative to which its own priority date can be assigned. In short, the board ruled that all densities within the spectrum covered by the terms of the granted claim could be individualised to generate plural respective priority domains. Adopting this approach, the priority domain defined by density 0.04 g/cm^3 was entitled to the claimed priority date and was held not anticipated by the use that had taken place between the priority date and filing date. The remaining domains would be entitled to the filing date.²⁴

3.5 This rather artificial approach appears to take T0665/00 well beyond the boundaries of G0002/98, reason 6.7 and therefore to treat the patentee with an unexpected leniency²⁵ that it is submitted is unlikely to be generally available:

- There is no clear basis, and certainly not one expressed in reason 3.5.1 of T0665/00, for taking the claims in question and individualising each of plural microsphere densities falling within the claimed $<0.1 \text{ g/cm}^3$ limit, as the Appeal board did:
 - Following case law available to the board (T1127/00 *supra*), the board would have been expected to require a solid rationale for the split – some disclosure in the patent which supports the selectivity associated with individualisation. However, the patent in T0665/00 specifically discloses only one density, namely the density of 0.04 g/cm^3 mentioned in example 1, and is silent as to any other density within the spectrum concerned
 - As to the specific density mentioned in example 1, the figure is not flagged in the patent in the individualised sense apparently required by the then existing case law. It is merely disclosed as one only of a number of microsphere characteristics (the copolymer composition and particle size for the microspheres are, for example, also recited in example 1), and indeed the microspheres are one integer only of the overall budget of features in the example (which also mentions, for example, pigments and other components representing the bulk of the composition disclosed)²⁶. In short, the density integer is presented as part of a marriage with other features, the whole constituting an overall setting from which density alone cannot be individualised.²⁷
- In terms of "OR" claims, the proviso to reason 6.7 of G0002/98 (per T1127/00 and T0070/05) requires that splitting a claim across a generic term or formula into alternative features in priority date assessment is limited to situations where those features can be individualised

to give rise to a limited number of clearly defined alternative subject-matters.²⁸ The approach of the board in T0665/00 to individualization does not create a limited number of alternatives, but many alternatives; in essence, the board divided a range, with considerable granularity, into its component parts using a denominator which seems tailored to the desired outcome.

3.6 Unlike T0665/00, the reasoning in T0680/08 (April 2010) does not cite reason 6.7 of G0002/98 but it did adopt an approach which has more than mere shades in it of that earlier T decision²⁹:

- In T0680/08, the claims of the opposed patent recited a numeric range of $0.330 - 0.415 \text{ kWh/kg}$ for a parameter, total drive specific energy, in a chemical process. The range was held not disclosed in the priority document, which recited a different range of $0.325 - 0.415 \text{ kWh/kg}$; the range definition had been narrowed between P1 and P2 filings.
- The board held in T0680/08³⁰ that "... the subject-matter of claim 1 according to the main request – **insofar as a method carried out at the lower bound value of 0.330 kWh/kg is concerned** – is not entitled to the priority..."³¹ (emphasis added).
- However, the board went further, and surprisingly assigned the claimed priority date to a claim amended to exclude, by use of a disclaimer, processes carried out in accordance with the specific parameter of 0.330 kWh/kg on the basis that this limit was in the board's view responsible for loss of priority³²; the board commented³³ that "... methods carried out at claimed SEC values other than 0.330 kWh/kg , i.e. the subject-matter of claim 1 according to the first auxiliary request, concern the same invention as is disclosed in document D0".
- It can be argued that the board split the claim in depicting it as having one domain specific to 0.330 kWh/kg and a domain representing the balance of the

An important philosophical test

The fundamental purpose of recognising "OR" claims is to enable definition of individual priority domains that have different priority dates – reason 6.7 in G0002/98 is about "multiple" priorities (see also T01127/00, reason 6). Taking T0665/00 as an example, the density integer used to define the split in T0665/00 per paragraph 9.3.3 of the decision is exported from a specific setting much narrower than the general setting of the claim into which it is imported. The import seems unlikely to be priority-conferring.

