

Has the EPO's Enlarged Board detoxified "Poisonous Divisionals"?

In G 1/15, the EPO's Enlarged Board of Appeal was asked to clarify the position regarding the entitlement to "partial priority". A key issue was whether it is necessary for subject matter to be defined as alternatives in a claim in order for the claim to be entitled to multiple priority dates.

While the full decision in G1/15 is not yet out, the Enlarged Board has issued an order to the effect that the only aspect that needs to be considered is whether the subject matter claimed is disclosed in a priority document. This possibly more liberal approach to partial priority may be good news for many applicants.



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The background

"Partial priority" arises when a claim in a patent or application is not identical to the text in its priority application so that some of the claim, but not all of it, is entitled to the earliest priority date, and the remainder of the claim is entitled to a later date. Typically, this arises when a claim is broadened between the priority filing and the filing of the application itself.

A very strict approach to partial priority has been taken by some EPO Boards of Appeal such that a claim is considered only to be entitled to multiple priority dates when it is divisible into clearly defined alternative subject matters (e.g. A OR B). Thus entitlement to partial priority is denied unless the disclosure of the priority document can be identified as a clearly defined alternative from within the claim.

This approach has led to harsh consequences, with even minor broadening of a claim leading to the entire claim losing entitlement to priority. As a consequence, any disclosure of the content of a priority document during the priority year could deprive the claim of novelty. A particularly bizarre outcome was the "poisonous divisional" situation in which the filing of a divisional application could render a parent application invalid. See our article: [Demystifying Self-collision at the EPO](#) for more details.

The Enlarged Board's order

In case G1/15, the Enlarged Board was asked to clarify whether the strict approach outlined above was correct or whether a more liberal approach to "partial priority" was required. Further details on the referral to the Enlarged board can be found in our article [EPO Enlarged Board of Appeal to tackle divisional poisoning](#).

Although the full decision is not yet out, the following order has been issued:

"Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR"-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect."

Thus, a claim may not be refused multiple priority dates just because it uses a generic term and does not include the subject matter of the priority document as a clearly defined alternative. Instead the sole consideration is what is disclosed in the priority document.

Sanity restored?

The Enlarged Board has thus adopted a more liberal interpretation of the requirement for entitlement to priority. Denial of partial priority and the harsh consequences that ensue may now be less common. In particular, members of the same patent family that share common priority applications are less likely to deprive each other of novelty.

This is potentially good news for many applicants.

We will report further when the full text of the decision is available. In the meantime, if you would like more information regarding the order, please do not hesitate to get in touch with your usual Abel & Imray contact, or send an email to ai@abelimray.com.

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