

HIGH PRIORITY: THE ENLARGED BOARD TAKES ON EPO PRIORITY PRACTICE IN THE G 1/22-G 2/22 REFERRAL CASES

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In a written interlocutory decision dated 28 January 2022, issued in consolidated appeal proceedings T 1513/17 and T 2719/19 ('the Referral Decision'), the Technical Board of Appeal 3.3.04 ('the Board') referred the following questions to the Enlarged Board of Appeal ('the Enlarged Board') pursuant to Article 112 EPC:

(1) 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)¹ EPC?

(2) If Question (1) 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

(i) 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

(ii) the PCT-application claims priority from an earlier parent application that designates party A as the applicant, and

(iii) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

These referrals are currently pending before the Enlarged Board as consolidated proceedings G 1/22 (T 1513/17) and G 2/22 (T 2719/19). The appeal in Case T 1513/17 arises from a decision of the Opposition Division revoking European patent EP 1 755 674 (EP patent application 05 779 924.9) that issued on 30 May 2017. The underlying application on which this patent was granted was originally filed as international application PCT/US2005/017048, which claims priority from a US provisional patent application No 60/571,144, filed on 14 May 2004.

The appeal in Case T 2719/19 arises from a decision of the Examining Division refusing European patent application No 16 160 321.2 issued on 11 April 2019, which is a second-generation divisional application of EP 05 779 924.9 (T 1513/17).

The priority issue shared by both of these cases can be understood by a simple illustration. A first US provisional application priority application (P₁) was filed by inventors A and B. The subsequent PCT application (A₁) claiming priority to P₁ was filed in the name of company C for all PCT Designated States *except the US*, where inventors A and B were named as the A₁ applicants. Under the prevailing EP practice, company C can validly claim priority if company C could demonstrate that the priority right P₁ was assigned to company C by inventors A and B before the PCT A₁ was filed, thereby making company C a successor in title to the priority right interest of inventors A and B.

The issues underlying the questions of the instant referral can be summarised as: (i) whether the EPO has the jurisdiction

¹ We note that Question (1) of the Referral Decision mentions 'Article 87(1)(b)', which pertains to 'any member of the World Trade Organization', a topic that is not covered by the T 1513/17 and T 2719/19 cases. Accordingly,

we shall address the questions posed in the context of Article 87(1) EPC as appropriate.

(competence) to determine who is entitled to claim priority, in particular determining if a party is a valid successor in title (Question (1)), and (ii) whether company C can validly claim priority without evidence of an assignment of P1 based on the fact that PCT A1 was filed jointly by inventors A, B, and C, albeit for *different* PCT Designated States (Question (2)).

We consider that Question (1) is inadmissible based on established EPO practice and case law that interprets the criteria for referring a case to the Enlarged Board under Article 112 EPC. Should Question (1) be admitted and examined by the Enlarged Board, the question must be answered in the affirmative. Question (2) does appear to encompass issues that are ripe for review by the Enlarged Board and should also be answered in the affirmative.

Question (1) The EPO's Jurisdiction to Determine 'Successor in Title' Priority Entitlement

Article 112 EPC, which governs the referral of questions to the Enlarged Board of Appeal by a second instance Board of Appeal, lays down the following gateway criteria: a referral is necessary in order to 'ensure uniform application of the law' or because the question concerns a 'point of law of fundamental importance' (Article 112(1) EPC) and a *decision is required* for the above purposes (Article 112(1)(a) EPC).

The Enlarged Board has clarified that these criteria must be fulfilled for a question to be admissible and that these criteria must be examined *ex officio* by the Enlarged Board, as is evident from headnote 2 of G 1/14, which states: '[i]n any event, the Enlarged Board must examine whether the referral fulfils the criteria of Article 112(1)(a) EPC (including that a "decision is required") and is thus admissible'. Furthermore, headnote 1 of G 1/14 states that 'it is primarily up to the [referring Board of Appeal] to explain, in its referral decision, that – and why – it believes it needs an Enlarged Board ruling on the point arising in the case before it'.

