



February 9, 2016

Registrar of the Enlarged Board of Appeal
European Patent Office
D-80298
GERMANY

Dear Sirs,

Re: Amicus Curiae Brief on questions referred to the Enlarged Board of Appeal in case G1/15

We are writing to provide Intellectual Property Owners Association (IPO's) views on the questions referred to the Enlarged Board of Appeal (EBA) in case G1/15. IPO is pleased to be able to provide its opinion on the questions referred and thanks the EBA for its invitation to file amicus briefs in this case.

The questions referred to the EBA are of fundamental importance to the validity of European patents and will affect all users of the European patent system. Although not binding on national courts in Europe, the EBA's decision will be highly influential in those jurisdictions and so the referral will have impact throughout Europe and not just on cases handled by the EPO. The referral is particularly significant because it provides the EBA with the opportunity to rule on the validity of the "toxic divisional" attack. It is therefore particularly important that the views of the users of the European patent system are fully taken into account by the EBA in formulating its answers to the referred questions.

Intellectual Property Owners Association is an international trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as an inventor, author, executive, law firm, or attorney member. Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO regularly represents the interests of its members before legislative and regulatory bodies, and other governmental agencies and has filed amicus curiae briefs in the US courts and other courts on significant issues of intellectual property law. The members of IPO's Board of Directors, which approved the filing of this brief, are listed in the Appendix.¹

¹ IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

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Background – the so-called “toxic divisional” problem

A consequence of filing a divisional application is the creation of a new European patent application which may disclose specific subject-matter which is entitled to an earlier priority date than the generic claims of its parent application. According to the “toxic divisional” attack, the new divisional and the specific subject-matter in particular become novelty-destroying prior art under Article 54(3) EPC against the parent. It is the mere act of filing the divisional application and the consequent creation of a new piece of prior art under Article 54(3) EPC which allegedly causes the “toxic divisional” problem. The reason for the filing of the divisional or the subject-matter claimed in the divisional are irrelevant to its effect as a “toxic divisional.”

IPO’s position is that divisional and parent applications in the same family should never be available as novelty-destroying references against each other under Article 54 EPC. To allow such “toxic divisional” attacks would be inconsistent with the concepts of priority and, in particular, “multiple” and “partial” priorities under the EPC.² The EBA has already provided guidance on the concepts of “multiple” and “partial” priorities in an early decision³ and that guidance shows why the “toxic divisional” attack is incorrect. Indeed, the EPO Technical Boards of Appeal have correctly applied the early EBA guidance in some more recent decisions to show why the toxic divisional attack is not correct.⁴

In the following paragraphs, we first summarise our proposed answers to the referred questions and then state our principle reasons for these answers.

Summary of answers to questions

IPO believes that the questions referred to the EBA should be answered as follows:

Question 1: Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document?

Answer 1: No

Questions 2 to 5 do not require an answer in view of the proposed answer to question 1 above.

However, if the EBA should decide to answer question 1 in the affirmative, it is IPO’s view that the answers to questions 2 to 5 should be as set out below. Importantly, IPO is of the opinion that any answers given to questions 2 to 5 must be such that the so-called “toxic divisional” attack is rendered impossible.

² As set out in Article 88(2) EPC and interpreted by later Board of Appeal case law.

³ G2/98 (from 2001).

⁴ T1222/11 and T571/10 discussed in more detail below.

Question 2: If the answer is yes, subject to certain conditions, is the proviso "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" in point 6.7 of G 2/98 to be taken as the legal test for assessing entitlement to partial priority for a generic "OR" claim?

Answer 2: Yes

Question 3: If the answer to question 2 is yes, how are the criteria "limited number" and "clearly defined alternative subject matters" to be interpreted and applied?

Answer 3: The approach set out in decisions T1222/11 (reasons 11) and T571/10 (reasons 4.5.12) should be followed, i.e., that the requirement for a claim giving rise to a “limited number of clearly defined alternative subject-matters” refers to the ability to conceptually identify, by comparison of claimed subject-matter with the disclosure of its priority document, such alternative subject-matters to which the multiple rights of priority claimed can be attributed.

Question 4: If the answer to question 2 is no, how is entitlement to partial priority to be assessed for a generic "OR"-claim?

Answer 4: No answer needed. But any answer that is given to question 4 should ensure that the “toxic divisional” attack is rendered impossible.

Question 5: If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Article 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon?

Answer 5: No

REASONS

Our reasons for the above proposed answers are set out in more detail below.

