



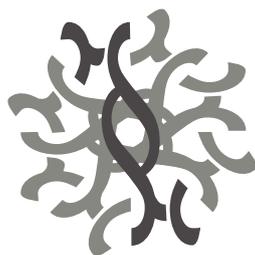
Newsletter Edition 2/2022

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M I C H A L S K I • H Ü T T E R M A N N
P A T E N T A N W Ä L T E

G 1/22 and G2/22- New referrals to the GBK: What are the consequences of designating inventors as applicants only for the US under PCT for priority claims under EP?

The Board of Appeal 3.3.04 has referred the following questions to the Enlarged Board of Appeal by decisions [T 1513/17](#) and [T 2719/19](#):

„I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

II. If question I is answered in the affirmative:

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?”

As can already be seen from the questions referred, the circumstances of the case are in no way unusual for applications from the USA filed up to 2012: A US provisional application was filed in 2004 in the name of the inventors as applicants, as this was required in the USA at that time. A PCT subsequent application was filed the following year claiming priority to the US provisional application. The inventors were again named as applicants in the PCT application for the USA, while the inventors' employers, namely a company and a university, were named as joint applicants for all other states. On the part of the university, it was erroneously assumed that the priority right had been transferred to the university by the employment contract of the inventors concerned. In contrast, the employment contract of the company in question actually contained an effective clause by which the priority right of one of the inventors had passed to the company.

The situation thus differs from CRISPR-Cas case [T 844/18](#),¹ in which the priority of a US provisional application had been claimed which had designated several applicants. There, the subsequent application had named only one applicant, without the remaining “shares” of the priority right having effectively passed to her. In this case, the Board of Appeal had found itself authorized and obliged to decide on the validity of the priority right claim and had denied such validity.

For the sake of completeness, it should be mentioned that in the present case, after entering the regional phase before the EPO, the university's rights were transferred to the second applicant and a transfer took place. A grant was made in 2014 and an opposition was filed in 2015. During the examination procedure,

¹ Cf. our newsletter [10/2020](#)

a divisional application had been filed.

The opposition proceedings ended with the revocation of the patent. The patentee had unsuccessfully attempted to obtain a correction of the applicant under R. 139. The priority claim was thus invalid and intermediate prior art resulted in all claims being considered as lacking novelty or inventive step.

Two years later, the divisional application was also rejected. The Examining Division concurred with the decision of the Opposition Division in the parent application with respect to the priority situation. The pending claims were thus struck by prior art prejudicial to novelty.

In both proceedings, the company appealed, and the proceedings were later combined by the board. The grounds of appeal included the argument that all applicants of the priority application were also named as applicants in the subsequent application. Therefore, the question of the transfer of the priority right did not arise at all. The designations for different states did not change anything about the naming of all applicants; according to Art. 11(3) PCT in conjunction with Art. 152(2) EPC, the PCT application already had the effect of an EP application.

Since decision [T 1933/12](#),² the principle applies to European patent applications that not all applicants of a subsequent application must also be applicants or successors in title of the priority application, i.e. an applicant identity between priority application and subsequent application is not required. Article 87(1) EPC only requires that all applicants of the priority application or their successors in title are also named as applicants of the subsequent application.

In addition to jurisdiction, the question that the Enlarged Board of Appeal now has to answer is whether this approach also applies if applicants are designated under the PCT only for the US, but not for EP. Examining and opposition divisions have answered this question differently.

Not entirely irrelevant for the Enlarged Board of Appeal might be the question of the significance of the fact that the designation of the inventors as applicants was explicitly for the USA only and that this was due to national requirements in the USA. In contrast, Art. 118 EPC allows different applicants for different EPC contracting states, but they are considered as joint applicants in the proceedings before the EPO. Decision [J 2/01](#) had derived from this a uniform procedural position of all applicants. However, the provisions under the PCT treaty are likely to take precedence here. From these, the referring board derives the possibility that individual applicants are applicants for the USA, but not for regionalization before the EPO.³

Finally, it remains to be feared that another important question will remain unanswered, namely under which jurisdiction the transfer of the priority right falls - especially since the present Chamber did not consider it necessary to put a question to the Enlarged Board on this issue.⁴ There seems to be agreement

² C.f. 2.4 of the reasons

³ No. 31 of the reasons

⁴ No. 37 of the reasons

among the chambers that this falls under national law, but the question under which .⁵

T 1367/19: Purpose provisions in claims

Although purpose provisions, such as “(suitable) for” or “to”, frequently occur in patent claims, there is comparatively little case law before the European Patent Office on the question of the extent to which these provisions can or cannot serve to distinguish from the prior art.

Now, in the recently published [T 1367/19](#), this very issue was at stake. The subject matter of the claim was a device “for culturing animal cells”, wherein the device concerns a fermenter with an agitator designed in a certain way.

The most important state of the art was a fermenter with the same stirrer that was public prior use. At that time, however, it was indisputably not used for the cultivation of animal cells but of bacteria.

Fermenters for the cultivation of bacteria are usually more simply designed than fermenters for animal cells.

In particular, the latter often have a further feed line for CO₂ as well as a more precise pH control, since animal cells are usually buffered with a CO₂ bicarbonate buffer system, while bacteria usually make do with other buffers (phosphate or HEPES buffers) where this is not necessary. For this reason, the patent proprietor had argued (inter alia) that said prior art device lacked the claimed suitability. The opposition division found in favor of the patentee, and the opposition was rejected.

However, it was the case that corresponding features were not present in the granted claim as well as in the description. Moreover, it is not impossible to use a fermenter normally used for the cultivation of bacteria also for animal cells; only the results will sometimes be worse.