On this basis, it is apparent that Question (1) fails to meet these mandatory criteria. Notably, the referring Board *did not*

set out any detailed reasons in the Referral Decision as to why an Enlarged Board ruling on Question (1) is required within the framework of Article 112 EPC, for instance whether Question (1) is referred in order to 'ensure uniform application of the law' or because it concerns 'a point of law of fundamental importance'. The passages of the Referral Decision relevant to Question (1) are in the reasons at §§ 24 to 26 on pages 25 to 26. We note that the remaining reasoning stated in the Referral Decision concerns other points, for instance admissibility of the appeals, a request for correction under Rule 139 EPC made in one of the appeal cases, admissibility of new arguments, and the merits of the 'joint PCT applicants approach' that underlie Question (2).

As far as a uniform application of the law is concerned, the prevailing case law of the Boards of Appeal is that no referral is necessary where there is no contradictory case law and earlier EPO case decisions can be followed (see, for example, J 47/92, r. 5). Significantly, the referring Board does not point to any contradictory or otherwise divergent case law in the Referral Decision. Quite to the contrary, in the Referral Decision at §24, the Board *openly acknowledges that no meaningful conflict in the case law exists* concerning the EPO's authority to examine entitlement to claim priority by stating '... the standing practise of the boards of appeal to decide on the priority rights in general, including the entitlement to the priority right'. The Board continues in the Referral Decision at §25 by noting that '... *none of the parties* presented arguments in their written submissions *why the present standing practise is incorrect* ...'.

Thus, it is evident from the reasoning of the Referral Decision that the Board did not consider the uniform application of the law under Article 87(1) EPC to be an issue ripe for Enlarged Board review insofar as Question (1) is concerned.

We agree with the Board's findings on this point and additionally note that numerous decisions issued by the Boards of Appeal over decades since entry into force of the EPC almost 50 years ago have *at least implicitly* answered Question (1) in the affirmative, by engaging in an assessment as to whether the applicant of a subsequent application

was a ‘successor in title’ to the person who filed the priority application(s) in compliance with Article 87(1) EPC: see, for example, T 1008/96, T 62/05, T 788/05, T 493/06, T 382/07, T 577/11, T 205/14, T 517/14, and, most prominently, T 844/18. Importantly, in T 844/18 the 3.3.08 Board decided that the EPO has jurisdiction to investigate whether all requirements of Article 87(1) EPC are fulfilled and that ‘the bar for overturning long established case law and practice should be a high one because of the disruptive effects a change may have’ (see T 844/18 at §§ 53, 86).² Provisions for carrying out this priority entitlement examination are equally laid down in the EPO Guidelines of Examination (2022) (see F-VI, 1.3). The referring Board indicates their agreement with T 844/18 on this topic in §24 of the Referral Decision when observing that this ‘high bar’ for reversing well-established case law also ‘applies to the standing practise of the boards of appeal³ to decide on the priority rights in general, including the entitlement to the priority right’.

Particularly when drafting a report on patentability, the EPO is obligated to formally examine the entitlement to priority to ensure that the relevant date of the prior art is reliably established. The EPC authorises this inquiry under Article 87(1) EPC, which takes on particular importance when a priority claim is called into question. Under Article 89 EPC, a validly claimed priority date acts as the effective date of filing for the purposes of determining the state of the art against which an application is evaluated for novelty and inventive step. The EPO must therefore be competent to assess priority entitlement to allocate a prior art date in a systematic and dependable fashion in a way that affords legal certainty for all users of the EPO: see Enlarged Board decisions G 2/98 (for example, at r.8.1) and G 1/15 (for example, at r.4.3). Thus, it cannot be contested that it is the standing practice of the EPO to examine successorship in title to the priority right, should this question be relevant for the purposes of patentability. Therefore, the referral of Question (1) could not have been occasioned by the need to ensure uniform application of the law.

