

About the Chartered Institute of Patent Attorneys (CIPA)

The Chartered Institute of Patent Attorneys is the UK's largest intellectual property organisation. We are the professional and examining body for patent attorneys in the UK, representing virtually all the 2,400 registered patent attorneys in the UK, whether employed in industry or private practice. Total membership is over 4,000 and includes trainee patent attorneys, judges, barristers and other professionals with an interest in protecting innovation through the use of intellectual property rights (patents, trade marks, designs and copyright). We represent members' interests to government and a wide range of stakeholders at home and abroad. The profession is one of the UK's most export intensive technical / legal services, generating around £1 billion for the economy in gross value added, and approaching £750 million in exports.

1 Summary

- 1.1 Two questions have been referred to the Enlarged Board of Appeal (EBA) by Technical Board of Appeal 3.3.04 (the Referring Board) in consolidated cases T 1513/17 and T 2719/19. The two questions that have been referred are:

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

II. If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC

in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

1.2 The jurisdiction of the EPO

- 1.3 The first referred question to the EBA is:

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

- 1.4 CIPA considers the answer to this question to be "yes".

1.5 Background

1.6 The EPO is a patent granting authority. In order to undertake this task effectively, the EPO needs to identify the relevant prior art horizon by conducting a search. The search typically identifies prior art documents that are published between the priority date and the effective filing date of any given European patent application. However, in order to determine whether a prior art document is relevant for assessing patentability under Article 54(2) EPC or Article 54(3) EPC, the EPO will need to make an assessment of priority entitlement. If the EPO was not able to assess priority entitlement, then it would not be possible to conduct an effective examination of the patentability of any European patent application.

1.7 If follows from the above that it is evident that the EPO does have jurisdiction to consider whether a party validly claims to be a successor in title.

1.8 The relevant law

1.9 Article 87(1) EPC states:

- 1) *Any person who has duly filed, in or for*
 - (a) *any State party to the Paris Convention for the Protection of Industrial Property or*
 - (b) *any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor 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.*

1.10 Articles 87-89 EPC were intended to be consistent with the provisions of the Paris Convention. Article 87(1) EPC was derived from Article 4 of the Paris Convention, which states:

4A.(1) Any person who has duly filed an application for a patent...in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed¹.

1.11 The Paris Convention provides an indication of the minimum requirements for making an effective priority claim. However, the Paris Convention permits each country, and regional office, to require further proof to support an application for priority, *e.g.*, see Article 4D.(1) and (5). Thus, countries and regional offices, such as the EPO, can set further requirements for making a valid claim to priority.

1.12 There are clearly challenges presented when the entitlement to priority is challenged. However, and historically speaking, the EPO has relied upon the provisions of the relevant national law, or applicable law as identified in any agreement or instrument, along with the submission of expert evidence, where appropriate, to make a determination on priority entitlement. For example, the Technical Boards of Appeal have consistently referred to national law to consider the question of whether a party is a successor in title, *e.g.* see T1008/96, T 160/13, J 19/87, T493/06, T 205/14 and T 1201/14.

¹ The time period was fixed at 12 months for patents (Article 4C.(1)).

2 The “joint applicants” approach

- 2.1 The second question referred by the Technical Board of Appeal makes no reference to the so-called “joint applicants” approach. However, this question appears to be directed towards seeking an answer to the validity of that approach. The second question states:

II. If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC

in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

- 2.2 Of course, if the PCT application validly claims priority in compliance with Article 4 of the Paris Convention (part 3) above, then the answer to question II must be “yes” and it is not necessary to consider parts 1 and 2. However, there are other factors that need to be considered in determining whether or not the PCT application does indeed validly claim priority in compliance with Article 4 of the Paris Convention, and so part 3 above should be considered before parts 1 and 2.
- 2.3 In relation to part 3, it appears that the intention of this question is to determine whether the circumstances set out in points 1 and 2 might give rise to the applicant of the European patent being deemed to be a successor in title in accordance with Article 4(1) of the Paris Convention (see above).

2.4 Background

- 2.5 A central part of assessing priority entitlement at the EPO is the ability to determine if the applicant of a priority claiming application is the same or a successor in title. In order to establish if the applicant of a priority claiming application is a successor in title, it is submitted that the validity of any transfer of the right to claim priority should be determined under the provisions of the relevant national law, or applicable law as identified in any agreement or instrument.
- 2.6 The EPO has adopted the so-called “joint applicants” approach whereby it considers the applicants named on a PCT application to be joint applicants, despite the fact that one applicant may have been named as an applicant (sole or joint) for one or more states only and importantly not the European patent application. Thus, it may be the case that no evidence of the transfer of priority right is required in this instance.

