



Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
Institut des mandataires agréés près l'Office européen des brevets

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29th February, 2016

Amicus curiae brief of epi concerning case G 1/15

Dear Sirs,

Please find enclosed, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office, an amicus curiae brief submitted by the European Patent Practice Committee of the Institute of Professional Representatives before the European Patent Office (**epi**) with regard to case G 1/15.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'Antonius Tangena', with a long horizontal stroke extending to the right.

Antonius Tangena
President

Encl.: Amicus curiae brief of **epi** concerning case G 1/15

Amicus curiae brief of **epi** concerning case G 1/15

Summary

epi is pleased with the present referral to the Enlarged Board of Appeal (EBoA) and with the opportunity to comment on it. **epi** is of the opinion that the practice of allowing a European patent or patent application to be poisoned by the content of its priority application – be it as a European priority application or as a priority application of a divisional application – can and must be terminated so as to keep the European patent system orderly, fair and tenable, as well as intelligible for more than just the inner circle of the European Patent Office and the representatives directly interacting with the Office. This must be and can be achieved by proper interpretation of the applicable law and Enlarged Board of Appeal case law.

Preliminary remark

It is noted that a number of amicus curiae briefs have already been submitted to the EBoA. These appear to be more or less unanimous in that the poisonous divisional and poisonous priority practices – also called self-destruction or auto-mutilation of a European patent application – should be terminated and that the answer to Question 1 or at least to Question 5 of the referral should be answered in the negative. **epi** will refer to these amicus curiae briefs below where appropriate, to avoid unnecessary duplications.

The problem

The situation in which the content of a priority application (PA) becomes poisonous for the novelty of a claim of a related European patent or patent application under review (EPuR) can be analysed as follows.

- The EPuR claims the priority of the PA.
- Part of the subject matter of a claim in the EPuR is disclosed in the PA, e.g. as one or more examples and/or more narrowly defined features of the claimed subject matter.
- Another part of the subject matter of the claim in the EPuR is not disclosed in the PA. Often the claim in the EPuR is extended in scope in respect of one or more features compared to the PA.
- The subject matter of the PA becomes publicly available after the filing date of the EPuR in the form of:
 - the published priority document as such – if it is a European patent application¹, this is the so-called poisonous priority situation; or

¹ Under the current practice (2016), it is only a post-published prior *European* patent application which can constitute prior art for the purpose of Article 54(3) EPC and thus be relevant for novelty of a(n)other

- a published patent application which claims the priority of the PA and which can be:
 - a divisional application of the EPuR,
 - the parent of the EPuR, where the EPuR is a divisional; this is the so-called poisonous divisional situation.

This factual situation can, according to some of the contentious case law, lead to partial or complete invalidity of the EPuR claim if the right to priority of the EPuR claim may be denied.

In the referring decision, T557/13, this factual situation for the case under review is explained in sections 6 to 7 (page 21) and elaborated in sections 8 to 9 (pages 22 to 28).

Until early in the 21st century, the problem did not exist under the EPC, even though the factual situation frequently occurred. In fact, the situation has always occurred, and will continue to occur, whenever a follow-up claim is not exactly and entirely present in the priority document because of the developments made by the inventor and the relevant content of the priority document is published in one way or the other.

In the world outside the EPC, the problem referred to above had never previously caused a problem.

The problem arose with the increasing tendency within the EPO to apply the provisions on added matter (Article 123(2) EPC), right to priority (Articles 87 to 89 EPC), conflicting patent applications (Article 54(3) EPC) and the like in a more literal, mathematical way rather than in the conceptual, technical sense as understood by the skilled reader.

The practice that a priority disclosure (of the applicant) can be detrimental, rather than supportive, for a derived patent application (of the same applicant), without any third party contributing anything by means of a publication or patent application filed in the meantime, is unsatisfactory and does not appear to have been intended by the legislators and should therefore be eliminated.

Decision T 557/13 of 17 July 2015 by Technical Board of Appeal 3.3.06 referred five questions to the EBoA. These are dealt with below.

