

## Potential Solutions for prior art under Art. 54 (3) EPC of the same patent family

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Recent case law raised more and more the awareness for situations where the novelty of a claim of European patent applications is destroyed by its own priority application or by a European patent application claiming the priority of the same priority application, e.g. in the articles [1] and [2]. The subject shall briefly be resumed on the basis of those two articles. Subsequently, different solutions for this problem shall be discussed.

The enlarged board of appeal of the EPO construed the term "same invention" in Art. 87 (1) EPC as "only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole" (G2/98). Therefore, a claim of a European patent application fails claiming priority, if any of its features have been generalized with respect to the priority application. For example, a priority application P discloses a specific embodiment A', but not a generalized embodiment A. Then, the European patent application EP claiming the priority of P loses the priority for a claim on A.

In the case the priority application PEP is a published European patent application and the priority claim of a European patent application EP is not valid, the boards of appeal decided further in T1443/05 and T680/08 that the own priority application PEP can become state of the art under Art. 54 (3) EPC. In this case, the specific embodiment A' published with the priority document PEP destroys the novelty of the later-filed European patent application EP failing to claim the priority of the broader scope of protection A.

The same situation arises for any kind of priority application PXX disclosing A', whose priority is formerly claimed by the European patent application in question EP and a further published European patent application EP' disclosing as well A'. Then the specific embodiment A' of the further European patent application EP' becomes a state of the art under Art. 54 (3) EPC destroying again the novelty of the claim of the European patent application in question EP for the general embodiment A, because the specific embodiment A' disclosed in the further published European patent application EP' is able to claim priority of the priority application PXX. The further European patent application EP' could be a divisional of the European patent application in question EP as predicted in the mentioned article [1] and confirmed by the case law T1496/11 of 12.09.2012. The further European patent application EP' could also refer to a second invention on the same embodiment A' claiming the same priority application PXX.

This issue could become even more relevant for future unitary patents (UPs), if the future unified patent court (UPC) follows the strict interpretation of Art. 87 (1) EPC of the EPO. This is due to the fact that national priority applications of only one of the countries of the unitary patent could infer a nullity reason for the unitary patent under Art. 139 (2) EPC as described in [2]. However, it is also possible that the future UPC will follow the interpretation of Art. 87 (1) of e.g. the German supreme court which interprets Art. 87 (1) EPC such that a specific embodiment A' of a generalized scope of protection A could be a sufficient disclosure for validly claiming priority for A [3].

This recent development of the case law of the boards of appeal of the European patent office is not satisfactory and the following possible solutions are analysed.

### 1. Solution by change of the law

A change of the law seems the most unlikely solution. However, on a long term some hope is coming from the Tegersee experts group considering some questions on international patent law harmonization. At least two considered questions of harmonization could resolve the present issue.

One question of harmonization considers directly the prior right effect of an older patent application. On the user consultation of the EPO considering those questions, the Deutsche Patentanwältskammer ([4]) favoured the Solution of Art. 54 (3) EPC as harmonized rule for prior rights. It was however mentioned that there is a need for an anti-self-colliding-clause that omits the above-described situation. Such an anti-self-colliding-clause could simply clarify that patent applications which have at least one applicant or successor in title in common with the patent in suit should not be considered for the novelty under Art. 54 (3) EPC.

Another question of harmonization considers a grace period for own publications of the applicant or the inventor in suit. If such a grace period is well formulated, it could also include the patent applications published after the filing date under Art. 54 (3) EPC and render an anti-self-colliding-clause for Art. 54 (3) EPC superfluous. This would be probably the most elegant solution. Care should be taken that such a grace period is open to change of applicants at least between the earlier filing or priority date of the prior right and the filing or priority date of the patent application in suit.

Considering the time periods of harmonization of international law plus the time it needs to organize a conference of the then probably more than 40 contracting states of the EPC, such a change of law for the EPC is

not likely within the next 10 years. In addition, such a new regime would not resolve the problem for the patent applications filed with the current law leading to a total of at least 30 years before this problem is completely resolved.