If that is right, the split would not achieve its purpose of defining plural priority domains that collectively have at least two priority dates. The split, on this basis, is not a valid one in the first place, and in principle should be impermissible.

claim (namely, 0.330 – 0.415 kWh/kg truncated at its bottom end by loss of the specific 0.330 kWh/kg figure)

- The latter domain would, however, still be narrower than the priority document because it would exclude the parameter range 0.325 to <0.330 kWh/kg at the bottom end of the range recited in the priority document; it would thus not be the same invention and as a consequence would not enjoy the claimed priority date.

3.7 In summary, it is submitted that the amendment with which the patentee succeeded in T0680/08³⁴ does not result in a residual claim entitled to the P1 priority date – the residue of the claim following the disclaimer has date P2 and remains anticipated by the description in the priority document cited by the opponents. Additionally, viewed as a process of claim splitting, the two domains formed by the split have the same priority date. As a split must, it is suggested, produce domains of different priority dates (reason 6.7 of G0002/98 and Article 88(3) EPC are concerned with *multiple* priorities) for it to be a *valid* split under, and fulfilling the purpose behind, reason 6.7 of G0002/98, there was no basis for a claim split in T0860/08 in the first place.

3.8 It is valid to consider a modification of the approach in T0665/00 – on that fact pattern, dividing the claim into just two domains, domain I characterised by microspheres of density 0.04 g/cm³ and domain II representing the balance of the claim. This has a sense of the right scale to it (*vis-à-vis* the proviso to reason 6.7 of G0002/98) and so may deal with the issue flagged in the second (main) bullet point of paragraph 3.5.

3.9 However, it does not deal with the issue flagged in the first bullet point of paragraph 3.5 (see its second sub-bullet point) if domain I is comprised of the subject-matter of the claim expressed in unchanged general terms save only for the specific density limitation applied to the microsphere component.

To be continued – see part 2 in the August CIPA Journal.

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.

Notes and references

* The pseudonymity of this peer reviewer is a result of the internal rules of the relevant corporation.

1. Notably, although specific to the UK jurisdiction, three patents were held invalid earlier this year through having invalid priority claims: *Samsung v Apple* [2013] EWHC 468 (Pat) [March 7, 2013]; *Samsung v Apple* [2013] EWHC 467 (Pat) [March 7, 2013]; and *Hospira and another v Novartis* [2013] EWHC 516 (Pat) [March 15, 2013].
2. This is against a real life background in which there is some evidence that priority challenges are becoming more common in inter partes proceedings, especially in crowded technology areas.
3. G0002/98 is, of course, approved in the key UK court decisions in (1) *Biogen v Medeva* [1997] RPC 1 and (2) *Unilin Beheer v Berry Floor* [2005] FSR 6.
4. The exact language in G0002/98, reason 6.7 is: “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” (emphasis added).
5. An interesting consideration is whether basis for claim splitting must be in the patent, if priority is challenged for the claims as granted, as opposed to having been historically present in the application filed, a question presumably to be answered in the affirmative (Article 88(2) EPC is framed about patent applications,

- but it is suggested that this is not significant beyond the fact that it is there that the priority claim is made). To this conjectured extent, it is clearly, although inconveniently, possible for priority entitlement to change, through disapplication of claim splitting, in the amendment process which may be experienced by a patent application in prosecution. Amending a specification always moves the goal posts but an outcome such as this seems a technical consequence too far and is perhaps an early sign that the semi-consensus state of case law, at least prior to T1222/11, has not entirely ended up in the right place.
6. Denoted “Memorandum M/48/I, Section C” in the *Préparatoires Travaux*.
 7. It would be (theoretically) interesting to learn how many people who practise IP have read the *FICPI memorandum*, or even had it in their possession, until recently.
 8. In T0680/08, it is stated by the board in reason 1.3, second paragraph 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; however, it is suggested (see paragraph 8.8 below) that the deciding board may have erred in concluding that this gave it the freedom it decided it had.
 9. Where priority date is at issue, it is common for alleged anticipatory disclosures to be self-disclosures and for those self-disclosures to be disclosures of specific information. For a recent example, see the UK case of *Hospira and another v*

Novartis, [2013] EWHC 516 (Pat) (and IPKat March 19, 2013) and, more generally, T1213/05 and T0331/07 (scientific paper publication), T0665/00 (product disclosure), T0680/08 (publication in priority document) and T1496/11 (publication in divisional).

