



HOFFMANN EITLE

Legal Entitlement to Priority at the EPO and national courts in Europe

JIPA – March 2022

Dr. Clemens Tobias Steins

MÜNCHEN LONDON DÜSSELDORF HAMBURG MILANO MADRID AMSTERDAM

自己紹介

- **Clemens Tobias Steins**
- **German attorney-at-law**
- **at Hoffmann Eitle's**
- **patent litigation and licensing team**

専門知識を有する経験豊富な弁護士が、ドイツの裁判所における特許侵害訴訟等の案件を担当します。対象となる技術分野は、情報通信から医療機器、医薬品からバイオテクノロジーに至るまでの全分野です。また、知財戦略の立案や策定の際のアドバイス、無効訴訟や異議申立続きでのサポートを行うほか、欧州の他の国々で行われる手続きのコーディネートも行っております。さらに、仲裁や調停による紛争解決や、ライセンスやR&Dに関する契約をはじめ各種契約に関するアドバイスも提供しております。



Recent trends in IP

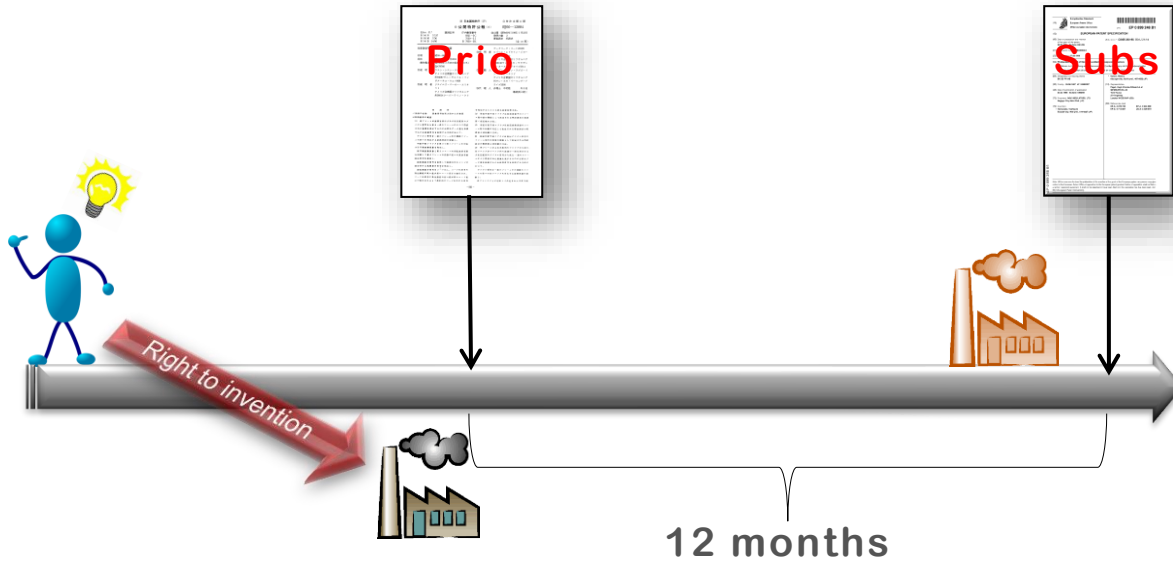
Most important recent development is the start of the provisional application period (PAP) for the Unified Patent Court on January 19, 2022.

This means, at the end of 2022 or early 2023 a new patent system will come to Europe with the Unified Patent Court (UPC) and the European Patent with Unitary Effect (EP-UE).

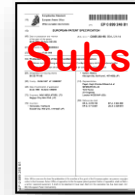
All applicants of European patent applications and holders of European patents will be affected by this new patent system and therefore should consider how to prepare.



