



Letter accompanying subsequently filed items

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Application number

98203458.9

Applicant's or representative's reference

DHP81933M.GE

	Description of document	Original file name	Assigned file name
1	Letter relating to Appeal procedure	Filing third party obs G1-15.pdf	APPEAL-LETT-1.pdf
2	amicus curiae (statement by third parties in the procedure of the Enlarged Board of Appeal according to Art. 10 RPEBA)	Third Party Observations 140116.pdf	APPEALG-AC.pdf

Signatures

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Signed by: **David Pearce 29300**
Representative name: **David Pearce**
Capacity: **(Representative)**

Acknowledgement of receipt

We hereby acknowledge receipt of the following subsequently filed document(s):

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/European Patent Office/

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Dear Sirs

European Patent Application No. 98203458.9
Infineum USA L.P.
Enlarged Board referral by T 557/13
Case number G 1/15
Our ref: DHP81933M.GE

We submit the enclosed third party observations on behalf of a patent practitioner with particular knowledge of Japanese practice and the history of the Paris Convention, who wishes to remain anonymous.

Yours faithfully

<signed electronically>

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Third Party Observations with regard to Case G1/15

Introduction

The EPO's Enlarged Board of Appeal invited written comments on the issues relating partial priority, especially the problem of the so-called "poisonous" divisional and "poisonous" priority on 2 October 2015. With regard to the interpretation of the proviso "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" instructed in G2/98, it is expected that lots of comments be submitted. In this regard, my concerns might be different from those of many other patent practitioners because I would like to consider the issues not only from the standpoint of the EPC but also from the standpoint of the Paris Convention.

So far the Enlarged Board of Appeal has not analysed Article 4H of the Paris Convention in the context of Article 29(1)(c) of the Paris Convention. The difference between Article 4B of the Paris Convention and Article 89 EPC has also not been analysed in the context of Article 19 of the Paris Convention. These analyses are desired to be made in G1/15. As a result, my concerns are directed to only Question 1 and Question 5.

Over the past decade, I have researched on jurisprudence on the right of priority in US and Europe and legislative history of the Paris Convention. Those experiences motivated me to express my concerns about the issues. This is my personal statement regarding the points of law referred by Technical Board of Appeal 3.3.06 in case T 557/13.

Technical Board of Appeal 3.3.06 referred some points of law to the Enlarged Board of Appeal by interlocutory decision of 17 July 2015 in case T 557/13. The first question and the fifth question, which are my concerns, are as follows:

1. Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document?
5. If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Article 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic

"OR"-claim of the said European patent application or of the patent granted thereon?

1. Consideration under the EPC

Article 88(2) EPC stipulates multiple priorities as follows:

Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries. Where appropriate, multiple priorities may be claimed for any one claim. Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

The provision means that multiple priorities may not be recognised if inappropriate. It is understood that partial priority is a special case of multiple priorities. A typical example of inappropriate cases is errors of formal requirements such as an application which an earlier application of was filed more than 12 months before the filing date of the European patent application, but inappropriate cases also may include errors of substantive requirements, which is the legislative intent of the EPC as informed by the so-called FICPI Memorandum¹. According to the legislator, multiple priorities cannot be claimed for an "AND"-claim. This can be affirmed by the provision "The right of priority shall have the effect that the date of priority shall count as the date of filing of the European patent application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2" in Article 89 EPC.

The FICPI Memorandum includes three examples illustrating "OR"-type situations in which it would be desirable to be able to claim multiple priorities for one and the same claim: a) Broadening of chemical formulae; b) Broadening of a numerical range of values (temperature, pressure, concentration, etc.); and c) Broadening of a field of use. On the other hand, in G 2/98 the Enlarged Board of Appeal considered that "the use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters". This has caused confusion in the current practice.

The Enlarged Board of Appeal, of course, can stand for the requirement of appropriateness in which multiple priorities can be available, and must form such jurisprudence. However, the proviso "provided it gives rise to the claiming of a limited

¹ Memorandum C of document M/48/I, submitted at the Diplomatic Conference of 1973 by FICPI.

number of clearly defined alternative subject-matters" (hereinafter "the proviso in G 2/98") does not seem to be appropriate. The first reason is that the proviso in G 2/98 is clearly contrary to the legislative intent of the FICPI memorandum. The second reason is that even though a generic "OR"-claim may be questionable, a formal "OR" expression itself would not have any problem at all. For example, when subject matter "copper" is disclosed in the priority document, the subsequent application, in which claim 1 is "metal, except for copper" and claim 2 is "copper", does not cause any failure with respect to the requirements for patentability, e.g. novelty. There might be problem concerning lack of unity of invention, but strictly blaming lack of unity of invention is contrary to rule-of-reason. According to R. 44(2) EPC and R. 13.3 PCT, the determination of whether a group of inventions is so closely linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims, or as alternatives within a single claim.

