



# MULTIPLE AND PARTIAL PRIORITIES

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# OVERVIEW

- What is this all about?
- Significant events
  - Paris Convention
  - European Patent Convention
- So what's the problem?
  - G2/98
  - G1/15
  - Life after G1/15



WHAT IS IT ALL ABOUT?



# PRIORITY

- Right of priority allows a subsequent filing not to be invalidated by publication or exploitation of the invention
  - Article 4B, Paris Convention 1979
- No mention of what is in the subsequent filing in relation to the first filing



# MULTIPLE AND PARTIAL PRIORITY

No country of the Union may refuse a priority or a patent application on the ground that the applicant claims **multiple priorities**, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains **one or more elements that were not included in the application or applications whose priority is claimed**, provided that, in both cases, there is unity of invention within the meaning of the law of the country.



# MULTIPLE AND PARTIAL PRIORITY

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions

- Article 4F, Paris Convention 1979



# AN EXAMPLE



*P1 – 1 Mar 16*

1. A lemon



*P2 – 1 Sep 16*

1. An orange



*Reg – 1 Mar 17*

1. A citrus fruit  
2. A lemon or an orange



# AN EXAMPLE – PRIORITY DATES

## Claim 2

A lemon or an orange



PD = 1 Mar 16

PD = 1 Sep 16

- Multiple priorities within a single claim



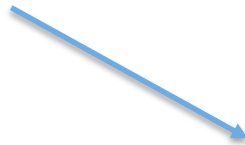


# AN EXAMPLE – PRIORITY DATES

## Claim 1

A citrus fruit

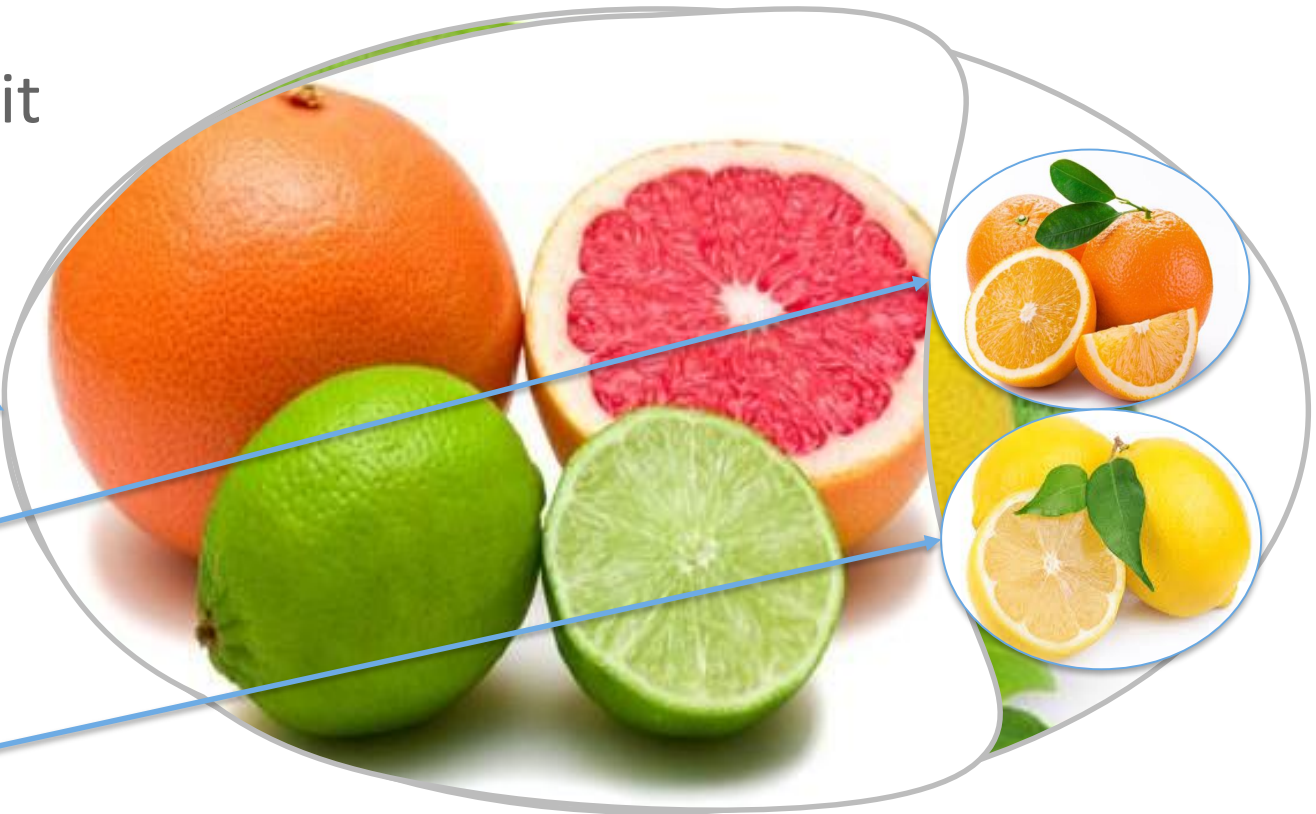
PD = 1 Mar 17



PD = 1 Sep 16




PD = 1 Mar 16



# SIGNIFICANT EVENTS

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**H** | **S** **T**  **R** **Y**

# PARIS CONVENTION

- Paris 1883
- Brussels 1900
- Washington 1911
- The Hague 1925
- London 1934
- Lisbon 1958
- Stockholm 1967
- Amended 1979



# PRIORITY

- 1883 – Paris
  - Right of priority first introduced in a treaty
  - 6 month period
- 1900 – Brussels
  - Priority period extended to 12 months
  - Allowed Germany to join the Union



# MULTIPLE PRIORITY

- 1911 – Washington
  - Proposal to allow multiple priorities, to avoid need for patents of addition for improvements made in priority year
  - Objected to by Great Britain and not adopted
- 1925 – The Hague
  - French proposal – maximum of 4 priorities!
  - Multiple priorities allowed, but tied to possibility of divisionals



# MULTIPLE PRIORITY

- Article 4F, the Hague Act:

If an application for a patent contains a claim for multiple priorities or if examination reveals that an application relates to more than one invention, the competent authority must, at least, allow the applicant to divide his application in accordance with conditions determined by the domestic legislation, and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any.



# MULTIPLE PRIORITY

- 1934 – London
  - Multiple priorities discussed again
  - Article 4F introduced, and previous 4F becoming 4G

Article 4F:

No country of the Union may refuse a priority or a patent application on the ground that it contains multiple priorities, provided that there is unity of invention within the meaning of the law of the country.



# MULTIPLE PRIORITY

- 1934 – London
  - New Article 4H introduced
  - Provides suggestion as to what the subject matter of priority is

Article 4H:

The priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims made in the application to the country of origin, provided that these elements are clearly specified in the description





# PARTIAL PRIORITY

- 1958 – Lisbon
  - First acknowledgement of partial priority
  - Follows from earlier development of multiple priorities
  - Article 4F was amended to
    - Allow multiple priorities from different countries
    - Specify the possibility partial priorities
    - Clarify new elements can give rise to their own priority right (not shown)



# PARTIAL PRIORITY

Article 4F:

No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, **even if they originate in different countries**, or **on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed**, provided that, **in both cases**, there is unity of invention within the meaning of the law of the country.

...



# PRIORITY IN THE EPC

- Drafting of the EPC took place in 1973
- A key document in understanding the provision on priority is:

FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE

Date: August 20, 1973  
Revised: August 28, 1973

re: Munich Diplomatic Conference  
September 10 to October 6, 1973.

MEMORANDUM C

on multiple priorities (Art. 86 (2)) and partial  
priorities (Art. 86 (3)).



# PRIORITY IN THE EPC – FICPI MEMO C

- Multiple Priorities
  - Should be allowed in application
  - Should be allowed within a claim
    - Wasn't possible in all countries at the time
- Two types of claim
  - Type A + B claim (“AND” claim)
  - Type A or B claim (“OR” claim)



# PRIORITY IN THE EPC – FICPI MEMO C

- Type A + B claim
  - “AND” claim
  - Claim too narrow to be supported by the disclosures of the first priority document
  - E.g. Claim to a lemon with a cocktail stick in it
  - No priority!