A typical scenario



Risk of diverging applicants



: X



: A



: X



: B

- *Inventor is not relevant for priority*
- *person duly filed an application? – no*
- *his successor in title – tbd*



: A



: A+B

- *person duly filed an application? – yes:
it is regarded sufficient if A is applicant*



: A+B



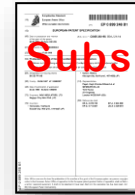
: B

- *person duly filed an application? – no:
A+B are only jointly entitled (T844/18)*
- *his successor in title – tbd*

Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, **or his successor in title**, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.



Successor in title – When must priority be transferred



📄 : A

📄 : B

• *his successor in title – tbd*



12 months

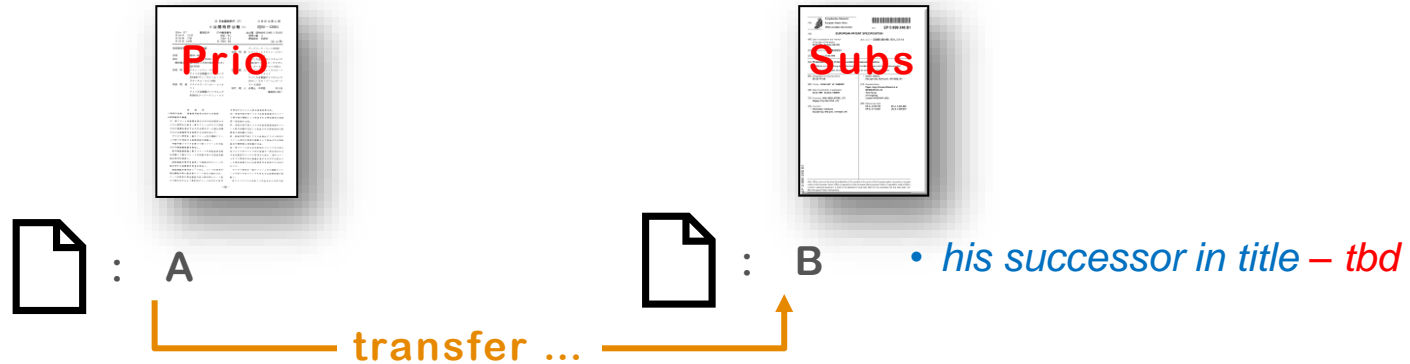


Priority right must be acquired *prior to* subsequent application – retroactive transfer not possible (T1201/14)

Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.



Successor in title – EPO’s jurisdiction to assess



Does the EPC give jurisdiction to the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC? (G1/22, G2/22 – Q I.)

