



## Newsletter 1/2017 Edition

Düsseldorf/Munich, 9 February 2017

### Decision G1/15: There aren't any "toxic divisionals" or "poisonous priorities"

After the Enlarged Board of Appeal for the European Patent Office published an order regarding their decision on G1/15 last year, they have now made their full reasoned [decision](#). To get straight to the point: this is good news for patent holders, as the Enlarged Board of Appeal has de facto thrown the concept of any "poisonous priorities" overboard.

The underlying issue was whether a claim to priority would be valid if content in prior and subsequent applications is not identical. This matter was previously regulated by the fundamental jurisdiction of the [G2/98](#) decision which stated that partial priorities can be acknowledged if each individual subject matter can be clearly defined (s. 6.7 of this decision).

In the following case, the situation regarding priorities has therefore been clear thus far: if a prior application specifies a list of materials A, B and C, whereas the subsequent application specifies materials A, B, C and D, the priority would be acknowledged for A, B and C, but not for D.

Problems arise when subject matters cannot be recognised as individual from one another, such as ranges, for example. According to case law settled by the European Patent Office, each subsection is often not disclosed. Without the appropriate disclosure, a given range of (e.g.) 1-20 cannot be narrowed down to 5-10.

Except for the 3.3.07 Board of Appeal, Boards of Appeal used to regularly deny claims for priority when area specifications changed, due to this disclosure test. For example, a claim for priority was denied for a range from 30 to 65 in [T 1877/08](#) (cited in G1/15), as only a range of 30 to 55 was disclosed in the priority document.

In cases where a prior application was also submitted as a European patent application, or the

### Schedule for introducing the Unitary Patent Package released

Great Britain's decision to ratify the Unified Patent Court (UPC) Agreement<sup>1</sup> has brought the single patent system within our grasp and preparations to introduce this system are underway once again. According to a [document](#) published by Preparatory Committee of the UPC, it is even likely to enter into effect this December.

As this publication indicates, it can be assumed that the so-called UPC protocol phase will begin in May. From this point onwards, the court can start to recruit judges and supplement the IT.

The possibility to opt-out existing European patents is scheduled to be available as of September. The exact terms are yet to be announced. The opportunity to opt-out would be given to patent holders three months before the Unified Patent system enters into effect.

This schedule is naturally subject to Great Britain's imminent, and Germany's subsequent, ratification. Shortly after their announcement on 28 November 2016, Great Britain signed the [Protocol](#) on Privileges and Immunities of the judges of the UPC on 14 December 2016, [pre-senting](#) this to parliament on 20 January 2017; this suggests that Great Britain will turn their words into actions.

There is naturally still some ambiguity, in particular where Great Britain is concerned. If they are unable to stay in the Unified Patent system after Brexit, what will become of single patents? How will complaints before the London local chamber be handled? As outlined in our previous newsletter, this will also depend on potential proceedings before the European Court of Justice.

All those working in the European patent sector

### And in our own affairs...

We'd like to once again make you aware of our annual patent seminar taking place on 11 May 2017 at the Düsseldorf Industrie-Club. Please find the detailed programme [here](#).

Invitations will be sent out shortly. If you'd still like to register for this event, please send an email with your postal address to: [seminar@mhpatent.de](mailto:seminar@mhpatent.de)

\*\*\*

Please also note the date of our tenth Rhineland Biopatent forum taking place on 8 June 2017 at our offices. The detailed programme will be announced separately.

\*\*\*

In February and March, Dr. Ulrich Storz will speak at several congresses on antibodies, namely:

- [9th Annual International congress on Antibodies](#) (29 – 31 March 2017, Beijing)
- [7th World ADC summit](#) (20 – 22 February 2017, Berlin)
- [Antibody/Targeted Drug Conjugates 2017](#) (22 –

applicant submitted a divisional, being denied a claim for priority could even lead to the applicant's own application being held against him as the state of technology. These were identified as "poisonous priorities" or "toxic divisionals".

Such "toxic divisionals" also led to the submission to the Enlarged Board of Appeal and to decision G1/15.

Their ruling was distinctly and preferably clear; no additional requirements need to be fulfilled for an applicant's priority right, apart from disclosure in the prior application. Most notably, the requirement to clearly define characteristics or sub-groups, as set out in G2/98 should not be understood as an additional demand (point 5.3 of the decision).

Consequently, there can't be any "poisonous priorities": the application or divisional giving rise to a right of priority cannot be prejudicial to novelty for a European application or European patent. Either novelty is present, or a priority is effective.

G1/15 therefore establishes an opinion as the new standard which has been the minority to date. At the same time, it constitutes a remit of the tough approach that has been taken so far, whereby only alternative subject matters that are clearly defined play a role in the substantive law of the European Patent Office when acknowledging the right of priority. It remains to be seen if changes to this will impact the European Patent Office in their future practice.

may well have to slowly warm towards the idea that the Unified Patent system will become a reality in the not too distant future.

<sup>1</sup> see our previous newsletter, available [here](#)

24 March 2017, LUMC, Leiden)

\*\*\*

At the end of February/beginning of March 2017, Guido Quiram will hold a series of seminars in San Diego, Irvine and Sunnyvale with patent attorney colleagues from Japan, China and the USA. He will give talks on the preparations and strategic aspects related to the Unified Patent system and Brexit. The exact date is yet to be announced.

\*\*\*

An [interview](#) is held with Dr. Aloys Hüttermann in the podcast "IPfridays" and he is given the opportunity to answer questions regarding the Unified Patent system.

### Proposals and Questions

If you have any proposals or questions, please don't hesitate to contact us [here](#)

---

[Impressum](#): Michalski · Hüttermann & Partner Patentanwälte mbB

Speditionstrasse 21 - 40221 Düsseldorf, Germany - Tel.: +49 211 159 249 0 - Fax: +49 211 159 249 20  
Joseph-Dollinger-Bogen 12 - D-80807 Munich, Germany- Tel.: +49 89 7007 4234 - Fax: +49 89 7007 4262

The content of this newsletter only reflects general information and does not constitute legal advice as per the German Legal Advice Act. Despite thoroughly checking the content, Michalski Hüttermann & Partner Patent Attorneys mbB does not assume any responsibility for the validity, accuracy, integrity or quality of the information above.