2.7 In the alternative, the EPO is presented with the challenge of identifying the relevant national law that needs to be considered, and making a determination of the validity of the transfer of the right to claim priority under that national law. The joint applicants approach typically avoids the EPO making any determination in relation to national law, but it does not address the issue where a party that is entitled to claim priority is not named as an applicant of the priority claiming application, e.g., as was the case in T 844/18. This issue is not addressed by the questions that have been referred to the EBA.

2.8 The joint applicants approach

2.9 The attraction with the joint applicants approach is that it is quite simple. However, the simplicity of the approach does not address issues that arise when an applicant should have been named on a priority claiming application, for example. In this scenario, it is still necessary to determine whether the applicant named on the priority claiming application is the successor in title for priority purposes.

2.10 The Guidelines for Examination (A-III, 6.1) state:

As concerns (ii) above, the transfer of the application including the priority right (or of the priority right as such) must have taken place before the filing date of the later European application and must be a transfer valid under the relevant national provisions. Where the previous application was filed by joint applicants, all these applicants must be amongst the applicants of the later European patent application or have transferred their rights in the priority application to the applicant of the later European patent application (see T 844/18). Proof of the transfer can be filed later.

2.11 Thus, the Guidelines indicate that the determination of a successor in title should be a consideration of national law. However, the practice adopted by the joint applicants approach has been to ignore national law and apply a separate determination.

2.12 The referring decisions refer to Article 118 EPC as support for using the joint applicants approach. Article 118 EPC states:

Where the applicants for or proprietors of a European patent are not the same in respect of different designated Contracting States, they shall be regarded as joint applicants or proprietors for the purposes of proceedings before the European Patent Office. The unity of the application or patent in these proceedings shall not be affected; in particular the text of the application or patent shall be uniform for all designated Contracting States, unless this Convention provides otherwise.

2.13 Article 118 EPC refers to applicants and proprietors of a European patent in proceedings before the EPO. Article 2 EPC refers to European patents as “[p]atents granted under this Convention”. Further, Article 153(2) EPC states:

An international application for which the European Patent Office is a designated or elected Office, and which has been accorded an international date of filing, shall be equivalent to a regular European application (Euro-PCT application).

2.14 There is no reference in Article 153(2) EPC that an international application naming different applicants for a country or region, other than the EPO, would also be the applicants of the European patent application. For example, a PCT application could name applicants for the

EPO that are different from applications that may enter one or more of the EPC member states separately, and it would be absurd for the applicants of these applications to be considered to be the same. That said, there is no apparent mechanism under the PCT for an applicant of a PCT application to make a declaration of priority that is different in each PCT member state.

2.15 The joint applicants approach relies on the unitary nature of applicants. That principle is set out in the international phase in the Regulations under the PCT. For example, it is not possible for a single applicant to withdraw a claim to priority without the signature of all of the applicants (see Rule 90*bis*.5 PCT).

2.16 Thus, the PCT provisions appear to suggest that applicants have equal rights and should be considered together, even if the applicants are not joint and separate applicants are listed for different PCT member states.

2.17 Summary

2.18 There are arguments that can be set out for and against the joint applicants approach, and its simplicity is attractive. However, the question that needs to be considered is whether the applicants of the EPO part of a PCT application that are named at the time of filing are entitled to claim priority from the priority application. In making that assessment, then it needs to be remembered that the entitlement to claim priority could come from a written assignment, but it may equally be equitable in nature arising, for example, from the conduct of the parties (e.g., see J 19/87). An equitable transfer of rights could arise even if the party named on a public register differs from the equitable/beneficial owner. Any transfer of the right to claim priority should be compliant with national law, and the EPO could make a determination on that point once it has been presented with evidence. That transfer could, in some instances, be a confirmatory assignment document, even if dated after the filing date, or effective filing date, of the European application.

2.19 Fundamentally, CIPA is of the view that it would be beneficial for applicants and proprietors if a generous approach is adopted by the EPO when considering entitlement to priority. The EPO is a patent granting authority, and patents should not be revoked and applications should not be refused for procedural reasons relating to priority entitlement. The current approaches that are used to assess priority entitlement are clearly time consuming, and CIPA would support deregulation in this area to the extent that the EBA considers that it is possible to do so. There is currently a risk to applicants and proprietors regarding the validity of their cases, which is disproportionate and unnecessary.