Policy Paper PP03/16

Amicus curiae brief on the questions referred to the Enlarged Board of Appeal pending as case G1/15

Introduction

The IP Federation contains representatives of IP intensive companies operating across a wide range of technical sectors and which operate in markets around the world. A list of members is attached. These companies are regular users of the European patent system. They regularly conduct international filing programmes for their patents and seek a consistent and fair approach to patentability issues around the world and especially in major industrial markets, including countries covered by a European patent.

Case G1/15 (Partial priority)

The following questions have now been referred to the Enlarged Board of Appeal of the European Patent Office on this case:

1. Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document?
2. If the answer is yes, subject to certain conditions, is the proviso "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" in point 6.7 of G 2/98 to be taken as the legal test for assessing entitlement to partial priority for a generic "OR"-claim?
3. If the answer to question 2 is yes, how are the criteria "limited number" and "clearly defined alternative subject- matters" to be interpreted and applied?
4. If the answer to question 2 is no, how is entitlement to partial priority to be assessed for a generic "OR"-claim?
5. If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Article 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon?

Third parties have been given the opportunity to file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal (*OJ EPO* 2015, A35) by **1 March 2016**.

IP Federation observations

1. The concept of restrictive partial priority and toxic divisionals was unknown in the patent world until the earlier part of this decade. Many patent applications and divisional applications were filed in Europe before then with the understanding the EPO approach to priority was consistent with the Paris Convention. The practice of other countries, under the Paris Convention, provided no room for arguing that parent and divisional patent applications were cross-citeable for prior art purposes.
2. Likewise the idea that a published priority application acts as prior art against a European Patent Application that claims priority from that priority application is inconsistent with the Paris Convention and the practice of other patent offices.
3. Adopting a practice of allowing a parent and a priority or divisional application to collide would lead to the EPO treating entitlement to priority differently to other major patent offices and would require companies to follow significantly differing patenting strategies at the EPO compared to other jurisdictions. This would be a retrograde step at a time when there are major international efforts at harmonising patentability standards. This would not be in the interest of companies with an international business focus who use the EPO, and might result in patenting strategies which avoid European patents in favour of national patents around Europe.
4. It is noted that nothing in the EPC suggests a restrictive approach to partial priority nor that parent and divisional patent applications can be prior art to each other. For the Enlarged Board now to suggest that they can be prior art would not be consistent with the EPC nor with how it has been understood since it was signed in 1973. The same applies to published priority applications.
5. The IP Federation therefore urges the Enlarged Board to follow the reasoning of the *amicus curiae* brief from BUSINESSEUROPE and to answer the first question 'no'.
6. Neither Infineum nor Shell, who are both members of IP Federation and both have an interest in the outcome of G1/15, have participated in the preparation of this *amicus curiae* brief. The views expressed do not necessarily reflect their views.

IP Federation
1 March 2016

IP Federation members 2016

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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