

FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE

Date: August 20, 1973
Revised: August 28, 1973

re: Munich Diplomatic Conference
September 10 to October 6, 1973.

MEMORANDUM C

on multiple priorities (Art. 86 (2)) and partial
priorities (Art. 86 (3)).

1. Multiple priorities.

The UNICE in M/19, point 8, pages 172-3, the CIFE in M/22, point 4, pages 244-5, and the FEMIP in M/23, point 23, pages 294-5, propose that it should be stated in Art. 86 (2) that multiple priorities may be claimed not only in respect of one and the same application, but also in respect of one and the same claim of that application.

The claiming of multiple priorities for one and the same patent claim is expressly prohibited in the laws of some countries. As an example the applicant is required in Austria to state which priority is claimed for each of the patent claims, and is only permitted to state one priority for each claim. Similar rules exist in Canada and Australia, and existed in the United Kingdom in a quite recent epoch. In a number of European countries where the priority claim is normally not examined by the Patent Office there is a presumption that multiple priorities cannot be claimed for one and the same patent claim, in other European countries there is a presumption that they can. In quite a number of countries, the position is not clear.

Under the European Patent Convention it is essential that the position should be made clear, because priority is one of the issues coming under grounds for revocation, viz. under Art. 138 (1) (c). As long as the Convention does not contain an express provision on the question considered, the maximum solution will be illusory in the case of patents for which multiple priorities are claimed, and applicants would not know how to draw up their patent claims in such cases.

In the following analysis, an application from the filing date of which priority is claimed, will be referred to as a priority document, while an application for which priority is claimed, will be referred to as an application.

In evaluating whether there is any justification for claiming multiple priorities for one and the same claim of an application, a distinction has to be made between the following situations:

Type A + B claim ("AND"-claim, claim too narrow to be supported by the disclosure of the first priority document).

It is probably recognized by everybody that where a first priority document discloses a feature A, and a second priority document discloses a feature B for use together with A, then a claim directed to A + B cannot enjoy a partial priority from the first priority date, because the invention A + B was disclosed only at the date of the second priority document.

In other words, if A + B is proved to belong to the state of the art between the two priority dates, the claim to A + B must be declared invalid.

If A in itself is a patentable invention, and the application contains both a claim to A, and a claim to A + B, the first priority can be claimed for the claim to A, and the second priority for the claim to A + B, thus multiple priorities can be claimed for the application as a whole, but not for any individual claim of the application.

Type A or B claim ("OR"-claim, claim too broad to be supported by the disclosure of the first priority document).

If a first priority document discloses a feature A, and a second priority document discloses a feature B for use as an alternative to A, then a claim of the application directed to A or B will in fact consist of two distinct parts A and B respectively, each complete in itself, and there seems to be no reason why it should not be possible to claim the first priority for part A of the claim and the second priority for part B of the claim.

It is of course immaterial whether the word "or" actually occurs in the claim, or is implied through the use of a generic term, or otherwise.

Situations of the "OR"-type will particularly occur in chemical cases because of the limited possibilities in such cases of broadening claims. Situations of this type will in the following be illustrated by some examples typically occurring in everyday practice.

a) Broadening of chemical formulae.

A first priority document discloses a relatively narrow chemical formula supported by representative examples. A second priority document discloses a broader chemical formula which within its scope includes the narrower chemical formula, and which is supported by additional examples justifying the broader formula.

If multiple priorities for one and the same claim are allowed, it will suffice to draw up a single claim directed to the broad formula. This claim will then enjoy priority from the first priority date to the extent that the compound in question comes within the scope of

the narrow formula, and the second priority for the rest of its scope.

14. If multiple priorities for one and the same claim are not allowed, the applicant would have to draw up two parallel claims, one directed to the narrow formula and enjoying the first priority, and another directed to compounds coming within the broad formula, but not within the narrow formula. The latter claim would then enjoy the second priority.

15. Let us assume that the principal claim of the first priority document is directed to a composition including chlorine in some form and capacity and that the description of the first priority document, including the examples, does not mention any alternatives for chlorine. Let us assume that as a consequence of further experiments the applicant has found that chlorine may be replaced by bromine, iodine or fluorine, without substantial change of the technical effect. He then files a second priority application claiming the use of bromine, iodine or fluorine as a substitute for chlorine. The second priority application contains examples of the use of all these elements.

16. When the applicant files his European patent application he accordingly draws up a principal claim directed to the use of a halogen. He is clearly entitled to the first priority for that claim to the extent that the halogen is chlorine, and entitled to the second priority to the extent that the halogen is bromine, iodine or fluorine. In this situation the claiming of multiple priorities therefore makes sense, seeing that one of the possible embodiments within the scope of the claim is clearly disclosed in the first priority document.

17. If the applicant is not permitted to claim multiple priorities for his principal claim, he cannot claim any priority at all for that claim, not even the second priority because the second application was not the first to disclose the use of a halogen. In order to secure his priority rights he will then try, as the only possible remedy, to draw up four sub-claims, each directed to one of the members of the halogen group. The first of these claims will enjoy the first priority and the following three claims will enjoy the second priority.

8. However, experience in many European countries shows that this type of sub-claims will not be allowed. They will be rejected as frivolous, as just being an exhaustive list of the halogens which any school boy can find in his elementary text book.

9. But if these sub-claims are so rejected, and multiple priorities for the first claim are not permitted, the applicant has entirely lost his priority right, which is contrary to the Paris Convention.

o. In other words, in order to comply with the Paris Convention in the case considered it will be necessary either to allow multiple priorities for one and the same claim, or to allow claims which on the face of it are frivolous, but in fact serve the perfectly legitimate purpose of claiming multiple priorities. This will create a tendency towards multiplicity of claims

which it may be difficult to keep in check.

