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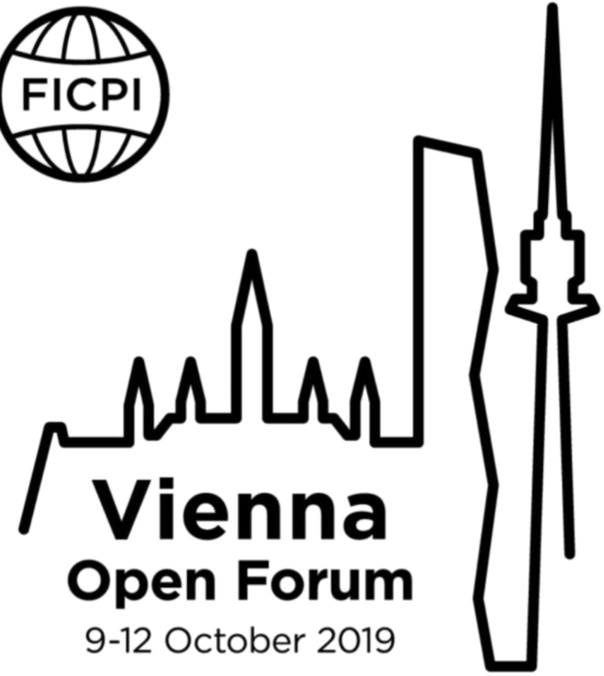
The forward-looking IP firm

# Transfer of Priority Rights

## CRISPR-Cas 9 case & Equitable Title

Robert Watson
October 2019



# CRISPR-Cas9 at the EPO

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# CRISPR-Cas9 at the EPO

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- EP13818570.7 – EP-B-2771468
- The Broad Institute, MIT, Harvard University
- 12 Priority Applications filed in the US from 12 December 2012 to 17 June 2013
  - All applications were US provisionals filed in the names of inventors
- PCT application (PCT/US13/74819) filed on 12 December 2013
  - Filed in the name of The Broad Institute, MIT, and 4 inventors
  - r92bis change recorded from 4 inventors to Harvard University on 23 May 2014
  - EP patent granted on 11 February 2015
- 9 Oppositions filed
  - Novelty, Inventive Step, Sufficiency and Added Matter

# CRISPR-Cas9 at the EPO

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- Novelty attack was based on a lack of priority entitlement
- Maraffini named as applicant for P1, P2, P5 and P11
- Bikard and Jian named as applicants for P5 and P11
- All three employed by Rockefeller University – not named as a PCT applicant
  - Assignment of priority rights from inventor/applications to Rockefeller University dated 7/12/13 and 12/12/13
- Arbitration between Rockefeller University and Broad Institute over Maraffini inventorship took place separately – it was determined two days before Oral Proceedings that Maraffini was not entitled to be named as an inventor on the PCT!

# CRISPR-Cas9 at the EPO

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- Preliminary opinion of the Opposition Division followed EPO established practice

- Right of priority is vested on either the applicant or their successor in title
- In the case of lack of applicant's identity (if the validity of the priority is questioned) evidence is required that a valid transfer of the application from which priority is claimed (or the priority right as such) has taken place before the filing date of the later patent application
- If the earlier application is filed by joint applications, either all of them or their successor(s) in title should be amongst the joint applicants for the later application

# CRISPR-Cas9 at the EPO

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- Proprietors argued (at the Oral Proceedings) on three grounds

- I – The EPO should have no power to assess legal entitlement to the right of priority
- II – In case of joint/multiple applicants in a first application, the meaning of the term “any person” under Article 87 EPC should be interpreted to mean “one of some indiscriminately” of the co-applicants
- III – The meaning of “any person who has duly filed” should be interpreted according to national law, in this case US law

- Asking Opposition Division to reconsider established EPO practice

# I – No power to assess legal entitlement to the right of priority

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- Argued that assessment of righful owner of priority right implies a determination of ownership of property right, which was not intended to be part of EPO jurisdiction (ref to a preliminary opinion in T 239/16)
- Would require EPO to apply national law of all members (177) of the Paris Union, which would be an enourmous burden
- Challenge of a priority right should only be allowed by the alleged owner of that right
- Article 60 EPC on entitlement to a patent leaves this to national courts – the same should happen for priority

