



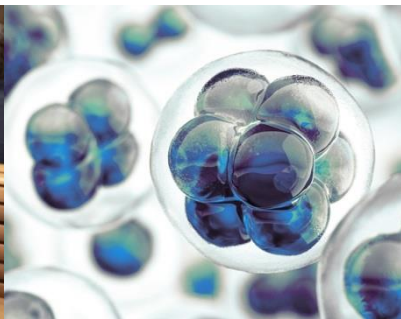
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Formal entitlement to claim priority – An EPO perspective

FICPI 18th Open Forum, Vienna



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Examiner, European Patent Office



10 October 2019

Formal entitlement to claim priority under the EPC

Agenda

- **Legal basis and Examination Guidelines**
- Succession in title
 - General principle
 - Three-step test
 - Determining the applicable law
 - Examples from case law
- Joint applicants
 - Missing priority filing applicants
 - Joint PCT applicants

Legal basis and Examination Guidelines

- "Any person who has duly filed [...] an application [...] or his successor in title, shall enjoy [...] a right to priority"

- Same applicant(s)

If not

- Successor(s) in title

▶ **EPO has the power to assess entitlement/succession.**

Article 87(1) EPC
GL 2018, A-III, 6.1

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Succession in title

General principle

Transfer of priority application, or of priority right as such...

...before the filing date of the later European or Euro-PCT application...

...in accordance with the relevant national provisions.

GL 2018, A-III, 6.1
E.g. T 205/14, r. 3.6.1

Succession in title

Three-step test

T 205/14, r. 3.6.4 – 3.7.6

- What is the law applicable to the transfer?

- What are the requirements for a valid transfer under the applicable law?

- Are the requirements met?

Succession in title

Determining the applicable law

- Choice-of-law clause in written assignment

If not

- Law most closely connected to succession

?

- Law governing relationship between parties to succession

Succession in title

Case law on assignments under US law

- **"employed to invent" under US law**
 - automatic assignment of employer's right to inventions and patents to employer before priority application is filed

- **"nunc pro tunc assignment" under US law**
 - assignments concluded after the filing of the priority claiming application with retro-active effect
 - not recognised under the EPC

pending as
T 434/15

T 1201/14, r. 3.2.1
with further reference

Formal entitlement to claim priority under the EPC

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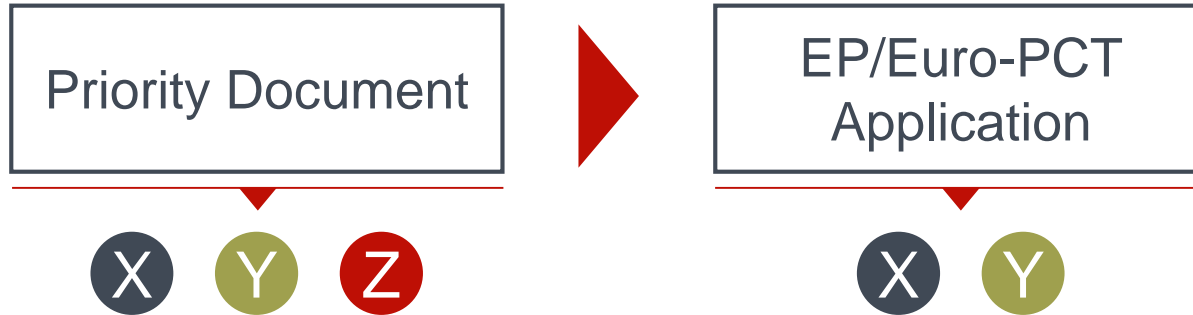
- Legal basis and Examination Guidelines

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- **Joint applicants**
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Joint applicants

Missing priority filing applicants



T 788/05, r. 2

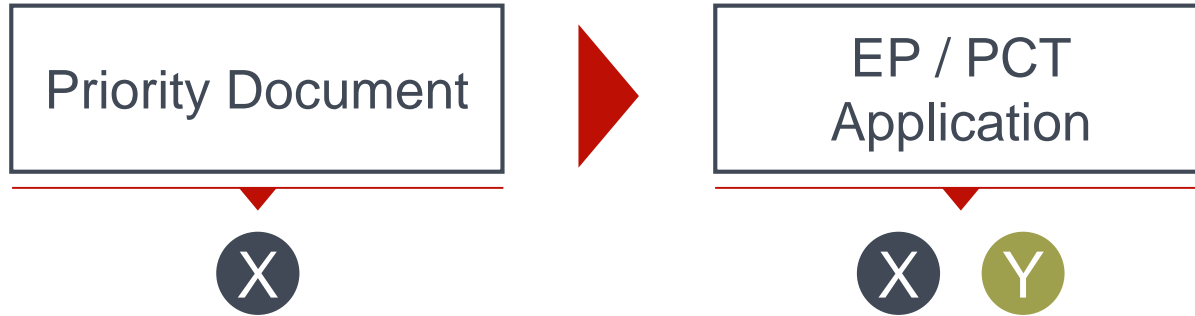
▶ Proof of transfer required.

▶ Priority right belongs simultaneously and jointly to all the applicants of the priority application.

▶ Inventorship in subject-matter for which priority is claimed irrelevant under EPC.

Joint applicants

Joint PCT applicants – no evidence required



GL 2018, A-III, 6.1

T 1933/12, r. 2.4

Article 118 EPC

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