21. Let us now examine what happens if the applicant lets himself be coerced into abandoning the sub-claims to chlorine, bromine, iodine and fluorine, thus maintaining only the halogen claim, and his European patent later comes before a national court in a situation where an alleged infringer is able to prove that there has been public use of the invention (maybe the patentee's own use) between the second priority date and the actual filing date of the European patent application.

22. If, under the national law of the country concerned multiple priorities for one and the same claim are not allowed, the patent will be declared invalid, but if multiple priorities for one and the same claim are allowable, the patent will be declared valid.

23. Similarly, if public use of the chlorine embodiment is proved to have taken place between the two priority dates, the halogen claim will be declared invalid in a country of the first type, and valid in its entirety in a country of the second type.

24. If public use of all four embodiments is proved to have taken place between the two priority dates, the halogen claim will again be declared invalid in a country of the first type, while in a country of the second type, it will, in accordance with Art. 138 (2), be limited to the chlorine embodiment.

25. Such differences between decisions on the same validity issue under Art. 138 (1)(a) in different Contracting States obviously should not be tolerated.

b) Broadening of range (temperature, pressure, concentration, etc.).

26. Let us assume that a first priority document discloses a temperature range of 15-20° and a second priority document discloses a temperature range of 10-25°.

27. If multiple priorities for one and the same claim are allowed, it will suffice in the European patent application to draw up a claim directed to the temperature range 10-25°.

28. If multiple priorities for one and the same claim are not allowed, the applicant will have to draw up two parallel claims, one directed to the temperature range 15-20° and enjoying the first priority, and another claim directed to the temperature ranges 10-15° or 20-25°, which claim will then enjoy the priority of the second priority document which was the first one to disclose these temperature ranges.

c) Broadening of field of use.

29. Let us assume that a first priority document discloses a method of coating the inner wall of a pipe and that a second priority document discloses the use of the same method for coating the inner wall of bottles or any other hollow bodies.

30. If multiple priorities for one and the same claim are allowed, it will suffice in the European patent application to draw up a claim to a method for coating the inner wall of hollow bodies. If multiple priorities for one and the same claim are not allowed, the applicant will have to draw up two parallel claims, one directed to a method of coating the inner wall of pipes, which claim will enjoy the first priority, and a second claim directed to a method of coating the inner wall of hollow bodies not being pipes, which claim would enjoy the second priority.

31. The probable reason why some countries have a prohibition against the claiming of multiple priorities for one and the same patent claim, is that they have particularly considered situations of the "AND"-type. Obviously these situations have to be considered, and it might therefore give rise to confusion if a provision were adopted simply stating, without reservation that multiple priorities can be claimed for one and the same patent claim.

32. The following addition to Art. 86 (2) is therefore presented for consideration:

English version:

"Where appropriate, multiple priorities can be claimed for one and the same claim of the European patent."

German version:

"Gegebenenfalls können mehrere Prioritäten für ein und denselben Patentanspruch des europäischen Patents geltend gemacht werden."

II. Partial priority.

33. It has been pointed out by the CNIPA in M/20, point 18, pages 204-5, that Art. 86 (3) is not clear, and in M/22, point 5, pages 244-5, the CIFE makes substantially the same comment on Art. 86 (4) and points out that the words "Merkmale", "elements" and "éléments" used in the three versions are not clear and are hardly coextensive.

34. The trouble is that the wording of both paragraph 3 and 4 have been taken from the Paris Convention and therefore the Diplomatic Conference will probably hesitate to make any amendments.

35. The objection to paragraph 4 seems not to be very important, because paragraph 4 relates to a full priority claim and in fact just says that the applicant is permitted to take up in his claim subject matter disclosed but not claimed in the priority document. For that purpose it is immaterial whether subject matter, elements, Merkmale, etc. is interpreted one way or the other.

The objection to paragraph 3 is more serious, because paragraph 3 relates to the claiming of a partial priority. The claiming of partial priorities should of course be governed by the same principles as those explained above for the claiming of multiple priorities. Consequently, an improvement might be obtained by making a similar addition to paragraph 3 as that proposed above to paragraph 2.

English version:

"Where appropriate, a partial priority may be claimed for a claim of the European patent, or separately for several claims."

German version:

"Gegebenenfalls kann eine Teilpriorität für einen Patentanspruch des europäischen Patents oder für mehrere Ansprüche je für sich geltend gemacht werden."

It would not be appropriate to claim a partial priority in the case mentioned by the CNIPA in W/20, point 18, pages 204-5, which corresponds to the "AND"-situation under "Multiple Priorities", but it would be appropriate to claim a partial priority in situations corresponding to the "OR"-situation under "Multiple Priorities", the European patent application itself taking the place of the second priority document.

III. Distribution of priorities by limitation of claims.

In countries where limitation may be effected in the form of an amendment to the claims, the description or the drawings, cf. Art. 138 (2), the question of the claiming of multiple and partial priorities for one and the same claim is less important, seeing that at least in most cases it would probably be possible to amend the claims in such a manner that after amendment only one priority is claimed for each individual claim. The question may be raised however, whether such a procedure would not amount to an admission that before amendment multiple or partial priorities were validly claimed for one and the same claim.

It is also pointed out that the possibility of limitation by amendment of claims is subject to national law and in many countries it is highly questionable whether amendment in this form is permissible under present law. If not, the Convention does not force Contracting States to change their law on this point.