Therefore, the answer to question 1 must be "No", I think.

2. Consideration under the Paris Convention

If the question were instead "may entitlement to partial priority be refused under the Paris convention?", another reasons for question 1 would be raised.

Under the Paris Convention, there used to be an idea that, regarding element "A" in a claim covering invention "A or B" or invention "A and B" in a subsequent application, partial benefits are enjoyed from the first priority date for "A," and consequently, a reference that discloses element "A," which has arisen during the priority period, does not become prior art of the entirety of the claimed invention "A or B" or "A and B". The idea is the so-called "umbrella" theory.

G1/15 has been entitled "Partial Priority", but I think that this title should have been also allocated to G3/93. The question in G3/93 was as follows:

Does a document published during the priority interval and whose technical contents correspond to that of the priority document constitute prior art citable under Article 54(2) against a European patent application where the claim to priority is not valid because said application comprises subject-matter not disclosed in the priority document?

Although this question seems to be concerning the effect of the right of priority under the Paris Convention, the point of law referred to the Enlarged Board of Appeal by the President of the EPO, actually, relates to the application of Articles 87 to 89 EPC concerning priority. The answer to question was "Yes." According to the provision

“the date of priority shall count as the date of filing of the European patent application” in Article 89 EPC, the answer is worthy of support. The reason why is that recognising separate priorities to be claimed for the respective elements of an invention is difficult under the “fiction” theory that the subsequent filing is supposed to have been made at the time of the first filing.

However, the Paris Convention does not stipulate the “fiction” theory as the effect of the right of priority in the same manner as the EPC. Article 4B of the Paris Convention stipulates the effect of priority as follows:

Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

This effect of the right of priority is understood according to the “umbrella” theory that publication of an application used as the basis of a priority claim is a non-prejudicial disclosure. In this regard, Dr. Ladas also pointed out as follows²:

Publication of Invention by the Inventor or Third Parties Is No Bar. ... Moreover, the purpose of article 4 was in favor of giving to the applicant the opportunity to publish and work his invention, in order to facilitate his plans and find in other countries persons interested in it. At the Brussels Conference the words “par un tiers” were stricken.

However, without taking into consideration such effect of the right of priority under the Paris Convention, the Enlarged Board of Appeal in G3/93 directly reached the conclusion that a document published during the priority interval constitutes prior art because the subject-matter of the right of priority is only the invention. The Enlarged Board of Appeal instructed “It is generally held that the subsequent filing must concern the same subject-matter as the first filing on which the right of priority is based [cf. ... G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the*

² Stephen P. Ladas, *Patents, trademarks, and related rights: national and international protection*, Harvard Univ. Press Ed. (1975), p.496.

Protection of Industrial Property as Revised at Stockholm in 1967, Geneva 1968, at Article 4, Section A(1), sub (i) ”. However, the Guide actually instructs as follows:

(i) The *subsequent* filing must concern *the same subject* as the first filing on which the right of priority is based. This means that in the case of patents, utility models or inventor’s certificates it must concern the same invention or innovation. . . . Moreover, with regard to patents, special rules concerning the identity of the subject are given in Sections F, G and H of Article 4. These provisions will be commented upon below.

Therefore, with regard to the subject-matter of the right of priority, not only Section A but also Sections F, G and H should be examined. It is necessary to explore the legislative intent of the provision “No country of the Union may refuse a priority or a patent application on the ground ... that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed...” in Article 4F. Interpretation of “elements” is also needed. So, I look at the historical background of the Paris Convention.

At the Washington Conference in 1911, multiple priorities were first proposed in order to avoid improvements of the original invention having to be prosecuted in applications for patents of addition, but the proposal was not assented to. At the Hague Conference in 1925, handling of the case in which multiple priorities are claimed was stipulated for the first time. The Hague act, in Article 4F, stipulated that the applicant may divide the application into divisional applications and preserve the benefit of the right of priority where appropriate as follows:

Si une demande de brevet contient la revendication de priorités multiples, ou si l’examen révèle qu’une demande est complexe, l’ Administration devra, tout au moins, autoriser le demandeur à la diviser dans des conditions que déterminera la législation intérieure, en conservant comme date de chaque demande divisionnaire la date de la demande initiale et, s’il y a lieu, le bénéfice du droit de priorité.