Similarly, there is no explicit statement in the Referral Decision that, and no reasoning why, the point of law should be considered as of fundamental importance. Even if the Enlarged Board acknowledges that the point of law triggering Question (1) is of fundamental importance, the referral conspicuously fails at least the criterion under Article 112(1)(a) EPC, because no Enlarged Board decision is necessary to answer this question. The referring Board does not concern itself with arguing why a decision by the Enlarged Board would be required, despite the clear mandate in headnote 1 of G 1/14 to do so. Quite to the contrary, the entire thesis of the referring Board’s comments on Question (1) indicates that the Board would have been perfectly capable of answering Question (1) of its own accord, without any Enlarged Board guidance, based on EPC provisions and existing EPO case law: see, for example, Referral Decision at §24, with reference to T 844/18.

Taken together, the referring Board experienced no apparent difficulty in deriving from the EPC and the standing practice of the EPO Boards that Question (1) should be answered in the affirmative.

In our view, the purpose of Article 112(1)(a) EPC cannot be read to support a permanent review of every established line of case law from every Board of Appeal, relating to questions that the Boards were able to consistently answer based on the EPC. This observation is confirmed by the case law itself. For instance, in numerous decisions, see, for example, J 5/81, T 39/05, and J 10/15, the Boards respectively held that there was no need for a referral to the Enlarged Board if the answer to a legal question, even of fundamental importance, could be derived unambiguously from the EPC. In fact, other decisions, for example T 248/88 and T 15/01, have held that this principle even applies in cases where the Board answered questions not perfectly consistent with the EPC, but instead represented isolated ‘one-off’ decisions that deviated from the established case law. It is thus evident that, by these standards, presently referred Question (1) does not need to

2) We refer to our article regarding the EPO priority entitlement approach in Case T 844/18: Stacey J. Farmer, Gabor Mester and Martin Grund, ‘The EPO Maintains its Long-standing Priority Entitlement Approach in Case T 844/18’, 17(6) *Bio-Science Law Review* 248–54.

3) Although the referring Board refers to the ‘standing practice of the boards of appeal’, we submit that this ‘standing practice’ also refers to EPO departments in the first instance.

be answered by the Enlarged Board, since the EPO Boards of Appeal have been reliably able to derive an affirmative answer from the EPC alone.

In the Referral Decision at §26, the Board also states that it ‘is also receptive to the argument’ that if other questions relating to priority (that is, Question (2)) are referred to the Enlarged Board, this constituted a ‘convenient opportunity’ to piggyback Question (1) into the referral as well. To put it bluntly, apparently the referring Board was of the opinion that if Question (2) was to be referred, Question (1) might just as well be bundled in for good measure. We strongly disagree with this approach. ‘Convenience of opportunity’ is not a criterion for the admissibility of an Enlarged Board referral according to Article 112(1) EPC. The Enlarged Board has a history of limiting referred questions in scope if they are considered too broad for what actually needs to be answered in the underlying case. A prominent and recent example is decision G 1/21. Here, the Enlarged Board limited the originally referred question, which concerned the compatibility with the EPC of oral proceedings by mandatory videoconference *in general*, to the significantly narrower scope of mandatory videoconferences *before the Boards of Appeal in a state of general emergency*, such as the ongoing Covid-19 pandemic. In view of this frank approach by the Enlarged Board to even limit individual referral questions in their scope, we fail to understand any justification of admitting a separate ‘extra’ question (Question (1)) that is referred not because the referring Board does not know how to answer it, but instead because the referral of another question affords a ‘convenient opportunity’ for the question to be reviewed.

