


AN INTRODUCTION TO THE EUROPEAN PATENTING PROBLEM OF
TOXIC PRIORITIES, POISONOUS DIVISIONALS
DISCUSSION THEME 2
AIPLA Patent Law Committee
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To stay oriented, start from home:

Santarus, Inc. v. Par Pharmaceutical, Inc., 694 F.3d 1344 (Fed. Cir. 2012)

In re Chu, 66 F.3d 292, 296–97 (Fed. Cir. 1995)

and do revisit:
In re Van Langenhoven, 458 F.2d 132, 136–37 (C.C.P.A. 1972)

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Keep a “gem” with you:

“As to given claimed subject matter, only one effective date is applicable. Whether or not the requirements of section 120 are satisfied is determinative of that date, and in the case of the [B] claims, those requirements have not been met. Accordingly, the [foreign, priority-based] patent may properly be relied upon for all it fairly teaches to establish obviousness, under 35 U.S.C. § 103, of the subject matter defined in the [B] claims.”

In re Van Langenhoven

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The *Santarus* minority opinion, also useful:

"The panel majority forgets that '*matter*' disclosed in the parent application is entitled to the benefit of the filing date of the parent application.' *Waldemar Link, GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558 (Fed. Cir. 1994);....Instead, the panel majority relies upon the common subject matter from the '737[parent] patent disclosure to invalidate the '885[CIP] claims supported by that subject matter. This is incorrect, for *the common subject matter* in the '885 patent is entitled to the '737 filing date. That entitlement is not lost by issuance of the '737 patent. The common subject matter, properly carried forward in copending continuing patents, cannot be prior art against itself, as the majority holds."


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The *Santarus* minority opinion, conceptually:

A claim for priority to any parent, removes the content of the parent from the prior art ?

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And so, on this visit to EPO practice, the amount of travel required on your part is perhaps less than you might have originally thought.



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EPO Primary Statutes on Priority

European Patent Convention (EPC) Articles 87, 88

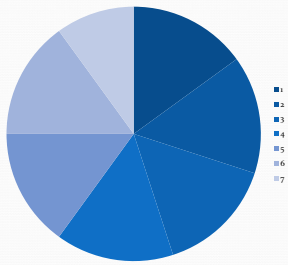
88(2)
Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries. **Where appropriate, multiple priorities may be claimed for any one claim.** Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

88(3)
If one or more priorities are claimed in respect of a European patent application, the right of priority shall cover **only those elements of the European patent application which are included in the application or applications whose priority is claimed.**

87(i)
"...in respect of the same invention, a right of priority during a period of twelve months from the date of filing..."

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Thus, it seems mandated by statute (EPC Art. 88(2)) that independent CLAIM 1 (an "OR" claim) may look like this, with different priority dates 1,2,3,4,5,6,7



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Is there an EPO "CIP"?

Hint: bends minds



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The EPO divisional

A diagram illustrating the concept of dependency between two patent applications. It consists of two red circles, each containing the letter 'A'. A blue arrow points from the left circle to the right circle, with the word 'dependency' written above it.

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The EPO divisional

EPC Article 76 “Divisional Applications”
76(1):
... It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed...

A diagram showing two red circles, each containing the letter 'A'. A blue arrow points from the left circle to the right circle.

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EPO Primary Statute on Novelty

European Patent Convention (EPC) Article 54

54(3)
..... the content of [other] European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 [Comment: the subject appln. date of filing] and which were published on or after that date, shall be considered as comprised in the state of the art.

Note also: 54(1)
An invention shall be considered to be new if it does not form part of the state of the art.

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EPO Statute on Amendments

European Patent Convention (EPC) Article 123

123(2)
 The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends **beyond the content of the application as filed**....

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Arriving to the “Gold Standard”

Recently stated by Hon. Klaus Bacher, German Federal Court of Justice:

“That an invention must be disclosed **directly and unambiguously** is required not only under Article 123(2) EPC, but also under Article 54(1) EPC....The Federal Court of Justice has observed in almost all the decisions presented to you today that.... the same standards have to be applied as under Article 123(2) EPC. It also applies these standards in the context of Article 87(1) EPC, namely when deciding whether an earlier application from which priority is claimed relates to the same invention.”

[But] “for the purposes of Article 54(1) EPC, all that matters is whether the technical teaching claimed by the patent is disclosed in the prior document. The additional requirement that the teaching must be disclosed in the prior document as forming part of the invention applies solely for the purposes of Articles 123(2) and 87(1) EPC.”

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Arriving to the “Gold Standard”

directly and unambiguously

is required not only under Article 123(2) (AMENDMENTS)

also under Article 54(1) EPC...(NOVELTY)

in the context of Article 87(1) EPC...(PRIORITY)

and thus surely as to Article 76(1) EPC...(DIVISIONALS)

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Arriving to the “Gold Standard”

directly and unambiguously

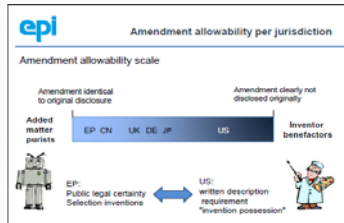


This is very likely to be strongly supported/defended/preserved in the forthcoming resolution of the pending Referral to the Enlarged Board of Appeals G 1/15 (identifier: “Partial Priority”), whatever the decision be.