(If a patent application contains multiple priority claims, or if examination reveals that an application is complex, the Authority shall, at least, allow the applicant to divide under conditions to be determined by domestic legislation, preserve as the date of each divisional application the date of the initial application and, where appropriate, the benefit of the right of priority.)

At the London Conference in 1934, introduction of multiple priorities was agreed on. The London act stipulated divisional application in Article 4G, and stipulated multiple priorities in Article 4F as follows:

Aucun pays de l'Union ne pourra refuser une demande de brevet pour le motif qu'elle contient la revendication de priorités multiples, à la condition, qu'il y ait unité d'invention au sens de la loi du pays.

(No country of the Union may refuse a patent application on the ground that contains multiple priority claims, provided that there is unity of invention within the meaning of the law of the country.)

With regard to interpretation of the effect of the right of priority for improvements of the original invention under Article 4F, there are two possibilities. One is that right of priority is given rise to with respect to each invention, and the other is that right of priority is given rise to with respect to each element of an invention. The reason why two possibilities occur is that Article 4F makes no mention of the subject-matter of right of priority. However, this question can be solved by checking legislative example in Netherlands. In 1956, the new paragraph Article 7(3) was inserted into the Patent Act in order to correspond to Article 4F and 4H of the Paris Convention introduced at the London Conference. The text is as follows:

De voorrang kan niet worden geweigerd, op grond dat voor de uitvinding meer dan een recht van voorrang als in dit artikel bedoeld wordt ingeroepen. Evenmin kan de voorrang worden geweigerd, op grond dat voor de uitvinding of voor enig gedeelte daarvan, waarvoor het recht van voorrang wordt ingeroepen, niet uitdrukkelijk een uitsluitend recht verlangd is in de aanvraag in het land van oorsprong, mits die uitvinding of dat gedeelte in de tot deze aanvraag behorende stukken zo nauwkeurig is geopenbaard, dat die uitvinding of dat gedeelte daaruit door een deskundige kan worden begrepen en aan de hand daarvan toegepast.

(Priority may not be refused on the grounds that in the invention more than one right of priority, as referred to in this article, is invoked. The priority cannot be refused on the grounds that the invention or any part thereof for which the right of priority is invoked does not specifically require an exclusive right in the application in the country of origin, provided that the invention or that portion in the documents related to this application accurately disclosed such that the invention or part can be understood by an expert and can, on the basis thereof, be applied.)

The comment of the Government on this amendment is as follows³:

The purpose of the newly inserted provision is clarifying that the priority extends over "iedere uitvinding of ieder gedeelte (every invention or any part of an invention)", regardless of whether it is made in the claims of the previous application.

It is understood that the subject-matter of the right of priority is not always limited to the invention itself but also can be part of the invention. This is more obvious from the Lisbon Act which was adapted at the Lisbon Conference after two years of the Netherlands Patent Act amendment. The "Proposal with Statement of Reason Prepared by the International Bureau on the Request of the Government of Portugal" states as follows⁴:

Partial priority presupposes that a subsequent application filed in one of the countries of the Union claiming priority within the period of 12 months includes elements that are not stated in the previous application; in this case, priority based on the date of previous filing is available only for "elements of the invention" firstly stated in the scope of claims or in the application documents as a whole and other elements belong to the subsequent application; consequently, it causes partial priority; in this manner, belonging of several differently-dated privileges to a single invention causes a special case of multiple priorities.

It is understood that elements of the invention can be the subject-matter of the right of priority. Furthermore, there is another informative document in the Proposal with Statement of Reason. At the Conference, the International Bureau submitted a proposal for the introduction of a general grace period in Article 4J of the Paris Convention. The text of Article 4J is as follows:

1. L'octroi d'un brevet ne pourra être refuse pour le motif que les élément de l'inveniton qui fait l'object de la demande ont été divulgués par une personne autre que l'inventeur ou son représentant dans les six mois précédant la demande.

(The grant of a patent shall not be refused on the ground that the element of the invention which is the subject of the application has been disclosed by

³ Memorie van Toelichting, No. 3, Zitting 1953-1954-3451", p.2.

⁴ I could not find original text in French, but I found Japanese text which was translated by Government of Japan. Then, I translated the text into English.

a person other than the inventor or his representative within 6 months preceding the application.)