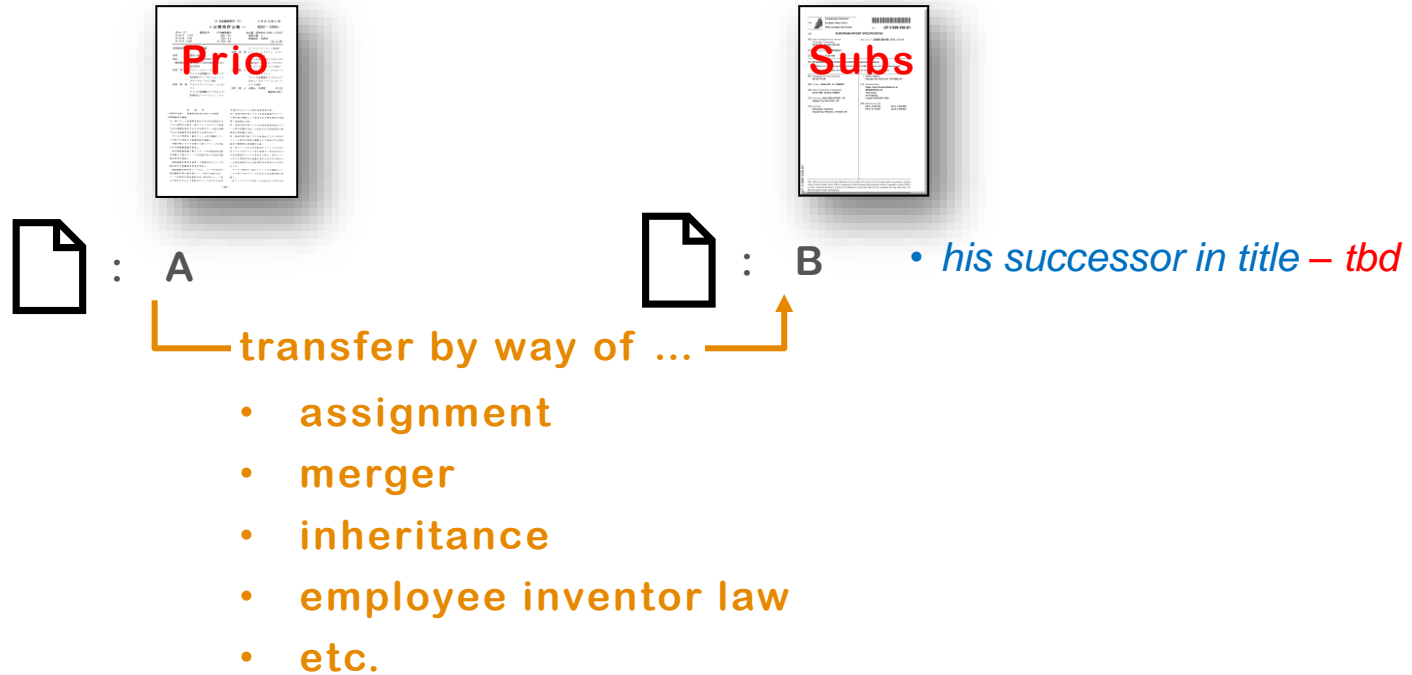
Contra:

Pro (T844/18):

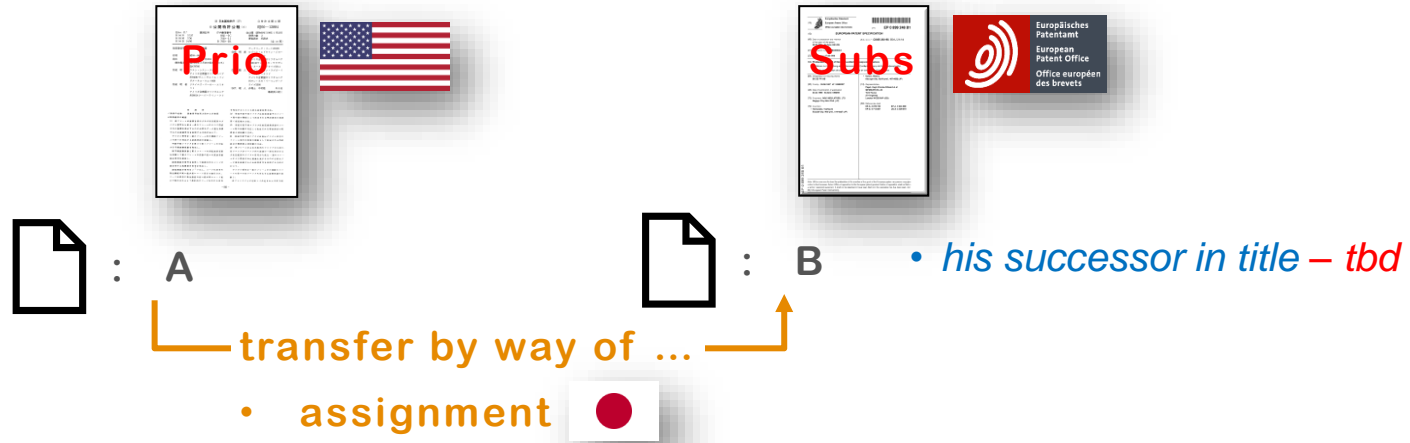
- **When the member states created the EPC:**
 - a proposal to require proof of entitlement was not adopted; and
 - disputes regarding a right to be granted a patent (inventor right) were seen as better left with national civil courts.
- **A deficiency in formal proof of transfer should not invalidate a patent**
- **“Who” is entitled to claim priority is one of the requirements under Art. 87 EPC; the EPO is not relieved from assessing it**
- **Failures to comply with formal requirement can lead to a loss of right also in other contexts**