# I – No power to assess legal entitlement to the right of priority

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- Argued that assessment of righful owner of priority right implies a determination of ownership of property right, which was not intended to be part of EPO jurisdiction (ref to a preliminary opinion in T 239/16)
- Preliminary opinion in T 239/16 not binding as not needed to take final decision in that case
- OD does not dispute that EPO has no competence to assess rightful ownership of priorty right, i.e. inventorship
- Article 87(1) EPC provides sufficient legal basis for examination of legal entitlement
  - Substantive – “same invention”
  - Formal – declaration of priority & successor in title
- Not a determination of ownership, but whether validly claimed!

# I – No power to assess legal entitlement to the right of priority



- Challenge of a priority right should only be allowed by the alleged owner of that right
- OD distinguished right of person to bring a challenge for the legal competence of an organ to decide on such a right
- Article 60 EPC on entitlement to a patent leaves this to national courts – the same should happen for priority
- Article 60/61/138 EPC governs the division between the EPO and its contracting states complemented by legal fiction of Article 60(3) EPC
  - That applicant is assumed to be entitled to grant of EP patent
  - No equivalent fiction for the entitlement to priority

# II – "any person" under Article 87 EPC = "one of some indiscriminately"

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- Argued that the word "any" in Article 87 EPC should mean "one or some indiscriminately of whatever kind", so that any one of a plurality is sufficient
- Referred to Vienna Convention – Article 31
- "A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in light of its object and purpose"
- All three EPC texts bear such open, permissive meaning
  - English "Any person"
  - French "Celui qui"
  - German "Jederman"

# II – "any person" under Article 87 EPC = "one of some indiscriminately"

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- Paris Convention (in French) uses different terms
  - Articles 4A(1) and 4D – permissive form "any person", "Celui qui" "Quiconque"
  - Articles 4F and 4G – prescriptive form "the application", "le deposànt" "le demandeur"
- Implies Paris Convention has a permissive notion of who is allowed to claim priority, compared to who may prosecute the subsequent application
- Object and purpose of priority right is to assist applicant in obtaining international protection, so each and any of joint applicants should be able to exercise the right independently
  - EPO practice does not meet this object/purpose
  - C.f. US practice of one inventor in common

# II – "any person" under Article 87 EPC = "one of some indiscriminately"

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- Opposition division considered a change in practice "might have practical benefits for applicants"
  - But such a change would be far reaching and OD did not consider it "appropriate to deviate from established practice"
- OD considered that wording of Article 87 EPC does not provide an exclusive indication of which interpretation is correct, with the English and German forms being more permissive, and the French form being restrictive
  - All three texts are equally authentic and presumed to have the same meaning
  - French version of Paris Convention uses the restrictive term i.e. "the one who"
- Travaux Preparatories for both treaties offer no help in the view of the OD

# II – "any person" under Article 87 EPC = "one of some indiscriminately"

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- OD see a basis for the "all applicants" approach in
  - First commentaries to the Paris Convention onwards
  - EPO practice
  - EPO case law
  - Relevant national case law
    - German Patent Office decisions
    - Austrian Patent Office decisions
    - Czech Patent Office decisions
    - UK High Court
- EPO approach has held steady – all applicants (or more)
  - Supported by many text books

# II – "any person" under Article 87 EPC = "one of some indiscriminately"

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- Legal submissions – Scharen, Prof Strauss, Ladas (text book)
  - OD noted that the wording of the EPC/PC does not exclude the "at least one person" approach
- Considered claiming priority may be an exploitation of the common right in the first application, rather than an act of disposition of the common right, and therefore could be exercised individually
  - Mention of AIPPI Q194 on co-ownership & exploitation
- However, concern that such an approach would lead to a multiplication of proceedings with identical content
  - Contrary to the interest of patent offices and the public
- OD considered themselves bound to follow established practice!