2. Cette meme disposition sera applicable lorsque la divulgation est fait par l'inventeur lui-même ou son représentant, sous r reserve des restrictions qui peuvent être imposées par la legislation nationale du puys dans lequel la demande brevet est fait.

(This provision shall apply where the disclosure is made by the inventor himself or his representative, subject to any restrictions which may be imposed by the domestic legislation of the country in which the patent application is made.)

The Proposal with Statement of Reason states that the reason behind the proposal was inventors often must disclose some elements with its invention before knowing the need to undertake other tasks.

By checking both the provisions of Article 4F and J, it is understood that the proposal aimed that the respective elements, which are gradually being added to an invention, can be the subject-matter of the right of priority and non-prejudicial disclosure. This understanding corresponds to the Netherlands Patent Act which stipulates that portion can be the subject-matter of the right of priority. In this regard, Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967 instructs in same manner as follows:

It frequently happens that an invention is not immediately complete, so that, even after a patent application has been filed for it, improvements or additions are found which are made the subject of other patent applications. The Convention makes it possible to claim, in one and the same later application in other countries of the Union, separate (multiple) priorities for the different parts of the invention, based on the various first applications made in respect of each of those parts, provided, of course, that these various applications are filed within the term of priority counted from the first application.

It frequently happens that, after a first application for a patent has been filed, subsequent applications in respect of the same invention for which the priority of the first application is claimed contain elements of the invention which were not present in the first application and which either no separate patent application has been filed in time to claim multiple priorities or no separate patent application will be filed at all (for example, because the added elements

do not, in themselves, have an inventive character). Under the Convention, such additions in later applications will not prevent priority from being recognised for those other elements of the invention which were already present in the first application.

When elements can be the subject-matter of priority, multiple priorities can be available for an "AND"-claim from a direct interpretation of Article 4B and Article F.

Nevertheless, the Enlarged Board of Appeal in G2/98 states that “umbrella” theory should be disregarded. The Enlarged Board of Appeal determined, through contrary interpretation of Article 4H of the Paris Convention, that the priority for a claim can be refused pursuant to the provision of Article 4H of the Paris Convention if “elements” of the “invention” for which priority is claimed are not disclosed in the priority application. On the other hand, according to the provision of Article 4F of the Paris Convention, it is not possible to refuse a priority on the ground that an application contains “elements” that are not included in the priority application. The Enlarged Board of Appeal eventually determined, that in order to concurrently satisfy these two provisions that are conflicting at first glance, it is necessary to understand “element” not as a “feature” but as an “embodiment”.

However, it would be natural to understand that “elements” as English word is feature, supposing "all elements rule for obviousness" and "all elements test for equivalence" in US patent law. In the Netherlands Patent Act, “gedeelte,” which means “part” in English is probably allocated to “element”, and in the German version of Article 4F of the Paris Convention, "Merkmale", which means “features” in English, is allocated to "element." Moreover the Enlarged Board of Appeal also had considered that “elements” were “features” until G3/93 decision was rendered⁵.

Furthermore, it can be said that in G2/98 the Enlarged Board’s interpretation of “element” as “embodiment” is a misunderstanding by checking the Article 4H in French. Article 4H stipulates “*ceratins éléments* de l’invention *pour lesquels* on revendique la priorité” but the Enlarged Board of Appeal understood “*ceratins éléments de l’invention pour laquelle* on revendique la priorité”. This is because the procedural language was English. It is ambiguous whether the antecedent of relative pronoun “which” in relative clause “for which priority is claimed” in the provision of Article 4H of the Paris Convention is “invention” or “elements” in English text. The original text of the Paris Convention is French, which goes without saying. Article 29(1)(c) of the Paris

⁵ In G3/93, the expressions “an application P1 containing the elements A+B” and “an application P2 containing the elements A+B+C” can be found. It is clear that each element is a feature rather than an embodiment.

Convention stipulates that "In case of differences of opinion on the interpretation of the various texts, the French text shall prevail."

There would be no problem with disregarding the “umbrella” theory in the case where the provision on the right of priority in the EPC is independently interpreted. This is because the EPC does not contain any provision corresponding to Article 4F of the Paris Convention that stipulates partial priority—“No country of the Union may refuse a priority ... on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed.” In view of this, it may be possible to say that the conclusion drawn in the EBA Opinion G2/98 is not in error since the matter referred by the President of the EPO to the EBA was not the identity of the subject given in Sections F, G and H of Article 4 of the Paris Convention but the interpretation of the requirements for the “same invention” under Article 87 EPC.