European patent (application). However, a post-published national prior application of an EPC member state is relevant for novelty of the national part of a (granted) European patent according to Article 139(2) EPC. More importantly, such a national prior application of a member state of the Unified Patent Court Agreement may be relevant for the novelty of a European patent with unitary effect *in its entirety* (EU Regulation 1257/2012, Article 3(2)) and thus the effect of the poisonous priority practice will be even more serious if the UPC were to endorse it.

Question 1

1. *Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document?*

With this question, the referring Board asks the EBoA to decide on the extent to which a partial priority can be acknowledged (although the question formulates it in the negative: "refused"). While the basis of the referral is a case of a poisonous divisional (or poisonous parent), the question has been formulated so as to address poisonous priorities as well.

The legal framework is constituted by the Paris Convention and Articles 87 to 89 EPC. The EPC is a special agreement under Article 19 of the Paris Convention and thus should not contravene the Paris Convention, as emphasized in the Vienna Convention on the Law of Treaties, in particular Articles 30 to 32 thereof. In other words, the Paris Convention is the primary legislation. The Paris Convention clearly acknowledges multiple priority (Article 4(F), first half sentence), including having separate priorities for different parts of the invention, in the following referred to as partial priority (Art. 4(F), second half sentence). The Paris Convention explicitly acknowledges that different priority dates may be assigned to different parts ("elements"), i.e. that multiple, including partial, priorities shall be acknowledged.

These provisions are also present in Articles 87 to 89 EPC, in particular in Article 88(2) to (4) EPC, which deals with multiple and partial priorities.

Neither Article 4F of the Paris Convention, nor Article 88 EPC, nor the preparatory or explanatory documents for these Conventions set or suggest any limitation to the principle of allowing partial or multiple priorities.

The authoritative explanatory document² to the Paris Convention confirms that it was the intention to allow different parts of the ultimately claimed subject matter to rely on different priority applications (or priority dates) and thus to allow original and additional subject matter, covered by one and the same claim, to be assigned different priority dates.

As to Article 88 EPC, the Minutes of the Munich Diplomatic conference of 1973 may be used for guidance as to the intentions of the legislators. These Minutes testify that the FICPI Memorandum C was an essential element in the process of drafting the EPC (see also G2/98, par. 6.4, and

² Bodenhausen "Guide to the application of the Paris Convention for the Protection of Industrial property" (Stockholm 1967 version), Article 4, Section F. See in particular under (b) and (d). Note (b) reads: "*It frequently happens that an invention is not immediately complete, so that, even after a patent application has been filed for it, improvements or additions are found which are made the subject of other patent applications. The Convention makes it possible to claim, in one and the same later application in other countries of the Union, separate (multiple) priorities for the different parts of the invention, based on the various first applications made in respect of each of those parts, provided, of course, that these various applications are filed within the term of priority counted from the first application*" (emphasis added).

T577/13, par. 11.7). The Memorandum is quoted in almost every decision or article which discusses the metes and bounds of the priority right. The Memorandum advocates in favour of multiple priorities, of which partial priorities is a particular subset. In compliance with the Memorandum, generic “or”-claims, i.e. different, alternative subject-matters encompassed by a single claim, may have different content (genus type terms such as chemical formulae, ranges, broadening the field of use). The Memorandum suggests that acknowledging multiple priorities would have advantages, such as avoiding claim proliferation. It then states that the claiming of partial priorities should be governed by the same principles as multiple priorities and that “... it would be appropriate to claim a partial priority in situations corresponding to the ‘or’-situation under ‘Multiple Priorities’, the European Patent Application itself taking the place of the second priority document”.

Thus, the legislators clearly approved of the concept of partial priority. As the examples of the Memorandum encompass generic situations, the legislators obviously approved of the concept of partial priority for generic “or”-claims as well. No restriction appears to have been contemplated to this principle of partial priorities.

G2/98 also goes back to the FICPI Memorandum (par. 6.4). G2/98 had to deal with the question of the President whether the right to priority is determined by strict reading of the priority document or by a more loose correspondence between the priority document and the claim under review. It answered the question in favour of the first, i.e. the “same invention” of Article 87(1) EPC requires a direct and unambiguous disclosure as derivable by the skilled person, i.e. essentially the same standard as for allowable amendments within a patent (application) under Article 123(2) EPC.

