

EIP

G1/22 & G2/22: Entitlement to priority

Background

As shown by the figure above, the applications in question are European stage of an application under the Patent Cooperation treaty (PCT) and its divisional applications. These applications claim priority from a priority application which lists Zhong, Rother and Wang as applicants.

The PCT application when it was filed, listed:

- Zhong, Rother & Wang as applicants for the US only; and
- Alexion Pharmaceuticals & The University of Western Ontario as applicants for all other designated states (including EP and subsequent EP divisional applications).

Problem: Validity of the PCT priority claim

The appellant, Alexion Pharmaceuticals argued that all the applicants from the priority application had assigned their rights to their employer. However, only Rother had explicitly assigned their rights to Alexion Pharmaceuticals prior to filing the PCT application. Zhong and Wang were employees of the University of Western Ontario but had not explicitly assigned their rights in these applications to the University of Western Ontario or Alexion Pharmaceuticals. Therefore, Alexion Pharmaceuticals were alleged to not be the priority applicants or successors in title of the priority applicants. The resulting loss of priority brings in new novelty and inventive step attacks against the patent based on documents published after the claimed priority date but before the patent filing date.

One of the appellant's requests was for the PCT to be corrected pursuant to Rule 139 EPC to include Zhong and Wang as applicants in all other designated states. Rule 139 EPC requires the correction must introduce what was originally intended. This was not the case here as this request was a correction of a mistake based on the assumption that the rights were properly assigned. Hence, this request was considered unallowable.

Potential solution: Applying the joint applicants approach to PCT applications

The appellant argued that the joint applicants approach to European applications should also be applicable to PCT applications.

The joint applicants approach is whereby a Party A is the applicant of the priority application and Party A + Party B are applicants in the subsequent application, which claims priority from the priority application. Party B is a joint applicant with Party A and therefore benefits from the priority that Party A is entitled, without the need of a transfer of priority right to Party B.

The joint applicants approach to European patent applications has never been contested before and has been developed in case law (see T 1933/12, reasons 2.4). However, there have been several appeal cases where it has been disputed whether the joint applicants approach should also be applied to PCT applications (see communications issued by the boards in T 2749/18, T 2842/18, T 1837/19 and T 845/19).

When applied to this case, the act of filing the PCT together means that the European designation benefits from Zhong and Wang's entitlement to priority, even though they were not listed as applicants for the European designation. This is as in the joint applicants approach, if one applicant is entitled to priority, then all other applicants in that application are also entitled to that priority.

There is no provision for splitting priority right to different designations under the Paris Convention and PCT. Therefore, the validity of applying the joint applicants approach to PCT applications was referred to the Enlarged Board of Appeal. This would also address whether the EPO has the jurisdiction to assess priority entitlement in a PCT application.

It is important to note that applying the joint applicants approach to PCT applications

would not answer the question of lost applicants from the priority application as seen in the CRISPR-Cas case (T0844/18), known as the 'All Applicants' Approach'. In that case, the priority claim failed as all the applicants in the priority application were not all applicants in the subsequent PCT application (see below):

Joint Applicants Approach:

- Priority application: Party A
- Subsequent PCT application: Party A + Party B

All Applicants Approach:

- Priority application: Party A + Party B
- Subsequent PCT application: Party A

Legal basis for applying the joint applicants approach to PCT applications – transfer of right by agreement

The EPC does not require formalities for assignment of priority and therefore it is sufficient to provide a proof of agreement of an assignment of the right to priority. Furthermore, the requirement for right to priority are determined under national law under Article 2(1) of the Paris Convention. In several boards of appeal decisions, the transfer of priority by agreement has been assessed by applying national law, however this does not address conflict of laws-rules and has not been addressed by the Enlarged Board of Appeal.

If the EPC were the correct legal system to assess the transfer of priority right by agreement, then the act of filing the PCT application by both parties would be an implied agreement and would suffice as proof of transfer of priority right by agreement.

Questions referred to the Enlarged Board of Appeal

G1/22 and G2/22 are two pending referrals to the Enlarged Board of Appeal regarding entitlement to priority. The two questions that were referred were:

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title 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?

Article 87(1) EPC states that:

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.

Future significance of decision

There has been disquiet in some quarters over recent years that parties risk losing patent protection at the EPO for not complying with the procedural requirements of Article 87(1) EPC regarding transfer of the right to claim priority even when there is no disagreement between the priority applicant and the EP applicant as to who shown be the rightful applicant for the European application. This is most often seen in cases claiming priority from US applications listing inventors as Applicants (the standard practice before USPTO before America Invents Act was that inventors were necessarily listed as

Applicants). Furthermore, EPO Opposition Divisions and Technical Boards of Appeal are increasingly being called upon to undertake complex legal analyses under various national laws to assess whether rights in a priority application were validly transferred during the priority year.

Acceptance of the joint applicants approach to PCT applications would provide an elegant solution and simplify assessment of compliance with the same applicant or successor in title requirements of Article 87(1) EPC for a significant subset of cases (where priority applicants are not listed as applicants for EPO but listed for other designations such as US in the PCT application) where this issue arises.

We eagerly await the decision from the Enlarged Board of Appeal.