However, if the EPC aims not to contravene the basic principles of priority laid down in the Paris Convention, “umbrella” theory should not be disregarded. “Umbrella” theory is that, regarding element “A” in a claim covering invention “A or B” or invention “A and B” in a subsequent application, partial benefits are enjoyed from the first priority date for “A,” and consequently, a reference that discloses element “A,” which has arisen during the priority period, does not become prior art for the entirety of the claimed invention “A or B” or “A and B”. Hence, alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document does not constitute prior art citable under Article 54(2) against generic "OR"-claim. There are actual cases in which the effect of “umbrella” theory was recognised⁶. All these decisions were rendered in the last century, however, even now the spirit of “umbrella” theory is still alive. The effect of Prior Art Exception under AIA, where priority is not by the Paris Convention but by the first-to-disclose system, makes pre-disclosure of species to overcome intervening disclosure of genus⁷. Concerning the object of the alleged prior use which occurs between the priority date and the filing date of the patent and the content of which is described in the priority document, the EPO’s Technical Board considered that the patent application was able to enjoy partial benefit from the priority date because the

⁶ *Ziegler*, Re 347 F.2d 642, 146 USPQ 76 (CCPA 1965), *Mulder*, Re 716 F.2d 1542, 219 USPQ 189 (Fed. Cir.1983), *a-interferons/BIOGEN*, T301/87; OJ EPO 1990, 335, *Hakennagel*, BPatG 22.3.1995; GRUR 1995, 667, Concerning detailed analysis about the decisions and judgments, please refer to Kazuo Shibata "Some Problems with the Current Practices Concerning the Priority System" (2010) E.I.P.R. Issue 10, pp.520-529.

⁷ Manual of Patent Examining Procedure (MPEP)2135.02.

prior use corresponded to the content disclosed in the priority document⁸. These effects in US and Europe are similar to “umbrella” theory itself.

Therefore, the answer to question 1 is much definitely “No”, if the intent of partial priority under the Paris Convention is given, I believe.

3. Answer to question 1 under special circumstances

The “fiction” theory that the subsequent filing is supposed to have been made at the time of the first filing has already become the de facto standard in EPO, USPTO, and JPO. In fact, examination that relies on “umbrella” theory is much complicated if the third party incidents are in priority period. The reason why is that partial benefit is effective for all disclosure. In that sense, the answer to question 1 may be amended under such special circumstances.

There are other considerations. Before establishment of the EPC, multiple priorities were available in Germany, but only one priority was available for one claim under old UK practice. The EPC then reached a compromise that multiple priorities could be available for only “OR”-type-Claims. Introduction of an inventive step provision all over the world can also be mentioned. As of the London conference in 1934, there was no uniform criteria of inventive step all over the world, and as of the Lisbon Conference in 1958, only US, UK and Japan stipulated criteria of inventive step. Furthermore, systems that were common, at that time after introduction of criteria of inventive step, were such that, even if the original patent was publicly known, a patent of addition was not questioned in terms of the inventive step from the relevant publicly known fact (provided that novelty is required)⁹. As of today, the situation concerning patentability

⁸ T0665/00 of 13 April 2005. Actual instructions are as follows:

Il a été établi que le document de priorité décrivait des poudres non compactées contenant des microsphères creuses "Expancel DE" dont la masse spécifique tombe sous le terme générique "inférieure à 0,1 g/cm³ de la revendication 10 du brevet litigieux (point 3.2). Par conséquent, parmi les différentes alternatives que regroupe la revendication 10 du brevet en litige, les poudres non compactées contenant les microsphères "Expancel DE" bénéficient de la date de priorité revendiquée. L'usage antérieur invoqué se situant après la date de priorité et mettant en jeu le produit "Poudre Majeur", qui selon la requérante contient les mêmes microsphères "Expancel DE", ne peut donc détruire la nouveauté des poudres non compactées contenant les microsphères "Expancel DE" selon la revendication 10 du brevet litigieux, puisque ces dernières jouissent de la date de priorité. Comme le présumé usage antérieur ne met en jeu que des poudres contenant des microsphères "Expancel DE", la nouveauté des autres poudres non compactées objet de la revendication 10 du brevet litigieux ne peut être remise en question par l'usage antérieur même si elles ne bénéficiaient pas de la date de priorité.