In developing its opinion, G2/98 analyses Article 4F of the Paris Convention and Articles 87 to 89 of the EPC (par. 2 to 6) and, in passing, goes into the question of multiple priorities under Article 88(2) EPC. It concludes, taking the FICPI Memorandum as guidance, that *“As regards the “OR”-claim [...] a claim directed to A or B can enjoy the first priority for part A of the claim and the second priority for part B of the claim [...]. The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2) EPC, second sentence, is perfectly acceptable under Articles 87(1) and 88(3), provided³ [...]”* (emphasis added) (par. 6.7). It may be noted that herein the EBoA equates “feature” with “part” and in par. 6.2, it equates “element” (Article 88(3) EPC) with “subject-matter”.

In par. 6.8, G2/98 considers this acceptability of generic terms for covering parts differing in priority basis to be in support of a narrow interpretation of “the same invention” which the EBoA, for that matter, equates with “the same subject-matter”. Since this – to advise whether a narrow or more lenient interpretation should apply – was precisely the task of the EBoA in G2/98, the considerations about multiple priorities in par. 6.3-6.7 must be read in this context. It was neither

³ The proviso “... that it gives rise to the claiming of a limited number of clearly defined subject matters ...” is discussed below, under Questions 2 and 3.

the task for the EBoA nor the apparent desire of the EBoA to interpret the provisions for partial or multiple priorities as such.

In summary, neither the black letter law (Paris Convention, EPC), nor the intentions behind it (Munich Diplomatic Conference), nor the authoritative case law (EBoA decisions or opinions⁴) puts a limit on the applicability of multiple (or partial) priorities. In particular, where the subject matter of a claim of a European patent (application) has two or more parts, each part being disclosed in a different priority-establishing application⁵, the priority of these priority-establishing applications must be acknowledged for the corresponding parts of the claim, with each part being attributed to one of the priority-establishing applications.

The inevitable – and originally intended – result is that any part of a claim which enjoys the priority of a certain priority document is protected against the disclosure of that priority document in whatever form because priority must be acknowledged for that part and hence the effective dates for the purpose of Article 54(3) EPC are the same. On the other hand, any part which does not enjoy the priority of that priority application, because it was not disclosed therein, is novel over that priority application, precisely because the part was not disclosed therein.

In practice, in a case where there is no intervening prior art, it is always possible to divide a claimed subject matter into one or more parts which can rely on a priority-establishing application and one or more parts which cannot and which, therefore, are novel over that priority-establishing application. So, in case of a later subject matter claiming the priority of a narrower subject matter, the later subject matter can always be divided in one entity, which enjoys priority and is novel over the disclosure in the priority application because it is entitled to priority, and another entity which does not enjoy priority but is still novel over the disclosure in the priority application because that subject matter is not disclosed in the priority application. The two entities are separated by a dividing line, but it does not matter where the dividing line is situated or how it is defined, because the mere existence of the two entities – one enjoying priority and the other not, but both still being novel – results in the whole subject matter not being prejudiced by the priority disclosure.

Taking only one set of examples of a range:

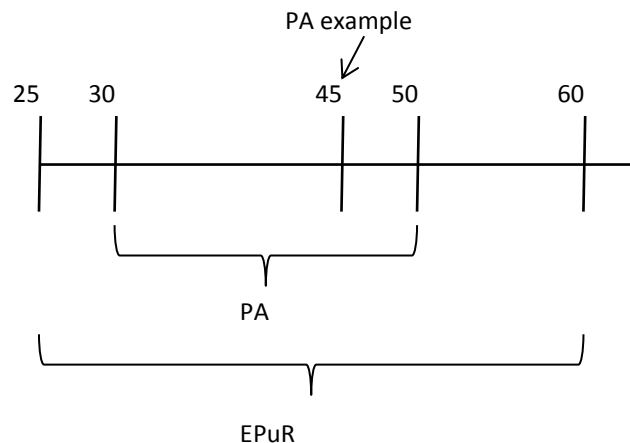
- a claim in the PA includes a range of 30-50 for a certain feature A (for example percentage of a component in a composition or temperature of a process);
- the PA contains an Example with the value of 45 for feature A (and the other features also being within the claim);
- the EPuR claims a range of 25-60 for the same feature but is otherwise the same as the claim in the PA;