The “toxic divisional” attack should be excluded

Questions 1 and 5

IPO recommends eliminating the possibility of so-called “toxic divisional” attacks where a family member (a parent or divisional of the patent in-suit) can be cited as novelty only prior art under Article 54(3) EPC rendering the patent-in-suit lacking in novelty.

If the “toxic divisional” attack is not excluded by the EBA’s answers to the referred questions, the validity of European patent portfolios will be severely compromised. Many patents previously considered to be valid will be vulnerable to invalidity challenges on the basis of their own family members as prior art. This would have wide reaching negative consequences for all users of the European patent system and would be against the interests of the European business community.

The “toxic divisional” attack relies on a more specific disclosure in the priority application A (often an example), set against a generic claim in an application B that is not entitled to priority (often because the claims were broadened when filing application B and claiming priority to priority application A). As a result, application B loses priority for the broadened claims, but the more specific disclosure in priority application A retains its earlier date and so is citable as novelty only prior art.

By answering question 1 in the negative, the EBA would confirm the principle that the disclosure of subject-matter in a priority document is enough to permit partial priority for that part of a generic claim and this would provide a permanent solution to the “toxic divisional” problem. With an answer of “no” to question 1, all toxic divisional attacks would fail, because the generic claim would always be entitled to partial priority for any disclosure that appeared in the priority document. As a result, no family member (parent or divisional) could contain a novelty destroying disclosure with an earlier effective date. IPO considers this to be the simplest way to achieve the desired outcome of excluding the “toxic divisional” attack.

However, if a positive answer is given to question 1, question 5 must be answered in the negative to ensure that the “toxic divisional” attack is explicitly excluded. IPO’s view is that it was never the intention of the legislator for family members to be citable against each other under Article 54(3) EPC. Furthermore, to permit the “toxic divisional” attack would allow the validity of European patent portfolios to be put in question as a result of divisional applications filed in good faith at a time when no question of their impact on validity of their family members arose. The problem is not merely hypothetical because the innovative industry normally builds from specific examples to generic classes over time. Patent holders often file a series of priority documents disclosing progressively broader sets of examples as the corresponding research and development work progresses. Additionally, the innovative industry relies on the filing of divisional applications as a legitimate means of securing adequate protection and return for its investment in research and development. Accordingly, the innovative industry would be unfairly impacted if the “toxic divisional” attack is not rendered impossible.

These public policy reasons also point the EBA towards a negative answer to question 5, in the event that question 1 has to be answered positively.

Questions 2 to 4

IPO believes that Board of Appeal decisions T1222/11 and T571/10 correctly interpreted the proviso of reasons 6.7 of G2/98, namely the requirement for a generic “OR” claim to “give rise to the claiming of a limited number of clearly defined alternative subject-matters.” T1222/11 and T571/10 held that this requirement referred to the ability to conceptually identify, by comparison

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of claimed subject-matter with the disclosure of its priority document, such alternative subject-matters to which the multiple rights of priority claimed can be attributed.⁵ In reaching these decisions, the Boards rejected the idea set out in some earlier Board of Appeal decisions⁶ that the proviso of reasons 6.7 of G2/98 included an additional requirement that the subject-matter was spelt out or individualised in the claim itself in order for entitlement to partial priority to be recognised. For example, as noted in T557/13⁷ (reasons 15.3.3), the Board in T1222/11 concluded that the decision on whether priority could be acknowledged for subject-matter disclosed in the priority document and encompassed by an “OR”-claim does not depend on whether this subject-matter is expressly identified as a separate alternative in the claim.

IPO agrees with this “conceptual approach” to the interpretation of the proviso of reasons 6.7 of G2/98. IPO in particular agrees with the Board’s analysis in T1222/11⁸ of Memorandum C of document M/48/I submitted at the Diplomatic Conference of 1973 by FICPI (the “Memorandum”). Accordingly, in our view, the EBA should answer questions 2 to 4 in a manner consistent with decisions T1222/11, T571/10 and the interpretation of the “Memorandum” in decision T1222/11.

IPO thanks the Enlarged Board of Appeal for the opportunity to provide these comments for consideration.

Yours sincerely,



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Chair, IPO Amicus Brief Committee
Intellectual Property Owners Association

⁵ Reasons 11 of T1222/11 and Reasons 4.5.12 of T571/10.

⁶ E.g. T1127/00, Reasons 5 to 7.

⁷ The referring decision in case G1/15.

⁸ Reasons 11.6.