

STANDARD FOR VALID PRIORITY CLAIM DEFINED BY EPO ENLARGED BOARD OF APPEAL.

Dr. Franz-Josef Zimmer

Over the last several years a fairly large number of case law has been developed by the Appeal Boards of the EPO regarding the requirements of a valid priority claim. The European Patent Organization which as such is not a member state of the Paris Convention has laid down in the European Patent Convention (EPC) several articles which address the priority right. In the context of this article and the question decided by the Enlarged Board of Appeal Article 87(1) EPC constitutes the pertinent regulation. Said article requires that the "same invention" must be disclosed in the priority document and the later European patent application claiming priority thereof¹.

History

The question as to whether the "same invention" is described in the priority document and in the younger European patent application has been examined in several decisions by the Appeal Boards of the EPO².

Basically two lines of case law developed which defined a different standard for a valid priority claim. The first line of case law applying a narrow or strict interpreta-

tion of the concept of the "same invention" (in following the "narrow approach") and the second line of case law applying the more broad or less strict interpretation of the "same invention" (which was first applied by an Appeal Board in the so-called "Snackfood Case"³ and in the following called "snackfood approach"). In the traditionally and narrow approach the priority for a given claim was acknowledged if the claimed subject matter had at least been implicitly disclosed in the priority document⁴. This narrow approach was applied in most cases, also by the Appeal Boards handling biotech cases⁵. In T 0081/87 the Board stated:

Although no identical wording is required..., the Board takes the view that in order to give rise to priority the disclosure of the essential elements, i.e. features of the invention, in the priority document must either be expressed, or be directly and unambiguously implied by the text as filed. Missing elements which are to be recognized as essential only later on, are thus not part of the disclosure⁶.

Under the "narrow approach" the criterion of at least implicit disclosure of the features of the claimed invention in the priority document (as also applied e.g. for the novelty test under Article 54 (2) and (3) EPC and the disclosure test in Article 123 (2) EPC) was applied. This "novelty/dis-

¹ A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate, or his successor's in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

² Review in Case Law of the Appeal Boards of the European Patent Office, third edition, 1998.

³ T 0073/88 "Snackfood/HOWARD" (OJ EPO 1992, 557)

⁴ T 0116/84; T 0184/84; T 0085/87 and T 0295/87 "Polyetherketones/ICI" (OJ EPO 1990, 470)

⁵ T 0081/87 "Preprorennin/ COLLABORATIVE" (OJ EPO 1990, 250); T 0301/87 "Alpha-Interferons/BIOGEN" (OJ EPO 1990, 335); "T 0188/97 "NANBV/ CHIRON CORPORATION"

⁶ T 0081/87 supra

closure test” was applied in cases where features in the younger application had been defined in a more specific way than in the priority document as well as in cases where the features of the younger application constituted a broadening of more specific features of the priority document.

The second line of case law which developed in contrast to the above was first developed by T 0073/88 “Snackfood/HOWARD” (supra). In said case, priority was acknowledged for a claim that contained an additional technical feature (the claimed “Snackfood” was further defined by containing “at least 5 weight percent oil or fat” which was not disclosed in the priority document). Nevertheless the claimed priority was acknowledged because the Appeal Board was of the opinion that the said further feature would not change the characteristics and nature of the invention. This case law was then followed by others⁷.

In order to arrive at a harmonized jurisdiction between the different Appeal Boards of the EPO in this important point of law the President of the European Patent Office referred this matter to the Enlarged Board of Appeal. The following two questions (besides others) were raised by the President of the EPO and directed to the Enlarged Board of Appeal:

1a) Does the requirement of the “same invention” in Article 87 (1) EPC mean that the extent of the right to priority derivable from a priority application for a later application is determined by, and at the same time limited to, what is at least implicitly disclosed in the priority application?

1(b) Or can a lesser degree of correspondence between the priority application and the subject matter claimed in the later

application be sufficient in this respect and still justify a right to priority?

The Enlarged Board of Appeal answered as follows:

The requirement for claiming priority of the “same invention” referred to in Article 87 (1) EPC, means that priority of a previous application in respect of a claim in an European patent application in accordance with Article 88 EPC is to be acknowledged 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.

Therefore, in order to validly claim priority for a given embodiment the priority document must “directly and unambiguously” disclose said embodiment. This is the same standard that is also applied to the disclosure of a prior art document when assessing its relevance for novelty of a later application. A prior art document destroys novelty of a claim if the prior art directly and unambiguously discloses the respective embodiment falling under the claim in question. A similar “disclosure standard” must also be fulfilled if claims of a patent application are amended. The amended claim may also be directed to such embodiments only which are “directly and unambiguously” derived from the respective patent application. The “content of the application” which forms the basis for any allowable amendment under Article 123 (2) EPC is determined on this basis of what is “directly and unambiguously” disclosed. Therefore, the same standard should be applied for assessing as to whether a priority claim is valid under Article 87 EPC, a given claim is novel over a prior art document under Article 54 (2) (3) EPC, or an amendment of the European patent application is admissible under Article 123 (2) EPC. In all these cases the boundaries of what is admissible are set by what is “directly and unambiguously” disclosed in the respective document.

