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Fordham Conference 2015 – Priority Issues

Daniel Byrne (Bristows) · Thursday, April 9th, 2015

Justin Watts (Freshfields) asked whether the strict test for priority fails to appreciate the early stage at which the inventor will be enunciating the invention (often in multiple jurisdictions). He refers particularly to the decision of G2/98 which is that one has to understand the application as a whole through the eyes of the skilled person and therefore takes into account implicit factors as well as explicit. However, a number of hard line approaches have been taken, not least in T213/05 where a gene sequence was later corrected, but still had over 97% homology and yet was denied priority. Mr Watts referred to the 'Goldilocks' approach being neither too narrow nor too broad, but 'just right'. Given that the difference in the gene sequence made no difference to anything he characterised that result as overly strict and narrow. He sees a flexible priority system as a way of addressing the requirement to file early and in multiple jurisdictions.

When a generalised claim is anticipated by a divisional it is known as a poisonous divisional (T1496/11), but Mr Watts sees the priority system as being (as well as the cause) the way to mitigate this. The two systems should work together. On the question of formality (T778/05) he notes the difficulty where title is not perfected at the time of application but cannot be perfected later as a matter of harsh formality.

The priority system is technical in nature but care must be taken not to be overly technical to the detriment of patents. Tribunals are working hard to mitigate the effects of an overly technical approach (divisionals and formalities defeating patents), but, without legislation, this will remain a problem for tribunals.

Donald R Steinberg (Wilmer Cutler Pickering Hale and Dorr LLP) gave the US perspective, which distinguishes between an agreement to assign and a prospective assigment of patent rights ("I will assign" compared with "I assign"). The former only assigns equitable rights whereas the latter is an automatic assignment of full title upon the invention coming into existence. He referred to the difficulty of intervening prior art or assignments (without notice) but also the possibility of a previous publication of the patent invalidating a later version. The problem is particularly acute when a definition is added or expanded upon and the retrospective effect on claims in patent applications in the chain. Adding additional examples is also a potentially bad idea because they may not have support back to the original application. Added matter is not available as a standalone objection, but can can be raised as a priority question indirectly, by using prior art to defeat the patent and putting the onus on the patentee to demonstrate support.

It was suggested from the floor that partial priorities is the only solution for the EPO and the

national courts should come into line with that view. **Penny Gilbert** (Powell Gilbert LLP) did not think that this would necessarily be worse, but **Justin Watts** said that it would depend what examples you have in the patent. He sees it as an increased order of complexity, particularly where obviousness has to be borne in mind.

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