Maybe at least the problem for the future unitary patent applications could be addressed earlier by the ratifying contracting states of the UPC agreement. The biggest challenge for the acceptance of the new UP is to convince the practitioners and industry that there are no disadvantages compared to the present system. However, one well-known disadvantage of the unitary patent is that now a prior right of only one participating member state of the UP could destroy the novelty of the UP for the complete territory of the UP. Therefore, there are attempts to convince the contracting states, when ratifying the UPC and UP package, to allow in the national law under certain circumstances a so-called late-validation of national bundle patents of the UP group. This would give the patent owner under those circumstances the fall back to request the validation of the classic national bundle patents well after the three months period after grant of the European patent. One of the discussed circumstances is after a revocation of the UP due to a prior right. This would allow the patent owner in such a case to request at least the national patent validations for the contracting states not being compromised by the prior right. Coming back to our problem, when the own priority application of the UP being filed and published as a national patent application of one participating countries of the UP destroys the novelty of the UP, the patent owner could achieve the protection in most of the territory of the UP by a late-validation of the countries not compromised by the own priority application. However, the support among the participating Member States for this option seems not to be enormous at the moment ([5]).

Therefore, other solutions for the present issue are required.

## 2. Solution by case law

An immediate solution of this issue could be provided by the case law. Again the following case shall be considered. A published European priority application EP' (or another published European patent application claiming the same priority application) discloses the specific embodiment A' without any disclosure for the broader embodiment A and the European patent application EP in question claims the broader embodiment A, e.g. as in T680/08 and T1443/05. The scope of the claim for A can now be mentally divided in an "OR"-claim with the first alternative A' or the second alternative A without A'. For the first alternative claiming the specific embodiment A' the priority is valid, while the second alternative A without A' the priority is not valid. Consequently, the specific embodiment A' disclosed in the priority application cannot be state of the art according to Art. 54 (3) EPC for the first alternative A' in the claim on A, because the priority is valid for the first alternative A'. Fur-

thermore, the specific embodiment A' might be a prior right for the second alternative A without A', but is not novelty destroying for the second alternative. Such an argumentation can be based on the following case law.

The enlarged board of appeal pointed out in G2/98 reason 6.7 regarding multiple priorities of "OR"-claims that "the use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88 (2), second sentence, EPC is perfectly acceptable under Articles 87 (1) and 88 (3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters". The board of appeal in T1222/11 developed very well, in reason 11, how the feature "a limited number of clearly defined alternative subject-matters" must be interpreted considering also the Memorandum C drawn up by FICPI (M/48/I, Section C) for the Munich Diplomatic Conference in 1973 with three examples for multiple priorities. Those three examples show the situation where a first priority discloses A' and a second priority discloses A with the consequence that the claim on A has two priority dates, the first priority date for A' and the second priority date for A without A'. In reason 11.8, the board applied this concept of multiple priorities also to the present situation. It considers that the claim on A in EP should have two relevant dates, the priority date of EP' for the first alternative A' and the filing day of EP for the second alternative A without A'. The board specified in T1222/11 in reason 11.8 further that the priority claim for the first alternative A' is even independent of the fact that A' is disclosed in the later filed European patent application in question. With this interpretation T1222/11 expressly contradicts the approach of T1443/05 for interpreting the feature of a *limited number of clearly defined alternative subject-matters* of G2/98. In T1443/05 (and also in T680/08) it was decided that A' itself contained too many alternatives and the use of two dates according to G2/98 was refused. However, independently of how many alternatives A' comprises, in the discussed case, the scope of the claim can always be separated in a first set A' of all alternatives being disclosed in the priority document and a second set A without A' including all the remaining alternatives of A not being disclosed in the priority document. Therefore, the argumentation of T1222/11 seems right that the first set A' and the second set A without A' are two clearly defined alternative subject-matters and fulfil the feature of a *limited number of clearly defined alternative subject-matters* of G2/98, namely. This is intrinsic to the discussed problem and should always be applicable.

The contradiction on the interpretation between T1443/05 or T680/08 and T1222/11 for the feature of a *limited number of clearly defined alternative subject-matters* of G2/98 would be a reason for a referral to the enlarged board of appeal under Art. 112 (1) EPC. Such a referral would also clarify the approach for determining the first application disclosing the invention under Art. 87 (1) EPC, i. e. the date for calculating the end of the priority year.

For the case that the opinion of T1443/05 or T680/08 will be prevalent in the future, in the following a practical solution to the problem shall be discussed.

