

Patent Briefing Paper: *European Patent*

TEST FOR PRIORITY CLARIFIED BY ENLARGED BOARD OF APPEAL – G2/98

The Enlarged Board has clarified the test for priority under the European Patent Convention (G2/98)

In accordance with Art. 87 EPC a European patent application is only entitled to priority in respect of the **same invention** as was disclosed in the previous application.

The Enlarged Board held that to ensure a practice fully consistent with equal treatment for applicants and third parties, legal certainty and the principles for assessing novelty and inventive step, "the same invention" had to be interpreted narrowly and in a manner equating it to "the same subject-matter". This interpretation was underpinned by the Paris Convention and the EPC, and was entirely consistent with opinion G 3/93. The Enlarged Board therefore ruled as follows on the points of law referred to it:

"The requirement for claiming priority of "the same invention", referred to in Art. 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim **directly and unambiguously**, using common general knowledge, from the previous application as a whole."

As a result applicants must take great care when drafting priority founding applications to ensure that all aspects of the invention are defined and described fully. Priority could be at risk if the priority founding application is drafted with a single broad claim and a series of specific examples.

Further, when preparing a revised PCT specification, even if new matter is to be added and new claims are to be created, it is still very important to preserve all of the subject-matter from the priority filing so that if necessary claims can be introduced which are clearly entitled to priority.

Finally when amending the claims of a European patent application during examination, the entitlement to priority of any amended claim should be considered carefully, so that priority is not inadvertently lost.

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