

# Kluwer Patent Blog

## Claim to Priority Allowed Despite Generalization of Invention

Thorsten Bausch (Hoffmann Eitle) · Thursday, April 24th, 2014

In its recent decision “Communication Channel” (“Kommunikationskanal”) of 11 February 2014, docket, X ZR 107/12, the FCJ decided that the priority of an earlier application may be claimed if the technical instructions described there by means of an example or in other ways appear for the skilled person as an embodiment of the more general teaching described in the later application, and this teaching, in the generality exposed by the later application, can already be taken from the earlier application as belonging to the filed invention.

In this new decision the FCJ has ruled on the question of when it is admissible to generalize a teaching and still remain within the confines of the “directly and unambiguously disclosed” standard. In the decided case, the priority application had described a frequency division duplex communication channel comprising a data channel and control channel adapted to transmit both power control and bit rate information. The later application and resulting patent only described a communication channel in general comprising a data channel and a control channel for power control information, i.e. there was no mention of frequency division duplex or the transmission of bit rate information. The court of first instance, the Federal Patent Court, had denied the priority for these reasons.

The FCJ identified as the invention a concept recited both in the earlier application and in the granted claims of the later patent, according to which the initial transmission on the data channel is delayed until after the initial transmission on the control channel, during which delay closed loop power control is performed to adjust the control channel power. The court came to the conclusion that neither the problem underlying the identified invention nor the proposed technical steps for solving it stood in any relationship with the omitted features of a frequency division duplex communication channel or with sending bit rate information on the control channel, as the problem and solution dealt with power control and the avoidance of interference in the initial transmission stages. It was ruled that a skilled person would already have taken the more general concept of the later application from the description of the example in the priority application. Consequently, the appeal was successful and the FCJ confirmed the claim to priority.

The principle established by this case, which should not only apply to the question of priority but equally to that of (in)admissible extension, gives hope to all applicants/patent proprietors who discover that their basic patent application describes elements in connection with the invention that are later found to be unnecessary or undesirable, hence giving rise to the wish of generalizing the invention. According to the FCJ, if a skilled person is able to recognize a problem and a corresponding invention from the basic application, and the features that are to be omitted or

generalized do not stand in specific relationship with the identified problem and invention, then the desired generalization is permissible. Or, in other words, a skilled person would have directly and unambiguously arrived at the generalization.

For EP practitioners this is reminiscent of the “essentiality test”, which the FCJ possibly had in mind, although no reference is made to it in the decision. Indeed, the principle expressed by the FCJ is more vague and this is where a certain amount of criticism is in order. Namely, the new decision increases legal uncertainty, as the central problem is how to identify the concept of “the invention” that is then used as a measure for establishing whether or not an omitted feature stands in relationship with it.

Georg Siegert

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