### 3. Practical solution for the actual situation

If a board of appeal refuses the above-discussed solution, it is proposed to *explicitly* reformulate the claim on A in EP as an "OR"-claim with the first alternative A' and the second alternative A without A'. In this case, the first alternative A' can validly claim the priority for A' and the priority application EP' is not a state of the art according to Art. 54 (3) EPC and the second alternative A without A' holds only the filing date, but A' of the priority application is not novelty destroying for A without A'.

However, this practical solution could create some problems regarding the disclosure of one or two of the alternatives with respect to Art. 123 (2) EPC. Obviously, there is no problem with Art. 123 (2) EPC, if the European patent application discloses the specific embodiment A' and the disclaimer A without A'. The disclaimer could be disclosed explicitly as a disclaimer "without A'" or as a positive feature like  $A=A' \cup A''$  with  $A''=A$  without A'.

Normally, the first alternative A' disclosed in the priority application is also disclosed in the later-filed European patent application EP. For the unusual case that A' is not originally disclosed, there is no case law yet which could justify the claim on the first alternative A' with respect to Art. 123 (2) EPC.

If the disclaimer "A without A'" of the second alternative is not explicitly disclosed – which is often the case – the case law for the allowability of undisclosed disclaimers of G1/03 and G2/10 must be considered. According to G1/03 (points a) to d)) and G2/10 (point e)) an undisclosed disclaimer in this case is allowable:

- a) if it restores novelty by delimiting a claim against state of the art under Article 54 (3) and (4) EPC;
- b) if it does not remove more than is necessary to restore novelty;
- c) if it does not become relevant for the assessment of inventive step or sufficiency of disclosure (subcase of e) );
- d) if the claim with the disclaimer meets the requirements of clarity and conciseness of Article 84 EPC; and
- e) if the subject matter A without A' is directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

While a) is intrinsic to our problem, b), c), d) and e) must be considered for each individual case. The conditions b) and d) might become problematic, if A' comprises a large

number of alternatives which cannot be formulated clearly and concisely without removing more than necessary to restore novelty. Regarding the conditions c) and e), in G2/10 in reason 4.5.3. it is said that the disclaimer "without A'" normally does not provide a problem for the disclosure of the remaining part "A without A'" of the claim, but it has to be checked for each case. In addition, there is the clear intention to expand the protection from the embodiment A' to the embodiment A including also A without A'. Therefore, in most cases such a disclaimer should be allowable.

This solution should allow in most cases protection of all the embodiments A by reformulating the embodiment in a binary way as first alternative A' and a second alternative A without A'. As long as the specific embodiment A' is still disclosed in the European patent application EP in question, this should be allowable under Art. 123(2) EPC in most of the cases.

### 4. Conclusion

It was shown that a change of law is unlikely and would take too much time to resolve the problem of an own priority application being prior art under Art. 54 (3) EPC.

However, the present case law showed up in T1222/11 a potential solution for this problem by dividing the claim on A in the embodiments of A disclosed in the priority application for which the priority claim holds and the embodiments of A not disclosed in the priority application which might not be able to claim the priority, but which are also not anticipated by the priority application under Art. 54 (3) EPC. The contradiction to the approach of T1443/05 or T680/08 should be sufficient to justify a referral to the enlarged board of appeal for clarifying this legal uncertainty.

Until this issue is clarified and in the case that the opinion of T1443/05 or T680/08 will be confirmed, a practical solution could be to explicitly formulate the claim on A as a first alternative A' being disclosed in the priority document and as a second alternative A without A' being not disclosed in the priority document. This should be possible under Art. 123 (2) EPC in most of the cases.

[1] „Poisonous EPC Divisionals“ by M. Lawrence and M. Wilkinson, published in *epi information* 2/2011

[2] „Poisonous National Priority Applications for the Unitary Patent“ by P. Rambelli, published in *epi information* 1/2014

[3] Bundesgerichtshof (BGH), Kommunikationskanal, X ZR 107/12, February 11, 2014.

[4] „Konsultation des EPA zu den im Rahmen der Tegernsee-Expertengruppe aufgeworfenen Fragen“, by Dr. Keussen, Kammerrundschreiben KRS 2/13, Page 59, published by the Patentanwältsammer.

[5] „Report of the European Practice Committee (EPPC)“ by F. Leyder, published in *epi information* 2/2014