

EIP

European Patent Office liberalises rules on priority

The Enlarged Board of Appeal of the European Patent Office has issued its decision in the combined cases G1/22 and G2/22. With this decision, the likelihood that a priority claim is valid even where there is a different applicant for the EPO application and the priority application is significantly increased. The press release with a link to the text of the judgment is [here](#).

The outcome significantly liberalises the EPO's approach to the assessment of priority, and in particular the issue of whether the applicant for the European patent application (or PCT application that then proceeds to enter regional phase at the EPO) was in fact entitled to claim priority at the time of filing, where that applicant is a different entity from the applicant(s) for the earlier application from which priority is claimed. The priority right attaches to the applicant(s) for the earlier application, and if a different applicant files the later application, this right needs to be assigned to the priority-claiming applicant. A frequently encountered scenario was that a US priority-establishing application was filed in the name of the inventors, while a PCT application claiming priority of the earlier application was filed in the name of their employer (at least in respect of the EPO designation – often the inventors would be applicants for US only in the PCT application and the employer company the applicant for all other states), and there was no explicit assignment of the priority right in the intervening period. The EPO in opposition proceedings used to take the view that in such cases the priority claim was invalid, and that this could not be retrospectively remedied (the priority entitlement could not be retrospectively transferred). If there was intervening prior art, this could result in revocation of the patent.

This decision has now changed the EPO practice significantly. As an initial matter, the

Enlarged Board held that the EPO is competent to assess whether a party is entitled to claim priority, and rejected a suggestion that only a national tribunal should be competent to decide this. Moreover, it held that, in the absence of uniform national criteria for this issue, the EPO should apply the autonomous law of the European Patent Convention, applying criteria that should not be stricter than national rules applicable to the transfer of priority rights. The Enlarged Board noted that (unlike assignment of patents, for which the EPC prescribes that an assignment must be in writing with the signature of the parties) there is no specific law prescribing the requirements for a valid transfer of a priority right, and that some national laws accept informal or tacit transfers of priority rights. The judgment therefore accepts that priority rights can be transferred under an informal or implicit agreement.

The new ruling establishes that where priority is claimed and the formal requirements (such as submission of a certified copy of the earlier application by the appropriate deadline) are complied with, there should be a strong but rebuttable presumption that the applicant was entitled to claim priority, even if not the same applicant as for the priority-establishing application. The presumption cannot be challenged by speculative doubts – a party challenging the entitlement to priority must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority.

In addition, the new ruling addresses the specific situation that a PCT application is filed with the applicants for the priority-establishing application as applicants for one territory (such as the US) and a different applicant for the EPO. In such cases, the Enlarged Board held that the joint filing implies an agreement between the priority applicants and the other applicant, allowing that other applicant to rely on the priority, unless there are substantial factual indications to the contrary. Thus, in such cases it will be assessed that the priority entitlement has been implicitly transferred in respect of the EPO designation.

This decision will remove a frequent source of invalidity of European patents, at least as assessed by the EPO. National courts are not bound by the EPO's assessments, but may choose to re-evaluate their practice where it is currently stricter than that set out in this judgment.