# III - "any person who has duly filed" interpreted according to national law

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- It was also argued that the "any person who has duly filed" be interpreted by the national law of the place of filing of the priority application
  - Consistent with EPO approach to determining "successor in title"
- Would involve consideration of inventorship under US practice
  - Supported by many declaration (including John Doll, Judge Michel, Prof Thomas and Jim Pooley)
- OD did not follow this, partly as Case Law of Boards of Appeal make it clear than status/contribution of inventor not relevant to the EPO
- Also such an approach would complicate the determination of priority enormously!

# CRISPR-Cas9 at the EPO

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- Due to loss of some priorities, patent was revoked for lack of novelty over publication made in the priority year
- Case now under appeal – T844/18
- Proprietor argued further on all three approaches
- Asks for a Referral to the Enlarged Board of Appeal of six questions, including whether the EPO has the jurisdiction/competence to assess who is entitled to claim the right of priority; what "any person" means; and which is applicable for determining "any person"
- Oral proceedings scheduled for 5 days from 13 January 2020
- Watch this space!

# Equitable Ownership in the UK Courts

# Equitable title

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- A beneficial interest in property that gives the title holder the right to acquire legal title to the property, such as an obligation to assign
- In a series of cases in the UK courts, it has been sufficient to establish priority entitlement if the applicant holds the entire equitable interest at the relevant date
  - *KCI Licensing v Smith & Nephew [2010] EWHC 1487 (Pat)*
  - *HTC v Gemalto [2013] EWHC 1876 (Pat)*
  - *Fujifilm v Abbvie [2017] EWHC 395 (Pat)*
  - *Idenix v Gilead [2014] EWHC 3916 (Pat)*
- "When determining whether a person is a 'successor in title' for the purposes of the provisions, it must be the substantive rights of that person, and not his compliance with legal formalities, that matter."

# Accord and RCT [2017] EWHC 2711 (Pat)

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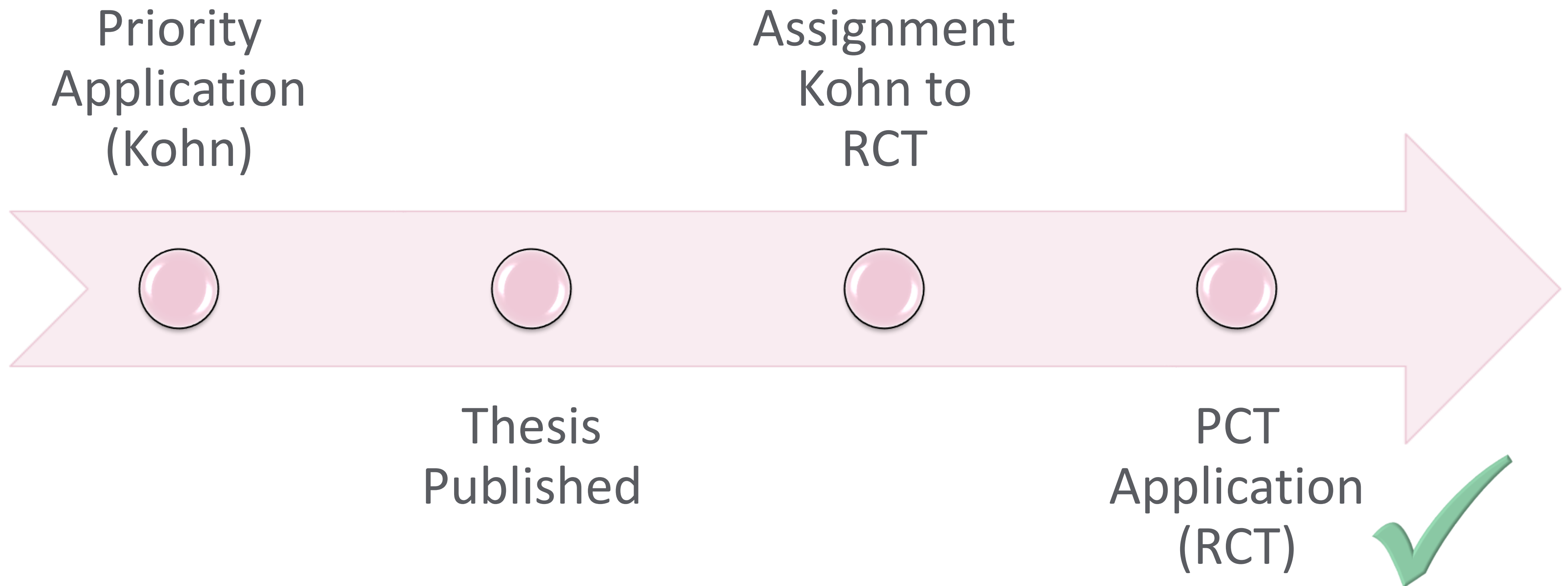

