Formal entitlement to claim priority – An EPO perspective
FICPI 18th Open Forum, Vienna
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)

- Successor(s) in title

EPO has the power to assess entitlement/succession.

Article 87(1) EPC
GL 2018, A-III, 6.1
Formal entitledment to claim priority under the EPC

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- **Succession in title**
  - General principle
  - Three-step test
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  - Examples from case law

- Joint applicants
  - Missing priority filing applicants
  - Joint PCT applicants
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

▪ 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
- Law most closely connected to succession
- Law governing relationship between parties to succession

If not?

?
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
Formal entitlement to claim priority under the EPC

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- Joint applicants
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  - Joint PCT applicants
Joint applicants
Missing priority filing applicants

- 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

Priority Document

EP / PCT Application

GL 2018, A-III, 6.1
T 1933/12, r. 2.4
Article 118 EPC
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