⁴ While G2/98 is the only EBoA opinion discussed here, others can be considered relevant as well, although less so. Some of the other amicus curiae briefs discuss other EBoA case law, such as G3/93, see e.g. Bremi (III.1), Brettel, page 3-4. Their conclusions are the same.

⁵ A “priority-establishing application” can be a priority application, i.e. a(nother) application the priority of which is claimed, but it may also be the European application itself for subject-matter disclosed therein for the first time.

- the EPuR contains the same Example; and
- the content of the PA is published in a European application (as the priority application itself or as a parent/divisional) after the filing date of the EPuR.

This is reflected by the following figure:



The following parts (“alternative subject-matters”) can be discerned:

1. the subject matter having all the features of the claim including the range 30-50 for feature A;
2. the subject matter having all the features of the claim including the range 25-30 for feature A; and
3. the subject matter having all the features of the claim including the range 50-60 for feature A.

Part 1 is entitled to priority and parts 2 and 3 are not entitled to priority, but are novel over the PA. So nothing of the claimed scope is prejudiced by the content of the PA (obviously parts 2 and 3 may be affected by other (third party) prior art published or established before the filing date of the EPuR).

This is a relatively straightforward case. As a further, slightly more complicated example, assume that the PA (and the EPuR) contain an Example exhibiting the value 55 for feature A, which is outside the claim of the PA, but within the claim under review. The number of parts may change then, but not the principle, nor the effect:

The following parts (“alternative subject-matters”) can then be discerned:

1. the subject matter having all the features of the claim including the range 30-50 for feature A;
2. the subject matter having all the features of the claim including the range 25-30 for feature A;

3. the subject matter having all the features of the claim including the range 50 up to (and not including) 55 for feature A;
4. the subject matter having all the features of the claim including the value 55 for feature A;
and
5. the subject matter having all the features of the claim including the range from (and not including) 55 to 60 for feature A.

Here, parts 1 and 4 are entitled to priority and parts 2, 3 and 5 are not entitled to priority, but are novel over the PA. So, again, the claimed scope is nowhere prejudiced by the content of the PA in whatever form.

The precise number of parts is not decisive. The last example could also be envisaged to have 4 parts: part 3 relating to the range 50-60 with the exception of 55 and part 4 relating to the value of 55, with the same result.

It is also immaterial how a point value is interpreted, whether mathematically, i.e. as a point without any breadth or, more practically, as a range of rounding or a range of uncertainty between 54.5 and 55.5, or anything else. This is because the difference neutralises itself. Anything that is considered to be part of the point enjoys the priority and anything outside it – which is necessarily and independently of the consideration complementary to the point – is novel over the point. The same applies to end points of continuous ranges⁶. Any other interpretation is legalistic fiddling and outside real technical life.

More examples can be given and some are given in the various other amicus curiae briefs and all lead to the same result.

The same situation applies even where there is intervening prior art. This is explained in more detail in connection with our comments on Question 4. For instance, if the applicant for the EPuR had published the priority document after filing the priority application but before filing the EPuR, then that publication would not be prior art against any part of the claim entitled to the priority date and would not destroy the novelty of any subject matter in any part of the claim not entitled to priority. The only difference would be that the publication would be prior art for the purposes of inventive step against any part of the claim not entitled to priority.

There may be rare situations where there is an intervening publication from a third party and it is not clear whether its content falls within or outside the scope of the part of the claim entitled to priority. If it falls inside, it cannot be used to attack the novelty of the claim, but if it falls outside it can be used to attack the part of the claim which is not entitled to priority. (In either case, it can be used to attack the inventive step of the part of the claim not entitled to priority.)