The consequences of submitting Question (1) do not appear to have been adequately considered by the referring Board. The referral affects many other pending cases. At least one Board of Appeal has already found itself obliged to stay appeal proceedings in unrelated cases (for example, T 2360/19, T 2516/19, and T 2689/19) in view of the instant pending referral. Other proceedings at the first instance have also been stayed because of the instant referral, for example opposition proceedings for EP18200462.2. Importantly, in

these cases, only the answer to *Question (1)* is of potential relevance, meaning that the proceedings would not have been stayed if the present referring Board had refrained from using the emphasised ‘convenient opportunity’ to bundle Question (1) with the more relevant issues framed by Question (2). We can expect that other Boards of Appeal will follow suit with this new strategy, which will naturally impact even more parties and their procedural right to swiftly conduct EPO appeal proceedings without undue delay. Thus, there is a high likelihood that unnecessary inconveniences and delays will be imposed on many parties due to the referring Board having availed itself of this ‘convenient opportunity’, which is not in the interest of the public, the EPO, or in keeping with the EPO principles of legal certainty.

To summarise, based on current European practice and case law, we consider there is no valid reason for referring Question (1) to the Enlarged Board of Appeal. Consequently, the referral of Question (1) should be held inadmissible due to a failure to comply with the requirements of Article 112(1)(a) EPC.

Should the Enlarged Board nevertheless decide to admit Question (1), finding that indeed this question meets the criteria under Article 112(1) EPC, we hope that the answer to Question (1) will be in the affirmative. Should the Enlarged Board find that the fact pattern in T 844/18 is distinguishable from the instant set of referral cases because no successorship in title was expressly at issue in T 844/18, and referred Question (1) formally concerns only the EPO’s jurisdiction to examine successorship in title, this difference cannot change the Enlarged Board’s answer to Question (1).

In Case T 844/18, the Board only examined the ‘identity of applicant’ question, namely whether the PCT applicants at the filing date were the same as the ‘priority-entitled applicants’ who filed the 12 priority applications claimed. No direct successorship in title inquiries were at issue in the case. However, it would lead to a manifestly absurd outcome under Article 87(1) EPC if the EPO were deemed to have jurisdiction on the question whether a priority-entitled applicant was the one who filed the priority application, but, in the case of a negative answer, would have no jurisdiction to examine

whether a claim to successorship in title put forward by this applicant was valid. If this view were adopted by the Enlarged Board, any applicant not entitled to claim a priority right could thus remove this question from the EPO's jurisdiction by making, even with the complete absence of any evidence, a spurious and self-serving claim to successorship in title, while applicants not making such a claim would have their claim to priority held as invalid. In effect, such an EPO policy would seem to strongly encourage, and even reward, making sham claims to successorship in order to secure access to a priority right.

To avoid such undesirable incentives, the jurisdiction to decide on whether an applicant is the person who filed the priority application at the filing date or their successor in title may not be divided. There is absolutely no rationale for such a division of jurisdiction provided by the EPC. Rather, the reasoning in T 844/18 is likewise fully applicable to the examination of successorship in title, even if the Board did not need to specifically examine this issue in that particular case.

Question (2) The 'PCT Joint Applicants Approach'

In contrast to Question (1), we consider Question (2) to be admissible and ripe for review, as both the EPO case law and numerous first instance decisions appear to reflect divergent outcomes as to the treatment of the 'PCT joint applicants approach' where this issue has been material to the patentability of the underlying patent right. The fundamental question underlying Question (2) is therefore whether the EPO's established 'joint applicants approach' under the EPC can be extended to determining the validity of a priority claim to international applications filed under PCT procedures.

As discussed above, we consider that the EPO is empowered and even obliged to examine whether a priority claim meets the formal requirements laid down in Article 87(1) EPC, namely that the priority claim can only be validly made by a priority-entitled applicant or their successor(s) in title.