⁷ T 016/87 “Catalyseur/PROCATALYSE” (OJ EPO 1992, 212); T 0582/91; T 0255/91 “Priority/ AIR PRODUCTS AND CHEMICALS” (OJ EPO 1993, 318); T 0669/93; T 01056/93

What is the impact of G 0002/98 on the strategy of first filings of biotech cases?

One lesson from G 0002/98 should be to be extremely careful as regards the correctness of the features of an invention described in a first application serving as priority document. This will be exemplified in the following by the problem occurring by indicating an incorrect amino acid or nucleic acid sequence or by defining ranges of parameters such as temperature, molecular weight, percent identity between two amino acid/ nucleic acid sequences, etc. in the priority document.

a) Importance of correct protein/ nucleic acid sequences in the priority document:

It is the established practice of the Appeal Boards to regard protein/ nucleic acid sequences referred to in a claim as an essential feature of the respective molecule, as e.g. decided in T 0923/92⁸. This case makes clear, that the sequence of a protein or nucleic acid is not merely one parameter like the isoelectric point or molecular weight, etc., but the most important feature of a claimed protein/ nucleic acid. The importance of a nucleic acid or protein sequence has also been stressed in a case by the Enlarged Board of Appeal relating to the possibility of correcting se-

⁸ In T 0923/92 "Human tPA/ GENENTECH," the Board stated the following "...the skilled person considers the primary amino acid structure of the protein as an essential feature thereof because it represents its chemical formula... For these reasons, the skilled person would consider the reference to the chemical formula, i.e. to the amino acid sequence, of a protein as having not merely an informational character, but as being a primary technical feature linked with the character and nature of the product. Thus, the primary amino acid sequence of a protein (or the nucleotide sequence of DNA) constitutes a true technical feature and relying on a given sequence rather than on another one for the definition of the subject matter of an invention in a claim makes a critical difference.

quence errors⁹. In said case the Enlarged Board of Appeal required for the admissibility of a correction of a wrong sequence that the error must be immediately evident to a person skilled in the art from the application as filed and the offered correction must also be immediately evident from the application as filed. At least, the latter requirement is rarely given.

Considering these cases on the importance of protein/ nucleic acid sequences in an application in combination with the standard for a valid priority claim according to G0002/98 it is of most importance that the priority document already contains the correct protein/ nucleic acid sequence. Clearly speaking, there is a high risk that a claim directed to a corrected protein/ nucleic acid sequence could not enjoy priority of a previously disclosed sequence of the priority document but containing sequence errors. The question, therefore, is what to do if within the priority interval the inventor identifies sequence errors in the originally disclosed sequence of the priority document. One answer is to incorporate both, the incorrect and the correct sequence into the later European patent application but not to merely replace the incorrect sequence with the correct one. Often protein/ nucleic acid claims are directed to a specific sequence and embodiments that show a certain degree of identity/ homology thereto. It would be dangerous in such a case as well when filing a European patent application claiming priority of an earlier application containing an incorrect sequence to replace the incorrect sequence of the priority document by the correct sequence and omit the incorrect sequence completely. Rather, also in this case, one should maintain the original incorrect sequence and add a further claim being directed to the corrected specific sequence.

⁹ G 11/91 "GLU-GLN/CELTRIX" (OJ EPO 1993, 125).

b) Importance of Parameter Ranges for a Valid Priority:

Changing a range for a given parameter of a priority document to another range in a later application also bears the risk that the priority claim is invalid. The Appeal Board had to decide in T 0188/97¹⁰ on the question whether a claim can enjoy priority although the claim in question defined a polypeptide by its homology to a specific amino acid sequence whereas the priority document characterized the protein only by functional terms (but not by homology). Although the Patentee argued that the 40 percent homology feature that was introduced into the younger European patent application was not detrimental to the claimed priority because the feature “only served to restrict the scope of the claim,” the Appeal Board did not follow this argumentation and did not acknowledge the claimed priority. In the Appeal Board’s opinion the homology feature had not the sole function to restrict the scope of the claim but was regarded as an essential feature since it provided the necessary information to isolate suitable primers.

What one may learn from this is that one should incorporate into the priority document as many as possible reasonable fall-back positions such as preferred ranges of homology, percent identity, temperature ranges, hybridization conditions, etc. which would allow amendments (in particular introducing limitations) in the later application (e.g. required due to located prior art) without running the risk that a claim loses priority by the introduction of a limiting feature, which as such is not directly and unambiguously derivable from the priority document. In such case it does not matter that the limitation only serves to restrict the scope of the claim without changing the character and nature of the claimed invention.

Summary

The Enlarged Board of Appeal case G 0002/98¹¹ on one hand makes it more predictable as to whether a certain claim in a later European patent application indeed enjoys the claimed priority but on the other hand increases the risk, particularly in the field of protein/ nucleic acid inventions, that priority is lost as a result of a sequence error in a sequence disclosed in the priority document. Even more care in this respect is now required than was required before under the more broad “snackfood approach.”

¹⁰ T 0188/97 “NANBV/ CHIRON CORPORATION”

¹¹ Full text available from the homepage of the EPO www.european-patent-office.org