⁶ Technically speaking, there is no difference between “from A to B” and “between A and B”, at least as long as there is no specified breadth of A and B beyond a mere point of reference.

Even the possible existence of these rare situations does not require a positive answer to Question 1. Question 1 should still be answered **NO** and partial priorities should be acknowledged. The potential problem of deciding where the dividing line should be drawn can then be decided by the Boards using the established jurisprudence relating to whether unclear features can be used to establish novelty. If the Board considers that there is no clear dividing line, the Board should adopt an interpretation which is the least favourable to the applicant/patentee.

So, in conclusion, the law and its background and interpretation, as well as the practice fully support a maximum application of partial and multiple priorities and such application results in avoiding a PA becoming detrimental – whether later-published as a European patent application (toxic priority) or as the priority disclosure in a parent/divisional scenario (poisonous divisional) – to a claim of a European patent application claiming the priority of the PA.

In this context, the principle and the effect do not depend on whether the priority application is a European patent application and is published as such (poisonous priority) or whether it becomes publicly available as the priority document of a follow-up European parent or divisional application (poisonous divisional).

Thus, the answer to Question 1 must be **NO**.

Question 2

2. *If the answer is yes, subject to certain conditions, is the proviso "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" in point 6.7 of G 2/98 to be taken as the legal test for assessing entitlement to partial priority for a generic "OR"-claim?*

Since **epi's** elaborated answer to Question 1 is **NO**, and Question 2 starts from the premise that the answer is "YES", if the EBoA agrees with **epi**, there is no need to answer Question 2. However, if the EBoA were – against what **epi** considers is correct – to tend to answer Question 1 in the affirmative, **epi** wishes to express its thoughts about such a situation.

Question 2 focuses on the last half-sentence of paragraph 6.7 of G2/98 which says that "*... the use of a generic term or formula [...] for [...] multiple priorities [...] is perfectly acceptable [...], provided that it gives rise to the claiming of a limited number of clearly defined alternative subject matters*".

As discussed above under Question 1, it was neither the task, nor the apparent intention, of the EBoA in G2/98 to interpret the law as to the allowability of using multiple (or partial) priorities, and the EBoA only looked into the matter of multiple priorities to find support for answering the question of how strict the correspondence between a priority disclosure and ultimately claimed subject-matter must be for validly claiming priority. It may be added that, even if the EBoA had any intention, beyond the question asked by the President, to qualify the allowability of multiple priority

claiming, it did not indicate which problem was in need of qualification or how such problem would have been solved by a qualification. Under these circumstances, it can only be seen that this half sentence of par. 6.7 does nothing other than support the EBoA's final conclusion that the "same invention" should be interpreted narrowly. Moreover, making the proviso obligatory, would add a further condition to be met for acknowledgment of a partial priority beyond what is foreseen by the Paris Convention.

Therefore, Question 2 deserves the answer **NO**.

Question 3

3. If the answer to question 2 is yes, how are the criteria "limited number" and "clearly defined alternative subject-matters" to be interpreted and applied?

The answer **NO** to Question 2 would have the consequence that Question 3 need not be answered. However, in case the EBoA would tend to answer both Questions 1 and 2 in the affirmative, **epi** observes the following.

It appears to **epi** that this question is unnecessary or impossible to answer.

In many cases, it will not be necessary to answer. In particular, where there is no intervening art, the answer is abundantly clear (the limited number is two – that entitled to priority and that not entitled to priority – and there is no need to "clearly define" – the definition makes no difference at all, as explained above).

In other cases, any interpretation will be open to further interpretation and will vary from case to case. "limited" by itself is unclear out of context, as is "clearly defined". The terms are not defined in G2/98 as they were not related to the questions asked in G2/98. Looking for interpretation from the EBoA would be of no use as the EBoA cannot possibly envisage all the situations to which the interpretation could apply and so will inevitably be flawed.

It seems to **epi** that, if there is a need in any particular case for a Board to decide on whether a claim can be entitled to more than one priority date, the Board should answer in the affirmative but then use the established principles for dealing with unclear features in claims for deciding what the effect of the multiple priorities is on a case-by-case basis.