Under the European 'joint applicants approach', a priority-entitled applicant who has duly filed a priority application can introduce the right to priority into a subsequent priority-claiming European patent application in respect of the same invention *for the benefit of all co-applicant(s)*. This does not change even if the priority-entitled applicant is designated for the same or different Contracting States as the other co-applicant(s). The European 'joint applicants approach' thus underscores the *joint action* of the priority-entitled applicant and the other co-applicant(s) who have *jointly filed* the subsequent priority-claiming European application. While Article 87(1) EPC does not attach priority claim validity to a transfer of the priority right from the priority-entitled applicant to the fellow applicant(s) prior to filing the subsequent priority-claiming European application, Article 87(1) EPC does require a showing of a succession in title where the priority-entitled applicant is not named with the other co-applicant(s) at the filing date. In other words, Article 87(1) EPC only requires that the priority-entitled applicant, or their successor in title, to file a European patent application claiming that priority. How national rights are distributed amongst the co-applicant(s) following validation of the resulting European patent in one or more EPC Contracting States is irrelevant to the application of Article 87(1) EPC.

Question (2) concerns the related situation, coined as the 'PCT joint applicants approach',⁴ where the later application is an international application filed under the PCT procedures by co-applicants, where the applicant(s) of the priority application (or their successor in title) are named as PCT applicant(s) *for PCT Designated States other than the EP regional designation*. Question (2) arises by examining whether the priority can be validly claimed *for the designation EP* in the absence of a separate transfer of the priority right(s) due to the fact that the co-applicants of the PCT application included all priority-entitled applicants named on the previous (priority) application(s) (or their successor in title) for the non-EP designations, such as the US.

The appellant in the present consolidated referral cases advocates the position that the PCT joint applicants approach

4) See Referral Decision at §17.

can be properly applied to the formal priority problem at issue, relying on Article 11(3) PCT and Articles 118 and 153(2) EPC.⁵ The core argument of the patentee centres on the fact that the priority claim to US priority document (P₁) is valid even in the absence of a successor agreement, because all priority-entitled applicants named on P₁ were named as applicants in PCT application A₁ at the filing date, which is consistent with the Examination Guidelines (2022) at A-III, 6.1, the EPO Notice in OJ EPO 2014, A33, decision J 2/01, and also in line with other relevant PCT and EPC provisions: see Patentee's Grounds of Appeal dated 5 October 2017 at §3.

However, in the Referral Decision at §19, the Board opined that the PCT joint applicants approach 'concerns a point of law of fundamental importance relevant to a number of cases' and acceptance of this approach 'is not clear cut', at least because there is no established legal basis deriving from Article 11(3) PCT. In the Referral Decision at §30, the Board acknowledges that Article 11(3) PCT provides that the international application shall have the effect of a regular national application in each designated state, a 'provision mirrored in Article 153(2) EPC'. On the subject of joint applicants acting in unity during EPO procedures, the Board recognises the basis in Article 118 EPC:

Where the applicants for or proprietors of a European patent are not the same in respect of different designated Contracting States, they shall be regarded as joint applicants or proprietors for the purposes of proceedings before the European Patent Office. The unity of the application or patent in these proceedings shall not be affected [...].

However, as stated in §31 of the Referral Decision, the Board was not convinced by the appellant's argument, instead finding that 'not all of the applicants for the PCT application are applicants for a European patent, [which] is materially different from that of a regular European application'. The Board emphasises that:

Neither Article 11(3) PCT nor Article 153(2) EPC provide that PCT applicants for a different territory [...] shall be regarded as applicants for all other designated

territories as well. On the contrary, the possibility of designating different applicants for different designated states [...] must necessarily mean that the status as an applicant is limited to the designated territories.

Based on this finding, the Board held that the application of Article 118 EPC in this context was improper.

The PCT joint applicants approach had previously been endorsed by at least one opposition division; namely in case EP 1 737 491 in a decision dated 1 February 2019. However, this approach has not been confirmed by the Boards of Appeal to date. In its reasoning at §19, the referring Board mentions several appeal cases in which the PCT joint applicants approach is (or has been) a disputed concept (for example, T 2749/18, T 2842/18, T 1837/19 and T 845/19). Furthermore, there are cases in which the PCT joint applicants approach could have been applied, but the Board of Appeal nevertheless required proof of the transfer of the priority right to the successor in title (T 205/14). We therefore consider that Question (2) does concern a point of law of fundamental importance to which no definitive answer can be derived from the existing EPO case law.