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A quick comparative view of the “Gold Standard”

directly and unambiguously



*This slide with thanks-to/courtesy-of : Professor Dr. Gees Mulder, University of Maastricht

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But a look back to *Santarus*

A claim for priority to any parent, removes the content of the parent from the prior art ?

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Fundamental contributors to current problem

Art. 88(2) – multiple priorities in one claim
Art. 54(3) – no distinction, as pre-AIA 35 U.S.C. 102(e) “by another”
Art. 89 – priority date = EPO filing date

Prior Enlarged Board of Appeals decision **G 2/98** interpreting Art.88(2) gave some guidance as to 88(2)

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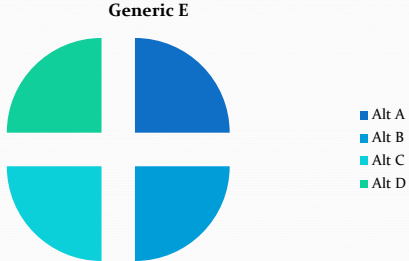
G 2/98

where a first priority document discloses a feature A, and a second priority document discloses a feature B for use as an alternative to feature A, then a claim directed to A or B can enjoy the first priority for part A of the claim and the second priority for part B of the claim. It is further suggested that these two priorities may also be claimed for a claim directed to C, if the feature C, either in the form of a generic term or formula, or otherwise, encompasses feature A as well as feature B. The use of a generic term or formula in a claim for which multiple priorities are claimed ...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.

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“a limited number of clearly defined alternative subject-matters”

Generic E



■ Alt A
■ Alt B
■ Alt C
■ Alt D

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Generic "C" unprotected, anticipated?

Generic C(alone loses priority?) C

●
A (priority)

"A or C"? claimed?

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G 1/15 (identifier: "Partial Priority/Infineum")

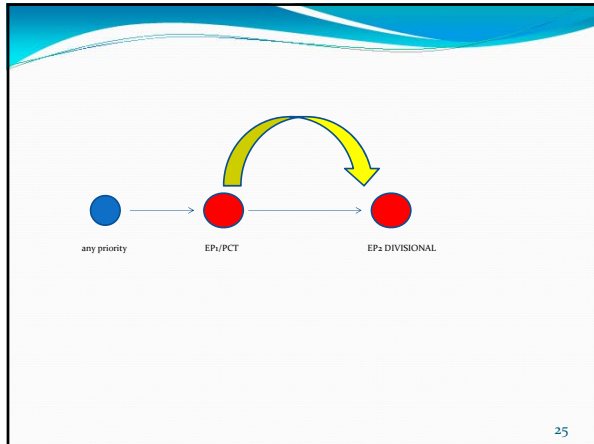
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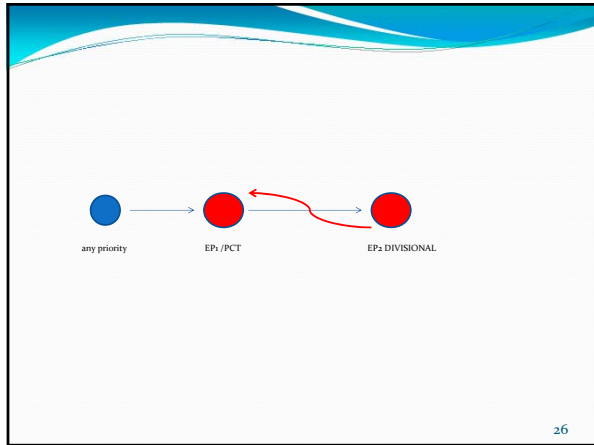
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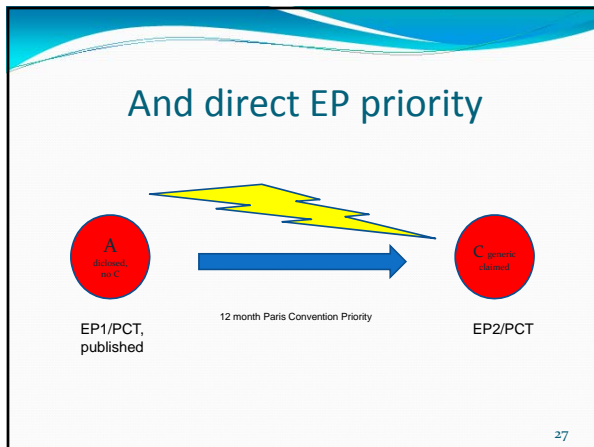
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GB priority EP1 (as PCT) EP2 DIVISIONAL

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Harmony?

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