

REVISED APPROACH BY EPO FOR FORMAL ENTITLEMENT FOR A VALID PRIORITY CLAIM

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The recent decisions G1/22 and G2/22, issued by the Enlarged Board of Appeal (EBA), delve into the issue of formal entitlement to priority for patents filed at the European Patent Office (EPO).

The decisions confirm that the EPO has the authority to assess whether a party is entitled to claim priority. Furthermore, the EBA states that there is a rebuttable presumption that the applicant for the subsequent application is entitled to claim priority under the autonomous law of the European Patent Convention (EPC). This presumption applies in cases where the applicant of the claiming application is not identical to the applicant of the priority application, irrespective of whether the claiming application is a PCT application.

Additionally, the decisions establish, among other arguments, that there are no formal requirements for the transfer of the priority right under the EPC. They also touch upon concepts such as implicit agreement in cases of joint filing of PCT applications with two applicants, allowing both to rely on the priority, unless substantial evidence suggests otherwise.

This decision introduces a notable shift in the EPO's approach, favoring applicants and patentees by relaxing the EPO's stance on same-applicant priority issues. On the other hand, it places a burden on third parties, who will no longer find it easy to challenge priority claims in certain cases and will be required to prove the absence of entitlement.

In any case, it remains to be seen whether this approach will be adopted by European national courts and the Unified Patent Court.

The EPO is actively organizing lectures to enhance attendees' understanding of the aforementioned decisions. During a training session held in October 2023, it was confirmed, for instance, that the stayed cases will be resumed. Additionally, it was stated that the Board of Appeal case law will be closely monitored to apply the principles outlined in G1/22 and G2/22. Furthermore, the Guidelines for Examination in 2024 will be revised to align with these decisions, particularly with respect to Part A-III, section 6.1 of the EPC Guidelines.

Full text of the decision is available [here](#) and you may find below a summary on the facts, the questions addressed to the EBA and their answers.

The facts

EP regional phase of a PCT claimed priority of a US Provisional originally filed on behalf of three inventors. The priority application named the inventors as inventors and applicants for the United States of America (US) only. For all designated States except the US, it named companies A and B as applicants.

Since B had assigned their right to the patent application to A, the EP named A as the sole patent proprietor and the inventors as inventors.

The patent was revoked after opposition proceedings. Among other contested facts, the validity of the priority claim was contested, inter alia because the applicants, A and B were alleged not to be the applicants or the successors in title of the applicants of the priority application, e.i. the inventors.

The priority right was found to be invalid because only the priority right of one of the three inventors had been assigned to the patent proprietor. An assignment of the other two inventors to the patent proprietor or to B had not taken place prior to the filing of the PCT application.

The contentious procedure continued until reached the EBA.

The questions addressed to the EBA.

- I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?
- II. If question I is answered to 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?

The EBA's answers.

- I. The European Patent Office is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC.

There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.
- II. The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).

In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.