In the Referral Decision at §32, respondent 1 argued in favour of answering Question (2) in the affirmative by presenting the idea that a PCT joint applicants approach 'can be based on the unitary character of the priority right in the PCT and thus on the operation of the PCT alone'. The referring Board, however, was not persuaded, noting in §33 that the 'PCT does not create rules of its own regarding the effect of a priority claim' but instead 'refers to Article 4 of the Paris Convention' in Article 8(2)(a) PCT. Therefore, the Board found that the validity of the PCT joint applicants approach should be assessed 'in light of the Paris Convention' rather than the PCT, 'in particular the meaning of the term "successor in title"'.

A third argument brought forward by the appellant as discussed in the Referral Decision in §§ 34 to 36 offered a perspective that, according to the referring Board at §37, is more 'appealing as it provides for a harmonized and well-founded assessment of an alleged transfer of the priority right' by showing how the PCT joint applicants approach could

5) See Referral Decision at §30.

be accepted under the EPC. This argument is based on the judgment of the Court of Appeal of The Hague (CoA) in the case *Biogen/Genentech v Celltrion*.⁶ In this case, the dispute centred on the validity of the Biogen owned EP 1 951 304 (EP304). EP304 claims the priority of two US applications, denoted herein as 'P1 and P2'. P1 was applied for by an employee of Biogen. Prior to the filing of P1, Biogen and the employee concluded an agreement governed by Massachusetts state law ('Employee Proprietary Information and Inventions and Dispute Resolution Agreement') that purported to assign P1 to Biogen. To establish whether Biogen could invoke the P1 priority right, the court first determined if and how a priority right can be assigned. The right to priority is (according to the CoA) a right that is granted by the *lex loci protectionis*. Since Biogen claimed the P1 priority right for a European patent, the governing law is thus the EPC. This is contrary to what both of the parties argued when agreeing that US law should be applicable. Article 87 EPC stipulates that a successor in title shall also enjoy a right of priority, *but the article does not contain limitations on the assignment of a priority right*. The CoA therefore found that the priority right as such is assignable from the point of view of property law. The CoA also determined that the *EPC does not prescribe* formal requirements for the assignment of priority rights. Although formal requirements are prescribed by Article 72 EPC for the assignment of a European patent application, the CoA saw no reason to apply these as requirements for assigning priority rights. Because a priority right can be separately assigned and there are no formal requirements established by the EPC that such a priority right assignment must meet, the CoA concluded that the P1 priority right had been validly assigned to Biogen by mutual agreement.

The referring Board points out in the Referral Decision at §38 that should the CoA's reasoning be followed by the Enlarged Board, that:

the legal system to be applied to assess the priority right is solely the EPC, then it seems that the EPC does not, in Article 87 EPC or elsewhere, impose any formal requirements for the transfer of the priority right by agreement.

The Board refers to several EPO decisions that are considered to support this point. The Board then provides an example that illustrates this rationale: a mutual filing of a PCT application by parties A and B, wherein party B is named as the applicant for the designation EP and party A is the priority-entitled applicant who is named as the applicant solely for the US, 'demonstrates – absent indications to the contrary – the existence of an implicit agreement between party A and party B, conferring on party B the right to benefit from the priority for the EPC territory'. In fact, we consider that this joint act of filing might be sufficient evidence showing that the right of priority had been implicitly agreed for all countries, since party B had consented to take part in the filing of the PCT application with full knowledge that party A would be the applicant for the designation EP and would claim the right of priority, at least according to the formal documentation transmitted with the application at the filing date. The Board found that 'this implicit agreement could possibly be sufficient to bring about the transfer of the priority right to party B for the [entire] EPC territory'.