The Board of Appeal now ruled on lack of novelty on the following grounds: The corresponding claim 11 would describe a device with corresponding features.

„On the other hand, the rest of the peripheral equipment, including the control system and corresponding input pipes as well as the fluids used, is not part of the device defined in claim 11. Any modifications thereto in order to render the entire system suitable for culturing animal cells (e.g. a pH control, the supply of CO₂, the use of a different buffer solution) are irrelevant to the evaluation of the question of novelty of the claimed device. Contrary to the opposition division’s position, the Board is of the opinion that the intended purpose “for culturing animal cells” cannot be used to read into the claim features that are not present. If the intention was to protect the device including the whole control system, the corresponding features should have been included in the claim.

In our own affairs

On a [Webinar](#) of the Bavarian Group of the GRUR Prof. Dr. Aloys Hüttermann will speak about the unitary patent system, together with EPO’s Dr. Stefan Luginbühl.

⁵ Siehe z.B. die Entscheidung T 1201/14

As a consequence, the [patentee's] relating to the gas connections, the control system and the type of valves to be used to avoid carbon dioxide corrosion are irrelevant, since these features are not part of claim 11 and do not have to be taken into consideration for the question of novelty. The [prior use fermenter is] a system which is preconfigured for the measurement and control of certain parameters such as temperature, pH etc. However, this does not mean that the vessel as such with the specific stirrer, which is the claimed device, could not be used (or would be unsuitable) with a different control and measurement system. Different controls allow the technical features such as the stirrer to be adapted to a different use, meaning that the stirrer as such is suitable for an alternative use.”⁶

As a result, the patent was granted as is and a first auxiliary request, which still contained the relevant claim 11, was rejected due to lack of novelty.

However, the situation was different with respect to the granted claim 1. This was directed to a method using the fermenter, but for “culturing mammalian cells”. Here, the Board of Appeal considered the statement of purpose to be so limiting that novelty was assumed over the obviously pre-used fermenter, nor was it considered to be the closest prior art.

As a result, a set of claims based on this claim was held to be novel and inventive, and the patent was thus upheld on a limited basis.

In this decision, the Board of Appeal showed with desirable clarity that purpose or suitability statements in patent claims must not be overused and, in particular, cannot lead to demand from the prior art the presence of features not contained in the disclosure underlying the patent in suit or even in the granted patent claim itself. A suitability in principle of the subject matter out of the prior art is also sufficient to anticipate the claimed purpose. However, the fact that the process claim was upheld also shows that purpose features are not meaningless.

From our law firm, Dr. Torsten Exner and Dr. Ulrich Storz (lead) were involved in the proceedings on the side of the opponents.

European Patent Office facilitates access to unitary patents - no news from the Unified Patent Court

After the Protocol⁷ entered into force on January 19, 2022, the necessary preparations are underway for the Unified Patent Court to start its work. This concerns in particular the selection of judges. The selection procedure⁸ is regulated in such a way that an initial selection is made by the Advisory Committee, but the final appointment is done by the Administrative Committee.

So far, however, neither the Advisory Committee nor the Administrative Committee have been officially constituted, so we will have to wait and see.

In the meantime, however, the European Patent Office has decided to facilitate access to unitary patents during the protocol phase.

⁶ C.f. 1.2 of the reasons

⁷ Exact title: „Protocol to the Agreement on a Unified Patent Court on provisional application“, cf. our newsletters [Newsletter 9/2021](#), [11/2021](#), [12/2021](#), [14/2021](#) und [1/2022](#)

⁸ Art. 3 of the statute of the Unitary Patent Court

Unitary patents can be requested for all European patents where the publication of the grant is after the entry into force of the Convention.

Since the latter is in the hands of the European Patent Office, the President⁹ has decided to allow applicants to request that the publication of the grant be delayed for corresponding applications. The applications for which such a request is possible are those for which an intention to grant (=71(3) communication) has been issued

by the Office, but the applicant has not yet communicated his agreement, i.e. paid the fees and the translations into the other two official languages.

There is a form for the free request. However, it is not possible yet, but only after Germany has deposited the instrument of ratification of the Convention with the EU.¹⁰

From this date, according to a further communication from the Office,¹¹ it will also be possible to file applications for unitary effect (= validation applications for the unitary patent). These would then also be examined in advance by the EPO.

Both possibilities, i.e. delayed publication of the grant as well as early application for unitary patents, are only valid until the system enters into force. It has not yet been determined when Germany will deposit the instrument of ratification, but this is probably not expected before the summer. As soon as this is done, however, applicants should consider whether they want to make use of either.

In our own affairs

We wish your relatives, employees, colleagues and, of course, yourself all the best for the current, still difficult time.

Imprint:

Michalski · Hüttermann & Partner
Patentanwälte mbB

Speditionstrasse 21
D-40221 Düsseldorf
Tel +49 211 159 249 0
Fax +49 211 159 249 20

Hufelandstr. 2
D-45147 Essen
Tel +49 201 271 00 703
Fax +49 201 271 00 726

Perchtinger Straße 6
D-81379 Munich
Tel +49 89 7007 4234
Fax +49 89 7007 4262

De-Saint-Exupéry-Str. 10
D-60549 Frankfurt a.M.
Tel +49 211 159 249 0
Fax +49 211 159 249 20

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⁹ Cf. here: <https://www.epo.org/law-practice/legal-texts/official-journal/2022/01/a4.html>

¹⁰ cf of our newsletters [Newsletter 9/2021](#), [11/2021](#), [12/2021](#), [14/2021](#) und [1/2022](#)

¹¹ Cf. here: <https://www.epo.org/law-practice/legal-texts/official-journal/2022/01/a6.html>