Hence, **epi** considers that, even if the EBoA decides to address this question, it should answer it to the effect that the Boards should evaluate whether the possibility of a claim having multiple priorities has an effect on the validity of the claim on the basis of existing case law on the use of unclear features in considerations of novelty.

Question 4

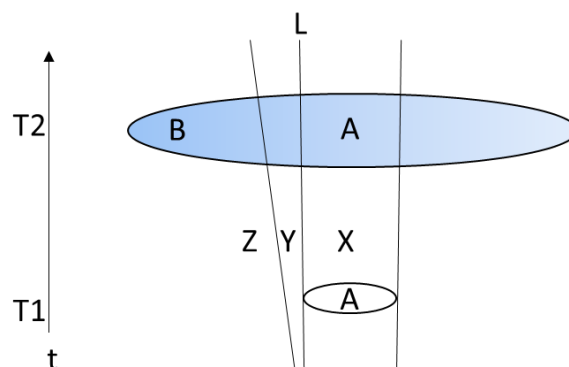
4. If the answer to question 2 is no, how is entitlement to partial priority to be assessed for a generic "OR"-claim?

As elaborated under Questions 1 and 3 above, entitlement to partial priority (for alternative subject matters or generic "OR"-claims) does not need to be assessed. A claim is entitled to have multiple priorities under all circumstances.

No Intervening Art

In the absence of any intervening art, the content of a PA cannot prejudice the applicant's entitlement to obtain a patent for the subject matter of even a broader claim in a later application claiming priority from the PA.

As explained above, where a generic "OR"-claim is entitled to partial priority: in respect of the subject matter of the generic "OR"-claim found in the PA (A in the figure below), lack of novelty under Article 54(3) EPC cannot be found. In respect of the subject matter of the generic "OR"-claim not found in the PA (B in the figure below), the content of the PA cannot destroy the novelty of part B of the generic "OR"-claim under Article 54(3) EPC. There is therefore no need to consider the dividing line (L) between subject matters A and B.



In effect, this means that an applicant who files a first application (the PA) of limited claim scope (A) at T1 and subsequently, within the priority period at time T2, files a second application (the EPuR) based on the first application, but which expands the claim to cover a broader scope (AB), the filing of the PA of limited scope (A) cannot prejudice his seeking patent protection for a claim of broader scope (AB).

T1 is the effective date of any application limited to subject matter A; and T2 is the effective date of applications directed to subject matter B.

Thus, if, after an applicant files a PA for invention A at time T1, the state of the art does not advance vis-à-vis the priority application, for example because third parties continue to think in the same manner as before the PA, the same prior art would be citable against the application for AB as for the priority application. The second application would be assessed in exactly the same way, without priority being an issue, as if the applicant had made his invention AB at time T2.

There is Intervening Prior Art

Now consider the situation if there is intervening prior art (X, Y, Z in the figure above) published after the filing of the PA (T1) and before the later filing date of the EPuR (T2) and the circumstances where this might be employed to assess both Articles 54 and 56 EPC of the second application.

Even if a subsequent publication, i.e. published by a third party (X in the figure above) or the applicant (A=X in the figure) after T1, is strictly limited to the teaching of the PA, such publication will be citable against the second application as its claims are not strictly limited to A.

In this case, for the applicant to secure a patent with scope AB in the second application, B would have to be independently inventive over the subject matter of A.

Clearly, if, after the filing of the PA, either the applicant or the third party discloses the broader applicability of invention A (Z in the figure above), this would prevent the applicant from securing a patent for AB, but would not prevent him from securing a patent strictly limited to subject matter A.

The only area where there might be any uncertainty is where there is an intervening publication which may or may not be within the scope of A. If the dividing line between A and B is the vertical line L, then Y is outside the scope of A and can be used to attack both the novelty and the inventive step of B. If the dividing line is the angled line next to L, then Y is inside A and so Y can only be used to attack the inventive step of B. Such a situation can only arise if there is a lack of clarity about where the dividing line is. However, there is no need for the EBoA to give any guidance on what to do in such situations as there is already established jurisprudence about how to deal with unclear features in claims in relation to novelty.