The Board expresses concern with the CoA's approach by addressing the problem of 'uncertainty regarding the legal system that is applicable to the assessment of the transfer of the priority right' in the Referral Decision at §37, by noting that several decisions of the EPO Boards of Appeal have assessed the legal requirements for the transfer of the priority right by applying national law. The Board questions whether this approach is correct, 'as the EPC does not contain any conflict of laws-rules and this issue has so far not been addressed by the [Enlarged Board]'. The Board also observed that a 'separate question relating to the conflict of laws-rules to be applied to a transfer of the priority is nonetheless not necessary because it is inherently contained in the questions posed and it will be addressed in the considerations of the [Enlarged Board], as needed'.

Following the Board's observations in the Referral Decision at §37, we additionally note that the application of the *lex loci protectionis* (that is, the EPC) to the transfer of priority rights may have further undesirable ramifications outside of the presently examined context of multiple PCT co-applicants. For

6) Gerichtshof Den Haag 30 July 2019; ECLI:NL:GHDHA:2019:1962.

instance, many national laws (for example, German, Japanese, and Israeli law) contain specific provisions governing the transfer of rights to inventions by employees made during the scope of their employment to the employer, which also covers the right to claim priority, for example, from a national patent application filed by the employee. Should the *lex loci protectionis* be applied by the EPO for priority right transfers as a matter of course, it is questionable whether such transfers effected by the operation of *national law* (not the EPC) would still be acknowledged by the EPO. Thus, an employer filing a European patent application for such an invention and claiming the priority of an earlier, employee-filed application might find that the priority claim is invalidated by the EPO, since no valid transfer occurred according to the EPC. Therefore, the CoA's application of the EPC alone in the context of Question (2) appears to go too far and create more problems than it solves. Clearly, a more objective and reliable framework is needed to provide consistency when evaluating priority claims made by a successor in title, yet the approach must stay within the EPO's competence afforded by Article 87(1) EPC.

The referring Board, however, also mentions in the Referral Decision at §39 that, in the context of the above illustrative example, 'in case a particular national legal system were applicable, then a priority right could still be considered validly transferred to party B if the applicable system does not require any formalities either'. For instance, a judgment of the German Supreme Court (Bundesgerichtshof, or BGH) dated 16 April 2013 (X ZR 49/12 – *Fahrzeugscheibe*; submitted by respondent 2) acknowledged the validity of a priority claim from a German national patent application for the German part of a European patent on the basis of an implicit agreement ('konkludente Einigung'). Here, the BGH found that the priority-entitled applicant had validly transferred the priority right to the named EP applicant as a result of a research and development agreement in place between the parties. 'The BGH held (1) that the transfer of a priority right is a matter of the applicable German conflict of laws-rule [...]; (2) according to these rules 'German national law applied to the transfer of the priority right' [...]; and (3) 'that German law

did not require any particular formalities for the transfer': see Referral Decision at §40.

As a final thought, the Board in the Referral Decision at §41 identifies a UK decision, *KCI Licensing Inc and others v Smith & Nephew PLC and others* (Case HC09Co2624) dated 23 June 2010, which supports the view 'that the PCT application could be regarded as proof of an agreement to transfer the priority right' in a situation where a subsequent PCT application designated the priority-entitled inventor for the US only, Company B for GB only, and Company A, who was the proprietor of the subsequent European patents, for all other PCT Designated States. The UK court found that only Company B was entitled to claim the priority right from the priority-entitled inventor. Although the UK judgment did recognise that the applicants were separately distributed across the specified PCT Designated States, 'this did not adversely affect the claim to priority, although there was no evidence of any assignment of the priority right' from the priority-entitled inventor or Company B to Company A.⁷ Instead, the UK court found that the agreement to share the priority right 'could be inferred from the PCT application', namely, 'from the circumstances surrounding the filing of the PCT application' showing the conduct of Company B to transfer part of its interest in the invention to Company A, 'thereby making Company A a successor in title for the purposes of claiming priority, and that no greater degree of formality was required'. Although this rationale was an *obiter dictum*, this logic was found to 'support the qualification that, in certain circumstances, of the PCT application as an instrument of transfer of the priority right'.