# PRIORITY IN THE EPC – FICPI MEMO C

- Type A or B claim
  - “OR” claim
  - Claim too broad to be supported by the disclosures of the first priority document
  - First priority document – A
  - Second priority document – B
  - Application – A or B
  - Each part of claim can have respective priority



# PRIORITY IN THE EPC – FICPI MEMO C

- “It is of course immaterial whether the word “or” actually appears in the claim, or is implied thought the use of a generic term, or otherwise.”
- Examples
  - Broadening of chemical formulae
  - Broadening of range (Temperature, Pressure, Concentration, etc.)
  - Broadening of field of use



# PRIORITY IN THE EPC – FICPI MEMO C

- Partial priority
  - Only discussed briefly
  - Concern of clarity of wording based on Paris Convention





# PRIORITY IN THE EPC – ARTICLES

- Article 88(2) EPC:
  - Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries. Where appropriate, multiple priorities may be claimed for any one claim. ...



# PRIORITY IN THE EPC – ARTICLES

- Article 88(3) EPC:
  - If one or more priorities are claimed in respect of a European patent application, the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed.



# PRIORITY IN THE EPC – ARTICLES

- Article 88(4) EPC:
  - If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the documents of the previous application as a whole specifically disclose such elements.



# SO WHAT'S THE PROBLEM?



# PRIORITY AT THE EPO – CASES – G2/98

- Referral by the President of the EPO relating to the phrase “same invention” requirement of priority in the EPC
- How closely do the application and priority application need to correspond?
  - Reinforced that priority at the EPO should be considered in the same way as added subject matter
- What if the application is broader than the priority application?
  - Referred to FICPI Memorandum C



# PRIORITY AT THE EPO – CASES – G2/98

- However, introduced the concept of *“a limited number of clearly defined alternatives”* in the consideration of “OR” claims
  - This concept wasn’t necessary for the decision in this case
  - Seemed to have no basis
- Spawned the beasts of “poisonous priorities” and “poisonous divisionals”



# G 1/15

- Referral from Technical Board in T 557/13
- Opposition against a patent where the claim was broader than the disclosure in the priority document
- Following G2/98, Opposition Division (OD) concluded
  - “the intermediate generalisation ... does not give rise to the claiming of a limited number of clearly defined alternative subject matters
  - Therefore, no claim 1 has no priority



# G 1/15

- Example 1 in the application was identical to Example 1 in the priority document
  - This example had priority
  - Therefore, claim 1 lacked novelty over example 1!
- Referral on the basis of diverging case law
  - T1222/11 and T571/10 vs. G2/98
- 5 questions referred
- Numerous submissions received





- Q1

"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?



- President of the EPO
  - Admitted case law still developing, but
  - Preferred the certainty of the approach of G2/98
- Amicus curiae
  - Majority in favour of broad approach as explained in FICPI Memo C
  - Including the submission of FICPI!



# G 1/15 – THE DECISION

- Answered Q1 in the negative
  - Restored the approach of the FICPI Memo C
- Detailed analysis of what priority is
  - A ‘protective’ right, relating to the first to file system
  - Barrier against 3<sup>rd</sup> party disclosures
  - Must operate in the same way for the applicant
  - Operates to exclude the collision of subject-matter disclosed during the priority period with identical subject-matter disclosed in a priority document



# G 1/15 – THE DECISION

- Partial and multiple priorities
  - Noted that EPC and Paris Convention provisions identical
  - The idea of elements in the Paris Convention allows for partial priority
  - FICPI Memorandum C was acknowledged in the travaux préparatoires as reflecting the intention of the EPC as drawn up
  - Must fit with the PCT
  - Provision laid down in G2/98 cannot be construed as implying a further limitation on the right of priority



# LIFE SINCE G1/15

- The issue of partial priority keeps coming up
- T260/14
  - Opposition filed and decided before G1/15
  - Reversed on appeal following G1/15
  - An example of “poisonous priority”
    - Alleged loss of priority
    - Priority document published with example in patent
    - Example inside scope
    - Scope included multiple possibilities, so is an “OR” claim
    - G1/15 followed



# WHAT ELSE?

- Identifying the first application
- Other jurisdictions
  - Australia and New Zealand



# QUESTIONS?

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