Successor in title – No limitation as to basis of transfer



Successor in title – Applicable law

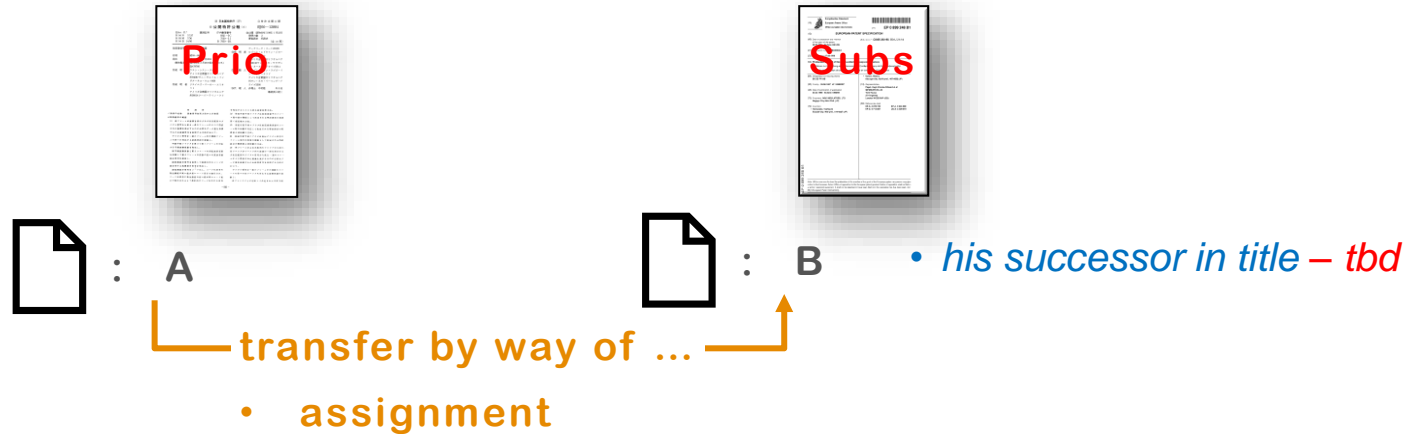


Requirements for a valid assignment may follow from the applicable law(s), so that the applicable law(s) must be determined (inherent question in G1/22, G2/22); it could be

- the law of the priority application (here US);
- the law of the subsequent application (here EPC); and/or
- the law governing the instrument of transfer (here Japanese law as the law governing the contract)



Successor in title – Identifying the transferred rights



Often the question is “which right” has been assigned:

- inventor rights
- right to priority application
- priority right

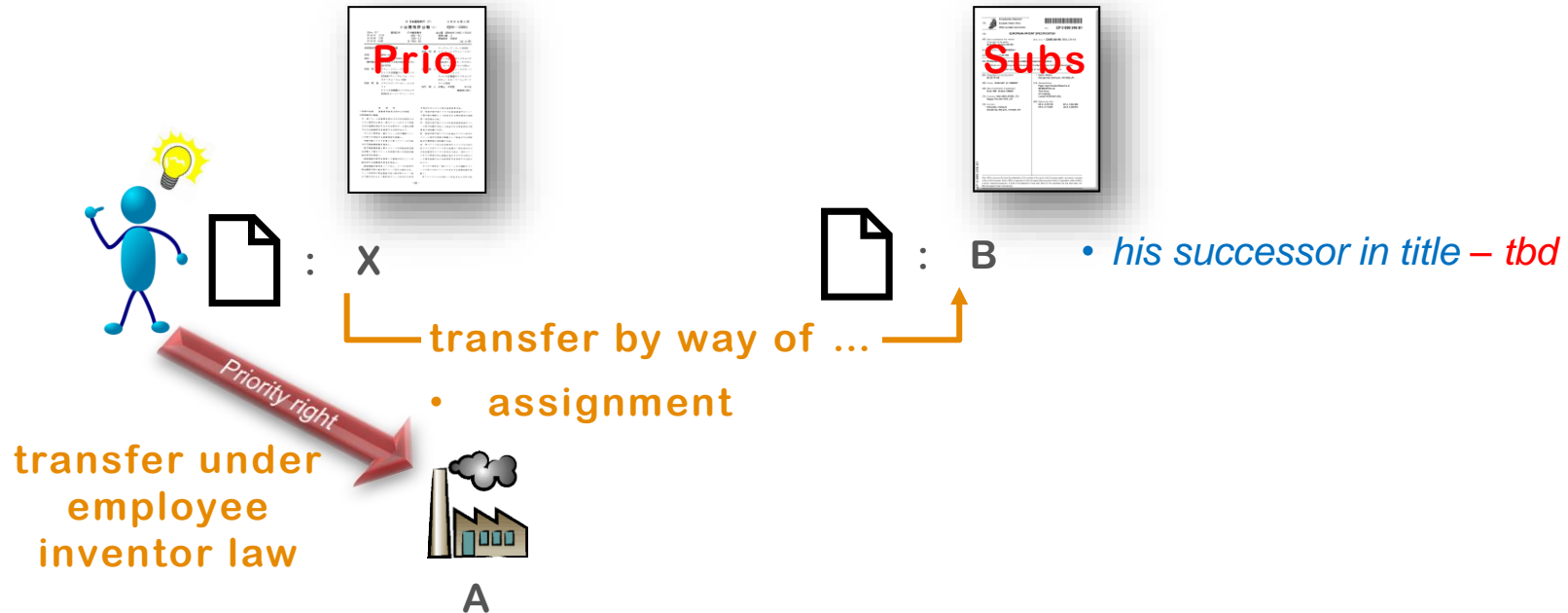
“Article 4A(1) and (2) Paris Convention do not refer to the "inventor" or the "applicant" for a patent application: they refer to a person who has carried out an act, that of filing a patent application. ... Whether these persons are the inventors of what is claimed or whether they are actually entitled to be the applicants for this patent are not issues requiring investigation under the Paris Convention.” (T844/18)

“Filing of a first application gives rise to two different and independent rights, namely the right to the application in question, and the right of priority” (T407/15)

Must be resolved by interpreting the agreement.



Risk of prior assignment



If the right to priority has been assigned to a third party, neither the applicant nor its later assignee is entitled to priority anymore (T725/14

Fujifilm Kyowa Kirin Biologics Co. Ltd. vs. Abbvie, [2017] EWHC 395)

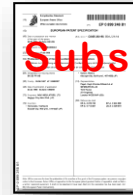
Except perhaps if later assignee is bona fide purchaser (Accord vs RCT, [2017] EWHC 2711)



PCT Joint Applicant Approach – The scenario



PROVISIONAL APPLICATION COVER SHEET
Additional Page



PCT



: A+B • *person duly filed an application, even if for other territory?*

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays this notice of approval by the U.S. Patent and Trademark Office.

Docket Number 117PRO

INVENTOR(S)/APPLICANT(S)		
Given Name (first and middle [if any])	Family or Surname	(C)
Hao	Wang	Lon Can
Zhen	Zhong	Lon Can

(71) Applicants (for all designated States except US): **ALEXION PHARMACEUTICALS, INC.** [US/US]; 352 Knotter Drive, Cheshire, CT 06410 (US). **THE UNIVERSITY OF WESTERN ONTARIO** [CA/CA]; 1151 Richmond Street North, Stevenson-Lawson Building, Room 328, London, Ontario N6A 5B8 (CA).