Even respecting partial priority, and so avoiding the poisoning effect of the earlier application A, but taking into account the jurisprudence on unclear features, the Y disclosure can be employed in exactly the same manner as any Article 54(2) document to assess the inventiveness, and possibly the novelty, of the invention B in the second application.

So the question rightly becomes: did another publication teach a broader applicability of invention A, so destroying the novelty or being relevant to the inventiveness of invention AB.

If so, an applicant could only secure a patent strictly limited to A in either the first or second application.

In summary, the answer to Question 1, clearly must be **NO** and the answer to Question 4 is that partial priority must be respected in such situations and that this can be achieved under existing jurisprudence without adversely affecting third party rights.

Question 5

5. If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Article 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon?

With this question, the referring Board seeks an answer to the issue of the interpretation of Article 54(3) EPC for the case where the content of the PA is reflected in a European patent application which is a family member (parent, divisional or sister) of the European patent (application). In fact, this question boils down to whether family members (e.g. the parent of a divisional or vice versa, a sister application having same time rank) of the EPuR can be considered as “European patent applications as filed [...] [the content of which] shall be considered as comprised in the state of the art” and thus whether self-collision between a parent and a divisional is possible as a matter of principle. (**epi** wants to mention that examining divisions have applied self-collision by citing a European patent application against itself and **epi** considers that this is not correct).

This issue has extensively and effectively been commented on by various other amicus curiae briefs, for example the submission of Vossius, and **epi** supports these comments.

A **NO** answer would finally terminate the poisonous divisional practice, i.e. the possibility of a priority document being destructive to the claims of an application claiming its priority to the extent that relevant parts of the priority document are published in a family member European application. It would do so irrespective of the answer to Questions 1 to 4, which deal with poisonous priorities at large.

epi is of the opinion that every common sense and logical interpretation of Article 54(3) EPC is clearly resistant to the concept of self-collision. For example, it should be noted that Article 54(3) EPC starts with the word “[a]dditionally”. The “addition” can only be with regard to Article 54(2) EPC, which defines the state of the art (as introduced in Article 54(1) EPC as relevant for novelty) vis-à-vis “the European patent application”, which is the European patent application (or patent for that matter) under (novelty) review. Thus, the “European patent application” (under review) of Article 54(2) EPC must be something different from the “European patent applications” (potentially added to the prior art) of Article 54(3) EPC. Thus, Article 54(3) EPC must be read as “other European patent applications”. Since the disclosure of a legitimate divisional – already by the word “divisional”, but also by the background, the intention, the wording and the interpretation of Article 76(1) EPC (see especially non-extended subject-matter, same effective filing date same priority) – can for all legal and substantive purposes not extend beyond that of its parent. Therefore, it is not another European patent application qualifying under Article 54(3) EPC. [Applications claiming priority from the same priority application cannot anticipate each other.] Reasoning otherwise might lead to the absurd conclusion that even a WO publication, which under Article 153(5) EPC is



equated with a European patent application, could be cited against its later European patent application.

In summary, the answer to Question 5 must be a clear **NO**.

Conclusion

In **epi**'s view, Question 1 should be answered **NO**. The EPC requires that multiple priorities, of which partial priorities is a subset, should be allowed. The EPO, and in particular the Boards of Appeal, should decide on whether a claim having partial priority lacks novelty or lacks an inventive step using the established jurisprudence regarding the effect of unclear terms in claims as regards novelty.

Oral Proceedings

If the EBoA were to summon the parties to oral proceedings, **epi** would be pleased to expand on the points made in this brief if it would assist the EBoA.

Encl. (copies have been provided on a CD):

Attachment 1- G.H.C BODENHAUSEN "GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY AS REVISED AT STOCKHOLM IN 1967"

Attachment 2- FICPI MEMORANDUM C, MUNICH DIPLOMATIC CONFERENCE SEPTEMBER 10 TO OCTOBER 6, 1973