The approach offered by the UK decision is provocative, at least for focusing the successor in title inquiry at the *circumstances surrounding the PCT filing date*, rather than events leading up to the filing date or events during prosecution of the application or subsequent to grant. For the European 'joint applicants approach', both Article 59 EPC and Article 118 EPC recognise that a single European patent application can be filed by joint applicants who can designate different EPC Contracting States as a unitary procedure,

7) See, for example, paragraph 59 of the decision.

wherein the joint applicants are assumed to have agreed to act in common for the *purposes of filing* the EP application; this cooperation continues until the European patent is granted, when the joint applicants can ‘part ways’ into the one or more EPC Designated States, as applicable. The EPO ‘joint applicants’ approach thus allows a priority-entitled applicant(s) (or their successor in title) to introduce their priority right into a European patent application filed with co-applicants as a *joint action for the purposes of the filing*, which is the time a filing date is accorded. The priority right is thus introduced and shared, *at least implicitly*, to the benefit of all joint applicants without the need for a separate contract governing the transfer of the priority right.

A parallel means as a ‘PCT joint applicants approach’ appears reasonable under the PCT framework where a priority-claiming applicant(s) (or their successor in title) introduces their priority right into a PCT application at the PCT filing date with other co-applicants: see, for example, Article 9 PCT, Rule 18.3 PCT. At the PCT filing date, a single PCT application is applied for and is controlled by the collective documentation submitted by all co-applicants *on the filing date*, including a single Form PCT/RO/101 Request that indicates, *inter alia*, all applicants and priority claims as a unitary procedural act *for the purposes of filing*, irrespective of any individual designations of the PCT Contracting States amongst the different joint applicants. Whatever happens downstream when the PCT enters the EP Regional Phase, the priority claims made at the PCT filing date, as governed by Article 8(2)(a) PCT (external priority claims) referring to Article 4 of the Paris Convention, should not be disturbed by a contrary treatment before the EPO that could otherwise invalidate the priority claims when applying the EPC. After all, per its Preamble, the EPC is a special agreement

under Article 19 Paris Convention and a regional patent under Article 45(1) PCT; Article 87 EPC must not contravene these agreements accordingly. Notably, Article 4A(1) Paris Convention does not require a priority-entitled applicant to transfer the priority right to the co-applicants before jointly filing the subsequent application; *instead, this provision only states that a successor in title to such priority interest can avail itself to such right instead of the applicant filing the previous application*. The above reasoning is supported by, for example, Article 153(2) EPC, which treats an international application (as a whole) that designates the EPO as a Designated/Elected Office as a regular European patent application and thus, for the purposes of filing a Euro-PCT, all named co-applicants at the PCT filing date are considered to act jointly (in line with PCT treatment), *but not necessarily for the purpose of proceedings before the EPO*. On balance, a claim to priority that is formally valid under the international PCT framework, which is independent from any applicable national law, should remain intact when it enters the EP Regional Phase.

How the Enlarged Board of Appeal will finally decide on this matter is awaited with great excitement by the global patent community. The *amicus curiae* briefs submitted to date in Cases G 1/22 and G 2/22 represent a thought-provoking and diverse array of views as to how the Enlarged Board should decide on Question (1) and Question (2). We remain optimistic that the Enlarged Board’s ruling will lead to a harmonised approach affording EP applicants the procedural benefits offered under the international PCT framework before the EPO, an approach that takes on greater importance considering the upcoming implementation of the Unitary Patent and Unified Patent Court systems, which is also under the competence of the EPO.