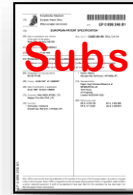
(72) Inventors; and

(75) Inventors/Applicants (for US only): **ROTHER, Russell, P.** [US/US]; 25 Blue Trail Drive, Prospect, CT 06712 (US). **WANG, Hao** [CA/CA]; 480 Sandybrook Drive, London, Ontario N5X 4H2 (CA). **ZHONG, Zhen** [CA/CA]; 60 Nathaniel Court, London, Ontario N5X 2N5 (CA).

Is it sufficient if the applicant(s) of the priority application is co-applicant on the subsequent PCT application for another territory? (G1/22, G2/22 – Q II.)



PCT Joint Applicant Approach – Decisions so far



PCT



: A



: A(US)+B(EPC)

PCT Joint Applicant Approach (legal basis)

Art. 11(3) PCT

International application shall have the effect of a regular application in each designated state

Art 118 EPC: “Where the applicants for ... a European patent are not the same in respect of different designated Contracting States, they shall be regarded as joint applicants...”

Unitary PCT Priority Right

Art. 8 PCT: “the international application” may contain “a declaration [...] claiming the priority of [...]”

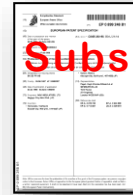
Rule 90bis.1 and 5: only all applicants jointly can withdraw a priority claim

Implicit Assignment

Due to the joint filing the applicants may have transferred the priority right by conduct



PCT Joint Applicant Approach – Decisions so far



PCT



: A



: A(US)+B(EPC)

PCT Joint Applicant Approach (legal basis)

Art. 11(3) PCT

Several Opposition Divisions

Tribunal de grande instance de Paris
(21/53136, decision of May 12, 2021)

HRC Dusseldorf (2 W 3/21, order of February 15, 2021)

Unitary PCT Priority Right

Several Opposition Divisions

Implicit Assignment

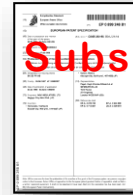
BoA in T1513/17

UK High Court (Fujifilm Kyowa Kirin Biologics Co. Ltd. vs. Abbvie, [2017] EWHC 395)

HRC Dusseldorf (see left)
But very fact dependent, e.g. denied in the above Fujifilm decision



PCT Joint Applicant Approach – Facts may matter



PCT



: A



: A(US)+B(EPC)

UK High Court

Fujifilm Kyowa Kirin Biologics Co. Ltd. vs. Abbvie

“AbbVie submits ... that the reasonable inference to be drawn from the filing of the PCT Application is that the inventors had consented to transfer part of their interest

I do not accept this argument. ... all of the inventors had left their employment and none of them had signed the PCT request. I recognise that this request was later replaced by a corrected version ... which included the signatures of the inventors. This replacement was filed within the time-period to correct defects However, ... no evidence that as of [the original filing date] any of the inventors had agreed to transfer the right to claim priority for foreign filings to Abbott Bermuda, nor that any of them knew that the PCT request was being filed...”



Summary and Conclusions

- 1) **The applicant of a European patent application may not rely on a priority date if, as of the time of filing, it was not legally entitled to the priority right**



Summary and Conclusions

2) This issue can arise

- if the applicant of the subsequent application is different from the applicant of the priority application,
 - including if not all applicants of the priority application are included in the subsequent application
- or if the applicant of the priority application transferred its priority right before filing the subsequent application



Summary and Conclusions

- 3) The questions referred to the Enlarged Board of Appeal (G1/22 and G2/22) may defuse this problem in many cases.
- If the Enlarged Board were to find that the EPO is not entitled to assess legal entitlement to priority, this issue could no longer be raised by opponents in oppositions (Q1)
 - If the Enlarged Board were to accept the PCT Joint Applicant Approach (Q2)
 - based on the legal arguments, it would resolve the issue for all typical pre-AIA cases
 - based on the concept of implicit assignment, it would resolve the issue only for the cases where the other facts support such implicit assignment



ご清聴ありがとうございました。





HOFFMANN EITLE

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Dr. Clemens Tobias Steins, LL.M.

Rechtsanwalt (German attorney-at-law)