Are you sure that priority is validly claimed?

The legal perspective
Are you sure that priority is validly claimed?

presenter and moderator

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Are you sure that priority is validly claimed?

Objectives

▪ Raise awareness of the complexity of legal issues revolving around the formal validity of priority claims

▪ Point out common pitfalls which ought to be avoided in transfers of the right of priority
Are you sure that priority is validly claimed?

**Agenda**

- Formal entitlement to priority
  - Principle
  - Same applicant
  - Joint applicants
  - Succession in title
  - Three-step test
  - Case law

- Questions
Formal entitlement to priority – principle

Rights to priority/the application/the invention under the EPC

Inventor or his successor in title has a right to a European patent for his invention under the EPC and the applicable national law.

Applicant or his successor in title deemed to be entitled to exercise the right to a European patent under the EPC.

Same applicant or his successor in title has a right to priority under the EPC and the law governing the transfer of the priority right/application.

Art. 60(1), Art. 61 EPC
Art. 60(3) EPC
Art. 87(1) EPC
Formal entitlement to priority – principle

Entitlement to claim priority under the EPC

"Any person who has duly filed [...] an application [...] or his successor in title, shall enjoy [...] a right to priority"

- Same applicant(s)
  - If not
    - Successor(s) in title

Art. 87(1) EPC
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Formal entitlement to priority – same applicant

Same applicant – no evidence required

Priority Document

EP Application
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Formal entitlement to priority – joint applicants

Joint applicants – no evidence required

Priority Document → EP Application
Formal entitlement to priority – joint applicants

Joint applicants – no evidence required

GL Part A-III, 6.1
T 1933/12, reasons pt. 2.4
Art. 118 EPC
Formal entitlement to priority – joint applicants

Joint applicants – evidence of succession required

Priority Document ➔ EP Application

X Y X

T 788/05, reasons pt. 2
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Formal entitlement to priority – succession in title

Succession in title – different types of succession

Individual succession

Universal succession

transfer of priority right or priority application

succession to the estates of a deceased person or company mergers/acquisitions
Formal entitlement to priority – succession in title

Succession in title – what to submit as evidence?

▪ The EPC does not provide the requirements for a valid transfer of the priority right in the EPC

▪ The Board in T 62/05 found:
  - transfer of priority justifies a formal approach
  - requirements set out in Art. 72 EPC are reasonable

▪ The Board in T 205/14 disagreed:
  - standard of proof is "balance of probabilities"
  - Art. 72 EPC limits the means of evidence for assignments of patent applications under the EPC
  - national law governs the relationship between the parties
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Formal entitlement to priority – three-step test

Three-step test

What is the law applicable to the transfer?

What are the requirements for validity of the transfer under the applicable law?

Are the validity requirements met?

T 205/14, reasons 3.6.4 – 3.7.6
Formal entitlement to priority – three-step test

Three-step test

Step 1: determining the applicable law

Choice-of-law clause in written assignment

If not

Law most closely connected to succession

? 

Law governing relationship between parties to succession

The legal sphere the transferor is most closely connected to
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Formal entitlement to priority – case law

Case law

▪ "Economische eigendom" under Dutch law
  - not sufficiently proven that the transfer of economic ownership amounts to succession in title (and not only to the grant of a licence)

▪ "Perfect equity" under UK law
  - transfer of priority right recognised when a transferee discharged all his obligations as purchaser, but missed to fulfil a purely formal requirement
Formal entitlement to priority – case law

Case law

▪ "employed to invent" under US law
  - automatic assignment of employer's right to inventions and patents to employer before priority application is filed

▪ "nunc pro tunc assignment" under US law
  - assignments concluded after the filing of the priority claiming application with retro-active effect
  - not recognised under the EPC

pending as T 434/15

T 1201/14, reasons 3.2.1 with further reference
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▪ Questions
Questions

now via chat to "All participants"

later via mail ➔ academy@epo.org