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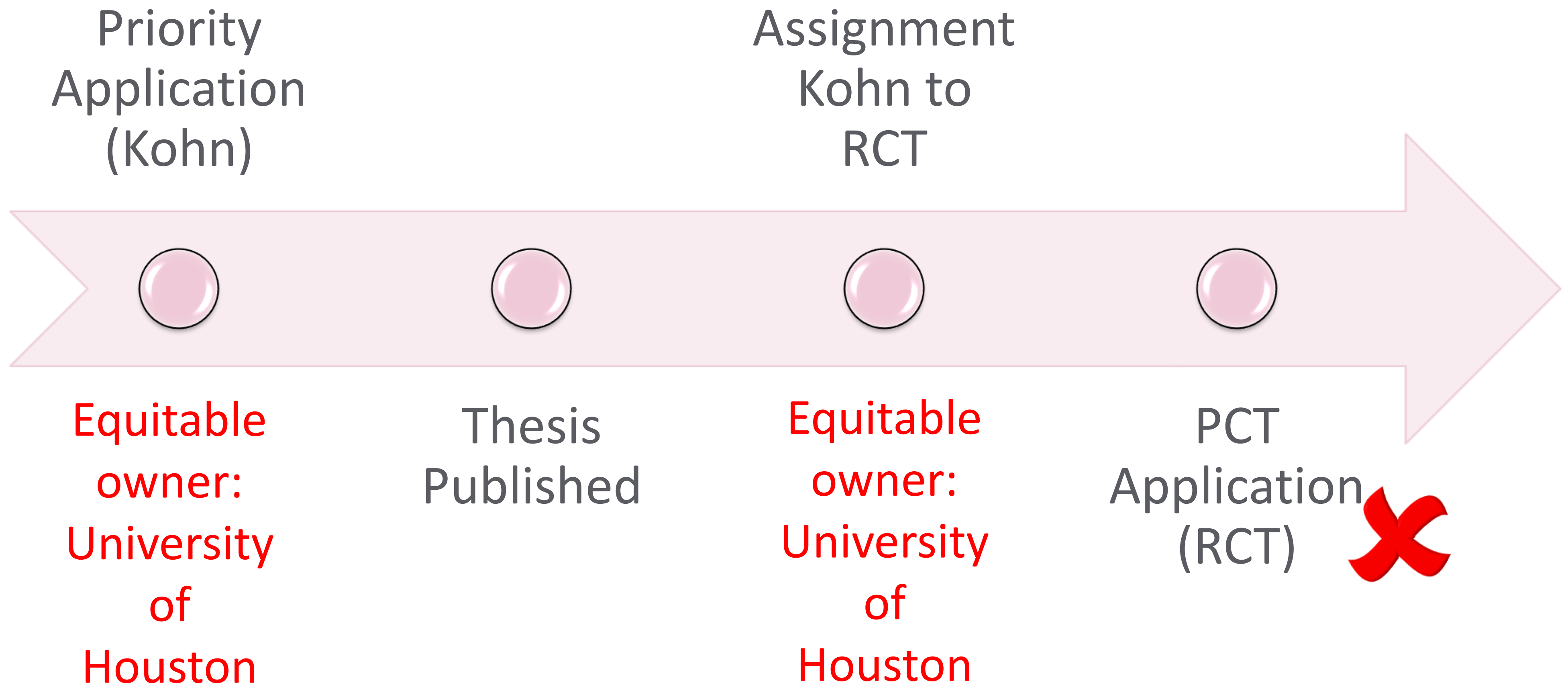