10. This could be the result of a competitor’s patent procurement actions or, as in the case of T0680/08 and T1443/05, those of the proprietor.
11. Of course, commonly, an EPC P3 will be filed cognating the P1 and P2 filings.
12. Unlike Illustration 1, the broadening is the result of a redefinition of a parameter rather than the provision of an entirely different alternative feature.
13. The decision may be found difficult to follow as reason 21 incorrectly refers to n and n/ whereas m and m/ were intended.
14. See reason 21 (in which, however, reason 6.7 of G0002/98 was not expressly mentioned).
15. The decision can be distinguished over T0665/00 because Feature C was individualised in the patent with a force greater than was the relevant microsphere density in T0665/00.
16. Oral proceedings were heard before a five-member board.
17. With a general audience in mind, the style of nomenclature shown has been used as a convenience in distilling into assimilable abstract form the reasonably complex technical fact pattern in T0070/05.
18. The board noted that the DDCR (30-215) and DR3-V1 (26-212) fragments could be in slightly shortened or extended form so that

there were a number of alternative possibilities for the composition of the common polypeptide chain.

19. The board in T0070/05 also decided (reason18) that the common polypeptide chain could not be derived clearly and unambiguously from the priority document so that, even if the claim could have been split, it seems that the claimed priority date would not have been assigned to the domain defined in the split.
20. A position also taken by the board in T1443/05.
21. ... and see T0135/01 (paragraph 2.10 below).
22. Of course, situations where the claim scope is defined by expressly stated alternatives are an easy matter; see, for example, T0676/01 (May 2005) and T0108/98 (March 2003).
23. Reason 2.3 makes it clear that the board did not actually accept that there had been prior publication; the consideration the board gave to priority date issues in the decision was to that extent *gratis dictum*.
24. The board did not find the claims lacked inventive step, although there is a case that the approach taken left inventive step issues intact and unaddressed. For example, a composition comprising a microsphere component density of (say) 0.045 g/cm³ would presumably not be entitled to the claimed priority date (as no domain so defined had not been disclosed in the priority document) and would presumably be open to challenge under Article 56 EPC for lack of inventive step. Parenthetically, it should be

said that the expert evidence in the case suggests that composition properties are density-dependant and that might suggest such a challenge could be met – but the *general* point remains valid that the approach of the board in T0065/00 is, for reasons beyond novelty, likely to provide non-holistic and therefore imperfect solutions in many instances.

25. From the decision, it is difficult to resist the feeling that this is not the only area in which the board demonstrated leniency.
26. On the latter point, the description in the patent specification beyond the examples singles out the *class* of branded microsphere product (*Expancel*) of which one form (Expancel DE) was used in example 1. Whilst this seems a move towards the necessary basis for individualisation, it seems to fall short of permitting individualization of density divorced from other microsphere attributes, such as composition and particle size. Perhaps the board thought the same as it did not propound this approach but ventured more deeply to decide on the basis it did.
27. As demonstrated by the patent and the priority document, the patentee did not seem to know enough about microsphere density at either filing date. Accordingly, a reflection on the fundamentality that priority is awarded for knowledge which is appropriately demonstrated at both junctures, non-entitlement to priority is a consequence which objectively might well be seen as just.

28. As noted previously, the exact language in reason 6.7 of G0002/98 is: “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”.

29. The boards in the two cases were not the same.
30. Blog posts on this decision contained notable surprise, even taking into account that blogs are commonly a medium for anonymous expressions of astonishment by the blog’s followers.
31. The board thus was perhaps at least courting with the rationale of reason 6.7 of G0002/98 – see reason 2.1 of T0680/08 (“...the subject-matter of claim 1 according to the main request – insofar as a method carried out at the lower bound value of 0.330 kWh/kg is concerned – is not entitled to the priority...”).
32. It is submitted that it is not the “bookends” per se that determine priority but the subject-matter between them – in this case, subject-matter which is not the same as that between the 0.325 and 0.415 kWh/kg “bookends” of the priority document.
33. Reason 3.2 of T0680/08.
34. The amendment was instigated by the board during oral proceedings.