⁹ For example, in the United Kingdom that had the patent of addition system until legal revision in 1977, the Patents Act put into force in 1950 provided that in the case where the original invention is publicly known, an additional invention is not required to involve an inventive step against the original invention (Section 26(7) of the Patents Act 1949). In addition, in France where the patent of addition system was established in 1844 for the first time in the world, it was provided, even after “activité inventive,” which is equivalent to inventive step, came to be clearly stated in patent law through 1968 revision, that an additional invention is not required to involve activité inventive

has been completely changed. In this sense, it is difficult to go back to the practice under “umbrella” theory.

However, the priority system was designed for the purpose of avoiding self-collision rather than overcoming competitors. In other words, the priority system originally aimed to prevent collision between a pre-filing disclosure caused by a right holder’s act in a first country and a patent application in a second country. In the nineteenth century, since the patent application was published without undue delay after the filing in many countries, that is, the invention described in the first application was published in the Patent Gazette before the date of the patent application in the second country, patent publication in the first country constituted prior art in the second country. This problem was solved by introduction of the right of priority, whose duration was six months. As of the Madrid Conference in 1890, applicants tended to decide to await the grant of the patent before applying in foreign countries. However, a period of six months starting from the first filing was too short for an effective securing of the interests of inventors, especially those who filed their first application in countries in which the system of previous examination of the invention prevailed. Various suggestions were made with the purpose of making the priority period longer. Thus, it was proposed by the US delegation at the Madrid in 1890 that the period of the right of priority should begin from the date of the official publication of the invention, instead of the date of filing the first application¹⁰. This US proposal was not assented to by the other delegations. The Belgian proposal to the effect that the period be increased from six to twelve months, which was assented to by the US, was eventually withdrawn at the Madrid Conference. The Brussels Conference, giving effect to the *voeux* adopted by the successive Congresses of AIPPI (Vienna, 1897; London, 1898; Zurich, 1899; Paris, 1900), increased the period from six to twelve months¹¹. The extension of the period of the right of priority to twelve months made possible the accession of Germany to the Paris Union.

As will be understood from these histories of the Paris Convention, the original purport of the right of priority is to prevent it being impossible to obtain a patent due to a right holder’s own act. After several amendments of the priority system, introduction of multiple/partial priorities brought to the priority system an additional effect of giving to the applicant the opportunity to publish his invention before improving the invention within priority period. In light of the origin and history of the Paris Convention, to

(inventive step) against the original invention.

¹⁰ Ibid, Stephen P. Ladas, p475.

¹¹ Ibid, Stephen P. Ladas, pp. 476-477.

reject a patent due to the right holder's act in the intervening priority period significantly impairs the purport of the priority system.

Therefore, even the answer to Question 1 is "Yes", if the EPC aims not to contravene the purport of the Paris Convention, the answer to Question 5 should be "No". Question 5 should also be considered under special circumstances.

Conclusion

"Poisonous" priority (which is based only on European patent applications) aside, "poisonous" divisionals seem to be contrary to Article 4F of the Paris convention concerning partial priority and Article 4G (2) concerning application dividing.

One of the legislative intentions behind inventive step criteria that have been stipulated all over the world at the latter half of the 20th century relates to demarcation of the public domain and the exclusive domain. It is intended that exclusive rights should not be given to such technologies which can easily occur based on Public Domain technology. In case that the basic original invention does not belong to the public domain, an improved invention within the technical scope of the original basic invention does not belong to the public domain but belongs to the exclusive domain. If such an improved invention is rejected because it is obvious from the original basic invention, this does not fulfill the legislative intent of inventive step. However, in the case where the improved invention is not obvious from the basic original invention, if the improved invention was been made by others, such an improved invention would belong to the other right holder notwithstanding the exclusive domain of the original right holder. "Umbrella" theory gives a clear explanation of the right-relationship between an original inventor and the following people¹².

Nevertheless, such ideal "Umbrella" theory might be disregarded under special circumstances although straight forward "fiction" theory is much easier for patent prosecution. Even so, I believe that poisonous divisionals should be disregarded at least under special circumstances so that the original purport of the Paris Convention can be respected.

¹² In T301/87, it was stipulated that "if such publication goes beyond the content of a previously filed application and includes subject-matters not covered by the disclosure of that application, such disclosure may in principle be cited against any claim in the (final) European patent application relying on a priority date subsequent to the publication date". The CCPA in the United States has also clearly understood such relationships. That is, in *Ziegler*, facts during the term of priority did not exceed the content of the priority applications, while in *Wertheim*, the intervening reference disclosed broader subject-matter than the foreign priority application. Therefore, the intervening reference was cited in *Wertheim*.

(Annex)

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