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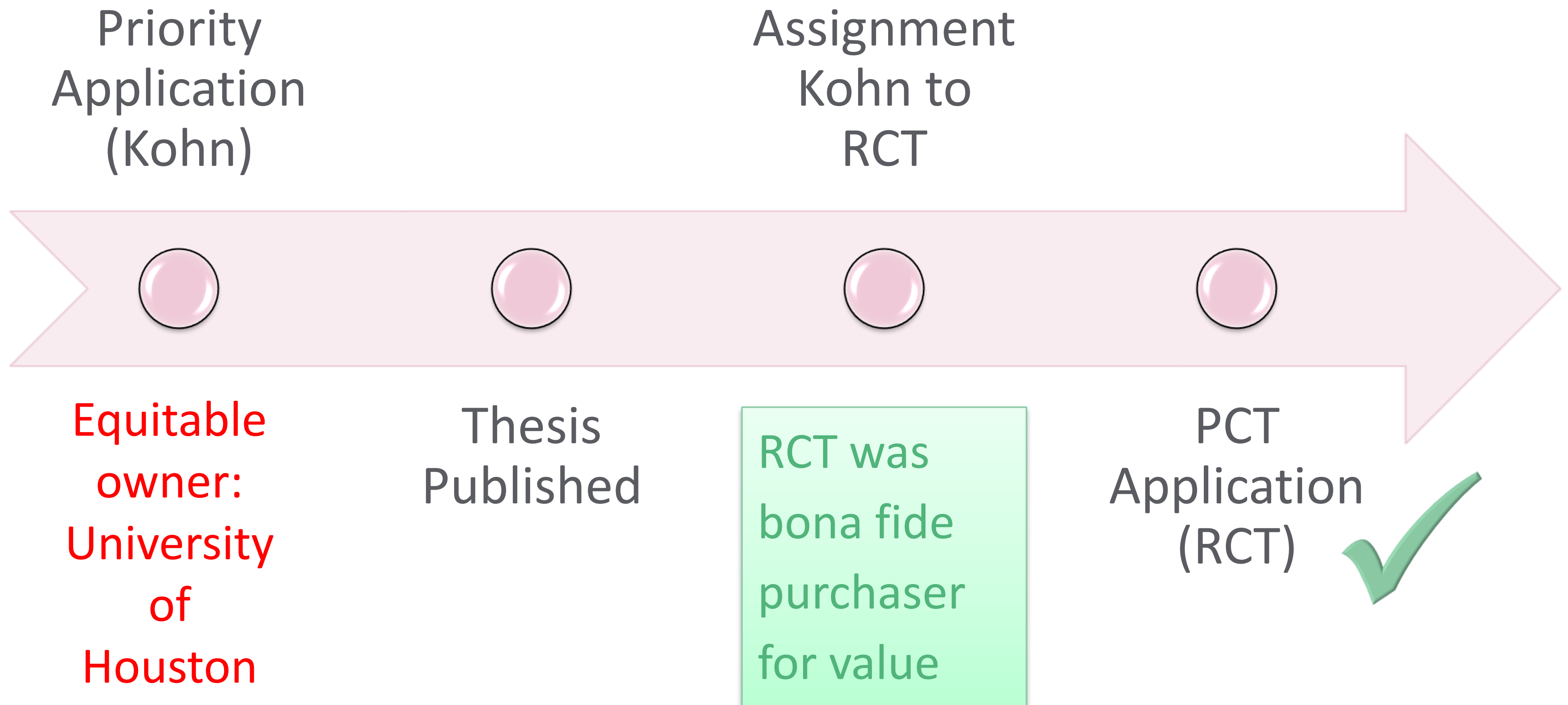

# Thank you for listening!

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